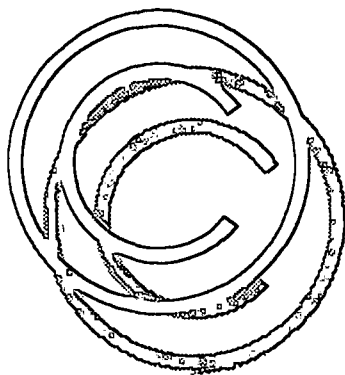

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PART I.

ARTICLES

1. U.S. SENATE PASSES OMNIBUS REVISION BILL (S.1361)
AND INTERIM LEGISLATION (S. 3976)*

By WALTER J. DERENBERG**

A major step forward to ultimate revision of the entire United States Copyright Act of 1909 has been accomplished. In accordance with his repeated promise to report his Copyright Revision Bill S. 1361 out of the Subcommittee of the Senate Judiciary Committee to the full Committee,¹ and thereafter to the floor of the Senate, Senator McClellan succeeded in having an amended bill passed on the floor of the Senate on August 9, and in addition had the Senate adopt two interim Copyright legislative measures which are necessary before the House of Representatives may again take action on final revision. (It will be recalled that the House had several years ago passed a revision bill.²)

After the McClellan bill was reported by the Senate Judiciary Committee, it was referred, upon special request by the Chairman of the Committee on Commerce, to that Committee for the purpose of considering a number of amendments dealing with communications — the thorny issue of cable television, the performance royalty for the benefit of record companies and performing artists and some related matters. On July 29 of this year the Commerce Committee reported the bill, submitting five additional amendments³ which were subsequently debated on the floor of the Senate on September 6 and 9, 1974.⁴

* This article is an extract from a report by the author to the Legislative Committee of CISAC (Confédération internationale des Sociétés d'Auteurs et Compositeurs) at its meeting on October 3 and 4, 1974, in Madrid.

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¹ Copyright Law Revision, S. Rep. No. 93-983 (93d Cong. 2d Sess.), July 3, 1974.

² H.R. 2512 (90th Cong. 1st Sess.), April 11, 1967.

³ S. Rep. No. 93-1035 (93d Cong. 2d Sess.), July 29, 1974, to accompany S. 1361, a bill for the general revision of the copyright law, title 17 of the United States Code.

⁴ Copyright Law Revision, Congressional Record, vol. 120, no. 133, (daily ed. Sept. 6, 1974), pp. S16064-S16075, and no. 134, (daily ed. Sept. 9, 1974), pp. S16146-S16186.

I.

The final vote on S. 1361 on September 9 was 70 to 1 in favor of the revision bill. The Senate, therefore, overwhelmingly approved most of the basic changes of our copyright system which had also been approved by the House of Representatives in 1967. Outstanding among these is, of course, the proposed abolition of our two-term copyright and renewal system and the substitution therefor of the principle of protection for the life of the author plus 50 years. It should not be assumed, however, that the debate over some of the most controversial features of copyright revision has now been terminated. On the contrary, some of these will undoubtedly be revived by the House Judiciary Committee or subsequently on the floor of the House.

I shall, therefore, refer only to some of the major features of S. 1361 as passed by the Senate which undoubtedly will be again raised in the House at some future time, i.e. at the earliest, some time during 1975 (there is no hope that the House of Representatives in the present political climate would have an opportunity to even consider the Omnibus Copyright Revision Bill before the expiration of the present Congress).

1. The most hotly debated issue on the floor of the Senate proved to be an amendment introduced by Senator Ervin and others, seeking the elimination of the performing royalties, added in Sections 110 and 114 by the Judiciary Committee, which would be paid by broadcasters to record companies and performing artists for playing their records over the air. In other words, with a possible view toward ultimate ratification of the Rome Convention on Neighboring Rights,⁵ the Judiciary Committee had included provisions which for the first time would give record companies a performing right in addition to existing protection against unauthorized duplication and would provide for quasi copyright protection for the benefit of performing artists. Opposition against recognition of these neighboring rights (long recognized by the laws of a great many European countries) was so strong that the entire bill may have become the subject of a motion to recommit if these provisions had been retained in the bill. When the Ervin Amendment finally came up for a vote on the floor (one of the proposed amendments of the Commerce Committee also included the striking of these provisions on the ground that such royalties would put too great a financial burden on radio and television stations, especially the small radio broadcasters⁶), it was adopted by a vote of 67 to 8.⁷

⁵ The Rome Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations, October 26, 1962.

The debate on the floor on the neighboring rights issue reflects a strong bias in favor of broadcasters and a notable lack of understanding of the need for some protection of performing artists against unauthorized performance of their renditions. It is, indeed, astonishing to read that so acknowledged an expert on the Constitution as Senator Ervin stated that there may even be a question of constitutionality. His objections were shared, among others, by Senator Hruska, who stated on the floor:⁸

“We cannot accept the view held by some that the record manufacturers and performers are ‘authors’ or ‘inventors’ as specified in article I, section 8, clause 8 of the U.S. Constitution. Although their efforts in producing records are very significant, such contributions do not, in my judgment, constitute original intellectual creations justifying protection under our copyright statute. This would be an unwarranted stretching of the Constitution and a bad precedent in law.”

The Senate Minority Leader, Senator Scott, was one of the few who urged retention of the neighboring rights provisions and introduced into the Congressional Record⁹ a letter from the present Register of Copyrights of July 31, 1974, in which she stated that there was “no doubt about it in my mind as to the constitutionality of the performance royalty in S. 1361.” Ms. Ringer forcefully observed *inter alia*:

“Performing artists contribute original, creative authorship to sound recordings in the same way the translator of a book creates an independently copyrightable work of authorship.

⁶ The Commerce Committee Report said further in this regard:

“Your Committee has never had ample opportunity to consider the possible consequences of such a provision.

“More importantly, those who would be directly affected — the broadcasters, the performers, and the recording companies — have never had an opportunity to appear before the Committee charged with legislative jurisdiction over broadcasting to explain what they perceive to be the effect of this requirement on them.

“There are differing views on the matter, but this Committee has never had the opportunity to hear them and weigh the pros and cons.

“Your Committee would have been derelict if it ignored a provision which would have such a significant impact on the nation’s broadcast service to remain in S. 1361, as amended, without thoroughly exploring its possible consequences.” S. Rep. No. 93-1035 (93d Cong. 2d Sess.) July 29, 1974, “Minority and Additional Views”, p. 71.

⁷ Cong. Rec. p. S16153, Sept. 9, 1974.

⁸ *Ibid.* p. S16149.

⁹ *Ibid.* p. S16151.

Record producers similarly create an independently copyrightable work of authorship. * * * In my opinion, the contributions of both performers and record producers are clearly the 'writings of an author' in the constitutional sense, and are as fully worthy of protection as any of the many different kinds of 'derivative works' accorded protection under the Federal copyright statute."¹⁰

The hostility against recognition of the performing royalty went so far as to lead one senator to suggest that instead of receiving recognition for their artistic contribution, recording artists and companies should pay the broadcasters for the privilege of having their works transmitted.¹¹ The senator then referred to the "sinister consequences" of the bill's position in favor of neighboring rights. He pointed out that in the full Judiciary Committee a motion to delete Section 114 failed by the slimmest of all possible margins (a tie vote of 8 to 8).

What is particularly disconcerting — in this writer's personal opinion — is the characterization by the Chairman of the Commerce Committee, Senator Pastore, of the performing rights royalty amendment as "a can of worms", a "monstrous pie" and a "new family of copyright entitlements which has never existed before."¹² Moreover, Senator Ervin went so far as to state that neither a recording artist nor a sound recorder was an "author" under the Constitution. He said: "The recording artist merely sings a song which someone else has composed. The composer is the author of the song and there is nothing original as far as the writing is concerned in the work of the performing artist."¹³ If that were really true, in other words, if the performance of a classical work by a Horowitz or Heifetz or Toscanini was not considered "an original work of art", how can our present statute provide, in Section 5, for a separate classification of "reproductions" of works of art which are considered "original" even though copyright may never have existed or may no longer exist in the works of art from which they are derived?¹⁴ And how would we justify copyright in photographs which only "reproduce" nature or human beings?

With the unfavorable comments by Senators Ervin, Packwood and others should be compared the statement by Senator Tunney who regretted the action of the Senate in striking the performance royalty "without a full debate" and expressed the hope "that next year a full record and

¹⁰ *Ibid.*

¹¹ Statement by Senator Packwood, *Ibid.* p. S16152.

¹² Senator Pastore, *Ibid.* p. S16149.

¹³ Senator Ervin, *Ibid.* p. S16073, Sept. 6, 1974.

¹⁴ See NIMMER ON COPYRIGHT, Sections 20.1 and 20.2.

debate will result in a different outcome.”¹⁵ And Senator Williams had made an impassioned plea for protection of performing artists earlier this year.¹⁶

2. Perhaps even more controversial proved to be the issue whether the so-called “blackout” provision for professional sports events by CATV stations should be included. A proposal for exclusion of sports events from the compulsory license otherwise available to cable systems had been incorporated in the Subcommittee’s report but had been deleted in its entirety in the full Judiciary Committee Report.¹⁷

“Without prejudice to the arguments advanced in behalf of these proposals, the committee has concluded that these issues should be left to the rule-making process of the Federal Communications Commission, or if a statutory resolution is deemed appropriate, to legislation originating in the Committee on Commerce. In reaching this determination, the committee notes that the Federal Communications Commission has a pending rulemaking proceeding on this subject.”

A suggestion was made by the Commerce Committee and on the floor of the Senate to refer the entire “blackout” issue to the Federal Communications Commission on the ground that this matter did not properly belong within the realm of copyright, but the suggestion was defeated. Among those speaking against any limitation of use of cable television in connection with sports events, Senator Gurney said:

“We already favor sports by exempting them from the antitrust law. I do not see why we have to give them further protection under the copyright bill.”¹⁸

He also observed:

“Literally, cable television could not stay in business if they were not permitted to carry sports programs. That is how much of an issue we have here, and that being the issue, I do not see it is fair at all to direct this to the Federal Communications Commission and have the U. S. Senate do a copout on it.”¹⁹

In the end, a motion to table an amendment giving the Federal Communications Commission power to regulate the sports “blackout” was

¹⁵ Cong. Rec. vol. 20, no. 138 (daily ed.), pp. S16646-S16647, Sept. 16, 1974.

¹⁶ Cong. Rec. vol. 120, no. 107 (daily ed. July 18, 1974), p. S12888.

¹⁷ Copyright Law Revision, S. Rep. No. 93-983 (93d Cong. 2d Sess, July 3, 1974), at p. 132.

¹⁸ Cong. Rec. vol. 120, no. 134, Sept. 9, 1974, at p. S16157.

¹⁹ *Ibid.*

adopted by a narrow vote of 36 to 34. Consequently, the bill, as finally enacted by the Senate, does not include the original sports "blackout" provision but retails in this respect the general compulsory licensing provisions as previously approved by the Judiciary Committee.

3. Apart from the controversial sports blackout provision, the Bill as passed provides for a rather complicated graduated schedule of royalty payments for cable television systems.²⁰ The bill as passed by the House in 1967 had eliminated the controversial CATV question altogether. Since the so-called "classic" early CATV systems, established in remote mountain communities, never paid for the use of copyrighted material and were sustained in this exemption in the *Fortnightly* case²¹ and, more recently, in the *Teleprompter* case,²² an amendment was offered by Senator Cotton of New Hampshire to "grandfather" those cable systems serving local communities before March 31, 1972, which were dependent on access to broadcast signals.²³ However, this amendment was found defective in wording since it may have exempted approximately 70 percent of existing cable systems, and it was tabled by unanimous consent.

4. The bill, as passed by the Senate, also establishes a copyright royalty tribunal for the purpose of adjusting royalty rates (Chapter 8, Sections 801 to 809) which would be located in the Library of Congress. However, as a result of an amendment offered on the floor of the Senate,²⁴ the royalty to be paid by jukebox operators in the amount of \$8.00 a year was voted to be a fixed amount not subject to periodical review by the tribunal. The view expressed by Senator McClellan that the fees to be paid by jukebox operators should not be treated differently from cable television systems as far as reviewing them by the tribunal was concerned, was not shared by the majority of the Senate. Senator McClellan, the sponsor of the Omnibus Revision Bill, subsequently criticized the jukebox amendment which freezes the copyright royalty rate and exempts the jukebox industry from the provisions of periodic review of the royalty rates by an impartial tribunal.²⁵

5. The Senate also retained the increased royalty to be paid by the recording industry in connection with the compulsory license of three cents per composition in place of the present two cents over the opposi-

²⁰ For a detailed schedule of the fees proposed to be paid by a cable system, see Section 111. of S. 1361, reproduced in cong. Rec. vol. 120, no. 134, Sept. 9, 1974, at p. S16170 *et seq.*

²¹ *Fortnightly Corp. v. United Artists, Inc.*, 392 U.S. 390 (1968).

²² *Teleprompter Corp. v. Columbia Broadcasting Systems, Inc.*, 181 U.S.P.Q. 65 (1974).

²³ Cong. Rec. p. S16154, Sept. 9, 1974.

²⁴ *Ibid.* at p. S16163, Amendment by Senator Hollings.

²⁵ Cong. Rec., vol. 120, no. 136 (daily ed. Sept. 11, 1974), at p. S16356.

tion of at least one Senator who considered the proposed increase "inflationary". The Senate Subcommittee had left the compulsory license fee at two and one-half cents without voting on it, but an amendment was proposed by Senator Hartke to raise this fee to three and one half cents; despite considerable support, an increase to only three cents was finally approved.²⁶ It may be expected that the amount of the mechanical fee of the recording process will remain one of the controversial issues in future copyright revision discussions. (The record industry had been opposed to any increase of the now existing fee under Section 1(e) of the Act of 1909.)

6. The Senate also adopted a new amendment introduced on the floor by Senator Baker, permitting private universities to continue to make tape recordings of nightly network TV news shows and to make these tapes available on a loan basis to researchers and scholars. This last-minute amendment was introduced in view of pending litigation instituted by Columbia Broadcasting Systems against Vanderbilt University Television News Archives.²⁷ According to Senator Baker and an opinion by the Register of Copyrights, S. 1361, in the absence of his proposed amendment, would make it necessary for the University to negotiate with each of the networks for the right to continue operation of its News Archives. The Senator emphasized that these tapes would be made available under his amendment only for use by scholars and researchers and not for commercial use.

7. The Senate also adopted a floor amendment by Senator Inouye of Hawaii which would provide that the compulsory license provisions with regard to cable systems should also apply to such systems operating in the State of Hawaii on the same basis as those operating on the mainland to the extent that such Hawaiian systems would ever be permitted under the rules of the Federal Communications Commission to report signals of independent television stations into Hawaii in the form of taped programs.²⁸

Finally, it should be noted that the controversial "education exemption" giving extensive "fair use" protection to educators never got past the Subcommittee, but will be emphatically raised again by the National Education Association and others in the House of Representatives. As passed, S. 1361 allows for a single duplication of an entire article under the "fair use" provision but as explained in the accompanying Committee Report,²⁹ specifically prohibits multiple copies of the same material or "systematic copying by libraries or other institutions."

²⁶ Cong. Rec. p. S16166, Sept. 9, 1974.

²⁷ Cong. Rec. p. S16162, Sept. 9, 1974.

²⁸ *Ibid.* p. S16160.

²⁹ *Supra* note 17 at p. 115.

8. Two other amendments were offered in connection with educational television but in the absence of their sponsors were not acted upon on the floor of the Senate and were merely included in the Congressional Record. Senator Bayh's amendment would remove a restriction in the Copyright Revision Act limiting to thirty the number of copies which can be made of copyrighted exempted educational programs produced for classroom broadcast, provided such programs would be destroyed after seven years. In Senator Bayh's opinion, based on the views expressed by a nonprofit agency for educational television, thirty copies would not be a sufficient number to go around to all public schools even in a single state and certainly not on a nationwide basis.³⁰

Another amendment by Senator Mathias, intended only to stimulate discussion in both Houses, would provide for compulsory licensing for public broadcasting of educational television and radio programs produced for general audiences, commercial and educational stations. This, in the Senator's opinion, would free public broadcasters from the burden of arranging for copyright fees on an individual basis with authors of copyrighted works; instead, they would have to pay the royalty fees as established and collected by the newly established central copyright royalty tribunal.³¹

II.

As previously stated, there would seem to be no hope that the House of Representatives would take final action during the present Congress on the Omnibus Revision Bill. With that situation in mind, Senator McClellan introduced on the floor of the Senate a separate bill, S. 3976,³² which would take care of three issues demanding immediate attention and enactment by the Congress:

1. The first and most important of these would make permanent the grant of copyright protection to sound recordings and tapes beyond the present expiration date of December 31, 1974. In other words, the bill would strike from the present anti-piracy and anti-duplication bill³³ the expiration date which had been inserted in the hope that by January 1, 1975 the entire Copyright Revision Bill would have been enacted. S. 3976 also includes the heavy cumulative penalties for infringement of records

³⁰ Cong. Rec. p. S16165 *et seq.*, Sept. 9, 1974, Amendment 1831 to S. 1361.

³¹ *Ibid.*, Amendment 1815.

³² Cong. Rec. p. S16185 *et seq.*, Sept. 9, 1974, amending the Anti-Piracy Act of Oct. 15, 1971 (85 Stat. 391).

³³ See *supra* note 33.

by duplication which are included in Revision Bill S. 1361. The bill would provide for penalties of not more than \$25,000 or imprisonment of not more than three years, or both, for the first offense, and not more than \$50,000 or imprisonment of not more than seven years, or both, for any subsequent offense.

2. S. 3976 once more provides for a two-year extension of all copyrights the renewal terms of which would expire prior to December 31, 1974.

3. S. 3976 also takes out of the Omnibus Revision Bill for immediate enactment Title II, which would establish a National Commission on New Technological Uses of Copyrighted Works.

It is expected that this measure will be enacted into law even during the present 93rd Congress since similar action, at least with regard to the first of these three steps, has already been initiated in the House of Representatives by the Chairman of the Judiciary Committee Subcommittee, Congressman Kastenmeier. S. 3976, as proposed by Senator McClellan, passed the Senate unanimously on September 9, 1974; House action can be expected in the near future since the House Subcommittee had already reported out legislation to extend the anti-piracy act. It should, however, be mentioned that the Subcommittee proposes to reduce the imprisonment penalties for record pirates even though it left intact the fines structure for first and second offenders.³⁴

According to the latest information, the House of Representatives is expected, under suspension of its rules, to pass HR 13364, the Anti-Piracy Extension Bill, on October 7, 1974 but is not expected to take immediate action on the two other proposals included in S 3976.

³⁴ A few days ago, the full House Judiciary Committee approved the anti-piracy extension bill as passed by the Senate but with milder prison terms of one and two years maximum for first and subsequent offenses respectively. It is understood that the Senate Sub-Committee will go along with these milder prison terms so as to avoid the need for a conference and to expedite quick enactment of this legislation before the end of the year.

The vote in the House Judiciary Committee in favor of making the anti-piracy legislation permanent was 30 to 2. In taking this action, Chairman Kastenmeier promised to hold hearings in depth next year with regard to performing rights royalties for performing artists and related problems.

The Chairman also announced that while he was not personally in favor of another copyright extension bill for works whose renewal term would soon expire, he would not oppose such an extension (already passed by the Senate) if the majority of the Committee were in favor of it, nor would he oppose the enactment of interim legislation for the establishment of a commission to study new technological uses of copyrighted materials.

2. AN OVERVIEW OF *TELEPROMPTER v. CBS* AND OTHER RECENT DEVELOPMENTS — OMINOUS SIGNALS FOR COPYRIGHT LAW*

By RICHARD DANNAY**

Ambrose Bierce, with characteristic cynicism, defined "labor" as "one of the processes by which A acquires property for B." Had he lived to see current judicial interpretations of the Copyright Act on new technology such as CATV and photocopying, he might have been moved to define "copyright" as "one of the processes by which A creates property for B."

For that is just about where we are left after such recent decisions as *Teleprompter Corp. v. Columbia Broadcasting System, Inc.*¹ and *Williams & Wilkins Co. v. United States*² — decisions which do not augur well for copyright interests and which reflect a myopic philosophy gaining ever-greater currency: that traditional principles of copyright protection are unduly burdensome to "technological progress" and, hence, expendable. This paper deals with *Teleprompter*, the more recent of the two decisions, and some recent developments concerning cable television and copyright.

In *Fortnightly Corp. v. United Artists Television, Inc.*,³ the Supreme Court held that the reception and retransmission of copyrighted works by Fortnightly's CATV systems did not infringe the plaintiff's copyrights. The case was decided on the basis of an interpretation of the meaning and application of the exclusive right to "perform" copyrighted works, specifically given to copyright owners by the Copyright Act. The Court said that the test of the meaning of the term "perform" depends upon a determination of the "function" that CATV plays in the total process of television broadcasting and reception.

The cable systems in *Fortnightly* were found to function more like the passive, non-performing viewer than the active, performing broadcaster, on the theory that the cable systems merely improved their subscribers' capacity to receive the broadcaster's signals. Although acknowledging that CATV equipment was powerful and sophisticated, the Court nonetheless found that a cable system merely provided a well-located

* Copyright © 1974 Richard Dannay. All rights reserved. This lecture was delivered on May 17, 1974 before the Copyright Luncheon Circle in New York City.

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¹ 94 S.Ct. 1129, 181 U.S.P.Q. 65 (March 4, 1974)

² 487 F.2d 1345, 180 U.S.P.Q. 49 (Ct. Cl. Nov. 27, 1973), *cert. granted*, 182 U.S.P.Q. 1, 42 U.S.L.W. 3652 (May 28, 1974)

³ 392 U.S. 390, 158 U.S.P.Q. 1 (1968)

antenna with an efficient connection to the viewer's television set; the basic function the equipment served was thus little different from that served by the customary equipment of a television viewer. Moreover, the Court noted that broadcasters select the programs to be viewed, and propagate them to the public. Cable systems, on the other hand, simply carry, without editing, whatever programs they receive and retransmit them by private channels to additional viewers. Thus CATV operators, like viewers and unlike broadcasters, do not perform the copyrighted programs that they receive and carry.

In *Teleprompter* the plaintiffs claimed that certain basic changes in the operation of cable systems — changes not involved in *Fortnighly* — served to transform the function of cable systems, making them now function more like broadcasters than viewers. These new functions included program origination (sometimes known as cablecasting), sale of advertising time, and interconnection with other CATV systems. But the Supreme Court, in an opinion by Mr. Justice Stewart (also author of the Court's *Fortnighly* opinion), gave short shrift to the significance of these new functions. Although acknowledging that cable systems "perform" programs which they cablecast, the Court found that each of the expanded services was, in this case, "extraneous to a determination of copyright infringement liability"⁴ because the particular copyrighted programs in question did not involve any of these expanded services. In other words, none of the particular programs which were originated, or which accompanied cable advertisements, or which were carried via interconnection, involved plaintiffs' copyrighted material. And even though these new functions might allow cable systems to compete more effectively with broadcasters for the television market, this was not considered germane to the copyright question.

Yet this answer seems, to me at least, less than satisfactory, because it does not meet squarely the plaintiffs' argument that these and other expanded services, taken together, change the fundamental character of the entire CATV operation from that of mere passive reception service, thus bringing it from the viewers' side of the line over to the broadcasters' side.⁵

But the key difference between the cable systems in *Fortnighly* and *Teleprompter*, as concerns the economic impact of CATV on copyright

⁴ 94 S.Ct. at 1136-37, 181 U.S.P.Q. at 69

⁵ The Court also rejected the argument that cable systems, by choosing among various broadcasting stations for signals to retransmit, exercise a form of program selection analogous to the broadcaster function. The creative choice open to cable, said the Court, was far more limited in nature and scope.

owners, was this: the CATV systems in *Teleprompter* imported so-called distant television signals from remote areas that could not otherwise have been receivable by CATV subscribers, whereas *Fortnightly* involved only the carriage of local signals already in the areas being served by the cable systems, albeit such local signals were often incapable of adequate or in some instances any reception because of topographical conditions. But the Supreme Court in *Teleprompter* held that this distant signal importation did not, for copyright purposes, alter the function CATV performed for its subscribers.

The Court reversed the decision of the Second Circuit Court of Appeals⁶ on this matter and held (6 to 3) that the importation of distant signals from one geographical area into another, where they would not otherwise have been receivable by subscribers, does not constitute a "performance" under the Copyright Act, and thus does not amount to copyright infringement. The Court, following its *Fortnightly* decision, reasoned that the CATV transmission of signals remains essentially a passive viewer function, irrespective of the geographical distance between the originating broadcast station and the ultimate viewer.

But the aspect of *Teleprompter* with alarming implications for copyright interests is the Court's cavalier treatment of the copyright owners' economic arguments. Here judicial copyright philosophy and methodology have coalesced to severely undermine traditional copyright principles.

The Court rejected the copyright owner's and broadcaster's policy argument that importation of distant signals should entail copyright infringement liability because of the harmful impact of such retransmission upon the economics and market structure of copyright licensing. Specifically, the copyright holder's argument was that meaningful financial return for him depended not only on the first run or network showing, but also on syndication or reruns on local stations in secondary markets. Thus if CATV systems are allowed to import programs and rechannel them into distant secondary markets, before these programs can be licensed to affiliates and independent stations in the importing market, the profitability of later syndications will be diluted because the potential viewing audience diminishes with each successive showing in a given market.

But the Court, in rejecting this argument, distinguished commercial relations in the television industry from those in publishing and other fields. The Court pointed out that, unlike publishers who sell their books

⁶ 476 F.2d 338, 177 U.S.P.Q. 225 (2d Cir.1973), affirming in part and reversing in part, 355 F.Supp. 618, 1973 U.S.P.Q. 778 (S.D.N.Y. 1972)

or magazines directly to readers, broadcasters are not paid directly by the television viewers, but by advertisers who use the drawing power of the copyrighted broadcast material to promote their goods and services. Advertisers typically pay broadcasters a fee for each transmission of an advertisement based on an estimate of the expected number (and characteristics) of the viewers who will watch the program. In the Court's view, therefore, the compensation an advertiser is willing to pay a broadcaster, and, in turn, the compensation a broadcaster is willing to pay a copyright holder, will be calculated on the basis of the size of the direct broadcast market augmented by the size of the CATV market.

So, according to the Court, the copyright holder's loss of syndication income in secondary markets (due to CATV distant signal importation) may be offset by increased revenues from advertisers because of the extended primary market. The Court thus concluded that CATV systems, by merely extending the size of the potential viewing market of a broadcast program, do not interfere in any traditional sense with the copyright holder's means of obtaining compensation for his creativity or labor.

The Court relegated to a footnote the countervailing argument of the copyright owners, namely, that local advertisers would not be willing to pay higher fees on the basis of additional viewers in a distant market where the local advertiser has no facilities to serve customers. Indeed, the Court of Appeals in *Teleprompter* had specifically found that there was no evidence of record that local or regional advertisers would be willing to pay greater fees because the sponsored program would be exhibited in some distant market, or that national advertisers would pay more for the relatively minor increase in audience size that CATV carriage would yield for a network program. In fact, the Court of Appeals concluded that "economics and common sense would impel one to an opposite conclusion."⁷

The central economic question before the Supreme Court, therefore, was the extent to which (if at all) enlargement of the viewing market by CATV distant signal importation was reflected in increased revenue to the broadcaster and, in turn, to the copyright owner; and the Court conceded that there was no conclusive evidence of the precise impact of distant signal importation on the value of program copyrights. But — and

⁷ 476 F.2d at 342 n.2, 177 U.S.P.Q. at 226. On behalf of CATV, it has been argued that a requirement of copyright license fees for the rechanneling of television broadcasts would subject CATV subscribers to double payment: indirectly through increased prices for the goods and services of the advertisers who pay for the television broadcasts, and also directly through increased costs of the CATV service, 94 S.Ct. at 1140 n.13, 181 U.S.P.Q. at 71.

this is the alarming point — such a showing, the Court stated, would in any event be of “very little relevance” to the limited copyright question before it.⁸ According to the Court: “At issue in this case is the limited question of whether CATV transmission of ‘distant’ signals constitutes a ‘performance’ under the Copyright Act.”⁹

In other words, the Court was concerned only with the vague “functional” test of the meaning of the term “perform” — not with the economic impact of distant signal importation. This judicial methodology produces a kind of tunnel vision. First, rights and liabilities arising out of the use of today’s sophisticated technology (such as cable television) obviously involve immensely important, previously undecided, and complex and difficult questions of economic and public policy. Second, these questions cannot be controlled or resolved satisfactorily by judicial interpretation of vague and ambiguous words — such as “perform” — plucked from a copyright statute enacted more than half a century ago, when the particular technology in issue was not conceived or conceivable.

As Mr. Justice Fortas said, in the lone dissent in *Fortnightly* — applying the normal jurisprudential tools, such as interpretation of the words of the Copyright Act, to the facts of CATV “is like trying to repair a television set with a mallet.”¹⁰

Indeed, the Court’s CATV approach borrows a page from its methodology in obscenity cases. I am not suggesting that the *Teleprompter* decision is obscene, although it may be a bit scandalous. But, if explosive technological advances are to be controlled by the 1909 Copyright Act rather than by consideration of their economic impact on the interests involved, we may yet hear judicial statements like (with apologies for this paraphrase to Mr. Justice Stewart): “I could never succeed in [defining “performance”] intelligibly,” but “I know it when I see it.”¹¹ Or, to paraphrase Mr. Justice Brennan’s more recent observation on the vagueness of obscenity: “The problem is . . . that one cannot say with certainty [what a “performance” is] . . . until at least five members of this Court, applying inevitably obscure standards, have pronounced it so.”¹²

The real issue, then, is not whether CATV systems “perform,” but, as Mr. Justice Fortas said in *Fortnightly*, whether the owner of copyrighted material should be compensated by cable systems which “are based upon the use of other people’s property.”¹³ No one disputes the worthy objec-

⁸ 94 S.Ct. at 1140 n.15, 181 U.S.P.Q. at 72

⁹ *Ibid.*

¹⁰ 392 U.S. at 403, 158 U.S.P.Q. at 7

¹¹ *Jacobellis v. Ohio*, 378 U.S. 184, 197 (Stewart, J., concurring)

¹² *Paris Adult Theatre I v. Slaton*, 413 U.S. 49, 92 (1973) (Brennan, J., dissenting)

¹³ 392 U.S. at 403, 158 U.S.P.Q. at 6-7

tive of fostering the development of CATV. But it simply does not follow from this that cable operators should obtain free that for which competing broadcast stations must pay, particularly when licensing the right to use copyrighted material is the rule in all the other media.

Mr. Justice Douglas in his dissent in *Teleprompter*, in which he was joined by Chief Justice Burger,¹⁴ put it well:

“Rechanneling by CATV of the pirated programs robs the copyright owner of his chance for monetary rewards through advertising rates on rebroadcasts in the distant area and gives those monetary rewards to the group that has pirated the copyright.”¹⁵

He added that “It would be difficult to imagine a more flagrant violation of the Copyright Act,” and that the immunity for distant signal importation given by the majority thus “reads the Copyright Act out of existence for CATV . . . a legislative decision that not even a rampant judicial activism should entertain.”¹⁶

Let us turn now from the judicial to the legislative sphere. The amended copyright revision bill¹⁷ reported out last month by the Subcommittee on Patents, Trademarks and Copyrights to the full Senate Judiciary Committee would, if enacted, go a long way toward redressing the damage to traditional copyright principles exemplified by *Teleprompter*.

With respect to the CATV provision,¹⁸ the bill acknowledges the principle — rejected in *Fortnightly* and *Teleprompter* — that cable systems should be generally subject to copyright liability, and makes cable transmissions of distant signals authorized by the Federal Communications Commission subject to compulsory licensing, based on statutory royalty fees which are subject to periodic review and adjustment to assure that the rates, as well as the revenue base on which they are computed, are “reasonable.”¹⁹ The amount of the fees has been, of course, one of the

¹⁴ A separate dissent was written by Mr. Justice Blackmun, who noted his agreement with the dissenting views of Mr. Justice Fortas in *Fortnightly*.

¹⁵ 94 S. Ct. at 1143, 181 U.S.P.Q. at 74

¹⁶ *Ibid.*

¹⁷ S.1361 (Comm. Print April 9, 1974), 93d Cong. 2d Sess. It has been reported that the Senate Judiciary Committee expects to mark up the bill on June 6, 1974. [On September 9, 1974, after this paper was prepared, the Senate passed, by a vote of 70-to-1, an amended version of S. 1361. Some of the CATV amendments are noted below.]

¹⁸ §111 (“Limitations on exclusive rights: Secondary transmissions”)

¹⁹ Cable carriage of local television broadcast signals and, when permitted by the FCC, of exclusively aural broadcast signals, are also subject to compulsory license.

prime areas of contention in the CATV controversy.

If the bill passes, the FCC rules and regulations²⁰ would in effect determine copyright infringement liability in many instances. The present rules are extremely comprehensive and complex, covering all facets of CATV, including carriage of over-the-air broadcast signals, cablecasting (i.e., carriage of non-broadcast television programming), access to non-broadcast cable channels (on public, educational, local government and leased access channels), diversification of ownership and control, technical standards for cable systems, non-television two-way cable communications services, inter-governmental regulatory relationships, etc. Suffice for now to say that the vexing economic issues presented by distant signal importation, which were deemed irrelevant in *Teleprompter*, are handled through an elaborate set of rules designed to accommodate the interests of the cable industry and conventional over-the-air broadcasters and their program suppliers.

Because the FCC rules are so central to the CATV provision of the copyright revision bill, at least a brief description is useful. CATV is permitted to enter all television markets by means of the carriage of distant signals, but the interests of broadcasters and copyright owners are maintained by quotas on the number of distant signals and by complex provisions for program exclusivity for both network and non-network (syndicated) programming. Cable systems are authorized (indeed, usually required) to carry all "local signals", including all signals "significantly viewed" locally, as those terms are defined under FCC rules, thus assuring that "local" broadcasting stations are not denied access to the audience they are licensed to serve. If the local signals do not suffice to reach defined levels of minimum service, cable systems may import distant signals to reach a full complement of television network stations (i.e., three) and a quota of independent stations, either one, two or three depending on the size of the television market in which the cable system is located. Under the FCC rules, cable systems in the major markets also may have so-called "wild cards", that is, they may import two additional distant signals, less the number imported to meet the network-independent station quotas. The carriage of distant signals is also subject to so-called "leapfrogging" restrictions, i.e., priorities based on the proximity of the television stations whose signals are being carried by CATV. And there are certain "grandfather" exceptions for the benefit of cable systems.

But not even all of these distant signals are authorized. Thus the FCC rules also contain program exclusivity features (or "black-out" provisions)

²⁰ Cable Television Report and Order, 36 F.C.C. 2d 143 (1972), Reconsideration of Cable Television Report and Order, 36 F.C.C.2d 326 (1972)

whereby local television stations may protect themselves (if cable systems are given appropriate notification of asserted exclusivity rights) (i) against simultaneous cable duplication of network programs on imported distant signals (with special relief for time-zone problems), and (ii) in the major markets against cable carriage of syndicated programs on imported distant signals for periods of time that vary according to the size of the television market, the category of program, and applicable contract terms.

I have necessarily been able to give only a broad description of the FCC rules. But the intent of the carriage rules is to permit cable systems to carry at least a minimum of distant signals (i.e., two) considered necessary to attract subscribers and investment capital and thus foster cable expansion and development, without jeopardizing the economic interests of conventional broadcasters and program producers. Moreover, the exclusivity provisions for syndicated programs in major markets benefit copyright owners by permitting them to sell the same program to many television stations in different areas, free from competitive cable importation of that program for specified time periods.

In addition, the revision bill as reported out retains the so-called "sports blackout" provision, which imposes ordinary copyright liability (i.e., no compulsory license) for distant signal importation of live professional sports events into the local service area of TV broadcast stations which have not been authorized to broadcast the events. This is another of the major issues in the CATV controversy, and cable interests seek to eliminate or at least narrow the provision.²¹ Likewise, there is full copyright liability when cable systems carry signals not authorized by the FCC; and the compulsory license is lost if cable systems fail to comply with the statutory filing and reporting procedures which, of course, provide the information essential for implementation of the compulsory license scheme and distribution of the royalty fund.

The bill also retains the provision that cable systems are fully subject to copyright liability, and have no compulsory license, when they retransmit signals made for reception, not by the public at large, but by particular members of the public (e.g., background music services such as Muzak, closed circuit broadcasts to theaters, pay-TV). And the bill retains

²¹ Compare the exemption from the antitrust laws in 15 U.S.C. §1292, which under certain circumstances prohibits sports blackouts, except in the home territory of a club on the day it is playing at home. And see 47 U.S.C. §331 (live television coverage of certain sold out games). [In the revision bill passed by the Senate, note 17 *supra*, the controversial sports blackout provision has been deleted, thus presumably allowing future FCC rules to govern the question, and the initial statutory royalty schedule has been reduced by one-half]

the provision exempting entirely from copyright infringement liability certain categories of retransmissions.²²

Of course, the “whether” and “when” of passage of the revision bill have become the subject of annual speculation and frustration; and as the Supreme Court noted in *Fortnightly* in 1968, in what may yet become an enduring truth: “Progress has not been rapid.”²³ If, however, the bill eventually passes and recovery from *Teleprompter* results, it would bring to mind George Bernard Shaw’s observation: “I enjoy convalescence. It is the part that makes the illness worth while.”

²² The exemption covers the replay of unaltered local signals by non-cable master antenna systems of hotels, apartment houses and the like, to the private lodgings of their guests or residents, if no direct charge is made; certain instructional closed circuit systems; common, contract, or special carriers not controlling program selection or content or the particular recipients of the signals they passively relay; and non-cable systems of noncommercial, nonprofit (governmental or other) organizations if no charge other than to defray certain costs is made to recipients (e.g., so-called “translators” or “boosters” which are authorized to amplify and retransmit broadcast signals). [The revision bill passed by the Senate, notes 17 and 21 *supra*, does not include a proposed amendment that would have exempted, by “grandfather clause”, so-called secondary transmissions by cable systems serving (prior to March 31, 1972) local communities “principally dependent” upon such systems for access to broadcast signals authorized to amplify and retransmit broadcast signals.]

²³ 392 U.S. at 396 n.17, 158 U.S.P.Q. at 4

3. PUBLICATION AND PROTECTION: IN QUALIFIED SUPPORT OF THE COPYRIGHT OFFICE APPROACH TO MOTION PICTURE SOUNDTRACKS.

By DEAN G. YUZEK*

Introduction

The Copyright Office has recently rejected a number of applications for unpublished copyright in musical compositions "on grounds that the compositions for which registration is sought have appeared on the soundtracks of motion pictures which, according to information available to the Copyright Office, have previously been distributed."¹ The action of the Copyright Office is predicated on adoption of the view "that the release of a motion picture divests common law copyright and removes the music contained therein from the category of unpublished music for purposes of registration."² The inability to secure Section 12 registration as unpublished works for film music after motion picture release is of particular concern to the Music Publishing and Motion Picture Industries. As noted by the Motion Picture Association of America (MPA), "neither are they [the music publishers] permitted to register it [film music] as 'published' music because it is not regarded by the Copyright Office as having been 'published' in the statutory sense."³ The contention seems to be that in order not to leave original film music wholly exposed, an act such as motion picture release which *arguendo* is incapable of investing film music with statutory protection should not be able to effect a forfeiture of common law rights. It will be necessary to inquire into the tenability of such demands for what may be called a "symmetrical" approach to publication and protection.

Notwithstanding the subsequent showing that it need feel no commitment to the concept of "symmetry," the Copyright Office has adopted the position that motion picture release is not only divestive of common law protection of film music but is also capable of resulting in the investiture of statutory protection. The Copyright Office suggests that in order

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¹ Letter from Alan L. Shulman, Chairman of the Legal Committee of the National Music Publishers' Association, Inc., to Barbara Ringer, Register of Copyrights, January 21, 1974, at 2 [hereinafter cited as NMPA letter].

² Letter from William R. Fisher, Chairman of the Copyright Committee of the Motion Picture Association of America, Inc. to Abe Goldman, Register of Copyrights, January 7, 1974 at 1 [hereinafter cited as MPA letter].

³ *Id.* at 2.

to protect their rights in film music, music publishers rely on the principle that the motion *picture* copyright includes, and thereby affords protection to, such film music.⁴ The compelling need for careful scrutiny of the Copyright Office position on protection of film music through the motion picture copyright is revealed by the MPA assertion that this is “an interpretation never judicially determined or even as yet accepted by the Copyright Office.”⁵

It is worth noting that the National Music Publishers' Association, Inc. (NMPA) has attempted⁶ to convince the Copyright Office of the *procedural* inappropriateness of its current position on the question of publication. NMPA has emphasized what it considers to be a radical departure by the Copyright Office from the basic approach to registration which is mandated by the Copyright Act; that is, to accept and file any registration which colorably embraces copyrightable material and which complies with relevant registration provisions and regulations. Similarly, on the issue of publication and protection, the MPA has expressed⁷ concern as to the authority of the Copyright Office to engage in the judicial function of interpretation of law. The importance of these “procedural” objections is not to be denied. However, it is important to devote attention to an analysis of the prospects for judicial sanction of the Copyright Office position on publication and protection, notwithstanding procedural limitations which may inhere in that position.

A few more prefatory remarks are necessary with regard to the

⁴ *Id.* at 2. The position attributed to the Copyright Office by the MPA is as follows: “It is suggested by the Copyright Office that for the protection of our rights in such music, the music publishers rely on the principle that the picture copyright includes the music” Discussions between the Copyright Office and the private sector focus on the film music portion of the soundtrack because film music has far greater commercial value, independent of the motion picture, than does the dialogue portion of the soundtrack. See text accompanying note 86 *infra*.

On April 29, 1974, the author received a response to an inquiry directed to Barbara Ringer, Register of Copyrights. The letter reveals, in relevant part, the current approach of the Copyright Office to the soundtrack problem:

“Instead of its former neutral position on the copyright status of soundtracks, the Copyright Office would take an affirmative position that a sound motion picture is an entity, that copyright in a motion picture extends to all copyrightable component parts of the motion picture including those reproduced on soundtrack”

⁵ MPA letter, *supra* note 2, at 2.

⁶ NMPA letter, *supra* note 1, at 2.

⁷ MPA letter, *supra* note 2, at 2.

distinction between statutory protection, through the motion picture copyright, of the soundtrack itself and of the underlying film music. The report of the House Judiciary Committee on the recent amendment to provide for the creation of a limited copyright in sound recordings⁸ does not deal directly with the underlying film music, but does refer specifically to the motion picture soundtrack:

“In excluding ‘the sounds accompanying a motion picture’ from the scope of this legislation the Committee does not intend to limit or otherwise alter the rights that exist currently in such works. The exclusion reflects the Committee’s opinion that soundtracks or audio tracks are an integral part of the ‘motion pictures’ already accorded protection under subsections (l) and (m) of Section 1 of Title 17, and that the reproduction of the sound accompanying a copyrighted motion picture is an infringement of copyright in the motion picture.”⁹

Thus, the Committee believes that in granting protection to and affording rights in sound recordings, the Amendment need not extend similar treatment to soundtracks insofar as those rights are *already* protected by the motion picture copyright. In the context of this legislation, precisely what rights does the Committee feel currently exist with regard to these purportedly protected soundtracks? In light of the Committee’s reason for the soundtrack exclusion, a response to this question necessitates only an analysis of what rights are extended to sound recordings by the Amendment. It is the Committee’s position that the copyrightable elements of a sound recording involve “authorship” on the part of performers whose renditions are memorialized therein and on the part of producers whose efforts culminate in the final sound recording.¹⁰ Therefore, the legislative exclusion of soundtracks reflects the view that it is this type of “authorship” that is already protected by the copyright of the motion picture. Further, the Committee carefully distinguishes between sound recordings (and, presumptively, soundtracks) and any underlying literary, dramatic, or musical works that may be reproduced thereon.¹¹ Thus, uncritical extrapolation of the Committee report in an effort to support the Copyright Office view on the protection of *film music* through

⁸ The Sound Recording Amendment was added to Title 17 by the Act of October 15, 1971, Pub. L. 92-140, 85 Stat. 391. For legislative history, see H.R. Rep. No. 487, 92d Cong., 1st Sess. (1971).

⁹ 117 Cong. Rec. 1566, 1570-71 (1971).

¹⁰ *Id.* at 1570.

¹¹ *Id.* at 1570.

the motion picture copyright is not without shortcomings. The shortcomings become apparent if by "film music" reference is made to the underlying work and not merely to the "authorship" involved in the creation of the soundtrack itself.¹² For the purpose of subsequent discussion, the term "soundtrack" shall refer to the underlying composition of both the music and the dialogue components of the aural track of the motion picture, unless otherwise indicated by the context of the discussion.

I. Publication

An analysis of whether motion picture release divests common law protection of the soundtrack, and removes the underlying music or dialogue from the category of unpublished works, mandates initial inquiry into the form and effect of motion picture distribution. Indeed, in light of the fact that motion pictures are *commercially leased*¹³ rather than sold outright, it is necessary to determine — prior to any determination of the divestive effect of motion picture publication — whether or not the motion picture itself is in fact "published."¹⁴

Previous analyses¹⁵ make it unnecessary to explore this initial problem in depth; a full appreciation of subsequent discussion, however, mandates somewhat fuller treatment than the simple assertion that the "Copyright Bar generally takes the position that the commercial leasing of copies of a motion picture does constitute a divestive publication."¹⁶ In *Patterson v. Century Prods., Inc.*,¹⁷ the exhibition of a motion picture did not constitute general publication and thus did not result in removal of the film from the category of unpublished works. One of the elements of the *Patterson* case was the *non-commercial* or gratuitous nature of the distribution of the film. Indeed, in *Blanc v. Lantz*,¹⁸ the plaintiff's reliance on *Patterson* was distinguished on the basis of the strictly limited non-commercial distribution involved in that case. Thus, the *Blanc* court felt free to find as follows:

¹² This interpretation is supported by reference to the Copyright Office letter of April 29, 1974, *supra* note 4.

¹³ Nolan, *Motion Picture Copyright Protection*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER EIGHTEEN 174, 177 (1970).

¹⁴ The question arises at all due to the fact that commercial leasing results in only a limited distribution to a select group of lessees. See Fritch, *Some Copyright Implications of Videotapes*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER THIRTEEN 87, 102-03 (1964).

¹⁵ Nolan, *supra* note 13; Fritch, *supra* note 14.

¹⁶ Nolan, *supra* note 13, at 183.

¹⁷ 93 F.2d 489 (2d. Cir. 1937), *cert. denied*, 303 U.S. 655 (1938).

¹⁸ 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

“...the recordination of [a musical laugh] on a motion picture soundtrack for the purpose of distribution for reproduction in commercial theatres throughout the world and the actual distribution of such prints and playing of the sound tracks in such theatres constituted a ‘publication’ of the plaintiff’s composition.”¹⁹

The court found that the fact that copies of the film were leased rather than sold did not prevent the distribution from constituting a divestive publication. One commentator has attempted to mitigate the importance of the non-commercial nature of the distribution to the *Patterson* decision by stressing the fact that “the rule has never been that an otherwise general publication can be avoided simply by making the distribution gratuitously.”²⁰ The further assertion that the *Blanc* decision was based on a California statute and did not strictly involve a determination under the Federal Copyright Act has led to the contention that *Blanc* is merely a “hybrid phonograph record case,”²¹ thereby leaving *Patterson* intact as the “leading authority” with regard to motion picture leasing and exhibition cases.²² It is apparent, however, that the *Blanc* decision is capable of meaning different things to different people. For instance, it has quite properly been pointed out that the *Blanc* court did “not rely on the broad language of the [California] statute to reach its holding, but the court supported its conclusion only on cases construing the common-law definition of publication.”²³ And notwithstanding the previous reference to the attempted mitigation of the importance of the non-commercial distribution in *Patterson*, it would be erroneous to disregard the clear emphasis which that court placed on the gratuitous nature of the distribution in arriving at the conclusion that the film was unpublished. In light of the ability, adverted to above, to give credence to *Blanc* in a federal statutory sense, that case stands ready to respond to the question left unanswered under the preceding interpretation of *Patterson*; that is, whether commercial distribution pursuant to the leasing practices of the motion picture industry results in a divestive publication. As noted, the *Blanc* court is quite affirmative in its response. Further, an analogy has been made²⁴ to the *Jewelers’ Mercantile*²⁵ case, dealing with the leasing of

¹⁹ *Id.* at 140.

²⁰ Fritch, *supra* note 14, at 105.

²¹ *Id.* at 105.

²² *Id.* at 106.

²³ Nolan, *supra* note 13, at 187.

²⁴ Brylawski, *Copyrightability of Motion Picture Sound Tracks*, 18 BULL. CR. SOC. 357, 365 (1971).

²⁵ *Jewelers’ Mercantile Agency Ltd. v. Jewelers’ Weekly Publishing Co.*, 155 N.Y. 241, 49 N.E. 872 (1898).

books to subscribers, as support for the proposition that a motion picture is "published" when it is leased or distributed for purposes of public exhibition.

It has been deemed necessary to offer merely the highlights, in summary fashion, of the dialogue on this question of motion picture publication. Indeed, different emphases in interpretation of the foregoing authorities have been noted. Nonetheless, it is apparent that the principle that motion picture release is *not* publication of the picture itself does not enjoy enough support to be a substantial barrier to the Copyright Office position that motion picture release is in fact publication of the soundtrack.

It is submitted that the earlier reference to *Blanc* as merely a "hybrid phonograph record case"²⁶ may have significant, albeit unintended, implications for the soundtrack publication issue. Part II of this article focuses on the purported analogy between motion picture soundtracks and phonograph records, and on the equation many courts make between the two. There is a clear practical distinction between the dialogue and music portions of the soundtrack. The music portion of the soundtrack may have a useful life above and beyond that of the motion picture itself, and is capable of being exploited long after the picture is no longer useful.²⁷ On the other hand, the market for the dialogue portion of the soundtrack normally exists only as long as, and in conjunction with, the exploitation of the film. Such industry realities as these increase the tenability of the analogy of film music to phonograph records. Insofar as the initial distinction between record *sale* and film *leasing* has been shown to be a distinction without a difference for the purpose of publication, it becomes particularly appropriate to analyze the effects of record publication for potential clarification of the soundtrack problem. In this regard, it may be helpful to note Professor Kaplan's introduction to the problem of publication of phonograph records.²⁸ He states:

"Now take the case of a song. If the composer first deals with the public by selling sheet music, the consequences are plain. At most he is left with the congeries of rights described in the statute . . . [T]his qualified statutory monopoly is the most the composer can claim; he will have lost all exclusive rights if he has failed to implant the notice of copyright on the sheets as the statute requires. But suppose the composer chooses to deal with the public not by selling sheet music, but by selling phonograph

²⁶ See note 21 *supra* and accompanying text.

²⁷ See text accompanying note 86 *infra*.

²⁸ Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469 (1955).

records of the composition or by licensing another to do it. Following the general rationale of the Code, we would expect similar results to follow. For when he sells records, as when he sells sheet music, the composer would seem to have reached the point where he should be compelled to make his treaty with the public."²⁹

It is well known that judicial sanction was given to those general expectations, albeit by way of dicta, in *Shapiro Bernstein & Co. v. Miracle Record Co.*³⁰ In that suit for infringement of copyright, the plaintiff claimed that defendant's musical composition "Long Gone" infringed plaintiff's musical composition "Yancy Special". Judge Igoe contended that the composer of plaintiff's composition abandoned any rights to a copyright which may have existed by permitting the composition to be produced on phonograph records and sold prior to copyright. The production and sale of phonograph records was equated with the production and sale of sheet music with regard to the capacity to fully effect a divestive publication. Judge Igoe, unable to see any practical distinction between the two, contended that "if one constitutes an abandonment, so should the other."³¹ Four years later, in *Mills Music v. Cromwell Music*,³² the court referred to the *Miracle Record* case and asserted that the manufacture and sale of records is perfectly capable — even absent the sale of sheet music — of constituting a publication of the underlying composition, and thus capable of divesting common law copyright. The thrust of *Miracle* and *Mills* is not too surprising in light of *RCA Mfg. Co. v. Whiteman*,³³ in which Judge Hand stated that:

"... we see no reason why the same acts that unconditionally dedicate the common law copyright in works copyrightable under the Act, should not do the same in the case of works not copyrightable."³⁴

Judge Hand's reference was to his opinion that the sale of records constituted a dedication of the distinctive contribution of the performer (assuming *arguendo* that common law rights were capable of inhering in the performer's distinctive contribution), and of the composition itself.

Standing in contrast to the spirit of the Kaplan approach to phonograph record publication as reflected in these and other cases,³⁵ is the

²⁹ *Id.* at 471.

³⁰ 91 F. Supp. 473 (N.D. Ill. 1950).

³¹ *Id.* at 475.

³² 126 F. Supp. 54 (S.D.N.Y. 1954).

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

³⁴ *Id.* at 89.

³⁵ See, e.g., *McIntyre v. Double A-Music Corp.*, 166 F. Supp. 681 (S.D. Cal. 1958).

recent case of *Rosette v. Rainbo Mfg. Corp.*³⁶ and that which may simply be referred to as "industry practice". Judge Gurfein's opinion in *Rosette*, of which more will be said subsequently, is that a phonograph record is not a "copy" of a musical composition and that 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."³⁷ The view is, then, that since the sale of records does not constitute a "publication" of the underlying composition, the need to seek statutory copyright protection is obviated and — alternatively stated — failure to secure such protection does not cause forfeiture of common law copyright. A similar attitude has resulted in the record industry practice of releasing records *prior* to registration of the underlying material as either a published or unpublished work.³⁸ Certain analogous practices and procedures are prevalent in the motion picture industry. In NMPA correspondence with the Copyright Office on the issues of whether and when under Federal Copyright law the release of a motion picture soundtrack constitutes publication of the underlying material, it is asserted that the present position of the Copyright Office is contrary to the view held by most experts in the field.³⁹ In this regard, the following statement by the MPA is instructive:

"The Copyright Office and the motion picture music industries have always treated motion picture music separately from the motion picture and its copyright. The music has always had its own notice and registration. Frequently such registration is made *after* the release of the picture simply because deposit copies are not ready. The sheet music copyright notice is based upon the year of the registration as an unpublished work, and, therefore, is not necessarily the same year of the release of the motion picture. (The clearest example would be that of a film released for the Christmas holiday with the music published a few weeks later.)⁴⁰ [emphasis added.]

³⁶ 354 F. Supp. 1183 (S.D.N.Y. 1973).

³⁷ Garzilli, *Rosette v. Rainbo: Its Impact on Copyright Law and the Music Industry*, 20 BULL. CR. SOC. 412 (1973).

³⁸ Garzilli, *id.* at 414, states as follows:

"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. 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, this method was rarely employed."

³⁹ NMPA letter, *supra* note 1, at 5.

This practice is a definite reflection of what Kaplan terms “the world of difference” that is sometimes taken between exploitation of a composition by the “public rendering of it to the ear, as through records” or the soundtrack of a motion picture, and exploitation by “public delineation to the eye (and to the inner ear), as in sheet music.”⁴¹ The Copyright Office, however, may properly rely, for support of its position on publication, on the *Blanc*, *Whiteman*, *Miracle*, and *Mills* trend which finds that there is in fact no such “world of difference” between the two methods of exploitation. While those cases standing alone are susceptible to cavalier dismissal, as a line of authority they should not be taken lightly. Their impact on the issue of publication cannot properly be lessened by any sense of a need to accommodate industry practice, when that industry has been so singularly unmindful of the potentiality of section 12 protection. And it is certainly possible that the industry practice adverted to above is based less on an objective analysis of the legality of that practice than on an industry proclivity for the perpetual rights that inure to a common law copyright. Further, the *Rosette* case is quite unpersuasive as a refutation of the *Blanc-Miracle* line of authority. The attempted accommodation of industry practice by Judge Gurfein — finding *no* publication from phonograph record distribution but requiring that statutory copyright be obtained and notice of use filed prior to recovery for infringement — is an abrogation of the meaning of section 2 of the Copyright Act:

“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.”⁴²

It is quite incorrect to state, as at least one commentator has,⁴³ that the Gurfein approach is similar to a proposal advanced by Professor Kaplan. Kaplan proposes⁴⁴ that the states should deal with the measure of rights to be accorded to unpublished works, insofar as section 2 does not define the scope or duration of those rights. The basis for the proposal is that the rules which comprise the common law copyright are no more “fixed or invariant than other rules of common law; they must be intelligently shaped and applied to the emergent and developing facts of intellectual production.”⁴⁵ There is a very great difference between the Kaplan

⁴⁰ MPA letter, *supra* note 2, at 2.

⁴¹ Kaplan, *supra* note 28, at 472.

⁴² 17 U.S.C. §2 (1973).

⁴³ Garzilli, *supra* note 37, at 419.

⁴⁴ Kaplan, *supra* note 28.

⁴⁵ *Id.* at 487.

assertion that state courts are capable of effecting a continuing and evolving definition of the scope of common law rights, and the Gurfein attempt to subject those common law rights — in derogation of section 2 — to compliance with the rules and regulations of statutory protection.

Kaplan also refers to the purported “world of difference” between the sale of sheet music and the performance of the composition in public:

No matter how long-continued or profitable such performance may be, it is thought neither to forfeit the composer's exclusive rights nor to put limits on them; and this again because the composition has not been published.”⁴⁶

That approach to performance was engendered by the decision of *Ferris v. Frohman*,⁴⁷ which dealt with the question of whether an unprinted play had been dedicated through performance in the absence of statutory registration. The Supreme Court held that there was no dedication, and seven years later *McCarthy v. White*⁴⁸ applied the *Ferris* rule to the public performance of a musical composition. The music publishing industry might prefer to view a record (or soundtrack) as a “captured” performance in order to bring the work within the *Ferris* rule of non-dedication. It has been advanced, however, that the extension of *Ferris* to other fields should be carefully scrutinized; *especially* in light of the fact that a principle objection even to *Ferris* is that:

“it is abhorrent to the central theme of copyright to permit the dramatist (or composer) to exploit his work, and that in a way most appropriate to the medium, without exacting the usual limits on his monopoly.”⁴⁹

It is important to note that neither the *Whiteman* nor the *Mills* courts were unmindful of the *Ferris* approach to performance; with a demonstrated awareness of the validity of the doctrine of performance within its sphere,⁵⁰ those courts and the *Miracle* court were of a single mind with

⁴⁶ *Id.* 472.

⁴⁷ 223 U.S. 424 (1912).

⁴⁸ 259 Fed. 364 (S.D.N.Y. 1919).

⁴⁹ Kaplan, *supra* note 28, at 479.

⁵⁰ The following language from *RCA Mfg. Co. v. Whiteman*, *supra* note 33, at 88, is instructive in this regard:

“... if a conductor played over the radio, and if his performance was not an abandonment of his rights, it would be unlawful without his consent to record it as it was received from a receiving set and to use the record. Arguendo, we shall also assume that such a performance would not be an abandonment, just as performance of a play, or the delivery of a lecture is not; that is, that it does not ‘publish’ the work and dedicate it to the public.”

regard to the following proposition:

“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.”⁵¹

It is decidedly suspect to attempt to use *White-Smith Music Pub. Co. v. Apollo Co.*⁵² in order to refute authority which proclaims the divestive effect, on the underlying work, of record sale or motion picture distribution. It is not accurate to assert that an act such as the release of a motion picture soundtrack which *arguendo* is incapable of investing film music with statutory protection, due to the fact that it is not a “copy” within the meaning of the Act, is similarly incapable of effecting a forfeiture of common law rights. It is well known that *White-Smith* held that a perforated pianola roll did not constitute an infringing copy of a musical composition. The definition of a “copy” of a musical composition that most commended itself to the Court was “a written or printed record of it in intelligible notation,” (the well-known requirement of visual, as opposed to aural, appreciability). *White-Smith*, however, dealt with the subject of infringement as opposed to copyrightability. Nevertheless, the doctrine of *White-Smith* has “so affected interpretation of the 1909 Act as to deny . . . copyrightability for works perceptible only acoustically.”⁵³ Any attempt to apply the *White-Smith* concept of “copy” in an effort to preclude the divestive effect of motion picture release on the soundtrack, or to equate divesting with investing acts, is questionable. As Professor Latman has noted, “attention should be paid to the possibility of divergent definitions of ‘publication.’”⁵⁴ Reference is then made to the following development:

“ . . . the perpetual rights enjoyed under the common law are leading some courts to the view that commercial exploitation of a work should terminate common law protection, even if such exploitation of a work should terminate common law protection, even if such exploitation does not amount to ‘publication’ under section 10.”⁵⁵

Thus, while the absence of a “copy” in the *White-Smith* sense may preclude a finding of investive publication, effective divestive publication

⁵¹ Shapiro, Bernstein & Co. v. Miracle Record Co., *supra* note 30, at 475.

⁵² 209 U.S. 1 (1908).

⁵³ Outline of lecture prepared by Edward A. Sargoy for the Literary & Artistic Property Seminar at N.Y.U. School of Law, March 28, 1974, at 4.

⁵⁴ LATMAN, HOWELL'S COPYRIGHT LAW 62 (rev. ed. 1962).

⁵⁵ *Id.* at 62.

may be left unimpaired. In *Blanc v. Lantz*,⁵⁶ where a musical laugh was deemed divestively published by motion picture exhibition, the court commented on *White-Smith* as follows:

"The decision in that case that a player piano roll was not a 'copy' as contemplated by the Federal statute by no means is authority for the proposition that a player piano roll, phonograph record, or movie sound track is not a copy of the musical composition which, when distributed generally, does not result in a 'publication' of the composer's creation so as to result in termination of his common-law right."⁵⁷

In dealing with the renditions of virtuosi in the *Mercury Records* case,⁵⁸ Judge Learned Hand was conscious of the harsh limitation involved in his position that divestive publication had been effected even though the "works" were not copyrightable under the Act. However, it was not deemed unjust that the plaintiff could have only a very limited use of its records if it hoped to keep its monopoly, in light of the alternative of a monopoly unlimited both in time and in user.

Several salient points emerge as we approach an analysis of the Copyright Office position on soundtrack protection. First, there is considerable authority in support of the Copyright Office position on publication of the motion picture soundtrack. Second, the questionable nature of the supposed divestive-investive equation renders the validity or invalidity of the Copyright Office position on soundtrack protection immaterial with regard to the validity of its position on publication. Third — and alternatively — the ability to sustain the Copyright Office position on protection of the soundtrack would render its approach to divestive publication consistent with the symmetrical theory of copyright publication and protection; a result not mandated by law but equitably satisfying nonetheless. It is to the Copyright Office attempt to afford protection to the soundtrack, through the motion picture copyright, that we now turn.

II. Protection

The underlying rationale of the Copyright Office for the proposition that the motion picture copyright protects the soundtrack is similar to the House Judiciary Committee approach as far as the following attitude is concerned:

⁵⁶ 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

⁵⁷ *Id.* at 140.

⁵⁸ *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657 (2d Cir. 1955) (dissenting opinion).

“... ‘motion pictures’ represent a broad genus whose fundamental characteristic is a series of related images that impart an impression of motion when shown in succession, including any sounds integrally conjoined with the images.”⁵⁹

The notion that “talkies” are but a “species of the genus motion pictures” was first advanced in *L.C. Page & Co. v. Fox Film Corp.*⁶⁰ L.C. Page & Co. claimed to have acquired in 1923 the exclusive motion picture rights in the novel “Captain January”, Plaintiff Page brought the suit for infringement of copyright due to the fact that the defendant film corporation threatened to produce a talking motion picture version of the novel without obtaining the plaintiff’s consent. In considering the following statement by the court, it should be noted that “talkies” were *not* commercially known in 1923:

“... we can entertain no doubt that the words used, ‘the exclusive moving picture rights,’ were sufficient to embrace not only motion pictures of the sort then known but also such technical improvements in motion pictures as might be developed during the term of the license, namely, the term of the copyright. The development of mechanism making it possible to accompany the screen picture with the sound of spoken words was but an improvement in the motion picture art. As the plaintiff well says, ‘talkies’ are but a species of the genus motion pictures; they are employed by the same theatres, enjoyed by the same audiences, and nothing more than a forward step in the same art. Essentially the form and area of exploitation were the same. The mere fact that the species ‘talkies’ may have been unknown and not within the contemplation of the parties in their description of the generic ‘moving pictures’ does not prevent the latter from comprehending the former.”⁶¹

Certainly, any cursory attempt to use the *Page* “species of the genus motion picture” approach in order to proclaim the copyrightability of motion picture soundtracks would not escape criticism. As one commentator has accurately noted,⁶² the *Page* language is merely dictum since it dealt not with the copyrightability of the soundtrack, but with the construction of an assignment of “exclusive motion picture rights.” Notwithstanding that fact, the recent Copyright Office and Judiciary Committee embrace of a “species of the genus” approach to soundtrack protection mandates an examination of whether the *Page* analysis can be transposed

⁵⁹ 117 Cong. Rec. 1566, 1571 (1971).

⁶⁰ 83 F.2d 196 (2d Cir. 1936).

⁶¹ *Id.* at 199.

⁶² Brylawski, *supra* note 24, at 358.

to, and sustained within, a copyrightability setting. Indeed, the affect of *White-Smith* on the copyrightability question has resulted in the Copyright Office view that a soundtrack in and of itself is uncopyrightable. In this regard, attention has been called to the Copyright Office rule of practice that registration "is not made for a soundtrack alone, or for a soundtrack as the only new matter in a previously published or registered motion picture."⁶³ When this approach to the individual soundtrack is contrasted with the recent Copyright Office position on protection of the soundtrack through the motion picture copyright, the importance of analyzing the validity of the "species of the genus" approach becomes apparent. A proper analysis should initially be concerned with whether a "species of genus" can be validly applied to the general question of copyrightability; if so, appropriate inquiry may then be directed at whether that approach can properly be used to afford statutory protection to a soundtrack.

In spite of attempts to limit the *Page* dicta to its contractual context, there is much authority to support application of the analysis in a statutory copyright setting. The *Page* court itself was conscious of the fact that it was construing the words of a contract rather than the words of a statute. For that reason the court, in analogizing to the statutory construction case of *Kalem Co. v. Harper Bros.*, made the following statement:

"In [*Kalem*] it was held that the words, 'exclusive right to dramatize,' in the copyright statute, though used when motion pictures were unknown, included the right to produce by motion pictures when that mechanism was later developed; that is to say, the genus embraced the later developed species."⁶⁴

The necessity of relying on a *Page-Kalem* approach is, of course, due to the fact that "talkies" were unknown when the 1912 Townsend Amendment introduced classifications "l" and "m" for "motion picture photoplays" and "motion pictures other than photoplays" into the Copyright Act. Before statutory protection for soundtracks can be denied solely on the basis that they could not have been comprehended by the grant of motion picture copyright, attention should be paid to the following interesting historical development; a development that presaged the *Page* court's "species of the genus motion picture" analysis. Prior to the grant of protection to the motion picture by the Townsend Amendment, the motion picture itself was given recognition by judicial decision as a species of "photograph" under the Copyright Act of 1870. The following summary of the solution to the problem engendered by the turn of the century development of the motion picture art is instructive:

⁶³ *Id.* at 362.

⁶⁴ *Page*, supra note 60, at 199.

"While the copyright statutes had long since been amended specifically to include a "photograph" as a work subject to copyright . . . there was no specific reference to "motion pictures" as copyrightable in the existing statutes at the time the controversy in *Edison v. Lubin* arose. . . . The court held that the plaintiff's motion-picture film was properly subject to copyright as a "photograph" under a Copyright Act of July 8, 1870, despite the fact that the work was the product of methods that were unknown at the time of the passage of the act. The court characterized the new motion-picture processes as an advance in the art of photography . . . and ruled that, while such an advance had resulted in a new type of photograph, the motion-picture product was 'none the less a photograph — a picture produced by photographic process.'"⁶⁵

The *Edison* analogy is helpful as further authority for a "species of the genus" approach to general copyright protection; it is not, however, totally satisfying as authority for application of that approach to the problem of motion picture soundtrack protection. In *Edison*, both the "species" motion picture and the "genus" photograph were visually appreciable. The problem of the motion picture soundtrack is complicated by the presence of a visually appreciable genus (the motion picture) and an "integrated" element (the soundtrack) that renders the species ("talkies") decidedly *aural* in nature, as well as visual. It is this aspect of the problem which mitigates against complete acceptance of Professor Nimmer's "integral element" approach to ultimate protection of the material recorded on a motion picture soundtrack.⁶⁶ He refers to *Universal Pictures Co., Inc. v. Harold Lloyd Corp.*⁶⁷ for the now basic proposition that motion pictures are themselves "copies" of the works upon which they are based. If, the theory continues, soundtracks are an integrated part of the picture, then the track portion may be viewed as a copy of the material recorded, thereby securing statutory protection to the underlying material through the motion picture copyright. Subsequent analysis is intended to indicate, however, that while this "species of the genus motion picture" approach may be warranted with regard to the *dialogue* portion of the soundtrack, the special nature of film music may preclude similar treatment.

An examination of the application of the "species of the genus" approach to the underlying composition of aural works is not very helpful. The present systems used to notate electronic and indeterminate

⁶⁵ Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U.L. REV. 1081, 1084 (1955). The citation for *Edison v. Lubin*, referred to in the Meagher article, is 122 Fed. 240 (3d Cir. 1903).

⁶⁶ 1 M. NIMMER ON COPYRIGHT, 442.1, §109.14 (1973).

⁶⁷ 162 F.2d 354 (9th Cir. 1947).

musical compositions did not exist when the 1909 Copyright Act was enacted. In response to the question of whether such new systems of notation — not universally accepted in the manner of traditional staff notation — are copyrightable musical expression, commentators have urged that the new systems of notation be regarded as substitute or alternate forms of traditional notation.⁶⁸ This attempt to apply a “species of the genus” approach to the problem of musical notation has been endorsed by implication by the Copyright Office, at least as far as electronic music is concerned. In this regard the following statement on Copyright Office developments is noteworthy:

“... in connection with the continuing problem of what to deposit in connection with electronic music, ... in one case we accepted a complete oscillogram made directly from a performance of the tape.”⁶⁹

Developments in the field of aleatory and indeterminate music, and in the field of electronic music, may well bear significantly on the “intelligibility” requirement advanced by Justice Day in *White-Smith*.⁷⁰ But the test formulated therein was twofold; before the issue of intelligibility could be reached, the purported copy had to be capable of visual appeal. Electronic and indeterminate music scores are visually appreciable. The only question of concern is, as noted, with regard to readability or intelligibility. Notational breakthroughs are helpful for film music only if copyright protection as a published or unpublished work is sought for underlying sheet music in unusual notational form. As to soundtrack protection through the motion picture copyright, intelligibility breakthroughs matter little if the initial hurdle of visual perception remains extant.

Interestingly, a motion picture soundtrack is capable of being published under the Universal Copyright Convention, notwithstanding the requirement that works, in order to be published, be capable of visual perception.⁷¹ The commentary by Bogisch⁷² on this seeming anomaly is comparable to the attitude of the Copyright Office and House Judiciary Committee on soundtrack protection:

“A cinematographic work is the sum total of different arts Cinematographic films usually contain two bands or tracks: a

⁶⁸ Savelson, *Electronic Music and the Copyright Law*, 11 BULL. CR. SOC. 144, 165 (1964); Keziah, *Aleatory and Indeterminate Music*, 17 BULL. CR. SOC. 311, 336 (1970).

⁶⁹ Kaminstein, *Copyright Office Developments*, 12 BULL. CR. SOC. 3, 5 (1965).

⁷⁰ *White-Smith Music Publ. Co. v. Apollo Co.*, *supra* note 52.

⁷¹ Universal Copyright Convention, Art. VI.

⁷² BOGICH, *THE LAW OF COPYRIGHT UNDER THE UNIVERSAL CONVENTION*, (1968).

visual or picture band and a sound track. If the sound track is separated from the visual band, it has striking resemblances to what we called sound recordings which we declared are not copies of the works the performances of which are fixed thereon. It is believed that the same is true in respect to the musical, etc., work, the performance of which is fixed on the sound track. On the other hand, a sound track is part of a copy of the cinematographic work. In other words: neither phonograph records nor the sound tracks of films are copies of the musical work; films (the sound track and the picture band together) are copies of the cinematographic work”⁷³

As one commentator has noted, the statement seems contradictory in its attempt to assert that a soundtrack can be part of a copy but not an entire copy.⁷⁴ It is not so unreasonable, however, to attribute different qualities or natures to even the same work in different situations. Reference was made earlier to the difficulty of applying a “species of the genus” approach, when the “integral” element for which protection is sought is aural in nature. Perhaps it is fair, however, to fall back upon the reason of the thing. Since the picture track of a film alone is relatively unintelligible, it is not unreasonable to say that the nature of the whole, when the soundtrack is joined with the visual band, is indeed different than the nature of the individual parts of that whole. The soundtrack, however, may be comprised of both dialogue and music. There may in fact be a valid dividing line to be perceived here; on one side may fall material contributions to beneficial use. Such contributions may be copyrightable as validly proclaimed *integral* elements of the whole. On the other side may fall those contributions to the whole which merely enhance enjoyment. If uncopyrightable individually, such contributions would remain uncopyrightable even when joined with a copyrightable work. Under the above analysis, the justice of the result would lie in the fact that the element which merely enhances enjoyment — as opposed to that which materially contributes to beneficial use — neither has its nature modified by association with the whole nor causes the nature of the whole to be materially modified. The dialogue portion of the soundtrack may be viewed as a material contribution to the beneficial use of the motion picture, the film music as an enhancement of enjoyment. It is our contention, then, that it may be proper in certain circumstances to afford protection to an aural element of an otherwise visual whole, on the basis of an “integral” element or “species of the genus” approach. One commentator, though, has criticized the Bogsh statement and the *Page* suggestion

⁷³ *Id.* at 72.

⁷⁴ Brylawski, *supra* note 24, at 359.

"that the mechanical coupling of a sound track to a copyrightable cinematographic work somehow might make the sound track itself copyrightable."⁷⁵ He states:

"If it were true that copyrightability is an automatic consequence of being coupled or intermixed with a clearly copyrightable work, as a sound track is with the cinematographic portion of a sound picture, then a phonograph record of music included in the pocket of a printed album of lyrics would be copyrightable. Portions of mechanically recorded dialogue used in conjunction with a "book" would likewise be copyrightable, since the mechanical recording would be an integral part of a "book," which is copyrightable under Section 5(a) of the Act. Hence, the mechanical coupling of a sound track with a film cannot of itself change the copyrightability of the sound track."⁷⁶

In light of the distinction advanced between "material contribution to beneficial use" and "enhancement of enjoyment," the above analysis seems limited when indiscriminately applied to the motion picture soundtrack. Certainly, an *automatic* extension of protection to an individually uncopyrightable aural element of a copyrighted work may be improper. The difference, however, between the examples given in the statement above [record coupled with lyrics; recorded dialogue coupled with book] and the motion picture soundtrack situation, is the relative unintelligibility of the picture without the dialogue portion of the track. That factor — relative unintelligibility of the visual element without the aural element — is absent in each example given. The lyrics can be read and *fully* understood without the record. Similarly, the book can be read and *fully* understood without resort to the recorded dialogue, which in that case constitutes merely an enhancement of enjoyment; not a material contribution to beneficial use as might be the case when that same dialogue accompanies a motion picture. The dialogue portion of the soundtrack may, then, have a fairly tenable claim to statutory protection through the copyright of the motion picture of which it is a part.

The response to this analysis might be that it proves too much, that it seems to confer protection not only on the underlying material of the dialogue portion of the soundtrack but on the soundtrack *rendition* itself. Similarly, the charge might be that the inability to protect film music in a rendition or authorship sense has nothing to do with the ability of motion picture copyright protection to reach copyrightable material underlying the film music. Indeed, neither the Copyright Office approach to sound-

⁷⁵ *Id.* at 359.

⁷⁶ *Id.* at 360.

track protection⁷⁷ nor the approach suggested by Professor Nimmer⁷⁸ need be read as conferring protection, through the motion picture copyright, on the soundtrack rendition. Both analyses may be read in more conservative fashion; that is, the soundtrack rendition may be viewed as a copy of the recorded material pursuant to an “entity” approach to sound motion pictures, in accordance with which the soundtrack is viewed as an “integral element” of the film. In that manner, statutory protection for the underlying material — the copyrightable component parts of the picture reproduced on the soundtrack — is attained through the copyright of the motion picture.⁷⁹ That interpretation obviates the need to come to grips with the question of whether the soundtrack as a rendition is also a copyrightable component part of the motion picture. However, it is apparent that the necessary link to a view of the soundtrack rendition as a copy of the underlying material is the establishment of the proposition that the soundtrack rendition is an integral element of the film. Thus, the “integral element,” “entity,” or “species of the genus” approach is as important to a determination that the underlying recorded material is protected by the motion picture copyright as it is to a suggestion that the soundtrack rendition itself may be similarly protected. Therefore, any attempt to assert that the “material contribution”-“enhancement of enjoyment” analysis obscures the distinction between the soundtrack *qua* rendition and the soundtrack *qua* underlying work is to misapprehend the dominant motif of that analysis; that is, the impropriety of indiscriminately applying “integral element” or “species of the genus” labels to the soundtrack without differentiating between the dialogue and music portions thereof. And as noted previously, it is only the dialogue portion of the soundtrack which can, thus far, even reasonably be deemed an integral element of the film under a species of the genus or entity approach to sound motion pictures. The question, obviously, is where this analysis leaves the music portion of the track — somewhat curtly dismissed earlier as a mere “enhancement of enjoyment.” The following development may have some bearing on the issue of film music protection.

⁷⁷ See note 4 *supra* and accompanying text.

⁷⁸ See text accompanying notes 66-67.

⁷⁹ Note Professor Nimmer’s language, *supra* note 66, at 442.1, in this regard:

“ . . . it would seem that since motion pictures are themselves ‘copies’ of the works upon which they are based, and since ‘talkies are but a species of the genus motion pictures’ it follows that the sound track portion of a film as an integrated part thereof is itself a ‘copy’ of the material recorded, and hence the unauthorized use of music in a soundtrack constitutes an infringement of the right to copy.”

On April 19, 1961, the Register of Copyrights accepted registration for magnetic video tape. The still pictures of motion picture film are preceptible to the unaided eye. On the other hand, no picture or image can be seen when tape is held up to the light; sound and pictures are projected only through electronic playback. In spite of the fact that, like the perforated pianola roll, videotapes are not visually appreciable to the naked eye, pursuant to Copyright Office regulations tape is held to be a copyrightable form of motion pictures.⁸⁰ The rationale underlying such registration may perhaps be discerned from remarks made by Justice Holmes in the *Kalem*⁸¹ case:

“But if a pantomime of Ben Hur would be a dramatizing of Ben Hur, it would be none the less so that it was exhibited to the audience by reflection from a glass and not by direct vision of the figures The essence of the matter . . . is not the mechanism employed but that we see the event or story lived.”⁸²

Notice may be taken, then, of the ultimate visual *effect* of videotape, notwithstanding the necessity of an intervening electronic playback. Notice may also be taken of the possible breakdown of the distinction between aural and visual perception, in light of the fact that “some of the more sophisticated devices can now print out a musical score from a motion picture soundtrack.”⁸³ The ability to “effect” a visually perceivable copy should, however, be at most cautiously used in the attempt to proclaim soundtrack copyrightability. The mere technological capability to render a work visually perceivable may not be sufficient to ensure copyrightability, especially when that work is ordinarily or customarily enjoyed in an aural or non-visual sense. It is that distinction that makes videotape registration a somewhat inapposite analogy for an assertion of soundtrack protectibility, notwithstanding technological developments which can create a visual soundtrack print-out.⁸⁴

While industry practice⁸⁵ — in conjunction with the Copyright Office position on the divestive effect of motion picture publication — may prompt efforts to protect film music, it is industry practice that also mitigates against the Copyright Office position on protection of film music through the motion picture copyright. The motion picture industry recognizes the difference that business practice has created between the music and screenplay or dialogue portions of the motion picture soundtrack:

⁸⁰ 37 C.F.R. §202.15(d) (1973).

⁸¹ *Kalem Co. v. Harper Bros.* 221 U.S. 55 (1911).

⁸² *Id.* at 61.

⁸³ Brylawski *supra* note 24, at 365.

"[T]he music, unlike the screenplay, [has] a life of its own, apart from the picture. It . . . [is] exploited independently through the publication of sheet music, licenses for records and other uses. Often the value of a music copyright survives a picture's commercial value. On the other hand, screenplays as such very seldom have any use except as an integral part of the picture."⁸⁶

This "life of its own" nature of film music can severely mitigate against a "species of the genus motion picture" approach to film music copyright protection by supporting an analogy of film music to phonograph recordings and by giving credence to demands that they be treated similarly.⁸⁷ The significance of such similarity of treatment lies in the influence that the traditional inability to secure statutory protection for phonograph recordings may have on the issue of film music protection.⁸⁸ In assessing the validity of the film music-record equation, attention should perhaps be directed at the potential amenability of film music to the compulsory license provision of section 1(e).⁸⁹ The ability to unequivocally state that film music is not amenable to the compulsory license

⁸⁴ The "ultimate visual effect" implications of videotape registration should be carefully scrutinized for several other reasons. Videotape, of course, is often accompanied by a soundtrack. Registration has traditionally been made of the copyright claimed in the visually perceptible portion of the videotape only. See Cary, *Copyright Registration and Computer Programs*, 11 BULL. CR. SOC. 362 (1964). That is not to say, however, that it is an unwarranted exercise to attempt to examine, for possible extension to other areas, the distinction between that which is visually appreciable to the naked eye and the type of visual appreciability inhering in videotapes.

There is one further caveat as far as videotape is concerned. One District Court, thus far, has held that the unauthorized videotape of a copyrighted work constitutes not an infringement of the right to *copy* but an infringement of the right to *record*. See *Walt Disney Prods. v. Alaska Television Network, Inc.*, 310 F. Supp. 1073 (W.D. Wash. 1969). The very copyrightability of videotape might be suspect pursuant to such an interpretation.

⁸⁵ See the text accompanying note 40 *supra*.

⁸⁶ MPA letter, *supra* note 2, at 5.

⁸⁷ See also Brylawski, *supra* note 24, at 361.

⁸⁸ The Amendment to the Copyright Act which extends limited protection to sound recordings does not affect the textual statement in light of the motion picture soundtrack exclusion. See note 8 *supra* and accompanying text.

⁸⁹ 17 U.S.C. §1(e) reads in appropriate part:

"And as a condition of extending the copyright control to such mechanical reproductions, that whenever 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 2 cents on each such part manufactured . . ."

would enhance the suggestion that, for purposes of protection, film music be treated like the motion picture of which it is a part. It will be shown, however, that no such unequivocal statement can be made.

In the *Mercury Records*⁹⁰ case Judge Learned Hand advanced his view that section 1(e) of the 1909 Act — enacted in response to *White-Smith* — did not of itself preclude the copyrightability of the record of a performer of a musical composition.⁹¹ In spite of his analysis, Hand felt that records should *not* enjoy protection under the statute; that view resulted from the careful attention paid by Hand to the spirit, as well as the specific mandate, of section 1(e).⁹² The question that presents itself is whether Hand would have applied his analysis in the same manner to the issue of statutory protection for film music embodied on a motion picture soundtrack. There is evidence, bearing on the film music-record equation, that his analysis may have been the same. In *Foreign & Domestic Music Corp.*

⁹⁰ *Capitol Records, Inc. v. Mercury Records Corp.*, *supra* note 58.

⁹¹ Note Judge Hand's reference, *id.* at 664-65, to the *White-Smith* case, 209 U.S. 1 (1908), and the effect of §1(e):

"That decision had held that under the existing statute mechanical reproductions of the score of a musical composition were not infringements of the composer's copyright; but those reproductions were not of any contribution of a performer; and therefore the only effect of §1(e) was to give a limited protection to the existing copyright of the score from this kind of infringement. I cannot find in the language of the report [H.R. Rep. No. 2222, 60th Cong., 2d Sess. 9 (1909)] anything even to intimate that the record of a performer of a 'musical composition' should not be copyrighted; for, if copyrighted, such records would be themselves the 'works,' not infringements of another 'work': i.e. the score."

Contrast this analysis with such unequivocal statements as "It is clear that records themselves were not to be the subject of copyright." Morrison, *Copyright Publication: The Sale and Distribution of Phonograph Records*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER TEN 387, 392 (1959).

⁹² One further excerpt from the Hand opinion in *Capitol Records, Inc. v. Mercury Records Corp.*, *supra* note 58, at 665, is instructive:

"Although Congress meant to depart from the existing denial of mechanical infringement of 'musical compositions,' and to adopt in general the view of the concurring opinion of Holmes, J., in *White-Smith Music Publishing Company v. Apollo Company*, it did not choose to make mechanical reproductions infringements in the ordinary sense. Obviously, it thought that this kind of invasion of the composer's property demanded only a limited remedy, which it specifically prescribed: two cents for each record. If we were to hold that records made of the renditions of a singer or a virtuoso were copyrightable, this limitation could scarcely be imported into their infringement, which in its absence would therefore carry the same remedies as any other infringement. That, I agree, we should have no right to assume"

v. Licht,⁹³ Judge Hand stated that the imposition upon the soundtrack of “those marks which will reproduce the words and music of a copyrighted song is to infringe the copyright; it falls exactly within section 1(e)”⁹⁴ That is not necessarily to say, however, that a song *originally* recorded on a motion picture soundtrack may subsequently be recorded pursuant to the compulsory license, an issue of some significance in the attempt to determine whether film music embodied on a soundtrack is best treated like a motion picture — pursuant to a species of the genus approach — or like a phonograph record. Professor Nimmer contends that the application of the compulsory license to film music is improper.⁹⁵ Such a view supports those theories which deny the record-like nature of film music and focus on its integration in the film as a whole. The difficulty with the Nimmer approach, however, is that it relies on a “species of the genus motion picture” analysis in order to assert the non-amenability of soundtracks to the compulsory license. Any theory which erodes the applicability of the compulsory license to soundtracks by employing “species of the genus” notions on an *a priori* basis, is incapable of then positing the inapplicability of section 1(e) as authority for the species of the genus approach. Further, Nimmer states that the legislative rationale in preserving the *White-Smith* rule “that records are not copies and providing for compulsory licenses of musical recordings was in order to avoid the threat of a ‘great music monopoly.’”⁹⁶ The following statement concerning film music should be carefully noted:

“This rationale is much less applicable to recordings on film sound tracks since it is hardly feasible to obtain a monopoly on music contained in sound tracks if the accompanying films are not themselves amenable to such a threat of monopoly.”⁹⁷

That analysis assumes, however, that the useful life of film music is inextricably entwined with — and indistinguishable from — the useful life of the motion picture. As noted earlier,⁹⁸ such an assumption is *not* warranted in light of industry practice. It is important to recognize the ability to equate film music with phonograph records as at least another

⁹³ 196 F.2d 627 (2d Cir., 1952).

⁹⁴ *Id.* at 629. *Contra*, *Jerome v. Twentieth Century-Fox Film Corp.*, 67 F. Supp. 736 (S.D.N.Y. 1946) *aff'd mem.*, 1965 F.2d 784 (2d Cir. 1948). It is important to note that the *Jerome* Court, in refusing to equate film music with records, assumed *a priori* the validity of a “species of the genus” approach to sound motion pictures.

⁹⁵ Nimmer, *supra* note 66, at 442.1.

⁹⁶ *Id.* at 442.1.

⁹⁷ *Id.* at 442.1-442.2.

⁹⁸ See text accompanying note 86 *supra*.

possible obstacle to acceptance of the Copyright Office theory of film music protection.

The prospects for judicial sanction, under current copyright law, of the theory that film music is protected by the copyright of the motion picture is not encouraging. There is, however, an alternative method of protection. "Suppose," states the MPA, "we copyright the picture music as 'unpublished' before the release of the picture."⁹⁹ The MPA's own response to this hypothetically postulated approach to film music protection is the following series of questions:

"Do we register the music after release of the picture and if so, how? Is the music contained in the picture a 'new version,' bearing in mind that the deposit on an E-unp. pre-release registration is a simple 'lead sheet?' . . . [W]hat if the unpublished copyright is taken in the name of the subsidiary? Should not the copyright notice on the film then refer to the music specifically as that of the publishing subsidiary?"¹⁰⁰

The problems referred to are not without substance, but neither are they insuperable. The "simplicity" of the current position — protection of film music through the motion picture copyright — is certainly to be contrasted with an approach to protection that necessitates Copyright Office pronouncements on such issues as "new version registration" and "notice referrals" to publishing subsidiaries. Pre-release registration of film music in the unpublished works category obviously imposes concomitant procedural burdens on the music publishing and motion picture industries. But until the adoption of the proposed general revision of the Copyright Law,¹⁰¹ the motion picture and music publishing industries are best advised to rely for protection on the pre-release registration of film music in notational form. In light of the foregoing analysis, the need for registration prior to film release is most compelling with regard to film music. Wisdom dictates, however, that this alternative be used also with regard to the motion picture screenplay. Finally, in light of the limited prospect for complete judicial sanction of a theory of soundtrack protection through the motion picture copyright, a prospective-only adoption of the present Copyright Office position on soundtrack publication may be warranted; such an approach would have the advan-

⁹⁹ MPA letter, *supra* note 2, at 3. This is precisely the solution Brylawski, *supra* note 24, at 368, would suggest to the MPA. It should be noted that Brylawski does not differentiate between the dialogue and film music portion of the soundtrack. See text accompanying notes 74-77 *supra*.

¹⁰⁰ MPA letter, *supra* note 2, at 3.

tage of taking into account the former industry misapprehension of the principle that motion picture release constitutes publication of underlying material.

Conclusion

The attempt by the Copyright Office to provide a "symmetrical" approach to publication and protection of film music is not likely to be sustained. The principle that the release of a motion picture removes the underlying material of the soundtrack from the category of unpublished works has a sound basis in authority. The assertion that the copyright of the motion picture includes and thereby protects such material is tenable at least with regard to the dialogue portion of the soundtrack; as to the commercially valuable film music, that assertion loses much of its appeal. The fact that the single act of motion picture release is capable of total divestive effect but of no or only partial investive effect, cannot properly be said to impinge upon the validity of the Copyright Office position on divestive publication. There is no inexorable legal requirement that mandates a divestive-investive equation. A viable alternative to protection,

¹⁰¹ S.1361, 93d Cong., 1st Sess. (1973). Note how the proposed general revision will eliminate the problems presently under discussion. Section 101 defines "publication" as follows:

"'Publication' is the distribution of copies of photorecords [sic] of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending. The offering to distribute copies or phonorecords to a group of persons for purposes of further distribution, public performance, or public display, constitutes publication."

"Copies" are defined in the same section as follows:

"'Copies' are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term 'copies' includes the material object, other than a phonorecord, in which the work is first fixed."

Finally, bearing on the issue of protection, is section 102 which deals with "subject matter of copyright":

"(a) Copyright protection subsists, in accordance with this title, in 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. Works of authorship include the following categories . . . (6) motion pictures and other audiovisual works."

albeit not a totally satisfying one, is registration of underlying soundtrack material prior to motion picture release. As to film music in particular, such an approach seems almost a necessity.

PART II.

LEGISLATIVE AND ADMINISTRATIVE DEVELOPMENTS

1. United States of America and Territories

4. U.S. CONGRESS. HOUSE.

H.R. 16562. A bill to amend title 17 of the United States Code to remove the expiration date provided in Public Law 92-140 which authorized the creation of a limited copyright in sound recordings for the purpose of protecting against unauthorized duplication and piracy of sound recordings; to increase the criminal penalties for piracy and counterfeiting of sound recordings; and for other purposes. Introduced by Mr. Mathias of California, August 22, 1974, and referred to the committee on the Judiciary. 3 p. (93d Cong., 2d Sess.)

Similar to several bills introduced in the present Congress, except that the penalty for imprisonment is reduced from 3 years to 1 for the first offense, and from 7 years to 2 for any subsequent offenses.

5. U.S. CONGRESS. HOUSE.

H.R. 16601. A bill to amend title 17 of the United States Code with respect to registration for unpublished works and with respect to the fees for the Copyright Office and for other purposes. Introduced by Mr. Kastenmeier, September 11, 1974, and referred to the Committee on the Judiciary. 95 p. (93d Cong., 2d Sess.)

A companion bill to S.3960, introduced by Mr. McClellan on September 4. See Item 16, *infra*.

6. U.S. CONGRESS. HOUSE. *Teague, Olin E.*

Report on the International Conference of States on the Distribution of Programme-Carrying Signals Transmitted by Satellite in Brussels, Belgium, May 6-21, 1974 to the Committee on Science and Astronautics, U.S. House of Representatives, Ninety-third Congress, second session, July 1974. Serial U. Washington, U.S. Govt. Print. Off., 1974. 45 p. (Committee Print)

Contents: Background. The Brussels Conference. Final act of the International Conference of States on the Distribution of Programme-Carrying Signals Transmitted by Satellite. Convention Relating to the Distribution of Programme-Carrying Signals

Transmitted by Satellite. Draft report of the General Rapporteur. Draft letter relating to UNESCO/WIPO/CONFESAT/23 submitted to the Plenary Meeting by the Main Commission.

7. U.S. CONGRESS. SENATE.

Copyright law revision. In *Congressional Record*, vol. 120, no. 132 (daily ed. Sept. 5, 1974), pp. S16006-S16043; no. 133 (daily ed. Sept. 6, 1974), pp. S16064-S16075; no. 134 (daily ed. Sept. 9, 1974), pp. S16146-S16186.

The Senate debates on the copyright revision bill, S. 1361. By 70 yeas to 1 nay, with 3 voting present, the Senate passed the bill on September 9 after adopting the Ervin amendment No. 1846, striking provisions which would create performance royalties; the Commerce Committee amendments with several of them rejected; the Inouye amendment No. 1847, designed to give CATV systems in Hawaii similar treatment given to those on the mainland; a modified Baker amendment No. 1803, designed to insure that Vanderbilt University Television News Archive can continue operation; and the Mansfield amendment No. 1839, to impose the same penalty for infringement of the copyright in a motion picture as is provided in the bill for willful infringement of the copyright in a sound recording.

8. U.S. CONGRESS. SENATE.

S. 1361. An Act for the general revisions of the Copyright Law, title 17 of the United States Code, and for other purposes. In the House of Representatives, September 12, 1974; referred to the Committee on the Judiciary. 80 p. (93d Cong., 2d Sess.)

An amended version of the copyright revision bill as passed in the Senate on September 9. The principal change is the deletion of the provision for performance royalties.

9. U.S. CONGRESS. SENATE.

S. 1361. Amendments intended to be proposed by Mr. Gurney (for himself, Mr. Thurmond, and Mr. Ervin) to 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 Commerce, July 11, 1974. 2p. (93d Cong., 2d Sess., Amdt. No. 1548)

The amendments, which are similar in purpose to those proposed by Senator Bentsen (Amdt. No. 1461), are designed to exempt broadcasters from payment of royalties for the public per-

formance of sound recordings.

10. U.S. CONGRESS. SENATE.

S. 1361. Amendments intended to be proposed by Mr. Ervin (for himself, Mr. Gurney, Mr. Bentsen, Mr. Hatfield, Mr. Eastland, Mr. Hruska, Mr. Clark, Mr. Thurmond, Mr. McGovern, Mr. Curtis, Mr. Packwood, Mr. Dole, and Mr. Proxmire) to S.1361, a bill for general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Ordered to lie on the table, July 15, 1974. 4p. (93d Cong., 2d Sess., Amdt. No. 1553)

The purpose of the amendments "is to delete the recording arts performance royalty, to be paid to record manufactures royalty, to be paid to record manufactures and performers at the expense of broadcasters and jukebox operators." Remarks of Senator Ervin, 120 *Congressional Record* S12369 (daily ed. July 15, 1974). Amendments, similar in purpose, were previously proposed by Senators Bentsen and Gurney.

11. U.S. CONGRESS. SENATE.

S. 1361. Amendments intended to be proposed by Mr. Baker (for himself and Mr. Griffin) to S. 1361, a bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Ordered to lie on the table, August 15, 1974, and to be printed. 1 p. (93d Cong., 2d Sess., Amdt. No. 1803)

Amendments which would have the effect, if enacted, of exempting the Vanderbilt University Television News Archive from liability for copyright infringement arising out of the Archive's activities in making, for purposes of preservation and leasing of copies to scholars and researchers, off-the-air videotapes of the nightly news and special news events produced by the three major networks. See Senator Baker's statement with regard to the amendments in 120 *Congressional Record* S14940 (daily ed. Aug. 14, 1974).

12. U.S. CONGRESS. SENATE.

S. 1361. Amendments intended to be proposed by Mr. Mathias to S. 1361, a bill for the general revision of the copyright law, title 17 of the United States Code, and for other purposes. August 19, 1974. 4 p. (93d Cong., 2d Sess., Amdt. No. 1815)

A proposal to add a new section 118 to S. 1361, to provide a compulsory licensing system of "Public broadcast of nondramatic literary and musical works, sound recordings, and pictorial, graphic,

and sculptural works.” “Public broadcast” is defined as “production, duplication, interconnection, distribution, and transmission of ‘educational television or radio programs’ by or for ‘non-commercial educational broadcast stations’.”

13. U.S. CONGRESS. SENATE.

S. 1361. Amendment intended to be proposed by Mr. Bayh to S. 1361, a bill for the general revision of the copyright law, title 17 of the United States Code, and for other purposes. Ordered to lie on the table and to be printed, August 20, 1974. 1 p. (93d Cong., 2d Sess., Amdt. No. 1831)

An amendment which would eliminate provision in the Judiciary Committee print of Sec. 112(a) limiting to 30 the number of copies that could be made of copyright exempted educational television programs. See statement by Senator Bayh with respect to the amendment in 120 *Congressional Record* S15308 (daily ed. Aug. 20, 1974).

14. U.S. CONGRESS. SENATE.

S. 1361. Amendment intended to be proposed by Mr. Mansfield (for Mr. Tunney) (for himself and Mr. Cranston) to S. 1361, a bill for general revision of the Copyright Law, title 17, of the United States Code, and for other purposes. Ordered to lie on the table and be printed, September 4, 1974. 1 p. (93d Cong., 2d Sess., Amdt. No. 1839) “*(Star Print).”

A bill which would impose the same penalty for infringement of the copyright in a motion picture as is provided in the bill for infringement of the copyright in a sound recording. See statement of Mr. Mansfield on the amendment in 120 *Congressional Record* S15858-S15859 (daily ed. Sept. 4, 1974), which incorporates a statement by Senator Tunney.

15. U.S. CONGRESS. SENATE.

S. 1361. Amendment intended to be proposed by Mr. Inouye to the amendment proposed by the Committee on Commerce to S. 1361, a bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Ordered to lie on the table and to be printed, September 6, 1974. 1 p. (93d Cong., 2d Sess., Amdt. No. 1847)

An amendment designed to give CATV systems in Hawaii similar treatment to those on the mainland.

16. U.S. CONGRESS. SENATE.

S. 3960. A bill to amend title 17 of the United States Code with respect to registration for unpublished works and with respect to the fees of the Copyright Office, and for other purposes. Introduced by Mr. McClellan (by request) and referred to the Committee on the Judiciary. 9 p. (93d Cong., 2d Sess.)

A bill, introduced at the request of the Librarian of Congress, which would permit the registration of unpublished works not subject to registration under the existing law, and which would generally increase the fees for the registration of published works and for other services performed by the Copyright Office. Its principal purpose is to bring the cash receipts of the Office more nearly in line with its expenditures. See statement of Mr. McClellan on his introduction of the bill, and the letter of the Librarian of Congress which is appended to the statement, in 120 *Congressional Record* S15857 (daily ed. Sept. 4, 1974).

17. U.S. CONGRESS. SENATE.

S. 3976. A bill to amend title 17 of the United States Code to remove the expiration date for a limited copyright in sound recordings, to increase the criminal penalties for piracy and counterfeiting of sound recordings, to extend the duration of copyright protection in certain cases, to establish a National Commission on New Technological Uses of Copyrighted Works, and for other purposes. Introduced by Mr. McClellan (for himself, Mr. Hugh Scott, and Mr. Baker), September 9, 1974, read twice, considered, read the third time and passed. 7 p. (93d Cong., 2d Sess.)

An interim bill which was passed by the Senate on the same day it was introduced. The criminal penalties for piracy and counterfeiting of sound recordings are identical to those provided by the general revision bill, S. 1361, which was also passed by the Senate on the same day. The bill would also continue until December 31, 1976, the renewal term of any copyright subsisting on the date of approval of the bill, or the term as extended by previous extension measures.

18. U.S. CONGRESS. SENATE. *Committee on Commerce.*

Copyright law revision. Report to accompany S. 1361, together with minority and additional views, submitted by Mr. Pastore, July 29, 1974. 82 p. (93d Cong., 2d Sess., S. Rep. No. 1035)

Among the amendments proposed by the Commerce Committee were included the elimination of the record performance royalty

for radio and TV stations; the imposition of an annual fee of \$8.00 per jukebox, with \$1.00 going to record owners and performers and \$7.00 to music composers and publishers; and a number of changes dealing with CATV exemptions and pickup of sports programs. Minority views were given by Mr. Tunney in regard to amendments dealing with CATV, with special reference to sports programming and grandfather exemption from copyright fees. Additional views were made by Mr. Baker.

19. U.S. CONGRESS. SENATE. *Committee on the Judiciary. Subcommittee on Patents, Trademarks, and Copyrights.*

Patents, trademarks, and copyrights; report pursuant to S. Res. 56, Ninety-third Congress, second [i.e., first] session. [Submitted by Mr. McClellan, September 4, 1974] Washington, Govt. Print. Off., 1974. 11 p. (93d Cong., 2d Sess., S. Rep. No. 93-1135)

The annual report on the activities of the subcommittee, covering the first session of the 93d Congress.

20. U.S. CONGRESS. SENATE. *Mansfield, Mike.*

The disposition on the Watergate tapes. In *Congressional Record*, vol. 120, no. 138 (daily ed. Sept. 16, 1974), pp. S16602-S16613.

An address, which was made largely in connection with Senator Mansfield's introduction on September 11, 1974, of S. Res. 399, "urging full public access to information regarding the Watergate investigation." Included in the address, among other matters, is the text of a legal opinion by Attorney General Saxbe, dated September 6, 1974, which cites the landmark case of *Folsom v. Marsh*, Fed. Cas. 342, No. 4901 (C.C.D. Mass. 1841), with the full text of the decision in a footnote, for the proposition that Presidential papers, including official correspondence, are the private property of the President.

21. U.S. CONGRESS. SENATE. *McClellan, John L.*

Jukebox industry provisions of S. 1361. In *Congressional Record*, vol. 120, no. 136 (daily ed. Sept. 11, 1974), p. S16356.

Senator McClellan criticizes the jukebox amendment of the copyright revision bill S. 1361 which was passed by the Senate on September 9. The amendment, which froze the jukebox copyright royalty rate, and exempted the jukebox industry from the provisions providing for periodical review of the royalty rates by an impartial tribunal, was adopted by a voice vote. An article from the September 14, 1974, issue of *Billboard*, reporting that a major jukebox manufacturer is recommending that jukebox operators

charge the public 25 cents per play on certain machines is inserted at the end of the statement.

22. U.S. CONGRESS. SENATE. *Scott, Hugh.*

Copyright revision. In *Congressional Record*, vol. 120, no. 120 (Aug. 8, 1974), pp. S14564-S14565.

Remarks made as a result of a question raised by a member of the Senate Judiciary Committee as to the constitutionality of sec. 114 of the copyright revision bill which establishes a performance royalty in sound recordings. Senator Scott commends a letter received by him from Ms. Barbara Ringer, Register of Copyrights, in response to his request for her opinion as to the constitutionality of sec. 114, and has it reprinted in the *Record* at the end of his remarks, with the unanimous consent of the Senate. The letter strongly upholds the constitutionality of sec. 114.

23. U.S. CONGRESS. SENATE. *Tunney, John V.*

Performance royalty in the copyright bill. In *Congressional Record*, vol. 120, no. 138 (daily ed. Sept. 16, 1974), pp. S16646-S16647.

Senator Tunney presents his views on "one of the most important and most controversial sections of the copyright bill, section 114—the so-called performance royalty," regrets the action of the Senate in striking the section "without a full debate," and expresses the hope "that next year a full record and debate will result in a different outcome."

24. U.S. CONGRESS. SENATE. *Williams, Harrison, A., Jr.*

Performance royalties: long overdue justice for musical artists. In *Congressional Record*, vol. 120, no. 107 (daily ed. July 18, 1974), p. S12888.

Senator Williams, in remarks on the Senate floor, indicates his support of the performance royalties provided by sec. 114 of the copyright revision bill, S. 1361, and receives unanimous consent to have printed in the *Record* at the end of his statement the "persuasive remarks" of Senator Scott, contained in his separate views accompanying the report on S. 1361.

25. U. S. COPYRIGHT OFFICE.

Library of Congress, Copyright Office. [37 CFR Part 202] Material not subject to copyright: registration of original typeface designs. In *Federal Register*, vol. 39, no. 176 (Sept. 10, 1974), pp. 32631-32632.

An advance notice of proposed rulemaking in respect to consideration by the Copyright Office of an amendment to §202.1 (a) of the Copyright Office Regulations to permit copyright registration for original typeface designs. "This advance notice of proposed rulemaking is being issued to facilitate the widest possible public expression of views on the legal and policy questions implicit in the possible change in registration practices."

26. U.S. COPYRIGHT OFFICE.

The manufacturing clause of the U.S. Copyright Law, by Marjorie McCannon, Assistant Chief, Reference Division, with the assistance of Benjamin W. Rudd, General Attorney-Librarian. Washington, Library of Congress, 1972 [i.e., 1974] 73 p. ([Copyright law revision] Study no. 35) Reprinted from *Studies on Copyright*, Arthur Fisher Memorial Edition, vol. 2, 1963.

"This study is part of the series of studies conducted by the Copyright Office in connection with revision of the Copyright Law."

27. U.S. NATIONAL SCIENCE FOUNDATION. *Office of Science Information Service*.

U.S.-U.S.S.R. copyright negotiations on scientific and technical journals; survey report. Washington, June 1974. 52 p.

Results of a survey of U.S. publishers conducted by the Foundation's Office of Science Information Service in March-April 1974.

2. Foreign Nations

28. HONG KONG. *Laws, statutes, etc.*

Ordonnance du 1er février 1973 sur le droit d'auteur modifiant, en ce qui concerne son application à Hong Kong, la loi de 1956 sur le droit d'auteur concernant les dessins, et introduisant des dispositions supplémentaires dans la législation de Hong Kong sur le droit d'auteur. In *Revue Internationale du Droit d'Auteur*, no 81 (July 1974), pp. 168-172.

An English version of this amendatory copyright law was previously published in *Copyright*, vol. 10, no. 3 (Mar. 1974). See 21 BULL. CR. SOC., 315, Item 284 (1974).

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

29. CONVENTION FOR THE PROTECTION OF PRODUCERS OF PHONOGRAMS AGAINST UNAUTHORIZED DUPLICATION OF THEIR PHONOGRAMS.

Accession by Fiji (Corrigendum); ratification by the United States of America; ratification by the Federal Republic of Germany; state of ratifications, acceptances and accessions up to 1 March 1974. In *Copyright Bulletin* (Unesco), vol. 8, no. 1.

30. INTERNATIONAL CONVENTION FOR THE PROTECTION OF PERFORMERS, PRODUCERS OF PHONOGRAMS AND BROADCASTING ORGANIZATIONS.

State of ratifications, acceptances and accessions up to 1 March 1974. In *Copyright Bulletin* (Unesco), vol. 8, no. 1 (1974), pp. 10-14.

31. 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 1 March 1974. In *Copyright Bulletin* (Unesco), vol. 7, no. 1 (1974), pp. 3-8.

32. UNIVERSAL COPYRIGHT CONVENTION.

Universal Copyright Convention as revised at Paris on 24 July 1971 and annexed Protocols 1 and 2. Ratification by Kenya; state of ratifications, acceptances and accessions up to 1 March 1974. In *Copyright Bulletin* (Unesco), vol. 8, no. 1(1974), pp. 8-9.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY****A. DECISIONS OF U.S. COURTS****1. Federal Court Decisions**

33. *Nolan v. Sam Fox Publishing Company, Inc.*, Docket Nos. 73-1077, 73-1187 (2d Cir. July 8, 1974) (Waterman, C.J.) (not yet reported).

Action for declaratory judgment confirming rescission of copyright assignment of original and renewal copyright in musical composition. Plaintiff Nolan composed the song "Tumbling Tumbleweeds" (the "song") in 1929, and thereafter assigned the song and the copyright on it to the Sam Fox Publishing Co. ("Fox"). Subsequently, Fox assigned all of its rights to the song to Williamson Music, Inc. ("Williamson"). On March 1, 1960, the plaintiff assigned the renewal term of the copyright to Fox, which then assigned that renewal term, as it had all its previous rights and interests in the song, to Williamson. In 1963 plaintiff Nolan sought to rescind the assignment to Fox of the original and renewal copyright on the musical composition and also sought a judicial declaration confirming the rescission. Although the District Court below found divers breaches of the contract by Fox, it found that none of them were substantial enough or were so material as to justify rescission by Nolan, maintaining that Nolan could "be rendered whole by an award of monetary damages."

On cross appeals, *held*, affirmed.

The Court rejected Nolan's two main justifications for rescinding his assignment as too minor to warrant rescission, stating that:

"[a]ll parties to this action agree that rescission of a contract is an extraordinary remedy which should not be granted whenever there is only an inconsequential breach of the contract. Rather, before rescission will be permitted the breach must be found to be 'Material and willful, or, if not willful, so substantial and fundamental as to strongly tend to defeat the object of the parties in making the contract'."

The Court then analyzed and rejected each ground offered by the plaintiff for rescission, offering the following reasons:

1. *Fraud* — While "a showing of fraud would certainly be grounds for rescission", the lower court's finding of no fraud was not "clearly erroneous". The plaintiff's claim of fraud was that Fox's assignment to

Williamson of plaintiff's copyright was concealed from plaintiff. The Court stated first that Fox had the right to assign the copyright and, second, that neither Fox nor Williamson had concealed the fact of the assignment. This latter conclusion was supported by the following facts:

- (i) a widely circulated trade paper carried an ad concerning the copyrighted work, listing both Williamson and Fox's name,
- (ii) all sheet music of the copyrighted work carried both names,
- (iii) the assignment from Fox to Williamson was recorded in the Copyright Office,
- (iv) Plaintiff's agent with regard to the copyright work had actual knowledge of the assignment, though he learned of it while acting on behalf of another party. His knowledge is imputed to plaintiff.

2. *Non-Payment of Royalties* — The court said that a total failure to pay royalties would defeat an essential objective of a composer-publisher contract and would, therefore, be an adequate ground for rescission. However, where the publisher's failure to pay was partial rather than complete, rescission was unwarranted. Although Fox had paid only 26% of the royalties due Nolan, the Court, adhering to the above, denied rescission on this ground.

Also of interest are the following aspects of the Court's opinion:

1. *Denied Equitable Lien on Copyright* — The court below had held that of Fox and Williamson, only Fox was liable to Nolan. As Fox claimed its non-payments of royalties were the result of non-payments by Williamson to it, Nolan asked the Court to impose an equitable lien on the copyright so that Williamson would, in the future, be directly liable to Nolan if Fox should be unable to make the obligated payments. The Court, noting the specific terms of the Nolan-Fox contract as well as the facts, rejected Nolan's plea:

"For authority, Nolan relies on *In re Waterson, Berlin & Snyder Co.*, *supra*, where this court imposed such a lien when the assignor publisher was, in fact, bankrupt. In *In re Waterson*, however, the trustee for the bankrupt publisher wished to sell the copyright free of any royalty claims. This effort to repudiate the obligation to pay royalties is not present in the instant case. Fox has consistently paid some royalties to Nolan, and Williamson has made some royalty payments to Fox. The court in *In re Waterson* faced a much different situation from that which is now before us, and the *Waterson* case has not been extended to cases like the present one where the publisher is not bankrupt. To impose a lien on the copyright when Nolan's contract with Fox imposes no restriction on assignability of the copyright is a drastic remedy not required by the facts in the present case."

2. *Statute of Limitations* — While a composer-publisher relationship may include trust elements, the Court stated, it is essentially contractual in nature, and hence the six year Statute of Limitations would properly bar any claims by Nolan for royalties owing prior to 1957. The Court distinguished cases holding the relationship to be fiduciary as limited to the issue of the publisher's duty to exploit the copyright.

34. *Rohauer and Hull v. Killiam Shows, Inc. et al.* 71 Civ. 4183, No. 41079 (S.D.N.Y. Aug. 3, 1974) (Bauman, D.J.) (not yet reported).

Action for defendant's alleged infringement of plaintiff's renewal copyright in work. An outline of the pertinent facts is as follows: Author owned copyright in its work. Author then assigned the motion picture rights to a producer, which assignment resulted in the production of a film which was covered by a copyright notice in the name of the producer's assignee. Such copyright was eventually reassigned to another proprietor who took out the renewal copyright prior to the expiration of the renewal term. This renewal copyright on the film was then twice assigned, the second assignee being Killiam Shows, the defendant of this action. In the interim, the author of the underlying work died prior to the expiration of the original copyright term and her heir (plaintiff Hull) took out the renewal copyright which was assigned to Rohauer (plaintiff). Defendant then, over the objections of plaintiff, showed the film on television.

Held, judgment for plaintiffs.

The principal legal issue presented was whether the author's assignment of the motion picture rights authorized defendant, the assignee's successor, to make the televised showings. The Court held that "when an author of a copyrighted work dies prior to the expiration of the copyright term, and the next of kin applies for renewal before the term expires, he acquires 'a new and independent right in the copyright, free and clear of any rights, interests, or licenses attached to the copyright for the initial term.'" *Fitch v. Shubert*, 20 F. Supp. 314 (S.D.N.Y. 1937); *G. Ricordi & Co. v. Paramount Pictures Corp.*, 273 F. 909 (2d Cir. 1921)." Thus the assignee of the author's heir owned all rights despite the author's assignment.

This case underscores how deeply entrenched the above approach to renewal rights is, at least in this circuit. The principal that a renewal term is, indeed, a *completely* new term, is here strictly followed to the point of even denying rights with respect to a derivative work which is independently copyrighted.

35. *Universal Athletic Sales Company v. Salkeld*, 182 U.S.P.Q. 278 (W.D. Pa. March 13, 1974, amended March 18, 1974) (Knox, D.J.).

Action for alleged infringement of plaintiff's copyrighted wall charts and coach's training manuals which illustrate the use of plaintiff's gymnasium exercising equipment.

On plaintiff's motion for summary judgment, *held*, motion granted.

Defendant's claim that a material fact was still in issue was based on one deponent's testimony which was inconsistent as to whether he had traced plaintiff's work or whether he had copied it by freehand. The Court rejected this claim because, in its view, actual copying in the copyright sense could occur by either freehand, tracing, or numerous other means. Thus, whether the work was actually traced or not did not raise an issue of material fact.

36. *Big Sky Music v. Todd* (No. 854); *Cayman Music, Ltd. v. Todd* (No. 869) (S.D. Georgia, Waycross Div., Aug. 27, 1974) (not yet reported).

Actions for admitted infringements of plaintiffs' copyrighted musical compositions which were publically performed for profit by defendant without permission from plaintiffs. Prior to the infringement, ASCAP, as agent for plaintiffs, offered to negotiate a license to permit defendant to make authorized performances of ASCAP compositions, which defendant refused. Thereafter, defendant made several demands on ASCAP for a list of all musical compositions on which ASCAP members hold copyrights. Such demands were claimed to be for the purpose of avoiding performance, and hence infringement, of the listed works. ASCAP repeatedly failed to offer such a list, stating that as works are continually being added and subtracted, such a list would necessarily be constantly incomplete and thus would serve no practical purpose. ASCAP did, however, in conjunction with its refusal, state that if defendant would furnish a list of works in its repertoire ASCAP would inform defendant which, if any, of such works were "ASCAP" works.

Held, judgment for plaintiffs.

(1) *Defense of Equitable Estoppel Rejected.*

The Court rejected the defendant's defense of equitable estoppel which was based on *Temp Music, Inc. v. Meyers*, 407 F.2d 503 (4th Cir. 1969). In that case, in which plaintiffs were equitably estopped from claiming infringement, the ASCAP agent had also refused to provide the infringer with a list of all ASCAP works. However, in addition, ASCAP failed to notify the defendant of ASCAP's mandatory service of informing requestors whether their submitted repertoires consisted of any ASCAP works. The Court here distinguished *Tempo Music* on the facts, *i.e.*, ASCAP here had not been "derelict in its duties" in that it had on at

least two occasions offered to defendant to compare defendant's list of works to be performed against ASCAP's full list and to notify defendant of any ASCAP works on its list.

37. *Kogan et al. v. Longstreet, et al.*, 182 U.S.P.Q. 457 (N.D. Ill. March 29, 1974) (Bauer, D.J.).

Action for infringement of plaintiff's copyrighted book brought by Illinois residents against a foreign corporate defendant. Said defendant was neither incorporated nor licensed to do business in Illinois, had no authorized agent in Illinois, had no telephone listing, bank account or real property in Illinois. Defendant admitted however, the following contacts with Illinois:

1. It distributed books to Illinois retailers, distributors and book purveyors for at least 50 years.

2. Its agents and representatives solicited orders from its Illinois customers for at least 50 years.

3. It sent new books to Illinois retailers, distributors and book purveyors on a "sale-and-return" basis.

4. It advertised in local Illinois newspapers and local Illinois periodicals from time to time.

5. It caused certain advertisements to appear in several Chicago newspapers and/or periodicals attempting to generate interest and promotion of sale of the infringing book.

6. It caused copies of this book to be transported by common carrier to its Illinois customers.

7. It sold and distributed books to several Illinois bookstores on a "sale-and-return" basis.

On defendant's motion to dismiss the complaint for improper venue, *held*, motion denied.

The Court's decision rested on its interpretation of 28 U.S.C. §1400(a), the venue provision of the Federal Copyright Act, which provides as follows:

"(a) Civil actions, suits, or proceedings, arising under any Act of Congress relating to copyrights may be instituted *in the district in which the defendant or his agent resides or may be found*". [Emphasis added].

Since the defendant was a non-resident, the Court's inquiry was solely whether it was "found" in Illinois under the statute. The Court held the test to determine whether or not the non-resident was so "found there to be the same as the test used to determine whether a non-resident corporation is subject to the Court's jurisdiction under the applicable state "long arm" statute — i.e., "the questions of personal jurisdiction and of venue are one and the same".

The Court went on to state, at 459:

In order for a non-resident corporate defendant to be amenable to suit in this district under the standards enunciated in *International Shoe Co. v. State of Washington*, 326 U.S. 310 (1945), it must affirmatively appear that the defendant's activities in the Northern District of Illinois were so systematic and continuous as to make it present in this jurisdiction for the purposes of service of process.

It has also been recognized that the copyright statute does not require a stronger finding of presence with its reference to "may be found" that is usually required in order to obtain jurisdiction over a corporate defendant. *Boltons Trading Corporation v. Killiam*, 320 F.Supp. 1182, 168 USPQ 424 (S.D. N.Y., 1970). In other words, the standard is the same whether jurisdiction is determined with reference to the relevant state long-arm statute or with reference to the copyright statute.

38. *Southwestern Bell Telephone Co. v. Nationwide Independent Directory Service, Inc.* 182 U.S.P.Q. 193 (W.D. Ark., Hot Springs Div. Jan. 4, 1974) (Harris, C.J.).

Action for alleged infringement of plaintiff's copyrighted telephone directory and for unfair competition. Defendant's directory evidenced substantial copying from plaintiff's directory, as to both listings and advertisements, as well as the unauthorized use of the plaintiff's logo "Yellow Pages".

Held, judgment for plaintiff.

In a full but not complex opinion, the Court made the following points worth repeating:

(1) *Evidentiary Value of Certificate*: Since the certificate of registration named plaintiff as author, the plaintiff was afforded a prima facie presumption of originality. In addition, the defendants had the burden of overcoming the prima facie presumption of copyright validity also flowing from the certificate.

(2) *Substantiality of Copying*: The spelling errors in plaintiff's directory, "faithfully repeated" by defendant, created a prima facie case of copying. In addition, the defendant's typesetter testified that plaintiff's directory was furnished for use in typesetting.

(3) *Telephone Directories Copyrightable*: The Court rejected defendant's argument that the "public nature" of plaintiff's book made it an inappropriate subject for copyright protection, citing the statute and case law to support its holding:

The copyright law specifically states that directories may be copyrighted. 17 U.S.C. §§3, 5 and 7. Moreover, the case law is well settled that telephone directories, as well as other similar compilations, are copyrightable and that suits for copyright infringement will lie when

such compilations are copied without consent. [citations omitted]

The landmark case on copyright infringement of a telephone directory is *Leon v. Pacific Tel. & Tel. Co.*, 91 F.2d 484, 34 U.S.P.Q. 237. In that case, Leon published a directory which was prepared by taking the information contained in Pacific's San Francisco telephone directory and rearranging it according to telephone numbers in numerical order followed by the subscriber's name. Pacific brought suit for temporary and permanent injunctions, damages and costs alleging violation of its copyright. The trial court entered judgment for Pacific. On appeal the court concluded that a telephone directory may be copyrighted. In doing so it quoted the following from *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 F. 83 at 88, cert. denied, 259 U.S. 581:

The right to copyright a book upon which one has expended labor in its preparation does not depend upon whether the materials which he has collected consist or not of matters which are publici juris, or whether such materials show literary skill or originality, either in thought or in language, or anything more than industrious collection. The man who goes through the streets of a town and puts down the names of each of the inhabitants, with their occupations and their street number, acquires material of which he is the author. He produces by his labor, a meritorious composition, in which he may obtain a copyright, and thus obtain the exclusive right of multiplying copies of his work. *Id.*, 91 F.2d at 486, 34 U.S.P.Q. at 238.

... It has also been specifically held that copying of a portion of a telephone directory in order to prepare a separate directory for a town included in the directory constitutes infringement. *Cincinnati and Suburban Bell Tel. Co. v. Brown*, *supra*; see also *Markham v. A.E. Borden Co.*, 206 F.2d 199, 98 U.S.P.Q. 346. [Emphasis added]

(4) *Abandonment*: The Court held that the plaintiff's failure to claim infringement against another, prior copier of its directories was, under these facts, insufficient evidence of the overt act necessary to constitute an intention to surrender or abandon its copyright. No such "overt act" had been proven and the copied version in question reportedly had a different format which defendant's did not. Although this version had not been introduced into evidence, the Court nevertheless commented that the plaintiff's copyright only extended to the compilation and there was "nothing to stop another compiler obtaining this information, which is in the public domain, by independent research What a subsequent compiler cannot do is copy from an already copyrighted directory and thereby save himself the labor and expense incurred by the prior compiler."

(5) *Plaintiff Owns Copyright on Advertisements*: The Court rejected defendant's argument that copying of certain advertisements (presumably covered by the plaintiff's general copyright notice) was not an infringement because the advertisers gave defendant permission to do so, stating that "this cannot constitute a justification without proof that plaintiff has assigned reproduction rights to its advertisers." Without explicitly saying so, this quote implies that the advertisers gave an implied assignment of their copyright rights to plaintiff, who thereafter owned them not in trust but for its own benefit.

(6) *Officers and Directors Personally Liable*: The Court reiterated that copyright infringement is a tort, and that, therefore, all those participating therein are jointly and severally liable:

"Officers and directors of a corporation guilty of infringement are individually liable if personally participating in the acts constituting infringement or if they are sole shareholders It is not necessary to pierce the corporate veil."

(7) *Unfair Competition*: The Court found the defendant guilty of unfair competition in the unauthorized use of plaintiff's unregistered, common law tradename "The Yellow Pages" because such use would be likely to result in consumer confusion, particularly in view of the long exclusive and extensive use by plaintiff of its term.

39. *Williams & Co., Inc. v. Williams & Co.—East* 182 U.S.P.Q. 241 (C.D. Cal. March 14, 1974) (Williams, D.J.).

Action by plaintiff licensor against defendant licensee for breach of contract, copyright infringement, and unfair competition arising out of defendant's unauthorized sale of a substantially identical book. Licensor licensed the licensee to sell its copyrighted record-keeping forms in the Eastern U.S., while licensor made sales in the Western U.S. Customers of licensee generally ordered directly by mail from licensor.

Held, judgment for plaintiff in part and defendant in part.

The greater part of this case centers around a complex of factors peculiar to the unique relationship between the parties which are too lengthy for repetition. However, two valuable points noted in the opinion merit comment:

(1) *No Violation of §1 of Sherman Act.*

(a) *No per se violation* — Territorial restrictions placed by a licensor over its licensee, when the two are truly noncompetitors but are rather in a vertical relation to one another, are "justified as reasonable steps taken to implement a valid copyright licensing system," and therefore do not constitute a per se violation.

(b) While vertical restrictions also could violate §1, such would be so only when a manufacturer sells a product to a distributor, yet still imposes restrictions on resale by the distributor. However, as here, where the plaintiff retains "dominion, title, and risk" over the goods, the relationship is one of agency, and restrictions on resale are permissible unless "unreasonably restrictive" of competition.

(2) *Record-Keeper with Instructions Copyrightable.*

Since the plaintiff's record books contained "test material intended to instruct the user in the proper manner in which to use the forms contained in the book", the Court stated it "conveyed information" and was therefore a proper subject for copyright protection.

2. State Court Decisions

40. *Krahmer v. Luing*, 182 U.S.P.Q. 494 (Superior Court, N.J., Chancery Div., March 12, 1974) (Francis, J.).

Action for alleged infringement of plaintiff's architectural plans, which plaintiff asserts are protected by common law copyright. Prior to the alleged infringement, plaintiff had filed a copy of the plans with the borough building inspector, as required by a borough ordinance, and had constructed a building pursuant to the plans. Defendant's alleged infringement was the erection of a building according to a copy of plaintiff's plans.

On defendant's motion to dismiss, *held*, motion denied.

The Court held that the plaintiff's filing of its plans did not manifest an intention to abandon copyright or dedicate its work to the public, and that therefore, such filing was a limited publication which did not divest common law copyright.

In addition, in holding that the erection of a structure according to the plans does not justify copying of the *plans themselves*, the Court had the following comments to add:

"Performance is not a publication. A structure is the result of plans, not a copy of them. It follows that building a structure and opening it to public gaze cannot be a publication of its plans. The right fully to reproduce plans is a far more substantial aid to a builder unwilling to pay for architectural services than the right to make sketches or drawings of a completed structure. Here the architect limited the use of his plans both as to the persons allowed to use the work [Mrs. Krahmer and her agent the builder] and to the use which such persons might make of the work [the construction of one house]. These limitations as to persons and use meet the test of a limited publication. Of course, the interior or exterior is copyable by

anyone with sufficient draftsmanship abilities. But construction of the residence is not a general publication of the architect's plans, drawings, blueprints and specifications; in short, his work product. [Citations omitted].

B. DECISIONS OF FOREIGN COURTS

1. England

41. *George Henshler Ltd. v. Restawile Upholstery Ltd.* 2 All England Law Reports 420 (House of Lords Feb. 18, 19, 20, 21; May 1, 1974).

Action for infringement of plaintiff's alleged copyright in its "work of artistic craftsmanship" consisting of a settee which defendant admitted copying. From judgment for defendant, plaintiff appeals.

Held, affirmed.

The opinions of the several Lords are primarily concerned with whether the aesthetic aspects of the plaintiff's work qualified as sufficiently "artistic" under §3(1)(c) as to make the work subject to copyright protection under the British Act. Using different standards as to the meaning of the term "artistic," the Lords independently concluded that while testimony indicated the item was a "winner," it nevertheless fell short of being "artistic". While this specific conclusion is not particularly important, based, as it was on the particular facts of this case, the opinions highlighted the related issues in American copyright law, namely, that copyright protection is available for a work of art even if that work is designed also as a useful object, and the corollary problem of determining when a useful object is sufficiently "artistic" to qualify it as a "work of art" under the U.S. Copyright Law.

PART V.

BIBLIOGRAPHY**A. BOOKS AND TREATISES****1. United States Publications**

42. **AMERICAN LIBRARY ASSOCIATION.** Libraries and copyright: a summary of the arguments for library photocopying. [Washington, June 1974] 46 p.

A partisan "attempt to provide librarians with a short summary of the arguments in favor of photocopying, combined with a status report on how these arguments have fared in the courts and in Congress."

43. **KAPLAN, BENJAMIN, AND RALPH S. BROWN, JR.** Cases on copyright, unfair competition, and other topics bearing on the protection of literary, musical, and artistic works. 2d ed. by Ralph S. Brown, Jr. Mineola, N.Y., Foundation Press, 1974. 997 p. (University casebook series).

An updating which reflects the heightened importance of photocopying, computer uses, and cable television. The appendices, in addition to statutory and regulatory materials, include the text of the general revision bill, S. 1361, 93d Congress, 1st session, as originally introduced by Senator McClellan on March 26, 1973.

2. Foreign Publications**1. In Dutch**

44. **KLAVER, FRANCESCA.** Massamedia en modern auteursrecht. Amsterdam. Weten schappelijke Uitgeverij, 1973. 262 p.

A new Dutch language treatise dealing with Dutch and international copyright problems in the communications industries. One sensible and useful feature of this book is the inclusion of a summary in English, which runs from page 221 through page 235 and outlines some of the main points. The treatise captions are as follows: (1) Video: a general survey; (2) Cable Television: copyright and "neighbouring rights"; (3) The Rome Convention on "neighbouring rights" once more under discussion; (4) Developing Countries and Copyright; (5) Problems concerning the film sound track. The dis-

cussion ranges from recommendation for revision of the Rome Convention to neighbouring rights protection for phonograms in Czechoslovakia and, what may be of particular interest to American readers, recent cases concerning cable television in the United States which are analyzed in the context of similar dilemmas abroad.

This book will be of interest not only in terms of specific analysis but equally as a reflection of up to the minute European thought on the complex relationships between hardware and software.

2. In English

45. CAVENDISH, J.M. A handbook of copyright in British publishing practice. London, Cassell [1974] 210 p.

A practical working tool in handling day-to-day problems of book publishing and book writing in the United Kingdom. Includes chapters on the public lending right, protection copyright in the United States, copyright and the U.S.S.R., international copyright conventions, and the compulsory licensing of translations and reprints in developing countries. Appendices contain part III of the U.K. Copyright Act, 1956, the Net Book Agreement, 1957, book club regulations, and the British publishers' traditional market, 1973.

3. In French

46. Hommage à Henri Desbois; études de propriété intellectuelle. [Paris] Dalloz, 1974. 334 p.

A collection of studies on intellectual property, contributed in homage to the eminent French jurist.

Contents: Dock, M. Cl. La Convention universelle sur le droit d'auteur révisée à Paris le 24 juillet 1971. Kerever, A. Le droit d'auteur en Europe occidentale. Plaisant, R. Les conventions relatives au droit moral de l'auteur. Strömholm, S. Le refus par l'auteur de livrer une œuvre de l'esprit cédée avant son achèvement. Étude sur le "droit de divulgation" de la loi du 11 mars 1957. Ulmer, E. Le droit de suite et sa réglementation dans la Convention de Berne. Bastian, D. De la marque constituée par la forme d'un bâtiment. Chavanne, A. Modèles et marques de fabrique. Françon, A. La prohibition des marques descriptives en droit français. Lassier, J. Haute fidélité. Mathely, P. L'étendue de la protection conférées par le brevet selon la loi de 1968. Mousseron, J.M. L'obligation de garantie dans les contrats d'exploitation de brevets d'invention.

Perot-Morel, M.A. L'usage du nom patronymique d'autrui à titre de marque. Rotondi, M. Un projet italien de loi type pour les brevets les modèles et les marques. Saint-Gal, Y. Marques: obligation d'usage en droit comparé. Savignon, F. Essai de présentation de données internationales en matière de brevets d'invention. De Sanctis, V. La cour constitutionnelle italienne et le droit d'auteur. Masouyé, Cl. L'Organisation mondiale de la propriété intellectuelle (O.M.P.I.).

4. In German

47. BRANDT, GÜNTER. Der Rechtsschutz von Rechenprogrammen der elektronischen Datenverarbeitung. Potsdam-Babelsberg, Akademie für Staats- und Rechtswissenschaft der DDR, Informationszentrum Staat und Recht, 1973. 220 p. (Aktuelle Beiträge der Staats- und Rechtswissenschaft, Heft 99).

A text on the legal protection of computer programs for electronic data processing, with special emphasis on the laws of the German Democratic Republic.

48. Gewerblicher Rechtsschutz, Urheberrecht, Wirtschaftsrecht; Mitarbeiterfestschrift zum 70. Geburtstag von Eugen Ulmer, mit Beiträgen aus dem deutschen, ausländischen und internationalen Recht. Köln, C. Heymann [1973] 587 p.

A festschrift published in honor of the 70th birthday of Professor Eugen Ulmer. The contributions, which deal with German, foreign and international aspects of the legal protection of industrial property, copyright, and laws concerning economic problems, are by former and present members of the staff of the Max-Planck Institute and of the Institute for the Legal Protection of Industrial Property and Copyright of the University of Munich.

49. HUBMANN, HEINRICH. Urheber- und Verlagsrecht: ein Studienbuch. 3., neubearb. Aufl. München, Beck, 1974. 307 p. (Juristische Kurz-Lehrbücher)

The 3d edition of a textbook on the copyright law and the law on publication contracts of the German Federal Republic.

50. WEISSTHANNER, MARGOT. Urheberrechtliche Probleme neuer Musik. München, C.H. Beck, 1974. 96 p. (Urheberrechtliche Abhandlungen des Max-Planck Instituts für ausländisches und in-

ternationales Patent-, Urheber- und Wettbewerbsrecht, München, Heft 14.)

A treatise on copyright problems of so-called "new music," which comprises serial music, concrete music, electronic music, music composed with the aid of computers, and experimental or aleatoric music, organized into two parts. The first part deals with the development and structure of each type of new music, and the second with the copyright problems each type raises under the laws of the German Federal Republic and the United States.

5. In Hungarian

51. BEÑARD, AURÉL, *ed.*

A szerzői jog kézikönyve. Szerkesztette: Benárd Aurél és Tímár István. Írták: Batta János [et al.] Budapest, Közgazdasági és Jogi Könyvkiadó, 1973. 810 p.

A comprehensive reference book on Hungarian copyright law, with chapters on the history and theory of copyright and international copyright. Appendices contain the texts of the Hungarian copyright law, its decree of general application and the exposé des motifs; important legal texts relating to different kinds of art; international conventions; and model contracts.

B. LAW REVIEW ARTICLES

1. United States

52. The Convention for the protection of producers of phonograms against unauthorized duplication. In *Law and Policy in International Business*, vol. 6, no. 2 (Spring, 1974), pp. 587-601.

A brief survey of attempts at legal protection against record piracy in the United States and internationally, the scope of the protection offered by the international convention, and its relation to other protection agreements. One of the conclusions reached is that "the convention's failure to provide for the protection of composers and performers may warrant the drafting of a new convention to deal with this problem."

53. Copyrights—radio and television—cable television operator subject to liability for copyright infringement when distant signals are imported. In *Harvard Law Review*, vol. 87, no. 3 (Jan. 1974), pp. 665-675.

A comment on the appellate decision in *Columbia Broadcasting System, Inc. v. Teleprompter Corp.*, 476 F.2d 338, 20 BULL. CR. SOC. 255, Item 201 (2d Cir. 1973).

54. DUNAJ, WILLIAM J. Tape piracy and applicable Florida criminal laws. In *Florida Bar Journal*, vol. 48, no. 5 (May 1974), pp. 337-341.

A conclusion is reached that "Florida's anti-tape piracy statute appears valid on its face and may be vindicated" in the courts.

55. GERALDSON, RAYMOND I., and DAVID C. HILLIARD. Copyright protection for visual artists and authors. In *Chicago Bar Record*, vol. 55, no. 7 (May-June, 1974), pp. 304-308.

"This paper sets forth simple guidelines which artists and authors should follow to protect their rights."

56. HARVELL, MICHAEL C. Copyright—fair use—Government photocopying of medical journals does not infringe journal copyright. In *Boston University Law Review*, vol. 54, no. 3 (May 1974), pp. 689-701.

A critical comment on the Court of Claims decision in *Williams & Wilkins Co. v. United States*, 487 F.2d 1345, 21 BULL. CR. SOC. 112, Item 102 (Ct. Cl. 1973), cert. granted, 42 U.S.L.W. 3652 (U.S. May 28, 1974) (No. 1279).

57. HUSTON, JOSEPH H., JR. Constitutional law—copyright clause—States may afford protection to sound recordings against unauthorized reproduction without infringing on the federal copyright power. In *Villanova Law Review*, vol. 19, no. 3 (Feb. 1974), pp. 496-507.

A note on the Supreme Court decision in *Goldstein v. California* 412 U.S. 546 (1973).

58. JONES, KEITH R. Characters and the copyright clause—is a character a writing? In *Baylor Law Review*, vol. 26, no. 2 (Spring, 1974), pp. 222-231.

A comment, based on an entry in the Nathan Burkan Memorial Competition, 1974, which "explores the breadth and historical expansion of copyright protection with an eye toward discerning the permissible limits of that expansion, with special emphasis on the unique problems surrounding character protection."

59. MUETH, JOSEPH E. Copyright infringement & community antenna

television—the Supreme Court's re-run. In *Journal of the Beverly Hills Bar Association*, vol. 8, no. 3 (May-June 1974), pp. 20-24.

A brief analysis of the Supreme Court's decisions in the *Fortnightly* and *Teleprompter* cases.

60. MAGGS, PETER B. New directions in U.S.-U.S.S.R. copyright relations. In *American Journal of International Law*, vol. 68, no. 3 (July 1974), pp. 391-409.

Developments during the course of 1973 and early 1974 with respect to "questions of regulation of transmission of works abroad, publication and copyright notice, transfer of author's rights, expropriation, royalties, taxation, all of which have been affected by Soviet legislation during the course of 1973 and most of which have been the subject of misinterpretation in articles in the popular press."

61. MURDOCK, KENT. *Williams & Wilkins Co. v. United States*: library photocopying of copyrighted materials. In *Utah Law Review*, vol. 1974, no. 1 (Spring), pp. 127-143.

A comment, entered in the 1974 Nathan Burkan Memorial Competition, on the Court of Claims decision in *Williams & Wilkins* case, 487 F.2d 1345, 21 BULL. CR. SOC. 112, Item 102 (Ct. Cl. 1973), *cert. granted*, 42 U.S.L.W. 3652 (U.S. May 28, 1974 No. 1279).

62. NAKAMURA, FRANK M. *Goldstein v. California*—the constitutionality of a State copyright. In *Utah Law Review*, vol. 1973, no. 4 (Winter), pp. 851-861.

A comment on the Supreme Court decision in the *Goldstein* case, 412 U.S. 546 (1973).

63. ROTHENBERG, STANLEY. Copyright. *Encyclopedia Americana* (1974 ed.), pp. 772-776.

Revision of an article first published in the *Encyclopedia* in 1968.

64. Soviet accession to UCC; has the Russian bear been tamed? In *BNAs Patent, Trademark & Copyright Journal*, no. 191 (Aug. 22, 1974), pp. AA4-AA6.

A summary of a panel discussion of the implications of the Soviet accession to the U.C.C. at the annual meeting of the American Bar Association in Hawaii, where a consensus of the views of the

participants "makes it appear that the 'Russian bear' has not been tamed."

2. Foreign

1. In English

65. Intergovernmental Committee of the International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations. *2d Extraordinary Session, Brussels, May 6 and 10, 1974*. Report, prepared by the Secretariat and adopted by the Committee. In *Copyright*, vol. 10, no. 6 (June 1974), pp. 159-174.

The extraordinary session was convened to consider again a revised draft Model Law Concerning the Protection of Performers, Producers of Phonograms and Broadcasting Organizations and the commentary on it. Appended to the Report is the list of participants, and on the following pages are presented the model law as approved by the Committee in the left-hand column and the commentary on the right.

66. NIMMER, MELVILLE B. Who is the copyright owner when laws conflict? In *IIC*, vol. 5, no. 1 (1974), pp. 62-72.

"An updated version of the article which first appeared in 1973 *GRUR Int.* 302 (*Festschrift fur Eugen Ulmer*). See 21 *BULL. CR. SOC.* 59, Item 34 (1973).

67. PAGENBERG, BIRGITT A. Patentability of computer programs on the national and international level. In *IIC*, vol. 5, no. 1 (1974), pp. 1-43.

"Based on a paper submitted . . . in the Seminar offered by Harvard Law School and M.I.T. in 1973 on 'Information Systems and Law' in satisfaction of the requirements for the degree of LL.M." The article is an "attempt to analyze the development and actual state of the law as reflected in various jurisdictions outside of the United States which have been confronted with the problem."

68. WORLD INTELLECTUAL PROPERTY ORGANIZATION. Brussels diplomatic conference on the distribution of programme-carrying signals transmitted by satellite: Note. In *Copyright*, vol. 10, no. 6 (June 1974), pp. 143-155.

A note on the International Conference of States on the Distribution of Programme-Carrying Signals Transmitted by Satellite,

held at Brussels from May 6 to 21, 1974. Appended are the list of participants, and the English and Russian texts of the Convention.

2. In French, English & Spanish

69. GAUDEL, DENISE. Á propos de la télédistribution. In *Revue Internationale du Droit d'Auteur*, no. 81 (July 1974), pp. 84-120.

An article on questions of authors' rights, under French law and the Berne Convention, entailed by the "teledistribution" of their works, and on the possibility of derogation to the monopoly enjoyed by the French radio and television office (ORTF). "Teledistribution" is defined as "a method of dissemination through the intermediary of electrical-signal cables producing light and sound effects which cannot be picked up directly from the atmosphere."

70. JOUBERT, CLAUDE. Commentaires sur la nouvelle loi sénégalaise relative à la protection du droit d'auteur. In *Revue Internationale du Droit d'Auteur*, no. 81 (July 1974), pp. 34-82.

A commentary on the new copyright law of the Republic of Senegal, promulgated on December 4, 1974.

71. ROUDAKOV, N.S., and I.A. GRINGOLTS. L'agence de l'URSS pour les droits d'auteur: sa création, ses fonctions, sa structure. In *Revue Internationale du Droit d'Auteur*, no. 81 (July 1974), p. 2-33.

An article on the background, functions and structure of the Copyright Agency of the U.S.S.R. (VAAP), recently established as a result of Soviet adherence to the 1952 text of the Universal Copyright Convention. An explanation is given as to why the Soviets did not choose to adhere to the Berne Convention or to the 1971 text of the U.C.C.

3. In German

72. Fotokopieren in den USA—Schutzlosigkeit von Autoren und Verlegern? In *Gewerblicher Rechtsschutz und Urheberrecht*, Int. Teil, no. 6 (June 1974), pp. 246-251.

An analysis of the Court of Claims decision in the *Williams & Wilkins* case, 487 F.2d 1345, 21 BULL. CR. Soc. 112, Item 102 (Ct. Cl. 1973), cert. granted, 42 U.S.L.W. 3652 (U.S. May 28, 1974), followed by a critical evaluation of the decision, which concludes with the hope that the Supreme Court will find a solution to the library

photocopying problem. Contents: A. Die Williams & Wilkins Entscheidung des United States Court of Claims vom 27. November 1973, von Alexander v. Mühlendahl. B. Kritische Würdigung, Perspektiven, von Eugen Ulmer.

73. GENTZ, GÜNTHER. Der künstlerische Leistungsschutz. In *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 76, no. 6 (June 1974), pp. 328-331.

A discussion of two differing possibilities of interpreting the protection of performing artists in three places in the copyright law of the German Federal Republic.

74. PETER, FRANZ WILHELM. Urheberrechtssituation in der Sowjetunion; Verhandlungen für den BRD-Bereich angelaufen. In *Film und Recht*, vol. 17, no. 8 (Aug. 15, 1973), pp. 367-370.

A brief report on the current copyright situation in the Soviet Union, with special attention to the effect of Soviet adherence to the Universal Copyright Convention on copyright relations with the German Federal Republic.

75. ULMER, EUGEN. Das Wiener Abkommen über den Schutz typographischer Schriftzeichen und ihre internationale Hinterlegung. In *Gewerblicher Rechtsschutz und Urheberrecht*, Int., no. 4 (Apr. 1974), pp. 164-170.

An analysis of the Vienna Agreement for the Protection of Type Faces and Their International Deposit.

76. WALTER, MICHEL M. Gemeinschaftsantennen im österreichischen Urheberrecht und im Recht der Berner Übereinkunft; Bemerkungen zum Urteil zweiter Instanz im Testprozess "Feldkirch." In *Film und Recht*, vol. 18, no. 5 (May 15, 1974), pp. 303-307.

Comments on a recent decision of an Austrian appellate court in a test case involving the question of copyright liability of community antenna television systems under the Austrian copyright statute and the Berne Convention.

4. In Italian

77. RICHIELLO, GIAMPIETRO. Recenti orientamenti della giurisprudenza sulle riproduzioni illecite di dischi e apparecchi analoghi. In *Il Diritto*

di Autore, vol. 44, no. 3 (July-Sept. 1973), pp. 302-310.

A brief survey of the recent course of court decisions in Italy dealing with the unauthorized duplication of records and similar contrivances.

5. In Spanish

78. MOUCHET, CARLOS. Derechos de autor en la Argentina, 1973. In *El Derecho*, vol. 51, no. 3339 (Dec. 5, 1973), pp. 1-5.

A survey of the situation in 1973 and in the future with respect to domestic and international copyright protection in Argentina.

79. MOUCHET, CARLOS. Estado general de derecho de autor nacional e internacional en el mundo. (En el quinquenio 1969-1973). Informe para el "X Congreso Inter-americano sobre Derechos de Autor" (Brasilia, 29 octubre-10 noviembre 1973). [Buenos Aires, 1974?] 13 p. At head of title: Consejo Panamericano de la Confederación Internacional de Autores y Compositores (CISAC).

A report to the 10th Inter-American Congress on Copyright, Brasilia, October 29 to November 1, 1973, on the general state of national and international copyright in the world during the quinquennial, 1969-1973.

ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

80. CECIL, HENRY. Copyright in the public interest. In *American Libraries*, vol. 5, no. 7 (July-Aug. 1974), p. 343.

After a brief account of recent efforts of the British Parliament to secure a Public Lending Right for authors and to find means of financing it, a suggestion is made that the feasibility of a *domaine public payant* be investigated afresh in Great Britain, where it had been rejected a little over twenty years ago, and also in the United States as a possible means of financing the scheme.

81. Col, ASCAP, BMI accords spur music ties to Soviet. In *Billboard*, vol. 86, no. 33 (Aug. 17, 1974), pp. 1,33: NMPA bolsters U.S.-Soviet publishing accord idea, by Robert Sobel; pp. 1, 6: Col, Soviets in reciprocal deal, by Is Horowitz.

Articles on preliminary and final arrangements by CBS Records International, ASCAP, BMI, and the National Music Publishers Association with Soviet copyright and cultural authorities for reciprocal payment of performance royalties and mechanical royalty collection and distribution.

82. HAGEL, RAYMOND C. Views on publishing: Some outspoken opinions from Raymond C. Hagel, chairman of MacMillan. In *Publishers Weekly*, vol. 206, no. 4 (July 22, 1974), pp. 36-41.

Questions and answers relating to publishing operations. In answer to a question about the position of MacMillan in regard to copyright, Mr. Hagel stated that "the most important single step publishers can take today is to assume a leadership position in seeking immediate passage and implementation of Title II [National Commission on New Technological Uses of Copyrighted Works] of the pending Senate bill (S. 1361)."

83. MATHESON, WILLIAM. Recent acquisitions of the Rare Book Division. In *The Quarterly Journal of the Library of Congress*, vol. 31, no. 3 (July 1974), pp. 166-182.

A paper by the chief of the Rare Book Division of the Library of Congress, which includes a section on copyright. This section sets out the criteria for selecting copyright deposits for additions to the collections of the division, and describes the importance of such additions.

84. MUCHNICK, IRV. Copyright bill may aid archive. In *The Vanderbilt Hustler*, vol. 86, no. 6 (Sept. 13, 1974), pp. 1, 7.

An article on the adoption by the Senate in passing the general revision bill, S. 1361, of the Baker-Griffin amendment which would have the effect of exempting the Vanderbilt Television News Archive from liability for copyright infringement for the taping of television news broadcasts. See Item II, *supra*.

85. PILPEL, HARRIET F., and ALAN U. SCHWARTZ. Mickey Mouse, Dracula and the rights of parody and privacy; the legal position regarding some famous fictional characters. In *Publishers Weekly*, vol. 206, no. 12 (Sept. 16, 1974), pp. 32-34.

A discussion of several court decisions dealing with the question of what rights derive from "invented non-persons."

-
86. POSNER, MICHAEL. Senate votes for copyright law overhaul; outlook for House passage is cloudy. In *The Washington Post*, vol. 97, no. 279 (Sept. 10, 1974), p. A12, cols. 1-4.

A Reuter dispatch on the action of the Senate on September 9 in passing the copyright revision bill, S. 1361, after defeating a controversial provision for payment of performance royalties. "The bill now goes to the House, where the outlook is cloudy."

87. WAGNER, SUSAN. Are the Soviets engaging in unauthorized photocopying? In *Publishers Weekly*, vol. 206, no. 8 (Aug. 19, 1974), p. 22.

An article on a report released recently by the National Science Foundation which indicates that the lack of reproduction agreements for the bulk of desired U.S. scientific and technical journals is causing the Soviets to engage in limited unauthorized photocopying.

88. WINN, KARYL. Common law copyright and the archivist. In *The American Archivist*, vol. 37, no. 3 (July 1974), pp. 375-386.

A discussion of problems faced by the archivist because of complex issues of common law copyright such as legal interpretation of publication, photocopying policy, donor relations, and the privacy issue. Until Congress acts, archivists are "urged to adopt such practices as seeking literary rights and photocopy permission at time of gift, helping the donor define reasonable, specific instructions, and requesting researchers to sign photocopy permission forms before they provide facsimile copies."

2. England

89. Extension of copyright. In *The Author*, vol. 85, no 2 (Summer 1974), pp. 51-55.

After a brief sketch of the history of changes in the U.K. copyright law in respect to the term of copyright protection, two comments are given by Antonia Fraser and Piers Paul Read, members of a subcommittee of the Management Committee of the Society of Authors. The comments are in regard to the kinds of changes which might be made in the term of protection in the light of a forthcoming revision of the Copyright Act 1956.

NEWS BRIEFS

90. UNITED KINGDOM COMMITTEE TO STUDY COPYRIGHT.

The Minister for Trade and Consumer Affairs of England has set up a departmental committee to inquire into the law of copyright in that country. The committee will consider and report on whether changes are desirable in the Copyright Act of 1956 and the Design Copyright Act of 1968. Mr. Justice Whitford will chair the committee, whose other members are: Mr. G.V.K. Burton, C.B.E., Mr. G.H. Doughty, Mr. D. Fiske, Ms. Rosina Harris, Ms. Jacqueline Inchbald, Mr. E.P. Skone-James, Mr. W. Wallace, C.M.G., and Mr. W. Weston.

CORRECTION

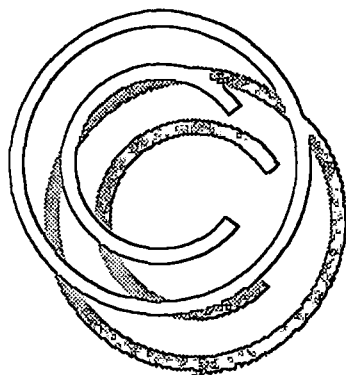
91. In Volume 21 of the BULLETIN, page 347, Item 328, *Marx v. Darien House, Inc.* was erroneously cited to the October 16, 1973 issue of the New York Law Journal. The correct citation is N.Y.L.J., Nov. 16, 1973.
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ANNOUNCEMENT

BULLETIN'S TWENTY-YEAR INDEX AVAILABLE

We are pleased to announce the publication of a twenty-year Cumulative Index to the **BULLETIN OF THE COPYRIGHT SOCIETY OF THE U.S.A.** covering 1953-1973. The Index was compiled by Meira G. Pimsleur, formerly of Columbia University Law Library.

The volume contains an Author Index; a Table of Cases cited and digested; an Index to Legislative and Administrative Developments; an Index to Conventions, Treaties and Proclamations; and a comprehensive and detailed Subject Index. In short, the volume offers a quick approach to copyright developments during two decades.

The clothbound volume is available at \$32.50 from Fred B. Rothman & Co., 57 Leuning Street, South Hackensack, New Jersey 07606.

JOHN SCHULMAN

On Friday, October 25th, John Schulman, one of the leading members of the Bar, specializing virtually all his life in copyright, passed away after a very brief retirement.

John Schulman was one of the founders of our Society and served several times as one of its trustees. For many decades he represented the Song Writers Protective Association (now known as the American Guild of Authors and Composers) and in that capacity participated in numerous landmark litigations. Outstanding among these was the famous case of *Fisher v. Witmark*, in which he sought to establish on behalf of authors and composers the renewal right of widows and children, regardless of whether or not the author or composer who survived into the renewal term had otherwise disposed of or assigned the renewal expectancy. While he did not prevail in the Supreme Court, his persuasive argument and brief resulted in a dissent by three distinguished Justices and a personal letter from the late Justice Frankfurter, who wrote the majority opinion, in which he congratulated John upon his splendid presentation.

John was also from the outset one of the most active forces behind the move to revise — or rather completely rewrite — the Copyright Act of 1909. This effort has now continued for over 20 years, and John Schulman served from the very beginning on the Panel of Experts appointed by the Librarian of Congress.

John Schulman's reputation and participation in the work of various professional organizations was significant enough to lead the American Patent Law Association a few years ago to appoint him its President, an honor never previously bestowed on a copyright specialist. He also served as President of the American Group of the A.I.P.P.I., known in the United States as the International Patent and Trademark Association. Again, it was the first time that a copyright expert had been elected to this position.

He loved educational work and was a frequent lecturer at New York University School of Law, the Practicing Law Institute and many other organizations. In 1971, New York University and the Copyright Society jointly invited John Schulman to deliver the second lecture in the annual series known as the Donald C. Brace Memorial Lecture. His provocative lecture on the philosophy of copyright is published in Volume 18 of the *Bulletin of the Copyright Society*.

Among his outstanding contributions to international copyright was his participation as a member of the United States Delegation in the preparation and ultimate ratification of the Universal Copyright Convention. He played a decisive role during the early 1950's in the negotiations which finally resulted in the signing and subsequent ratification of the Universal Copyright Convention. In addition, he was a delegate to the Stockholm Conference of 1967 and to the Geneva Conference of 1967 concerning the Patent Cooperation Treaty.

His numerous friends and colleagues of the Copyright Bar will long remember not only his outstanding knowledge and experience, but especially the advice so generously and readily offered to any student of copyright.

Walter J. Berenson.

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PART I

ARTICLES

92. PROTECTION OF CHARACTERS — SAM SPADE REVISITED

By E. Fulton Brylawski*

Recent court decisions have shown that the legal doctrines for the protection of literary and cartoon characters are rather inconsistent, unclear and quixotic. Some cases have protected characters only under copyright doctrine,¹ others under principles of unfair competition² and still others under an admixture of both.³ In addition, the judicial process by which the courts have selected the appropriate legal doctrine has become such a complicated maze that the outcome is neither predictable nor fair.

Today, literary and cartoon characters, particularly in television fields, are very often the most valuable portion of the particular works or

* Mr. Brylawski is a Washington, D.C. lawyer specializing in copyright and trademark matters. He received a J.D. degree from Yale Law School and an M.B.A. from Harvard University.

¹ See, e.g., *Detective Comics, Inc. v. Bruns Publications, Inc.*, 111 F.2d 432 (2d Cir. 1940) ("Superman"); *Fleischer v. Freundlich*, 73 F.2d 276 (2d Cir. 1934) ("Betty Boop"); *King Features Syndicate v. Fleischer*, 299 F. 533 (2d Cir. 1924) ("Spark Plug"); *Detective Comics, Inc. v. Fox Publications, Inc.*, 46 F. Supp. 872 (S.D.N.Y. 1942) ("Batman" and "Robin"); *Hill v. Whalen & Martell Inc.*, 220 F. 359 (S.D.N.Y. 1934) ("Mutt and Jeff").

² See, e.g., *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F. Supp. 621 (S.D.N.Y. 1958) ("Wyatt Earp"); *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939) ("Stella Dallas"); *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 (Dist. Ct. App. 1928) ("Charles Aplin"); *Lone Ranger, Inc. v. Cox*, 124 F.2d 650 (4th Cir. 1942) and *Lone Ranger, Inc. v. Currey*, 79 F. Supp. 190 (M.D. Pa. 1948) ("Lone Ranger"); *Star Co. v. Wheeler Syndicate, Inc.*, 160 N.Y.S. 689 (Sup. Ct. 1916) ("Mutt and Jeff"); *Feldman v. Amos and Andy*, 68 F. 2d 746 (C.C.P.A. 1934) ("Amos and Andy"); *Premier Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754 (D. Conn. 1934) ("Old Maestro"); *Patten v. Superior Talking Pictures*, 8 F. Supp. 196 (S.D.N.Y. 1934) ("Frank Merriwell"); *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133 (Ct. App. 1921) ("Mutt and Jeff"). Cf. *New York Herald Co. v. Star Co.*, 146 F. 204 (S.D.N.Y.), *aff'd*, 146 F. 1023 (2d Cir. 1906) ("Buster Brown").

³ See, e.g., *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 216 F.2d 945 (9th Cir. 1954); *Walt Disney Productions v. The Air Pirates*, 345 F. Supp. 108 (N.D. Cal. 1972).

properties of which they are a part.⁴ This is particularly true of an outmoded story where the principal value is often in its characters and less in the story. Yet, as television and other media turn to reviving these older and well-established characters, the problem of determining ownership and the duration of protection of characters becomes increasingly acute. To meet this perennially perplexing problem, it is necessary to find and adopt a new legal framework which will assist in determining, with some reasonable degree of certainty, whether there are any outstanding rights in a character, who owns them, and when such rights will expire.

- A. *A character is not a unitary concept, but rather consists of two dissimilar parts: a name and a characterization or personality portrait.*

Much of the confusion surrounding the protectibility of a character stems from a failure or unwillingness to recognize that a character actually consists of two separable and legally dissimilar parts. The first is the character name, and the second a set of physical attributes and personality traits sometimes called a characterization or personality portrait.⁵ Almost no judicial cases dealing with the protection of a literary or cartoon character have stripped away the name of the character and separately examined the legal basis for protecting the characterization alone. Instead, the cases seem to assume that a characterization is merely an inseparable component of that which is called a character.⁶ Where the characterization is weak⁷ but the name is entitled to protection, the "character" as a whole seems to be generally protectible under principles

⁴ It has been noted that some characters are "as valuable as the most gilt-edged security listed on the Stock Exchange". *Kurlan v. Columbia Broadcasting System, Inc.*, 40 Cal. 2d 799, 819, 256 P.2d 962, 975 (1953) (Carter, J., dissenting). See also Nimmer, *Copyright and Quasi-Copyright Protection for Characters, Titles and Phonograph Records*, 59 T.M. REP. 63 (1969).

⁵ One writer at least has recognized the dual nature of cartoon characters with copyright being the dominant mode of protection, supplemented by trademark rights when the character has become publicly distinctive. See Waldheim, *Mickey Mouse—Trademark or Copyright?* 54 T.M. REP. 865 (1964).

⁶ But see *Supreme Records, Inc. v. Decca Records, Inc.*, 90 F. Supp. 904, 909 (S.D. Cal. 1950) (indicating that a characterization, in the sense of a role played by an actor, "is not copyrightable or subject to any right recognized under the law of unfair competition.")

⁷ Judge Learned Hand highlighted the legal effect of a weak or poorly defined characterization: "[T]he less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly." *Nichols v. Universal Pictures Corp.*, 45 F.2d 119, 121 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1935). This language has been labeled Judge Hand's "well developed character" dictum, which affords little real protection to the creator of even the most sharply delineated characters. Note, *Literary*

of unfair competition.⁸ Where the characterization is strong or dominant, the entire "character" tends to be protected under copyright doctrine.⁹ The unfortunate consequence of this unitary approach is that the legal rationale for the protection of the entire character is inappropriate to its parts, resulting in the application of the laws of unfair competition to a characterization simply because it has imperceptibly merged with a dominant character name to comprise the entire character and, correspondingly, the application of copyright doctrine to a character name merely because it is connected to a copyrightable characterization.¹⁰

B. *The law governing the protection of a character name*

A character name has generally enjoyed protection under common law principles of unfair competition¹¹ or trademark law. The law of unfair competition protects a character name once it has become iden-

Property in Characters: Protection Afforded Authors by Copyright and Unfair Competition, 21 ALBANY L. REV. 185, 191 (1957).

⁸ A character name is entitled to protection under the doctrine of unfair competition when that name has acquired a secondary meaning, which is to say when the name has become identified in the public mind with a particular character. See, WARNER, RADIO AND TELEVISION RIGHTS §234 (1953); See also Note 2, *supra*.

⁹ This is, of course, the corollary to Learned Hand's proposition that the less defined a characterization, the less it is subject to copyright protection. See Notes 1 and 7, *supra*. See also NIMMER, §30 at 135 (1973); WARNER §71 at 232-35 and §2316, and Note, *The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition, and Copyright*, 68 HARV. L. REV. 349, 357-58 (1954).

¹⁰ The ambivalence of the courts is clearly demonstrated in the cases involving the cartoon characters "Mutt and Jeff". In *Hill v. Whalen & Martell, Inc.*, 220 F. 359 (S.D.N.Y. 1914), the characters were accorded protection under copyright doctrine, while in *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133 (Ct. App.), *cert. denied* 257 U.S. 654 (1921), they were granted protection under principles of unfair competition. This is precisely the type of inconsistency which the duality concept suggested herein is intended to eliminate.

¹¹ Although competition between the parties was once thought necessary to an action for unfair competition, by 1950 it had been recognized that "the existence of actual competition between the parties was no longer a prerequisite". *Metropolitan Opera Association, Inc. v. Wagner—Nichols Recorder Corp.*, 199 Misc. 786, 795, 101 N.Y.S. 2d 483, 491-92 (Sup. Ct. 1950), *aff'd mem.*, 279 App. Div. 632, 107 N.Y.S. 2d 795 (1951). See also *Tomlin v. Walt Disney Productions, Inc.*, 18 Cal. App. 3d 226, 96 Cal. Rptr. 118 (1971). See generally, *Callmann, Unfair Competition Without Competition? The Importance of the Property Concept in the Law of Trade-Marks*, 37 T.M. REP. 175 (1947). With the attenuation of competition as a necessary element to an action for unfair competition, there has emerged a new common law property right justified by the notion that one should not reap where he has not sown.

tified in the public mind with a particular character.¹² Sometimes this public identification is called "secondary meaning".¹³ For instance, "Mickey Mouse" in the first or primary sense is a mouse named "Mickey", but it has also acquired a secondary meaning or public identification in connection with the Walt Disney creation.¹⁴ Sometimes a character name is the title or part of the title of a particular work and it thereby achieves additional protection in a more traditional and familiar sense as a title of the novel, play or cartoon series which has acquired sufficient celebrity to be protected under common law doctrines of unfair competition.¹⁵

Yet, even where a character name does not appear in the title itself, the name still may have acquired such a popular significance, independent of the particular work in which it appears, that the author can and should prevent use of the character name by another who would lead the public to associate the new use with the original author's creation. In this sense, the creator of the character name has acquired a property right at

¹² See Note 2, *supra*. At times it seems that rights in names or titles are the only concern of the parties and that copyright protection in the characters is only secondary. For instance, Rudolph Dirks had been drawing the cartoon strip "The Katzenjammer Kids" for the *New York Journal* until 1912 when, after a dispute, he began to draw the strip for another newspaper, the *New York World*. Following the ensuing litigation and final settlement, the *New York Journal* retained the right to draw these strips with the original characters under the original title and Dirks was permitted to continue the strip at the *New York World* under the title "The Captain and the Kids," but with the same characters and format. Thereafter, both strips with substantially the same characters and format and only slightly different titles appeared in the two competing newspaper publications and endured until recent years. BECKER, *COMIC ART IN AMERICA* (1959) at 17, 47-49; PERRY AND ALDRIDGE, *THE PENGUIN BOOK OF COMICS* (1967) at 94. Indeed, the contemporaneous publication of the two strips with the same characters and format and with similar titles has undoubtedly created public confusion and constituted copyright infringement, but no one apparently has had the legal standing to complain about it.

¹³ See generally, Warner §232; Note, *The Protection Afforded Literary and Cartoon Characters through Trademark, Unfair Competition and Copyright*, 68 HARV. L. REV. 349, 352-56 (1954).

¹⁴ See *Walt Disney Productions v. The Air Pirates*, 345 F. Supp. 108 (N.D. Cal. 1972), in which the court stated that the Disney characters, particularly "Mickey Mouse", have "achieved a high degree of [public] 'recognition' or 'identification'". *Id.* at 113.

¹⁵ See, e.g., *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939) where the "Stella Dallas" name was taken from a novel for use as the title of a radio program; *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934) where the "Frank Merriwell" character name was taken from a series of stories for use as the title of a motion picture; and *Paramore v. Mack Sennett, Inc.*, 9 F.2d 66 (S.D. Cal. 1925), where a motion picture adopted its title from the "Yukon Jake" name in plaintiff's poem.

common law, vested in him as a matter of public interest, to prevent public confusion between his work and that of a trespasser. Earl Biggers' "Charlie Chan", Johnny Gruelle's "Raggedy Ann", Rex Stout's "Nero Wolfe", Agatha Christie's "Hercule Poirot", Edgar Rice Burroughs' "Tarzan" and Sir Arthur Conan Doyle's "Sherlock Holmes" come to mind as examples of character names which have achieved the necessary celebrity and distinction to be protected under principles of unfair competition.¹⁶

The trademark laws, which are but a part of the broader field of the law of unfair competition,¹⁷ are likewise concerned with the protection of a name against a use which would create a likelihood of confusion, mistake or deception. That character names applied to goods or used in rendering of services are capable of protection as trademarks or service marks is well established under the Federal Trademark Act of 1946.¹⁸ Section 45 of the Act defines a "trademark" as "any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify his goods and distinguish them from those manufactured or sold by others", a definition which clearly embraces a character name used to identify the work product of an author. Furthermore, the Act specifically states that titles, *character names* and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.¹⁹ As a result, numerous character names have

¹⁶ These character names, through their immense popularity, have acquired the requisite "secondary meaning" by which the public has come to associate them with their originators. Thus, each name would be protectible against appropriation under doctrines of unfair competition so long as the author can establish that the public associates or identifies the name with him or his works. *Cf. Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943).

¹⁷ *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 413 (1916); E. VANDENBURGH, *TRADEMARK LAW AND PROCEDURE* §1.70 (2d ed. 1968).

¹⁸ 15 U.S.C. §§1051, et seq. (1970) (commonly known as the Lanham Act, 60 Stat. 427, 1946). Even rather dilute or common names can function as trademarks within the broad realm of unfair competition. In *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F. Supp. 621 (S.D.N.Y. 1958), the court held that the proprietor of a television program based on the life of Wyatt Earp could restrain the manufacturer of playsuits from marketing garments bearing the name Wyatt Earp, stating at page 625:

The 'critical question' in a case of secondary meaning 'always is whether the public is moved in any degree to buy the article because of its source and what are the features by which it distinguishes that source' . . . The defendant's use of the name created a likelihood that the public would believe, erroneously, that its playsuits were licensed or sponsored by the plaintiff, to the injury of the plaintiff's good will and to the hazard of its reputation.

¹⁹ 15 U.S.C. §1127 (1970).

been registered as trademarks and service marks, including such well known examples as "Mickey Mouse" for watches,²⁰ "Raggedy Ann" for dolls,²¹ "L'il Abner" for comic strips²² and "Zorro" for a television program.²³

Like the creation of rights in a character name, the loss of such rights is also governed by common law principles, common law trademark doctrine and the federal trademark statute.²⁴ Under common law, a character name receives protection as long as it enjoys a secondary meaning identifying it with a particular author or source.²⁵ If there has been non-use of a character name for a substantial number of years or if others have used the same or a similar name for their characters, then the name can lose its distinctiveness and will no longer be entitled to protection.²⁶ Similarly, though articulated somewhat differently, protection of a character name under common law trademark laws or the federal trademark statute endures until it has become abandoned or has lost its distinctiveness.²⁷ Abandonment is also the appropriate label where there has been non-use coupled with an intention not to use the name.²⁸ Or, if the owner of a trademark on a character name allows others to use the

²⁰ U.S. Trademark Reg. No. 309,098.

²¹ U.S. Trademark Reg. No. 837,049.

²² U.S. Trademark Reg. No. 324,549.

²³ U.S. Trademark Reg. No. 668,794.

²⁴ These are all within the broad area of unfair competition. See Note 17, *supra*.

²⁵ See *Gruelle v. Molly-E's Doll Outfitters*, 94 F.2d 172 (3d Cir. 1937); *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934); *Prouty v. National Broadcasting Co.*, 26 F. Supp. 265 (D. Mass. 1939); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934); *Paramore v. Mack Sennett, Inc.*, 9 F.2d 66 (S.D. Cal. 1925); *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133 (Ct. App.), *cert. denied*, 257 U.S. 654 (1921). *Cf.* *Feldman v. Amos and Andy*, 68 F.2d 746 (C.C.P.A. 1934); *Premier Pabst Corp. v. Elm City Brewing Co.*, 9 F. Supp. 754 (D. Conn. 1934). *But see* *Wiley v. National Broadcasting Co.*, 31 F. Supp. 568 (N.D. Cal. 1940). See generally WARNER §§232, 234.

²⁶ *Gruelle v. Molly-E's Doll Outfitters*, 94 F.2d 172 (3rd Cir. 1937). *Cf.* *Screen Test, Inc. v. American Broadcasting Co. Inc.*, 277 App. Div. 755, 97 N.Y.S. 2d (1950).

²⁷ The concept of "abandonment" contemplates a loss of standing to enforce certain property rights in a name, whereas "loss of distinctiveness" involves a loss of the property rights themselves. But, under the federal trademark statute, "abandonment" seems to include loss of distinctiveness or loss of "significance as an indication of origin". See note 28, *infra*.

²⁸ "Abandonment" is defined in §45 of the Trademark Act of 1946:

A mark shall be deemed to be "abandoned"—

(a) when its use has been discontinued with intent not to resume . . .
 (b) when any course of conduct of the registrant . . . causes the mark to lose its significance as an indication of origin.

15 U.S.C. §1127 (1970); See *Johnson v. Universal International Pictures, Inc.*, 36 Cal. 2d 116, 222 P. 2d 433 (1950).

name to identify new or different sources of the material, such as by an assignment or license in gross²⁹ or by the acquiescence in continued use by a former licensee,³⁰ such would constitute another form of abandonment or loss of distinctiveness similar to, if not identical with, the loss of distinctiveness or secondary meaning under principles of unfair competition at common law.

C. *Cartoon characterizations or visual portraits have been consistently protected under copyright doctrine, but literary characterizations have not.*

A characterization may be defined as an artistic expression or representation of a personality, as in fiction or drama.³¹ Clearly, this formulation spans the gamut from a vaguely defined character we cannot visualize to a character whose definition is so complete that we can perceive him in detail. At the one vague extreme, we would have a mere concept or idea of a person—that is, a mustachioed gunfighter, a Chinese detective or a half-naked human who lives in the jungle. An abstract or ill-defined idea, whether in the form of a characterization or otherwise, is not copyrightable.³² Yet, with the proper embellishments of physical attri-

²⁹ A mark cannot exist independently of the good will of the business with which it is associated. *Purity Cheese Co. v. Frank Ryser Co.*, 153 F.2d 88 (7th Cir. 1946); *Corr v. Oldetyme Distillers Inc.*, 118 F.2d 919 (C.C.P.A. 1941). Thus an assignment in gross may result in the loss of rights in the mark. Although the result of such an assignment has been called an "abandonment", *LaFayette Brewery, Inc. v. Rock Island Brewing Co.*, 87 F.2d 489 (C.C.P.A. 1937), it may not technically be an abandonment since there is no intent to abandon. See E. VANDENBURGH, *TRADEMARK LAW AND PROCEDURE* §8.10 at 259 (2d ed. 1968).

³⁰ Abandonment occurs where the registrant of a mark allows it to lose its distinctiveness by "acts of omission as well as commission . . ." 17 U.S.C. §1127 (1970). The failure to move against a former licensee may well be construed as an act of omission under this section and may also give rise to the equitable defense of estoppel in an action against a third-party infringer.

³¹ Webster's defines the term as "the representation of human character or personality (as in fiction or drama)." WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (unabridged ed. 1966).

³² The general, oft-stated rule is that a statutory copyright protects only the "expression" and not the underlying "idea" expressed. See, e.g., *Homes v. Hurst*, 174 U.S. 82 (1899); *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911); *Dellar v. Samuel Goldwyn, Inc.*, 150 F.2d 612 (2d Cir. 1945), *cert. denied*, 327 U.S. 790 (1946); *Gaye v. Gillis*, 167 F. Supp. 416 (D. Mass. 1958). A poorly-defined character may therefore be denied copyright protection since it is an "idea" rather than a copyrightable "expression". See *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931). Conversely, the more defined a characterization is, the more likely it is to receive copyright protection. Cf. *Archie Comic Publications, Inc., v. American News Co.*, 204 Misc. 1060, 125 N.Y.S. 2d 919 (1953), *aff'd per curiam*, 129 N.Y.S. 2d 915, 101 U.S.P.Q. 211 (App. Div. 1954).

butes, personality traits and mode of dress, these characterizations can become sufficiently specific so as to achieve copyrightable stature in the forms recognized as "Paladin",³³ "Charlie Chan"³⁴ or "Tarzan".³⁵ Where such characterizations remain vague or ineffable, however, and thus fail to rise to the degree of specificity necessary to be copyrightable, they will not be protected under any theory.³⁶

The courts have rather consistently extended statutory copyright protection to cartoon characterizations.³⁷ The visual or pictorial elements of the "Betty Boop" and "Spark Plug" characters have been found to be copyrightable and infringed by dolls and other three-dimensional visual representations.³⁸ The visual depiction of a modern Hercules in tights called "Wonderman" was held to infringe the cartoon characterization of "Superman",³⁹ again under copyright principles. In other words, the visual nature of such cartoon characters alone has raised them above the ill-defined or abstract into the realm of that which is copyrightable.

D. *Protection for literary characterizations has been principally developed under common law.*

Literary characterizations, unlike cartoon characterizations, however, have been the stepchildren of the copyright law, being protected if at all under principles of unfair competition.⁴⁰ This strange dichotomy with respect to literary as opposed to cartoon characterizations was noted by Professor Leo Kellman in a recent article:

³³ In *Columbia Broadcasting System, Inc. v. DeCosta*, 377 F.2d 315 (1st Cir. 1967), the First Circuit admitted that the "Paladin" character was copyrightable but denied relief because DeCosta had failed to copyright his character.

³⁴ Suit was filed to protect the well-known Chinese detective character "Charlie Chan" in *Eleanor Biggers Cole v. Jack Benny*, Civ. No. 4170 (S.D.N.Y. 1960), but this case was ultimately settled out of court.

³⁵ See *Edgar Rice Burroughs, Inc. v. Charlton Publications, Inc.*, 243 F. Supp. 731 (S.D.N.Y. 1965); *Edgar Rice Burroughs, Inc. v. Metro-Goldwyn-Mayer, Inc.*, 15 Cal. Rptr. 611, 130 U.S.P.Q. 245 (Cal. Super. Ct. 1961); *aff'd*, 205 Cal. App. 2d 441, 23 Cal. Rptr. 14, 135 U.S.P.Q. 40 (Cal. Dist. Ct. App. 1962).

³⁶ Just as a characterization may be denied any protection if it is too insubstantial, so will a character name be denied protection if it does not enjoy a secondary meaning. See text at notes 11-23, *supra*. Hence, a weakly-defined character whose name is without public identification would receive no protection whatsoever under the duality analysis advanced herein.

³⁷ See note 1, *supra*. *Walt Disney Productions v. The Air Pirates*, 345 F. Supp. 108 (N.D. Cal. 1972); *cf.* *Empire City Amusement Co. v. Wilton*, 134 Fed. 132 (C.C.D. Mass. 1903).

³⁸ *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276 (2d Cir. 1934) ("Betty Boop"); *King Features Syndicate, Inc. v. Fleischer*, 229 F. 533 (2d Cir. 1924) ("Spark Plug").

³⁹ *Detective Comics, Inc. v. Bruns Publications, Inc.*, 111 F.2d 432 (2d Cir. 1940).

⁴⁰ See, e.g., *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 102 F. Supp. 141 (S.D. Cal. 1951), *aff'd*, 216 F.2d 945 (9th Cir. 1954).

[C]haracters [i.e., characterizations] which partake of the nature of visual art and hence are precisely perceivable by the naked eye, enjoy the security of membership in the family of materials which are welcomed into copyright. The same good fortune has not befallen those imaginary personages who commence their tangible lives solely in text and then perhaps are transformed into living beings on stage or screen . . .⁴¹

Part of the judicial reluctance to extend copyright protection to literary characterizations stems from the rather high degree of delineation necessary for copyright in such characterizations, demanded by the standard first articulated by Judge Learned Hand in the "Abie's Irish Rose" case:⁴²

But we do not doubt that two plays may correspond in plot closely enough for infringement. How far that correspondence must go is another matter. Nor need we hold that the same may not be true as to the characters, quite independently of the "plot" proper, though, as far as we know, such a case has never arisen. 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 of the household, or a vain and foppish steward who became amorous of his mistress. These would be no more than Shakespeare's "ideas" in the play, as little capable of monopoly as Einstein's Doctrine of Relativity, or Darwin's theory of the Origin of the Species. *It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly.*⁴³

⁴¹ Kellman, *The Legal Protection of Fictional Characters*, 25 BROOKLYN L. REV. 3, 10 (1958).

⁴² *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1935).

⁴³ *Id.* at 121 (emphasis added). The difficulty of securing copyright protection on a characterization under Judge Hand's standard of copyrightability is illustrated by the case of *Burtis v. Universal Pictures, Inc.*, 40 Cal.2d 823 (Cal. Sup. Ct., 1953), wherein the Court concluded:

Although it might be possible that an author could so carefully delineate a character as to secure a protectible property interest in that character, generally it is held that a character is not included within the monopoly of copyright. Here there has been no such careful development of characterizations. Only the barest outlines have been drawn, leaving the remainder to the talents of the particular actors chosen to fill the roles. "It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly".

40 Cal.2d 823 at 835 (cases omitted).

Hence, the penalty for painting a character too indistinctly is lack of protection for the copyrightable component of the character, namely the characterization. Yet, in cases where the characterizations are not copyrightable, courts have searched for an alternative theory for protecting an author's characters. Convinced that some protection of literary characters must be afforded to prevent encroachment by others, some courts have turned to common law principles of unfair competition as the appropriate rationale for protection of these characters.⁴⁴ In the process, however, any distinction between a character name, properly protectible at common law, and a characterization protectible, if at all, only under copyright doctrine has been largely ignored if not eliminated.

The tendency to protect literary characters at common law received its greatest impetus in *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*⁴⁵ In that case, now colloquially referred to as the "Sam Spade" case, Dashiell Hammett had granted to Warner Bros. the exclusive motion picture and allied rights in his book "The Maltese Falcon" and Warner thereafter produced three motion picture versions of the story. When Hammett subsequently granted to CBS the right to produce a radio program utilizing the characters from this book, Warner sued on the grounds that its earlier agreement with Hammett had conveyed to it exclusive radio rights in such characters. Apparently reluctant to deprive Hammett of the tools of his trade, namely his characters and the right to use them in new story situations, the court declared that the assignment showed no intention of granting exclusive or so-called sequel rights⁴⁶ in these characters. Yet, not content to rest its opinion solely on the intention of the parties, the court continued by way of dictum⁴⁷ to reason that Hammett's retention of sequel rights was a consequence of the non-copyrightable status of his characters. In other words, had the characters

⁴⁴ See note 40, *supra*.

⁴⁵ 102 F. Supp. 141 (S.D. Cal. 1951), *aff'd.*, 216 F.2d 945 (9th Cir. 1954).

⁴⁶ The term "sequel rights" has been defined as "the right to use the characters from a story in new and different stories." Nimmer, *Copyright and Quasi-Copyright Protection for Characters, Titles and Phonograph Records*, 59 T.M. REP. 63 (1969). Such rights can be extremely valuable, as pointed out by Wincor in *Some Trademark Reflections Upon Dramatic Sequel Rights*, 44 T.M. REP. 1273 (1954):

No form of incorporeal property is of greater potential value to its owners than the right repeatedly to exploit, in fresh dramatic situations, a character of fiction who intrigues the public. There lies annual harvest and repeated feast.

Cf. *Edgar Rice Burroughs, Inc. v. Metro-Goldwyn-Mayer, Inc.*, 205 Cal. App.2d 441, 23 Cal. Rptr. 14, 135 U.S.P.Q. 40 (Dist. Ct. App. 1962). *Also, see* note 4, *supra*.

been copyrightable, then the grant to Warner Bros. of exclusive motion picture, television and radio rights under the copyright in the book would have included exclusive rights in all copyrightable components of the book, including the characters. By finding the "Sam Spade" character was not copyrightable, the court was able to conclude that exclusive rights in the character were thereby excluded from the grant to Warner Bros. and, hence, remained in the author, Dashiell Hammett.

As if the reasoning of the case might not have been sufficiently productive of uncertainty and mischief, the "Sam Spade" court in apparent deference to the cartoon cases⁴⁸ suggested that there could be situations where characters *would* be copyrightable:

It is conceivable that the character really constitutes the story being told, but if the character is only the chessman in the game of telling the story he is not within the area of protection afforded by the copyright.⁴⁹

In this short and somewhat unintelligible verbal formula, the court provided the seed from which massive confusion has grown. If the court had concluded instead that the characterization component of the "Sam Spade" character was uncopyrightable and hence unprotectible, it could have reached the same result upon the theory that the remaining element of the character, the name "Sam Spade", was protected under principles of unfair competition. By this device, no exclusive rights in the "Sam Spade" character would have passed to Warner Bros. More importantly, future generations would have been spared the difficulty of determining whether "the character is only the chessman in the game of telling the story".⁵⁰

E. *The judicial aftermath of the Sam Spade case.*

It is always easy to label the unwelcome judicial declaration as dictum, so that it may be ignored in subsequent cases, as might be done to mitigate the effect of the "Sam Spade" formula. Yet, subsequent cases have shown an inclination to take the "Sam Spade" case and its dictum seriously. In

⁴⁷ Some courts have treated the "Sam Spade" court's discussion of copyright protection for characters as being merely dictum. *See, e.g.,* Goodis v. United Artists Television, Inc., 425 F.2d 397 (2d Cir. 1970); Columbia Broadcasting System, Inc. v. DeCosta, 377 F.2d 315 (1st Cir. 1967). Yet, the one court which seemed compelled to follow "Sam Spade" called it "*an alternative rationale*" for the earlier decision. Walt Disney Productions, Inc. v. The Air Pirates, 345 F. Supp. 108, 111 (N.D. Cal. 1972) (original emphasis).

⁴⁸ *See* notes 1, 37-39, *supra*.

⁴⁹ 216 F.2d 945 at 950.

⁵⁰ *Id.*

Walt Disney Productions v. The Air Pirates,⁵¹ a California federal court applied the "Sam Spade" formula to determine when a character might be copyrightable and held that each Disney cartoon character "really constitutes the story being told". In this sense, Disney's cartoon character was copyrightable because it constituted the principal appeal and value of the copyrighted comic strip. In this manner, the "Sam Spade" formula of copyrightability is satisfied by the qualitative importance of the central character or characters of a work and is not concerned with the quantitative standard of delineation or specificity enunciated by Judge Hand in the "Abie's Irish Rose" case.

While the courts and textwriters⁵² were trying to analyze the meaning and application of the "Sam Spade" formula, the Supreme Court handed down two decisions, critical to a determination of whether a particular character is copyrightable or is to be left to the vagaries of common law. In *Sears, Roebuck & Co. v. Stiffel Co.*⁵³ and *Compco v. Day-Brite Lighting Inc.*⁵⁴ the court declared that works not copyrightable either under existing copyright statutes or the Federal Constitution cannot be protected under any theory of state law because of federal pre-emption in the field of copyright matters. Almost immediately the *Sears* and *Compco* mandate of federal pre-emption was invoked in a controversy affecting rights in a character. In *Columbia Broadcasting System, Inc. v. DeCosta*,⁵⁵ the Court of Appeals for the First Circuit held that the character "Paladin" was copyrightable under the federal copyright act and, therefore, that the *Sears-Compco* doctrine of federal pre-emption precluded state common law protection.⁵⁶ In reaching this result, the court found that DeCosta

⁵¹ 345 F. Supp. 108 (N.D. Cal. 1972)

⁵² See, e.g., KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 51 (1967); Nimmer, *Copyright and Quasi-Copyright Protection for Characters, Titles and Phonograph Records*, 59 T.M. REP. 63 (1969); Waldheim, *Mickey Mouse – Trademark or Copyright?*, 54 T.M. REP. 865 (1964).

⁵³ 376 U.S. 225 (1964).

⁵⁴ 376 U.S. 234 (1964).

⁵⁵ 377 F.2d 315 (1st Cir. 1967).

⁵⁶ *Id.* at 319-321. Actually, DeCosta had been permitted to try only his claim of misappropriation of common law property rights in the character "Paladin" and his remaining claim, namely that CBS' use of the "Paladin" character and the phrase "Have Gun Will Travel" constituted unfair competition, was reserved by the court on defendant's motion to dismiss. Subsequently, DeCosta was able to persuade the federal magistrate that CBS was guilty of unfair competition in the use of the name "Paladin" and the slogan "Have Gun Will Travel". See Magistrate's Opinion, April 15, 1974, in *DeCosta v. CBS Inc.*, C.A. No. 3130, reviewed in April 24, 1974 issue of *Variety*. Also, DeCosta seems to be making progress in his attempt to register the chess knight, the slogan "Have Gun Will Travel" and the words "Wire Paladin" as a service mark under the federal trademark laws. See *DeCosta v. CBS*, 182 U.S.P.Q. 169 (C.C.P.A. 1974).

passed out business cards embodying all of the essential elements of his "Paladin" character and that such business cards constituted "writings" of an author within the meaning of the Constitution and the copyright statute, stating:

"Here, plaintiff's 'performance' consisted of two components: appearing in public and passing out cards and photographs. No other 'action' was involved, except an occasional 'quick draw' demonstration at a rodeo. So far as his costume and menacing appearance were concerned, it was fully conveyed on the cards bearing his photograph—which also contained the chess piece, the slogan and the name 'Paladin' . . . The cards were unquestionable 'writings' within the meaning of the copyright clause, and arguably were copyrightable under the statute . . . Not having copyrighted the cards, the plaintiff cannot preclude others from copying them."⁵⁷

A prerequisite to statutory copyright under the Constitution is that the work or creation be a writing of an author.⁵⁸ Admittedly, DeCosta's photograph was a "writing" of an author, copyrightable under the present statute,⁵⁹ but DeCosta's business card bearing a picture of a chess knight and carrying the words "Have gun, will travel, wire Paladin, N. Court St., Cranston, Rhode Island" was not a writing within the meaning of the Constitution, since none of the elements was sufficiently substantive or creative to constitute a work of authorship.⁶⁰ For instance, each element of the card failed to be separately copyrightable—neither the name "Paladin",⁶¹ the trademark symbol of a chess knight⁶² or the slogan⁶³—and it is doubted that a combination of these items on a business

⁵⁷ 377 F.2d 315 at 321.

⁵⁸ U.S. CONST., Art. I, §8. See also 17 U.S.C. §§4 and 5 (1970).

⁵⁹ U.S.C. §5(j) (1970).

⁶⁰ See *Titles, Names, Short Phrases*, Copyright Office Circular No. 34 (Sept. 1971); *Gray v. Eskimo Pie Corp.*, 244 F. Supp. 785 (D. Del. 1965).

⁶¹ A name cannot be registered for copyright under the Regulations of the Copyright Office. 37 C.F.R. ch. II, §202.1(a); Also, see note 60.

⁶² It is well settled that a mere trademark cannot receive copyright protection. *The Trademark Cases*, 100 U.S. 82 (1879). Thus, if DeCosta's chess piece symbol qualified as a trademark it probably would not be copyrightable. Furthermore, it is doubtful that the depiction of a chess knight appearing on DeCosta's card was possessed of sufficient originality or reflected sufficient intellectual labor to be copyrightable in its own right as a "writing". See also *Titles, Names Short Phrases*, Copyright Office Circular No. 34 (Sep. 1971).

⁶³ The phrase or slogan "most personal sort of deodorant" was denied copyright protection in *Alberto-Culver Co. v. Andrea Dumon, Inc.*, 466 F.2d 705 (7th Cir. 1972), on the ground that it represented too little in the way of intellectual creation to qualify as a work of authorship. There must be a "modicum of creative work". *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104 (3rd circ. 1951). See also the Copyright Office material cited in notes 60-1 *supra*.

card made them copyrightable under the statute or the Federal Constitution or rendered them registrable for copyright under the regulations of the Copyright Office.⁶⁴ Nevertheless, the *DeCosta* decision was almost predictable once the *Sears* and *Compco* decisions largely eliminated state common law as a basis for character protection. As a result, in the post *Sears-Compco* years, the failure of a character to meet the "Sam Spade" test of copyrightability meant that it was totally unprotectible under the *Sears-Compco* pre-emption doctrine.

The more recent Supreme Court decision in *Goldstein v. California*⁶⁵ has greatly modified if not reversed *Sears* and *Compco*. In the *Goldstein* case, the Court stated:

[Petitioners] argue that Congress so occupied the field of copyright protection as to pre-empt 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) . . . *Sears* and *Compco*, on which petitioners rely, do not support their position . . .⁶⁶

In reaching this conclusion, the Court declared that all constitutional "writings" were not comprehended within the subject matter of §§ 4 and 5 of the Federal Copyright Act⁶⁷ and that there remained categories of

⁶⁴ It is submitted that the combination of uncopyrightable elements on *DeCosta*'s business cards reflected neither the "modicum of creative effort" nor work product to qualify for copyright protection. *Amsterdam v. Triangle Publications, Inc.*, 189 F.2d 104, (1951). While it is true that a combination of uncopyrightable materials may be copyrighted as a compilation under 17 U.S.C. §5(a), see cases cited in NIMMER §43 at 175.1 n.53, such a copyrightable compilation must evince a minimal degree of intellectual effort or work product in order to warrant protection. *Cf. International News Service v. Associated Press*, 248 U.S. 215 (1918).

⁶⁵ 412 U.S. 546 (1973).

⁶⁶ *Id.* at 567, 569.

⁶⁷ Section 4 of the Copyright Act, 17 U.S.C. § (1970), provides that "(t)he works for which copyright may be secured under this title shall include all the writings of an author". Section 5, 17 U.S.C. §5 (1970), after enumerating the specific categories of registrable works, provides that those categories "shall not be held to limit the subject matter of copyright as defined in Section 4 of this title." In its analysis of the effect of these two sections, the *Goldstein* Court noted:

Since §4 employs the constitutional term "writings", 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.

412 U.S. 546 at 567.

constitutionally copyrightable categories of "writings" which may be protected under state laws:

At any time Congress determines that a particular category of 'writings' 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. Since state protection would not then conflict with federal action, total relinquishment of the States' power to grant copyright protection cannot be inferred.⁶⁸

Since Congress has evidenced no intent to exclude characters from state protection, and since state protection would not necessarily conflict with the federal scheme of protection,⁶⁹ the Goldstein decision has thrown open the door to protection of characters under state common or statutory law.

As a result of the "Sam Spade" decision, therefore, the protectibility of characters involves a veritable labyrinth of decision, depending first on whether the character is protected by copyright or common law under the "Sam Spade" formula; if protected under common law, whether *Sears* and *Compco* would apply; and finally whether the pre-emptive effect of *Compco* and *Sears* is overruled in the particular situation by the *Goldstein* decision. Any rationale by which this decisional process can be simplified or eliminated would indeed be welcome. Since this process stems largely from the need to determine whether common law or copyright doctrine will be invoked, an approach which does not require such a choice would help.

⁶⁸ 412 U.S. 546 at 559 (footnote deleted).

⁶⁹ This reading of the *Goldstein* case is in accord with the interpretation given it by other commentators. See, e.g., Kaul, *And Now, State Protection of Intellectual Property?* 60 A.B.A. J. 198 (1974); Note, *Goldstein v. California and the Protection of Sound Recordings: Arming the States for Battle with the Pirates*, 31 WASH. & LEE L. REV. (1974). However, a contrary conclusion can be developed in the *Goldstein* case. Specifically, the *Goldstein* court spoke in terms of permitting the states to protect a "category" of writings left untouched by the federal statute. It would seem that characters are not a "category" of writings — but rather components of existing copyrightable works — and, hence, state law cannot be invoked to protect them without conflicting with the federal pre-emption doctrine of *Sears-Compco*.

F. *De-fanging the "Sam Spade" doctrine and the emergence of the duality approach to the protection of characters.*

Because of the continued importance of the "Sam Spade" case, a better understanding of the decision is desirable if we are to eliminate it as a judicial road-block to an improved approach to the laws affecting the protection of characters. In the words of the "Sam Spade" case, "if the character is only the chessman in the game of telling the story", it is protected at common law and if it is something more, it is presumably copyrightable.⁷⁰ One wonders on a re-reading of the case how this semantic formula evolved from the facts. Certainly, "The Maltese Falcon", the property at issue in the "Sam Spade" case, was popular because the detective Sam Spade was involved, not because it was a story of a chase or a jewelled statuette. Indeed, Warner Bros. had purchased the movie rights in the book primarily because it provided a strong central character to be played by Humphrey Bogart, and this motive became even clearer when Warner brought out two sequels to its first picture, billed and publicized around the "Sam Spade" character, but bearing virtually no similarity to the story line of "The Maltese Falcon".⁷¹ In other words, it would appear

⁷⁰ The "Sam Spade" court suggested that the "something more" which would support a copyright might be found where "the character really constitutes the story being told." *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 216 F.2d at 950. Applying this test, the *Air Pirates* court concluded that the Disney cartoon character involved in the case "constitutes the story being told" since,

the plot of the piece not only centers around the character but is quite subordinated to the character's role. The principal appeal of each of (Disney's) works to the primary audience of children for which they were intended lies with the character and nothing else.

Walt Disney Productions v. The Air Pirates, 345 F. Supp. at 113. It has been suggested that Aldous Huxley's novel "Point Counterpoint" might satisfy the "Sam Spade" court's standard for copyright protection. See Nimmer, *Copyright* 1955, 43 CAL. L. REV. 791, 794 (1955).

⁷¹ The sequels to the original 1931 motion picture photoplay entitled "The Maltese Falcon" were a 1936 feature entitled "Satan Made Me A Lady" and another entitled "The Maltese Falcon" released by Warner Bros. in 1941.

⁷² It would seem that enactment of the current Copyright Revision Bill, S. 1361, 93d Cong., 2d Sess. (1974) (as reported by the Senate Committee on the Judiciary, July 3, 1974), would help resolve some of the problems generated by the "Sam Spade" decision. Section 301(a) of the Bill provides that "all rights in the nature of copyright" are to be governed exclusively by the provisions of the Bill. However, §301(b)(3) provides that the Bill will not pre-empt state laws with respect to "breaches of contract, breaches of trust, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation", so that some form of common law protection of characters should survive the passage of a new copyright statute.

that the character "Sam Spade" was not merely a "chessman", but was really the essence of the property or, in the court's own words, "constitute[d] the story being told". Thus, the character "Sam Spade" should have been copyrightable even under the holding of that case.

Perhaps it is enough that the "Sam Spade" formula should fall because unsupported even by its own facts. Yet, if the semantic and doctrinal mischief that is the legacy of the "Sam Spade" case is to be eliminated,⁷² what is needed is a simpler approach which applies equally well to both cartoon and literary characters⁷³ and which avoids any vestige of the federal pre-emption doctrine left in the wake of the *Compco*, *Sears* and *Goldstein* cases. Fortunately, such an approach does exist as a consequence of the dual nature of a character. Under the duality approach, any lingering effect of *Sears* and *Compco*, as modified or reversed by *Goldstein*, would be eliminated since a characterization would only be protected under copyright doctrine, a criterion that would circumvent all three cases. Those characterizations too vague or ineffable to be copyrightable would not be protected at common law or under any other theory,⁷⁴ again a result consistent with these cases. Finally, protection of character names, the remaining element of the duality concept of a character, would not be governed by the *Sears* and *Compco* decisions since character names, like trademarks, are not copyrightable "writings" in either the statutory or constitutional sense.⁷⁵

On the basis of the foregoing, the amorphous question raised by the "Sam Spade" formula of determining whether a character is merely the chess piece or vehicle for the story being told would be replaced under the duality approach by the more understandable determination of whether the delineation of the characterization is sufficiently specific to be copyrightable. Of course, the comparison of two literary characterizations or verbal portraits for purposes of finding copying or copyright infringement would still remain more difficult than judicially comparing drawings of two cartoons or other visual forms of characterizations. Yet, many verbal portraits of literature are clearly deserving of protection. For example, the thin trench-coated, pipe-smoking detective of Arthur Conan Doyle's creation, whose specific virtues and eccentricities have received intensive study and attention by generations of avid readers, is more than a mere abstract and unprotectible idea and therefore should be

⁷³ See notes 37-41, *supra*.

⁷⁴ See note 32 *supra*.

⁷⁵ See notes 58-62 *supra*. See also *Howell's Copyright Law* 41-45 (4th ed. rev'd. A. Latman 1962). In the *DeCosta* case, the court rejected Plaintiff's contention that a character was not a "writing" in the constitutional sense. Perhaps he would have been more successful had he instead argued that a character *name* is not a constitutional "writing".

sufficiently delineated to be copyrightable.⁷⁶ In addition, there is no obstacle under either the copyright statute or Constitution to extending copyright protection to such a non-visual literary characterization. First, a literary characterization would qualify in a copyright⁷⁷ and a constitutional sense as a "writing" of an "author" if only because of the substantial amount of written text necessary to develop a word portrait of the character. Second, a verbal portrait if properly delineated would be a copyrightable component of the book or work⁷⁸ in which the characterization originally appeared, sufficient in substance to sustain a copyright infringement claim where the characterization alone has been copied.

G. *Testing the duality concept in practice.*

Whether the duality approach can improve upon present practice depends, in part, upon how well it answers the question whether a character in a particular situation is protected and, if so, for how long. The possible duration of protection for a character may be (1) a term of protection limited by the statutory period of copyright in the original

⁷⁶ A Canadian court seemed to disagree in *Kelly v. Cinema Houses, Ltd.*, cited in *Macgillivray*, COPYRIGHT CASES (1932) at 362, wherein it was suggested that there was no copyright protection for the characterization of an English detective like "Sherlock Holmes".

⁷⁷ Insufficiently defined characterizations would be denied copyright protection on the theory that they are "ideas" and not "expressions". See note 32 *supra*; *Nichols v. Universal Pictures Co. Inc.*, 45 F.2d 119, 121 (2d Cir. 1930). Of course, an uncopyrightable characterization could receive some measure of protection by specific agreement, such as a license, or under an implied contract or quasi-contract theory, or even under the pure "literary property" theory of protection. Cf. *Healey v. Macy & Co.*, 277 N.Y. 681, 14 N.E.2d 388 (1938); *Kurlan v. Columbia Broadcasting System, Inc.*, 40 Cal.2d 799, 256 P.2d 962 (1950). However, even under these peripheral theories of protection, the characterization must rise to at least some minimal degree of "concreteness". See generally NIMMER §173.1. Finally, it would seem that such common law forms of protection would be available only if the *Goldstein* decision is interpreted as overruling *Sears* and *Compco*. See notes 65-66 and accompanying text *supra*.

⁷⁸ 17 U.S.C. §3 (1970). This section provides in relevant part: "The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted . . ." Certainly a literary characterization which is reasonably delineated through substantial textual description should constitute a "copyrightable component" of the copyrighted literary work.

⁷⁹ Nimmer suggests that the "better view" is that "once a work containing (the) character enters the public domain, anyone may thereafter copy such character in a new work which is otherwise original with the copier." NIMMER §30 at 136. In *Rosette v. Rainbow Mfg. Corp.*, 354 F. Supp. ¶183, the court indicated that the federal scheme of protection was paramount so that even common law rights should not endure for longer than the analogous statutory term of copyright.

work in which the character appeared;⁷⁹ (2) a term measured by the life of the original author;⁸⁰ (3) a term ending with the statutory copyright protection on the last of the original series of works embodying the character;⁸¹ (4) a term measured by the statutory copyright protection on any authorized derivative work or adaptation embodying the character but created by another as licensee of the author or the author's estate;⁸² or, (5) an indeterminate or possibly perpetual term as might be accorded

⁸⁰ Under this theory, rights which an author may possess in his characters would derive from public identification of the characters with the author as the source. Hence, it follows that when the author dies, the source of works involving these characters and consequently the basis of these rights likewise becomes extinguished.

⁸¹ This approach, at least superficially, seems to recognize a property right in a character, somewhat independent of copyright or the doctrine of unfair competition. The principal justification for this approach is to prevent a dilution of value in the author's outstanding copyrighted works which otherwise would result if his characters were used by others in competitive literary and dramatic material. However, this approach has been attacked as an unwarranted attempt to extend the copyright monopoly beyond the basic fifty-six year term of copyright protection. See Note, *The Protection Afforded Literary and Cartoon Characters Through Trademark, Unfair Competition and Copyright*, 68 HARV. L. REV. 349, 359-60 (1954).

⁸² This measure of the duration of protection for characters stems from the notion that the author possesses independent property rights in his characters with the unrestricted power to convey rights in his characters either inter vivos or by will. See *Kurlan v. Columbia Broadcasting System, Inc.*, 40 Cal.2d 799, 819, 256 P.2d 962, 975 (Cal. Sup. Ct. 1953) (Carter, J., dissenting), ("Characters and characterizations which are products of the mind *should* be held to be protectible property interests"). (original emphasis).

⁸³ This has been a more popular approach, being suggested by the following language:

It is submitted that a character consisting of a name and little else . . . who has won widespread recognition, is entitled to protection from unfair competition, or by "program mark" or similar recognition, *so long as he remains in the public eye.*

Kellman, *The Legal Protection of Fictional Characters*, 25 BROOK. L. REV. 3, 17-18 (1958) (emphasis added). Yet, the scope of protection of a character name under principles of unfair competition seems even consciously to be narrowed when the copyright on the particular work or works has expired. For instance, in a case involving the "Frank Merriwell" character, the following language appears:

[A] name which has become descriptive, and is closely identified in the public mind with the work of a particular author, may not, during the life of the copyright, be used so as to mislead . . . Nor may such a name be used even after expiration of the copyright, *unless adequate explanation is given to guard against mistake.*

Patten v. Superior Talking Pictures, Inc., 8 F. Supp. 196 at 197, (S.D.N.Y. 1934). See also Notes 100-101, *infra*.

to character names under principles of unfair competition or trademark laws.⁸³

Under the duality approach, a characterization if protectible would only enjoy protection for the term of copyright on the work in which the characterization originally appeared, expiring with the copyright on such work, unless the copyright was earlier lost by abandonment or non-compliance with the copyright statute. Upon the lapse of copyright protection, the configuration or pictorial representation of a cartoon character or the verbal portrait of a literary character could be re-created, imitated or otherwise copied by anyone as long as he adopts a different character name.⁸⁴ Hence, anyone could use the characterization of a Tarzan-like character in a loin cloth living in a jungle and swinging through the trees with the same general appearance as the original Tarzan-character on which the copyright has expired. If the characterization were too ineffable or abstract to be copyrightable, then it would be merely an unprotectible idea which might be copied at any time. In any event, protection for a characterization would not extend beyond the copyright term of the work on which the characterization originally appeared as a copyrightable component, thereby avoiding dependency upon the many imponderables such as how long the author lived and whether the characterization was used in other works prepared by the author or his licensees.

Correspondingly, a character name, the other component of a character under the duality concept, would be protected either under principles of unfair competition or under the trademark laws, but for an indefinite period of time, thereby providing a certain flexibility and adaptability to those situations that might arouse the court's conscience without at the same time creating bad case law or confusion with copyright doctrine.⁸⁵ Although the duration of rights in a character name may be indefinite, such would seem preferable to the uncertainty currently attaching to protection of the character as a whole, since anyone would still be free to adopt a new name for a public domain characterization where ownership of the character name itself is in doubt. For instance, no one could use the name "Tarzan" on a jungle-man characterization as long as that name had a secondary meaning or otherwise enjoyed trademark

⁸⁴ In *Detective Comics v. Bruns Publications*, *supra* at notes 1 and 39, the defendant adopted the name "Wonderman" but copied and thereby infringed the copyright on plaintiff's "Superman" characterization.

⁸⁵ This confusion is the unfortunate by-product of the unitary concept of character-protection. In an effort to do justice in each case, the courts have indiscriminately applied the mixed bag of common law and copyright doctrines, with the resulting mishmash of doctrine illustrated by the "Sam Spade" and *Air Pirates* cases. See notes 3 and 10, *supra*.

identification with the strips and works of Edgar Rice Burroughs or his successors. Yet, if the proprietors of the "Tarzan" name were to allow the name to be used by others or if they discontinued their own use under circumstances tantamount to abandonment,⁸⁶ then the distinctiveness of the name and its identity as a source of literary or illustrative creations would be lost and anyone would be free to adopt such name for other works.

Even the court in the *DeCosta* case could have reached an equitable and more realistic result under the duality concept within the confines of the *Compco* and *Sears* decisions. For instance, the court could have recognized that the name "Paladin" and the slogan "Have gun, will travel" were not copyrightable⁸⁷ under either the statute or the Constitution and, hence, were eligible for protection under common law principles.⁸⁸ As a result, CBS would have been free to portray a mustachioed cowboy, dressed in black and otherwise attired as the original "Paladin", but once CBS adopted the name "Paladin" and the slogan "Have gun, will travel", it created the likelihood of public confusion and consequent unfair competition with DeCosta's character.⁸⁹ In this manner, the court could have been obedient to the mandate of *Compco* and *Sears*, and at the same time it could have found protectible property rights in the plaintiff.

One of the most perplexing questions in the field of character protection is what becomes of rights in a character or character name after an author's death or after the expiration of the copyrights on works embodying such character. Under principles of unfair competition, a character name is protected as long as it is identified by the public with its author-

⁸⁶ See notes 25-30 and accompanying text *supra*.

⁸⁷ See notes 60-64 and accompanying text *supra*.

⁸⁸ U.S.C. §2 (1970). This section provides:

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.

Indeed, the Supreme Court in the *Sears* case expressly removed common law copyright protection permitted by §2 of the Copyright Act from the purview of federal preemption. *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 n. 7 (1964).

⁸⁹ See notes 11-16, *supra*.

⁹⁰ Property rights in a "live character" have been held to be fully descendible to the actor's estate. *Lugosi v. Universal Pictures Co. Inc.*, 172 U.S.P.Q. 541, 38 C.O. Bull. 433 (Cal. Super. Ct. 1972). Some of the same issues of the *Lugosi* case are involved in pending litigation over the ownership of the "Laurel and Hardy" names and characters. *Lucille Hardy Price et al. v. Hal Roach Studios, Inc.*, 71 Civ. 413 (U.S.D.C. of S.D.N.Y.). *But cf.* *Supreme Records, Inc.*, 90 F. Supp. 904, 909 (S.D. Cal. 1950). Upon analogy, perhaps some property rights in a fictional character's name should similarly devolve to an author's estate.

creator. If the author dies, then it might be asked upon what theory, if any, do rights in the character name survive his death,⁹⁰ what circumstances must exist for these rights to survive and who becomes the beneficiary of such rights? In the case of a licensee of rights in a character from an author's estate, it does seem difficult to justify the survival of common law rights in a character name beyond the author's death, since the licensee would seem to be nothing less than a trespasser on the public's expectation that works embodying a character emanated directly from the original author. A similar anomaly results from the application of trademark doctrine, wherein the adoption of a character name by someone other than the author is permissible as long as such use is within the control of the author.⁹¹ Obviously, where the author is dead it is no longer possible for him to control the use of the name or provide assurance to the public that the quality and integrity of the original character has been maintained according to the author's standards. Hence, under principles of both unfair competition or trademark law, rights in a character name should lapse with the author's death, subject to certain special limitations or exceptions.

One exception to the notion that rights in a character name should lapse upon the author-creator's death is where the author was an employee for hire, in which case his employer technically would be deemed the source of the creations⁹² and the owner of the name. In such a case, it is the employer who maintains the control over new works embodying the same character name, thus assuring the public of the continuing integrity of these works. Such is the commonly accepted result in trademark fields, whether the trademarked item is a finely crafted line of copperware⁹³ or a comic strip.⁹⁴

⁹¹ See VANDENBURGH, "TRADEMARK LAW AND PROCEDURE" 2nd Ed. 1968, §7.31; 15 U.S.C. 1055.

⁹² The proposition has been generally stated as follows:

[W]here an author is employed . . . [to] . . . perform . . . literary labor in accordance with the terms of a contract with his employer, the literary property in the completed work belongs to the employer . . .

BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY*, 479-80 (1944). This principle is also recognized in the Copyright Act which provides that the term "author" includes "an employer in the case of works made for hire". 17 U.S.C. §26 (1970). This is, of course, merely a specialized application of the general law of master-servant relations.

⁹³ For example, the makers of Revere-Ware, U.S. Trademark Reg. No. 888,544, employ a great number of artisans and other workers whose collective efforts combine to create the final product. Thus, the public relies not upon the quality of work of an individual, known craftsman, but rather upon the trademark of the manufacturer generally.

Another exception would be where the author's successors, be they representatives or licensees of his estate, next-of-kin or legatees under his will, continue the use of the character name in new works after the author's death. Adrian Conan Doyle wrote new stories embodying his father's "Sherlock Holmes" characters,⁹⁴ and Ruth Plumly Thompson as licensee of Baum's estate wrote new works around the "Oz" characters of L. Frank Baum.⁹⁵ Admittedly, there is a period of time after the original author's death when the revival of his characters with the authority of his estate may confuse the public by creating the impression that the new stories emanate from the original author. Yet, if rights in such characters are to be preserved by the author's estate, it is essential that public confusion be avoided by a clear indication of the new authorship. Also, a legend on the new stories that they are based on characters created by the original author helps maintain the original source identification without misleading the public. Then, as the revival and continued use of the character names by the author's successor becomes publicly known, the names would become identified publicly with such new stories, and any technical obstacles to a valid transition or survival of rights after the author's death would largely disappear.

A third exception exists where a character has appeared in a series of the author's works. In such a case, protection of the character name should not lapse with the author's death so long as the heirs continue to exploit the works, if only because the value of the author's remaining copyrights would be substantially impaired where others are permitted to utilize his character names in new story situations after his death. Since

⁹⁴ Most comic strips have been drawn over the years by a number of cartoonists after the originator died or ceased drawing. For instance, "Tarzan", originally drawn by Edgar Rice Burroughs, was subsequently drawn by Rex Maxon, Burne Hogarth, Reuben Moreira, Jack Celardo and Dick Van Buren, among others, under employee-for-hire arrangements.

⁹⁵ Such stories were "The Adventure of Foulkes Roth", "The Adventure of the Red Widow" and "The Adventure of the Two Women". Adrian Conan Doyle also collaborated with J.D. Carr on other "Sherlock Holmes" books and television scripts.

⁹⁶ After L. Frank Baum's death in 1919, Ruth Plumly Thompson, under license from the Baum estate, continued writing "Oz" books including "The Cowardly Lion of Oz", "Oho in Oz", "Grampa in Oz", and at least ten others.

⁹⁷ The classic view of property often resolves itself into the component rights of *jus utendi* and *jus disponendi*. Having the right to exclude others does not necessarily guarantee the right of use or the right to grant such use to others. See Cohen, *Property and Sovereignty*, 13 CORNELL L. Q. 8, 12 (1927). Thus, property rights in a character name may be limited to the right to exclude others without necessarily enjoying the right to convey use to another, particularly after the author's death.

property rights in a character name are accorded to an author as a matter of public interest to avoid public confusion with another's use of the name, these rights are by their nature and creation limited property rights,⁹⁷ dependent not only upon the will of the author or his successors but also upon the circumstances and conditions by which the public's interest can best be served. However, if the author's heirs or successors fail to continue the use and exploitation of the character names, any property rights in these names should expire with the copyright protection in the last work in the original series.⁹⁸

From the foregoing analysis, the rule emerges from the dual nature of a character that protection for a characterization will expire with the copyright on the first work in which such characterization appeared, while protection for a character name will generally lapse when the author dies or when the copyright on the last work embodying the character expires, whichever shall occur last. Exceptions to this rule would and should be made for situations where the author during his lifetime, typically under an employment-for-hire contract, develops a different source or identification for his works which persists beyond his death as well as where the author's heirs continue to exploit his works after his death so as to sustain a secondary meaning in connection with the character name.

In contrast, the identity of the owner and the duration of ownership of a character under the unitary concept is unclear and often inequitable. For instance, under the unitary concept, copyright protection for a character would endure only as long as the copyright on the work in which the character first appeared. Clearly, this means that copyright protection for an author's character could expire during his lifetime. In the event of such a loss of rights, he must either abandon the use of such a character or share its use in competition with others, a rather unfair deprivation without any apparent countervailing benefit to the public.

Also, where common law principles are invoked to protect a character under the unitary approach of the "Sam Spade" formula, the survival of such rights depends upon whether they can successfully run the gauntlet of the *Compco*, *Sears* and *Goldstein* cases, and the resulting term of protection, if any, may be indefinite and the identity of the owner unclear. For instance, once we affix the label of common law property rights to a character like "Paladin", the survival of these rights depends upon whether the *Goldstein* case has overruled *Compco* and *Sears* to the extent that common law protection of a character is no longer in conflict with the

⁹⁸ Cf. *Edgar Rice Burroughs, Inc. v. Charlton Publications, Inc.*, 243 F. Supp. 731 (S.D.N.Y. 1965); *Patten v. Superior Talking Pictures*, 8 F. Supp. 196 (S.D.N.Y. 1934).

federal statutory scheme. And, if we assume that the common law rights in such a character do survive this combined test, then these rights are perpetual, and ownership of such rights after the author or creator's death may be scattered among various assignees, the author's heirs or both, with few judicial guidelines as to who is the proper licensor.⁹⁹ To the extent that the unitary approach always entails the possibility of an indefinite term of common law protection, it promotes the need for a license from the author, his estate or employer. In a sense, such a license is an insurance policy purchased out of fear of the "Sam Spade" case and the perpetual common law rights in characters thereby spawned.

Summary and Conclusions

Admittedly, the duality approach is not a panacea for solving or simplifying all of the factual determinations necessary to an analysis of the ownership and duration of protection in character names or characterizations. The practitioner must still determine whether a literary characterization has been sufficiently delineated to be copyrightable. Additionally, in some instances, he will have to determine whether an author's continued development of a somewhat ineffable characterization has become sufficiently delineated in the course of such development to be copyrightable and, if so, when the copyright protection in this characterization commenced.

Yet, the separation of a character into its components, consisting of a character name and characterization, allows these parts to be dealt with separately and more clearly under traditional doctrines without the raging confusion of the "Sam Spade", *Compco*, *Sears* and *Goldstein* cases. The surgical separation of a character name from the personality of the character, or from what herein has been referred to as the characteriza-

⁹⁹ Even if the author's heirs can be located, which often requires prodigious effort, ownership of common law rights in a character would depend upon whether the author during his lifetime, or his heirs after his death, have granted rights in the character, which in turn might require an intensive examination and technical construction of all assignments executed by the author or his heirs with respect to literary or dramatic properties embodying such character. If, as in the "Sam Spade" case, an assignment of exclusive rights in characters depends upon the intent of the parties, then the buyer may have the additional burden of acquiring, in cases of doubt, quitclaim assignments or releases from various prior licensees or assignees of the author or his heirs. In addition, where there has been a substantial lapse of time, complete documentation on prior transfers of rights in an author's characters or related properties may not be available, creating additional risks for both buyers and sellers particularly where the buyer contemplates a multi-million dollar production based on the rights acquired in such characters.

tion, also allows a simpler examination of the problems of ownership and the duration of protection of characters under well-settled concepts of copyright, trademark and common law. Under the *Souvaine*¹⁰⁰ and earlier precedents,¹⁰¹ when a work falls into the public domain, all copyrightable elements including a copyrightable characterization likewise pass into the public domain.¹⁰² To the extent that rights in a character name endure longer¹⁰³ than copyright protection in a particular work, such rights would be governed strictly under principles of unfair competition, traditionally terminating with the author's death. Only under special circumstances would rights in a character name survive the author's death, generally limited to situations where the characters have been created under an employment contract, where the characters have been continued by a licensee of the author's estate in new story situations without any interruption after the author's death or where some of the author's original works are still protected by copyright.

It is hoped that the duality approach to the protection of characters will be adopted by the courts, at least so that where it is really the character name being protected, the court will say "character name" and not "character". Perhaps also, in future cases that resemble *Detective Comics, Inc. v. Bruns Publications, Inc.*,¹⁰⁴ the court will say that it is the "characterization" rather than the character which is being protected. If so, then the case law distinctions governing the protection of cartoon and literary characters should disappear. Finally, future rapprochement with the

¹⁰⁰ *Walt Disney Productions, Inc. v. Souvaine Selective Pictures, Inc.*, 192 F.2d 856 (2d Cir. 1951).

¹⁰¹ *In re Page Co.*, 47 App. D.C. (D.C. Cir. 1917); *Atlas Mfg. Co. v. Street & Smith*, 204 F. 398 (8th Cir. 1913) (involving the "Nick Carter" detective character); *Black v. Ehrich*, 44 F. 793 (S.D.N.Y. 1891). See also the *Webster Dictionary* cases holding that copyright may not be perpetuated on any theory of trademark or unfair competition in the work involved. *Merriam v. Straus*, 136 Fed. 477 (Cir. Ct. S.D.N.Y. 1904); *Ogilvie v. Merriam Co.*, 149 Fed. 858 (Cir. Ct. D. Mass. 1907), *aff'd*, 159 Fed. 638 (1st Cir. 1908).

¹⁰² This point was more recently made in the case of *In re Cooper*, 254 F.2d 611, 616 (C.C.P.A.), *cert. denied*, 358 U.S. 840 (1958), wherein the court stated:

A book, once published, is protected against copying only if it is the subject of a valid copyright registration and then only until the registration expires, so eventually all books fall into the public domain. The right to copy which the law contemplates includes the right to call the copy by the only name it has and the title cannot be withheld on any theory of trademark right therein. As was aptly said in *In re Page Company*, 47 App. D.C. 195, when copyright in a protected work expires, "the use of the descriptive name becomes *publici juris*".

¹⁰³ See notes 90-92, 95-98 *supra*. See also note 83 and accompanying text *supra* on *Patten v. Superior Talking Pictures, Inc.*

¹⁰⁴ 28 F. Supp. 399 (S.D.N.Y. 1939), *modified*, 111 F.2d 432 (2d Cir. 1940).

“Sam Spade”, *Compro*, *Sears* and *Goldstein* cases in situations involving the protection of characters should prove unnecessary and, hence, the confusing and rather conflicting dictates of these cases can be avoided.

93. THE AUDIOVISUAL PACKAGE: HANDLE WITH CARE*

By ARNOLD J. HOLLAND**

In the United States Congress, where copyright revision has been "imminent" for more than 15 years, attention is focused on the regulation of cable television.¹ But while the debate over CATV smolders on, technology has caused another new industry to arrive on the scene, complete with its own copyright headaches. The audiovisual package,² which presents a number of thorny problems for practitioners as well as lawmakers, has been lurking on the sidelines of the entertainment world for a few years, awaiting the development of consumer-priced hardware.³ But giant companies are now preparing to launch their products into a stormy sea of differing and incompatible technology, uncertain markets, and mixed-up law. The advent of the videodisk has brought the price of hardware and software well within the consumer range. The disk, shaped and sized like a phonograph record, embodies both video and audio signals in its "grooves." Color video with stereo or quadrasonic audio should cost the consumer about the same as a simple audio disk, according to industry sources.⁴

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¹ *Cable Ruling May Pry Lid on Copyright*, Billboard, March 16, 1974, p. 1, 39.

² This particular nomenclature ("audiovisual package" or "audiovisual program") was chosen because it is the simplest and most general, covering all the technological variations, and all the practical uses. "Videocassette," the most common term in the United States, is obsolete due to the introduction of the videodisk (see n.4, *infra*). "Video package" and "TV system" are shorter, but place too much emphasis on the visual aspect. Since often the visual images may be subservient to the sounds, as in a recording of a musical performance, the complete term is more accurate. See text accompanying n.27-28, *infra*, for a discussion of the legal consequences of "video chauvinism."

³ There is already a substantial market in the industrial and educational areas. See *ITA Focus: RCA, MCA, Sony TV Bid*, Billboard, March 2, 1974, p. 30. Video system sales have been estimated at \$100 million in 1973. Approximately 50,000 to 60,000 video players and recorder/players are in the hands of U.S. users. Only from one to five percent of these are in homes. *TV Systems Key Interest; LP Best*, Billboard, January 26, 1974, p. 60; *Industry Spurs Home TV*, Billboard, February 9, 1974, p. 36.

As the expiration of the 1971 Sound Recording Amendment⁵ draws near, and pressures to pass a revision build again, it would be well to examine the current edition of the long-awaited bill to see if it has grown moldy during its protracted hibernation.

This paper will focus on the inadequacies of the way the present law and S.1361, the Revision Bill, deal with the audio-visual package, and will also discuss related problems which the audiovisual industry may encounter.

I. THE NATURE OF PROTECTION

A. The present law

1. Copyrightability and classification:

Copyright law affects the audiovisual package from two directions. Copyrighted works such as music, books, and screenplays, are used in the making of audiovisual programs; and such programs, once completed, must be themselves protected against unauthorized use. The classification of audiovisual packages has great significance on both sides, because the protection afforded by the Copyright Act varies with classification in

⁴ There are already at least seven companies with systems in various stages of development, including RCA, MCA, Philips, and Zenith. See *7th TV LP System; \$300 Unit*, Billboard, October 27, 1973, p. 46. The estimated prices for the playback units range from as low as \$300. The different systems, some of which utilize laser technology, are not all compatible, however.

The major problem—which is also a blessing to those who fear widespread piracy—with the videodisk systems is that there is no recording capability. The consumer's excitement over his forthcoming ability to record television shows and produce instant home movies will not be satisfied by videodisks, which will be pre-recorded, not re-usable, and sold in record and book stores.

Therefore, the general opinion in the industry is that there is room in the marketplace for both the disks and tape or cassette systems. The true "videophile" will spend a great deal more for his system, in the same way that audiophiles buy expensive tape decks as well as turntables. See *ITA Focus: RCA, MCA, Sony TV Bid*, Billboard, March 2, 1974, p. 30 and *No Post-Mortem Needed*, Videoplayer, August, 1973, p. 4.

Videodisk units are already being distributed to consumer markets in Germany. *German TV Systems Market Set to Boom*, Billboard, Nov. 17, 1973, p. 44. RCA is planning to market a videotape recorder/player to the consumer in early 1975 at a price of about \$800, with a camera at about \$250. MCA's Disco-Vision plans to market their laser disk playback unit to the consumer in late 1975 or early 1976 at about \$500. MCA also owns several major record labels as well as Universal Films, and has scheduled a large catalogue of software to support the introduction of the units. *ITA Focus: RCA, MCA, Sony TV Bid*, Billboard, March 2, 1974, p. 30.

⁵ Act of October 15, 1971 (85 Stat. 391), effective February 15, 1972 until January 1, 1975.

regard to the derivative use of other works as well as the utilization of the classified work.

Although there have been no court cases holding audiovisual programs other than films copyrightable, the Copyright Office has been accepting registration of videotapes since 1961.⁶ The Copyright Office Regulations now provide for it under Section 202.15(d), making videotapes registrable as motion picture photoplays (Class L) and motion pictures other than photoplays (Class M).

The basic problem in assuming copyrightability of videotape (and other audiovisual programs besides films) has been thoroughly explored in several pioneering law review articles.⁷ The question, simply stated, is whether the functional similarities of tape or disk to film motion pictures outweighs the technological similarities to phonograph records, perforated music rolls, or the like.

The problem arises from a case which is familiar to copyright students because of the patent absurdity of its decision in the light of modern-day reality: *White-Smith Music Pub. Co. v. Apollo Co.*⁸ In that case the Supreme Court held that a perforated music roll (used for player pianos) was not a "copy" of a musical composition under the Copyright Act because it was not "a written or printed record . . . in intelligible notation."⁹ The Court, used to printed sheet music, saw nothing when visually examining the music roll except a series of holes. While recognizing that a machine, in combination with the music roll, could produce "musical tones in harmonious combination," the Court was unwilling to extend the law to cover such devices.

A year later Congress, in constructing the present Copyright Act, recognized recording and mechanical reproduction rights in musical compositions for the first time (though these rights were subjected to compulsory licensing),¹⁰ but protection was withheld from "mechanical reproductions themselves" in order to avoid "a great music trust."¹¹ In holding that sound recordings were not susceptible of copyright, Judge

⁶ Colby, *An Historic "First"—Copyright Office Accepts Magnetic Video Tape for Registration*, 8 BULL. CR. SOC. 205 (1961).

⁷ See Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U. L. REV. 1081 (1955); Lloyd, "Disk-Television": *Some Recurring Copyright Problems in the Reproduction and Performance of Motion Pictures*, 34 U. OF CHI. L. REV. 686 (1967); Meyer, *TV Cassettes—A New Frontier for Pioneers and Pirates*, 19 BULL. CR. SOC. 16 (1971); and Painter, *Proprietary Rights in Video Tape*, BEVERLY HILLS BAR J., May-June 1973, p. 24. See also NIMMER ON COPYRIGHT, Section 25.3, 114-118.1 (1972) (hereinafter cited as NIMMER).

⁸ 209 U.S. 1 (1908).

⁹ *Id.* 17.

¹⁰ 17 U.S.C. §1(e) (1909).

¹¹ H.R. Rep. No. 2222, 60th Cong., 2d Sess. (1909), 8-10.

Dimock, in *Capitol Records Inc. v. Mercury Records Corp.*,¹² based his reasoning partly on the *White-Smith* doctrine. Citing the *White-Smith* decision that a "copy" must be in intelligible notation, he said:

From this it follows that it was not the intention of Congress that a virtuoso's rendition of a musical composition in the public domain could be copyrighted under the unamended Act because it provided that "No person shall be entitled to a copyright unless he shall . . . not later than the day of the publication . . . deliver at the office of the Librarian of Congress . . . two copies" of the work of which the copyright was sought. R.S. §4956, as amended by Act March 3, 1891, L. 565, §3, 26 Stat. 1107, 17 U.S.C.A. §13 note. Mechanical reproductions of such a rendition are the only possible means of duplication. The virtuoso himself could not give two performances precisely alike, yet "copies" were necessary to secure copyright and mechanical reproductions were not "copies."

The *Capitol Records* Court goes on to point out that nothing in the 1909 Act alters the *White-Smith* holding that mechanical reproductions are not "copies." Section 13 of the current Act provides that:

No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies . . . shall have been complied with.

Without the ability to sue for infringement, copyright protection does not exist, and thus, until the 1971 Amendment, sound recordings (now defined in §26 as "not including sounds accompanying a motion picture") were excluded from the protection of the Act. Motion picture film can be distinguished because the pictures recorded on the film are visually perceptible on the film itself, and film was expressly included in the Act by the Amendment of 1912.¹³

Videotape and videodisks are similar to phonograph records in that the pictures and sounds recorded therein are not visually perceptible on the tapes or disks themselves. Nimmer points out¹⁴ that, unlike piano rolls, the visual images from videotape "are visually perceptible from the

¹² 221 F.2d 657, 660 (2d Cir. 1955). See also *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 89 (2d Cir. 1940); *Jerome v. Twentieth Century Fox-Film Corp.*, 67 F. Supp. 736, 742 (S.D.N.Y. 1946), *aff'd* 165 F.2d 784 (2d Cir. 1948); and *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 Atl. 631 (1937).

¹³ Act of Aug. 24, 1912, 37 Stat. 488, c. 356.

¹⁴ NIMMER §25.3, p. 116 (1972).

reproduction fostered by the tape," but he admits that this analysis does not really meet the thrust of the *White-Smith* opinion.¹⁵

The Sound Recording Amendment does not apply to videotapes and videodisks, as §26, amended concurrently, makes clear, for Congress chose to assume in 1971 that all audiovisual packages were motion pictures, copyrightable under §§5(1) and (m) of the Copyright Act:

Under the existing title 17, "motion pictures" represent a broad genus whose fundamental characteristic is a series of related images that impart an impression of motion when shown in succession, including any sound integrally conjoined with the images. Under this concept, the physical form in which the motion picture is fixed—film, tape, discs, and so forth—is irrelevant, and the same is true whether the images reproduced in the physical object can be made out with the naked eye or require optical, electronic, or other special equipment to be perceived.¹⁶

Thus, videotapes and videodisks were pigeon-holed into the motion picture classification. If they were not motion pictures, they would not fit anywhere in §5, and would not be entitled to protection.¹⁷

But each §5 "pigeon-hole" carries with it a distinct bundle of rights.¹⁸ And a close scrutiny of the nature of the motion picture rights as compared to the needs for protection of the various types of audiovisual packages that are about to hit the market may show that the classification was arbitrary indeed. While the motion picture classification may be the best available under current law, in some ways sound recording treatment would be preferable; in other situations neither protection would be adequate.

2. *Performance rights:*

For instance, the current law appears to be quite inappropriate with

¹⁵ *Id.* at 117.

¹⁶ Sen. Rep. No. 92-72, 92d Cong., 1st Sess. 5 (1971); H.R. Rep. No. 92-487, 92d Cong., 1st Sess. 6 (1971). Although so clearly stated by both the House and Senate reports, there is nothing binding about this analysis, and a court could still conceivably hold that videotapes and videodisks are not copyrightable.

¹⁷ The prevailing view, of the courts as well as the Copyright Office, is that the "catch-all" phrase at the end of §5 ("The above specifications shall not be held to limit the subject matter of copyright as defined in section 4") is virtually meaningless, and that only such works as can be fit into one of the §5 classifications are copyrightable. See NIMMER §12.21, p. 47-49 (1972).

¹⁸ 17 U.S.C. §1. Motion pictures are not specifically mentioned in §1 because the 1912 Amendment, while changing §5 to allow for motion pictures, neglected to adjust §1. The original §1 language has therefore been applied and adapted for motion pictures by the courts and—in part—by the industry itself.

respect to performance rights. While the Act itself is not at all clear on what constitutes an infringing performance of a motion picture,¹⁹ the prevailing view is that a photoplay under §5(1), being by definition²⁰ a dramatic work, is covered by §1(d), while a non-photoplay (under §5(m)) falls under the aegis of §1(c).²¹

Thus, the copyright proprietor of an audiovisual program with enough of a plot to satisfy the "dramatic work" requirement is granted the exclusive right "to perform or represent the copyrighted work publicly." Proprietors of documentary works, however, including most educational programs, only have the exclusive right to "present the copyrighted work in public for profit." (The producer, as the one responsible for the creation of the work, would of course be the copyright proprietor.)

Motion picture producers rarely are troubled by the "for profit" limitation, since film prints generally do not leave the control of the copyright proprietor, and thus unauthorized public performance is rare. Income from the making of a motion picture comes traditionally from the theatrical exhibition of leased copies of the film, although there does exist a small retail market for 16mm prints. The new producer of audiovisual programs on disks or tape, however, is selling copies of his work to the public. It has been previously noted²² that most of the programs on the market today are aimed at the educational and institutional area, and thus

¹⁹ See n. 18. See also NIMMER §109.13, pp. 437-440.

²⁰ Copyright Office Regulation §202.15 defines "photoplays" as "motion pictures that are dramatic in character and tell a connected story, such as feature films, filmed television plays, short subjects and animated cartoons having a plot."

²¹ Section 1(c) only applies if such motion pictures are considered "literary works." There is no definition of this term in the Act, but the language of §1(c) would suggest a broad interpretation. The phrase "other nondramatic literary works" implies that lectures, sermons, and addresses are such works, and thus a nondramatic motion picture, as an illustrated "lecture" or "address," would seem to be included. NIMMER §109.13, p. 440. But see *Fleischer v. Freulich*, 73 F.2d 276 (2d Cir. 1934), and *Basevi v. Edward O'Toole Co.*, 26 F. Supp. 41 (S.D.N.Y. 1939).

According to *Patterson v. Century Productions, Inc.*, 93 F.2d 489 (2d Cir. 1937), the projection of a motion picture on a screen is itself a "copy," though evanescent, and therefore anyone exhibiting a motion picture without license is violating the exclusive right to copy. This reasoning, if applied to all audiovisual works, would protect even documentaries from all unauthorized exhibition. But while this case has never been expressly overruled, its doctrine is not really good law. The intangibility and evanescence of such a "copy" would certainly not permit deposit in the Copyright Office. See NIMMER §101.4. See also *Mura v. Columbia Broadcasting System, Inc.*, 245 F. Supp. 587 (S.D.N.Y. 1965); *Metro-Goldwyn Mayer Distr. Corp. v. Wyatt*, 21 C.O. Bull. 203 (D.C. Md. 1932); *Tiffany Productions Inc. v. Dewing*, 50 F.2d 911 (D.C. Md. 1932).

²² See n. 3.

few of these programs would be considered dramatic. Producers of these programs have already encountered problems stemming from their inability to prevent owners of programs from exhibiting them in a "non-profit" manner.²³

One such problem arises from the fact that in dealing with writers, actors, and directors, most producers must pay Guild-approved minimum compensation according to whether the program is intended for theatrical distribution, television distribution, or distribution in "Supplemental Markets."²⁴ A producer intending to release his product in supplemental markets would have to pay extra if the program were to be broadcast or if it were to be theatrically exhibited. Yet even if the producer desists from licensing his program for theatrical or broadcast use, purchasers of copies of the program can freely exhibit it, as long as it is not "for profit." This leaves the producer in a very vulnerable position with regard to the guilds.

Also, such not-for-profit exhibition can cut deeply into the producer's market. A distributor who makes his bread and butter selling programs to schools and school districts is severely hurt when an educational television station or network broadcasts his product. Educational television is non-profit, and may broadcast non-photoplays with impunity once the station obtains a copy of the program. There is certainly no infringement in turning on television receivers in classrooms.²⁵

The problem is worsened by the ease with which such programs can

²³ Industry sources.

²⁴ "Supplemental Markets" is defined by Article 51(2) of the 1973 *Writers Guild of America Theatrical & Television Basic Agreement* (hereinafter cited as the *WGA Agreement*) as the "sale or rental" of "any audio-visual device, including without limitation, cassette, cartridge, phonogram or other similar audio-visual device now known or hereafter devised, containing a motion picture (recorded on film, disc, tapes or other material) and designed for replay through a television receiver or comparable device . . . in the home or in closed-circuit use such as in hotel rooms." Also included are "pay-type CATV", "pay television", and exhibition on commercial airlines, trains, ships, and buses ("in-flight"). Section 20 of the 1971 *Screen Actors Guild Television Agreement* (hereinafter cited as the *SAG Television Agreement*) and Section 5(B) of the 1971 *Supplement to the Producer-Screen Actors Guild Codified Basic Agreement of 1967* (hereinafter cited as the *SAG Theatrical Agreement*) contain almost identical language, except that "in-flight" use is excluded for theatrical motion pictures (though not for pictures designed for television). All three agreements are mostly concerned with supplemental markets use of motion pictures originally produced for television or theatrical exhibition. The *SAG Theatrical Agreement* provides in Section 8 that the producer must negotiate specially with SAG if he intends to produce a program intended "primarily" for supplemental markets. See text accompanying n. 145-158, *infra*.

²⁵ *Fortnightly Corp. v. United Artists Television, Inc.*, 392 U.S. 390 (1968).

be copied off the air. While such copying by school systems is almost certainly an infringement,²⁶ industry sources indicate that it is rampant. Policing off-the-air piracy is almost impossible, and many companies are reluctant to sue schools and school systems for fear of bad publicity.

3. *The use of music:*

A very different problem with the classification of all audiovisual packages as motion pictures involves the use of music on such programs. The motion picture soundtrack has always been the handmaiden of the visual images. Music on a soundtrack is usually "background," and when it is more it has still been subservient to the plot or point of the movie.

Imagine, however, an audiovisual disk (or tape or cassette), looking a great deal like a modern phonorecord, distributed in record stores by record companies, embodying a purely musical performance. There is little need to imagine, though, for such products will soon be ready for mass distribution.²⁷ Indeed, music programs are expected by many in the industry to become the most popular class of works in the new medium. The increasingly theatrical nature of popular music combined with the multiple playability of musical works augurs well for a very significant market.²⁸

The visual aspect of such purely musical performances will be subservient to the audio, for the visual is simply an addition to make the music more exciting and more commercially viable. This is vision in conjunction with sound, which is not the same as sound in conjunction with vision. This type of audiovisual package is much more similar to a sound recording than a motion picture in its artistic mien as well as its technological functioning, and thus the functional analysis which classified the entire medium "motion pictures" fails.

It is doubtful, though, that a court would ignore the visuals and declare such musical performances to be "sound recordings" under §1(f), especially in light of §26 of the Copyright Act, which defines "sound recordings" as specifically excluding "sounds accompanying a motion

²⁶ See text accompanying n. 84-102, *infra*.

²⁷ See n. 4.

²⁸ Russ Regan, president of 20th Century Records, was quoted recently as saying "I think the video disk system will emerge as the big thing in our industry. . . . The great thing about the video disk is that you can get *off* on it whether you're watching it or not. It'll be mostly music, right. But it isn't as if you'll have to sit there glued to your TV set. . . . After all, you've *seen* the visual part of the disk and you may see it again later . . . but the audio is there to enjoy over and over again even if you don't have time to go sit by the TV. And there's another good thing about the laser-disk . . . the lasting quality of the disk is much longer than with just a needle. I can hardly wait for the video disk." *Regan Predicting Smooth Sailing & Visual Expansion*, *Billboard*, February 23, 1974, p. 40.

picture." Unless Congress acts, such programs will most likely be considered motion pictures, and will be treated as such in terms of protection.

a. *Compulsory licensing and the motion picture soundtrack:*

The most obvious anomaly in this classification is that the §1(e) compulsory license will not apply, because the music will be considered a motion picture soundtrack. Once the proprietor of a copyrighted musical composition permits or knowingly acquiesces in the mechanical reproduction of the composition, the compulsory license allows any other person to "make similar use of the copyrighted work upon the payment to the copyright proprietor of 2 cents" for each reproduction manufactured.²⁹ This provision is deemed by most scholars not to apply to motion picture soundtracks, and the motion picture industry has never relied upon it, although there have been no cases ruling squarely on the subject and the statutory language is far from explicit.³⁰

The soundtrack is considered an "integral part" of the motion picture film.³¹ According to Nimmer, §1(b) provides for an exclusive right to "convert a copyrighted work into motion picture form;" and thus the proprietor of a musical copyright has an exclusive right under §1(b) to convert a musical composition into sound track form.³² His alternative analysis is that "the sound track portion of a film as an integrated part thereof is itself a 'copy' of the material recorded, and hence the unauthorized use of music in a sound track constitutes an infringement of the right to copy."³³

The first argument would seem to read §1(b) rather broadly, since the right to make "other version(s)" applies only to "literary works."³⁴ The exclusive right granted to a copyright proprietor of a musical work under §1(b) is "to arrange or adapt it." To read "adapt" as referring to recording on a musical soundtrack would also require reading it as referring to

²⁹ 17 U.S.C. §1(e).

³⁰ See NIMMER §25.2, p. 111-114; §109.14, p. 441-442.2 (1972). But see Dubin, *Copyright Aspects of Sound Recordings*, 26 SO. CAL. L. REV. 139 (1953). The "similar use" language might prevent compulsory motion picture use of a musical composition first done only on a sound recording, and *vice versa*. But after a first use in any medium, the "similar use" phrase would not prohibit compulsory use on other works in that medium.

³¹ Sen. Rep. No. 92-72, 92nd Cong., 1st Sess. 5 (1971); H.R. Rep. No. 92-487, 92nd Cong., 1st Sess. 6 (1971). See also *L.C. Page v. Fox Film Corp.*, 83 F.2d 196, 199 (2d Cir. 1936).

³² NIMMER §109.14, p. 442.1 (1972).

³³ *Id.*

³⁴ See n.21. While "literary works" is usually broadly construed, it is hard to see how instrumental music could be considered a literary work, especially since §1(b) mentions "musical work(s)" apart from literary works.

recording on a phonorecord, which would place §1(b) in direct contradiction to §1(e), which expressly rules out such an exclusive recording right.

Nimmer's second argument, based on the §1(a) right to copy, is also not impenetrable. While it has been held that a motion picture is a "copy" of the work upon which it is based,³⁵ it would be logical for the *White-Smith* doctrine to apply to the soundtrack, since it is hardly "a written or printed record . . . in intelligible notation."³⁶ On videotape or videodisk, nothing at all would be "intelligible." Even if the soundtrack were held to be a "copy" or an integrated part of a copy, §1(e) may be explicit enough in its terms to be said to modify the exclusive right to copy.

Nimmer also points out³⁷ that the compulsory license only applies when the copyright proprietor has permitted the use of the musical work "upon the parts of instruments serving to reproduce mechanically the musical work."³⁸ He goes on to say:

If a motion picture soundtrack is regarded as an integral part of a motion picture work, then (unlike a phonograph record) it cannot be regarded as a part of an instrument, that mechanically reproduces a work but is rather a part of the work itself. Therefore the necessary condition to the invoking of the compulsory license provision does not occur by reason of a musical composition appearing on a sound track.³⁹

It is difficult to understand, no matter how integrated a motion picture and its soundtrack may be, how a soundtrack could be considered "part" of the underlying musical work. The fact that it is part of the motion picture work is irrelevant, since the sound cannot be heard or "reproduced" without running the film (or disk or tape) through a machine, an amplifier, and speakers. While one may be able to see images when looking at a strip of film directly, one cannot hear music. The entire film

³⁵ *Universal Pictures Co. Inc. v. Harold Lloyd Corp.*, 162 F.2d 354 (9th Cir. 1947).

³⁶ *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908). Nimmer does not ignore this problem, but declares that the rule would be inapplicable because the anti-monopoly rationale behind the legislative adoption of the *White-Smith* doctrine would not apply to motion pictures. He also mentions the possibility that the 1912 Amendment of §5 adding motion pictures as copyrightable works may have "tacitly modified" the rule. See text accompanying n. 44-73, *infra*, for further discussion of the rationales behind compulsory licensing. If the anti-monopoly rationale is at all valid today there is no reason to assume it would be less valid with respect to videodisks than to phonorecords.

³⁷ NIMMER §25.2, p. 113 (1972).

³⁸ 17 U.S.C. §1(e).

³⁹ NIMMER, §25.2, p. 113 (1972).

(or disk or tape) is thus a "part" of an "instrument" serving to reproduce mechanically the musical work.

It would appear that the most cogent reason for not allowing the compulsory license to apply to sound tracks is not based on statutory language, but on the fact that such application would be grossly unfair to proprietors of musical copyrights.

In *Jerome v. Twentieth-Century Fox Film Corp.*,⁴⁰ the New York District Court stated in dictum:

If §1(e) applied to a motion picture use of a musical composition, then any producer could appropriate a copyrighted musical composition for use in a motion picture for a total sum of about \$10.00, at the rate of 2¢ for each positive print. . . . The sound on film is not the type of "mechanical reproduction" to which §1(e) of the Copyright Act applies.

Since motion pictures are not presently distributed at retail, a limited number of prints are manufactured. It is only fair that the producer obtain a "synchronization" license for the right to use a musical composition in his film, since he can profit a great deal from such limited reproduction.

It should be noted, however, that the "synchronization" right is separate from the right to perform the composition in public for profit.⁴¹ In fact until 1948, the performing rights societies (such as the American Society of Composers, Authors and Publishers (ASCAP)) sold blanket licenses to motion picture theatres, and film producers could only exhibit their films (containing copyrighted music belonging to members of such societies) in theatres covered by such licenses. The decision of a New York District Court in *Alden-Rochelle v. ASCAP*⁴² changed that practice, forcing motion picture producers to purchase the performing rights at the same time the synchronization rights are obtained, and forbidding the performing rights societies, on antitrust grounds, from selling licenses to theatres. Thus, when a motion picture producer obtains the right to use a musical composition from the copyright proprietor or from the Harry

⁴⁰ 67 F. Supp. 736, 741 (S.D.N.Y. 1946). *But see* *Famous Music Corp. v. Melz*, 28 F. Supp. 767 (W.D. La. 1939).

⁴¹ 17 U.S.C. §1(e).

⁴² 80 F. Supp. 888 (S.D.N.Y. 1948).

⁴³ Industry sources reveal that current contracts for the fixation of musical compositions on videotape (with educational and institutional programs) for sale and rental are an interesting cross between a synchronization license and a mechanical reproduction license, most often providing for payment based on number of copies manufactured or on gross income derived therefrom. Since some of these programs are rented rather than sold, the gross income method is preferable, at least with respect to the rentals.

Fox office (the copyright owner's agent for this purpose), a component of his cost is the right to perform the composition in theatres via the motion picture.

The new market for audiovisual packages is not based on theatrical exhibition, however. Consider the musical performance videodisk (or tape) discussed *supra*. Distributed in the same manner as sound recordings, the compensation to the proprietor of the musical copyright should logically be based on the number of copies manufactured.⁴³ Thus this kind of program would be susceptible to compulsory licensing. Also, the application of such a system might prove highly beneficial to composers, music publishers, producers, record companies, and the public.

b. *Compulsory licensing; the historical trend:*

Since legislative action would almost certainly be necessary to apply any kind of compulsory license to audiovisual programs, an examination of the desirability of such a move need not be limited to consideration of the present 2-cent rate. The 1909 provision has been under attack since its inception.⁴⁴ Proposals for amendment include raising the compulsory rate, transforming the rate into a percentage of retail or wholesale price,⁴⁵ pegging the license in each case at the rate for which the first recording of the composition was bargained,⁴⁶ and embodying a delay in the operation of the compulsory license to protect performer-songwriters and small record companies against cutthroat "covering."⁴⁷

⁴⁴ Henn, *The Compulsory License Provision of the U.S. Copyright Law*, Copyright Revision Study No. 5, Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary, 86th Cong., 1st Sess. (Comm. Print 1960) (hereinafter cited as HENN).

⁴⁵ *Id.* at 55.

⁴⁶ *Id.*

⁴⁷ Blaisdell, *The Economic Aspects of the Compulsory License*, Copyright Revision Study No. 6, Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary, 86th Cong., 1st Sess. (Comm. Print 1960) (hereinafter cited as BLAISDELL), p. 91. "Covering" is the act of utilizing the compulsory license or a negotiated license to produce another recording of the musical composition (by a different performer) after a first recording is released. This can be done in a matter of hours. In this manner, a large record company, with a top-name performer and a large promotion budget, can steal the market away from the person who first recorded the composition. The delay suggestion would force the would-be coverer to wait, for instance, three months, and would allow the initial recording to fly or fall on its own. The situation today is not as competitive in this way as it was at the time the Blaisdell study was written, when it was not uncommon for ten versions of the same popular song to be on the "charts" at once. Probably the increase in the volume of product, and especially of performers who compose their own material, is responsible for the smaller incidence of predatory practices. The problem is still extant, though, and the waiting period suggestion should still be considered.

The entire concept of compulsory licensing, however, has been a major source of controversy since the first copyright bill embodying the idea was introduced in the House of Representatives on May 4, 1908.⁴⁸ Congress wanted to grant mechanical reproduction rights to musical copyright proprietors, but fears were expressed that this would result in monopolization of the industry by the Aeolian Co., which was the leading mechanical reproducer (piano rolls) of the day.⁴⁹ While it has been asserted that such fears were greatly exaggerated,⁵⁰ it is true that Aeolian had made contracts with more than 80 of the leading music publishing companies for the exclusive rights for mechanical reproduction of all the music controlled or acquired in the future by the publishing houses. These rights covered a period of at least 35 years, with the possibility of almost indefinite extension, and would take effect upon the granting of mechanical reproduction rights by Congress or the courts. Consideration was Aeolian's taking of the *White-Smith* case to the Supreme Court.⁵¹ The compulsory license of 2 cents⁵² was a compromise to placate not only those who feared monopoly, but also those who felt that exclusive mechanical reproduction rights would be a burden on the music-loving people of the country.⁵³

In 1925 and 1926, bills were introduced in Congress to eliminate the

⁴⁸ HENN at 5.

⁴⁹ *Id.* at 11.

⁵⁰ *Id.*

⁵¹ H.R. Rep. No. 2222, 60th Cong., 2d Sess. (1909), p. 7-8.

⁵² The 2-cent flat royalty was then considered the equivalent of five percent of the manufacturer's price. HENN at 10.

⁵³ HENN at 5.

⁵⁴ Such bills have also been introduced sporadically since then, and the recommendation was renewed by several observers in the 1960 Revision Studies. HENN at 21-35. See *Comments and Views on the Henn Study*, p. 59-85, and on the Blaisdell study, p. 115-125.

⁵⁵ HENN at 22-23.

⁵⁶ *Id.* See also Hearings on S.2328 and H.R. 10353, 69th Cong., 1st Sess., p. 314, 329; Hearings on H.R. 10434, 69th Cong., 1st Sess., p. 261.

⁵⁷ U.S. Const. Art. I, §8. Mr. Burkan suggested that the reason why the provision had not been attacked in the courts was that if it were declared unconstitutional, the entire Act would fail and authors would lose all protection. He also noted the economic power of mechanical reproducers to boycott anyone who brought suit. Hearings on S.2328 and H.R. 10353, 69th Cong., 1st Sess., p. 314. See also Fenning, *Copyright Before the Constitution*, 17 J. PAT. OFF. SOC'Y 379, 385 (1935); Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 GEO. L.J. 109, 116-117 (1929); Evans, *The Law of Copyright and the Right of Mechanical Reproduction of Musical Compositions*, THIRD COPYRIGHT LAW SYMPOSIUM 113, at p. 148-150 (1940); Joiner, *Analysis, Criticism, Comparison and Suggested Corrections of the Copyright Law of the United States Relative to Mechanical Reproduction of Music*, SECOND COPYRIGHT SYMPOSIUM 43, at p. 66-67 (1940).

compulsory license provision.⁵⁴ Also proposed were bills to extend compulsory licensing to performance rights of musical compositions.⁵⁵ Elimination bills were heavily supported by ASCAP and other composer and publisher interests. Nathan Burkan, ASCAP co-founder and attorney, attacked the constitutionality of the compulsory license⁵⁶ as being beyond the Constitutional grant of power to Congress to grant to authors the "exclusive Right to their respective Writings,"⁵⁷ arguing that the compulsory license system is the antithesis of exclusive rights. ASCAP also asserted that by fixing the license price, Congress was appropriating private property (the copyright) without just compensation.⁵⁸ Burkan attacked the extension bills as "vicious and paternalistic price-fixing measures," intended "for the private benefit of a powerful group."⁵⁹ The bills to extend compulsory licensing failed, but so did the bills to eliminate it.

The controversy continued however. Composer interests opposed compulsory licensing because it restricts their bargaining power, and because it enables unscrupulous, financially irresponsible record manufacturers to use their works. Record companies and piano roll manufacturers insisted on their need to have complete access to all music, at "reasonable" royalty rates.⁶⁰

In the 1960 Revision Studies, the issues were trundled out again by a number of eminent copyright attorneys. Herman Finkelstein asserted that elimination of the compulsory license would encourage competition in the record industry by allowing manufacturers to obtain exclusive rights and forcing others to work on different compositions.⁶¹ Irwin Karp and John Schulman agreed, pointing out that the license has actually concentrated economic power by allowing the major record companies, with prominent performers and large advertising budgets, to preempt the market for a composition.⁶² Ralph S. Peer termed the system "un-American and not democratic," "monstrous," and a "crime committed against one of our supposedly creative industries."⁶³ George E. Frost,⁶⁴ Cedric W. Porter,⁶⁵ and Sidney W. Wattenberg⁶⁶ were opposed on essentially philosophical grounds, and thought the fears of monopoly greatly exaggerated, saying that the antitrust laws could protect against any real danger.

⁵⁸ U.S. Const., Amendment 5.

⁵⁹ Hearings on S.2328 and H.R. 10353, 69th Cong., 1st Sess., p. 371 (1926).

⁶⁰ HENN at 35.

⁶¹ *Comments and Views*, COPYRIGHT REVISION STUDY NO. 5, p. 63 (1960).

⁶² *Id.* at 71-73.

⁶³ *Id.* at 82-84.

⁶⁴ *Id.* at 67.

⁶⁵ *Id.* at 69.

⁶⁶ *Id.* at 76.

Joseph S. Dubin, however, thought the antitrust fears real enough, and asserted that the elimination of compulsory licensing "might give rise to the creation of a monopolistic monster."⁶⁷ Edward A. Sargoy, while inclined against compulsory licensing, noted several ways of amending the provision to make it more equitable and eliminate many of the problems—for instance allowing exclusive licensing for "a limited period of 6 months, a year, or two, or more, with full accessibility thereafter to other manufacturers." He also suggested the posting of security for royalty payments by would-be compulsory licensees, to counter the "irresponsible manufacturer" problem.⁶⁸ Sydney M. Kaye favored retention of the system because exclusive licensing would redound to the benefit of a few of the larger record companies and some of the leading composers, and a composition, once unsuccessfully recorded and released, could be lost forever to the public.⁶⁹ Benjamin Kaplan, while making no recommendation, was "disposed to measure composers' rights in the light of the public interest."⁷⁰ Joseph A. McDonald and George Link⁷¹ favored retention. Ernest S. Meyers praised the system as having "benefited handsomely" the public, the record companies, and publishers and composers as well. Meyers cited the huge growth of the record industry, the comparatively low prices of records, the high royalties for publishers and composers, and the lack of monopoly in the industry.⁷²

This patchwork quilt of criticism and praise is confusing, but the net result so far has been the retention of compulsory licensing. The criticisms would be much blunted if the suggestions for improving the system were adopted, and this author places himself on the side of retention, especially if the waiting period and percentage rate ideas were to be incorporated.

According to the 1966 House Report on the Revision Bill, the forces for elimination of the compulsory license had by then shifted their goal: "the real issue was not whether to retain the compulsory license but how much the royalty rate under it should be."⁷³ While music publishers testified that they would prefer outright repeal, according to the Report, "they would be willing to accept a compromise as long as the copyright owner's situation is improved."⁷⁴

⁶⁷ *Id.* at 64.

⁶⁸ *Id.* at 65-67.

⁶⁹ *Id.* at 70-71.

⁷⁰ *Id.* at 73-74.

⁷¹ *Id.* at 75-76.

⁷² *Id.* at 77-81.

⁷³ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966) p. 95.

⁷⁴ *Id.* at 96.

As can be gleaned from the House Report and from the present Revision Bill,⁷⁵ Congress is firm in its intention to retain the compulsory license system. It is therefore worth investigating whether the reasons behind that retention would hold true for extension of the system to cover some—or all—audiovisual programs. The issues are clearest with regard to the purely musical performance, discussed *supra*.

c. *Compulsory licensing and the audiovisual package:*

Under the present law, absent compulsory licensing, a producer of audiovisual works has to negotiate for every composition he uses, and a song recorded for the first time on an audiovisual program could not be recorded by anyone else in any medium without obtaining permission from the copyright proprietor (usually the music publisher). This might act as a drag on the exploitation of the work, for the publisher may have reasons for not wanting to deal, and producers may not be able to find the proprietor within the time available for making recording decisions. The artist who experiments in the studio for the right sounds and songs may simply not bother attempting to work with a tune he may be unable to record. A composer or publisher who is known to hold out for high royalties may discourage possible licensees from even approaching him. Certain performing artists who record their own material may be unwilling to allow anyone else to record it at any reasonable price. Record companies would try to save money by using cheaper material. They would also be able to use their heavy advantage in bargaining power to secure exclusive licenses, and thus “lock-in” many compositions which might otherwise have been successfully utilized by other companies.

If audiovisual users of copyrighted music could, however, invoke the compulsory license provision, at least with regard to the pure musical performances, a new industry will be able to grow faster, stronger, and more competitively. The public would receive more versions of their favorite compositions, and possibly at a lower price. High-quality compositions would not be “lost,” due to some third-rate performer or acquisitive record company having an exclusive license. The producer would have the certain knowledge and confidence that he could record any song that suits his artist, a matching task which is often difficult. The artist would feel free to add any song he likes to his repertoire. The composer, while lacking the power to grant exclusive licenses, would probably be better off, since he would receive royalties from every user of his composition. Likewise, the music publisher, whose income parallels the composer’s,

⁷⁵ S.1361 §115 retains the system with a slight increase in the rate. See text accompanying n. 116-126, *infra*.

would be aided. The record company would be free to concentrate on quality, without having to cut costs by using weaker material. As the industry grows, there would be more work for musicians, and everyone else in the industry. The transition from audio to audiovisual home music entertainment would be made smoother, with less confusion.

It is less clear whether compulsory licensing should apply to all audiovisual packages intended for retail sale. It might be argued that the program producer should pay a premium to combine music with a dramatic work or with any work in which the music is not the central focus. But while the parallel to sound recordings is not as blatant, most of the considerations in favor of applying the compulsory license to pure music programs remain valid with regard to all audiovisual works, (e.g., dramatic plays), as long as they are distributed at retail, and not intended for theatrical exhibition. While the composer or publisher would lose some freedom to negotiate, he would probably benefit in the long run from increased use of his composition. The public would receive better fare, and the producer would be able to make a more creatively consistent product. It would also be a great boon to a fledgling industry.

d. *Performance rights to music on audiovisual programs:*

If a producer of an audiovisual program embodying music obtained through compulsory licensing wanted to exhibit the program theatrically, at that point he would still have to purchase performing rights from the copyright proprietor or his agent. In negotiating a price, the proprietor could demand as much as or more than is given for today's combination performance-synchronization right.⁷⁶

Under the present law, producers of sound recordings have *no rights* in the performance of their programs,⁷⁷ while producers of motion pictures do have such rights.⁷⁸ Thus producers of audiovisual musical performances also have such rights, and if such a program were exhibited on (for-profit) television, for instance, permission from the producer would have to be obtained. If the producer, by the herein proposed compulsory license or by direct negotiations, only obtains the reproduction rights, and does not obtain performance rights from the composer, both composer and producer would have to give permission for broadcast.

The day may come when both the producer and the composer jointly assign their performance rights to a performance rights organization, which will proceed to license television broadcasts of audiovisual musical

⁷⁶ See text accompanying n. 41-42, *supra*.

⁷⁷ 17 U.S.C. §1(f). The only people who receive royalties from the performance of sound recordings are the composer and music publisher.

⁷⁸ See text accompanying n. 19-21, *supra*.

performances in the same manner in which radio broadcasts are licensed today. The advent of television programs consisting of audiovisual records of musical performances, perhaps complete with "disk jockey," is not unlikely, especially considering the multi-channel capability of cable television, and the recent popularity of popular music "concerts" on television. Such television exposure could become the chief promotion tool of the audiovisual record company.⁷⁹

e. *The juke-box exemption:*

Another promotion and marketing tool of the sound recording is the coin-operated playback machine (juke-box). The present law exempts "the reproduction or rendition of a musical composition by or upon coin-operated machines" from performance fees, unless admission is charged to the place where the performance takes place.⁸⁰ According to the letter of the law, this provision would seem to apply to audiovisual juke-boxes as well. Thus royalties would probably not have to be paid to composers and publishers. But whether the producer is entitled to royalties is an interesting question, and not readily answerable. Since the program is a "motion picture other than a photoplay" the producer has the right to payment for public performances of the work for profit.⁸¹ Section 1(e) provides that the "reproduction or rendition of a musical composition" on a juke-box "shall not be deemed a public performance for profit."⁸² It does not speak of the performance of a motion picture. Therefore, it might seem that the visual part of the program is being performed for profit, while the audio is not. But the "soundtrack" is an integral part of the visuals, or *vice versa*, and the sum result, assuming a purely musical performance, is still a rendition of a musical composition, so the exemption would seemingly apply to the entire work. It would be stretching the already attenuated analysis very thin to attempt to apply the exemption to works other than pure musical performances, though. It is conceivable that such works as photoplays, comedy or art⁸³ embodied on

⁷⁹ See *TV Special Spurs Zayre Disk Sales*, *Billboard*, January 19, 1974, p. 1, 37, in which it is reported that one particular rock music television special boosted record sales in one chain of stores as much as 400 percent. The lowest reported boost in sales from that single show was 60 percent.

⁸⁰ 17 U.S.C. §1(e).

⁸¹ See text accompanying n. 19-21, *supra*.

⁸² 17 U.S.C. §1(e).

⁸³ Audiovisual art on videotape has already been experimented with. It should come as no surprise that "painting" abstract patterns of light (and sound) with electrical impulses could be as valid an art-form as doing it with a paintbrush. Rose, *Switch-On-Art*, *NEW YORK* magazine, Dec. 20, 1971, p. 87. As a "motion picture," such works are protected against public performance for profit. If classified "works of art" under §5(g), however, there would be no performance protection at all. See NIMMER §107.1, p. 398-399 (1972).

videodisk (or tape) could become popular in coin-operated machines in bars, train stations, airports and "porn-parlors". But the juke-box exemption clearly would not apply. Such an exemption would help a new juke-box industry grow, but at the expense of the rights of copyright proprietors, who by any standard of fairness, deserve a portion of the proceeds.

4. *Fair use:*

Widespread distribution of audiovisual recording machines will greatly multiply the incidence of copyright infringement by unauthorized duplication. The 1909 Copyright Act grants to the proprietor of any copyright the exclusive right to "copy" his work.⁸⁴ But according to the *White-Smith* doctrine, a videotape or videodisk would not be a "copy" since it is not in "intelligible notation."⁸⁵ Even if a modern court were to adopt this doctrine, however, it would not open the door for unlimited piracy of audiovisual programs and television broadcasts, because of the provisions of §§1(c) and 1(d) of the Act, which provide an exclusive right to "make a transcription or record" of the copyrighted works covered by those sections. Since all audiovisual programs, as "motion pictures", and most television broadcasts fall under one or the other of these provisions, it is clear that unauthorized duplication constitutes infringement under the Act.⁸⁶

However, the exclusive right to copy or record a copyrighted work, including audiovisual packages, is modified by the court-made doctrine of fair use, which is a complete defense in an infringement action.⁸⁷

Fair use may be defined as the privilege in others than the owner of the copyright, to use the copyrighted material in a reasonable manner without his consent; notwithstanding the monopoly granted to the owner by the copyright.⁸⁸

⁸⁴ 17 U.S.C. §1(a).

⁸⁵ *White-Smith Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908). See text accompanying n. 8-9, *supra*.

⁸⁶ See Meyer, *TV Cassettes—A New Frontier For Pioneers and Pirates*, 19 BULL. CR. SOC. 16, 27 (1971): "It seems to us that the stenographic transcript, a then common method of piracy, was selected by the [1909 House] Committee Report as an illustration of a notation not intelligible to the human eye which under the Act would become an infringement under the new Section 1(d). A TV cassette is technologically more advanced than a stenographic transcript but it fulfills in our day a comparable function." The 1952 Amendment of §1(c) made that provision parallel the language of §1(d) in this respect. See also Fritch, *Some Copyright Implications of Videotapes*, COPYRIGHT LAW SYMPOSIUM No. 12, p. 87, 124 (1963).

The Copyright Act does not mention fair use at all, and the courts have not been totally explicit either, but they have laid down a fairly well agreed-upon list of criteria to be used in judging whether a particular infringement can be excused on the basis of this doctrine. The factors to be considered, which have been stated in various ways, include:

1. the purpose and character of the use;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work.⁸⁹

Factor number four, the extent to which the defendant's use tends to diminish or prejudice the potential sale of the plaintiff's work, has been considered to be the most significant of the criteria.⁹⁰

The applicability of fair use to the unauthorized copying of audiovisual programs, by the nature of the doctrine, can only be ascertained on a case-by-case basis. The educational program distributors, as noted *supra*, claim to have lost numerous sales by virtue of unauthorized copying by schools and school systems. The copiers apparently have assumed that their actions are within the law,⁹¹ and hide behind the nonprofit, educational nature of their purposes (factor number 1). While courts might indeed be sympathetic to the goals of these infringers, it could hardly be ignored that potential sales have been prejudiced when a school system

⁸⁷ *Rosemont Enterprises v. Random House*, 366 F.2d 303 (2d Cir. 1966) *cert. denied* 385 U.S. 1009 (1967); *Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130 (S.D.N.Y. 1968); *Berlin v. E.C. Publications, Inc.* 329 F.2d 541 (2d Cir. 1964); Latman, *Fair Use of Copyrighted Works*, COPYRIGHT REVISION STUDY No. 14, prepared for the Subcommittee on Patents, Trademarks and Copyrights, Senate Committee on the Judiciary, 86th Cong., 2d Sess. (Comm. Print 1960); NIMMER §145, p. 643-654.

⁸⁸ BALL, *THE LAW OF COPYRIGHT AND LITERARY PROPERTY* 260 (1944).

⁸⁹ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966), p. 58-59. *See also* *Folsom v. Marsh*, 9 Fed. Cas. 348 No. 4,901 (C.C.D. Mass. 1841); *Mathews Conveyor Co. v. Palmer-Bee Co.*, 135 F.2d 73, 85 (6th Cir. 1943).

⁹⁰ NIMMER §145, p. 646. *See also* *Public Affairs Associates, Inc. v. Rickover*, 284 F.2d 262 (D.C. Cir. 1960) *vacated for insufficient record* 369 U.S. 111 (1962); *Hill v. Whalen & Martell Inc.*, 220 Fed. 359 (S.D.N.Y. 1914).

⁹¹ Industry sources indicate that such infringers are often surprised when told that they acted wrongly.

buys only one copy of a program, makes 20 copies, and distributes them to individual schools.

Both classroom and library reproduction of copyrighted materials command a certain sympathy since they involve no commercial exploitation and more particularly in view of their socially useful objectives. What this overlooks is the tremendous reduction in the value of copyrighted works which must result from a consistent and pervasive application of this practice. One who creates a work for educational purposes may not suffer greatly by an occasional unauthorized reproduction. But if every school room or library may by purchasing a single copy supply a demand for numerous copies through photocopying, mimeographing or similar devices, the market for copyrighted educational materials would be almost completely obliterated. This could well discourage authors from creating works of a scientific or educational nature. If the "progress of science and useful arts" is promoted by granting copyright protection to authors, such progress may well be impeded if copyright protection is largely undercut in the name of fair use.⁹²

Even if the tapes are subsequently erased (and used to copy other programs), no stretching of the fair use doctrine should cover such a situation.

The difficulty of policing schools combined with the imprecision of the law make abuse very simple. At least one program distributor, Time-Life Multi-Media, allows limited duplication of its programs upon the payment of a special fee. Educational institutions appear willing to pay the fee, not being the unscrupulous type of pirates found in the "bootleg" sound recording arena.

It has been said that "anyone may copy copyrighted material for the purpose of private study and review,"⁹³ and that "private use is completely outside the scope and intent of restriction by copyright."⁹⁴ The House Committee Report on the Sound Recording Amendment stated that "it is not the intention of the Committee to restrain the home recording, from broadcasts or from tapes or records, of recorded performances, where the home recording is for private use and with no purpose of reproducing or otherwise capitalizing commercially on it."⁹⁵

Thousands, perhaps millions, of home tape enthusiasts uncon-

⁹² NIMMER §145, p. 653.

⁹³ Cohen, *Fair Use in the Law of Copyright*, COPYRIGHT SYMPOSIUM No. 6, p. 43, 58 (1955).

⁹⁴ Shaw, *Publication and Distribution of Scientific Literature*, 17 COLLEGE AND RESEARCH LIBRARIES 294, 301 (1956).

cernedly reproduce without authorization copyrighted musical compositions and sound recordings for their homes and cars, and their number grows daily. Yet is this really fair use? Entire works (see factor 3) are reproduced, often by people who would otherwise have purchased pre-recorded records or tapes (factor 4).⁹⁵ The market for the affected works has been seriously undercut; under the long-accepted criteria for fair use, home taping would certainly not qualify. When home video-recorders are widely available, the problem will increase manifold, as motion pictures and television programs become fair game. Is fair game fair use? There is no case law on point.

Nimmer finds it "difficult to accept the concept of fair use as completely immunizing home recording," and attributes the House Committee's attitude to the impossibility of policing such infringement.⁹⁷ Other observers agree.⁹⁸ As the situation grows worse, television may begin to suffer. While selling the performing rights for a program to a broadcasting network could be extremely profitable, producers will become reluctant to completely destroy their retail markets. Television may have to pay more to remain competitive, and far fewer feature films may risk such widespread exposure at all. Rerun policies may have to change.

⁹⁵ H.R. Rep. No. 92-487, 92nd Cong. 1st Sess. 7 (1971). This statement is not law, being only a committee report; but it might be controlling, and would certainly affect, a court.

⁹⁶ Roger Needham points out, in *Tape Recording, Photocopying and Fair Use*, COPYRIGHT SYMPOSIUM No. 10, p. 75, 98-102 (1959) that taping records to save record wear would probably fall under the fair use doctrine. After all, the infringer already has purchased a copy of the work and is not very likely to buy another in ordinary circumstances. The extent to which this practice cuts into the market for the work is probably negligible. Needham cites *Doan v. American Book Co.*, 105 Fed. 772 (7th Cir. 1901) and *Harrison v. Maynard, Merrill & Co.*, 61 Fed. 689 (2d Cir. 1894) for the proposition that there is a right in the owner of a copy of a copyrighted work to maintain it in good condition, and to repair damaged copies. Needham goes on to say that taping borrowed records is a different situation because the author's market is "more directly affected." But he terms such infringement "quite minor," which—in terms of widespread practice—is debatable. Needham also condones taping off the air, saying "the *de minimus* approach should protect the user. If the authors feel injured by the practice, they can increase the fees charged broadcasters." But if authors *are* injured, fair use should not apply. And it is not certain that broadcasters would be willing to pay higher fees. To the extent such fees are negotiated by performing rights organizations, they are probably already as high as the market will bear. And if certain authors—of quality programs that are being released at retail—attempt to charge more, television may prefer not to broadcast such programs. Thus the general public suffers by a weakening of programming.

⁹⁷ NIMMER §109.21, p. 442.7.

⁹⁸ Meyer, n. 86, *supra*, at 38; Harris and Mirisch: *Video Cassettes and the Pirates*, BEVERLY HILLS BAR J., March-April 1971, at 16-17.

Unrestrained copying of retailed programs without remuneration to copyright owners will also definitely slow down the growth of the new industry, and cut down the incentive to make programs.

It is clearly impossible to police this problem even if home taping were explicitly declared by Congress or the courts to be unlawful. The only workable remedy that has been suggested is a legislative provision similar to Article 53 of the West German Copyright Law.⁹⁹

The German law specifically permits the making of "single copies of a work for personal use,"¹⁰⁰ and applies to visual as well as sound recordings.¹⁰¹ Remuneration to copyright proprietors is provided by a five percent tax on "equipment suitable for making such reproductions," payable through collecting societies to owners of works which, by their "nature," are expected to be reproduced.¹⁰²

Such a tax would meet opposition from U.S. hardware manufacturers and importers, but in the long run it should redound to their advantage. The payments should provide incentives for the production of more software, the existence of which would encourage increased sales of hardware. The law should logically apply to tape manufacturers as well as or even instead of recorder manufacturers, however, because the payment of royalties should not remain the same regardless of how often a recorder is used. A tax on blank tape would affect the prodigious pirate in proportion to his duplication, and also encourage the sale of pre-recorded tapes by narrowing the price gap.

The fair allocation of income from the tax would also be a problem, as broadcast producers and retail program producers fight for their pieces of the pie. But ASCAP and BMI have experience at this sort of thing, and would surely not be averse to taking on the allocation burden. Alternatively, the government could authorize the creation of a new and specialized collecting society.

B. *The Revision Bill*

1. *Copyrightability and classification:*

Under the present Revision Bill, S.1361,¹⁰³ audiovisual works are specifically provided for. The term is defined as:

⁹⁹ Copyright Statute of the German Federal Republic, Act of September 9, 1965. See *Bundesgesetzblatt*, I page 1273 No. 51 of 16 September 1965, translated in *Copyright Laws and Treaties of the World*, United Nations Educational, Scientific and Cultural Organization (1972).

¹⁰⁰ *Id.* Article 53(1).

¹⁰¹ *Id.* Article 53(2).

¹⁰² *Id.* Article 53(5).

¹⁰³ 93d Cong., 1st Sess. (1973).

works that consist of a series of related images which are intrinsically intended to be shown by the use of machines or devices such as projectors, viewers, or electronic equipment, together with accompanying sounds, if any, regardless of the nature of the material objects, such as films or tapes, in which the works are embodied.¹⁰⁴

This definition plainly includes all types of audiovisual packages in existence today, and is flexible enough to cover further advances in technology.

Motion pictures are separately defined as a sub-class of "audiovisual works":

Motion pictures are audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.¹⁰⁵

This definition likewise does not revolve around a particular technology, and includes videotape and videodisk:

this definition encompasses a wide range of cinematographic works embodied in films, tapes, and other media. However it would not include: (1) unauthorized fixations of live performances or telecasts, (2) live telecasts that are not fixed simultaneously with their transmission, or (3) film strips and slide sets which, although consisting of a series of images intended to be shown in succession, are not capable of conveying an impression of motion.¹⁰⁶

With respect to protection, other audiovisual works are lumped together with "motion pictures."¹⁰⁷ Thus the present-day classification as motion pictures of audiovisual works sold at retail is explicitly affirmed in the Revision Bill.

2. *Performance Rights:*

The scope of protection to be enjoyed by such works is more clearly laid out than in the present Act. "Motion pictures" (and other audiovisual works) are included in a grant of the exclusive right to perform the works publicly in §106(4). This provision removes the "for profit" stipulation for

¹⁰⁴ S.1361, §101.

¹⁰⁵ *Id.*

¹⁰⁶ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966), at 47.

¹⁰⁷ S.1361, §102(a) (6); §106(4); §106(5).

non-photoplays, and thus affords the copyright owner of such works much-needed increased protection,¹⁰⁸ though it is qualified by other sections, discussed *infra*.

"Performance" is defined, "in the case of a motion picture or other audiovisual work to show its images in any sequence or to make the sounds accompanying it audible."¹⁰⁹

Also granted by §106 is the new exclusive right to "display" the copyrighted work publicly.¹¹⁰ This means, "in the case of a motion picture or other audiovisual work, to show individual images nonsequentially."¹¹¹

To perform or display a work "publicly" means: (1) to perform or display it at a place open to the public or at any place where a substantial number of persons outside of a normal circle of a family and its social acquaintances is gathered; (2) to transmit or otherwise communicate a performance or display of the work to a place specified by clause (1) or to the public, by means of any device or process, whether the members of the public capable of receiving the performance or display receive it in the same place or in separate places and at the same time or at different times.¹¹²

This definition of "public" is purposely tighter than the present court-made concept, and laudably so.

... one of the principal purposes of the definition was to make clear that, contrary to the decision in *Metro-Goldwyn-Mayer Distributing Corp. v. Wyatt*, 21 C.O. Bull 203 (D.C. Md. 1932), performances in "semi-public" places such as clubs, lodges, factories, summer camps, and schools are "public performances" subject to copyright control ... The ... committee ... notes that most routine meetings of business and governmental personnel would be excluded because they do not represent the gathering of a "substantial number of persons."¹¹³

However, §110(1) specifically exempts performance or display "by instructors or pupils in the course of face-to-face teaching activities of a nonprofit educational institution, in a classroom or similar place devoted to instruction," except for the use of unlawfully-made copies. This ex-

¹⁰⁸ See text accompanying n. 19-26, *supra*.

¹⁰⁹ S.1361 §101.

¹¹⁰ S.1361 §106(5).

¹¹¹ S.1361 §101.

¹¹² *Id.*

¹¹³ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966) at 57.

emption excludes broadcasting, and performances in auditoriums, assemblies, graduation ceremonies, class plays, and sporting events.¹¹⁴

Section 110(2) provides an exemption for educational broadcasts, but it does not apply to performances of audiovisual works. It does allow nonsequential "display" of such works.

These provisions solve most of the problems discussed *supra*¹¹⁵ under the present law regarding performance rights. Producers will be able to deal with the Guilds on a much more secure footing, knowing that broadcast and nonprofit theatrical exhibition of their works are within their control. Piracy and market undercutting from unauthorized "non-profit" broadcasts will be eliminated, and, while instructional performances are exempted, the exemption does not condone unlawfully reproduced programs. Since educational programs are distributed for the express purpose of instructional exhibition, the copyright proprietor does not lose much by the exemption. The market effect of nonsequential display by educational broadcasters will probably be minimal, and may be positive.

3. *Compulsory licensing:*

The Revision Bill renews the compulsory license system for reproduction of musical works in phonorecords in §115; sounds accompanying motion pictures and other audiovisual works are specifically excluded from the definition of "phonorecords."¹¹⁶

Certain changes in the formalities of obtaining compulsory licenses are effected, and the royalty rate is raised,¹¹⁷ but no real substantive changes have been made. Proposals for allowing exclusive licensing for a limited "waiting period"; the posting of security for royalty payments by licensees, and transforming the rate into a percentage of wholesale or retail price were not adopted,¹¹⁸ nor are they discussed in the Committee Report.¹¹⁹

Thus the Bill for the most part retains the present law with respect to mechanical reproduction of sound recordings, though it is much more explicit. The complete embracing of the compulsory licensing concept is apparent also by its adoption in several other contexts.

¹¹⁴ *Id.* at 70.

¹¹⁵ See text accompanying n. 24-26, *supra*.

¹¹⁶ S.1361 §101.

¹¹⁷ The rate specified in the Bill is "two and one-half cents, or one-half cent per minute of playing time or fraction thereof, whichever amount is larger." The playing time computation is welcome, and should lead to justifiably greater compensation for composers of more complex works.

¹¹⁸ See text accompanying n. 44-47, *supra*.

¹¹⁹ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966).

While performance fees for musical compositions are left to negotiation by performing rights organizations (the effect of which is very similar to a compulsory license), compulsory licensing is adopted in §114 for the newly created performance rights in sound recordings. Under this section, which does not apply to audiovisual recordings, the Register of Copyrights collects royalties from broadcasters and others, and distributes them equally between producers and performers. Performers in audiovisual works are thus not provided with performance rights, and must rely on negotiated contracts, although performance of an audio-only version of the same musical performance would entitle the performer to statutory royalties.

Compulsory licensing is also adopted with regard to cable television in §111(d), in which fees for "secondary transmissions" are likewise collected by the Register of Copyrights and distributed to copyright owners and their agents.

Section 116 discards the juke-box exemption,¹²⁰ and institutes another compulsory license provision. This provision is applicable to both the sound recordings and the underlying musical compositions. Unlike the present law, sounds accompanying "motion pictures" and other audiovisual works are expressly excluded, because this section only applies to "phonorecords" and "sound recordings."¹²¹ Thus there is no provision at all in the Revision Bill for audiovisual juke-boxes, and should such products become commercially viable, negotiated royalties for the performance right would have to be paid to producers and composers, unless the producer has himself obtained the performance rights from the composer. Performers would not be entitled to royalties, except by contract with producers.

The sound recording juke-box fees are divided one-eighteenth to producers, one-eighteenth to performers, and eight-ninths to composers and publishers.¹²² Distribution of fees for audiovisual juke-box programs (for simplicity of comparison, let us assume they are pure musical performances), since unregulated, would probably be very different. Since the producer has control of the program, he would likely take a much larger share of the proceeds. The composer, if he lacks bargaining power or a good lawyer, and has sold the producer his performance rights, may get very little. If not, his performing rights organization may negotiate a license with the juke-box operators, from which the composer and publisher would get some income. The performer would likewise be at the mercy of his contract with the producer.

¹²⁰ 17 U.S.C. §1(e).

¹²¹ See definitions, S.1361 §101.

¹²² S.1361 §116(c) (3).

Attorneys for performers and composers, in negotiating contracts for production of audiovisual programs for retail sale, would do well to reserve public performance rights, or at least to provide for equitable remuneration for such uses as audiovisual juke-boxes and television broadcasts.

Whether the jukebox provision and the compulsory license for performance provision ought to apply to audiovisual works are interesting questions, and ought to be carefully considered. As discussed earlier,¹²³ audiovisual productions of pure musical performances are so like sound recordings in so many ways that it seems absurd to have the protection so different. Performers should be entitled to royalties in both situations. Statutory resolution of items such as jukebox fees is very desirable; it may be the key to an entire industry, for obtaining a blanket license is much simpler than individual contract negotiations for jukebox distributors who have to deal with hundreds of disks (or tapes), with new ones every week.

Whether a compulsory license for performing audiovisual programs should be adopted, however, is more debatable. Allowing anyone, especially television broadcasters, to perform such works at will could severely hurt the retail distribution of the programs because of home taping. On the other hand, radio programs are not considered destructive to record sales, despite widespread distribution of tape recorders. Indeed, radio is the basic marketing tool for sound recordings, and the same could happen with television and videodisks.¹²⁴ Considering the high cost of home videotape recorders as compared to the cost of the disk playback machine,¹²⁵ it is likely that, while home taping will be a significant problem, it would be more than offset by the promotion value of television exposure. It must be remembered that if §114 were extended to audiovisual programs, all the parties involved (producer, performer, composer, and publisher) would receive royalties from an otherwise possibly negligible source. And, as a source of royalties, television broadcasters have very deep pockets; this type of programming might be very profitable to them. It is conceivable that such television programming may evolve by itself, by producers and composers assigning performing rights to organizations which would, in turn, sell blanket licenses to broadcasters. But legislative encouragement would certainly ease the process considerably. Radio programming evolved by itself, but then there were no performing rights in sound recordings apart from the underlying works.

The one basic problem with applying compulsory license to perform-

¹²³ See text accompanying n. 27-28, *supra*.

¹²⁴ See text accompanying n. 79, *supra*.

¹²⁵ See n. 4.

ances of audiovisual programs is the multiple playability question. Audio musical performances are the kind of works that can be played over and over again by the consumer without losing appeal. But how many times will a person want to watch the same expressions on a performer's face every time he sings a song? Could visual boredom occur long before musical boredom? Many observers feel this will be a negligible problem, and that the audiovisual programs will be very capable of multiple play.¹²⁶ And the television performance of a hit "single" would not discourage "album" sales through boredom. But the question has not been resolved, and there is a real possibility that repeated television exposure of an audiovisual program may, instead of promoting sales, do significant harm to the retail market for the program. In view of this, the performance compulsory license should *not* be applied to audiovisual works until the market ramifications are more certain. And even if musical performances prove to have high multiple playability, other types of audiovisual packages will have much less, so consideration of the application of the compulsory license should be limited to musical performances.

4. *Fair use and other limitations on proprietors' rights:*

Section 107 of the Revision Bill gives express statutory recognition of the fair use doctrine for the first time. Decisions as to applicability would still be on a case-by-case basis, however, for the criteria listed in §107 are the same as the ones the courts have evolved.¹²⁷ In fact, "Section 107, as revised by the committee, is intended to restate the present judicial doctrine of fair use, not to change, narrow, or enlarge it in any way."¹²⁸

The Revision Bill does clarify the law, however, and perhaps circumscribes it, by explicit provisions relating to practices which today are legal, illegal, or cloudy because of the fair use doctrine. Section 108 provides certain limitations on the exclusive right to copy¹²⁹ with regard to reproduction by libraries and archives. Under this provision a library or archive could reproduce no more than one copy of a work, including audiovisual works, for the purpose of "preservation and security or for deposit for research use" in the case of unpublished works, or replacement of a damaged or lost copy of a published work, if unused replace-

¹²⁶ See n. 28, *supra*.

¹²⁷ See text accompanying n. 89, *supra*.

¹²⁸ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966) at 61.

¹²⁹ The Bill defines "copies" as "material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term 'copies' includes the material object, other than a phonorecord, in which the work is first fixed." S.1361 §101. This definition removes the uncertainty of the *White-Smith* "intelligible notation" problem.

ments cannot be obtained through normal trade channels "at a normal price."

Section 110 exempts from performance and display rights certain acts by educational and religious institutions, by small businessmen, and certain others. Sections 110(1) and 110(2) are discussed *supra*.¹³⁰ Section 110(3) allows free performance of certain kinds or works at religious services, but only allows non-sequential display of motion pictures and other audiovisual works.¹³¹

Section 110(4) exempts non-profit performances of a "nondramatic literary or musical work or of a sound recording." The provision apparently does not apply to audiovisual works, but this is not as clear as it might be. The House Report says:

The exemption in clause (4) applies to the same general activities and subject matter as those covered by the "for profit" limitation today: public performance of nondramatic literary and musical works. However the exemption would be limited to public performances given directly in the presence of an audience whether by means of living performers, the playing of phonorecords, or the operation of a receiving apparatus, and would not include a "transmission to the public."¹³²

The "for profit" provision today, in applying to "nondramatic literary works", applies to motion pictures other than photoplays.¹³³ If the exemption in §110 applies to "the same general activities and subject matter" as today, such works would be included. But the Revision Bill defines "literary works" as "works other than audiovisual works."¹³⁴ This would be self-explanatory except that the definition goes on to mention that literary works may be embodied in "film" or any other "material object."¹³⁵ How a literary work could be on film and still not be an audiovisual work is hard to understand, but it probably refers to the fact that a literary work can be an underlying work for a derivative audiovisual work. That derivative work would then, according to the definition, not itself be a "literary work."

The question arises whether §110(4) *ought* to apply to audiovisual works, or at least to audiovisual musical performances. If a special class is made for audiovisual musical performances, and they are treated in the same manner as sound recordings in the various ways suggested in this

¹³⁰ See text accompanying n. 114 *supra*.

¹³¹ See H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966) at 75.

¹³² *Id.* at 76.

¹³³ 17 U.S.C. §1(c). See n. 21, *supra*.

¹³⁴ S.1361 §101.

¹³⁵ *Id.*

paper, we must be consistent. While §110(4) removes certain rights from copyright proprietors, there is really little reason to treat audiovisual musical performances differently than sound recordings in this matter. This section reimposes the "for profit" limitation, allowing performance if there is no purpose of direct or indirect commercial advantage and if promoters, organizers and performers are unpaid. There must be no admission charge, or else the proceeds must be used for educational, religious, or charitable purposes, and in the latter case the copyright owner has the right to object to the use of his work.

The only reason §110(4) should not be applied is because of the multiple playability question, discussed *supra*.¹³⁶ Certainly, if a compulsory license for performance is applied, §110(4) should also be applied. But if it is found that repeated exposure of an audiovisual musical performance harms the retailability of the work, then free nonprofit performance would also bring harm, and should not be permitted. Until such time as market studies determine the answer to the multiple playability question, §110(4) should not be applied.

Section 110(5) applies to all works, and allows small business reception and performance of a transmission on "a single receiving apparatus of a kind commonly used in private homes," as long as there is no charge to see or hear the transmission, and there is no further transmission. The clause itself has no reference to "small" business, but the House Report reveals that the provision was intended

to allow the use of ordinary radios and television sets for the incidental entertainment of patrons in small business or professional establishments such as taverns, lunch counters, hairdressers, dry cleaners, doctors' offices, and the like. The clause has nothing to do with community antenna operations, and there is no intention to exempt performances in large commercial establishments, such as bus terminals, supermarkets, factories, or department stores, where broadcasts are transmitted to substantial audiences by means of loudspeakers covering a wide area.¹³⁷

This provision would only affect copyright proprietors of audiovisual programs in that if they permit television broadcast of their works, they will know that people are watching in small businesses, as well as in homes.

Section 110(6) allows performance of "nondramatic musical work(s)" and sound recordings at non-commercial agricultural or horticultural fairs. This is apparently a special-interest provision, and would not apply to most audiovisual works, but the question arises whether "nondramatic

¹³⁶ See text accompanying n. 126, *supra*.

¹³⁷ H.R. Rep. No. 2237, 89th Cong. 2d Sess. (1966) at 77.

musical works" include audiovisual musical performances. The answer is probably no, though there is no explicit definition, because the clause was probably meant to apply only to live performances of musical works, and the other interpretation would be inconsistent with the House Report's interpretation of the other provisions of §110, which also use the phrase. As to whether this provision *should* apply to audiovisual musical works, the answer here must also be tied to the multiple playability question, and the general association of such works with sound recordings.

Section 110(7) uses the same slightly ambiguous phrase, in permitting free performance of sound recordings and "non-dramatic musical work(s)" in record stores and other places where "copies or phonorecords of the work" are sold at retail. Again, whether this applies to audiovisual musical works is doubtful, but in *this* case, what is clear is that the provision ought to apply. Such works will probably be sold right next to sound recordings, in the same stores, and in the same manner. The only reason for not allowing free performance in the other §110 provisions would be that such performance would hurt retail sale. If it would, retail stores would not perform the works, and there would be no need for §110(7). But if, as is probably the case, audiovisual musical works have high multiple playability, then promotional performance in record stores would not only be desirable; it would be necessary. In any case, a patron of a record store is not likely to watch an entire work; he is there to purchase records, tapes, or videodisks, and promotional performance can only whet his appetite to buy. Even if the other provisions are not applied, §110(7) should be.

Section 111 limits performance and display rights for "secondary transmissions" and cable systems. This provision can only help copyright proprietors of audiovisual programs by providing another royalty source once television broadcast of the work is permitted.

Section 112 allows transmitting organizations to make ephemeral recordings of programs they are lawfully entitled to transmit. Strict controls are laid down for the use of these recordings, which are necessary for the "practical exigencies of broadcasting."¹³⁸ The provision only applies to audiovisual works in §112(b), and there only to nonsequential display allowed under §110(2). It is not clear why audiovisual works are excluded under §112(a); perhaps such application is not necessary. But if it might be desirable, such works should be included, if the House Report is correct in saying that ephemeral recordings are "mere technical adjuncts of broadcasting that have no appreciable effect on the copyright owner's rights or market for copies or phonorecords."¹³⁹

¹³⁸ *Id.* at 88.

¹³⁹ *Id.* at 89.

II. CONTRACTUAL PROBLEMS

A. *The use of past services*

Careful attorneys should be able to protect their entertainment clients from future problems due to audiovisual technology with a little imagination and some painstaking contract-drafting.

But no one should accuse a lawyer of sloppy thinking if he failed to anticipate the new technology in contracts written before the invention of the machinery which will cause the problems. Some such old contracts will cost quite a number of authors, composers, publishers, performers, and directors a good deal of money.

The common thread to these situations is the sale of a right to reproduce, perform, or otherwise exploit a work for consideration which did not take into account the existence of a large retail market for audiovisual programs. Such sellers will be deprived of equitable remuneration because they sold out for a flat fee instead of continuing participation, or because they unwittingly gave away a right they didn't know they had.

For instance, a composer who sold an exclusive synchronization license for a song to a motion picture or television producer may have given away all rights to use that song on any audiovisual package, including videodisks sold at retail. The anomaly of a composer who cannot even perform his own song on his own "album" is another bit of fallout from the arbitrary and indiscriminate classification of all audiovisual packages as "motion pictures." Luckily, most synchronization licenses are nonexclusive.¹⁴⁰ And even exclusive grants may be worded so as to avoid the problem. But the nonexclusive grants, while usually keyed in with a particular motion picture, would generally allow the motion picture producer to disseminate the production, including the music, at retail as an audiovisual program.¹⁴¹ Since the fee to the composer is usually a flat rate, he would receive nothing at all when such motion pictures are released in supplemental markets. The performer is in the same position.

Creative artists such as playwrights, who generally reserve a sizable percentage of income from "subsidiary" uses of their works, will be protected by the terms of their contracts. Anyone with enough bargaining power to contract for a percentage of gross or net receipts from all uses will likewise be covered.

But the vast majority of writers, actors, and directors in the motion picture industry are employed under contracts which typically assign to

¹⁴⁰ SPIEGEL AND COOPER, RECORD AND MUSIC PUBLISHING FORMS OF AGREEMENT IN CURRENT USE (1971), Form 12.2, "Motion Picture Producer/Independent Music Contractor," par. 4, at 534.

the producer all rights of all kinds in their works.¹⁴² Case law in this country will not support an argument by such an artist that a general grant of rights is ineffective if the parties could not have known at the time of the possibility of the new uses for the work. In *L.C. Page & Co. v. Fox Film Corp.*,¹⁴³ a grant of "exclusive moving picture rights" was held to include sound motion picture rights although "talkies" were unknown at the time of the grant.¹⁴⁴ The express words of the contract will govern, even if the injustice is obvious.

The artists' guilds, however, in their latest agreements, do begin to protect their members against exploitation without remuneration due to overbroad "grant of rights" clauses. The 1973 Writers Guild of America Theatrical & Television Basic Agreement provides in Article 51 that theatrical and television films produced by signatory companies, principal photography of which commenced on or after July 1, 1971, are subject to payment of a percentage royalty if they are distributed in supplemental markets.¹⁴⁵ Writers of such motion pictures receive as additional compensation a total of 1.2 percent of the company's "accountable receipts" from such distribution.¹⁴⁶ "Accountable receipts" is based on "producer's gross" receipts.¹⁴⁷

¹⁴¹ *Id.* The grant includes the "nonexclusive, irrevocable right in perpetuity and throughout the world to use, synchronize, mechanically re-record (dub), and perform the musical material, the performances, and the recording for and in connection with the production and exhibition of a motion picture film with a playing time of approximately _____ minutes tentatively entitled _____ by any and all means and in any and all media, now or hereafter known, conceived, invented or used. . . . It is expressly agreed that the motion picture film and the sound track thereof embodying the musical material, the performances and the recording shall be your sole and exclusive property for all purposes, without restriction to place, time, manner or media or exhibition or other use." All synchronization contracts may not be worded this carefully, especially older ones.

¹⁴² Harris and Mirisch, *Video Cassettes and the Law*, BEVERLY HILLS BAR J. Summer 1970 at 18, 47.

¹⁴³ 83 F.2d 196 (2d Cir. 1936).

¹⁴⁴ See also *Photo-Drama Motion Picture Co. v. Social Uplift Film Corp.*, 220 Fed. 448 (2d Cir. 1915); *Cinema Corp. of America v. DeMille*, 149 Misc. 358, 267 N.Y. Supp. 327 (1933), *aff'd* 240 App. Div. 879, 267 N.Y. Supp. 959 (1933); *Frohman v. Fitch*, 164 App. Div. 231, 149 N.Y. Supp. 633 (1914); *Silverberg, Televising Old Films—Some New Legal Questions About Performers and Proprietor's Rights*, 38 VA. L.R. 615; NIMMER §125.3 at 542.2-548.

¹⁴⁵ "Supplemental markets" is defined in Article 51(2). See n. 24, *supra*.

¹⁴⁶ WGA Agreement, Article 51(3).

¹⁴⁷ "Producer's gross" is defined in Article 51(3)(a) as worldwide total gross receipts less returns and certain taxes, with special provisions for foreign production and distribution.

In the case of a film originally produced for television, "accountable receipts" means 100 percent of producer's gross.¹⁴⁸ With regard to theatrical films, however, accountable receipts means 50 percent of the first \$400,000 of gross receipts, and 100 percent of any excess.¹⁴⁹ After the time when total producer's gross from supplemental markets of all pictures produced by signatory companies, now or hereafter in existence, during any consecutive 12-month period reaches \$45,000,000, accountable receipts for theatrical films will mean 100 percent of total producer's gross receipts, including the first \$400,000.¹⁵⁰

The 15-page WGA Agreement Article on Supplemental Markets was based mainly on the language of the 1971 Supplement to the Producer-Screen Actors Guild Codified Basic Agreement of 1967 (SAG Theatrical Agreement), but the compensation scheme is very different. Only 50 percent of gross receipts are counted, no matter how high receipts get, and there is no provision for growth of the industry.¹⁵¹ Also, there is no fixed percentage compensation. Instead, remuneration is based on a "base amount," a flat fee figured on the length of the actor's employment on the film. The highest "base amount" is \$500, and each increment of gross receipts from supplemental markets brings the actor a payment of from 10 to 25 percent of the "base amount." If a film brings in \$1,000,000 in gross receipts from supplemental markets, an actor who has worked (or was guaranteed work) for three weeks or more will receive \$650. For such an actor, each additional \$200,000 in producer's gross will provide \$50.¹⁵² The SAG Theatrical Agreement covers films whose principal photography commenced after June 30, 1971.¹⁵³

The 1971 Screen Actors Guild Television Agreement (SAG Television Agreement), however, covers television films produced after July 21, 1952.¹⁵⁴ The compensation scheme is very similar to the SAG Theatrical Agreement's, except that the "in-flight" markets are counted at 100 percent. Gross receipts are otherwise included in the compensation formula at 50 percent.¹⁵⁵

The SAG Theatrical Agreement provides that films produced primarily for supplemental markets be subject to special compensation negotiations between the producer and SAG during the 60-day period

¹⁴⁸ WGA Agreement, Article 51(3) (b) (1).

¹⁴⁹ *Id.*, Article 51(3) (b) (ii).

¹⁵⁰ *Id.*, Article 51(3) (b) (iii).

¹⁵¹ SAG Theatrical Agreement, Section 20(b).

¹⁵² *Id.*, Section 5(A).

¹⁵³ *Id.*

¹⁵⁴ SAG Television Agreement, Section 20(b).

¹⁵⁵ *Id.*, Section 20(c).

before production begins.¹⁵⁶ The WGA Agreement does not provide specifically for pictures aimed primarily at supplemental markets, and indicates that the subject is a topic for future negotiations.¹⁵⁷ However, such a film would apparently fit under the WGA definition of a "theatrical motion picture" as pictures produced by any technique "other than those motion pictures produced primarily for exhibition by free television."¹⁵⁸ Thus the compensation provided by the 1973 WGA Agreement should apply to programs produced primarily for supplemental markets.

The Directors Guild of America, Inc. Basic Agreement of 1973¹⁵⁹ includes a section on supplemental markets very similar to the Writers Guild Agreement.

Compensation provided by guild agreements are minimums, and individual contracts calling for higher compensation are not at all unheard of. But most writers, directors and performers not covered by these Agreements because of independent production or production before effective date will probably receive nothing at all from supplemental markets distribution.¹⁶⁰

B. *Existing contractual ties*

A problem may develop between record companies and motion picture companies as to the right of performers to record on motion picture sound tracks that are released in supplemental markets.

The typical contract between a performer and a motion picture producer for the recording of a soundtrack would allow the producer the right to distribute retail copies of the film.¹⁶¹ But many recording artists have exclusive agreements with record companies under which

if Artist performs any selection for any medium other than records, including motion pictures or television, Artist agrees to do so only pursuant to a written contract prohibiting the use of such performance or any recording thereof, directly or indirectly, for the purpose of making records or any other device for home use.¹⁶²

Artists with bargaining power may be able to keep such clauses out of their

¹⁵⁶ SAG Theatrical Agreement, Section 8.

¹⁵⁷ WGA Agreement, Article 51(2) (c).

¹⁵⁸ WGA 1970 Agreement, Article 1(A) (2), incorporated by reference into the 1973 Agreement.

¹⁵⁹ Not available, except in summary, at the time of this writing.

¹⁶⁰ Harris and Mirisch, *supra* n. 142, at 48.

¹⁶¹ Spiegel and Cooper, *supra* n. 140, Form 12.9, "Motion Picture Producer/Artist" par. 3 at 579.

¹⁶² *Id.*, Form 1.2 "Exclusive Artists' Recording Agreement" par. 7 at 15.

contracts, but others may find themselves in a position where a motion picture company will not deal with them or where their record company refuses to allow their participation in motion pictures. The record companies apparently enforce such clauses selectively, as 16mm copies of films have been distributed for home use for years, and there is certain promotion value in allowing an artist to appear on the soundtrack of a motion picture. The record company often demands a share of royalties for soundtrack albums, however,¹⁶³ and may now do likewise with retail copies of motion pictures. The record companies may absolutely prohibit their artists, however, from doing audiovisual pure musical programs for others. Artists without such home-use clauses may be free to make such programs completely apart from their record companies, which would provide these artists with unprecedented freedom since it may be possible to make an entire recording career revolve around videodisks instead of phonorecords.

C. Extension of rights by perpetual lease

Some of the problems due to the inadequate coverage of audiovisual packages by the current copyright law have been confronted by at least one distributor of audiovisual works, in a very interesting sales contract. Time-Life Multi-Media, which specializes in educational and institutional videotapes and cassettes, distributes some of the programs by short-term rental, but most by what amounts to a perpetual lease. The would-be "purchaser" of a copy of any audiovisual program signs an agreement which, in fine print, states:

Legal title of the Programs and the containers, cassettes or reels on which the Programs are delivered shall at all times remain in Time and all rights therein are reserved to Time and thus the term "Purchase" as used herein and in the Schedule hereto shall be deemed to mean only the right and license to use and reuse the Programs hereunder without limitation as to the number of uses or reuses, but without any change in ownership or title and otherwise subject to and upon the terms and conditions hereof.¹⁶⁴

The contract also provides that

The programs may not be duplicated, broadcast, transmitted by

¹⁶³ *Id.*, Form 12.8, "Motion Picture Producer/Record Company Agreement," par. 2 at 576.

¹⁶⁴ "Nontheatrical Video Tape and Film Order And Contract Application and Schedule," par. 6, Time/Life Multi-Media, Time & Life Building, New York, N.Y. 10020.

¹⁶⁵ *Id.*, par. 1, 11.

cable or otherwise transmitted, on any multi-receiver open or closed circuit system, or displayed before the public, whether or not admission is charged. Customer shall exhibit the programs only as herein specified and use the programs for no other purpose. Customer shall not sublicense, sublease or part with possession of any program received by Customer hereunder . . . Customer shall exhibit each program only in its entirety. . . .¹⁶⁵

If such restrictions are valid and enforceable, they would solve the problem, noted *supra*,¹⁶⁶ of dealing with the Writers, Screen Actors, and Directors Guilds, and other such guilds in other countries, by giving Time control over non-profit performance, i.e., educational broadcasting and non-profit theatrical exhibition. In forbidding the "buyer" to "part with possession" of the program, Time may significantly prevent piracy, for they know to whom the copies are sold. But the lawfulness of this extension of the copyright monopoly is not without doubt.¹⁶⁷

Section 27 of the Copyright Act provides that:

The copyright is distinct from the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the title to the material object; but nothing in this title shall be deemed to forbid, prevent, or restrict the transfer of any copy of a copyrighted work the possession of which has been lawfully obtained.¹⁶⁸

It has been held, due to this section and the common-law concept which is embodied in it, that once a copy of a work has been sold, the copyright proprietor cannot prevent or control the resale of that copy or circumscribe its use in ways not covered by the Copyright Act. Suits for infringement will not be successful,¹⁶⁹ and extension of the copyright

¹⁶⁶ See text accompanying n. 24, *supra*.

¹⁶⁷ Sources at Time were confident of the validity of the restrictions, but admitted that this is a "gray area" of the law. The sources stated that the company, in practice, would not enforce its "ownership" in the event of erasure or total destruction of the tapes, but that any sale, legacy, gift, or attachment of copies would be subject to the legal title in Time.

¹⁶⁸ 17 U.S.C. §27.

¹⁶⁹ *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339 (1908); *Henry Bill Publishing Co. v. Smythe*, 27 Fed. 914 (C.C. Ohio 1886); *Harrison v. Maynard*, 61 Fed. 689 (2d Cir. 1894); *Independent News Co. Inc. v. Williams*, 293 F.2d 570 (3d Cir. 1961); *Blazon, Inc. v. DeLuxe Game Corp.*, 268 F. Supp. 416 (S.D.N.Y. 1965); *See Motion Picture Patents Company v. Universal Film Manufacturing Co.*, 243 U.S. 502 (1917).

monopoly in this manner is often considered a violation of the Sherman Antitrust Act,¹⁷⁰ where the extension is a "combination or conspiracy in restraint of trade," or in furtherance of monopoly.¹⁷¹

In *Bobbs-Merrill Co. v. Straus*,¹⁷² the plaintiff attempted to use the copyright statute's grant of the exclusive right to "vend" to restrain the resale of his books at a price less than one dollar. The notice on the inside of the books read:

The price of this book at retail is one dollar net. No dealer is licensed to sell it at a less price, and a sale at a less price will be treated as an infringement of the copyright.¹⁷³

Judge Day, in denying an infringement suit, construed the 1873 Act as not permitting restrictions on alienation of copies of copyrighted works after their first sale:

What does the statute mean in granting "the sole right of vending the same"? Was it intended to create a right which would permit the holder of the copyright to fasten . . . a restriction upon the subsequent alienation of the subject matter of copyright after the owner had parted with the title to one who had acquired full dominion over it and had given a satisfactory price for it? It is not denied that one who has sold a copyrighted article, without restriction, has parted with all right to control the sale of it. The purchaser of a book, once sold by authority of the owner of the copyright, may sell it again, although he could not publish a new edition of it . . . To add to the right of exclusive sale the authority to control all future retail sales, by a notice that such sales must be made at a fixed sum, would give a right not included in the terms of the statute, and in our view, extend its operation, by construction, beyond its meaning. . . .¹⁷⁴

In *Straus v. American Publishers Association*,¹⁷⁵ the Supreme Court, in an identical fact situation, construed the 1909 Copyright Act as not authorizing control over resale price. The court held such price fixing of copyrighted books was an unlawful restraint of trade and in violation of Section 1 of the Sherman Act.

¹⁷⁰ 26 Stat. 209, §1 (1890); 15 U.S.C. §1.

¹⁷¹ *Interstate Circuit, Inc. v. United States*, 306 U.S. 208 (1939); *Straus v. American Publishers Ass'n*, 231 U.S. 222 (1913); *Doubleday, Doran & Co. v. Macy & Co.* 269 N.Y. 272 (1936). See *U.S. v. Masonite Corp.*, 316 U.S. 265 (1942).

¹⁷² 210 U.S. 339 (1908).

¹⁷³ *Id.* 341.

¹⁷⁴ *Id.* 350-351.

¹⁷⁵ 231 U.S. 222 (1913).

In *Interstate Circuit, Inc. v. United States*,¹⁷⁶ the Court declared that the attempted enlargement of a copyright monopoly by encumbering licenses for the exhibition of copyrighted motion pictures with restrictive provisions such as banning double features and price-fixing was an "undue restraint:"

A contract between a copyright owner and one who has no copyright, restraining the competitive distribution of the copyrighted articles in the open market in order to protect the latter from the competition, can no more be valid than a like agreement between two copyright owners or patentees . . . (citations omitted) . . . In either case if the contract is effective, as it was here, competition is suppressed and the possibility of its resumption precluded by force of the contract. An agreement illegal because it suppresses competition is not any less so because the competitive article is copyrighted.¹⁷⁷

Forbidding a "purchaser" from re-selling, or from giving away the copyrighted article is at least as much a restraint of trade as fixing the resale price.

The restrictions in the Time-Life contract would probably be unenforceable in a breach of contract action because in restraint of trade, and would certainly not be enforceable under the Copyright Act, if it were not for the reservation of legal title. If Time's "ownership" in the copies of its programs is valid, there has been no "first sale" at all; the agreement is one for a license to perpetually use in the "purchased" program.

In *Platt & Munk Co. v. Republic Graphics, Inc.*,¹⁷⁸ the Court of Appeals for the Second Circuit held that the "first sale doctrine" only applies when there has been a "legitimate" first sale of full title. Judge Friendly construed the "lawful possession" language of Section 27¹⁷⁹ so that the exclusive right to vend on the part of a copyright proprietor could prevent a manufacturing licensee from unauthorized selling of allegedly defective copies:

Such a literal reading of the "but nothing" clause is unacceptable. If lawful possession by another sufficed to deprive the copyright proprietor of his right to control the transfer of the copyrighted objects, any bailee of such objects could sell them without infringing the copyright whatever his liability for conversion might be. In view of the necessary role played by man-

¹⁷⁶ 306 U.S. 208 (1939).

¹⁷⁷ *Id.* at 230.

¹⁷⁸ 315 F.2d 847 (2d Cir. 1963).

¹⁷⁹ 17 U.S.C. §27.

ufacturers, shippers, and others in producing and distributing copies of copyrighted works, the result in many cases would be that a copyright proprietor could not present his work to the public without risking the loss of a part of his copyright protection . . . A literal reading of the clause would mean, moreover, that an innocent purchaser of a copy from a conceded pirate would be free to resell it without liability for infringement. Yet the cases to the contrary are legion.¹⁸⁰

There is a chance, however, that a court would declare the Time-Life reservation of title clause a mere subterfuge to get around the first sale doctrine; that the transaction is a true sale, the copyright owner has received his just reward, and the Time "ownership" is illusory. In *United States v. Masonite Corp.*,¹⁸¹ the Supreme Court saw through a "del credere" agency device in an analogous patent situation, and found a resale price fixing violation of the Sherman Act. Justice Douglas handed down the decision:

this Court has quite consistently refused to allow the form into which the parties chose to cast the transaction to govern. The test has been whether or not there has been such a disposition of the article that it may fairly be said that the patentee has received his reward for the use of the article . . . the promotion of the progress of science and the useful arts is the "main object"; reward of inventors is secondary and merely a means to that end That must be the point of departure for decision on the facts of cases such as the present one lest the limited patent privilege be enlarged by private agreements so as to by-pass the Sherman Act Since patents are privileges restrictive of a free economy, the rights which Congress has attached to them must be strictly construed so as not to derogate from the general law beyond the necessary requirements of the patent statute . . . the result must turn not on the skill with which counsel has manipulated the concepts of "sale" and "agency" but on the significance of the business practice in terms of restraint of trade.¹⁸²

On the other hand, 22 years later Justice Douglas, while knocking down another "consignment" device in *Simpson v. Union Oil Co. of California*,¹⁸³ said, in dictum, that copyright and patent proprietors have

¹⁸⁰ 315 F.2d 347, 351.

¹⁸¹ 316 U.S. 265 (1942).

¹⁸² *Id.* 278-280.

¹⁸³ 377 U.S. 13 (1964).

more leeway in determining a first sale than other product distributors. Distinguishing *United States v. General Electric Co.*¹⁸⁴ on its patent facts, Douglas refused to overrule its allowance of an almost identical and obviously artificial agency device to fix the retail price of patented lamps:

The Court in that case particularly relied on the fact that patent rights have long included licenses "to make, use and vend" the patented article "for any royalty or upon any condition the performance of which is reasonably within the reward which the patentee by the grant of the patent is entitled to secure." *Id.* at 489 The patent laws which give a 17-year monopoly on "making, using, or selling the invention" are *in pari materia* with the antitrust laws and modify them *pro tanto*. That was the *ratio decidendi* of the *General Electric* case. See 272 U.S., at 485.¹⁸⁵

Justice Stewart, dissenting, accused Douglas of misreading the *General Electric* case, saying that the patent factor had nothing to do with the decision on the consignment device, and should have nothing to do with such decisions:

Possession of patent rights on the article allegedly consigned has no legal significance to an inquiry directed to ascertaining whether the burdens, risks, and rights of ownership actually remain with the principal or have passed to his agent ¹⁸⁶

A careful reading of the *General Electric* case reveals that Stewart is probably right; the patent law arguments of the 1926 Court applied only to a second antitrust charge, involving not retailers, but a license to Westinghouse to manufacture and sell the lamps.¹⁸⁷ But Douglas' interpretation still stands, and thus perhaps even an illusory device to avoid the first sale doctrine might hold up, although patents are not completely analogous to copyrights.

The question may turn on the incidents of Time's legal title—whether any real rights of ownership have been retained. If so, it could be argued that the provision is a valid method of extending the copyright monopoly because the very restriction of not being able to part with possession of the program, and the other restrictions on use, constitute enough of a defect of title (in the purchaser) to give the retained "ownership" meaning and validity. Thus, if the restrictive provisions are

¹⁸⁴ 272 U.S. 476 (1926).

¹⁸⁵ 377 U.S. 13, 22-24.

¹⁸⁶ *Id.* 29.

¹⁸⁷ 272 U.S. 476, 490.

violated, Time could sue for copyright infringement, as well as breach of contract, because there has been no "first sale." The argument is circular, however, since the validity of the restrictions is based on the restrictions themselves.

Under the Revision Bill,¹⁸⁸ the validity of this type of provision would be on a somewhat firmer basis. Section 109(c) provides explicitly that the rights of the owner of a particular copy of a copyrighted work to sell, otherwise dispose of, or publicly display the copy do not apply to persons who have acquired their copies by "rental, lease, loan, or otherwise, without acquiring ownership of it." Section 106(3) provides for an exclusive right to distribute copies to the public "by sale or other transfer of ownership, or by rental, lease, or lending." The generality of these terms suggests wide latitude in the construction of contracts for use without sale, but the possibility remains that a court would hold the above-discussed reservation of rights a subterfuge.

III. CONCLUSION

The present United States law is inadequate in its handling of the audiovisual package. The myopic classification as motion pictures, the attendant lack of sufficient performance rights, the confusing law as to the use of music, and the vagaries of fair use cry out for change. The Revision Bill, while offering some improvement, does not afford the kind of protection that logic, efficiency, fairness, and a devotion to the Constitutional mandate of promoting the creative output of our artists demands.

This observer would recommend the establishment of a separate class of works for audiovisual programs distributed at retail, to be treated in some ways like motion pictures but in other ways like sound recordings. Special provision should at least be made for the audiovisual musical performance, which is so much like a sound recording, and may well replace the sound recording. Compulsory licensing for reproduction should be applied at least to these purely musical performances, and suggestions such as a waiting period and a percentage rate should not be ignored. Performers should be guaranteed performance fees for such works, not merely for audio-only recordings. While this author has hesitated on the compulsory performing license and the juke-box provision because of the multiple playability question, I am confident that these programs do have high multiple playability, and would urge the extension of these provisions as soon as my conviction is empirically affirmed.

¹⁸⁸ S.1361.

The limitations on performance rights of Section 110 of the Revision Bill should also be adjusted.

Entertainment, including music, television, theatre, art and motion pictures, is a major concern of everyone. Our public occupies much of its leisure time with the endeavors of our creative artists; television and music have provided an escape for millions from the humdrum realities of everyday existence. Audiovisual programs, tying the two together, will revolutionize home entertainment, and are expectantly awaited by the American public. The deficiencies of the law should not be permitted to delay, impede, or carelessly alter the nature of the popularization of this new technology. The copyright law affects the entertainment industry profoundly, and the shape of the law will have much to do with the shape of the audiovisual industry. Such an immensely important project as the revision of the copyright statute should not be attempted haphazardly or be influenced by the unwillingness of weary legislators to examine the full consequences of their actions. Once a revision bill is passed, it will probably not be easy to focus Congressional attention on copyright again for many years.

PART II.

LEGISLATIVE AND ADMINISTRATIVE DEVELOPMENTS

1. United States of America and Territories

94. U.S. CONGRESS. HOUSE.

Extending prohibition of piracy of sound recordings. In *Congressional Record*, vol. 120, no. 151 (daily ed. Oct. 7, 1974), H9976-H9979.

The House debates on H.R. 13364, the bill to make permanent the law against piracy of sound recordings and to increase the penalties for such piratical conduct. The House passed the bill by a voice vote, under suspension of the rules, after agreeing to increase the maximum fine for a first offense to \$25,000, or imprisonment for not more than one year or both, and to \$50,000 or imprisonment for not more than two years or both for subsequent offenses.

95. U.S. CONGRESS. HOUSE. *Railsback, Tom.*

Copyright reform. In *Congressional Record*, vol. 120, no. 155 (daily ed. Oct. 11, 1974), p. H10525.

Representative Railsback causes to be inserted into the *Record* an article, published in the October 7, 1974, issue of the *New York Times* under the caption "A Law for Creativity". The article points out the need for copyright reform legislation.

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

Extending prohibition of piracy of sound recordings. Report, together with dissenting views, to accompany H.R. 13364, submitted by Mr. Kastenmeier, September 30, 1974. 17 p. (93d Cong., 2d Sess., H. Rep. No. 93-1389)

A favorable report, with amendments lowering the imprisonment terms, and dissenting views by Congressman Robert F. Drinan. See Item 94, *supra*.

97. U.S. CONGRESS. SENATE. *Williams, Harrison A., Jr.*

Performing arts royalty. In *Congressional Record*, vol. 120, no. 136 (daily ed. Sept. 11, 1974), p. S16432.

Senator Williams states that he was unable to be present for the

vote on the Ervin amendment to the revision bill, S. 1361, in favor of deleting sec. 114 to provide for performance royalty payments, but that if he had been present he would have voted against the amendment. He expressed the hope that the performing arts royalty would be incorporated into the revision bill by the 94th Congress.

98. U.S. DEPARTMENT OF THE TREASURY. CUSTOMS SERVICE.

19 CFR Part 133. Trademarks, trade names, and copyrights: fees and copyrights. In *Federal Register*, vol. 39, no. 184 (Sept. 20, 1974), pp. 33803-33804.

A proposal to "provide for an increase in Customs fees to be submitted for trademark, trade name and copyright recordings, ownership changes, name changes, and renewals of a recorded trademark or copyright recordation, and to provide for the consistent treatment of trademark and copyright fees." Comments are invited by October 21, 1974.

99. U.S. FEDERAL COMMUNICATIONS COMMISSION.

47 CFR—Telecommunication. Part 76—Cable television service; carriage of late-night television: programming by cable TV systems. In *Federal Register*, vol. 39, no. 182 (Sept. 18, 1974), pp. 33528-33532.

An amendment of the Commission's rules to allow cable television systems to import late-night programming from the sign-off of the last station which a cable system must carry to the sign-on of the first station which the system must carry. Included among comments for and against the adoption of the new rules are those by copyright owners and broadcasters opposing them as being beyond the Commission's authority and in violation of the copyright law.

2. Foreign Nations

100. BRAZIL. *Laws, statutes, etc.*

Law on the rights of authors and other provisions. (No. 5988, of December 14, 1973). In *Copyright*, vol. 10, no. 7 (July 1974), pp. 181-191.

An English translation of the new Brazilian law on copyright and neighboring rights which entered into force on January 1, 1974, "without abrogation of special legislation which is in conformity with it."

101. SENEGAL. *Laws, statutes, etc.*

Law on the protection of copyright. (No. 73-52, of December 4, 1973). In *Copyright*, vol. 10, no. 8 (Aug. 1974), pp. 211-217.

"Published in the Journal officiel de la République du Sénégal, of December 29, 1973 (No. 4333)—WIPO translation."

PART IV.

JUDICIAL DEVELOPMENTS IN LITERARY AND ARTISTIC PROPERTY**A. DECISIONS OF U.S. COURTS****1. Federal Court Decisions**

102. *International Tape Manufacturers Association v. Gerstein*, 494 F.2d 25 (5th Cir. May 13, 1974) (Thornberry, C.J.).

Action by association of tape manufacturers to declare Florida's "tape piracy" statute unconstitutional because of a conflict with the federal copyright law. The Florida law gives eternal protection whereas the Federal statute extends protection for a maximum of 56 years. The Court below held the Florida statute to be invalid. On defendant's appeal, *held* vacated and remanded.

The Court held there was no justiciable controversy, which, as a jurisdictional defect, required the judgment of the lower court to be vacated. The plaintiffs had offered no evidence to establish either that their members were subject to the jurisdiction of the Florida courts or that they were specifically threatened with enforcement. The fact that the members' duplicating activities, if carried on in Florida, would violate the tape piracy law, was insufficient to establish a justiciable controversy.

103. *Bartok v. Boosey & Hawkes*, not yet reported, 73-4570 (S.D.N.Y. Sept. 27, 1974) (Owen J.).

Suit by Peter Bartok, son and heir to the late composer, Bela Bartok, for the renewal rights to his father's concerto for orchestra. The maestro had assigned his rights in all his works to his publisher in 1939. While the concerto was performed publicly prior to Bartok's death, the publisher did not print and distribute copies of the work until after his death, at which time the publisher argued, the original term of copyright commenced.

Held, judgment for defendant.

It was noted that under the Copyright Law the composer or his surviving spouse or children are entitled to the renewal term of the copyright (notwithstanding an earlier assignment of the original term to another) *except* where the commencement of statu-

tory copyright was posthumous. Owen rejected Bartok's argument that the extensive performance of his father's musical work prior to his father's death should supersede the date of the actual printing of the music. Owen's decision rested on the more traditional approach that statutory copyright arises upon publication with notice, and publication means the making public of tangible copies understandable to the human eye.

104. *Donna v. Dodd, Mead & Co., Inc., et al*, 374F. Supp. 429 (S.D.N.Y. April 19, 1974) (Lasher, D.J.).

Action by author for infringement of copyright arising from co-author's subsequent publication, in conjunction with the other defendants, of three similar works without the consent of plaintiff author. In composing the original work entitled, "The Boy of Masai", plaintiff author had supplied the text and the co-author the photographs.

Held, complaint dismissed.

The plaintiff agreed that "a joint owner of copyright and his licensees cannot be liable to a co-owner for copyright infringement . . . since a copyright owner cannot infringe his own copyright". Therefore, plaintiff's action for infringement was bot-tomed on the argument that the original work was "composite" rather than "joint" and that therefore the writer of the text and the contributor of the photographs each owned separate copyrights to their respective contributions.

In rejecting plaintiffs' argument as to the definition of a "joint" work, the Court articulated the following summary of the present law which bears on that question:

"Although traditionally creation of a joint work required a common design which existed before the elements of the work were produced, that requirement has been considerably eroded. Nimmer on Copyright § 69. In *Marks*, supra, the Court of Appeals for this Circuit held that a joint work can result from the labors of persons who are strangers to each other and who work at different times, if each contributor contemplates that his work will form part of a whole to which someone else will also contribute. See also *Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc.* ("Melancholy Baby"), 161 F.2d 406 (2d Cir. 1946). Subsequently, the preconcerted design standard for joint authorship was further relaxed in *Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc.* ("12th Street Rag"), 221 F.2d 569, modified on rehearing, 223 F.2d

252 (2d Cir. 1955). 12th Street Rag held that, even if at the time one element of a joint work is created no intent to contribute to a joint work exists, if at any time thereafter the author of his assignee conceives and carries out such an intention, the resulting combination will be a joint work."

Applying these rules to the present case, it is clear that "Boy of the Masai" is a joint work. Although [the] photographs were not taken with [plaintiff's] text specifically in mind, it appears that they may have been intended from the start to become part of a joint work with text from another source. [Plaintiff's own affidavit states that she was informed by [the co-author] before she worked with him that he had already submitted the photographs to a publisher and been rejected If so, their subsequent collaboration would fall squarely within the *Marks-Melancholy Baby* rule. However, even if Larsen had no such intention when he took the photographs, Boy of the Masai is a joint work under the 12th Street Rag approach, because once Larsen and [the plaintiff] reached agreement on its creation it is evident that Larsen had the intention that his photographs be subsumed into their joint effort. At the very least, [plaintiff's] contribution, which came into being solely to complement Larsen's photographs, is jointly owned and can be licensed without her consent, subject only to a duty to account. Nimmer on Copyright §73.1.

[Plaintiff] concedes that, under the case law discussed above, "Boy of the Masai" would probably be considered a joint work However, she argues that this approach was modified in *Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640 (S.D.N.Y. 1970), *aff'd* on other grounds, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997, 93 S.Ct. 320, 34 L.Ed.2d 262 (1972). While it is true that *Picture Music* points out that the *Marks-Melancholy Baby*—12th Street Rag approach has been criticized, there is no indication that the Court intended to depart from it. Rather, it found that there was no collaboration whatever between the claimed joint authors, no intention conceived at any time by the original author to create a new work and no substantial contribution by any person other than the original author. 314 F. Supp. at 647. As a result, the copyright at issue in *Picture Music* was not jointly owned even under *Marks*, *Melancholy Baby* and 12th Street Rag. Moreover, the Second Circuit opinion in *Picture Music* does not consider the joint authorship question. Thus, the earlier cases stand as the law of this Circuit, and we decline plaintiff's invitation to depart from them. Accordingly, the cause of action for copyright infringement fails to state a claim for which relief can be granted."

105. *Meredith Corporation v. Harper & Row, Publishers, Inc.*, 182 U.S.P.Q. 609 (S.D.N.Y. May 29, 1974) (Owen, D.J.).

Action for declaratory judgment that Harper's work did not infringe Meredith's copyright in a competing work. The record disclosed that Meredith's textbook was used as a model in the preparation of Harper's textbook both as to structure and as to content. A comparison of the two revealed that significant portions of Harper's work was direct paraphrasing of parallel portions of Meredith's work performed by freelance writers who were unfamiliar with the subject of the text. On Meredith's motion to preliminarily enjoin Harper's from further publication, distribution, and/or sale of its work, *held*, motion granted.

Since the Plaintiff had established a *prima facie* case of infringement by proving ownership of a valid copyright and copying by Defendant, Defendant argued that its activities should be excused on either of two grounds: one, that Defendant's use was a "fair use" of Plaintiff's work, and two, that Plaintiffs are barred by laches.

Fair use: For the following three reasons, the Court rejected Defendant's defense:

- (1) As to the competitive effect and function of Defendant's usage, "The sale of the [Defendant's] book in the same marketplace as [Plaintiff's] would substantially injure the revenues of the [Plaintiff's] book."
- (2) As to the quantity of the materials used, that the amount taken was not "insignificant" but was, rather, "substantial" as to text, structure, and topical sequence. Such taking, the Court concluded, was "extensive" and "far beyond" any copying sanctioned by either *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F. 2nd 303 (2nd Cir. 1966) or *Orgel v. Clark Boardman Co.*, 301 F.2nd 119 (2nd Cir.), *cert denied*, 371 U.S. 813 (1962).
- (3) As to the purpose of the use, "there is no question on this record that it was to enable [Defendant] to compete with the very text from which the selections were taken; that this is impermissible hardly needs statement."

The Court also noted that any other decision would discourage the type of scholarship and writing necessary in the creation of a work such as Defendant's, and that students should be reading the original work of scholarship rather than a non-academic, paraphrased edition.

Laches: The Court rejected this defense, despite a delay of quite some time. The delay was not caused by Plaintiff's neglect but was, rather, due to the importance of new evidence which emerged after discovery, an earlier selling season for textbooks due to an

anticipated paper shortage, and the possible delay of a trial date. Due to these circumstances, earlier protection was needed, and hence the motion would not be barred.

Irreparable injury: Although the Court stated in dicta that one who makes out a prima facie case of copyright infringement is entitled to a preliminary injunction "without a detailed showing of danger of irreparable harm", *Uneeda Doll Co., v. Goldfarb Novelty Co.*, 373 F.2d 851-852 (2nd Cir. 1967), the Court held that there was, "on this record more than sufficient likelihood of irreparable harm to justify . . . injunctive relief."

106. *Monster Music et al. v. Abbeville Radio, Inc.* 332 F. Supp. 1047 (M.D. Ala. July 28, 1971) (Varnes, D.J.).

The initial decision in this case, reported at 328 F. Supp. 225 (M.D. Ala., S.D., 1971) and discussed at 21 BULL. CR. SOC. 336, Item 313, found the defendants liable for infringement of four of plaintiffs' copyrighted musical compositions but awarded only a limited recovery of \$33.00 with costs rather than statutory damages. Thereafter, in accordance with a settlement between the parties (probably as to liability of the defendants for infringements of other works of plaintiffs), Judge Varner vacated that opinion, order and judgment and entered a new order awarding statutory damages, namely, \$250.00 for each infringement, or \$1,000.00 total.

107. *In re "Truck in" Cartoon Characters Copyright Litigation*, 182 U.S.P.Q. 366 (Judicial Panel on Multi District Litigation March 28, 1974, amended April 3, 1974) (Per Curiam).

Motion to transfer to one District Court more than 30 actions for alleged infringement of plaintiff's copyright in his cartoon characters. The defendants are unrelated manufacturers, distributors and retailers of novelty items.

Held, motion denied.

Although the Panel conceded that validity of copyright would be an issue in each case, such a limited "common question was insufficient to warrant a transfer." Rather, the "main thrust of these actions, [was] whether the copyright protection extends to the various types of alleged exploitation. Since defendants market[ed] the novelty items at different levels, and the nature and degree of their use of the . . . characters varie[d] widely, discovery in each action [would] necessarily focus on individualized conduct".

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

108. The Art of Typeface Design and Visual Communication, *Washington, October 15-16, 1974*. [Addresses of permanent panelists. Washington, 1974]

A seminar on artistic, industrial, and legal aspects of typographic design. Contents: Type design and art by Alvin Eisenman. Typography and copyrights, unfair competition, patents & trademarks, by Joseph P. Gastel. Typeface development, production and implementation, by Mike Parker. Typography and the public sector; Government needs for typefaces, by David A. Sutton. A. Sutton.

109. COPYRIGHT LAW SYMPOSIUM, No. 21, New York, Columbia University Press, 1974. 286 p. (Nathan Burkan Memorial Competition, 1971)

The prize essays are analyzed separately, *infra*.

110. GELLER, HENRY. The mandatory origination requirement for cable systems. Santa Monica, Calif., Rand, Aug. 1974. 32 p. (R-1548-FF) "Prepared under a grant from the Ford Foundation."

"A draft of this report was submitted to the Federal Communications Commission in May 1974, in response to the Commission's request for the views of interested persons on its requirement for mandatory program origination by cable television systems." The report "suggests that the key public interest requirement is that the cable system provide local access; that is, a first or additional outlet for local expression rather than programming fare presented by the system owner himself."

111. MUETH, JOSEPH E. Outline of copyrights, patents and trademarks. Irvington-on-Hudson, N.Y., American Legal Publications, 1974. 110 p. (Blackstone law summaries)

Partial contents: The purposes of patent, trademark and copyright law. Copyright. Rights of a copyright holder. Copyright infringement. Remedies for copyright infringement. Brief statements of the law, and a perspective of each subject interspersed with a review of leading cases and pertinent dicta and statutes, for classroom use.

112. RECORDING INDUSTRY ASSOCIATION OF AMERICA. State laws against piracy of sound recordings: a handbook for enforcement and prosecution. New York, July 1974. 22 p. (loose-leaf)

"This handbook is intended as an aid to law enforcement agencies in those states which have adopted . . . [anti record piracy] statutes." It includes information on recording industry nomenclature and practices, hints on detecting piratical activities, and assistance in the prosecuting of offenders. An appendix contains a list, in tabular form, of state anti-piracy statutes, effective dates, type of offense (misdemeanor or felony), penalties imposed, and scope of coverage.

113. SCHAEFFER, MORTON. Copyrights. In *Intellectual property law for the general business counselor: patent/trademark/copyright*. Illinois Institute for Continuing Legal Education, Springfield, Ill., 1973, pp. 8/1-8/40.

One of the chapters in a handbook which summarizes the law in all fields of intellectual property in the United States for the general business counselor.

2. Foreign Publications

1. In English

114. Te-Hsier Huang. Bibliography on copyright. 2d ed. Halifax, Nova Scotia, Canada, 1972. 124 p.

Contains lists of materials on copyright-cited from legal and non-legal sources including articles, treatises, cases, reports, and proceedings.

115. Te-Hsian Huang. Union list of copyright publications in West European libraries. Halifax, Nova Scotia, Canada, 1974. 625 p.

It contains treatises, bibliographies, manuals, cases, reports,

decisions, documents, festschriften, serials, proceedings and others. English and European publications are included.

2. In German

116. *Wörterbuch des Verlagswesens in 20 Sprachen*, hrsg. von Imre Móra. The Publisher's practical dictionary in 20 languages, edited by Imre Móra. Pullach/München, Verlag Dokumentation, 1974. 389 p.

Published "with the object of promoting the efficiency of business contacts between the publishers of the countries (practically all the states of Europe, North and South America) united in the Berne Convention and the Universal Copyright Convention."

B. LAW REVIEW ARTICLES

1. United States

117. BOYERS, SARA JANE. Protection for the artist: the alternatives. In *Copyright Law Symposium*, no. 21 (1974), pp. 124-164.

A paper, awarded a tie for the National Fifth Prize in the 1971 Nathan Burkan Memorial Competition, which examines the economic interests of the pictorial artist in his work, the nature and applicability to the United States of the *droit de suite* in Europe with particular emphasis on France, and some of the proposed systems that would implement a policy that grants the artist a share in the economic success of his work.

118. BRYLAWSKI, E. FULTON. Renewal of copyright in a magazine contribution: a belated view. *The George Washington Law Review*, vol. 42, no. 4 (May 1974), pp. 737-760.

This article proposes "to show that an author's renewal privilege should not depend upon the accident or form in which his work is first published or copyrighted. If, as the legislative history indicates, an author or his statutory successors is entitled to renew his independently created work, he should be entitled to the same renewal privilege whether his work is originally copyrighted separately or as part of a periodical or collection."

119. COHEN, ERIC. Patentability of computer programs. *University of*

Miami Law Review, vol. 27, nos. 3-4 (Spring-Summer 1973), pp. 494-504.

A note on the Supreme Court decision in *Gottschalk v. Benson*, 409 U.S. 63, digested in 20 BULL. CR. SOC. 198, Item 141 (1972).

120. CURTIS, FRANK R. Protecting authors in copyright transfers: revision bill §203 and the alternatives. *Copyright Law Symposium*, no. 21 (1974), pp. 165-234.

A study, awarded a tie for National Fifth Prize in the 1971 Nathan Burkan Memorial Competition, of the termination-of-transfers provision, incorporated in S. 644, 92d Cong., 1st Sess. (1971), and of several possible alternatives. A later version of this study appeared in 72 Colum. L. Rev. 799 (1972). See 20 BULL. CR. SOC. 210, Item 149 (1973).

121. DURHAM, DANE J. Goldstein v. California: validity of state copyright under the copyright and supremacy clauses. *Hastings Law Review*, vol. 25, no. 5 (April 1974), pp. 1196-1225.

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122. GARNER, DANIEL CHARLES. Copyright—new light on *Sears* and *Compco*—State copyright laws are not totally preempted by the Copyright Act. *Texas Tech Law Review*, vol. 5, no. 3 (Spring 1974), pp. 843-850.

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124. KOHN, ALAN. Posthumous work defined in dispute over copyright; first impression ruling on Bartok concerto. *New York Law Journal*, vol. 172, no. 65 (Oct. 1, 1974), p. 1, cols. 3-4; p. 4, cols. 4-6.

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of New York. The ruling is to the effect that the renewal rights in the late composer Bartok's "Concerto for Orchestra" are in the publisher to which rights to the composer's works had been assigned, and not in the composer's son. The suit involved a definition of a "posthumous work", which the court held to be "one that is published and copyrighted after the death of the author, no matter if the work, in this case a concerto, has been performed during the author's lifetime."

125. LANG, JOHN WALTON. Performance and the right of the performing artist. *Copyright Law Symposium*, no. 21 (1974), pp. 69-97.

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126. LOW, JAMES R., JR. Copyrights—INFRINGEMENT—false and fraudulent material is entitled to copyright protection. *St. Mary's Law Journal*, vol. 6, no. 1 (Spring 1974), pp. 274-279.

A critical note on the decision in *Belcher v. Tarbox*, 486 F.2d 1087, digested in 21 BULL. CR. SOC. 331, Item 306 (9th Cir., 1973).

127. NELSON, MARSHALL J. Jazz and copyright: a study in improvised protection. *Copyright Law Symposium*, no. 21 (1974), pp. 35-68.

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128. SAMUELS, EDWARD. *Goldstein v. California*: breaking up federal copyright preemption. *Columbia Law Review*, vol. 74, no. 5 (June 1974), pp. 960-982.

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129. SILVERMAN, B. SCOTT. CATV and copyright liability: Teleprompter Corp. v. Columbia Broadcasting System, Inc. and the consensus agreement. *Hastings Law Journal*, vol. 25, no. 6 (May 1974), pp. 15-7-1548.

"This note will trace and analyze the significant CATV copyright cases culminating in the recent Supreme Court decision of *Teleprompter Corp. v. Columbia Broadcasting System, Inc.* [415 U.S. 394, 21 BULL. CR. SOC. 253, Item 223 (1974)] which seems to have finally settled the issue under the Copyright Act of 1909 in favor of nonliability. It will discuss the underlying economic and policy arguments and considerations in the context of both copyright and administrative regulation. Finally, it will focus on the compromise negotiated by the interested parties for integrating copyright and regulation, and suggest several changes in proposed copyright legislation for a final and more satisfactory resolution of the uncertainties which have plagued CATV over the past decade."

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2. Foreign

1. In English

133. DUVAL, HERMANO. Letter from Brazil, *Copyright*, vol. 10, no. 7 (July 1974), pp. 192-202.

A survey of copyright developments in Brazil covering the period from 1970 to 1973, divided into the following four sections: International relations, Domestic legislation, Domestic case law, and Miscellaneous.

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An article-by-article analysis of the new convention, preceded by some general considerations and previous history, and followed by the author's conclusions. The English text of the Convention appears on pp. 60-61 of the *Review*.

135. N'DIAYE, N'DÉNÉ. Letter from Senegal: Law on the protection of copyright. *Copyright*, vol. 10, no. 8 (August 1974), pp. 218-220.

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A discussion of copyright problems raised by new audio-visual channels of communication. The German version appeared in 1973 *GRUR Int.* 315. See 21 *BULL. CR. SOC.* 186, Item 139.

137. SCHULZE, ERICH. Collective administration and new types of exploitation in the copyright field. *EBU Review: Programmes, Administration, Law*, vol. 25, no. 5 (Sept. 1974), pp. 43-46.

An account of the administration of copyrights by the West German performing rights society, GEMA, with respect to new types of exploitation such as cable distribution, and the use of new audiovisual media.

138. Suggestions concerning the measures which might be taken in order to facilitate the access of developing countries to protected works with respect to copyright. *Newsletter of the Regional Centre for Book Development in Asia*, vol. 16, no. 3 (July 1974), pp. 9-10, 16-23.

Established from recommendations drawn up by a meeting of officials of regional or national copyright information centers and of publishing associations or agencies representing authors, which

took place at Unesco Headquarters in Paris from May 21-25, 1973. The meeting was convened in order to assist the International Copyright Information Centre in establishing a program of activity to enable it to fulfill as efficiently as possible the mandate entrusted to it. The "suggestions are preceded by some comments about the infrastructure required for undertaking publishing activities, together with a rapid survey of the problems encountered by developing countries wishing to use works protected by copyright."

2. In German

139. BIELENBERG, PETER EDUARD. Das urheberrechtlich schützbares Werk und das Urheberpersönlichkeitsrecht. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 76, no. 9 (Sept. 1974), pp. 589-590.

A discussion of the protection of an author, under the German copyright law, in respect to his intellectual and personal relations to the work and its utilization, with emphasis on works of the fine arts.

140. GERSTENBERG, EKKEHARD. Der "Bestseller-Paragraph" in der Praxis. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 76, no. 0 (Sept. 1974), pp. 591-593.

A contribution to a festschrift in honor of the 80th birthday of Dr. Ludwig Heydt, which deals with the practical application of article 36, referred to by the author as the "bestseller paragraph", of the copyright law of the German Federal Republic. This article provides, in effect, that if a licensee of an author makes the stipulated remuneration grossly disproportionate to the proceeds from the exploitation of the work, the contract must, at the request of the author, be amended in order to ensure the author an equitable share in the proceeds.

141. MOVSESSIAN, VERA. Spielfilmauswertung—Zweckübertragungstheorie und neue audio-visuelle Medien; eine Entgegnung. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 76, no. 7 (July 1974), pp. 371-376.

A paper on the protection of feature films, under the copyright law of the German Federal Republic, with respect to their exploitation, other than in conventional motion-picture theaters, by new audio-visual media.

142. MÜNZER, GEORG, and HEINZ PÜSCHEL. Die Stellung des Urhebers im Arbeitsrechts-verhältnis; zum Charakter der in einem Arbeits-rechtsverhältnis erbrachten urheberrechtlich geschützten Leistungen. *Neue Justiz*, vol. 28, no. 12 (June 1974), pp. 357-362.

A study of copyright and the employment relationship under the copyright law of the German Democratic Republic.

143. ULMER, EUGEN. Das Folgerecht im internationalen Urheberrecht. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 76, no. 9 (Sept. 1974), pp. 593-601.

A contribution to a festschrift in honor of the 80th birthday of Dr. Ludwig Heydt, which is a comparative study of the *droit de suite*, with emphasis on its regulation by the Berne and Universal Copyright Conventions.

144. WEISSTHANNER, MARGOT. Urheberrechtliche Probleme experimenteller Musik. *Gewerblicher Rechtsschutz und Urheberrecht*, vol. 76, no. 7 (July 1974), pp. 377-381.

A paper on copyright problems of experimental music in the German Federal Republic.

3. In Italian

145. ALGARDI, ZARA OLIVIA. Brevi note sulla condizione giuridica dell'opera d'arte oggetto di tutela artistica e di diritto di autore. *Il Diritto di Autore*, vol. 44, no. 3, pp. 271-301.

A brief note on the protection of works of art in Italy as a matter of the cultural heritage of the country and by copyright.

146. DE SANCTIS, LORENZO. In tema di reprografia e diritto d'autore. *Il Diritto di Autore*, vol. 45, no. 1 (Jan.-Mar. 1974), pp. 35-45.

A paper on international efforts toward finding a solution to the problem of unauthorized photocopying of protected works, followed by an analysis of the pertinent provisions of the Italian copyright law.

147. SANTORO, EMANUELE. Attività giornalistica e creatività: dati e spunti preliminari (con Postilla di M. Fabiani). *Il Diritto di Autore*, vol. 45, no. 1 (Jan.-Mar. 1974), pp. 1-34.

An article on the protectibility of news, with particular emphasis on newspaper journalism, under Italian copyright law and jurisprudence, with a postscript by Professor Fabiani.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

148. CARMODY, JOHN. To preserve a legacy of news. *The Washington Post*, Nov. 15, 1974, pp. B1, cols. 1-5; B4, cols. 1-3.

An article on a joint announcement made on November 14 by CBS, Inc. and the General Services Administration about a two-year pact pursuant to which CBS would make available all its television "hard news" programs, including specials, to "responsible researchers" throughout the nation through the National Archives, starting early next year. According to the article, a spokesman for CBS stated that the status of the suit against Vanderbilt Television News Archive would not be affected.

149. DANIEL, OLIVER. Universities' non-payment for performances adds to controversy in BMI survey. *Billboard*, vol. 86, no. 39 (Sept. 28, 1974), pp. 54, 56.

An article on a recent BMI orchestral survey, prepared in cooperation with the American Symphony Orchestra League, which showed that most universities do not make payments of performance fees in connection with university concerts.

150. DEMBART, LEE. Photocopying splits publishers, libraries. *N.Y. Times*, Oct. 29, 1974, at 30, cols. 1-4 (city ed.)

An article on the controversy between publishers and libraries concerning library photocopying of copyrighted material, with emphasis on the *Williams & Wilkins* case.

151. Drive is on to free cable from FCC rules; emancipation sought from regulation of pay cable and broadcast carriage; 1977 deadline on beefed-up plants; Commissioner Robinson sympathetic. *Broadcasting*, vol. 87, no. 17 (Oct. 21), pp. 23-24.

An article on a recent meeting at the Northeast Cable Exposition in Philadelphia at which delegates called for "a suspension of

all restrictions on broadcast carriage and the postponement or preferably abandonment of the 1977 deadline for compliance by all systems with the FCC's technological rules." Representative Charles Sandman (R.-N.J.), one of the speakers, claimed that "[c]omplicated FCC regulations as well as the pending copyright bill (S. 1361) 'all tend to stifle legitimate growth'."

152. HARRIS, PAUL. New copyright law still a year away. *Daily Variety*, vol. 165, no. 37 (Oct. 29, 1974), p. 82.

An article on the prospects for a new copyright law during the next session of Congress, with a run-down on a number of provisions in the bill as passed by the Senate that directly or indirectly affect everyone in show business.

153. HENRY, NICHOLAS L. Copyright, public policy, and information technology. *Science*, vol. 183, no. 4123 (Feb. 1, 1974), pp. 384-391.

A paper on discussions about the roles information technology should play in the American polity, which have been taking place within the more general debates on U.S. copyright law revision, with special reference to computer-based information storage and retrieval systems and photocopying technologies.

154. A little wonder cable wants another look at copyright; CATA-Kentucky 'copyright summit' features heated exchange between cable attorney and NCTA president over 'traps' in copyright bill. *Broadcasting*, vol. 87, no. 18 (Oct. 28, 1974), pp. 22-24.

"National Cable Television Association may soon be taking another look at its position on copyright issue which, considering political turmoil subject has recently aroused in industry, is no surprise. Small operators' concerns that pending copyright bill could scuttle industry—espoused by Washington lawyer Sol Schildhouse—and NCTA's respect for 'political realities'—voiced by President David Foster—were captured dramatically at Lexington, Ky., 'summit' meeting [organized by the Community Antenna Television Association and the Kentucky Association], excerpts of which are reprinted herein."

155. LOTTMAN, HERBERT R. Frankfurt 1974: in an inflationary time, prudence, caution and high professionalism. *Publishers Weekly*, vol. 206, no. 19 (Nov. 4, 1974), pp. 46-53.

An article on the 26th Frankfurt Book Fair, held from October 10-15, which includes an account of, among other activities, conferences with the Russians on East-West copyright relations, and a separate story about the attitudes of scientific-technical publishers in regard to unauthorized photocopying.

156. Need for two collection fee agencies questioned. *Billboard*, vol. 86, no. 39 (Sept. 28, 1974) p. 66.

An article about a view being expressed by an increasing number of composers and publishers in Canada that there may be no justification in having two public performance fee collection organizations in Canada: CAPAC and BMI. Most of the article is devoted to statements in this regard by Peter Steinmetz, a prominent music industry lawyer in Canada.

157. SCHULMAN, MICHAEL. Unauthorized photocopying illegal, immoral; publishers avoid the villain role with schools, churches. *The Music Scene*, no. 279 (Sept.-Oct., 1974), pp. 5, 17.

An article on the attitudes of a number of Canadian music publishers toward the unlicensed photocopying of music by schools and churches in Canada.

158. WAGNER, SUSAN. Political action, campaign contributions urged by Hoopes to influence Congress. *Publishers Weekly*, vol. 206, no. 14 (Sept. 30, 1974), pp. 35-36.

An article on the proceedings at the second annual publishers forum held in Washington under the sponsorship of the Association of American Publishers on September 18. One of the subjects discussed was copyright revision, which included remarks by Representative Robert W. Kastenmeier, chairman of the House copyright subcommittee, concerning House action during the next Congress.

2. Foreign

1. England

159. Copyright: P.A. submission to the Whitford Committee. *The Bookseller*, no. 3584 (Aug. 31, 1974), pp. 1620-1622, 1624-1626.

Excerpts from a submission by the Publishers Association to the Whitford Committee, which has been charged by the Minister for Trade to consider the U.K. law on copyright and designs.

160. The New South Wales Judgment. *The Bookseller*, no. 3585 (Sept. 7, 1974), pp. 1732, 1734.

An article on a recent decision of the Supreme Court of New South Wales in an action by *Angus & Robertson et al. v. University of New South Wales*, involving alleged copyright infringement by the defendant arising out of the use of eight token-operated photocopying machines in the University library.

161. Photocopying and fair dealing: submissions to the departmental committee. *The Bookseller*, no. 3585 (Sept. 7, 1974), pp. 1728-1732.

A summary of a submission by the British Copyright Council to the Whitford Committee, set up to review the U.K. Copyright Act of 1956. In the submission, the Council endorses the recommendations of the Publishers Association as regard photocopying.

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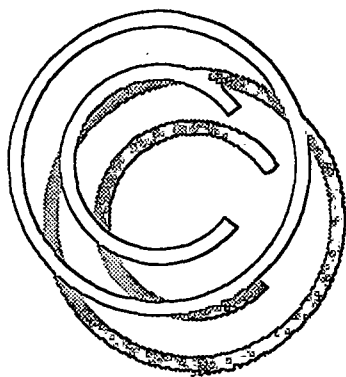
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PART I.

ARTICLES

162. OBSCOLESCENCE AB INITIO: THE NEW ACT AND
 ARCHITECTURAL COPYRIGHT*

By THEODORE HELLMUTH**

I. INTRODUCTION

The present United States Copyright Act is hopelessly antiquated. For over a decade Congress has been struggling to pass a totally new reform bill.¹ Indeed, optimistic souls hope that before another decade has passed a complete revision will actually come into law.² Unfortunately, although the latest revision bill in Congress bravely faces many of the big name copyright issues, it inartfully sidesteps one issue which after centuries of dormancy is beginning to press for main stage attention. This "sleeper" issue, which has recently begun knocking on courthouse doors across the country, is the issue of copyright protection for architectural productions.³

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¹ See House Comm. on the Judiciary, Copyright Law Revision, H.R. Rep. No. 83, 90th Cong., 1st Sess. 2 (1967) discussing the copyright reform history all the way back to 1955. For earlier history related to architectural copyright, see Strauss, *Copyright in Architectural Works*, Copyright Law Revision Study No. 27. 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 and 2d Sess. (1960-61).

² The present Register of Copyrights, Barbara Ringer, does not believe that the House version of the most recent reform bill S. 1361 93d. Cong. 1st Sess. (1973) will pass the present House. BNA's Patent, Trademark and Copyright Journal, No. 166, at A-11 (Feb. 21, 1974).

³ Four out of the mere handful of state copyright cases decided in the '70's have dealt with architectural copyright. See *Jones v. Spindel*, 128 Ga. App. 88; 196 S.E.2d 22 (1972); *Shaw v. Williamsville Manor, Inc.*, 330 N.Y.S.2d 623 (N.Y. Sup. Ct. 1972); *Ballard H.T. Kirk & Assoc. v. Poston*, 33 Ohio App. 2d 117, 293 N.E.2d 102; *Krahmer v. Luing*, 127 N.J. Super. 170, 317 A.2d 96 (1974).

Recent federal cases dealing with architectural copyright include: *Nucor Corp. v. Tennessee Forging Steel Service, Inc.*, 476 F.2d 386 (1973); *Herman Frankel Organization v. Tegman*, 367 F. Supp. 1051 (1973). The best recent commentary in this area is *Comment, Copyright Protection for the Architect: Leaks in a Legal Lean-To*, 8 CALIF. WEST. L. REV. 458 (1972).

Neither the present copyright act,⁴ nor the most recent revision bill⁵ directly mentions architectural protection at all. One has merely to read the latest advance sheets to know that this is an egregious oversight. In the past, the courts have experienced considerable difficulty in formulating sound, uniform rules of protection in areas which are not specifically covered by explicit language within the act. Their record of decision in recent architectural copyright cases does not bode any better for the future.⁶ The best solution is to set out explicit statutory guidelines in this area, even as the new bill does for the areas of sound protection and cable television.⁷

Luckily Congress need not strike out blindly in this task. A large number of more advanced nations have had explicit provisions dealing with architectural copyright within their copyright acts for decades.⁸ American copyright jurisprudence would be considerably advanced if the drafters of the new bill would analyze some of these foreign provisions and use them as a basis for drafting an explicit statement on the subject of architectural copyright within the proposed revision bill.

This paper will begin by discussing the metes and bounds of architectural production. It will then advance to a very brief, critical discussion of current American copyright protection for architects. Then it will look to the extent to which the new bill would alter existing law. Later sections will examine relevant statutory and judicial pronouncements by foreign countries followed by an outline of the status of architectural copyright under the various international treaties and conventions.

II. THE PRODUCT AND PROTECTION ISSUES

Architecture is the most prevalent, most commonly experienced of

⁴ 17 U.S.C. §§ 1-216 (1973).

⁵ S. 1361 93d Cong., 1st Sess. (1973).

⁶ Compare *Shaw v. Williamsville Manor, Inc.* 174 U.S.P.Q. 309 (N.Y. Sup. Ct. 1972) with *Jones v. Spindel* 128 Ga. App. 88, 196 S.E.2d 22 (1972).

⁷ S. 1361, 93d Cong., 1st Sess. §§ 110, 114-16 (1973).

⁸ For good updated English translations of all the copyright laws in the world, See U.N.E.S.C.O., *COPYRIGHT LAWS AND TREATIES OF THE WORLD* (1973) (hereinafter foreign statutes will be cited to these U.N.E.S.C.O. volumes citing; U.N.E.S.C.O.; the name of the country; the name of the act, sections within the act; date of last amendment.) It would serve no purpose to list the many countries which explicitly cover architectural works; suffice it to note that virtually all countries, with the notable exception of the United States, do: see e.g. U.N.E.S.C.O., France, Law No. 56-296 on Literary and Artistic Property, Art. 1-82 (1957); U.N.E.S.C.O., Germany, An Act dealing with Copyright and Related Rights, §§ Art. 1-143 (1965); U.N.E.S.C.O., United Kingdom, Copyright Statute, §§ 1-51, (1971).

all the arts. Whereas drama, music, literature, painting, graphics, and sculpture are all tremendously important, they are nonetheless mere interstitial arts compared to architecture. They are only used and enjoyed intermittently. No one lives or works in a painting. Sculptures seldom dictate the size of one's sleeping quarters. Music can generally be turned off. Contrarily, the architectural product is all-pervasive. The portentous ghetto, the mocking monument, the cryptlike office building, the sad suburban monotony, all are products of the architect's mandate. The architect is a designer, the choicemaker in the builders trade. Le Corbusier designed the city of Chandigarh, the local agriculturist designs his pigpen. Initially, the legislator must make the difficult decision as to which, if either, to protect.

If in fact the lawmaker finally decides to afford protection, two further problems immediately arise. In the first place, although a pigpen might arise in accordance with unrestrained and spontaneous fancy, Chandigarh does not. Any given architectural work of any complexity might be and often is the creation of not merely the primary architect, but of another or others as contributors. An eclectic example serves to illustrate the point. A building might begin as a sparkle in a client's eye. He relates his whimsy to the architect, who takes some minor notes. Then to prod the goose so to speak, the architect might make a little sketch. The client approves but adds a suggestion here and there. The architect returns to his office and begins the long process of actually designing the building: rough sketches, elevations, floor plans, detail drawings, renderings, three dimensional models, working drawings; all might be necessitated by the architect's twin goals of designing his work and keeping his client. Thus, those who would propose to protect architectural works must decide what portions of the architect's output are to be accorded protection, and what types of derivatives from such protected works are to be considered infringements of said works.

Once the decision is made to offer some protection to some aspects of the architect's product, the issue of the proper remedy in case of infringement immediately arises. Here also there are several questions: is equitable relief appropriate; if so, what types and under what circumstances; and lastly, how are monetary damages to be computed. These problems are not particularly idiosyncratic in the architectural sphere; nonetheless they deserve discussion because all but the most casuistic recognize that no right is larger than its coordinate remedy.

⁹ See generally, M. NIMMER, 1 NIMMER ON COPYRIGHT §§ 46-48, 60 (1973) [hereinafter cited as NIMMER].

¹⁰ See generally, A. LATMAN, HOWELL'S COPYRIGHT LAW (1962).

III. ARCHITECTURAL COPYRIGHT PROTECTION IN THE UNITED STATES

A. Existing Law

There are two mutually exclusive sources of copyright protection in the United States today. There is the potentially eternal state common law copyright frequently known as the right of first publication, which automatically adheres to creative works upon their embodiment in tangible form. Time-honored dogma asserts that common law copyright amounts to no more than the right to be the first to exploit a work. Once a work has been so exploited as to have been published, then common law protection has no further role.⁹ Alternatively, there is federal copyright. Federal copyright is statutory, limited in duration, does not arise automatically, and, in most cases is not available except after publication.¹⁰

Theoretically the two systems are supposed to complement one another. Prior to publication a work has state common law copyright, then upon publication the federal statute gives the proprietor a period of exclusive exploitation (up to 56 years) after which the work enters the public domain.

In point of fact the fit is not nearly as elegant as one might suppose. Nice problems arise as to what constitutes publication, and whether there are constitutional limits as to its definition by a particular court.¹¹ Additionally, the recent landmark case of *Goldstein v. California*¹² establishes the notion that states may constitutionally offer protection, regardless of publication status, to any type of work which is not dealt with by the federal copyright statute.¹³

It is well beyond the scope of this paper to attempt to describe all the intricacies of the law concerning copyright protection for architectural output in the United States today. A brief discussion, however, can suffice to expose some of the inadequacies of our system.

If a federally copyrightable item is published, its only hope for protection is under the federal statute.¹⁴ Architectural plans are subject to federal protection, under the classification of "drawings or plastic works of a scientific or technical nature."¹⁵ This federal protection gives the proprietor of such plans the exclusive right to "print, reprint, publish, copy, and vend the copyrighted work."¹⁶ Also, insofar as an architectural

¹¹ See NIMMER, *supra* note 9 at § 59.

¹² 412 U.S. 546 (1973).

¹³ See Kaul, *And Now, State Protection of Intellectual Property?*, 60 A.B.A.J. 198 (1972).

¹⁴ *Goldstein v. California*, 412 U.S. 546 (1973).

¹⁵ 17 U.S.C. § 5(1) (1973).

¹⁶ *Id.* at § 1(a).

plan can be characterized as a "design for [a] work of art" its proprietor is also invested with the exclusive right to "complete, execute and finish"¹⁷ said design.

Pursuant to the aforementioned statutory provisions, it has been generally held that anyone who makes a two-dimensional copy of a copyrighted plan has infringed the copyright. Contrarily, it has also been generally held that one does not infringe copyrighted plans by building the building which those plans describe. This unhappy result is traceable to the Supreme Court decision of *Baker v. Selden*.¹⁸ *Baker* involved a case wherein the copyright proprietor of a book outlining a novel accounting system sought to prevent infringement of his copyright by a competitor who wrote a similar book describing the same idea, using very similar accounting forms. The Supreme Court allowed that the defendant could actually copy the forms without infringing plaintiff's copyright insofar as those exact forms were necessary to use the system. The court explained that copyright protects expressions of ideas but not the ideas themselves.¹⁹ Thus the author of a book on how to tie knots might protect his descriptive passages but he could not prevent others from tying such knots. Despite a number of demurring voices, *Baker* has generally been interpreted to prevent copyright proprietors in architectural plans from complaining of three-dimensional, as opposed to two-dimensional, renditions of such plans.²⁰

Thus the architect who wishes to complain of structures which he feels violate his creative work must either show that the allegedly infringing building resulted from plans which were illegally copied from his copyrighted plans, or find some method whereby he can copyright the building itself. Unlike most foreign countries, the United States does not explicitly offer copyright protection to actual buildings themselves. Our copyright act does, however, protect works of art.²¹ Thus it can be argued that to the extent a particular architectural work is also a "work of art," such building is copyrightable. From this position it is argued that infringement of such a work of art would occur upon the re-creation of a similar piece, inspired by the original, despite the *Baker* idea/expression dichotomy.²²

If we were to follow the preceding line of reasoning, one could develop an argument whereby all original works of architecture would be

¹⁷ *Id.* at § 1(b).

¹⁸ 101 U.S. 99 (1879).

¹⁹ *Id.* at 101.

²⁰ See, NIMMER, *supra* note 9 § 26.

²¹ 17 U.S.C. § 5(a).

²² See, Comment, *supra* note 3 at 480-84.

protected. The drift of such an argument would be borrowed from a Canadian architectural copyright case, *Hay and Hay Construction Co. v. Sloan*.²³ In *Sloan*, the High Court of Ontario held that courts were not properly constituted to arbitrate matters of art. In the face of a legislative mandate to inquire into "artistic character", *Sloan* opted to look to "originality" and nothing else. Under the *Sloan* rationale one could argue that so long as a work of architecture was original, it would be susceptible to federal copyright. Unfortunately, no United States Court has been willing to go so far.

States are not preempted from protecting works which are either not covered by the federal act²⁴ or which are unpublished. Most state cases in the architectural area are primarily concerned with deciding whether or not a particular work has been published. Reaching a determination as to publication in a particular case can be quite difficult. A good approach to publication is provided by the following tripartite analysis. The first problem is to see what particular physical item is seeking protection. Then one must determine the form in which this original has been exploited. Finally one looks to see the character and extent of the exploitation to which the secondary item has been exposed. Compare the following situations. In Case 1 an architect draws a blueprint (the original) of a building and circulates copies of that blueprint (secondary item) among an audience of 1000 conventioners. In such a case, the original item is the same as the item which is being exploited; thus one only need look to see the character and extent of the exploitation to see if there has been publication.²⁵

It is unusual that the original and the secondary item be the exact same physical thing. More commonly, the secondary item is a derivative of the original. For instance, in Case 2 an architect makes a blueprint which he keeps hidden. He himself builds a building from this blueprint and the building is open for all to see, though the blueprint remains hidden. In such a case the blueprint is the original, the form of exploitation of the original (the secondary item) is the building. The manner of exploitation of this secondary item is public display. Some courts would find that sufficient display of a building could act to publish its underlying plans; others would hold that in no case can display of a building act to "publish" the plans of that building because the relationship of a building to its plans is not so close that display of the building should be treated as display of its

²³ 12 D.L.R.2d 397 (Ontario, Canada 1957).

²⁴ *Goldstein v. California*, 412 U.S. 546 (1973).

²⁵ *Cf. American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907) (case discussing "publication" of original painting).

plans.²⁶ Thus, the three step analysis can be distilled to two basic questions. First, what type of distribution has there been. Second, what is the relationship of that which has been distributed to that which is seeking protection. In the case where the blueprint itself was distributed the second question was irrelevant. However, any time anything other than the original is distributed the question is salient.

Courts have not definitively articulated how to determine the issue of whether Y is so closely related to X, such that publication of Y amounts to publication of X. In fact the opinions tend to gloss over this issue with conclusory statements: either it is or it is not. In cases where the relationship is too distant, the courts hold publication of X has not occurred.²⁷ However, if the relationship is close enough, the courts will find sufficient relationship and immediately drop that issue without a shred of explanation.²⁸ Rather, they will then expend all their energy on the other question as to the character and extent of the exploitation.

One recurring fact situation which causes the courts to analyze this latter issue, the quantum of exploitation as opposed to the nature of the item exploited, is where an architect files a copy of his blueprints with a local building authority prior to beginning construction of the building. Such filing is required by many communities. In such a case there is little question but that an exact duplicate of a set of plans is sufficiently related to the original to be treated as the original. Accordingly, attention focuses instead on the issue as to whether the filing of plans is such an exploitation as to merit loss of the common law right of publication. Earlier cases found that filing did effect a publication.²⁹ However, recent decisions considering the issue have virtually unanimously found no publication.³⁰ They emphasize that the filing is not intended to give the public unlimited rights to use an architect's plan, but is merely required for administrative purposes. They point out that the filing architect does not wish to aban-

²⁶ For a full discussion of this type of publication, see *Comment supra* note 3 at 468-70. Recent cases in this area include: *Nucor Corp. v. Tennessee Forging Steel Service, Inc.*, 476 F.2d 386 (1973) (construction of building is not publication of plans); *Herman Frankel Organization v. Tegman*, 367 F. Supp. 1051 (E.D. Mich. 1973) (issue presented by facts but not discussed by court.) *Cf. Imperial Homes Corp. v. Lamont* 458 F.2d 895 (5th Cir. 1972).

²⁷ See *Nucor Corp. v. Tennessee Forging Steel Service, Inc.*, 476 F.2d 386, 390-91, (8th Cir. 1973).

²⁸ An interesting case in this regard is *Letter Edged in Black Press, Inc. v. Public Bldg. Comm. of Chicago*, 320 F. Supp. 1303 (N.D. Wis. 1970) (pictures of statue held to be closely enough related to statue such that publication of pictures equalled publication of statue).

²⁹ See, e.g., *Kurfiss v. Cowherd*, 121 S.W.2d 282, 287 (Mo. 1938). See *Annot.* 77 A.L.R. 2d 1036 (1959).

don his common law rights; he merely wishes to comply with a statutory requirement.

Under *Goldstein v. California*,³¹ if the states could show that buildings were not protected under the federal statute despite the above-mentioned "work of art" argument, then states could protect architects against copying of such buildings if they wished.³² In point of fact, the American courts have been reluctant to allow buildings, as opposed to their underlying plans, copyright protection, either under the statute or at common law, regardless of the mode of attack. This neglect is quite distressful to some. The latest copyright revision bill offers little succor.

B. *The Latest Copyright Revision Bill*

In 1961 the Register of Copyrights issued a report on the general revision of the United States Copyright Law. The report made the following recommendations concerning architectural drawings:

- (1) The copyright law should continue to protect —
 - (a) Architectural drawings, against the unauthorized making and distribution of copies;
 - (b) Nonfunctional architectural structures that constitute works of art, on the same basis as sculptural works of art;
 - (c) Drawings for such a nonfunctional structure, on the same basis as drawings for a sculptural work of art.
- (2) The copyright law should not be extended to the design of functional architectural structures. Protection for these designs on a more limited basis should be considered in separate legislation for the protection of ornamental designs of useful articles.³³

The Register's rationale for refusing protection was not made particularly clear.³⁴ His main objection seemed to center on the notion that it

³⁰ See, e.g., *Jones v. Spindel*, 128 Ga. App. 88, 196 S.E.2d 22; *Shaw v. Williamsville Manor, Inc.*, 330 N.Y.S.2d 623 (N.Y. Ct. 1972).

³¹ 412 U.S. 546 (1973).

³² See Kaul, *supra* note 13.

³³ *Report of the Register of Copyrights on the Gen'l Revision of the U.S. Copyright Law* 15-16, Submitted to the House Committee on the Judiciary, 87th Cong., 1st Sess. (1961).

³⁴ The register might have been apprehensive that protecting buildings was unconstitutional. Although there are constitutional problems (see U.S. Const., Art. 1, § 8, cl. 8) as to the scope of the Copyright Clause, they have generally been resolved in favor of the broadest possible applications. For close analysis, see NIMMER, *supra* note 9 §§ 2.00-9.24.

would be difficult to differentiate between functional and "artistic" features of a design. For some reason the Register felt that no functional item was a proper subject for copyright.³⁵ The Register preferred to see all buildings other than monuments remain unprotected rather than risk having the courts decide what is a functional feature of a design and what is not.

It is difficult to ascertain exactly to what extent the latest revision bill reflects the Register's suggestions. The new bill provides, *inter alia*, that "pictorial, graphic and sculptural works" shall be protected.³⁶ The bill defines such works as any two- or three-dimensional work "of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, *plans*, diagrams, and models." (emphasis added)³⁷ Having established the aforementioned principles, the bill goes on to rule somewhat ambiguously that:

In no case does copyright protection for an original work of authorship extend to any idea, *plan*, procedure, process, system, method of operation, concept, principle or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work. (emphasis added)³⁸

Presumably this latter language is meant to codify the ruling in *Baker v. Selden*.³⁹ Nonetheless it is a clumsy attempt, particularly insofar as, on the one hand, "plans" are specifically enumerated as protected arts, whereas on the other hand the act purports to deny protection to "plans." The most important, though not exclusive, right which the new bill secures for copyright proprietors is the right "to reproduce the copyrighted work in copies" ⁴⁰ The term "copies" is defined as:

³⁵ One suspects that the United States' disinclination towards including architectural works in the coverage of the Universal Copyright Convention was based less on the stipulated grounds, that to do so would be unconstitutional, than upon a general animadversion to such protection. See Records of the Intergovernmental Copyright Conference, Geneva 334 (18 Aug.-Sept. 1952), which outlines the proposed drafts in which many countries proposed including architectural protection despite the United States' objection. Even if architectural works might not be protected under the aegis of the Copyright Clause they could easily be protected by Congress under the Commerce Clause. See NIMMER *supra* note 9 § 9.

³⁶ S. 1361, 93d Cong., 1st Sess. § 102 (a)(5) (1973).

³⁷ *Id.* at § 101.

³⁸ *Id.* at § 102(b).

³⁹ 101 U.S. 99.

⁴⁰ S. 1361, 93d Cong., 1st Sess. § 106(1) (1973).

"material objects, other than phonorecords, in which a work is fixed by any method now known or later developed and from which the work can be perceived, reproduced, or otherwise communicated . . ." ⁴¹

As far as protection of architectural works is concerned, the new copyright bill seems every bit as confused as the old act. The only real improvement is that under the new bill, common law copyright would be abolished, at least as to items covered by the act, and the old publication questions would be much less important. ⁴² Under the new bill, copyrightable items would be protected both before and after publication. As to the architectural issues though, there is little relief. If architectural plans are covered, which they probably are despite the previously noted contradiction, the issue will still arise as to whether buildings are "copies" of said plans. ⁴³ To arrive at an affirmative answer one would have to argue that one possible method of "fixing" a plan in "tangible form" from which the work can be perceived would be to build the building described by the plans. ⁴⁴

Additionally, the same problems of characterization of a work of architecture, as a possible three-dimensional work of art, arise under the new act. The act purports to protect works of art, and there will be those who will rely on the *Sloan* rationale that "originality" equates art in the building area. These difficulties will surely result in considerable litigation immediately upon passage of the revision bill. In fact, since the language of the new act is so different, even though its general thrust in the architectural area is the same, parties will be likely to litigate issues which they might otherwise have regarded as settled under the old act.

Appended to the new copyright bill is a separate section entitled "Protection of Ornamental Designs of Useful Articles." ⁴⁵ This section apparently fulfills the Register of Copyright's suggestion that architectural works be protected separately from the main body of the copyright

⁴¹ *Id.* at § 101.

⁴² Unlike the existing act, S. 1361 protects unpublished works as well as published works. *Id.* at § 104. Unfortunately, the Design Act addendum to the bill, *id.* Title III, at § 301-355, which will be discussed later, preserves common law rights prior to the date when a design is "made public". *Id.* § 304, 329.

⁴³ If buildings are not copies then one could copy buildings with impunity so long as one did not use that building's underlying plans.

⁴⁴ *Cf.* *White-Smith Music Pub. Co. v. Apollo*, 209 U.S. 1 (1908); *Letter Edged in Black Press, Inc. v. Public Bldg. Comm. of Chicago*, 320 F. Supp. 1303 (N.D. 111, 1970).

⁴⁵ S. 1361, 93d Cong., 1st Sess. Title III, § 301-335 (1973).

law.⁴⁶ This section offers 10 years of protection to the design of "useful articles" which are original, where the design is not a mere "standard geometric figure" and where the design is not dictated solely by a utilitarian function of the article that embodies it⁴⁷ (beware the architect who espouses the "form follows function" maxim, if this law is ever passed). The statutory period for designs begins to run from the date that such design is made public.⁴⁸ In order to secure protection, the design holder must attach a "Protected Design" notice to his article in a reasonably noticeable spot, along with date of first publicity and some suitable identification of the proprietor.⁴⁹ Additionally, the proprietor must register his design with a design Administrator.⁵⁰ The act protects registered designs by prohibiting the making, sale or importation of any infringing article which would be:

any article, the design of which has been copied from the protected design, without the consent of the proprietor. *Provided however* that an illustration or picture of a protected design in an advertisement, book, periodical, . . . or similar medium shall not be deemed an infringing article.⁵¹

The design provisions are specified to be complementary to and not derogatory of the copyright provisions in the new bill.⁵² Similarly, the bill is said not to affect any change in Patent Law.⁵³ It is prescribed, however, that any one who registers for a design patent shall lose his design protection otherwise accorded by the new bill.⁵⁴ One frightening aspect of the new design section is that it provides for a two-tiered system of protection similar to that found in the present Copyright Act. The only difference between the two is that the new design section speaks in terms of "making public" as opposed to publication.⁵⁵

⁴⁶ Compare, Report, *supra* note 33 at 16, recommending architectural protection "on a more limited basis . . . in separate legislation for . . . ornamental designs of useful articles" with S. 1361, 93d Cong., 1st Sess., Title III (1973) which is entitled "*Protection of Ornamental Designs of Useful Articles*."

⁴⁷ S. 1361, 93d Cong., 1st Sess., Title III § 302 (1973).

⁴⁸ *Id.* at § 304.

⁴⁹ *Id.* at § 306(a).

⁵⁰ *Id.* at § 309.

⁵¹ *Id.* at § 308(d).

⁵² *Id.* at § 327.

⁵³ *Id.* at § 328(a).

⁵⁴ *Id.* at § 328(b). For a comparison of the design protection portions of the Patent Act with Copyright Law protection, see Silverman, *The Scope of Protection of Copyrights and Design Patents in the United States*, A.S.C.A.P. SYMPOSIUM NUMBER 12, at 152 (1963).

⁵⁵ S. 1361, 93d Cong., 1st Sess. § 304 (1973).

The above discussion of the new act should present two questions to those interested in architectural copyright protection. First, is there any compelling reason for creating a design copyright, separate from other copyright, and second, if the answer to the first question is yes,⁵⁶ should works of architecture be treated under the main copyright scheme, or under the design copyright scheme. Before considering the answers to those two questions it would be helpful to examine the experiences of some of the other countries.

IV. SAMPLE FOREIGN STATUTES

It would be a herculean task to analyze all the various and sundry copyright statutes of the world insofar as such statutes protect architectural structures. Instead this paper will analyze several statutes from various countries as translated into English in the UNESCO publication "Copyright Laws and Treaties of the World." After analyzing these few statutes, this text will look into the practical experiences which various foreign English-speaking countries have experienced, as evidenced by their respective cases and secondary materials.

A. *The Berne Convention*

Stephen Ladas, in his excellent two-volume treatise entitled *International Protection of Literary and Artistic Property*, outlines the early history of architectural copyright.⁵⁷ According to Ladas, Jules de Borchgrave, a Belgian author, was the father of the concept of copyright protection for architectural structures. Borchgrave pressed his idea that architectural works were as much the product of an architect's creative genius as was any other manner of artistic output. Several delegates to the Paris Conference of 1896, wherein proposals for a protocol to the 1886 Berne Convention were being discussed, suggested that Borchgrave's theory be grafted on to the Convention. This was a highly radical idea, insofar as at that time no countries specifically recognized structures as being suitable for copyright protection in the domestic statutes.⁵⁸ Ever mindful of future developments, the German delegation was particularly

⁵⁶ Two Australian law review articles question the usefulness of separate design protection in addition to standard copyright and patent law protection: Lahore, *Art and Function in the Law of Copyright and Designs*, 4 ADELAIDE L. REV. 182 (1971); Comment, *The Legal Protection of Industrial Designs*, 10 WEST. AUST. L. REV. 65 (1971).

⁵⁷ S. LADAS, 1 THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY § 101 at 223 (1938) [hereinafter cited as LADAS]

⁵⁸ *Id.*

opposed to inclusion of architecture because "there are constructions lacking any artistic character, and their reproduction could not be considered an infringement of a work of art."⁵⁹ In consideration of this German negativism and that of the British and Norwegian delegations, the Paris Conference compromised the issue and inserted the following conciliatory article in the Final Draft of their Protocol.

In the countries of the Union in which protection is granted, not only to architectural plans, but also to the actual works of architecture, such works are admitted to the benefit of the provisions of the Convention of Berne and of the Additional Act.⁶⁰

The Berne Convention has been revised and modified several times since its inception.⁶¹ In 1908 at the Berlin Conference on the Berne Convention, the delegates switched their position on the architectural protection issue and added a clause to the main body of the Convention providing that creative works of architecture were to be fully protected by the Convention. The most recent version of the Convention,⁶² which was developed at a Conference at Brussels on June 26, 1948, continues to require protection for architectural works.⁶³

Article 2 of the convention draft protects *inter alia* "works of . . . architecture." The Convention provides that each work mentioned in this Article shall be protected for the benefit of its author by all Countries of the Union.⁶⁴ Article 4 provides that authors who are nationals of Berne Convention signatory countries shall have, in addition to national protection within each signatory country, all rights specifically granted by the Convention. Thus all nationals of Berne countries have automatic protection of their architectural works in all other Berne countries unless they fail to first publish their work in a Berne country. For this purpose the Convention specifically points out that construction of architectural works does not equal publication.⁶⁵

⁵⁹ *Id.*

⁶⁰ *Id.* at 224.

⁶¹ See Dawid, *Basic Principles of International Copyright*, 71 BULL. CR. SOC. 1 (1973). This article succinctly describes all the important versions of the major copyright conventions and their effects on the United States.

⁶² The most recent draft of the Berne Convention is the Paris Act (1971). It has not yet been ratified. See note 117 *infra*.

⁶³ U.N.E.S.C.O., Copyright Laws of the World, Berne Copyright Union, Brussels Convention, Art. 2 § 1 (1948).

⁶⁴ *Id.* at § 4.

⁶⁵ *Id.* Art. 4 § 4.

B. *The German Copyright Statute*

Ironically, Germany was one of the first countries to codify Borchgrave's dream in their national statute.⁶⁶ The most recent version of the German Copyright Law, which was enacted in 1965, continues this tradition. The new act fully integrates architectural protection into the main body of the statute, while at the same time making exceptions in those cases where architectural works should be treated differently from other types of artistic expression.

In common with the Berne Convention and the statutes of many countries, the German Act protects architectural works as a specifically enunciated subcategory of the larger group "artistic works."⁶⁷ According to the act, the copyright proprietor is the "author" who is "the person who creates the work."⁶⁸

The German Act is particularly generous in the protections which it affords copyrighted works. It begins by stating generally that:

"Copyright shall protect the author with respect to his intellectual and personal relations to the work and also with respect to the utilization of the work."⁶⁹

This general statement of rights is divided into three categories: The author's moral right,⁷⁰ the author's exploitation rights,⁷¹ and other miscellaneous rights.⁷²

An author's moral right is very significant as protected by the German statute. It protects his reputation and the integrity of his works from pious revisionists. Specifically, the moral right embraces three independent rights. The author has the right to be the first to disseminate his work. He has the right to be accorded recognition as author of the work or to eschew such designation. Lastly and most importantly, the author has the right to prohibit any distortion or mutilation of his work. This right could be particularly valuable to an architect. It would allow him to prevent less talented persons from disturbing the harmony of his designs by making unfortunate alterations. It would also assure the architect of first shot at any alterations or additions to his work. Although this is very nice for the architect, it might be argued that it hamstrings his client by

⁶⁶ See LADAS, *supra* note 54.

⁶⁷ U.N.E.S.C.O., Germany, An Act dealing with Copyright and Related Rights, Part I, § II; Art. 2 (4) (1965) (hereinafter referred to as the German Act).

⁶⁸ *Id.* § III, Art. 7.

⁶⁹ *Id.* § IV, Art. 1.

⁷⁰ *Id.* Art. 12-14.

⁷¹ *Id.* Art. 15-24.

⁷² *Id.* Art. 25-27.

giving the architect virtual blackmail rights. In fact, unless the section is narrowed by judicial construction it appears to give an architect the right to prevent his client not only from altering the work but also from destroying the building.

The architect's exploitation rights, under the German statute, are considerably less radical than his rights under the aforementioned moral rights sections. The statute bestows three essential, exclusive exploitative rights upon the author: the right of reproduction, the right of distribution, and the right of exhibition. These rights embrace the standard sorts of privileges which copyright is generally thought to cover in the United States.⁷³ Thus, the author has the right to make copies of the work, to publicize and distribute said copies, and the right to make adaptations of such copies. In respect of this last right, the statute holds:

Adaptations or other transformations of a work may be published or exploited only with the consent of the author of the adapted or transformed work . . . in the case of . . . copies of an architectural work, the creation of such adaptation or transformation shall require the author's consent.⁷⁴

The German Act falls short in that it fails to define the work "copy." The above quoted section seems to be particularly designed to protect architects from works which do not rise to the level of exact copies but which are substantially inspired by a copyrighted structure. This section offers protection somewhat like the moral rights protection in that it prevents distorted versions of any architect's work from being developed. This section, coupled with the moral rights section, certainly reflects a true reformist zeal in the German statute as regards architectural products.

Under the heading "miscellaneous rights", the author has the right to demand access to his creation or copies thereof for the purpose of furthering his creative endeavors. However, the author cannot demand actual custody of the work under this section. The other miscellaneous right, the much discussed *droit de suite*,⁷⁵ is specifically made inapplicable to architects. This is a very proper result. The *droit de suite* is primarily intended to allow artists such as painters and sculptors to realize some small profit from the appreciation in value of their works after they have

⁷³ See NIMMER, *supra* note 9 §§ 100-111.

⁷⁴ The German Act, Part I, § III, Art. 23.

⁷⁵ *Id.* Art. 26. See 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); Sherman, *Incorporation of the Droit de Suite into United States Copyright Law*, A.S.C.A.P. SYMPOSIUM NUMBER 18 at 50 (1970).

been sold. The rationale for this is that often a great artist will leave his family penniless while those who bought his works for a mere pittance are reaping huge profits from his genius. Such a right is fully suited to works which owe their primary value to artistic expression. However, works, such as most architecture, which have significant value regardless of any artistic merit would not properly be subjected to such a tax. In this regard it is interesting to note that whereas great paintings are kept as cherished artwork throughout the ages, great architecture often fails to sustain the high cost of urban real estate and so is destroyed.

It is clear that the German statute is quite solicitous for the rights of architects and contains several sections which are explicitly drafted with the peculiar problems of architectural protection in mind. One section which should be mentioned in this regard is Article 59, which immunizes pictures and other two-dimensional representations of works which are permanently displayed on public streets.⁷⁶ This section is specifically made applicable to architectural exteriors, and exteriors alone. This sort of provision is quite common in copyright statutes which protect architectural works. Without such a section no publicly visible building in Germany would be freely photographable until 70 years after its architect had died.⁷⁷ Such a limitation would, of course, be intolerable.

The second paragraph of Article 59 offers protection for particular works which are incorporated into a building. Thus, if a building has stained glass windows, or attached statuary, or gargoyles, or frescoes, or any other nice artistic touches, these items are accorded independent protection in that they may not be copied and used on another work of architecture.

The German remedies are only a little less generous than the German rights.⁷⁸ The statute provides for a cease and desist order against violations of the act if there is danger of further infringement, in addition to damages for negligent or intentional violation of copyright. If the injured party prefers, he can eschew damages in favor of recovering profits which the infringer has reaped from his violation. The statute also provides for destruction of certain infringing copies or, alternatively, that infringing copies be turned over to the proprietor. Wisely, the German statute exempted architectural works from these last two provisions.

The German statute has several articles, particularly those that deal with transfers of copyright and with co-authorship problems, which are important to architectural protection,⁷⁹ but would require extended dis-

⁷⁶ The German Act, Part I § VI, Art. 59.

⁷⁷ *Id.* § VII, Art 64

⁷⁸ *Id.*, Part IV, § II, Art. 97-105.

⁷⁹ *Id.*, Part I, § V, Art. 28-44.

cussion beyond the scope of this endeavor. Some aspects of these problems will be mentioned when dealing with the British Commonwealth materials. Suffice it to say at this point that the German statute is very modern and rather well drafted. It deals with most of the problems inherent in architectural copyright and seeks to draw a balance between public convenience and private necessity, albeit in some respects the statute exhibits a protectionist zeal which might not please all observers.

C. *The French Copyright Statute*

Architects are accorded protection under the French statute⁸⁰ which is comparable to the protection that architects receive under the German Act. Both acts integrate architectural protection with that of other types of works. The French statute, however, appears less carefully drafted than the German statute. The French act is often ambiguous and occasionally fails to exempt architectural works from statutory provisions which are inappropriate when applied to architectural works.

The French Act begins by bestowing an exclusive incorporeal property right on an author over all his creative works. This section proclaims that copyright protection is derived from intellectual, moral and economic considerations.⁸¹

The French Act protects specifically enumerated "intellectual works". Works of architecture, plans, sketches, and plastic works relative to architecture are among those classes of works which are included in the nondefinitive listing of intellectual works.⁸² French protection is similar to German protection, except in various particulars. For instance, as mentioned before, the French moral right, which includes the right of an author "to respect for his name, his authority and his work," unlike the German moral right, is inalienable *inter vivos*.⁸³ Also, the scope of the French moral right is more restricted and ambiguous than Germany's. The German Act specifically forbids unauthorized distortion.⁸⁴ France merely speaks in vague terms of respecting the work.⁸⁵

⁸⁰ U.N.E.S.C.O., France Law No. 57-296 on Literary & Artistic Property, Art. 1-82 (1957) (hereinafter referred to as the French Act).

⁸¹ *Id.* at Art. 1.

⁸² *Id.* at Art. 3.

⁸³ *Id.* at Art. 6.

⁸⁴ The German Act Provides:

The author shall have the right to prohibit any distortion or any other mutilation of his work which would prejudice his lawful intellectual or personal interests in the work.

Part I, § IV, Art. 14.

⁸⁵ The French Act provides:

The author shall enjoy the right to respect for his name, his authorship, and his work . . .

Art. 6.

French economic rights are mainly standard. An author has the right of publicizing and displaying his work along with the right to reproduce the work in any manner which permits indirect communication of the work to the public.⁸⁶ There is one disturbing provision. Under the French statute, the *droit de suite* applies to all graphic and plastic works.⁸⁷ In its list of protected items the statute specifically protects plastic works relative to architecture,⁸⁸ which might be interpreted as suggesting that some architectural works are plastic works.⁸⁹ Thus one might argue that the *droit de suite* applies to buildings in France. The German statute is much clearer and specifically exempts architectural works from the *droit de suite*.⁹⁰

The French *droit de suite* is three times as potent as the analogous German provision in that it requires three per cent of the sales price of any sale, by public auction or through a dealer, to be turned over to the author. The *droit de suite* vests immediately in the author until at his death it vests in his heirs for 50 years. If this provision applies to architectural works it would be worth millions of dollars. A well-drafted law would not be unclear on such a major issue.

Under French law, an "author" is a favored party when contracting in respect to his oeuvre. Some of these provisions are particularly important in the architectural context. The Act seems to prohibit implied transfer of an author's rights.⁹¹ Also, all transfers must be in writing.⁹² This means that if an owner wants to rebuild after a fire, or remodel, he must have or obtain express written permission to do so prior to beginning construction.

The act specifically saves the fickle artist from being subjected to an

⁸⁶ Any author protected by the French Act has the sole right to divulge his work, *id.* at Art. 19, and to enjoy or exploit the work during his lifetime, *id.* at Art 21. The right to exploit includes the right to perform and to reproduce, *id.* at Art. 26. Note that in France, the author's copyright continues until 50 years after the author's death, *id.* at Art. 21.

⁸⁷ *Id.* at Art. 42.

⁸⁸ *Id.* at Art. 3.

⁸⁹ This section was probably intended to be interpreted as referring only to three-dimensional models of architectural works.

⁹⁰ The German Act, Part 1, § IV, Art 26 (3).

⁹¹ The French Act is probably much too protective in this regard, as the later discussion dealing with implied licenses under the British and Canadian Acts will show. The French Act provides:

The transfer of author's rights shall be subject to the condition that each of the rights transferred shall be specifically mentioned in the act of transfer, and that the field of exploitation of the rights transferred shall be delimited as to extent and purpose, as to place and as to duration.

Art. 31.

⁹² *Id.*

order for specific performance brought for failure to produce an already completed work under contract.⁹³ The author must pay all damages occasioned by this refusal and may not peddle his wares elsewhere without first re-offering them to the party with whom he had originally contracted. This would not seem to be a very useful right for an architect unless he was quite rich and had created a monster which would destroy his reputation if released.

One interesting section provides that, except where impractical, an author must receive a proportionate share in the proceeds of the exploitation of his work.⁹⁴ This would seem to require that the subdivision developer cut the architect in on a piece of the action. Of course, there is no requirement as to the size of the participation, but if a plan is used several hundred times, even a small percentage could become significant.

The French statute is a good effort but is not fully tailored to meet the various exigencies of architectural protection. This is not because architectural works are not amenable to copyright treatment. Rather, some deficiencies could be quickly amended by merely excluding architectural works from a particular clause. Other deficiencies arise from general statutory vagueness and are not peculiar to works of architecture.

V. IMPLIED LICENSES

Statutory analysis is interesting and helps provide broad general outlines, but often it fails to provide true insight into practical problems inherent in the application of a given law to a particular factual nexus. Cases are more specific and tend to test the legitimacy of a law. If a law is drafted so as to compel inequitable results, then, even though it appears to be sound theoretically, it is of negative value. The major hidden issue which English and Canadian cases discover in the architectural copyright area is the issue of implied licenses.⁹⁵ Unlike France, England and Canada do not require that all assignments of copyright be express. This raises problems in a wide variety of contexts. Of course, the flexibility of the English view often produces more just results than would be reached under the French system. Two recent cases, *Blair v. Topkins and Osborne*⁹⁶

⁹³ *Id.* at Art. 32.

⁹⁴ *Id.* at Art. 35. Note the odd quirk in the French law whereby authors can sometimes demand the right to renegotiate the terms of contracts. *Id.* at Art. 37. This would create undue problems in the building trades.

⁹⁵ For an overview of Canadian and English cases dealing with architectural copyright, see F. JAMES, E. JAMES, COPINGER AND SKONE JAMES ON COPYRIGHT §§ 711-729. (10th ed. 1965) (hereinafter cited as COPINGER).

⁹⁶ (1971) 1 All ER 468.

and *Stovin-Bradford v. Volpoint Properties, Ltd.*,⁹⁷ deal with one aspect of this implied license problem.

In England, many architectural contracts are drawn on standard forms referring to fee schedules which are drafted by the Royal Institute of British Architects (RIBA). In *Blair*, an architect signed one of these RIBA contracts whereby he agreed to draw preliminary plans for the purpose of securing a building permit. He completed the plans and gave them to his client, who then got his permit. The architect charged a RIBA-sanctioned fee equalling one-sixth of the fee for a completed design. The client did not retain the architect to complete the job; instead he used the plans and built the building himself. The architect sued his former client for breach of contract. The architect maintained that building the structure was an infringement of his plans. The client maintained that he had an implied license to use the designs.

Blair ruled against the architect. The decision was not based on the theory that a building could not infringe plans, which is the rationale an American court would have used under present law.⁹⁸ Rather, the court accepted defendant's contention that there was an implied license. The court relied on the notion that a contrary decision would have been unconscionable, insofar as, according to the RIBA contract, an architect could withdraw from a project at any time on short notice. Thus the architect could submit all his plans and receive his fee for those plans, and then back down and not allow the client to use the plans for his building. In such a case the client would own the plans, mere worthless paper with lines and figures, while the architect would own the copyright, wherein lies the true value to the plans.⁹⁹ The obvious injustice of this possibility led the court to rule that the presence of the escape clause indicated that there was an implied license to use the plans to build one particular structure at the one particular site which was initially contemplated.

In *Stovin-Bradford* the court distinguished *Blair* and ruled that no implied license would be found where the fee arrangements were not such as to commend the justice of such a ruling. In *Stovin-Bradford*, the architect charged a nominal fee, less than the RIBA fee, for a set of plans which the client desired to use to secure a building permit. The court pointed out that licenses should only be implied where necessary and that no such necessity was present in *Stovin-Bradford* as was in *Blair*. The court noted that the small fee was an accommodation to a client so that if the building permit were rejected the client would not be unduly prejudiced.

⁹⁷ (1971) 3 All ER 570.

⁹⁸ See, e.g. *Scholz Homes v. Maddox* 379 F.2d 84 (6th Cir. 1967). Cf. *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir. 1972).

⁹⁹ See *Meikle v. Maufe* (1941) 3 All ER 144; *Copinger*, § 721. See *Architect's Copyright*, 202 L.T. 323 (Dec. 28, 1946).

Thus *Blair* found that the circumstances were not indicative of an intent to release copyright.

The decisions in the two cases seem particularly commendable. They allow protection to both the architect and the client. In the United States, the plaintiff in *Stovin-Bradford* would have been out of luck. Similarly he would be garnered no relief under the new Copyright Act or even the new Design Act.

The leading Canadian case on architectural copyright is *Netupsky v. Dominion Bridge Co. Ltd.*¹⁰⁰ In *Netupsky* the plaintiff was an engineer who had designed a particular structural system for a stadium complex which was to be built in Ottawa, Canada. The plaintiff had been hired by Gerald Hamilton, the project's architect, to develop a feasible array of A-frames to support the stadium's cantilevered roof. The plaintiff made his designs and submitted them to the defendant, a steel fabricator, for a cost estimate. The estimate was higher than anticipated. The fabricator blamed this high cost on plaintiff's design. The fabricator suggested several modifications in the design and submitted these to the plaintiff for his approval pursuant to his contract with Hamilton, which required that he approve all structural plans. Plaintiff refused to review the plans for less than \$25,000, in addition to his agreed upon fee for drawing the plans of \$45,000. This was too expensive, so Hamilton hired another engineer to approve the fabricator's modification of plaintiff's plans.

Ultimately the stadium was built using these modified plans. The plaintiff sued the defendant for violating his copyright in the original plans by making the modified plans. The trial judge ruled against the plaintiff. On appeal the plaintiff argued that there was no grant of any implied license for respondent to modify the plans. The British Columbia Court of Appeal agreed with the plaintiff in this respect. The court recognized that there was an implied license to use plaintiff's original license for much the same reasons as were advanced for the similar finding in *Blair*. However, the court stated that there was no implied license to alter said plans.¹⁰¹

The Canadian Supreme Court in overruling the British Columbia Court of Appeal relied heavily on a case decided by the Supreme Court of New South Wales. *Netupsky* quoted the Australian case to the effect that:

¹⁰⁰ *Netupsky* was appealed three times. The first two decisions favored plaintiff architect's (actually plaintiff was an engineer) recovery, 68 W.W.R 529 (1969); 70 W.W.R. 241 (1969), but plaintiff was dissatisfied with his damages award and appealed to the Supreme Court of Canada, (1972) 1 W.W.R. 420, where not only did he fail to get more damages but he lost his entire case, attorney's fees and all!

¹⁰¹ (1972) 1 W.W.R. 420, 427.

the engagement for reward of a person to produce material of a nature which is capable of being the subject of copyright implies a permission or consent or license in the person making the engagement to use the material . . . for the purpose . . . contemplated between the parties.¹⁰²

The Court noted that in *Netupsky* the plans had been substantially followed and that the alterations were within the "limits which should be considered acceptable."

The Supreme Court was probably wise in rejecting the appellate court opinions. It would seem to be bad policy to sanction the sort of blackmail which *Netupsky* was engaging in. Large modern construction projects require maximum cooperation. The appellate decisions in *Netupsky* were hardly calculated to create such cooperation. Additionally, the Court might have been reluctant to uphold *Netupsky's* claim for fear that its decision would be interpreted as a tacit approval of the *droit moral*, a concept which is not recognized under the English or the Canadian statutes.¹⁰³

Two articles in British legal periodicals discuss various aspects of English architectural copyright protection.¹⁰⁴ They mention implied licenses in a factual nexus which was particularly important in England after the last war. The problem can be simply stated: to what extent does a client, or an assignee of a client, have the right to rebuild or make additions to a building which is subject to an outstanding copyright in the hands of a third person?

The case which raised speculation in this area was *Meikle v. Maufe*.¹⁰⁵

¹⁰² (1972) 1 W.W.R. 420, 427, *quoting from* *Beck v. Montana Construction Pty. Ltd.*, 5 F.L.R. 298, 304 (1963).

¹⁰³ See footnotes 80 and 81 for the express formulation of the moral right in the French and German copyright statutes. Neither the English nor the Canadian statute has a similar provision. One commentator in the Australian Law Journal pointed out, however, that a concurring opinion in *Blair v. Tomkins* (1971) 2 W.L.R. 503 mentions that the defendant architects not only used plaintiff's plans but also claimed the building as their own design. The judge found this as grounds for assessing damages against defendants. The Law Journal notes that protection of authorship is one of those protections traditionally embraced by the *droit moral*. 45 *Aust. L.J.* 424, 425 (1971).

Similarly the appellate courts which recognized *Netupsky's* claim were recognizing a right to the integrity of his plans, a right traditionally considered part of the *droit moral*. See Marvin, *Author's Status in the United Kingdom and France: Common Law and the Moral Right Doctrine*, 20 *INT. & COMP. L.Q.* 675 (1971).

¹⁰⁴ See, *Architect's Copyright*, 202 *L.T.* 323 (1946); *Copyright and the Architect*, 109 *L.J.* 118 (1959).

¹⁰⁵ (1941) 3 *All ER* 144.

In *Meikle*, a group of businessmen commissioned the plaintiffs' architectural firm to design a large building for their business. The parties discussed the feasibility of making future additions to the building at that time, but made no specific plans. Some years later the owners of the building commissioned another architect to design an extension to the building which would be exactly compatible with the contours and facade of the existing structure. The plaintiffs sued this second firm for breach of their copyright in the building. Despite pleas of the existence of an implied license to extend the existing building, the court ruled for the plaintiffs. The court reached this result by applying general contract notions as to whether or not a term should be implied in a contract. In the instant case the court held it was not at all obvious that the parties would have executed an express license to expand the design at the time of the original building if they had considered it.

Meikle raised another particularly delicate question in post-war England, as to whether totally or partially destroyed buildings could be rebuilt pursuant to their original plans. However, *Meikle* merely mentioned the problem, while refusing to rule on the issue as not being relevant to the case at hand.

The British Parliament was unwilling to leave the reconstruction problem to the judges. Accordingly, the Copyright Act of 1956 provides:

where copyright subsists in a building as a work of architecture, the copyright is not infringed by a reconstruction of that building; and where a building has been constructed in accordance with architectural drawings or plans in which copyright subsists, and has been so constructed by, or with the license of, the owner of that copyright, any subsequent reconstruction of the building by reference to those drawings or plans shall not constitute an infringement of that copyright.¹⁰⁶

This provision is certainly sensible. It is to be questioned, however, exactly how much latitude it gives to the reconstructing owner. A court might follow the type of reasoning expressed in the *Netupsky* case to the effect that direct copying is permissible, whereas selective or modified copying is not. In fact, the better view would seem to require that the owner of a building have a plenary right to deal with his building as he sees fit and to harmoniously make additions to it without having to locate an architect who might have died or left the country long ago.

¹⁰⁶ U.N.E.S.C.O., United Kingdom, Copyright Statute, Pt. I, § 9(10) (hereinafter referred to as English Act).

VI. DAMAGES

In *Stovin-Bradford v. Volpoint Properties, Ltd.*,¹⁰⁷ the court discussed the proper measure of damages to be assessed in architectural copyright cases. As has been mentioned, *Stovin-Bradford* involved a situation where the plaintiff designed a building for about 18 percent of the authorized RIBA scale, so that defendant might use the plans to obtain a building permit. The court ruled that the defendant infringed plaintiff's copyright when they actually built a building which incorporated a prominent feature of plaintiff's design. The court held that the proper level of damages was correctly stated in *Chabot v. Daives*¹⁰⁸ wherein the following recovery principle was approved:

What is the remuneration which the plaintiff would fairly have got for his plan if the defendant had applied for his leave and license to use it?¹⁰⁹

In *Stovin-Bradford*, the court applied the above formula in such a manner as to approve a trial court award equal to the full RIBA scale when added to the architect's original remuneration. Thus the court allowed the plaintiff £ 500 in addition to the £ 100 he had originally been paid. This £ 600 total equalled the full RIBA fee for completing the design up to the point necessary to achieve a building permit, and such a fee would also have implied the grant of a license to allow the client to complete the building.

The Canadian statute prescribes two types of recovery in infringement cases. The plaintiff is entitled to recover for his loss and for defendant's gain. The first appellate decision, *Netupsky v. Dominion Bridge Co.*¹¹⁰ followed the same rule under the Canadian copyright statute to determine the first component of damages which the English court applied in *Stovin-Bradford*. However, the fact situation was such that assessment necessarily involved some conjecture. In *Stovin-Bradford*, the standard charge for designing a building up to the relevant stage of completion, which would also include an implied license to finish the building, was set out in the RIBA schedule. In *Netupsky* it was very difficult to determine how much one might reasonably expect to be paid "to allow the infringer to use his drawings in order to superimpose the desired modification." The court relied on this uncertainty to justify an award of

¹⁰⁷ (1971) 3 All ER 570.

¹⁰⁸ (1936) 3 All ER 221. See Copinger § 729.

¹⁰⁹ (1971) 3 All ER 570, 576, quoting (1936) 3 All ER 221, 228.

¹¹⁰ 68 W.W.R. 529 (1969). Note that this opinion was overruled on substantive grounds. (1972) 1 W.W.R. 420.

damages of \$1,000 for the loss component of the plaintiff's case. This recovery was very low insofar as plaintiff was claiming damages of \$25,000 to \$30,000, and the project architect, who had no reason to favor the plaintiff, had testified that he thought the work which plaintiff had been denied would have cost approximately \$2,500 to complete.

The court was even less sympathetic to plaintiff's claim for damages based on profits derived by the infringer. The court pointed out that defendant had lost over \$56,000 on the project. Accordingly, the court found no damages were owing under this heading.

The plaintiff in *Netupsky* applied for an order to vary the aforementioned ruling in the second *Netupsky* appeal,¹¹¹ which, as mentioned earlier, was overruled by the Canadian Supreme Court on substantive grounds. This second appeal dealt with two main areas of relief for copyright infringement. On the one hand the plaintiffs demanded that defendant be required to deliver up all infringing copies of his A-frame design and that defendants be enjoined from further copying said plans. The injunction was agreed to by stipulation. However, the court refused to exercise its discretion to require delivery of the plans, because it maintained that under the circumstances this would work an unfair hardship on the defendant. The court pointed out that these plans would undoubtedly be needed for the ongoing task of maintaining the structure and that no real benefit would be derived by the plaintiff in requiring delivery of the plans.

In his petition for a variance, plaintiff also tried to claim damages under a provision in the Canadian Copyright Act which read as follows:

All infringing copies of any work in which copyright subsists, or of any substantial part thereof, and all plates used or intended to be used for the production of such copies, shall be deemed to be the property of the owner of the copyright, who accordingly may take proceedings for the recovery of the possession thereof or in respect of the conversion thereof.¹¹²

The court had no trouble finding a technical conversion of the plans, but nonetheless refused recovery. Indeed, the court affirmed a 1939 case¹¹³ holding that this provision provides an accumulative as opposed to

¹¹¹ 70 W.W.R. 241 (1969).

¹¹² U.N.E.S.C.O. Canada, Copyright Act, § 21 (1971) (hereinafter referred to as the Canadian Act). The Canadian Act is based on the English Act. See Royal Commission on Patents, Copyright, Trademarks and Industrial Designs, *Report on Copyright* 8 (1957) (This is the report for the Canadian Act).

¹¹³ Caxton Publishing Co. v. Sutherland Publishing Co. (1939) A.C. 178.

alternative remedy. However, the second *Netupsky* opinion held that under the particular facts in that case an award of damages for conversion would give the plaintiff a double recovery. The court felt this was not proper despite the fact that the remedies were cumulative. In other words, the court recognized two separate modes of attack, both of which would be fully honored except insofar as this would result in double recovery.

Both the English and the Canadian acts forbid authorization of injunctions which will have the effect of retarding completion of a building under construction or which would require a building to be razed.¹¹⁴ This is a necessary addition to any architectural copyright statute. It would be extremely wasteful and unconscionable in an era of scarcity of natural resources to allow vindictive plaintiffs to destroy any substantial edifice because of copyright infringement. The best approach is to have flexible damages provisions which assure the plaintiff full recovery without causing harm to the community by destroying new buildings.

VII. THE CONVENTIONS

The first of the great multilateral Copyright Conventions was the Berne Convention.¹¹⁵ The Berne Convention has been revised four times since it first took effect in 1886.¹¹⁶ In addition, there is a new draft which was recently developed but has yet to be ratified.¹¹⁷ This paper shall discuss protection for architectural works under the latest official edition of the Berne Convention which has been ratified, the Brussels Revision of 1948. The United States has never ratified any version of the Berne Convention; however, the Convention is quite important to United States citizens because they can take advantage of the Convention by first publishing their works in countries which have adhered to the Berne Convention (hereinafter Berne Union countries).¹¹⁸

Another one of the early conventions is the Buenos Aires Convention of 1910.¹¹⁹ This convention is in force in the United States and 17 Latin

¹¹⁴ The English Act Pt. III, § 17, (4); the Canadian Act § 23 (1).

¹¹⁵ See LADAS *supra* note 57.

¹¹⁶ The four conventions are Paris (1896); Berlin (1908); Rome (1928); Brussels (1948). See Dawid, *supra* note 61 at 2. For text of these see U.N.E.S.C.O., Copyright Treaties of the World (1973).

¹¹⁷ The newest version is the Paris Act (1971), see U.N.E.S.C.O. Copyright Laws and Treaties of the World (1973); this version arose after a 1967 Stockholm draft failed to be ratified. Dawid, *supra* note 61 at 2.

¹¹⁸ United States Copyright Office, *International Copyright Protection*, Circular 38 at 2 (1971).

¹¹⁹ For text see U.N.E.S.C.O., COPYRIGHT LAWS AND TREATIES OF THE WORLD (1973).

American countries. This convention is not very important insofar as most countries which have adhered to the Buenos Aires Convention have also adhered to the Universal Copyright Convention.

The Universal Copyright Convention (the U.C.C.),¹²⁰ which came into effect in 1955, is the most widely adhered to of the multilateral conventions. It was developed at least partially in response to the failure of the United States to join the Berne Union.

Insofar as the U.C.C. was drafted with a particular view towards appeasing the sensibilities of the United States, it is not surprising that architectural works are not among the works specifically required to be protected by the Convention. The 1971 Paris revision of the convention reads:

Article 1: Each Contracting State undertakes to provide for the adequate and effective protection of the rights of authors and other copyright proprietors in literary, scientific and artistic works, including writings, musical, dramatic, cinematographic works and paintings, engravings and sculpture.¹²¹

The U.C.C. has no provision which is similar to the Berne rule whereby all countries adhering to the convention automatically offer protection to foreign architectural works according to the terms of the Convention itself. The U.C.C. only requires that signatory countries have a copyright law which protects the items outlined in Article 1. The U.C.C. generally has very few items which it protects over and above that required by the national laws of each constituent state.

Despite the fact that no U.C.C. country must protect architectural works by virtue of specific Convention requirements, there is certainly no prohibition of protection. In fact, the convention provides that each signatory country must offer unpublished works of nationals of other signatory countries precisely the same protection which it offers to its own nationals for such works.¹²²

The U.C.C. 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.¹²³

¹²⁰ For text *see id.*

¹²¹ For discussion of the Paris revision *see*, Dawid, *supra* note 61 at 11.

¹²² *Id.*, at 10-11.

¹²³ U.N.E.S.C.O., Copyright Laws and Treaties of the World, Universal Copyright Convention, Art. VI (1952).

To the extent a work of architecture is unpublished under the above definition, foreign adherents to the U.C.C. would be required to give protection to American architects in their courts for infringements of their copyright acts. Thus, if construction is not publication, an American architect could claim all the benefits hitherto discussed as provided by the copyright statutes of France, Germany, England and Canada for infringements of his work which occurred in those countries.

A particular court might decide that constructing a building was publication under the U.C.C. definition. This would not affect a signatory's duty to afford the work national protection insofar as that particular country protected published architectural works; however, in limited circumstances the architect might have to comply with certain statutory formalities of notice to be eligible for particular national protection.¹²⁴ Thus, by signing the U.C.C. the United States gained some measure of protection for her architects in foreign lands without any duty of reciprocating.

The Berne Convention also offers a potential source of foreign protection for United States architects, though this protection is much more limited than that afforded by the U.C.C. Since the United States is not a member of the Berne Union, no work created by a United States citizen can demand protection by authority of that Convention unless the work is first published in a Union country. In the case of architectural works this is a difficult requirement to meet. Publication under the Berne Convention is determined according to the law of the jurisdiction wherein first publication is alleged. Most Berne countries provide by statute that construction of a building is not publication of the building. In such case it is difficult to see how one could publish a building in a Berne country.

Of course, an American could first publish the plans in a Berne country. In such a case one's plans would have full national protection in all countries within the Union. Thus to the extent that a particular Berne Union country protected architects whose plans were infringed by buildings, the American architect whose plans were first published in a Berne Union country would be protected in that country.

SUMMARY COMMENT

The proposed United States copyright statute woefully neglects the architectural protection issue. Foreign experience has shown that architectural protection is feasible but requires carefully and thoughtfully

¹²⁴ The United States is one of the few countries requiring formalities as a condition to protection. 17 U.S.C. § 10 (1973).

drafted statutory provisions to be effective. The combined copyright and design provisions of the new proposed act are inadequate. The copyright act itself neglects to say whether buildings can be protected and fails to state whether structures infringe plans. The design section, which probably protects certain design components of building, is of scant additional help.

In the first place, the design act fails to resolve all the architectural questions which will necessarily arise under the copyright act. Secondly, it maintains that terrible archaic distinction between common law protection and statutory protection. Thirdly, coverage is too restricted. The act makes exceptions for such items as basic geometrical shapes, which might be fine for industrial articles but which obfuscates the true question in architectural protection.¹²⁵ The architectural structure should only require originality as a condition to protection. Standard copyright principles protect those who independently conceive of particular configurations. Copyright should protect the architect of an original work, who is beset by parasites who obtain their product by leechlike copying. The architect who creates an original building should be protected despite the facts that the design is:

-
- (b) staple or commonplace, such as a standard geometric figure . . .
- (c) different from a design excluded by subparagraph (b) above only in insignificant details or in elements which are variants commonly used in the trades; or
- (d) dictated solely by a utilitarian function of the article that embodies it.¹²⁶

The above factors might be relevant to hubcaps but merely cloud the inquiry in the architectural issue. The architect's protection should be just like that of the directory compiler. Anyone can make directories, but they must use original research.¹²⁷

Lastly, the duration of protection in the design act is too short. Its flimsy 10-year term would allow pirates to swarm through buildings making measurements while the original architect was out trying to solicit

¹²⁵ Note that *Stovin-Bradford v. Volpoint Properties Ltd.*, [1971] 3 All ER 570 dealt primarily with infringement of a "diamond-shaped feature." Such a feature would not be protectible under the proposed design protection bill S. 1361, Title III, § 302, 93d Cong. 1st Sess. (1973).

¹²⁶ S. 1361, Title III, § 302, 93d Cong. 1st Sess. (1973).

¹²⁷ See *Adventures in Good Eating v. Best Places to Eat*, 131 F.2d 809, 812 (7th Cir. 1942).

more commissions. This seems unfair in that the copyright portion of the act gives other artists protection which extends fifty years beyond their death.

Luckily for architects, the revision bill will probably not pass this legislative session. This allows for some maneuvering to try to extend architectural protection under subsequent bills. If one were to pick the best and reject the worst aspects of protection which are herein discussed, it would not be too difficult to draft an amendment which would suitably protect architectural works, while at the same time obviating much vexatious technical litigation in an area of increasing importance.

163.

LOST IN THE BRONX

By HARRY BLOOM*

Does the designer-manufacturer have copyright in the prototype of a commercially successful suite of furniture so as to prevent rival manufacturers making and marketing copies? "No," declared the English House of Lords in a recent case, *George Hensher Ltd. v. Restawile Upholstery Lancs. Ltd.*¹ Such designs must seek protection by registration under the Registered Designs Act 1949. Although there might in proper cases be dual² protection for articles both useful and good-looking under the Registered Designs Act and the Copyright Act of 1956 — which protects 'works of artistic craftsmanship' as a sub-species of works of art — the latter will only be effective if the work reaches a sufficient artistic standard. This accolade, the court agreed, could not be conferred on the furniture in question which witnesses had described as 'horrible', 'vulgar', and 'brash'. The best anybody could say for it was that it had 'eye-appeal' and 'distinctive shape'.

What is 'artistic'? the five Law Lords asked, sounding like Plato in search of Beauty. They produced five totally different answers. These added to the three answers — all different — given by the judges of the lower Court of Appeal, and the one proposed by the judge of the first instance, produced a grand slam of judicial divergence. "There is no definition framed by a member of the Appellate Committee which is altogether acceptable to any other member," observed Lord Kilbrandon, one of the Law Lords. "This means that each of their lordships has rejected or at least refrained from adopting nine solutions of the problem." He went on to express the hope that "the question which . . . this appeal poses will not often arise." Indeed, the tally of dissent was wider than Lord Kilbrandon indicated. The arguments of counsel on both sides similarly failed to find support among the judges.

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¹ 1974/ W.L.R. 700

² The Registered Designs Act 1949 protects 'features of shape, configuration, pattern or ornament applied to an article by any industrial process or means.' (S.1(3)). Protection may vest simultaneously by virtue of the Copyright Act — which protects works of artistic craftsmanship; and by the Registered Designs Act — which protects designs of industrial application which have been registered. However, these Acts employ different criteria.

It is doubtful if Lord Kilbrandon's hope will be granted. The circumstances of *Hensher v. Restawile* are in no way remarkable and could easily recur.³ Hensher had been selling a three-piece suite of lounge furniture (a settee and two armchairs) called The Denver. This had a distinctive 'boat shape' intended no doubt to play on the British public's love for all things nautical. In 1966, sales of the Denver began to fall; this Hensher's directors ascribed to the furniture's spindle-shaped legs. In experiments to make the furniture more attractive they stripped down the Denver, brought it closer to carpet level, and replaced the legs with a wooden plinth all around with castors on the corners — to enhance the illusion of riding on water. The wide arms of the Denver, which provided extra seating at a pinch (a good selling point) were carried forward into the new model. The prototype was nailed up (unlike the commercial product which would be glued and screwed together) and was thought to be a winner by the creators. Commercially it was just that. It had, in the words of one of the judges, "a commercially bold and original design, though not calculated to appeal to fastidious taste." Hensher called the new model "The Bronx" and put it on the market. "The Bronx" was so successful that other manufacturers, including Restawile, began to market imitations of it. Restawile admitted copying Hensher's product and also admitted that the prototype (since destroyed) was a work of 'craftsmanship'.⁴ The design was not registered under the Registered Design Act which meant that it had to fall back on protection under Sec. 3 (1)(c) of the Copyright Act. Indeed there never was a design, in the sense of a blue-print or drawing, from which "The Bronx" was made up.

The difficulty in the case was, of course, to determine if "The Bronx" was a work of 'artistic craftsmanship'. This in turn led to a hopeless definitional dispute over the meaning of Sec. 3(1) of the U. K. Copyright Act, which reads:

163. 3(1) "In this Act 'Artistic work' means a work of any of the following descriptions, that is to say:—
(a) the following, irrespective of artistic quality, namely paintings, sculptures, drawings, engravings and photographs;

³ There has in fact been a rash of similar cases because of the confusion in the laws of industrial designs, mentioned in fn. 2.

⁴ This admission saved the court a second major task of interpretation, for several of the judges doubted whether a mock-up, like that of the "Bronx" prototype, was a work of craftsmanship. E.g., Lord Reid, "The respondents have not taken the point that such a prototype, however artistic, could not be a 'work of artistic craftsmanship' and the point was not argued. But I feel bound to say that I have great doubt in this matter."

- (b) works of architecture, being either buildings or models for buildings;
- (c) works of artistic craftsmanship, not falling within either of the preceding paragraphs.”⁵

Note that the phrase ‘irrespective of artistic quality’ applies only to those forms of art set out in Sec. 3(1)(a). The court felt bound to assume that the inclusion of the phrase only in Sec. 3(1)(a) was deliberate and that it was therefore required to consider the artistic quality of the furniture, to decide whether it qualified for copyright protection under Sec. 3(1)(c). The dangers and difficulties of granting copyright protection as if it were a palm of excellence at an Arts Festival have been best expressed by Mr. Justice Holmes in an American case.⁶

“It would be a dangerous undertaking for persons trained only in the law to constitute themselves the final judges of the worth of pictorial illustrations outside the narrowest and most obvious limits. At the one extreme, some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge.”

Hensher v. Restawile illustrates the morass of opinion that results when this wise advice is ignored. It is not that the House of Lords was unaware of the dangers. The Law Lords are immensely experienced and sagacious. Lord Reid said in his judgment,

“There is a trend of authority, with which I agree, that a court ought not to be called upon to make an aesthetic judgment. Judges have to be experts in the use of the English language, but they are not experts in art or aesthetics. In such a matter my opinion is of no more value than that of anybody else.”

However he, and the rest of the court, were in an interpretation trap, for Lord Reid went on to say, “But I can and must say what in my

⁵ In the previous Copyright Act 1911, artistic work was defined to include ‘works of painting, drawing, sculpture and artistic craftsmanship, and architectural works of art and engravings and photographs’ (S.35 (1)). The phrase ‘irrespective of artistic quality’ did not appear, but some judges assumed it applied. Sec. 22 of the same Act provided that works were excluded from artistic copyright if capable of registration under the Design Acts.

⁶ *Bleistein v. Donaldson*, 188 U.S. 239 (1903)

view is the meaning of the word 'artistic' ". This meant that he would, after all, have to give an aesthetic judgment. The rest of the court felt the same and all agreed that "The Bronx" furniture did not reach the artistic standard required for copyright protection. But, as stated above, arguments differed widely, and added together they make up an anthology of popular views about the relative beauty and utility of chandeliers, candlesticks, garden gnomes, egg cups, deckchairs, bicycles, spinning wheels, lawn mowers and similar articles of utility and/or ornament.

Lord Reid thought it important that the maker or designer should have intended the work to have artistic appeal. Such works are not, his lordship suggested, created by accident or absent-mindedly (in legal phraseology, 'per incuriam'). However, the real test is whether a substantial section of the public consider the work to be artistic. The public includes people with simple or naive tastes. "If unsophisticated people get pleasure from seeing something which they admire I do not see why we must say that it is not artistic because those who profess to be art critics think differently." A blow struck for democracy in art! But how does a litigant prove to a court that he has public backing for his claim that his product is artistic if proof of market success fails to do this? His lordship offers no guidance on this. Lord Morris of Borth-y-Gest thought differently from Lord Reid. The word 'artistic' he said, is "well understood . . . it needs no interpretation." He emphasized that there was no absolute standard or measure; but something more than mere 'eye-appeal' or even customer approval was needed. Nor was the distinctive shape enough. There had to be "something else" — some artistic quality that raised it above the level of mere commodities that might be bought primarily because they were cheap, or comfortable, or gimmicky, or obscene, or for a variety of reasons that would not include their artistic qualities. This is reminiscent of the 'flash of genius' theory that plagued U.S. patent law for so long until put down by the Patent Codification Act of 1952⁷.

⁷ The difficulties of Hensher's case were encountered in U.S. law, but they were worked out in a different context — the application of the Design Patent Statute to works of the applied arts. Here, too, there was the same problem of such works falling between two stools, in spite of apparently having the double protection of patent and copyright. See Walter J. Derenberg 'Copyright No-Man's Land: Fringe Rights in Literary and Artistic Property,' *Journal of the Patent Office Society*, No. 10 (1953). The learned author suggested that the answer to the U.S. Design Patent problem was to adopt the British committee report that preceded the 1956 Act, and move the subject into the field of copyright.

Lord Dilhorne agreed with Lord Morris in saying that all 'artistic' means is 'artistic'. But he relied on intuition to solve the riddle. "I do not think that it suffices to show that some section of the public considers the work to be artistic," his lordship said in direct contradiction to Lord Reid. This was not a judicial assessment, he added, but one of fact. This seems like an easy way out, except that one man's intuition might be another's anathema.

Lord Simon of Gaisdale got down to hard pedantics. The Copyright Act protects 'works of artistic craftsmanship' and not 'artistic works of craftsmanship', he pointed out. One must look not at the work but at its creator. Was this work made by an 'artistic craftsman'? We are concerned with the *origin* of the work. Questions swarm into the mind at this suggestion — what if the craftsman is off form and produces an *overwrought* iron gate? What if he is awful at invention but splendid at executing the ideas of others? Will distinctions be made between amateurs and professionals? "This is irrelevant" said Lord Simon. Artistic merit does not come into it. This is why the legislature did not think it necessary to repeat the phrase 'irrespective of artistic quality' in sub-section (c). In deciding whether the maker was an artist-craftsman, one would rely on the evidence of acknowledged artist-craftsmen, or in other words, on expert evidence.

"In evaluating the evidence, the court will endeavour not to be tied to a particular metaphysics of art, partly because courts are not naturally fitted to weigh such matters, partly because Parliament could hardly have intended that the reconstruction of its statutory phrase should turn on some recondite theory of aesthetics — although the court must, of course, in its task of statutory interpretation, take cognisance of the socio-aesthetic situation which lies behind the enactment..."

This he proceeded to do by recounting the struggle of the arts to survive the iron siege of the industrial revolution. An "Arts and Crafts"

"The recommendation of the British Report can furnish a permanently satisfactory solution to the complex problem raised in the recent statuette-lamp litigation. . . . If such works (i.e., works of applied art) are reproduced in a substantial number for commercial use, then the available protection should be found in a design copyright along the lines of the British proposal, and should certainly not depend upon the 'flash of genius' or 'non-obviousness' standards of our existing patent legislation."

There is no doubt that the learned author was perfectly correct in making this suggestion at the time he wrote. He could not have foreseen the sudden change of direction, and the botched half-measures enacted for design copyright in the 1956 Act, and still less the disastrous effects of the hasty, incomplete and confusing Design Copyright Act of 1968.

movement led to William Morris starting up "The Firm" in 1862, which produced hand-printed wallpaper, artistic printing and beautiful furniture. In 1862 the Fine Arts Copyright Act was passed — which Lord Simon saw as no coincidence. Later events included the establishment by William Morris of the Kelmscott Press (1890), the founding of London's Central School of Arts and Crafts (1896), the appearance for the first time of an article on "Arts and Crafts" in the *Encyclopaedia Britannica*, (10th ed., 1902) and so on, until Parliament, for the first time, gave copyright protection to 'works of artistic craftsmanship' in the Copyright Act of 1911. In the United States a similar movement got under way through the ambitions of Ashbee to "tilt at the great industrial windmill", the metalwork of Benson which was mass produced, and especially through the work and teaching of Frank Lloyd Wright who himself turned to industrial design. The history of the Arts and Crafts movement in Britain and the United States combined to marry art to industry so that "'craftsmanship', in the statutory phrase, cannot be limited to handicraft: nor is the word 'artistic' incompatible with machine production," as Lord Simon said. Historical research led Lord Simon to conclude that there is no difference in meaning in the 1956 Copyright Act and the 1911 Copyright Act, in which works of artistic craftsmanship were included in the general description of art such as paintings, sculpture and drawing, all of which presumably got copyright protection, regardless of artistic merit.

This approach bypasses the difficulty of asking courts to recognize the altogether uncharacteristic copyright notion that they must approve the artistic quality of a work, before letting it through for protection. But the judge had to take a long detour to get there.

There is no space for a full catalogue of the opinions of the other judges who sat in the case. It is enough to indicate the wide span of judicial polemics raised by the case to add that Lord Kilbrandon disagreed that the public decides whether a work is artistic: it is or is not so, even before anyone has seen it; that in the Court of Appeal, Russell, L.J., held that the test was whether the functional utility of the article outweighed its ornamental attraction — did he mean the more useful the article, the more beautiful it must be to win copyright protection?—and that Graham, J.'s cautious view in the Chancery Division — if a work has distinctive shape, form and finish (an 'objective' element) and is conceived not purely as a useful article (a 'subjective' element), then it is a work of artistic craftsmanship — was rejected by all the other judges.

Hensher v. Restawile presents a problem not confined to English Law or to the vagaries of Sec. 3 of the 1956 Copyright Act. A well

known English copyright lawyer once said, "Thank heavens we don't have a written constitution. It spares us the headaches of the *Sears-Compco* pre-emption rule." Maybe, but it does not remove the ache, it merely relocates it. There is an inherent legal dilemma when different laws offer competing systems of regulation for the same subject matter. In this case, the stress arose over a subject matter that lives in the twilight area between copyright and patent. It might be said that the decision has done no damage to the system of protection of intellectual and industrial property: if a work is not the proper subject for copyright or patent, then it must surely be eligible for protection under the Registered Design Act 1949 or the Design Copyright Act 1968. Alas, the U.K. law on design protection has suffered more legislative mayhem than any other part of the copyright law. The damage stems from the days of the Arts and Crafts movement. Quoting Carlyle,

"On every hand the living artist is driven from his workshop, to make room for a speedier inanimate one."

and adding his own observation:

"So the handicraftsman must be restored to his creative role in society. Moreover, his creation, wherever appropriate, should be a work of art — creation par excellence: and the artist must in turn be a craftsman",

Lord Simon expressed the philosophy that led the framers of the 1911 Copyright Act to exclude working designs for industrial products from copyright protection. Instead they were directed to the (then) Registered Designs Act, which gave protection not only to registered designs but to industrial products made from them. Since articles of utility could also be things of art, an exception was made of works of artistic craftsmanship — which, along with more conventional art forms such as paintings or sculptures, would get copyright protection. What made Parliament modify the position when passing the 1956 Copyright Act is not known. But copyright protection was given to artistic works, whatever the intention of the creator, against anyone who copied the work in two or three dimensional form, except when the design was in use for the production of piece goods (such as textiles) or goods on mass production, or goods on the market. In the latter cases, protection was given under the Registered Design Act 1949. Unregistered and unexploited designs might get protection under the Copyright Act as works of artistic craftsmanship.

This meant that in the industrial field, the owner of an unregistered design, in most cases, got no protection. Further, the duration

of protection under the Registered Designs Act was 15 years (compared with the author's life plus 50 years under the Copyright Act); hence, after 15 years the work fell into the public domain for all industrial uses. In this confusion, plagiarism of selling points in commodities, and even of the novel and inventive features of commodities, flourished.

In 1959, the government set up a committee to investigate the muddle. It made over fifty suggestions for change, but there was no Parliamentary time for the major legislation required. A Private Member's Bill, primarily to protect the designs of articles with a short life, such as toys and jewelry, was passed with government support. The enactment had to be short. It could not include all the clauses that the government committee found necessary. At the same time, it was given wider scope than originally intended: it covered industrial articles of all sorts, even when not registered, including purely functional items such as automobile clutches or umbrellas. Manufacturers were now being sued for breach of copyright by 'designers' of functional articles, and because of the law's uncertainty, had to settle out of court.

Hensher's case has done one thing: if it has not given us the meaning of 'works of artistic craftsmanship', it has defined what it is not. It is not an industrial or commercial product unremarkable for its artistic qualities.

The House of Lords, in this case, acted in a strangely contradictory way. It emphasized that judges do not have the expertise or experience to decide matters of aesthetics. Having said as much, they then proceeded to do just that. In this way they undermined the value of their judgment in the course of delivering it. But the public, including the by no means inconsiderable section that makes useful articles with a touch of decoration, must decipher the decision and live with it. Where did things go wrong? At the legislative level, because of the rather hysterical draftsmanship of the Design Laws? Was the subject one that is incapable of legal adjudication? The decision would probably have gone the same way in the U.S. although for different reasons. There seems to be a kind of judicial schizophrenia when it comes to the protection of designs.

Perhaps judicial ignorance, not of art but of history, had something to do with it. Adding decoration to useful objects was not a mere counter-industrial-revolution. Napoleon's cannon were ornate with decoration. Medieval church organs were things of great beauty as well as being musical instruments. As far back as the days of Pericles, Greeks decorated their pottery with great paintings. It seems wrong to see decoration as a late arrival that must be found accom-

modation somewhere in the copyright-patent area. Why not create a new category suited to the facts of the case?⁸

In England at present, a departmental committee under Mr. Justice Whitford is considering whether and how the laws of copyright and design need changing. So it is on the cards that *Hensher v. Restawile* will before long become a museum piece. If nothing else, it should certainly be preserved as a warning to lawyers not to meddle in matters, like Art, which are above their heads.

⁸ In a letter to the *Times* (London: Jan. 24, 1972), a contributor, Eric Taylor, suggested that "copyright is about artistry, industrial design about articles, and patents about artifices". This just fails to come off, for patent is also about formulae, e.g., for drugs. But otherwise, it makes a neat division which legislators should keep in mind.

PART II.

LEGISLATIVE AND ADMINISTRATIVE DEVELOPMENTS

1. United States of America and Territories

164. U.S. CONGRESS. HOUSE

Copyright miscellany. *Congressional Record*, vol. 120, no. 179 (Dec. 19, 1974), pp. H12354-H12360.

The House debates on S. 3976, as amended by the Judiciary Committee (see 22 BULL. CR. SOC. 49, Item 17), which was passed, under suspension of the rules, by a vote of 292 yeas and 101 nays, with 41 not voting. The Senate agreed to the House approach on the same day (see 120 *Congressional Record* S22193 (daily ed. Dec. 19, 1974)), thus clearing the measure for the White House.

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

Copyright miscellany. Report, together with dissenting views, to accompany S. 3976. Submitted by Mr. Kastenmeier, December 12, 1974. 18 p. (93d Cong., 2d Sess., H. Rep. No. 93-1581)

A favorable report on the bill which would extend expiring copyrights through 1976, establish a National Commission on New Technological Uses of Copyrighted Works, and remove the expiration date from the record piracy provision, while increasing the penalties for such piracy. Views dissenting in part are given by Representatives Kastenmeier and Drinan. The bill, which was passed by the Senate on September 9, was amended in several minor provisions, dealing with membership on the Commission, midterm appropriations authority, and less severe jail penalties.

166. U.S. COPYRIGHT OFFICE.

Highlights of the copyright revision bill. Washington [Dec. 1974] 4 p. (Circular 99)

A list of some of the most important features of S. 1361, passed by the Senate on September 9, 1974.

167. U.S. COPYRIGHT OFFICE.

Library of Congress. [37 CFR Part 202] Material not subject to copyright: Registration of original typeface designs; extension of

comment period. *Federal Register*, vol. 39, no. 223 (Nov. 18, 1974), pp. 40515-40516.

"This notice extends the period for comments to the notice published September 10, 1974 (39 FR 32631) [to January 15, 1975] on the question whether the Copyright Office should amend §202.1(a) of its Regulations to permit copyright registration for original typeface designs."

168. U.S. FEDERAL COMMUNICATIONS COMMISSION.

[CFR Title 47—Telecommunication. Chapter I—Federal Communications Commission] Part 76—Cable television services: cable television systems, development of services. [FR Doc. 74-28962. Filed 12-11-74] *Federal Register*, vol. 39, no. 240 (Dec. 12, 1974), pp. 43302-43310. "Docket No. 19988 FCC 74-1279."

"FCC rules on program origination and inquiry into development of services; effective 1-20-75."

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

169.

CORRECTION

Through a regrettable error on the part of the editorial staff, the summary of the case of *Meredith Corporation v. Harper & Row, Publishers, Inc.* on page 154 of the December, 1974 issue of the BULLETIN referred to the victorious counter-claimant, Harper & Row, as the party guilty of copyright infringement. In actual fact, the court decided that an injunction should issue in favor of Harper & Row and that the party, Meredith, which was nominally the plaintiff in a declaratory judgment action, *was* the infringer.

Although the Editorial Board has already attempted to correct this error by sending a separate notice to each of our subscribers, we are taking this additional opportunity to express our regrets and apology to the parties concerned.

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

170. *Meeropol v. Nizer*, 183 U.S.P.Q. 513 (2d Cir., Oct. 17, 1974) (Oakes, (C.J.). *For Decision Below*, see 179 U.S.P.Q. 660, 21 BULL. CR. SOC. 323, Item No. 300 (S.D.N.Y. July 18, 1973).

Two actions for alleged copyright infringement instituted by the plaintiffs, children of Julius and Ethel Rosenberg (Meeropol). One action was brought in New York against the author (Nizer) of the allegedly infringing work and its hardcover publisher (Doubleday). Eight months later the second action was brought in Connecticut, against the publisher's licensee (Fawcett) who was to publish a paperback edition. Included in the Doubleday-Fawcett contract was an indemnification clause by which Doubleday was to hold Fawcett harmless for any loss due to a breach of Doubleday's warranty that the book did not infringe any copyrights or any other rights. Fawcett moved in New York for a stay of the Connecticut action pending outcome of the New York action, which was granted on the condition that Fawcett intervene in the New York action, which it did. On plaintiff's appeal from Judge Tyler's order granting the stay, *held*, affirmed.

(1) *Intervention Pursuant to F.R.C.P. 24(a)*

The court upheld Fawcett's right of intervention:

"[I]ndeed for all practical purposes Doubleday is the real party in interest in the Connecticut action. Under Fed. R. Civ. P. 24(a), Fawcett therefore intervened as of right in the New York action since the disposition of the New York suit might as a practical matter have impaired or impeded Fawcett's ability to protect its interests; by intervening, Fawcett was merely following the procedure essentially approved of, if not applied, in *Cresta Blanca Wine Co. v. Eastern Wine Corp.*, 143 F.2d 1012, 62 USPQ 224 (2d Cir. 1944), and *International Nickel Co. v. Ford Motor Co.*, 108 F. Supp. 833, 95 USPQ 356 (S.D.N.Y.1952). It is significant that there has been no appeal from that portion of Judge Tyler's order which granted Fawcett's motion for leave to intervene in the New York action."

(2) *Stay of Connecticut Action*

After the intervention by Fawcett, the New York federal court had jurisdiction over all the parties and thus had the power to order the stay of the Connecticut action. Therefore, the granting of said stay was a matter of discretion, which plaintiffs claimed was abused. First, the court interpreted the indemnity broadly so as to bring Fawcett in privity with Doubleday, contrary to the position of plaintiffs. Second, it found the issues in the two cases to be sufficiently similar to warrant a stay. And even though prior notice to Fawcett of plaintiffs' claims (possibly negating Fawcett's claim of good faith or innocence) might bear on punitive damages, it did not make the "underlying claim[s] . . . so different" as to prevent the stay. Finally, the court rejected plaintiffs' contentions that the stay prevented the possibility of a preliminary injunction in Connecticut and denied the right to a jury trial in that action. In the New York action, the plaintiffs had sought a preliminary injunction against the publication of a paperback edition, which had been denied. Their appeal from that portion of Judge Tyler's order had been withdrawn, and thus such a similar request in the Connecticut action was "an attempt to relitigate" that issue. As to plaintiffs' constitutional right to a jury trial, such was preserved notwithstanding Fawcett's intervention.

171. *Bernstein v. Universal Pictures, Inc.*, 183 U.S.P.Q. 422 (S.D.N.Y., June 28 and July 26, 1974) (Briant, D.J.).

Class action for alleged violation of antitrust laws. Defendants (motion picture and television producers) refused to transfer to plaintiffs (composers and lyricists) the copyrights in music composed by plaintiffs

but commissioned by defendants. Because of this steadfast refusal, along with the determination of plaintiffs to acquire the copyrights to their works, collective bargaining reached an impasse.

On the court's own motion, *held*, complaint dismissed.

The court held that the "work for hire" doctrine, embodied in 17 U.S.C. §26, provides that one who commissions a work at his own instance and expense owns the copyright in the work, absent a contrary intent. And further, that this rule applies whether the work be authored by an employee or an independent contractor. Hence, "[t]he mere refusal of the producers to give up the right conferred by the Congress, and to do so pursuant to collective bargaining or otherwise, cannot be considered contrary to the antitrust or any other laws."

172. *Rexnord, Inc. v. Modern Handling Systems, Inc.*, 183 U.S.P.Q. 413 (D. Del., July 10, 1974) (Stapleton, P.J.).

Action for copyright infringement and unfair competition arising out of defendant's publication of a catalogue of its conveyor equipment, portions of which were found to be copied from and substantially similar to portions of plaintiff's catalogue. Prior to suit, plaintiff had registered its claim to copyright in its current catalogue (the one allegedly copied). However, several facts concerning plaintiff's copyright in its catalogue are significant: (1) Much of plaintiff's current catalogue was composed of material which had previously appeared in several of plaintiff's earlier catalogues. These earlier catalogues had been published with a notice of copyright, but were not the subject of issued copyright registrations. (2) Plaintiff had disseminated to its customers a variety of brochures which were, in fact, exact duplications of corresponding current catalogue pages, without any notice of copyright. (3) Plaintiff had published, without notice of copyright, a variety of bulletins, sales manuals, data books, etc. for use primarily by its engineering department, which may have included exact duplications of pages from its current catalogue. In addition to defendant's alleged acts of copying, the defendant had represented to customers that it would supply equipment "like that of [plaintiff]" but at a lesser price.

On motions by both parties for summary judgment and motion by defendant for discovery, *held*, plaintiff's motion denied; defendant's motion denied in part (copyright infringement) and granted in part (unfair competition).

(1) *Copyright Infringement*

(a) Actual copying — Finding that the common errors in the two catalogues, together with the usual facts of defendant's access to and knowledge of plaintiff's work, were "especially probative", the court

easily concluded that actual copying had taken place. The common errors were persuasive in rebutting the argument that the "extensive resemblances" between the two works resulted not from copying but rather from the underlying similarity in the products sold by both plaintiff and defendant which were the subject of each catalogue.

(b) Substantial similarity — Citing *Markam v. A.E. Borden Co.*, 206 F.2d 199 (1953), the court held the catalogue in question to be a "composite work" within 17 U.S.C. §3:

"Accordingly, the test of 'substantial and material similarity' is not the degree of resemblance between defendant's catalogue and the entirety of plaintiff's catalogue. Rather, any product representation in plaintiff's catalogue may be segregated and juxtaposed against the portions of defendant's catalogue that allegedly infringe it. If that comparison discloses a 'substantial and material similarity', an infringement of plaintiff's copyright in his entire catalogue will be deemed established."

Applying the above test, the court found that as to the great majority of the allegedly infringed pages, there was in fact a 'substantial and material similarity'.

(c) Defendant's printer not liable — The court rejected defendant's claim that any liability must be attributed not to defendant but to its printer. Among the materials defendant had supplied its printer in order to compile its catalogue was the plaintiff's catalogue as well as "sufficient non-infringing material . . . to enable it to print an entire catalogue without drawing on the contents of [plaintiff's catalogue]". In addition, defendant asserts it instructed its printer not to infringe plaintiff's catalogue and was assured such instruction was complied with. The court held that, even if defendant's assertions were true, its

"ability to control the contents of the infringing work and a financial stake in its dissemination — [were] sufficient to impose liability even where a defendant has had no direct personal role in printing or publishing and was unaware of the copying."

(d) Forfeit by publication without copyright notice — The court held plaintiff had forfeited its copyright in those components of its catalogue which had been published without any copyright notice as brochures and generally distributed to its customers. Defendant argued that its failure to affix a notice to these brochures was excusable as an "accident" or a "mistake" under 17 U.S.C. §21 and therefore should not have the effect of forfeiture. However, a sworn statement on behalf of

defendant indicated that the omission was not "inadvertent but deliberate, based on [an] erroneous belief that notice was simply not legally necessary" — i.e., defendant's advertising and sales manager stated he believed the brochures "incorporated" the copyright of the catalogue since the brochure pages were numbered exactly as they appeared in the catalogue.

(2) *Unfair Competition*

Plaintiff's claim of unfair competition was based on defendant's copying of its catalogue with its sales pitch that it sold equipment like plaintiff's at a lower price. Absent any evidence of palming off or misrepresentation by defendant that its equipment *was* actually plaintiff's equipment, the court held plaintiff's rights were limited to those under the Copyright Act.

173. *Baldwin Cooke Company v. Keith Clark Inc.*, 183 U.S.P.Q. 209 (N.D. Ill. June 12, 1974) (Marshall, D.J.).

Action for alleged copyright infringement resulting from defendant's copying of plaintiff's copyrighted combination calendar, diary and appointment book in the publication of a competing work.

Held, judgment for plaintiff.

(1) *Copyrightability*

The court held the plaintiff's combination calendar diary and appointment book was a proper subject of copyright under 17 U.S.C. §7 as either a "compilation" or an "arrangement". Rejecting as "inapposite" cases cited by the defendant challenging the copyrightability of such works, the court distinguished the work before it as far more sophisticated and complex as to both format and arrangement.

(2) *Originality*

The numerous works similar to plaintiff's which defendant offered to the court were insufficient to rebut the prima facie evidence of originality flowing from plaintiff's copyright certificate. In addition, the court found independent evidence of originality in plaintiff's design, layout, and artwork, as well as its early entrance into the market.

(3) *Misstatements in Certificate*

While there were certain misstatements in the plaintiff's registration certificates relating to general revisions which had not in fact been made, these were "unaccompanied by fraud" and were not intended nor did in fact deceive or mislead anyone. Therefore, they did not invalidate the copyright or render the registration certificate incapable of supporting an infringement action.

(4) *Abandonment*

Defendant argued that plaintiff had abandoned its copyright

with respect to those portions of its work which had been reprinted on its more than 10,000,000 pieces of advertising material which bore no notice of copyright. Relying on *Imperial Homes Corp. v. Lamont*, 458 F.2d 895 (5th Cir., 1972), a case with distinguishing facts, the court rejected this argument. It emphasized that intention is an essential element of abandonment, and that plaintiff's continued placement of a copyright notice on each annual edition of its work was evidence of an intention to retain copyright rather than an intention to abandon it. Moreover, since the plaintiffs claimed a copyright in the compilation rather than in any particular portion of its diary, the court stated that even if certain portions were in the public domain, the work as a whole would nevertheless be protected.

(5) *Fair Use Defense*

Defendant, having included additional materials to its work which were not included in plaintiff's work, claimed he had made a "fair use" of plaintiff's work. The court readily rejected this argument, pointing out that additions to a copyrighted work cannot immunize an infringer where substantial similarities are present.

174. *United States v. Bodin*, 183 U.S.P.Q. 345 (W.D. Okla., May 7, 1974) (Daugherty, C.J.).

Criminal action pursuant to 17 U.S.C. §101(e) and §104 for tape piracy. On defendants' motion to dismiss information on the following grounds: (1) unconstitutionality of 1971 amendment providing for copyright protection for sound recordings; (2) ambiguity of the charges and the failure to include as an element lack of compliance with compulsory license provisions; (3) failure of charges to allege whether defendants were acting as agents or principals at time of violations, *held*, motion denied.

(1) *Constitutionality*

The defendants first argued that protection for sound recordings abridges the First Amendment right to freedom of expression. The court differed: "What [the defendant] seeks is not the freedom to express himself artistically or otherwise, but the right to make exact and identical copies of sound recordings produced by others. [The First Amendment does not give] a privilege to usurp the benefits of the creative and artistic talent, technical skills and investment necessary to produce a . . . record. . . ."

The court noted, however, that the statute in no way prevents the defendants from imitating on a new tape, with their own performers, a performance embodied on any copyrighted sound recording.

The defendants next argued that the protection for sound record-

ings in failing to include a compulsory license provision as is provided for musical compositions under 101(e), was a violation of due process which discriminates between the rights of recording companies and sound recording distributors. The resulting monopoly, the defendants argued, is contrary to the public interest. The court, on the contrary, upheld this distinction as rational, quoting *Shaab v. Kleindienst*, 345 F.Supp. 589 and directed the defendants to bring their public policy arguments before Congress rather than before a court: "... compulsory licensing of copyrighted musical compositions promotes the arts by permitting numerous artistic interpretations of a single written composition."

(2) *Ambiguity of Charges*

As the court had indicated earlier in its opinion, sound recordings are not subject to the compulsory license provisions of the Copyright Act and therefore the defendants' objection that this essential element was omitted was held to be clearly erroneous. As to the alleged "ambiguity" in the charges generally, the court stated that "the Information is a plain, concise and definite written statement of the essential facts charged as required by Rule 7(c), Federal Rules of Criminal Procedure". The Information included the elements of the alleged crimes as it applied to the particular violations of defendants, namely, that specific copyrighted sound recordings were wilfully copied and sold for profit without the authorization of the copyright proprietor.

(3) *Agency*

Since 17 U.S.C. §104 defines infringement to include acts constituting aiding and abetting another to infringe, the fact that any of the defendants may have been acting as corporate officers rather than in their individual capacities would not immunize them from criminal liability.

2. State Court Decisions

175. *Wolf v. Illustrated World Encyclopedia, Inc.*, 34 N.Y.2d 834, 359 N.Y.S.2d 59 (N.T. Ct. App. June 13, 1974). *For decision below, see*, 21 BULL. CR. SOC. 50, Item 13, N.Y.S.2d 419.

Action for royalties brought by illustrator against his publisher. The Appellate Division held for the illustrator. On defendant's appeal, *held*, affirmed.

The court directed its short memorandum opinion solely to defendant's defense that plaintiff had breached its contract by illustrating a related work of another publishing house. The court refused, over defendant's objections, to read into the contract any implied covenant restricting the illustrator's freedom to sell even similar illustrations as those sold to defendant, when no such express covenant had been added

by the parties. This decision was reached by charging that the publisher "must have been aware" that the plaintiff had "for some years . . . been professionally engaged in editorial, art, and illustration work for encyclopedias and other publications", and yet no provision to curb that activity was included in the contract.

176. *Mercury Record Productions, Inc. v. Economic Consultants, Inc.*, 183 U.S.P.Q. 359 (Wis. Sup. Ct., June 17, 1974) (Hefferman, J.). *For Decision Below*, see 181 U.S.P.Q. 105 (E.D. Wis., July 11, 1973). 20 BULL. CR. SOC. 426, Item 347.

Action for preliminary and permanent injunction against tape piracy, or violation of plaintiff's alleged common law copyrights in its recordings fixed prior to 1972, and for unfair competition. On plaintiff's appeal, based solely on ground of unfair competition, from order sustaining defendant's demurrer issued by Wisconsin Circuit Court, Milwaukee County, *held*, reversed.

The testimony in defense asserted three main facts: (1) that the defendant had not "palmed off" its products as plaintiff's; (2) that the records it taped had not been generally on the market for 10 years; and (3) that the major recording companies do not market "oldies" as singles.

The testimony on behalf of plaintiff, in addition to contradicting points (2) and (3) above, asserted the following facts: (1) that plaintiff incurred high costs to create its recordings, namely recording costs, advertising and marketing costs, and royalties to the performing artist and the composer of the underlying musical work; (2) that plaintiff is injured because it is not able to exploit by way of a second release its most popular recordings; and (3) that the public is injured because, if plaintiff cannot exploit its "money makers", it will be less willing to produce "money losers" — such as certain classical records — and the result will be a drastic decrease in the variety of musical recordings now available.

The cornerstone of the court's opinion is in its application of the facts before it to the three-pronged test of unfair competition developed in the *INS* case (*International News Service v. Associated Press*, 248 U.S. 215 (1918)) which effectively eliminated "palming off" as an element of the tort: (1) time, labor, and money expended in the creation of the thing misappropriated; (2) competition; and (3) commercial damages to plaintiff.

Defendants asserted several reasons why the above rule should not be applied, all of which were rejected by the court. In its thorough and lengthy opinion, all these reasons were rejected. Following are the major points made by the court:

1) Under *Goldstein v. California*, 412 U.S. 546 (1973), the federal government has not preempted state unfair competition laws with respect

to pre-February 15, 1972 sound recordings, and thus states may constitutionally apply their own laws to recordings fixed prior to that date.

2) *Goldstein* has revitalized the *INS* case if it ever was restricted by *Sears Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964).

3) To prevent defendant from retaping plaintiff's recordings is not giving plaintiff a perpetual copyright — for the property protected against larceny by competitors is plaintiff's time and professional skill.

4) The court did not decide whether re-release of a recording fixed prior to February 15, 1972 would subject such a recording to federal protection and thus cause the loss of state protection. The court hinted that its answer would probably be no, as such a result would circumvent Public Law 92-140 by offering federal protection to recordings fixed prior to February 15, 1972.

5) The court refused to rule that the issue should be resolved by the legislature, when "it is apparent that a wrong has been committed".

PART V.

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An analysis of the provisions contained in the Brazilian copyright law of December 14, 1973, particularly sections 49-51 (limitations on copyright), and sections 29-30 (economic rights of the author), concluding with a suggestion that a compulsory licens-

ing system for the use of literary-musical works and sound recordings in radio broadcasting be adopted.

C. ARTICLES PERTAINING TO COPYRIGHT
FROM TRADE MAGAZINES

1. United States

206. AUG, STEPHEN M. Cable TV rules on film liberalized. *Washington Star-News*, Nov. 15, 1974, p. B13, cols. 1-6.

An article on a new FCC rule, "which probably won't be made public for a month," allowing pay-cable television operators to show a greater number of current motion pictures than they are now permitted to show.

207. Authors League urges Congress to speed copyright extension. *Variety*, vol. 277, no. 4 (Dec. 4, 1974), p. 53, cols. 4-5.

An article on a letter to the House Judiciary Committee signed by the following well-known author-members of the League: Jerome Weidman, John Hersey, Elizabeth Janeway, Stephen Sondheim, Robert Anderson, Herman Wouk and Herbert Mitgang. The letter urges the Committee to approve a bill, already passed by the Senate [S. 3976], which would, in part, extend expiring copyrights for two years.

208. BLUMENTHAL, RALPH. Pornographic-film piracy disclosed here. *The New York Times*, vol. 124, no. 42,693 (Dec. 14, 1974), p. 33, cols. 1-2.

An article on a "new nationwide crime racket involving the pirating of major pornography films [which] has come to light, according to police experts, with the arrest . . . of a film processor on charges of possessing a stolen negative and sound track of 'The Life and Times of Xaveria Hollander'." The legitimate distributor has said that the film was copied and booked into at least 15 theaters across the country.

209. BURKE, JACK. Copyright: where do we stand? *TV Communications*, vol. 11, no. 12 (Dec. 1974), pp. 38-49.

An article on legislative efforts, as well as those of interested

parties such as broadcasters and cable television organizations, in connection with CATV and copyright since the *Teleprompter* decision in March 1973.

210. CARMODY, JOHN. To preserve a legacy of news. *The Washington Post*, Nov. 15, 1974, pp. B1, cols. 1-5; B4, cols. 1-3.

An article on a joint announcement made on November 14, by CBS, Inc., and the General Services Administration about a two-year pact pursuant to which CBS would make available all its television "hard news" programs, including specials, to "responsible researchers" throughout the nation through the National Archives, starting early next year. According to the article, a spokesman for CBS stated that the status of the suit against Vanderbilt Television News Archive would not be affected.

211. Copyright attorney cautions both sides in type design issue. *Publishers Weekly*, vol. 207, no. 1 (Jan. 6, 1975), pp. 45-46 (Book design and manufacturing).

An article on statements made by copyright attorney Bella Linden at the November luncheon meeting of the American Institute of Graphic Arts Book Clinic, where a number of copyright problems, including that of proposed typeface protection, were reviewed by her.

212. Copyright bill, re-regulation dominate NCTA board meeting; slight shift in association position on S. 1361 may be in offing. *Broadcasting*, vol. 87, no. 21 (Nov. 18, 1974), pp. 53-54.

A prognosis of what course the National Cable Television Association will take on the provisions about cable television in the pending copyright legislation (S. 1361), when its board of directors meets, November 19-20.

213. DOEBLER, PAUL. New computerized services provide speedy (but not free) copies "on demand." *Publishers Weekly*, vol. 206, no. 21 (Nov. 18, 1974), pp. 34-36 (New media publishing).

An article on a new service offered as an alternative to free photocopying of copyrighted material by McGraw-Hill and the Institute for Scientific Information. The service offers "rapid retrieval of huge quantities of published information—without infringing copyright."

214. DREYFUS, JOHN. Type design: the rationale for protection. *Publishers Weekly*, vol. 207, no. 1 (Jan. 6, 1975), pp. 42-44. (Book design and manufacturing).

An extract from Mr. Dreyfus's presentation in mid-October, 1974, at a symposium co-sponsored by the Copyright Office, the National Endowment for the Arts, and the Graduate School of the U.S. Department of Agriculture, held at the U.S.D.A., and aimed largely at informing government attorneys about the subject.

215. ELMAN, STAN. Copyright—even saints and kings had problems with it! *California Librarian*, vol. 35, no. 2 (Apr. 1974), pp. 32-38.

A brief historical sketch of copyright from its alleged beginnings in 567 A.D., involving the celebrated dispute between Saint Columba and his teacher, Finnian of Moville, to the *Williams & Wilkins* case.

216. Foster cites changing times as reason for changing policy on copyright. *Broadcasting*, vol. 87, no. 25 (Dec. 16, 1974), p. 26.

"National Cable Television Association President David Foster defended the group's about-face on copyright, citing 'outmoded' nature of old copyright agreement as central to decision. Remarks came in response to letter from Office of Telecommunications Policy chief John Eger, who was distressed by turn-about."

217. HENRY, NICHOLAS L. Copyright: its adequacy in technological societies; the traditional copyright concept may not be appropriate to knowledge management in a technological society. *Science*, vol. 186, no. 4168 (Dec. 13, 1974) pp. 993-1004.

A suggestion is made "that, in the way it was conceived originally, copyright may not be the optimal means of encouraging, researching, writing, and disseminating new ideas in a society characterized by a high level of information technology; and . . . steps [are proposed] that could be taken now to solve some of the problems of knowledge management."

218. KARP, IRWIN. Copyright & freedom. *Variety*, vol. 277, no. 9 (Jan. 8, 1975), p. 52.

The counsel for the Authors League of America makes a case for the proposition that copyright serves, in addition to the encouragement of individual creative efforts through personal gain, a fundamental constitutional purpose, namely, "to advance the

First Amendment freedoms to express, publish and disseminate ideas and opinions.”

219. KIRK, CYNTHIA. Copyright issue ignites debate at cable meet. *The Hollywood Reporter*, vol. 234, no. 12 (Dec. 6, 1974), pp. 1, 21.

An article on “a lengthy and at times heated debate” at the Western Cable Television Show and Convention, held in Anaheim, California on December 5, 1974. The debate was sparked by the outlining of the National Cable Television Association’s “newly adopted legislation goals, which include acceptance of the ‘politically realistic’ principle of paying copyright fees.”

220. KWITNY, JONATHAN. Pirate sails high Cs of record world without paying royalties to artists. *Wall Street Journal*, vol. 185, no. 2 (Jan. 3, 1975), p. 6, cols. 2-3.

An article about the activities of David Heilman of Milwaukee, who calls himself a “good pirate”, because he pays or offers to pay composers for records he duplicates without the consent of, and without payment to record manufacturers or performing artists. Mr. Heilman is currently enjoined by the Wisconsin Supreme Court from continuing in business while awaiting trial on charges of unfair competition.

221. LEES, GENE. Psst! Get your hot Glen Campbell tapes here. *New York Times*, Dec. 1, 1974, p. D-21 (late city ed.).

An article on tape piracy in the United States, with particular reference to the criminal action against Richard Taxe, who “was sentenced to four years in prison on charges arising from the illicit sale of ‘illegally copied 8-track stereo sound recordings’.”

222. LOTTMAN, HERBERT R. Photocopying; how is Europe handling the problem? Solutions range from a sweeping pioneer effort by Sweden to assorted studies and calls for court action elsewhere. *Publishers Weekly*, vol. 206, no. 22 (Nov. 25, 1974), pp. 26-27.

A spot check made in Europe by Publishers Weekly.

223. LOTTMAN, HERBERT R. The Russians are reaching out; amid his busy time at Frankfurt, the deputy head of the new Soviet copyright agency gives *PW* his country’s views on international publishing. *Publishers Weekly*, vol. 206, no. 20 (Nov. 11, 1974), p. 28.

An article on statements by Mr. Yuri Zharov about the new

Soviet copyright agency, VAAP, made at the 1974 Frankfurt Book Fair.

224. MACKENZIE, JOHN P. Supreme Court faces issue of copyright vs. copying. *The Washington Post*, Dec. 18, 1974, p. A2, cols. 1-3.

An article on the oral arguments before the Supreme Court on December 17 in the *Williams & Wilkins* case. The writer opines that the authors and publishers "got some encouraging signs" from the justices.

225. NCTA votes turnaround on copyright; its board yields to arguments against Senate bill it had endorsed; 1971 consensus with broadcasters and copyright owners is called dead. *Broadcasting*, vol. 87, no. 22 (Nov. 25, 1974), pp. 33, 36-38.

An article on a meeting of the National Cable Television Association in Washington in mid-November, at which its board resolved to work for three major changes in S.1361, the Senate-passed copyright revision bill. It elected to oppose the creation of a copyright tribunal; it resolved to work for a change in the penalty provisions of S.1361 to shield cable operators from "undue harassment"; and it voted to push for an amendment exempting systems with under 1500 subscribers from any copyright payment.

226. OETTINGER, ELMER R. Copyright and the librarian. *North Carolina Libraries*, vol. 31, no. 4 (Conference issue, 1973), pp. 25-34.

A discussion of the problems raised by the photocopying of copyrighted works by libraries, with a conclusion that "[w]here basic and profound disagreement exists among powerful interests, the ultimate answer always lies in compromise in which neither side obtains its optimum wish and both have to accept some accommodation of the other's perspective and needs."

227. RINGER, BARBARA A. The demonology of copyright. *Publishers Weekly*, vol. 206, no. 21 (Nov. 18, 1974), pp. 26-30.

A slightly abridged version of the Bowker Memorial Lecture for 1974 given at the Lincoln Center, New York, on October 24. In the lecture, Ms. Ringer, Register of Copyrights, "stresses that the rights of authors must remain paramount in any changes in copyright law."

228. TOY, STEVE. U.S. pic-tv piracy inquiry: Grand Jury told industry is

bilked in excess of \$1 bil yearly by international ring. In *Daily Variety*, vol. 166, no. 5 (Dec. 12, 1974), p. 1, cols. 4-5; p. 14, col. 3.

An article on a "sweeping international investigation of film and tv piracy, centering in Los Angeles, [which] is under way, with a Federal Grand Jury studying the matter and one person already under arrest." The investigation, which is being conducted by the U.S. Attorney's office and the F.B.I., has thus far broken an international South Africa-United States piracy ring.

229. WAGNER, SUSAN. Prospects look good for copyright term extension. In *Publishers Weekly*, vol. 206, no. 24 (Dec. 9, 1974), p. 15.

An article on some of the testimony on November 26, 1974, of Ms. Barbara Ringer, Register of Copyrights, before the House copyright subcommittee at a hearing on S.3976, the Senate-passed bill to remove the expiration date for a limited copyright on sound recordings, to increase the criminal penalties for piracy and counterfeiting of sound recordings, to extend the duration of expiring copyrights, and to establish a National Commission on New Technological Uses of Copyrighted Works. The article also covered a meeting on November 16 behind closed doors at the Library of Congress of a non-official group of library and publisher representatives to begin discussions on the question of copyright and photocopying.

230. WAGNER, SUSAN. Ringer talks to Russians; sees copyright progress. In *Publishers Weekly*, vol. 206, no. 20 (Nov. 11, 1974), p. 14.

An article on a visit to the Soviet Union during the period October 3 to 13 by the Register of Copyrights at the invitation of Boris Pankin, head of the new Soviet copyright agency, VAAP. Ms. Ringer exchanged views with Soviet copyright and publishing officials on such questions as photocopying, foreign publication of Russian dissident authors and unauthorized publication in Russia of excerpts of American works.

231. WAGNER, SUSAN. Typeface copyright row divides authors, designers. In *Publishers Weekly*, vol. 206, no. 21 (Nov. 18, 1974), pp. 16-17. (The Week.)

An article about a hearing on a proposal to permit copyright registration of original typeface designs, held recently at the Copyright Office.

232. WAGNER, SUSAN. U.S. sues 21 publishers for conspiracy on overseas sales. In *Publishers Weekly*, vol. 206, no. 23 (Dec. 2, 1974), p. 16.

An article on a civil antitrust action brought by the Department of Justice on November 25, 1974, against 21 major American publishers. The complaint charges that the American publishers entered into a variety of restrictive agreements with British publishers pursuant to which copyright licenses are used to allocate exclusive marketing territories for English language books in violation of sec. 1 of the Sherman Antitrust Act.

2. England

233. BONHAM-CARTER, VICTOR. Copyright: an early campaign. In *The Author*, vol. 85, no. 3 (Autumn 1974), pp. 99-103.

A description of the background to the U.K. 1911 Copyright Act.

234. DEFREITAS, DENIS. Changing the copyright law. In *The Author*, vol. 85, no. 3 (Autumn, 1974), pp. 104-110.

A summary of the changes in the present U.K. copyright law proposed by the British Copyright Council.

235. ECCLESHARE, COLIN. Return to Moscow 1974. In *The Bookseller*, no. 3590 (Oct. 12, 1974), pp. 2250-2253.

An informal report on a second mission to Moscow by Messrs. John Boon, Ronald Barker and Colin Eccleshare, an official delegation of British publishers, under the terms of the Anglo-Soviet cultural treaty. Among the topics discussed was the question of the U.S.S.R.'s accession to the Universal Copyright Convention in connection with the facilitation of the traffic in rights, "which could now, for the first time, take place in a framework of international law."

236. FERGUSON, GEORGE. Copyright and open market; Australian Government calls for evidence. In *The Bookseller*, no. 3591 (Oct. 19, 1974), pp. 2334, 2336, 2338, 2340-2341; no. 3592 (Oct. 26, 1974), pp. 2402, 2404-2405.

A paper, by the director of the Australian Book Publishers' Association, on a conference in Sydney called by the Australian Attorney-General's department to discuss two questions: Does the

copyright barrier to book importation need reform? Should Australia be an open or closed market?

237. Frankfurt 1974, by a special correspondent. In *The Bookseller*, no. 3593 (Nov. 2, 1974), pp. 2488-2492.

An article on the 1974 Frankfurt Book Fair, during which there were meetings with respect to copyright issues including U.S.S.R. and copyright, photocopying, and royalties.

3. The Netherlands

238. MARKE, JULIUS J.

Copyright. In *IFLA Journal*, vol. 1, no. 1 (1975), pp. 47-53.

"Part of the paper in which Prof. Marke presents basic premises to be considered in identifying copyright problems currently affecting libraries and information centres and his draft recommendations." The original paper was drafted as a working document for a Working Group on Copyright, chaired by Prof. Marke, and established jointly by the International Association of Law Libraries (IALL) and the International Federation of Library Associations (IFLA).

NEWS BRIEFS

239. MICHIGAN PASSES ANTIPIRACY LAW.

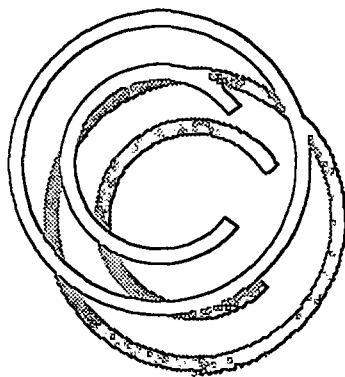
Michigan has become the twenty-seventh state to enact legislation prohibiting the manufacture, distribution and sale of pirated recordings. The law, effective September 1, 1975, makes violation a felony punishable by as much as \$100,000 and three years imprisonment.

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WILLIAM JOVANOVIH

PART I.

ARTICLES

240. WRITING AND READING FOR LOVE AND MONEY—*The Fifth Donald C. Brace Memorial Lecture on Copyright Law**

By WILLIAM JOVANOVIH**

Some years ago I recounted in a short essay a certain conversation with William Saroyan. As you may know from reading his stories, Saroyan is a man who can be amazed by the ordinary and, no less, feel familiar with the fantastic. On this occasion he was feeling familiar. He said, "I seem to have the notion that anything that anybody writes has got to be published—so that the writer will begin to feel better, I suppose." Now this remark is not unlike Andy Warhol's declaration that in the future everyone will be famous for fifteen minutes. And such remarks are desperate, being intimations of immortality. They have to do in an ultimate way with the curious business of writing and reading for love and money.

The notion that whatever is written should be readily published may become practicable in our time through a coincidence of changes in technology and the law. The technology we know already. Xerox and IBM are successively making the replication and duplication of written text so inexpensive that the passage from writing to publication becomes fast and easy. As for the law, in this instance the law of copyright, its putative effects on publishing, were it changed, are obscured by years and years of argument over legislation. One Congress after another debates the provisions of a new copyright law, returning again and again to the issue of how and why an act of publication (or of artistic performance) can ensure the ownership of unique and attributable expression. Meanwhile, publishers and librarians put on the masks of contention and step forth as plaintiffs and defendants, each not less than the other being devoted to the principle of protecting the public interest. As the years pass and as the litigants and petitioners fall weary, the issue itself becomes tedious and dim; and in the end, one supposes, some aged attorney may be stirred to recall that the fight over copyright was, like Blenheim, a famous victory.

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This lecture was delivered in the Auditorium of the Time-Life Building in New York City on January 15, 1975.

**William Jovanovich is Chairman of Harcourt Brace Jovanovich, Inc. He is also an editor and the author of numerous essays. His book, *NOW BARABBAS*, was published by Harper and Row in 1964.

But the issue is primal. Should the means and the acts of copying works be conducted without restriction, what will be the consequence? Then we will no longer consider writing to be an intellectual property that can be contracted and transacted. If we finally come to regard publishing as a kind of civil right, then anyone's expression will perforce belong to everybody—power to the people, whoever they say they are. The consequence is radical. It goes to the grounds of Western society for the obvious reason that writing as a profession and publishing as a private venture are the most durable forms of entrepreneurship we know. It is possible that this mode of free enterprise can be cut at its roots by legalists. If that should happen, then the act of writing for money, at least in those places where it is now usual, will have to proceed under different rules. If it should happen, then writing and reading for love—that is, those familiar literary practices whereby fame and popularity are sought and are given—will also proceed differently. This is not to say that a cultivated society is ended when writers must without choice become civil servants, and publishers become commissioners. Not at all. Rather, it is to say that under such a circumstance it is to be expected that culture is described, and hence perceived, in profoundly changed terms. In a sense, of course, all professional writers are employed. The question here is not one of whether writers can make choices, but whether readers can make them.

I confess to my prejudices as a publisher, and from them I perhaps grow antic. It may be that the present copyright issue is nugatory, the consequence *de minimis*. Yet there are ways to try the importance of the issue. One can inquire into the relation between private ownership and artistic creativity. One can also ask, quite plainly, if an artist's popularity or prestige can truly be won without counting the house, as they used to say in vaudeville. The truth is that in talking about writing and reading one gets to counting. We presume that there is always at least one reader for whatever is published, that being the publisher himself. That is not a safe presumption. In any event, it is not a consoling one, for it is certain that a writer wants lots of readers. In this simple desire is to be found an interesting conundrum. The public—all those readers—we tend to accept as an absolute concept: the public undeniably exists by reason of its numbers. Yet the public is not absolute if it is defined as an audience; in fact, the public at one time did not exist.

That time preceded the Renaissance. Writing and reading without the public's love or money, either one, is where we started in the modern Western world. Marshall McLuhan has demonstrated that in pre-Gutenberg times there was little discrimination in what sociologists call "work roles." He notes that in medieval times "... the scribe, the author, and the reader tended to merge." The author was anonymous and, in respect of his writing, unprivileged. The medieval writer could not have

comprehended the modern notion of identity even in simple mechanistic terms, let alone psychological ones. He oftentimes did not sign his own work, and he copied the work of others without attribution. In the modern view there is a connection between how we actualize our individual identities and how we formulate our social roles. What a man does is, at bottom, like himself. Whoever the medieval writer may have been, he was at once a writer, a reader, a librarian, and a publisher. Notwithstanding all that, he was not always gifted—there have been bad writers and bad publishers in every era—and it is accurate to call him versant, or practiced, rather than versatile.

The anonymity of the medieval author was largely ended by the advent of machine printing. Printing set the stage for the persona of the writer, and from the trade of printing there emerged a variety of literary identities. The characterization of writers as famous men was contingent on the invention of movable type and cheap printing. And the spread of printed works was the genesis of our present-day concept of the public. Indeed, it was not the public who made the authors recognizable; instead, it was the authors, once given access to machine-made books, who made the public known to itself. Of course I am here speaking of the public as audience, not as the Greek *polis*, the citizenry. Yet the distinction is not entirely exclusive. Both the public as a political body and the public as audience, which is to say, as witnesses to entertainment and to learning, are groups that are addressed, appealed to. In any event there is no audience, therefore in this particular sense no public, unless someone wins the attention of a group of people and by so doing defines their common interest.

Typography and printing have directly to do with our having developed, from the Renaissance, artistic performance and artistic reputation as a commodity—as something that can be compared and valued. Printing was the typical work of the Renaissance. It helped to secularize knowledge. It brought into being the first general marketing system under capitalism, which was the distribution of books. It made technology competent as art. Print was the first machined art. None of these tremendous effects, however, could have been comprehended by Gutenberg or Caxton because of the kinds of books they printed. The first books off the presses in the fifteenth century were not newly written; they were reprints of earlier works, mostly compilations. Only after presses were available in most cities, and only after books were commonly bought, did writers seek money and fame. As it turned out, they could not get much of the former without some of the latter. The literary game had begun and, as in classical cricket, some of the participants were gentlemen, like Sir Philip Sidney, and others were players, like Shakespeare. In the end they all became players.

Who was the emergent modern writer? Notably, he was a man interested in himself, a serious egoist. He was sometimes a reporter, otherwise an artificer of the ways of nature and man. He was in touch with his readers—either as a confidant like Montaigne, or as a publicist like Aretino. McLuhan thinks that the most characteristic of the earliest modern writers looking for love and money was the Venetian Aretino. J. B. Priestley speaks of him as “... a sinister figure ... presaging our own world of unscrupulous journalism and publicity—the incredibly popular Pietro Aretino.” He was less sinister than anxious, I think. He might be regarded as the Norman Mailer of the Renaissance, a man who held his passions to be instructive, a man who contended against all other writers living and dead and whose work was a eulogy to his life. For my purpose here it is more relevant to ask not what Aretino produced but what he wanted. Plainly, he wanted fame, the notice of the public. And who made up the public? They were the people whose immediate relation to each other was their having read the same authors, or at the least the same kinds of authors. One more turn of the wheel will show the coincidence of trade and art in the modern world. Books were probably the first objects of unlocalized mass consumption. This is to say that they were uniform and repeatable items that could be commonly bought at a distance from their place of manufacture. Their consumers were related to each other only through the customs of language and through their choices. Thus, the readers comprised a market and a public.

Yet I do not presume that such theorizing, whether or not it convinces, can explain the particular quality of communication in the modern age that exists between writers and readers. Mallarmé said that “the world exists to end in a book.” Of course he was right, for how else could we place ourselves? Unread, great events fall soundless like trees in the forest. It was intrinsic to the spirit of the Renaissance, when nations and peoples were cast loose from the old empires and the old religions, that at such a time of philosophical uncertainty there should arise writers who were confidants and confessors to their readers. The Renaissance was the beginning of the thing we now call *anomie*, of the *Welteinsamkeit*, the terrible loneliness of the sensible man. Montaigne knew of it, and described it in a familiar essay: “Besides this profit that I derive from writing about myself, I hope for this other advantage, that if my humors happen to please and suit some worthy man before I die, he will try to meet me. . . . Many things I would not want to tell anyone, I tell the public; and for my most secret knowledge and thoughts I send my most faithful friends to a bookseller’s shop. . . .”

It is a subtle thing, this nexus between writer and reader. There is no writer so proud that he scorns to learn that he has gained, or lost, another reader. Conventionally the writer says that he wants to enlighten the

reader, but in truth he wants first to enlist him. The reader gives to an author his attention, which in this age of distraction may be the noblest form of regard. (Frank Sinatra quite properly asks of everyone who speaks to him, "Is this going to take long?") There is also a certain price to popularity. Once the reader is won, he wants the author to produce the same book over and over; thus it is that some popular writers, out of a fidelity to their audience, can be trusted to repeat themselves season after season. You will perceive that the nexus between reader and writer is readily, and familiarly, described in numerical terms. The literary search for glory and gold, for love and money, was indicative not only of the Renaissance but also of its archetypical country, America. Captain John Smith discovered right off that the quickest way to make a buck on this wide continent is to write a bestseller. He arrived at Jamestown in 1607, found it to be a miserable hard place, and never made a cent there except for writing about it. His first book was published in the fall season of 1608. Or consider Ulysses S. Grant who, unlike Nixon, was not financially the victim of his own maladministration. Grant lost his money the honest American way—on Wall Street. To pay off the debts of his failed brokerage house, Grant wrote his memoirs and earned a fortune, even though his publisher lost money. His publisher was Mark Twain, who made the mistake of confusing his roles—no medieval scrivener he—and not seeing anything wrong with paying a royalty of forty per cent.

If the author and publisher live by words, they deal in numerals. On a recent occasion I told an author that his new novel was excellent. Later, his agent telephoned me to ask for a very high advance on royalties. "The word is out," he said, "that this is a big book." "Whose word?" I asked. "Yours," he replied. About five years ago, a mass market paperback publisher offered to me, and I accepted, more than a million dollars to reprint a single book, with the contractual restriction that neither of us would ever publicly reveal the price. "Otherwise," he warned, "the market will be ruined and every greedy author and agent will want more money." Three years later, another reprint publishing house announced that it had paid a million dollars for a book. My man returned and begged to be released from his bond so that he could now tell the public that he had earlier paid the record amount of a million dollars. "After all," he told me, "I ruined the market first."

From such tales no moral may be drawn except maybe the one that George Bernard Shaw told in respect of Count Leo Tolstoy's having put into the public domain the copyrights to his works as a gesture of his love for mankind. The sales of Tolstoy's books fell immediately, Shaw said, and it all went to prove that the public does not prize that for which it does not pay. That is a homely and disputable axiom. Still, it is reasonable to ask what, precisely, it is that gives tradable, measurable monetary value to

writing as well as to other artistic works. Writing as an artifact, as mere graphic communication, is so common that we tend to regard it as having no value. Unless it is reproduced, unless it is published in some form, the writing that we find in letters or diaries or even manuscripts is considered to be ephemeral or eccentric or, at best, documentary. Once it is published, however, two acts immediately serve to ascribe value to a work. There is, first, the fact of publishing itself, which entails an investment in the work independent of the author; second, there is copyright registration.

Copyright deposes that a work is singular in composition or performance and that it is singularly owned. Yet the absence of copyright does not mean that a work has no transactable value. Aretino and Montaigne and Milton received money from their writing without the protection of a general, statutory copyright. And today, in the People's Republic of China, where the proposition that a person can own a work of intellection or expression is thought to be incredible and ludicrous, there are writers who earn salaries. Yet there remains the significant relation between copyright and those durable forms of free enterprise, writing and publishing, as private risk-taking ventures. By a practical definition, copyright helps to confine the publication of a work to those parties who agree to be bound by contract, and it does this in large part by making illegal acts of piracy and unauthorized copying. Is it protectionist? It is. Is it, in some sense, monopolistic? It is. That it is so ought to be understood, I think, without unease. And it ought to be said aloud to laymen and lawyers alike, without tears. If copyright protection is a main means whereby we can incite an independent and uncensored expression in our society, it follows that state ownership of contemporary intellectual property is not in the public interest.

Again, this is not to say that writing for money cannot proceed under different rules. But to alter the rules may be to alter the writing. The risk in writing ought, I think, to be a material and measurable risk. Let the publisher take the risk that too few people will pay to read what is written. Let his risk be material rather than political, for it is less dangerous to us all. In the publishing of art, letters, and instruction, it is better that the individual fail than that the State succeed. There is, of course, the fallacy of simple syllogisms. We know, for example, that a totalitarian state can quite well enforce its own copyright laws and respect those of some other governments. We know that a democratic state can so alter its copyright provisions that it vitiates their first principle—it can happen here. But I find it more important to know, out of logic and experience and without either political or economic chauvinism, that an artist is at liberty to the fullest extent only as he is able to appeal to a public that is freely comprised. Readers and writers are best served, I think, when they choose

each other. A public that is freely comprised is the kind of public that will find—and support—the writer who confides his most secret self. In this act of confidence there is at once a simple and profound act of discovery. We make ourselves actual by telling and hearing our own stories. Indeed, there is no human story but for the telling.

241. WHY DON'T FINE ARTISTS USE STATUTORY COPYRIGHT? — *An Empirical and Legal Survey*

By TIMOTHY M. SHEEHAN*

Why Don't Fine Artists Use Statutory Copyright?

Visual artists seldom take advantage of the legal protection offered by the copyright statute. For the analytical purposes of this article, the term visual art is divided into two groups, applied art and fine art. Applied art, a term including commercial art, is defined¹ as "art that is employed in design or decoration of useful objects", while fine art is defined² as "art created primarily as an aesthetic expression to be contemplated or enjoyed for its own sake." A study of the Copyright Office Catalogue of Entries for the class³ that includes all visual artists shows that many applied artists (designers of greeting cards, scarves, wall paper . . .) have taken the necessary legal steps to secure a statutory copyright, while very few fine artists (painters, sculptors . . .) have taken these steps. The focus of this article is the fine artist and the reasons why most fine artists do not use statutory copyright.

Thomas L. Creel, in writing a chapter on statutory copyright in *The Visual Artist and the Law*,⁴ considered the problem and outlined the procedure for obtaining a statutory copyright for original works of art. Several other books⁵ directed to fine artists and a recent law review article⁶ have also urged artists to retain reproduction rights in their works by securing

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¹ R. MAYER, A DICTIONARY OF ART TERMS AND TECHNIQUES, Crowell, New York, 1969 at 17.

² *Ibid.*, at 145. The reader should keep in mind that the distinction between applied art and fine art is arbitrary at best.

³ U.S. Copyright Office, *Catalogue of Entries*, Part 7-11A, Works of Art, Vol. 24, 1970.

⁴ ASSOCIATED COUNCILS OF THE ARTS, ET AL., *THE VISUAL ARTIST AND THE LAW*, A.C.A., at 3-15, New York, 1971.

⁵ CAHN, J. B., *Copyright in Works of Art*, Artists Equity Association, New York, 1956; HODES, S., *THE LAW OF ART AND ANTIQUES*, Oceana, New York, 1966; WALLIS, H., *THE COPYRIGHT HANDBOOK FOR FINE AND APPLIED ARTS*, Watson-Guptill, New York, 1963.

statutory copyright. As improved reproduction techniques permit greater commercial application⁷ of original fine art, the possible financial benefits to artists who retain reproduction rights increases. The continuing non-use by fine artists of a statutory scheme intended for their benefit merits further inquiry.

An assumption made by most commentators is that the reason fine artists fail to use statutory copyright is that they are unaware of its benefits and the procedures involved in obtaining a copyright. A complementary assumption is that the way to alleviate the problem of non-use is to demonstrate to fine artists the virtues of statutory copyright and the ease with which it may be obtained. It would seem that once shown the ways of copyright fine artists might begin to preserve their legal rights.

An examination of these assumptions will be a major purpose of this article. Three other hypotheses will be set forth and considered: first, the possibility that fine artists believe the statutory requirement of a visible notice of copyright defaces or unduly commercializes their work; second, that fine art, a personal expression of the artist, is not intended at the time of creation to be a subject of commercial reproduction; third, that collectors are less willing to buy, and thus dealers are less willing to handle, a work which has a copyright notice attached.

The results of two empirical surveys will be used to test the validity of the four hypotheses. Fine artists' attitudes and knowledge of statutory copyright were measured by the compilation of questionnaires⁸ answered by 206 artists. Gallery directors' views were gauged by the combined response of 45 directors to a related questionnaire.⁹ Different techniques

⁶ Carroll, "Statutory Copyright—A Valuable Right for the Visual Artist", 7 GEORGIA L. REV. 134, (1972) [hereafter CARROLL].

⁷ One need only visit a department store or card shop to witness the proliferation of products inspired by original art, for example, Christmas cards, decorative plates, paperweights, posters and calendars.

⁸ See Appendix A-1 to A-3 for a copy of this questionnaire.

⁹ See Appendix A-4 to A-5 for a copy of this questionnaire.

¹⁰ The general practice was to introduce the subject and the purpose of the survey, leave a copy of the questionnaire and pick it up later in the day.

¹¹ Juried art fairs were chosen so as to eliminate most amateur artists from the sample. The three fairs surveyed were the New Mexico Arts and Crafts Fair, Albuquerque, New Mexico, June 29th through July 1st (The author is indebted to Robert L. Nelson, UNM Law '75 and Gerald Richardson, UNM Law '75, who conducted the survey in Albuquerque.); Ann Arbor Art Fair, Ann Arbor, Michigan, July 18th through 21st; Old Orchard Art Festival, Winnetka, Illinois, September 8th and 9th. (The author owes a special debt of gratitude to his wife Bonnie Ann for her invaluable assistance at the Ann Arbor and Winnetka fairs.)

were employed in the two surveys. The survey of artists was conducted in person¹⁰ at three juried art fairs¹¹ during the summer of 1973. The survey of gallery directors was conducted by mail¹² in August and September of 1973. The artists surveyed were selected¹³ on the basis of availability from the participants at the three art fairs. The gallery survey was a stratified sample¹⁴ of retail art galleries throughout the United States.

While empirical surveys are well suited to the sampling of individuals' experiences and attitudes, they have built-in limitations. Different respondents will interpret even the most carefully drafted questions differently. Certain of the questions, for example income or education, present a possibility for self-serving answers¹⁵. The validity of the survey results depends to a great extent on the character of the sample group.¹⁶ Given the inherent limitations of quantitative social research, care must be taken to avoid absolute conclusions being drawn from the data. However with a survey of this size, certain trends can be discerned that reveal present day thinking in the art world. These trends suggest additional reasons for fine artists' wholesale avoidance of statutory copyright.

If one of the major problems is in fact the fine artists' ignorance of the provisions of statutory copyright, the obvious solution is more education. If defacement is the problem, a statutory modification seems in order. If collector and dealer opinion is found to be a major impediment, more education is necessary. If the time immediately after completion of the work is the time when an artist must take steps to obtain statutory copyright and yet is the time he is least likely to be conscious of commercial

¹² Art galleries were selected from the Yellow Pages of telephone books of cities from all parts of the United States. The questionnaires were mailed along with a cover letter explaining the survey and with a stamped self-addressed envelope.

¹³ The main factor in selecting an artist to be surveyed was the availability of the artist. Those artists who were unavailable at the first contact were re-visited throughout the day. In this manner the majority of the artists at each fair were surveyed.

¹⁴ See: C. A. MOSER, *SURVEY METHODS IN SOCIAL INVESTIGATION*, Heinemann Educational Books Limited, London, 1971, at 85. The cities were weighted somewhat arbitrarily, according to the size and importance of their art market. This process yielded the following mix: 50% to New York City area, 5% to the Boston area, 5% to the Chicago area, 5% to the Los Angeles area, 5% to the San Francisco area and 30% to other cities, none of which had more than one gallery surveyed.

¹⁵ The anonymous nature of the survey was stressed in presenting the surveys to both the artists and the gallery directors in an attempt to mitigate this effect.

considerations, a judicial re-interpretation of the time of divestive publication¹⁷ might be desirable.

The argument for artists retaining future rights in their works is an equitable one: but for the artist's efforts, the work would not exist. It seems only fair that the artist retain some degree of control over the exploitation of that which he has created. The fine artists' continuing interest in a work is not solely economic. Preserving the integrity¹⁸ of a work is an equally important concern. Statutory copyright, pursuant to the Constitutional mandate¹⁹ to encourage the progress of arts and sciences, offers the fine artist at least a measure of such control. Yet these surveys show that an overwhelming majority of fine artists do not use statutory copyright. This article explores some of the causes and suggests some remedies for this continuing non-use.

Fine Artists' Knowledge of Statutory Copyright

Few of the fine artists surveyed use statutory copyright; fewer still think they know enough about it. Of the 206 artists questioned, 71.8% answered that they never placed a copyright notice on any of their works.

¹⁶ Surveying only art fair fine artists tends to limit the sample somewhat. A mail survey of fine artists was considered but the author was unable to obtain a reliable list of professional artists across the country. Although the make-up of the gallery director survey is probably more representative of all gallery directors than is the artist survey of all artists, the gallery survey was limited by its poor response ratio. Of the 100 surveys mailed out, 10 were returned blank due to improper addresses or because the gallery surveyed did not deal in living artists' work. Of the remaining 90, only 45 were completed and returned. The reader and the author are faced with the question of whether the unreturned surveys would have differed markedly from the ones that were returned. The author has decided to analyze the 45 returned surveys as a unit, but ever mindful that the results are a bit soft due to the response ratio. The author believes that the completed gallery director surveys at least stand for the opinions and experiences of 45 galleries, which is much more data than was available prior to the data gathering.

¹⁷ Divestive publication is that publication which causes an artist to lose a common law copyright. See Judge Frank's opinion in *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956).

¹⁸ Many fine artists are concerned about supervising the color faithfulness of a reproduction to the original. Artists also like to retain a voice in the appropriateness of the commercial adaptation of their work, for example, many artists would like to be able to deny their permission to a shower curtain manufacturer who wanted to use a work of art to grace his latest creation.

¹⁹ U.S. CONST. ART. I, §8, see also: "A Bill to promote the development within the United States and foreign countries of American arts and handicrafts", H.R. 16792, 92nd Congress, 2d Session, 1972 for a recent application of the national commitment to the promotion of the arts.

Eighty-three and one half percent felt that they did not have enough information concerning copyright protection to make an informed judgment as to its use. Of the 14.6% of the artists who felt that they had enough information about copyright, two-thirds had placed a copyright notice on their work sometime. The following table tends to establish that more fine artists would use the provisions of the copyright statute if they knew more about it.

Table ONE
RELATIONSHIP BETWEEN STATUTORY
COPYRIGHT KNOWLEDGE AND USE²⁰

Q—Do you feel that you have enough information concerning copyright protection to make an informed judgment as to its use?

ANSWERS: Yes(14.6%) No(83.5%)

Q—Do you personally place a copyright notice on any of the work you produce?

ANSWERS:

Never	33%(10)	81%(138)
Very Infrequently	33%(10)	10%(18)
Only on Major Works	13%(4)	3%(5)
Only on Commissioned Works	—	2%(4)
Usually	3%(1)	2%(4)
Always	17%(5)	3%(5)

²⁰ A comparison of the responses to questions 2.) and 13.) of the Artist Survey, *see* Appendix A-1 and A-2 for the questions in context.

If the goal of artists retaining some future control in their work is best attained by the use of statutory copyright and if the preceding statistics showing that the more knowledgeable artists are, or feel they are, the more likely they are to use it, then an examination of how fine artists learn of copyright is important. There are several possible opportunities for fine artists to learn of statutory copyright: formal education, professional experience, national artist organizations and attorneys. These will be discussed in the paragraphs that follow.

The typical description of a Bachelor of Fine Arts (BFA) or a Master of Fine Arts (MFA) degree is that it is a course of study designed to

Table TWO
EFFECT OF BFA OR MFA DEGREE ON CERTAIN RESPONSES

	BFA(60)	MFA(46)	Entire Sample (206)
Questions from Artist Survey:			
1.) Thinks visual artists need copyright protection			
Yes	88.3%(53)	89.1%(41)	88.9%(183)
No	11.7%(7)	10.9%(5)	6.8%(14)
(No Response) N.R. .	—	—	4.3%(9)
2.) Uses a copyright notice			
Never	71.7%(43)	71.7%(33)	71.8%(148)
Very Infrequently	18.3%(11)	8.7%(4)	13.6%(28)
Only on Major Works .	1.7%(1)	4.4%(2)	4.4%(9)
Only on Commissioned Works	1.7%(1)	2.2%(1)	1.9%(4)
Usually	1.7%(1)	2.2%(1)	2.4%(5)
Always	5.0%(3)	10.9%(5)	4.8%(10)
13.) Has enough knowledge concerning copyright .			
Yes	11.7%(7)	10.9%(5)	14.6%(30)
No	85.0%(51)	84.9%(39)	83.5%(172)
N.R.	3.3%(2)	4.3%(2)	1.9%(4)

prepare the student for a career as a professional artist.²¹ This preparation includes instruction in technical skills and art history. Ideally, the instruction should also include some reference to those provisions of the copyright statute intended to benefit fine artists. Apparently this is not presently the case, since most university art departments offer no courses covering statutory copyright.²²

That most university art departments fail to teach about statutory copyright is demonstrated by the results of the artist survey. Of the 206 artists surveyed, 29.1%(60) had a BFA and 22.3%(46) had a MFA. The following table represents the responses of those artists having a BFA or a MFA to questions concerning the need for, and the knowledge and use of copyright.

Table THREE
RESPONSES OF TEACHERS OF COLLEGE AGE STUDENTS TO SELECTED
QUESTIONS

Questions from Artist Survey:	Teachers (72)	Entire Sample (206)
2.) Uses a copyright notice		
Never	69.4%(50)	71.8%(148)
Very Infrequently	13.9%(10)	13.6%(28)
Only on Major Works . . .	4.2%(3)	4.4%(9)
Only on Commissioned Works	5.6%(4)	1.9%(4)
Usually	4.2%(3)	2.4%(5)
Always	2.8%(2)	4.8%(10)
13.) Has enough knowledge concerning copyright		
Yes	11.1%(8)	14.6%(30)
No	87.5%(63)	83.5%(172)
N.R.	1.4%(1)	1.9%(4)

²¹ For example, Michigan State University: "Students who anticipate careers in the fine arts field"; University of North Carolina. "For those considering professional careers"; University of Wisconsin: "The program is planned for the prospective professional artist".

²² The author was unable to find any such course as being offered by a university art department. Several dozen university catalogs were consulted. The possibility that the subject is covered in other courses remains.

It is significant that the responses of those with degrees in fine art do not differ greatly from the sample as a whole. Holders of fine art degrees are just as unaware of the provisions and intended benefits of statutory copyright as those artists who were not educated in university art departments. The remedy is obvious. Art departments should add courses to their curricula that cover statutory copyright. Instruction should be offered to teach fine art students how to retain some control over their work.

Table FOUR
EXPERIENCED ARTISTS RESPONSES TO CERTAIN QUESTIONS

Questions from Artist Survey:	More than 50 Juried Exhibitions (39)	More than 10 One Person Shows (41)	Entire Sample (206)
2.) Uses a copyright notice			
Never	64.1%(25)	56.1%(23)	71.8%(148)
Very Infrequently	17.9%(7)	14.6%(6)	13.6%(28)
Only on Major Works . .	2.6%(1)	12.2%(5)	4.4%(9)
Only on Commissioned Works	2.6%(1)	4.9%(2)	1.9%(4)
Usually	5.1%(2)	4.9%(2)	2.4%(5)
Always	7.7%(3)	7.3%(3)	4.8%(10)
10.) Relies on sale of art as main source of income	66.7%(26)	58.6%(24)	37.9%(78)
13.) Has enough knowledge concerning copyright			
Yes	15.4%(6)	19.5%(8)	14.6%(30)
No	84.6%(33)	75.6%(31)	83.5%(172)
N.R.	—	4.9%(2)	1.9%(4)
17.) Had some art work reproduced	76.9%(30)	78.1%(32)	55.3%(114)
21.) Has personally felt the need for copyright protection	46.2%(18)	34.2%(14)	28.6%(59)

But beyond merely stating that new courses are necessary, there is the additional problem of training sufficiently qualified teachers. Since 88% of the teachers of college age students felt that they did not know enough about copyright, it cannot reasonably be expected that their students will learn about the provisions and benefits of the copyright statute.

Many fine artists learn of copyright through contacts with other artists or by repeated dealings with the public. In order to measure the degree to which their professional experience of fine artists affects their knowledge of statutory copyright, the responses of those who had participated in more than fifty juried²³ art exhibitions were analyzed separately. The responses of those artists who had more than ten one person shows were also studied separately. Table Four shows the more experienced fine artists' responses to selected questions.

These data suggest that more experienced artists are more likely to use copyright than the neophyte. This might be because they have more of their work reproduced, and more of them rely on the sale of their art as a main source of income. As compared to the whole sample, the more experienced fine artists more often felt a personal need for copyright protection. And yet the overwhelming majority of these more experienced artists stated that they did not have enough information concerning copyright protection to make an informed judgment about its use. Further, 31 of the 56(55.4%) artists who used a copyright notice at times felt that they did not have enough information on copyright. Clearly more opportunities should be offered fine artists so that they may learn of the procedures and benefits of statutory copyright.

Many fine artists, notably the more successful ones, sell their art primarily through a retail art gallery. Artists often look to art gallery directors for information concerning legal rights. Eighty-two percent(37) of the art gallery directors responding to the survey stated that they advised their artists on business and legal matters. Significantly, of the 82% who did advise artists, 78.4%(29 of the 37) did not feel that they had enough information concerning copyright. Since 1966 New York State has had a statute²⁴ enacted specifically to make it easier for fine artists to retain reproduction rights. Of the 19 New York galleries replying to the gallery director survey, only one was familiar with the law.²⁵ These figures suggest that contact with most gallery directors does not provide a realistic opportunity for fine artists to learn of statutory copyright.

²³ Juried art fairs qualified as juried art exhibitions.

²⁴ N.Y. GEN. BUS. L., Art 12-E. *See infra*, note 36.

²⁵ A question specifically inquiring about the law was not included on the survey; the answer came to question 12.) of the gallery survey. *See* Appendix A-5 for the complete question.

For many fine artists the art gallery director might be the only source of information. Eighty percent(36) of the replying art gallery directors stated that they represented some artists on an exclusive basis.²⁶ Those directors felt somewhat more confident about their knowledge of artists' rights. Still 72.2%(26 of the 36) admitted insufficient knowledge of copyright on which to base an informed judgment. The gallery directors were also asked whether they felt that the fine artists they represented had enough information about copyright to make a judgment for themselves. Seventy-five and one half percent(34) of the directors felt that the artists they deal with lacked such knowledge. These 34 directors represented a total of 260 artists on an exclusive basis. Trade associations such as the Art Dealers Association could provide their members with a needed service by initiating a program of copyright education for art gallery employees and owners.

Table FIVE
SELECTED RESPONSES OF THE MORE
FINANCIALLY SUCCESSFUL ARTISTS

Questions from Artist Survey:	Paintings Sell for More than \$500 (30)	More than \$10,000 in Yearly Art Income (19)	Entire Sample (206)
2.) Uses a copyright notice			
Never	43.3%(13)	57.8%(11)	71.8%(148)
Very Infrequently	26.7%(8)	10.5%(2)	13.6%(28)
Only on Major Works . .	3.3%(1)	10.5%(2)	4.4%(9)
Only on Commissioned Works	6.7%(2)	—	1.9%(4)
Usually	6.7%(2)	10.5%(2)	2.4%(5)
Always	13.3%(4)	10.5%(2)	4.8%(10)
13.) Has enough knowledge concerning copyright			
Yes	23.3%(7)	10.5%(2)	14.6%(30)
No	76.7%(23)	89.5%(17)	83.5%(172)
N.R.	—	—	1.9%(4)
17.) Has had some art work reproduced	70.0%(21)	73.7%(14)	55.3%(114)

As artists' fame and following increases, the price of their work and the amount of their income generally rise as well. The possibility that an artist will experience copyright problems appears to increase with renown. As an artist's economic position improves, it is likely that the artist will seek legal advice concerning reproduction rights. While a question about lawyers was not included in the artist survey, several artists indicated that they had sought legal advice concerning copyright. In order to see what patterns there might be, responses of the financially more successful artists were sifted out for separate study.

While the data are not conclusive, it does not seem to establish that the financially successful fine artist is more likely to take advantage of the benefits of copyright. This may be due to greater experience with commercial reproduction of their work—some seventy percent of this group answered that at least one of their works had been reproduced. But even this group complained of a general lack of information about copyright, although their average was somewhat better than the sample as a whole. Those 68.8% (31 of the 45) art gallery directors who sold paintings priced at more than \$2000 demonstrated a knowledgeableness about copyright similar to that of the financially successful artists. Only 25.8% (8 of 31) of the directors of galleries selling higher priced works felt that they had sufficient knowledge of copyright. While relative financial success would allow artists and gallery directors to seek legal advice from an attorney, it appears that most have not. And with the rising price of legal services this may not be a practical solution.²⁷

Perhaps the best opportunity for many fine artists to learn about statutory copyright is that which could be provided by the national artist organizations and the periodicals directed to fine artists. Artists Equity Association has developed a campaign to educate fine artists about the benefits of statutory copyright.²⁸ Artists Equity Association, unfortunately, seems to be the exception rather than the rule. Most artists' groups have made no such attempts. The responses of those 47 artists who belong to a national artist group do not differ much from the sample as a whole. More do use a copyright notice; 31.9% (15 of 47) stated that they used a copyright notice sometimes. Ironically, the artists who belong to such national organizations felt less sure about their knowledge of copyright

²⁶ A typical clause in a gallery contract serves as a good definition of exclusive representation, "During the term hereof, you agree that you shall not contract with, or make any arrangements whatsoever for any other sales representation . . ."

²⁷ Several of our bigger cities have organizations that offer free legal advice to artists. Volunteer Lawyers for the Arts in New York City is but one example.

²⁸ A copy of J.B. Cahn's COPYRIGHT IN WORKS OF ART has been distributed to Artists Equity members.

than the sample as a whole. Eight-seven percent (41 of 47) felt they had too little information as compared with the 83.5% figure for the entire sample.

The survey suggests that most fine artists belong to some artists' organization, whether local, regional or national.²⁹ These organizations present a good opportunity to remedy the problem of ignorance of statutory copyright among those artists who have completed their formal education. Another good method of educating this group of artists is by means of those art journals, widely read in the artist community, which have become interested in the general area of "artists' rights". Subjects like 'droit de suite'³⁰, artists' royalties³¹ and contract rights³² seem to have attracted the most attention, but a few articles have touched on the general area of statutory copyright.³³

In a field that so very much needs reliable information about copyright, the literature directed to fine artists has some notable sources of possible mis-information. Some confusion exists about the significance of an unrestricted sale. Kenneth Harris states that "... when a painting is sold, the reproduction right remains the property of the artist unless specifically conveyed to the purchaser in the bill of sale".³⁴ The opposite presumption may well be true. *Pushman v. New York Graphic Society*³⁵ held that the artists' common law copyright passed to the buyer in an unrestricted sale of an uncopyrighted work of art. New York State in 1966 attempted to overrule *Pushman* by legislating a presumption favoring the artist³⁶, but of course this statute applies only in New York. The editors of

²⁹ 134 artists (65% of the 206) answered that they belonged to at least one artists' group.

³⁰ 'Droit de suite' or follow-up rights allow the artist to participate in the financial appreciation of a work of art. France has had such a law since 1920; since 1957 the artist has a right to 3% of the total sales price on all future sales. See note 71, *infra*. See also: M.E. and A.B. Price, *Rights of Artists: The Case of the Droit de Suite*, 31 ART JOURNAL no. 2, p. 144-9, Winter 71-72, and M.E. Price, *Government Policy and Economic Security for Artists: The Case of Droit de Suite*, 77 YALE L. J. 1333 (1968).

³¹ Baldwin, *Art & Money: The Artist's Royalty Problem*, ART IN AMERICA, March-April 1974, 20-22.

³² Sieglub, *Artists Reserved Rights and Sales Agreement*, 181 STUDIO 142-144, April 1971; Weiner, *The Artist and His Gallery: Legal Agreements that Work*, AMERICAN ARTIST, 22-27, January 1974.

³³ Rie, *Legal Rights of Artists*, THE ART JOURNAL, 46-7, Fall 1970.

³⁴ K. Harris, HOW TO MAKE A LIVING AS A PAINTER, at 126, Watson-Guptill, New York, 1966 [hereafter HARRIS].

³⁵ 287 N.Y. 302, 39 N.E.2d 249 (1942). See *infra* notes 85, 86 and 87.

³⁶ N. Y. GEN. BUS. L., Art. 12-E, see *supra* n. 24.

a recent Practising Law Institute handbook³⁷ on the subject of the fine arts and the law stated that the *Pushman* holding was representative of the law in those jurisdictions without a statute like that in New York.

Harris goes on to state that to be safe an artist should place the following notice on the back of every painting: "Reproduction Rights Reserved. This Painting may not be reproduced in any form without the written permission of the artist."³⁸ Another author recommends that fine artists should "... insist on labeling the back of every painting 'All reproduction rights reserved' ".³⁹ While such notices no doubt would have substantial *in terrorem* effect, it is unclear what their legal impact would be. If such notices are meant to be a clause in the sales agreement, it is advisable that they be included in the bill of sale. If such notices are meant to trigger the protections of the copyright statute, they might be found to be unacceptable deviations from the prescribed notice form.⁴⁰ The possibility that these authors might confuse fine artist readers concerning reproduction rights is heightened by the fact that nowhere in either book is the availability of statutory copyright protection mentioned. *The Visual Artist and the Law*⁴¹ stands out as the most authoritative legal guide for fine artists. In addition to information about copyright, the book covers the entire spectrum of fine artists' potential legal problems.

In conducting the surveys I found many artists and gallery directors who expressed a strong desire to learn about the procedures for obtaining a statutory copyright. Many questions were asked concerning the legal effect of certain notice forms. The problem is not one of indifference, but of a lack of reliable sources of information.

The potential sources of reliable information are three: university art departments, art associations and art journals. Considering their academic and financial resources, university art departments are probably best equipped to provide this needed service to artists. The various universities' art departments should begin to offer courses to fine art students interested in their legal rights. University art departments should also initiate programs in continuing education for those artists who have completed their formal education. This task of presenting the benefits and provisions of statutory copyright to artists out of school should be a joint effort of university art departments, art associations and

³⁷ Feldman and Weil, editors, *Legal and Business Problems of Artists, Art Galleries and Museums*, Practising Law Institute, 333, New York, 1973.

³⁸ HARRIS at 126.

³⁹ B. CHAMBERLAIN, *THE ARTISTS' GUIDE TO HIS MARKET*, 63, Watson-Guptill, New York, 1970.

⁴⁰ See *Compendium of Copyright Office Practices*, U.S. Government Printing Office, Washington, D.C., 1970 at part 4.2.2 [hereafter COMPENDIUM].

⁴¹ See *supra* note 4.

art journals. A major reason why more fine artists do not use statutory copyright is that they do not know enough about it. These three sources could greatly reduce the problem of non-use of statutory copyright by providing fine artists with the information they need.

Do Fine Artists Feel That a Copyright Notice Defaces a Work of Art?

The surveys show that there are additional reasons for fine artists not using statutory copyright so that even if every fine artist knew of the procedures and benefits of statutory copyright, there would continue to be substantial non-use. The first of these considerations is that the notice requirement might be thought to deface a work of art.

Thomas L. Creel recommends that fine artists place the copyright notice "in the most conspicuous place possible to give the public adequate notice that a copyright is claimed."⁴² The same author goes on to suggest that for paintings and drawings a notation in the lower right-hand corner would be proper. A recent law review commentator states that "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"⁴³. This commentator proceeds to recommend this form of notice placement. But it is doubtful that many artists or gallery directors would welcome the frontal notice form.

Daniel-Henry Kahnweiler was Picasso's lifelong dealer and one of the major gallery owners of the century. He opened his first gallery in 1907, and was the first to sell the work of Braque, Derain, Picasso and Vlaminck. Kahnweiler chronicles his memories of his early years as an art dealer in a published interview⁴⁴ with the French journalist Francis Cremieux. The following question and answer reveal a strong feeling about the integrity of the face of the canvas.

"Q: You mention Ceret. Wasn't it at Ceret that, in the course of a rather long period of cohabitation, Braque and Picasso painted side by side and decided to stop signing their canvases? What's the truth about this?

A: On this point there is absolute confusion.⁴⁵ They never painted

⁴² *The Visual Artist and the Law*, at 9. See n. 4, *supra*.

⁴³ CARROLL at 149.

⁴⁴ D. KAHNWEILER AND F. CREMIEUX, *MY GALLERIES AND PAINTERS*, The Viking Press, New York, 1971 [hereafter KAHNWEILER].

⁴⁵ L. WERTENBAKER, *THE WORLD OF PICASSO*, Time-Life Books, New York, 1967 adds to this rumor in the following passage: "By 1911, Picasso and Braque had worked so closely together that their pictures, two of which are shown on these pages, are almost impossible to tell apart . . . the two men also periodically stopped signing their names on the fronts of their canvases during this period, as evidence of their complete and selfless dedication to a common goal" (at 92-93).

side by side, and they never wanted their canvases to be confused; the proof of this is that they are always signed. However, they are signed in back instead of in front, because all the painters with whom I collaborated felt that a signature on the canvas could, in fact, necessarily must, disturb the construction, the architecture of the painting, which they wanted to be so strong and solid that even a signature would disturb it."⁴⁶

Table SIX
RESPONSES TO DEFACEMENT QUESTION BY CATEGORIES

CATEGORIES OF ARTISTS	Thinks Notice Defaces Work		
	Yes	No	No Response
Sample as a whole (206) . . .	25.2%(52)	53.9%(111)	20.9%(43)
Holders of BFA Degrees (60)	25.0%(15)	61.7%(37)	13.3%(8)
Holders of MFA Degrees (46)	23.9%(11)	50.0%(23)	26.1%(12)
More than 10 one-person shows	26.8%(11)	58.5%(24)	14.6%(6)
More than 50 juried exhibits	23.1%(9)	61.5%(24)	15.4%(6)
Sculptors (9)	55.6%(5)	44.4%(4)	—
Craftsmen (24)	20.8%(5)	45.8%(11)	33.3%(8)
Painters, Printers Photographers and Drawers (173)	24.3%(42)	55.5%(96)	20.2%(35)
Teachers of College Age Students (72)	30.6%(22)	52.8%(38)	16.7%(12)
Paintings more than \$500 (30)	23.3%(7)	56.7%(17)	20.0%(6)
Members of National Art Organizations (47)	21.3%(10)	63.9%(30)	14.9%(7)

⁴⁶ KAHNWEILER at 45-46.

This feeling of the inviolability of the front of the canvas is held by many artists and dealers. Several of the artists interviewed stated that they signed their paintings only on the back of the canvas. Among those artists who feel that a signature "disturbs the statement" there is little hope that such artists would place the symbol[®] on the face of a work. Many artists however, do sign their paintings on the face of the work. This group of fine artists would seem to be more receptive to the suggestion that they integrate the symbol[®] with their signature.

Nonetheless 25.2%(52) of the fine artists surveyed felt that a copyright notice defaces a work of art. This question produced a very high rate of no responses (20.9% or 43), so that only a slight majority (53.9% or 111) of the fine artists felt that a copyright notice did not deface a work of art. The art gallery directors' response to a similar question⁴⁷ produced quite different results. 57.7%(26), more than twice the rate of the artists, of the gallery directors felt that a copyright notice did deface a work of art. Table Six breaks down the artists' answers to the defacement question by categories.

Except for the sculptors, 55.6% of whom thought a copyright notice would deface their work, the breakdown of the data shows a fairly consistent 20-30 percent span of responses supporting the defacement hypothesis. These artists' reasons for not using a copyright notice include that "the implication is commercial; fine art is one of a kind", that it "seems to have an awfully commercial slick connotation", that "it's somewhat pretentious", and that "people tend to think the work is a print or something commercial".⁴⁸ Art gallery directors also refer to the "commercial implication of copyright" and that "the [®] symbol would debase an excellent artist"⁴⁹.

Without solicitation dozens of the artists and art gallery directors surveyed offered one obvious solution to the defacement problem: put the notice on the back. If this were to be done, would it constitute sufficient notice?⁵⁰ The Copyright Act⁵¹ deals with the matter of notice in

⁴⁷ "Do you personally feel that a copyright notice defaces a work of art?" was question 15.) in the Art Gallery Director Survey.

⁴⁸ Derived from comments to question 11) of the Artist Survey: "If you DO NOT use the copyright notice on your works of art, is it due to any particular reason?"

⁴⁹ Derived from comments to question 12.) of the Gallery Survey: "If you very infrequently or never reserve future rights for a living artist, please explain why not."

⁵⁰ A general discussion of the sufficiency of notice can be found in NIMMER ON COPYRIGHT § 87.6.

⁵¹ U.S.C. §§ 1 *et seq.*

§§ 10, 19 and 20. § 10 provides that a "notice shall be affixed". § 19 prescribes that the general form of notice "shall consist either of the word 'Copyright', the abbreviation 'Copr.', or the symbol © accompanied by the name of the copyright proprietor." In the case of a work of art, § 19 authorizes a short form notice consisting of the symbol "©, accompanied by the initials, monogram, mark, or symbol of the copyright proprietor: Provided, that on some accessible portion of such copies or of the margin, back, permanent base, or pedestal, or of the substance on which such copies shall be mounted, his name shall appear." § 20 prescribes the particular placement requirements for notice in the case of books, periodicals, and musical compositions. § 20 sets up no particular requirements for the placement of notice in the case of works of art.

It can be argued that for works of art § 19 prescribes the form of notice and § 10 prescribes the placement of notice, that is to say that proper notice could be the symbol © and the artists's name "affixed" on the back of the work of art. A contrary argument can be made to the effect that in order to read vitality into the § 19 authorization of short form notice, the statute should be construed as requiring some form of notice on the face of a work of art.

This very question of what constitutes proper notice in the case of a work of art was the subject of *Coventry Ware, Inc. v. Reliance Picture Frame Co.*⁵² The case was one of an admitted copyist of the plaintiff's three-dimensional wall plaques. The defendant copyist attacked the sufficiency of the plaintiff's copyright notice, the defendant's position being that the notice of copyright must appear on the front of a work of art and that a notice appearing on the back was insufficient. A federal district court accepted this argument and granted a summary judgment for defendant.⁵³ Plaintiff appealed and the Second Circuit reversed.⁵⁴ Circuit Judge Clark, tracing the legislative history of the Copyright Acts, noted that "§20 is the culmination of a long history of increasing liberalization of restrictions on the placement of notice."⁵⁵ Clark referred to the harshly restrictive requirement of the Acts of 1802⁵⁶ and 1831⁵⁷ which prescribed notice to be "on the face" of non-book and non-literary items. This specific requirement of frontal notice was gradually eroded and the Act of 1874⁵⁸ has no reference to face or front. The present act⁵⁹ as passed

⁵² 186 F. Supp. 798 (S.D.N.Y. 1960), 288 F.2d 193 (2d Cir. 1961).

⁵³ Id.

⁵⁴ 288 F.2d 193 (2d Cir. 1961).

⁵⁵ Id. at 194.

⁵⁶ 2 Stat. 171.

⁵⁷ 4 Stat. 436,437.

⁵⁸ 18 Stat. 78,79.

⁵⁹ 35 Stat. 1075, 1079.

retained specific placement requirements only for books or other printed publications, musical compositions, and periodicals. All other items are subject only to the general requirement of § 10, that the notice should be affixed to each copy. Clark concludes his recital of the progression of the copyright notice requirement for works of art by stating that “§ 19 should not be read to impose a restriction on placement, which, had it been intended by Congress, would certainly have been expressly stated.”⁶⁰

The reasoning employed in the *Coventry* appeal is supported by a Second Circuit case of the year previous. In *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*⁶¹ Judge Hand found that a copyright notice in the selvage of printed cloth was sufficient even though the notice was cut off or permanently concealed. Hand put the burden on the defendant infringer who was attacking the sufficiency of the notice “to show that notice could have been embodied in the design without impairing its market value.”⁶²

Clark’s reading of the ambiguity presented by § 19 is supported by other decisions. In *Prestige Floral v. Artificial Flower Co.*⁶³ a notice on the underside of a leaf was found to be sufficient notice to give copyright protection to a molded polyethylene flower in the form of a lilac. A notice of copyright on a simulated antique telephone was found to satisfy the statute although “some scrutiny is required to locate it and it is in small type.”⁶⁴

But there is a limit to how inaccessible a proper notice can be. A notice which is permanently covered is inadequate.⁶⁵ A notice of copyright on the back of a statue twenty-two feet above the ground which could not be seen by one standing on the ground was also held to be inadequate.

The Compendium of Copyright Office Practices exhibits a similar attempt at drawing the line between adequate and inadequate notice for works of art. The Copyright Office will not accept a concealed notice, the stated example being, “A notice which the Office is told is on the margin or back of a painting but which is concealed under a permanent frame or mat.”⁶⁷ However, the *Compendium* states that for a work of art “a notice on any accessible portion is acceptable . . . a notice on either the front or the back of the work may be accepted.”⁶⁸ One final caveat is offered by *Ross*

⁶⁰ 288 F.2d 193 at 195.

⁶¹ 247 F.2d 487 (2d Cir. 1960).

⁶² *Id.* at 488.

⁶³ 201 F. Supp. 287 (S.D.N.Y. 1962).

⁶⁴ *Ted Arnold Ltd. v. Silvercraft, Inc.*, 259 F. Supp. 733 at 734 (S.D.N.Y.).

⁶⁵ *White v. Cornell*, 353 F. Supp. 1170 (E.D.N.Y. 1972).

⁶⁶ *Scherr v. Universal Match Corp.* 297 F. Supp. 107.

⁶⁷ *COMPENDIUM*, Part 4.4.2, III a(1).

⁶⁸ *Ibid.*, Part 4.3.6, I.

*Products Inc. v. New York Merchandise Co.*⁶⁹ which registered real doubt as to the sufficiency of a notice of copyright on a hanging tag, which could easily be removed.

By bringing together the language of the statute, the cases and the Copyright Office practices, some general suggestions can be made for the fine artist who wants to retain future rights in a work but who is offended by frontal notice. For oil or acrylic paintings, the placement of the copyright notice on the back of the canvas or board will almost certainly constitute sufficient notice provided that the artist is careful to see that the notice is not permanently covered.

Drawings, photographs, prints and watercolors present further problems, since the back of these works of art are generally covered in the framing process. Notice on the back of the work would be permanently covered and hence inadequate; notice on the back of the frame could become separated if the work were reframed and a subsequent purchaser would have no notice of the copyright. A reasonable solution to this quandary would be to use two notices, one permanently affixed to the back of the frame and one on the reverse side of the work. This would give notice to all but a purchaser of a reframed work, who decided to reproduce the work while it was still framed. In the case of sculpture or pottery, a copyright notice on the underside of the work would probably satisfy the statutory requirements, at least for smaller works which could easily be picked up and examined. For large works of sculpture, the artist must make sure that the copyright notice is accessible to the viewer.

But some would dispute the necessity of any notice requirement, arguing that an artist's signature alone ought to be enough to secure continuing rights in a work of art. Such is the law in Canada where the statutory scheme provides for automatic copyright: It is not necessary for an artist in Canada to take any formal steps to secure future rights in a work, it "is a proprietary right which arises from authorship alone".⁷⁰ France has a similar provision in its copyright law where a copyright in a work of art inheres to the artist "by the mere fact of its creation."⁷¹ But such is not the law in the United States. The traditional U. S. view of the notice requirement is well stated by the following statement of Judge Friendly: "The notice requirement serves an important public purpose; the copyright proprietor is protected so long and only so long as he gives

⁶⁹ 233 F. Supp. 260.

⁷⁰ H. G. Fox, *THE CANADIAN LAW OF COPYRIGHT AND INDUSTRIAL DESIGN*, at 6. Carswell Co. Ltd, Toronto, Canada, 1967.

⁷¹ France: Copyright Statute, Law No. 57-296, Art 1.

effective warning to trespassers that they are entering on forbidden ground.”⁷²

The data reveal that many fine artists find the current notice requirements objectionable. The inherent strengths of the notice requirement argue for its retention in some form. On the other hand fine artists should not have to choose between defacing their works of art or losing copyright protection.⁷³ The language of the 1971 Copyright Revision Bill seems to offer a reasonable solution to this dilemma. § 401(c) prescribes that “The notice shall be affixed to the copies in such a manner and location as to give reasonable notice of the claim of copyright.”⁷⁴ § 401(c) seems to be a natural extension of the long history of increasing liberalization of restrictions on the placement of copyright notice for works of art.⁷⁵ By adopting this “reasonable notice” requirement, Congress would make it easier for many fine artists to avail themselves of the benefits of statutory copyright.

Does Judicial Interpretation of the Concept of Publication Deny Copyright Protection to Fine Artists?

Fine artists’ seeming indifference to statutory copyright may very well stem from the effect of certain formalities of the Copyright Act. As was just discussed, proper notice is necessary in order to bring a work of art within the protections of the statute. A very harsh sanction results from a finding that publication has taken place without notice or with improper notice: the work passes into the public domain. One of the crucial factors in fine art copyright analysis is the timing of publication. For if an artist acts too late in attempting to secure future rights in a work, the result will be a total loss of his common law copyright and an inability to obtain a statutory copyright.

A great deal has been written about what constitutes publication for a copyrightable work. One of the most useful dissertations on the subject is by Judge Jerome Frank in *American Visuals Corp. v. Holland*⁷⁶. Frank begins with the statement that “the word publication does not have the same legal meaning in all contexts”,⁷⁷ contrasting publication in

⁷² Friendly in dissent to *Peter Pan Fabrics v. Martin Weiner Corp.*, 247 F.2d 487 (2d Cir. 1960).

⁷³ See Friendly’s dissent to *Scherr v. Universal Match Corp.*, 417 F.2d 497 (2d Cir. 1969).

⁷⁴ Senate Bill 644, 92nd Congress, 1st Session (1971).

⁷⁵ Completing the historical progression which Judge Clark traced in *Coventry Ware, Inc. v. Reliance Picture Frame Co.*, 288 F.2d 193 (2d Cir. 1961).

⁷⁶ 239 F.2d 740 (2d Cir. 1956).

⁷⁷ *Ibid.*, at 742.

copyright, torts and privacy. He draws a distinction between the publication necessary to divest an author of his common law copyright and the publication necessary to invest the author with statutory copyright protection. Frank concludes that a publication must be "quite large" in order for an author to lose his common law copyright, yet a publication can be "quite narrow" and still bring an author within the copyright statute.

Whether one prefers the term "general publication", "divestive publication" or one of Frank's suggestions, it is important to determine under what conditions a fine artist will lose common law copyright. At the outset it is necessary to draw a distinction between a loss of common law copyright by abandonment or dedication to the public and a loss of common law copyright by expressed or implied transfer to the purchaser of the work. Dedication to the public means that no one is able to obtain a statutory copyright in the work, while transfer of the common law copyright allows the transferee to secure a statutory copyright. The subject of loss of common law copyright by dedication to the public, i.e., general or divestive publication, will be first discussed.

The two points most relied on in determining whether a work of art has been divestively published are the time of exhibition and the time of sale. Mere exhibition of a work of art has been found to be a divestive publication.⁷⁸ A more recent analysis of the effect of exhibiting a work of art is provided by Randolph Jonakait in "Do Art Exhibitions Destroy Common Law Copyright in Works of Art?"⁷⁹ Jonakait traces the meager and somewhat conflicting precedents and advises fine artists not to show unless there are express restraints against copying at the place of exhibition. What the form of prohibition ought to be, and where the notice must be placed, were unresolved questions.

A 1970 case⁸⁰, involving Pablo Picasso's monumental Chicago sculpture, provides further insight into what constitutes divestive publication of a work of art. As part of a campaign to publicize the not completed sculpture, the Public Building Commission of Chicago held some press showings of the maquette of the sculpture at the Chicago Art Institute. A notice of copyright⁸¹ was in the exhibition room, but it was not affixed to

⁷⁸ *Pierce & Bushnell Mfg. Co. v. Werckmeister*, 72 F. 54 (1st Cir. 1896); *see also* *American Tobacco Company v. Werckmeister*, 207 U.S. 284, where the U.S. Supreme Court found that an exhibition at a gallery that expressly reserved copyright for the artist and enforced a ban on copying was not a general or divestive publication.

⁷⁹ 19 ASCAP COPYRIGHT LAW SYMPOSIUM 108(1971).

⁸⁰ *Letter Edged in Black Press v. Public Building Commission of Chicago*, 320 F. Supp. 1303 (N.D. 111. 1970).

⁸¹ The notice read "The rights of reproduction are the property of the Public Building Commission of Chicago. © 1966 All Rights Reserved."

the model. Photographers for several national magazines attended these press showings and photographs of the maquette were published in many of these magazines without any copyright notices. The court held that "the display of the maquette constituted general publication"⁸², remarking that there were no restrictions placed on the press photographers and that the notice was improper.

The result in the Picasso case is justifiable on several special grounds. Among these are that Picasso intended to give the work to the people of Chicago and that the sculpture was meant to be a public work, like the Statue of Liberty. But the stated reason of the court in deciding that the work passed into the public domain was that it was generally published by exhibition. Thus the court's discussion of notice and the enforcement of notice will have some precedential value.

In light of the Picasso case, artists must make sure that their common law copyright is not lost by exhibition. In order to be sure that common law copyright is not lost, an artist should show works only at galleries that have and enforce restrictions against copying (or taking photographs). In addition a notice of copyright reservation should be included in gallery brochures promoting the artist. This same notice of copyright reservation should be physically present in the exhibition area. To be absolutely sure, an artist might insist that individual notices be attached to each work on exhibit.⁸³ However, one general notice in the exhibition area would probably be adequate, as long as the place of exhibition enforced the above restrictions.

The point of sale is the other time at which some feel a work of art is divestively published. Melville Nimmer, in his treatise, states that "the unrestricted sale . . . of a work of art . . . results in its publication."⁸⁴ Three cases are often cited for this proposition. The first is *Pushman v. New York Graphic Society*⁸⁵, which would serve as direct authority for sales being characterized as divestive publications were it not for Pushman's appeal. The New York Court of Appeals, in affirming the lower court's dismissal of Pushman's prayer for an injunction, expressly rejected the lower court's language about publication.⁸⁶ The Court of Appeals decided the case on the ground that an "unconditional sale carried with it the transfer

⁸² 320 F. Supp. at 1311.

⁸³ This suggestion is given with the assumption that the artist has chosen not to place the symbol © on the front of the work.

⁸⁴ NIMMER ON COPYRIGHT §54.

⁸⁵ 25 N.Y.S.2d 32 (Sup. Ct. 1941).

⁸⁶ "We are not entering into a separate discussion as to whether by this sale and the public exhibition the artist is to be held to have 'published' the work so that his common law right is lost." 287 N.Y. 302 at 304.

of the common law copyright and the right to reproduce.”⁸⁷ This holding proved to be equally troublesome to fine artists, and it will be discussed at a later point. But its significance for the law of publication is that it does not stand for the proposition that a sale is a divestive publication.

A more recent case cited as holding that a sale is equivalent to a divestive publication is the case of *Grandma Moses Properties, Inc. v. This Week Magazine*⁸⁸. Here, the court, in denying the artist’s request for a preliminary injunction, states *inter alia*⁸⁹, that “the unrestricted sale of No. 563 (The painting ‘Over the River to Grandma’s House’) carried to its purchaser and his successors . . . the untrammelled right to reproduce . . . No. 563.”⁹⁰ This language seems more analagous to the transfer analysis than to a reading that an unrestricted sale resulted in a dedication of the work to the public. There would have been no need to speak of successors in ownership of the right to reproduce if the work had fallen into the public domain, since all have equal reproduction rights to a work in the public domain.

The third case is *Van Veen v. Franklin Knitting Mills*⁹¹. In this case the artist Peter Van Veen allowed an art magazine to publish and distribute a reproduction of one of his paintings. Van Veen claimed no statutory copyright in the work at the time it was reproduced. Subsequently Van Veen sold the painting to a third party. Later still, the defendant attempted to reproduce the reproduction. Van Veen was held to have no common law right to prevent the alleged infringer from making copies of the reproduction. The court in directing a verdict for the defendant placed more emphasis on the fact that the painting had been reproduced in the art magazine than on the fact that there had been a later sale. These three cases suggest that the issue is anything but clear. The precedents are few and ambiguous. It is hoped that a clear judicial statement is forthcoming on the relationship between an unrestricted sale of a work of art and a divestive publication.

Ideally, the time for divestive publication ought to be when an artist is most aware of his legal rights in order that the artist might make the decision by his actions instead of by his inaction. The timing of publication

⁸⁷ 287 N.Y. 302 at 304.

⁸⁸ 117 F. Supp. 348 (S.D.N.Y. 1953).

⁸⁹ The court also quotes the following language from a Second Circuit case involving the sale of copies of a book without notice, “the common law right is lost by the general publication or unrestricted sale of a single copy.” *Bobbs-Merrill v. Strauss*, 147 F. 15 at 19. This seems to be a questionable precedent for the proposition that the sale of an original work of art causes its general publication.

⁹⁰ 117 F. Supp. 348 at 351.

⁹¹ 145 Misc. 451, 260 N.Y.S. 163 (Sup. Ct. 1932).

should be geared to take account of the intent of the artist. Simply put, did the artist intend to dedicate his work to the public? Absent an express dedication to the public, most artists do not intend for their works to fall into the public domain and should not be deemed to have lost their common law copyright by inaction. This however, is not the general approach of the case law on divestive publication.⁹² The proffered reason for not measuring the subjective intent of the artist when determining whether a divestive publication has occurred is that once subjective intent is the determinative factor, then fine artists (and other seekers of copyrights) will be able to manipulate their actions so as to perpetuate the statutory monopoly. One solution to this problem is to modify the copyright statute so that an artist can obtain a statutory copyright for his life plus a set number of years.⁹³

§ 302(a) of the 1971 Copyright Revision Bill⁹⁴ proposes "a term consisting of the life of the author and fifty years after his death." The adoption of this proposed amendment to the Copyright Act would be desirable, since it would make unnecessary most of the tedious line drawing associated with the concept of divestive publication. If the term of a copyright were set at the life of the artist plus fifty years, there would be no reason for any artist to lose a common law copyright unless the artist chose to do so. An artist might choose to relinquish his common law copyright in a work if he expressly dedicated the work to the public⁹⁵ or if he desired a statutory copyright.⁹⁶

A related but different question is whether an unrestricted sale of a work should be characterized as a transfer or assignment of the artist's common law copyright to the purchaser. *Pushman v. New York Graphic Society*⁹⁷ held that an "unconditional sale carried with it the transfer of the common law copyright and the right to reproduce."⁹⁸ After *Pushman*, the presumption ran against the fine artist, so that unless an artist expressly retained the common law copyright in a work, it was assigned upon sale. A section of the New York General Business Law, enacted in 1966, reversed the presumption. § 224 of Article 12-E provides that:

⁹² NIMMER states that looking to the artists' intent "is clearly contrary to the prevailing rule which holds that the forfeiture resulting from publication occurs as a matter of law regardless of intent". NIMMER §58.3.

⁹³ The current term is for 28 years with a right to renew the copyright for a second term of 28 years. See 17 U.S.C.A. § 24.

⁹⁴ Senate Bill 644, 92nd Congress, 1st Session (1971).

⁹⁵ As Picasso did with the Chicago sculpture, see text at notes 80-83, *supra*.

⁹⁶ If an artist decides to commercially reproduce an original work of art, he should obtain a statutory copyright for the reproductions.

⁹⁷ 287 N.Y. 302.

⁹⁸ *Ibid.*, at 304.

“§ 224 Right to Reproduce Works Of Fine Art”

Whenever a work of fine art is sold or otherwise transferred by or on behalf of the artist who created it, or his heirs or personal representatives, the right of the reproduction thereof is reserved to the grantor until it passes into the public domain by act or operation of law unless such right is sooner expressly transferred by an instrument, note or memorandum in writing signed by the owner of the rights conveyed or his duly authorized agent. Nothing herein contained, however, shall be construed to prohibit the fair use of such work of art.”

This law may prove to be quite helpful to fine artists, but its effect depends on the resolution of the previous questions about divestive publication. If either the time of exhibition or the time of sale is deemed to place a work of fine art in the public domain, §224 loses its force since it will have set up a presumption that the artist retains a non-existent right.

The vitality of the various state court decisions and state legislative pronouncements in this area of common law copyright is put into question by two 1964 U.S. Supreme Court decisions. Federal pre-emption of the fields of copyright and patent law was the subject of *Sears, Roebuck & Co. v. Stiffel*⁹⁹ and *Compco Corp. v. Day-Brite Lighting, Inc.*¹⁰⁰. Justice Black wrote 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.”¹⁰¹ It could be argued on the basis of this language that a state may not dictate the conditions upon which a fine artist loses a common law copyright, since the loss of a common law copyright necessarily precludes the artist from obtaining a federal statutory copyright. The idea of federal supremacy would suggest that we look to the federal courts and statutes for the resolution of these questions.

A more recent U.S. Supreme Court decision, *Goldstein v. California*¹⁰², retreats somewhat from the rigid federal supremacy analysis of *Sears* and *Compco*. In a decision upholding the constitutionality of California’s anti-tape piracy statute, Justice Burger wrote:

“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 Constitution ex-

⁹⁹ 376 U.S. 225 (1964).

¹⁰⁰ 376 U.S. 234 (1964).

¹⁰¹ 376 U.S. 225 at 232.

¹⁰² 412 U.S. 546 (1973).

pressly provide that such power shall not be exercised by the States."¹⁰³

Goldstein seems to open the door for state protection of areas of intellectual property which the Federal Copyright Act does not protect.¹⁰⁴ It could be argued that since the federal law does not adequately protect the work of fine artists, states which have a special interest in protecting and promoting the fine arts can adopt legislation like the New York statute. Whether they be federal or state questions, the questions surrounding the problems of divestive publication and the transfer of common law copyright need solutions. Those who answer the questions of 'When does divestive publication take place?', and 'Is a fine artist presumed to retain a common law copyright in a work of art after its sale?', should remember the Constitutional mandate to promote the arts.

The uncertainty surrounding the above questions makes it difficult for fine artists to avail themselves of the protections of statutory copyright. In resolving these two questions, the fine arts would be best promoted by the statutory adoption of the following propositions:

- 1.) That two distinct and separable property rights exist in a work of fine art. They are the right to possess the original and the right to reproduce the original.¹⁰⁵
- 2.) That the term of statutory copyright should be modified along the lines of § 302(a) of the 1971 Copyright Revision Bill, so that the term would be for the artist's life plus a certain number of years.
- 3.) That the concept of divestive publication should no longer be applied to a sale or exhibition of a work of art, absent an expressed dedication¹⁰⁶ of the work to the public.
- 4.) That in order for there to be a transfer of an artist's copyright (common law or statutory), there must be a bargained for contract evidenced by a writing.¹⁰⁷

¹⁰³ *Ibid.*, at 553.

¹⁰⁴ See *And Now, State Protection of Intellectual Property?*, 60 A.B.A.J. 198, February, 1974.

¹⁰⁵ Other future rights in a work of art, such as the right to use a work in future exhibitions, might also be included in the right to reproduce the original.

¹⁰⁶ Pablo Picasso's express desire to give his monumental sculpture to the people of Chicago serves as a good example of an expressed dedication.

¹⁰⁷ In the case of a commissioned work of art, the contract of employment ought to suffice as evidence of a transfer of both property rights in a work of art. This would leave intact a fairly consistent line of precedent holding that the employer is presumed to own a copyright in the case of a commission. See *Van Cleef & Arpels, Inc. v. Schecter*, 308 F. Supp. 674 (S.D.N.Y. 1969) for a recent application of this rule.

If this sort of legislative suggestion is impracticable, the courts can achieve similar results by a few re-interpretations. Neither an exhibition nor a sale should be construed as a general or divestive publication; rather, using intent as the test, they should be construed as limited publications. Intent should also serve as the criterion for determining if an artist's common law copyright is transferred to a purchaser of a work. Absent an express provision in the bill of sale, there should be a presumption that the artist intends to retain a common law copyright.

To What Extent is Collector and Art Gallery Director Opinion an Impediment to Fine Artists Using Statutory Copyright?

Discussions with art collectors and written comments to the two questionnaires reveal that most art collectors are at least uncertain about the concept of copyright in a work of art, and some collectors are affronted by fine art copyright. A sociological survey¹⁰⁸ suggests that in some of the larger art markets, a few very influential art collectors determine the financial success or failure of a new artist. A management study¹⁰⁹ of a large New York art gallery indicates that the typical art gallery is often only marginally successful financially. These three factors taken together add up to an art market in which the fine artist is left with very little bargaining power with which to assert legal rights.

Many collectors of fine art have an idealized conceptualization of the creative spirit of an artist. To many collectors (as well as some artists) the coexistence of the ideal and real facets of the art world is incongruous. Many of today's collectors are likely to think that a fine artist who uses copyright is too business oriented. Much collector hesitancy concerning fine art copyright stems from the problems of frontal notice and defacement, which have been discussed previously¹¹⁰ from the artists' perspective. Some of the fine artists surveyed also observed that the "public tends to be confused by and put off by notice."¹¹¹

The art gallery directors were much more concerned than the artists about this matter. But then it should be kept in mind that the majority of the art gallery directors (57.7%) personally felt that a copyright notice defaced a work of art, while only one-fourth (25.2%) of the artists surveyed did. The art gallery directors were asked: "Do you think that a

¹⁰⁸ Levine, *Chicago's Art World: The Influence of Status Interests on Its Social and Distribution Systems*, URBAN LIFE AND CULTURE, 293 October 1972.

¹⁰⁹ J. GOLDSMITH AND C. J. GOODMAN, *A Management Study of an Art Gallery, Its Structure, Sales and Personnel*, Tamirand Lithography Workshop, Los Angeles, 1967. [hereafter GOLDSMITH & GOODMAN].

¹¹⁰ See text following note 41, *supra*.

¹¹¹ Comment to Question 11.) of the Artist Questionnaire: "If you DO NOT use the copyright notice on your works of art, is it due to any particular reason?"

painting by an artist who placed a copyright notice (©) after his or her signature would be more difficult to sell than a painting by an artist who did not use a copyright notice?"¹¹² Fifty-five percent of those responding (25 of 45) answered yes. The directors were also asked to elaborate on this answer, and some of their comments are enlightening. Many felt that a notice "makes the work of a fine artist look like it was made purely for commercial reasons", that it "creates a commercial feeling". Several thought it would be an especially bad practice for beginners, that "young artists would find it impossible to get galleries to show their work or collectors to purchase it." Some felt that "buyers might think it was less theirs", that "it's like putting a restriction on the purchaser". The stronger comments against a notice varied from "we don't go out of our way to make sales more difficult" to "I would not sell a painting when an artist reserves copyright." The strongest statement in favor of copyright notice was that a notice "would be better, not worse, for it authenticates original work."¹¹³

If the results of this survey are a fair indication of gallery directors' opinions concerning copyright, then fine artists need more than modifications of the notice requirement and the concept of publication in order to start using statutory copyright. Any sort of copyright education program must include art gallery directors as well as artists. These education programs should not deal only with procedures and benefits to the fine artist of statutory copyright. They should also examine the statutory implementation of the Constitutional mandate to promote the arts. If the statutory grant of copyright is viewed as a method of promoting the economic security of fine artists, then a strong case can be made for the desirability of such statutory protections. The limited protection of the Copyright Act is meant to serve as a stimulus for artists, and hence both gallery directors and fine artists emerge as beneficiaries of the copyright protections.

The importance and effect of collectors' opinion cannot be ignored. While there is virtually no empirical data concerning collectors' opinions about copyright, there is a recent study¹¹⁴ which discusses the great degree of influence that certain collectors have on the art world in general. One artist questioned by Levine remarked that,

"it's a mark of prestige if you have a painting in famous Chicago collectors' collections. This really carries weight. If one of them buys a

¹¹² Question 16.) of the Art Gallery Directors Questionnaire.

¹¹³ Selected comments to Questions 12.) and 16.) of the Art Gallery Directors' Survey. See Appendix A-5 for the complete questions.

¹¹⁴ LEVINE, URBAN LIFE AND CULTURE, 293, October, 1972; see n.108, *supra*.

painting—he knows, he has good taste. It's like a lot of other things, like fashions — people don't trust themselves, but they do trust an expert. So they're impressed if he purchased something of an artist's".¹¹⁵

If some of these leading collectors are uncertain about or affronted by an artist who attempts to retain future rights, then it is possible that an artist on the rise has more to lose than to gain by using a copyright notice.

The well respected collectors assert their art world influence in more ways than just purchasing art works. They serve as jurors for prestigious exhibitions and sit on the acquisition committees of major museums. So that if the prominent collector denigrated an artist for employing a © symbol with his signature, there would be several forums for the collector's negative opinions about the artist. It may seem facile to suggest that, here too, the remedy is education. If one believes that it is desirable for artists to retain some future control in their works, it is not enough to convince only artists and dealers. Collectors must also be persuaded that the authors of the Constitution and the Copyright Act shared the collector's goal of promoting the fine arts.

An art gallery's ability to assert fine artists' legal rights in the face of negative collector opinion is somewhat dependent on the gallery's financial stability. If retaining reproduction rights in works makes them less easy to sell, art gallery directors will be quick to question the worth of copyright protection. A gallery might be willing to lose some sales as a cost of retaining copyright, but how many sales can a gallery lose and still stay in business?

In 1966 the Tamirand Institute, a non-profit organization devoted to the stimulation and preservation of the art of the lithograph, commissioned a management study of a large New York art gallery. The purpose of the study was to gain insights into the financial and structural inter-workings of a gallery in order to better assess the possible market for original prints. The resulting 110 page report¹¹⁶ delves into many areas; for our purposes the analysis of the marketing function of the gallery is instructive.

The Blue Gallery¹¹⁷ is presented as "prototypical". At the time of the study it had 11 full-time employees and 4 part-time employees. Blue annually placed approximately 10 artists under exclusive contract. In 1966 the gallery's total sales volume was more than \$400,000 and sales for 1967 were expected to exceed \$450,000. Blue was said to "rank among

¹¹⁵ LEVINE, at 314.

¹¹⁶ GOLDSMITH & GOODMAN, *see n. 109, supra*.

¹¹⁷ A pseudonym used to protect the identity of the gallery.

New York's ten leading galleries". And yet the net profit was 0.2% or approximately \$800.¹¹⁸ The management study concludes that the profit is "too small to warrant the cost and risk of capital".¹¹⁹

On a day to day basis, the Blue Gallery could not afford to lose sales. The gallery's break-even point was such that if it had sold one less major work in the year studied, it would have shown a loss. This is probably not typical of all galleries, but it does point out the precariousness of the retail art market.

The demand for original art is somewhat elastic and several factors influence the success of a gallery. The price of works *vis-a-vis* the state of the economy is one. Another factor is best described as image building. The Blue Gallery in 1966 expended more than \$30,000 on advertising, public relations and brochure printing. Galleries attempt to create an esthetic mystique about their business, and to many gallery directors the concept of copyright seems inapposite with their image. Many gallery directors might consider the retention of copyright in works they sell to be counter-productive.

Thus the fine artist might be left with a bundle of rights that cannot be asserted. A massive education program is called for to remedy this problem. Fine artists probably would retain future rights in their works if collectors and dealers were convinced that the use of copyright would make for a stronger art market. Whether the immediate effect of more fine artists asserting their legal rights would be to bolster or depress the art market is speculation. I am convinced that in the long run, the retention of future rights by fine artists in their works will bring about a healthier art market.

Conclusion

The purposes of this research project were to test the prevailing hypothesis and to discover some additional hypotheses to answer the question 'Why don't fine artists use statutory copyright?' While I do not purport to have discovered any easy solutions, I hope that readers of this article will gain a wider perspective of the issues surrounding fine art copyright. Even though these empirical studies establish that many fine artists lack sufficient knowledge of statutory copyright, it is not enough to conclude that the only remedy called for is education.

Even the most effective education program will probably not convince fine artists who believe that a visible notice defaces a work of art that they should use statutory copyright. This paper posits that the present

¹¹⁸ GOLDSMITH AND GOODMAN, at 40.

¹¹⁹ *Ibid.*, at 48.

state of the law would allow an accessible but normally hidden notice of copyright to satisfy the statutory requirements. This position should be clarified by a statutory enactment.

The rigidity of the concept of divestive publication causes many fine artists to lose statutory copyright. The concept of limited publication should be expanded so as to include exhibitions and sales of art works. Divestive publication should only be found when a fine artist intends to part with common law copyright. In order not to provide an incentive to the fine artist to put off obtaining a statutory copyright, the Congress should re-define the term of copyright protection to be the life of the creator plus a fixed number of years. Section 302(a) of the 1971 Copyright Revision Bill should serve as a good model. The defacement problem and the divestive publication problem are interrelated so that the adoption of § 302(a) would likely solve both of these problems.

Ultimately, the remedy must be education, but this should include the education of art gallery directors and collectors in addition to the education of fine artists. Those who sell and those who buy the works of fine artists must be convinced that statutory copyright for fine art benefits all parties concerned. For fine artists, copyright means a measure of economic security and an impetus to create. For dealers and collectors, copyright means a healthier and more productive art world. More will be known about copyright when university art departments inform fine art students, when national artist organizations and art journals inform practising fine artists, when dealer groups inform art gallery directors, and when art museums and collectors groups inform collectors.

It is hoped that the various suggested remedies will have a synergistic effect in solving the problem of non-use. That is, collectors might more readily accept fine art copyright, if the notice were not on the face of the work. And, art gallery directors might be more inclined to handle an artist who used copyright, if nearly all fine artists did. Laws need to be passed and classes need to be taught. The time has come to act so that more fine artists will be able to preserve their legal rights.

A-1

**ARTIST OPINION SURVEY
UNIVERSITY OF MICHIGAN LAW SCHOOL**

- 1.) Do you think that visual artists need copyright protection?_____ If so for
(check one or both)
_____ protection from plagiarizers.
_____ retention of reproduction rights (posters, calendars, prints, etc.).
- 2.) Do you personally place a copyright notice on any of the work you produce?
(check only one)
_____ never.
_____ very infrequently.
_____ only on major works.
_____ only on commissioned works when the client requests it.
_____ usually.
_____ always.
- 3.) Of the following artistic media, please indicate those that you use in the
order of frequency that you use them.
(Use the numeral 1 for the most frequently used medium, then
2, 3..., but do not enter a number next to a medium not used)
_____ painting.
_____ printmaking.
_____ sculpture.
_____ jewelry.
_____ pottery.
_____ (others)_____
4. What is your educational background?
(check as many as apply)
_____ college degree from 4 year college or university.
_____ Bachelor of Fine Arts.
_____ Master of Fine Arts.
_____ other formal instruction in art, if so for how many years?_____
- 5.) Do you teach art classes?_____ If you do, what ages are your students?
(enter a percentage next to each group, should add up to 100%)
_____ 12 years old or younger.
_____ 13 to 17.
_____ 18 to 25.
_____ 26 years old or older.

A-2

- 6.) Please list any local, regional or national artists' associations that you belong to. _____

- 7.) How many one person shows have you had? _____
- 8.) In how many juried exhibitions (including juried art fairs) has your work been included? _____
- 9.) Do you sell most (dollar value) of your work:
(check only one)
_____ directly to the public (including art fairs).
_____ through a gallery.
_____ in your own gallery.
_____ by commission.
_____ (other). _____
- 10.) Is your main source of income derived from the sale of the art you produce?
_____ If so, for how many years have you relied on the sale of your art as your main source of income? _____ Present age? _____
- 11.) If you DO NOT use the copyright notice on your works of art, is it due to any particular reason? (be as specific as you can) _____

- 12.) Do you feel that a copyright notice defaces a work of art? _____
- 13.) Do you feel that you have enough information concerning copyright protection to make an informed judgment as to its use? _____
- 14.) If you DO NOT use the copyright notice, do you reserve any future rights in the art you produce when you sell the work? _____ If so, please indicate the method by which you reserve future rights. _____

- 15.) If you DO use the copyright notice, do you in addition register any works with the Register of Copyrights in Washington, D.C.?
(check only one)
_____ never.
_____ only upon sale.
_____ only upon request of the client in the case of a commission sale.
_____ usually.
_____ always.

A-3

- 16.) In the artistic medium you use most frequently, please indicate by percentages which of the following ranges of prices your work is priced.

(should add to 100%)

_____ less than \$50.
_____ \$50 to \$100.
_____ \$100 to \$500.
_____ \$500 to \$2000.
_____ more than \$2000.

- 17.) Has any of your art work been reproduced?_____ If so, how many different works have been reproduced?_____

- 18.) If you have had some of your work reproduced, was it ever done without your consent?_____ If so how many times?_____

- 19.) If you have had some of your work reproduced, were you paid each time a work was reproduced?_____ If you have ever been paid when one of your works was reproduced, was it (check one or both)_____ a lump sum payment, or_____ a royalty arrangement, whereby you were paid on the basis of the number of reproductions sold?

- 20.) How much of your last year's income (1972) do you attribute to the sale of your art?

(check only one)

_____ less than \$2000.
_____ \$2000 to \$4000.
_____ \$4000 to \$10,000.
_____ \$10,000 to \$25,000.
_____ \$25,000 to \$50,000.
_____ more than \$50,000.

- 21.) Have you ever personally felt the need for copyright protection with reference to one of your works?_____ If so, please explain.

A-4**ART GALLERY DIRECTOR OPINION SURVEY**

- 1.) Do you think that visual artists need copyright protection?_____ If so for:
(check one or both)
_____ protection from plagiarizers.
_____ retention of reproduction rights (posters, calendars, "prints", etc.)
- 2.) In 1972, for how many living artists did your gallery attempt to sell works?_____
- 3.) Of this number, how many did you represent exclusively?_____
- 4.) What sort of agreement (concerning commissions, exclusivity, etc.) does your gallery enter into with a living artist for whom you sell works?
(check the category which describes your normal course of dealing with artists, check only one.)
_____ oral agreement.
_____ written contract. (If you normally use a written contract, I would appreciate a copy of a sample contract.)
- 5.) Does your gallery advise the artists you represent concerning business and legal matters?
(check only one)
_____ frequently.
_____ seldom.
_____ never.
- 6.) Of the artistic media (excluding reproductions) by living artists that your gallery sells, please indicate what percentage of total items sold each of the following represents:
(should add to 100%)
_____ paintings.
_____ original prints.
_____ sculpture.
_____ jewelry.
_____ pottery.
_____ (others) _____
- 7.) Does your gallery sell reproductions of original art works?_____ If so, what percentage of total dollar volume sales does the sale of these reproductions represent to your gallery?_____

A-5

- 8.) What percentage of your total dollar volume sales is the sale of art by living artists? _____
- 9.) Of paintings by living artists that you sell, please indicate what percentage of total paintings sold are in the following ranges of prices:
- (should add to 100%)
- _____ less than \$50.
- _____ \$50 to \$100.
- _____ \$100 to \$500.
- _____ \$500 to \$2000.
- _____ more than \$2000.
- 10.) When you sell a work of art for a living artist, do you reserve for the artist any future rights in the work of art?
- (check only one)
- _____ always.
- _____ usually.
- _____ very infrequently.
- _____ never.
- 11.) If you always or usually reserve future rights for a living artist, please describe the nature of the right and the manner in which you reserve such rights. _____
- _____
- _____
- 12.) If you very infrequently or never reserve future rights for a living artist, please explain why not (as specifically as you can). _____
- _____
- _____
- 13.) Do you feel that the artists you represent have enough information concerning copyright protection to make an informed judgment as to its use? _____
- 14.) Do you feel that you have enough information concerning copyright to make an informed judgment as to its use? _____ If you feel that you do have enough information concerning copyright, where did you learn about copyright?
- (check as many as apply)
- _____ in college.
- _____ by reading a book on the subject.
- _____ from a trade association (like the Art Dealers Association).
- _____ other (please list). _____

- 15.) Do you personally feel that a copyright notice defaces a work of art?_____
- 16.) Do you think that a painting by an artist who placed a copyright notice © after his or her signature would be more difficult to sell than a painting by an artist who did not use a copyright notice?_____ Please elaborate.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

I. United States of America and Territories

242. U. S. CONGRESS. HOUSE.

H.R. 2223. A bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. Kastenmeier, January 28, 1975, and referred to the Committee on the Judiciary. 77 p. (94th Cong., 1st Sess.)

A companion bill to S. 22. *See* Item 248, *infra*.

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

Copyright miscellany. Report, together with dissenting views, to accompany S. 3976, submitted by Mr. Kastenmeier on December 12, 1974. 18 p. (93d Cong., 2d Sess., H. Rep. No. 93-1581)

S. 3976 was reported favorably to the House, as amended, by roll call vote at a meeting held on December 11, 1974, at which 21 members voted "Aye" and 7 members voted "Nay." Mr. Kastenmeier dissented to the further extension of expiring renewal terms of copyright. Mr. Drinan also dissented to such extension as well as to the establishment of a National Commission on New Technological Uses of Copyrighted Works.

244. U.S. CONGRESS. HOUSE. *Committee on the Judiciary. Subcommittee on Courts, Civil Liberties, and the Administration of Justice*.

Copyright miscellany. Hearing, Ninety-third Congress, second session, on S. 3976, to amend title 17 of the United States Code to remove the expiration date for a limited copyright in sound recordings, to increase the criminal penalties for piracy and counterfeiting of sound recordings, to extend the duration of copyright in certain cases, to establish a National Commission on New Technological Uses of Copyrighted Works, and for other purposes. November 26, 1974. Washington, U. S. Govt. Print. Off., 1975. 19 p. (Serial No. 59)

Barbara Ringer, Register of Copyrights, was the sole witness. The Register was accompanied by Dorothy Schrader, General Counsel of the Copyright Office.

245. U.S. CONGRESS. HOUSE. *Committee on the Judiciary. Subcommittee on Courts, Civil Liberties, and the Administration of Justice.*

Extending limited copyright in sound recordings. Hearing, Ninety-third Congress, second session, on H.R. 13364, to amend title 17 of the United States Code to remove the expiration date provided in Public Law 92-140 which authorized the creation of a limited copyright in sound recordings for the purpose of protecting against unauthorized duplication and piracy of sound recordings; to increase the criminal penalties for piracy and counterfeiting of sound recordings; and for other purposes. June 3, 1974. Washington, U.S. Govt. Print. Off., 1974. 62 p. (Serial No. 40)

246. U.S. CONGRESS. HOUSE. *McDonald, Larry.*

Sports and the 93rd Congress. *Congressional Record*, vol. 121, no. 31 (daily ed. Feb. 27, 1975), pp. E797-E798.

Representative McDonald causes to be inserted into the *Record* an article by Philip R. Hochberg which was published in the February 15, 1975, issue of *Sporting News* under the title "Sports and the 93rd Congress." The article reviews all recent broadcasting legislative proposals, including copyright law revision, which in addition to the antiblackout bill, is described as "a potential setback" for sports.

247. U.S. CONGRESS. HOUSE. *Won Pat, Antonio Borja.*

Introduction of non-contiguous area cable television station legislation. *Congressional Record*, vol. 121, no. 41, (daily ed. Mar. 13, 1975), pp. E1127-1128.

In an extension of remarks, the Congressman from Guam proposes the text of legislation similar in purpose to the so-called Stevens amendment included in S. 1361 as passed by the Senate in the 93d Congress, which provided for compulsory licenses and copyright payments by cable systems in most non-contiguous areas. The "proposed legislation will insure that cable systems in non-contiguous areas are not treated differently under our copyright laws from those located elsewhere," because of the possibility that cable systems in non-contiguous areas that tape television programs may stand on a different footing than systems located within the boundary of the 48 contiguous states, given the uncertainty of the applicability of the *Fortnightly* and *Teleprompter* decisions to non-contiguous areas.

248. U.S. CONGRESS. SENATE.

S.22. A bill for the general revision of the Copyright Law, title 17 of the United States Code, and for other purposes. Introduced by Mr. McClellan, January 15, 1975, and referred to the Committee on the Judiciary. 77 p. (94th Cong., 1st Sess.)

"Other than for necessary technical and perfecting amendments, and changes required by the enactment of Public Law 93-573, the interim copyright bill, the text of this bill is identical to that passed by the Senate on September 9, 1974 [S.1361, 93d Cong.]." Cf. Statement of Mr. McClellan on his introduction of S.22 in 121 *Congressional Record* S104 (daily ed. Jan. 15, 1975).

249. U.S. CONGRESS. SENATE.

S. 31. 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), January 15, 1975, and referred to the Committee on the Judiciary. 6 p. (94th Cong., 1st Sess.)

"The bill would establish a uniform body of Federal unfair competition law by creating a Federal statutory tort of unfair competition affecting interstate commerce, and by establishing Federal jurisdiction over such tort claims within the Trademark Act of 1964."—Statement of Mr. McClellan on his introduction of the bill in 121 *Congressional Record* S109 (daily ed. Jan. 15, 1975). A number of identical or similar bills have been introduced in previous Congresses.

250. U.S. CONGRESS. SENATE.

S. 1111. A bill to amend the Copyright Act of 1909, and for other purposes. Introduced by Mr. Hugh Scott (for himself, Mr. Baker, Mr. Bayh, Mr. Cranston, Mr. Hartke, Mr. Tunney, and Mr. Williams), March 7, 1975, and referred to the Committee on the Judiciary. 7 p. (94th Cong., 1st Sess.)

A bill, which, if enacted, "may be cited as the 'Performance Rights Amendment of 1975'," and is designed to provide royalty payments to performers for the use of their recorded music for profit. See statement of Senator Scott on his introduction of the bill in 121 *Congressional Record* S3411 (daily ed. Mar. 7, 1975).

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

Public law 93-573, 93rd Congress, S. 3976. December 31, 1974. An Act to amend title 17 of the United States Code to remove the expiration date for a limited copyright in sound recordings, to increase the criminal penalties for piracy and counterfeiting of sound recordings, to extend the duration of copyright protection in certain cases, to establish a National Commission on New Technological Uses of Copyrighted Works, and for other purposes. 3 p. (88 STAT. 1873-1875)

252. U.S. OFFICE OF EDUCATION.

45 CFR Part 100a. Department of Health, Education and Welfare. Office of Education. General provisions for discretionary programs. Copyrightable materials developed under Office of Education programs. *Federal Register*, vol. 40, no. 16 (Jan. 23, 1975), pp. 3607-3610.

Proposed amendments which "would codify the Office of Education's copyright guidelines, and supersede the document appearing at 35 FR 7317 (May 9, 1970) . . . The regulations . . . govern the use of copyrightable material developed under Office of Education programs, including provision for obtaining a limited copyright on such materials . . . [N]o major change in the substantive rules is intended."

2. Foreign Nations

253. BRAZIL. *Laws, statutes, etc.*

Loi no. 5,988 du 14 décembre 1973 réglementant les droits des auteurs et contenant d'autres dispositions. *Revue Internationale du Droit d'Auteur*, no. 82 (Oct. 1974), pp. 210-229.

A French translation of the Brazilian law on copyright and neighboring rights which came into force on January 1, 1974.

254. JAPAN. *Laws, statutes, etc.*

Design law. (Law No. 125 of April 13, 1959, as amended.) *Industrial Property*, vol. 13, no. 11 (Nov. 1974), pp. 443-453.

Amended by Law No. 140, of 1962, Law No. 148 of 1964, Law No. 81 of 1965, Law No. 91 of 1970, and Law No. 96 of 1971.

"This text is the translation of the Patent Office of Japan, published by the Japanese Group of AIPPI. The new provisions of

the amended Design Law were translated by Mr. Takashi Ishihara and the full text of the amended Design Law was revised by Mr. Haruo Goto."

255. PHILIPPINES (REPUBLIC). *Laws, statutes, etc.*

Decree on the protection of literary property. (Presidential decree no. 49, of November 14, 1972. *Copyright*, vol. 10, no. 12 (Dec. 1974). pp. 294-300.

"This Decree was published in the Official Gazette of November 20, 1972, and came into force on December 6, 1972."

256. PHILIPPINES (REPUBLIC). *Laws, statutes, etc.*

Presidential Decree authorizing the compulsory licensing or reprinting of educational, scientific or cultural books and materials as a temporary or emergency measure whenever the prices thereof become so exorbitant as to be detrimental to the national interest. (No. 285, of September 3, 1973). *Copyright*, vol. 10, no. 12 (Dec. 1974), p. 101.

Section 3 of the Decree reads: "The reprinting of the above books, pamphlets and materials shall be subject to the condition that the reprinter shall pay, in local currency, a royalty of three per centum (3%) of the gross selling price, if so demanded by the authors, publishers or copyright proprietors concerned, whoever is legally entitled thereto: *Provided* that, in the case of non-resident authors, publishers or copyright proprietors, the payment of the royalties shall be made only to them personally in the Philippines or their respective representatives or branch offices in the Philippines."

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

257. BERNE UNION. *Copyright*, vol. 11, no. 1 (Jan. 1975), pp. 23-30.

Contents: The Berne Union and international copyright and neighboring rights in 1974. Dahomey: accession to the Paris Act (1971) of the Berne Convention. South Africa: accession to the Paris Act (1971) of the Berne Convention. Table of member states as on January 1, 1975. Membership of the administrative bodies.

258. CONVENTIONS ADMINISTERED BY WIPO. *Copyright*, vol. 11, no. 1 (Jan. 1975), pp. 31-32.

Contents: Convention for the Protection of Producers of Phonograms Against Unauthorized Duplication of Their Phonograms: state of ratifications and accessions as on January 1, 1975. United Kingdom: declaration concerning the application of the [phonogram] convention to certain territories. International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations: state of ratifications and accessions as on January 1, 1975.

259. CONVENTIONS NOT ADMINISTERED BY WIPO. *Copyright*, vol. 11, no. 1 (Jan. 1975), pp. 33-34.

Contents: Universal Copyright Convention: state of ratifications and accessions as on January 1, 1975. European agreements (European Agreement Concerning Programme Exchanges by Means of Television Films; European Agreement for the Prevention of Broadcasts Transmitted from Stations Outside National Territories; European Agreement on the Protection of Television Broadcasts; Protocol to said Agreement): state of signatures, ratifications and accessions as on January 1, 1975. Additional Protocol to the Protocol to the European Agreement on the Protection of Television Broadcasts: entry into force.

260. INTERNATIONAL CONFERENCE OF STATES ON THE DISTRIBUTION OF PROGRAMME-CARRYING SIGNALS TRANSMITTED BY SATELLITE, *Brussels, May 6-21, 1974*. [Documents] *Copyright Bulletin* (Unesco), vol. 8, no. 2/3 (1974), pp. 10-15.

Contents: Convention Relating to the Distribution of Programme-Carrying Signals Transmitted by Satellite. Signatory

states. Final Act of the International Conference of States on the Distribution of Programme-Carrying Signals Transmitted by Satellite. Signatory states.

261. WORLD INTELLECTUAL PROPERTY ORGANIZATION.

Agreement between the United Nations and the World Intellectual Property Organization. *Copyright*, vol. 11, no. 1 (Jan. 1975), pp. 3-10.

The English and Russian texts of an agreement, pursuant to which WIPO became, on December 17, 1974, a specialized agency of the United Nations system.

262. WORLD INTELLECTUAL PROPERTY ORGANIZATION.

The World Intellectual Property Organization in 1974. *Copyright*, vol. 11, no. 1 (Jan. 1975), pp. 11-18.

The 1974 annual report of WIPO, the main event of which is described as its becoming a specialized agency of the United Nations.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U. S. COURTS

1. Federal Court Decisions

263. CERTIORARI DENIED IN COLORADO MAGNETICS CASE

Edward B. Marks Music Corporation v. Colorado Magnetics, Inc., not yet reported. *For decision below, see* 497 F.2d 285, 21 BULL. CR. SOC. 272, Item 224 (1974).

The U. S. Court of Appeals of the Tenth Circuit had earlier held in an en banc opinion that record duplicators of sound recordings fixed before the effective date of the Sound Recording Act of 1971 (February 15, 1972), could not resort to the compulsory license provision in Section 1(e) of the Copyright Act of 1909 as a defense for duplicating or dubbing recordings, including copyrighted music.

Contrary to the District Court, the Court of Appeals had held on appeal and subsequently on rehearing en banc that such complete dubbing or piracy was not making a "similar use" of the "copyrighted composition" and was therefore subject to state law on unfair competition.

The unsuccessful defendants had petitioned the Supreme Court for a grant of certiorari on July 10, 1974. The Court took the unusual step of inviting the Solicitor General to submit a brief as *amicus curiae*. In reply to the Court's request of October 15, 1974, the Solicitor General filed a brief urging the Court to deny certiorari on the ground that on the authority of the Court's earlier decision in *Goldstein v. California*, 412 U.S. 546 (1973), and on the reasoning of the court below, it had been correctly decided that a "tape pirate" may not take advantage of the compulsory license provision under Section 1(e).

In its *amicus* brief to the Supreme Court the Solicitor General said, *inter alia*:

"The controlling words in the compulsory license provision are "similar" and "use". What is it that is available for "use": the copyrighted composition alone, or the mechanical reproduction manufactured under license from the copyright owner? Is it a "similar" use if the third party duplicates the original licensee's recordings, or must the third party "similarly" perform *all* of the acts of the original licensee,

including hiring musicians and transcribing their work? We submit that on a fair reading of the compulsory license provision only the original composition is available for "use" and that to be "similar" a "use" must be made in the same fashion as the original licensee.

"Several considerations support this restrictive reading of the provision. First, because until the Sound Recording Act of 1971 the mechanical reproductions were themselves uncopyrighted, it would be surplusage for the statute to grant a compulsory license to "use" the reproduction itself. The license intended therefore must have been a license to "use" the copyrighted composition itself. It is this use, beginning with the composition, that must be "similar" to the use made by the original licensee.

"Second, because at the time the statute was passed direct copies of an existing mechanical reproduction could not be made economically, Congress must have contemplated that a "compulsory licensee" would begin from scratch and record a new arrangement with its own artists. This understanding would have been consistent with the desire of Congress, expressed elsewhere in the debates of the 1909 revisions, to foster musical diversity from a variety of arrangements of a single composition. See *Shaab v. Kleindienst*, 345 F. Supp. 589, 590 (D. D.C.). The desire for musical diversity would be frustrated, rather than advanced, if the compulsory license provision were held to authorize a mere duplication that makes no artistic contribution."

And again,

"If the recording companies' most successful products are copied and sold at prices they cannot match, the expected return from producing new songs will decrease; because the production of new material will be less attractive, companies will be less likely to provide recordings of new songs. This will reduce musical diversity, as well as harming the owners of the composition copyright, such as respondent.

"Moreover, owners of the composition copyright derive returns not only from the original recording, but also from recordings of new arrangements of their material by new artists after the first recording has become popular. Such new arrangements will be deterred if recording artists and companies fear that any new recording will be undersold either by an unauthorized duplication of the new recording or by an unauthorized duplication of the original recording. If such new variations are deterred, musical diversity will again be diminished, a result contrary to both the purposes of the copyright laws and the pecuniary interests of the composition copyright owners."

It may well be expected therefore that the continued efforts of record or tape pirates to justify their practices by resorting to the compulsory license provision will have been finally put to rest.

WALTER J. DERENBERG

264. *Siegel v. National Periodical Publications, Inc.*, 184 U.S.P.Q. 257 (2d Cir. December 5, 1974) (Mulligan, C.J.) *For decision below, see* 180 U.S.P.Q. 575 (S.D.N.Y. 1973), 21 BULL. CR. SOC. 328, Item 303 (1974).

Action for declaratory judgment as to ownership of copyright renewal rights in the comic strip "Superman". The United States District Court for the Southern District of New York dismissed plaintiff's complaint.

On plaintiff's appeal *held*, affirmed.

The court upheld the dismissal solely on the grounds that the 1974 state court judgment had finally determined that defendant owned *all* rights to the works, even though the specific words "renewal rights" had not been mentioned in that judgment. The court did not uphold, however, the District Court's further conclusion that, in any event, defendants owned the works under the "work for hire" doctrine. The Second Circuit stated that the essence of the works had been created prior to the employment of plaintiffs by defendants and that the creation was not done, therefore, at the "instance" of defendants. The court held, in effect, that the plaintiffs rather than defendant were the "authors", but this in no way altered defendants' complete copyright ownership since plaintiffs had been found to have transferred to defendants *all* their rights.

265. *Fischer-Price Toys, Division of the Quaker Oats Company v. My-Toy Co., Inc.*, 184 U.S.P.Q. 376 (S.D.N.Y. Nov. 27, 1974) (MacMahon, D.J.).

Action for alleged infringement arising out of copying of four of plaintiff's copyrighted dolls. Notice of copyright was on each of plaintiff's dolls and plaintiff had obtained a certificate of copyright registration for each doll as a "work of art". On the issues of liability and permanent injunctive relief, *held*, judgment for plaintiff.

Applying the generally applicable standards, the court found for plaintiff on the issues of copyrightability, access, copying, and substantial similarity. While defendant contended that plaintiff's dolls were not protectible because they contained features found on other dolls, the court stated that "the original combination of these features into new dolls makes the dolls copyrightable." Despite testimony of defendant's independent creation of its dolls, which the court described as "incredible", the defendant was found to have copied plaintiff's dolls because they were "strikingly similar" and therefore, "no explanation other than copying

[was] reasonably possible." Minor differences appeared "to be the result of a calculated but thin attempt to disguise deliberate copying of plaintiff's dolls". As further evidence of defendant's copying, the court noted with interest that the names of defendant's dolls, "although not paired with the similarly appearing dolls", were similar to or adaptations of the names of plaintiff's dolls. This further convinced the court that the similarity of the dolls was not chance, but due "to a deliberate tracking of plaintiff's line of dolls."

266. *Mailer v. Zolotow*, 184 U.S.P.Q. 20 (S.D.N.Y. July 16, 1974) (Tyler, D.J.).

Action by Norman Mailer against Maurice Zolotow for declaratory judgment that plaintiff's book "Marilyn" does not infringe defendant's copyright in his book "Marilyn Monroe". Prior to the publication of "Marilyn", plaintiff's publisher had contracted with defendant's publisher for permission to incorporate into plaintiff's book a 3500 word portion of the defendant's book, which plaintiff used as a jumping off point for a fuller statement in his book commenting on prior works on the life of Ms. Monroe, including those by the defendant. Then, shortly before plaintiff's book was released, an article was published indicating that the defendant threatened suit against the plaintiff for unauthorized use of copyrighted material as well as for slander. Thereafter, defendant commenced a suit against plaintiff specifically alleging libel, invasion of privacy, interference with contractual relationships, and intentional and negligent infliction of emotional distress. Although no formal count for copyright infringement was included, defendant did allege there had been "unauthorized borrowing" from defendant's work.

On defendant's motion to dismiss, *held*, motion granted.

Declaratory Judgment

The court noted that in the field of copyright law, declaratory judgments are not uncommon where there has either been a threatened suit for infringement or where a copyright proprietor has given notice that its copyright has been infringed. These would be sufficient to create a "justiciable controversy". While the article referred to above did contain a public threat by defendant to sue plaintiff, which ordinarily would suffice to create a "justiciable controversy", the court held such a "real" controversy did not in fact exist. The following reasons were given to negate plaintiff's claim of a real controversy: (1) The article was followed by the commencement of a suit "structured more narrowly than the threat". (Plaintiff failed to convince the court that defendant's "unconsummated" threat therefore retained its "vitality"); (2) defendant swore in his affidavit that he had no intention of commencing any additional litigation, and

(3) defendant issued a retraction, which the court stated, "is not by itself proof positive that a controversy has been extinguished . . ." but "it [was] another factor to be weighed in assessing whether an actual controversy exists."

The court concluded by noting that "it is not enough that there may have been a controversy when the action was commenced if subsequent events have put an end to the controversy."

Jurisdiction

The defendant also claimed a dismissal or a consolidation was required due to the existence of a prior pending action. The court declined to exercise jurisdiction, stating that although the "pendency of another suit will not necessarily defeat jurisdiction in every situation . . . the pendency of the California action, coupled with the opportunity therein for [plaintiff] to interpose a counterclaim, militates against the exercise of jurisdiction in this case."

267. *Broadcast Music, Inc. v. J.B. Broadcasting of Baltimore, Ltd.*, 184 U.S.P.Q. 478 (D. Md. September 26, 1974) (Blair, D.J.).

Action for alleged copyright infringement arising out of defendant's unauthorized broadcast of plaintiffs' copyrighted songs for which plaintiffs seek damages and injunctive relief. At the deposition of defendant, the general manager of defendant was asked whether defendant had broadcast plaintiffs' copyrighted songs not only on the specific dates alleged in plaintiffs' complaint, but thereafter as well. Defendant refused to answer questions relating to its possible broadcast after the specific dates alleged, claiming such questions were outside the permissible scope of the deposition.

On plaintiffs' motion to compel defendant to answer such questions, *held*, motion granted.

By alleging specific dates in its complaint, plaintiffs did not limit discovery to acts of defendant only on those dates. Since defendant's possible continued acts of infringement were "highly relevant" to whether the court should issue the injunction sought by plaintiffs, the court stated that the questions asked of defendant by plaintiffs are appropriate.

268. *Quackenbush Music Ltd. v. Wood*, 184 U.S.P.Q. 210 (M.D. Tenn. Aug. 9, 1974) (Morton, D.J.).

Action for infringement of plaintiffs' copyrighted songs arising out of defendants' unauthorized reproduction thereof on a coin-operated machine at their place of business. Defendants charged admission to their place of business when the above reproduction took place, although the fee was not for the sole privilege of listening to the coin-operated

machines. The fee was, rather, charged only when a live band was to give a performance at defendants' place of business.

Held, judgment for plaintiff.

Favoring a literal reading of 17 USC § 1(e), the court rejected defendants' assertion that such section was inapplicable because the fee charged was separate and unrelated to the reproduction of plaintiffs' copyrighted songs on the coin-operated machine. This was still a "public performance for profit" within § 1(e), because, on the particular occasions in question, "the patrons of defendants' establishment could not have heard these particular performances without paying the admission charge." The court awarded statutory damages and an injunction against further infringements.

269. *International Luggage Registry v. Avery Products Corp.*, 184 U.S.P.Q. 66 (N.D. Cal. July 18, 1974) (Zirpoli, D.J.).

Action for alleged infringement of plaintiff's copyright in its "personalized paper identification labels", printed by defendant Avery Products Corp. and used by plaintiff in connection with its business of relocating lost luggage. Defendant Credit Card Service Bureau, a competitor of plaintiff, adopted plaintiff's basic business system and, in that connection, began utilizing labels (also printed by defendant Avery) for the same purpose as plaintiff. The labels of both plaintiff and defendant were

"identification labels . . . coated on the back with pressure-sensitive adhesive so they [could] be stuck on the subscriber's luggage. Each label ha[d] the subscriber's initials printed on it, and each label [bore] an individual computer code number. Each label also request[ed] any finder of lost luggage to call, toll free, a particular telephone number appearing on the label."

On defendant's motion for summary judgment, *held*, motion granted.

Substantial Similarity and Copyrightability

The court held that summary judgment would be appropriate if, upon a side-by-side comparison (which was there available), no substantial similarity existed. For, even assuming access and copying, there could be no infringement but for substantial similarity "between the copyrightable portions of plaintiff's label and the corresponding portions of Credit Card's label." In its comparison of the two labels, the court "excluded from its analysis . . . those elements which [were] essential to any particular type of form." Using that approach, the two labels were held not substantially similar since "the most striking elements of similarity" (the shapes of the labels, the large blank areas for initials, and the use of the

telephone numbers with "if found notify") were all either essential features of an uncopyrightable system or inherent features of luggage identification labels. In addition, the design and writing portions of each label showed "considerable differences".

Unfair Competition

Defendant's claim of unfair competition, absent an allegation of "palming off", was rejected by the court:

"Absent a showing of something more than even an exact copying of a competitor's product, the allegedly injured party's sole protection is through federal copyright and patent law."

270. *Walker v. University Books, Inc.*, 184 U.S.P.Q. 10 (N.D. Cal. 1974) (Peckham, D. J.).

Action for alleged infringement of plaintiff's copyright in her book "I Ching Cards" and for unfair competition. Defendant Morrow (who claimed he had no "active role" in the affairs of the corporate defendants at the relevant time), allegedly fraudulently secured confidential information from plaintiff in New York concerning the "I Ching" book prior to a proposed reprinting thereof. He then conveyed such information to the corporate defendants, and thereby allegedly participated in the corporation's subsequent publishing and marketing in California of an infringing book.

On defendant Morrow's motion to dismiss for lack of personal jurisdiction, *held*, motion denied.

Since California's "long arm" statute indicates "an intent to exercise the broadest possible jurisdiction", the court held that defendant Morrow would be subject to in personam jurisdiction in California if plaintiff could show that the cause of action alleged arose out of or was connected with his activities in California. Plaintiff's position, accepted by the court, was that defendant Morrow committed an out-of-state act having in-state consequences (sales of infringing book) all of which was foreseeable, and that this alone satisfied the standards for the exercise of jurisdiction. The court stated:

"... [C]orporations (or individuals) who reasonably can foresee that their actions may have substantial effects in foreign state are subject to the foreign state courts' personal jurisdiction. This logic would appear to apply not only to cases which involve personal injuries but also to cases which concern other types of tortious activity. Cf. *Elkhart Engineering Corporation v. Dornier Werke*, 343 F. 2d 861, 868 (5th Cir. 1965)."

The court closed its opinion with an interesting point, however, noting that "whenever a plaintiff attempts to gain personal jurisdiction solely on the set of facts which also make out the claim, . . . [such] plaintiff cannot conclusively 'prove' the facts relevant to personal jurisdiction without necessarily 'proving' her right to relief on the merits. . . . However, the court believes that plaintiff's fairly specific allegations suffice as proof for the purpose of resolving the initial personal jurisdiction problem, even though later court proceedings on the merits may prove all or part of the allegations erroneous."

2. State Court Decisions

271. *Szczesny v. W.G.N. Continental Broadcasting Corporation*, 183 U.S.P.Q. 427 (Ill. App. Ct. June 25, 1974) (Stamos, J.).

Action for alleged infringement of plaintiff's common law copyright in its retail store promotional television program entitled "At the Races". Plaintiff had submitted a plan of his idea, which included various methods of audience participation, to defendant W.G.N. in 1959. Thereafter, in 1963, defendant Jewel and defendant W.G.N., without plaintiff's authorization, agreed to broadcast a similar show entitled "Let's Go To The Races". (Plaintiff allegedly had given W.G.N. a release which W.G.N. was unable to locate and therefore did not rely on.) In support of defendants' motion for summary judgment, which was granted, defendant submitted substantial evidence of independent creation, the original phases of which predated defendants' access to plaintiff's plans.

On plaintiff's appeal from the granting of summary judgment to defendants, *held*, reversed and remanded.

Plaintiff argued on appeal that the program originally created by defendant (which did not include audience participation), was different from the program defendant ultimately broadcast as "Let's Go To The Races". Therefore, the plaintiff argued, the defense of independent creation was inapplicable. On appeal, the court held that the element of audience participation in defendants' "Let's Go To The Races" was a "salient feature of the idea entitled to protection, for the method of audience participation would directly affect the saleability of the program to a sponsor, and would also be an important factor in determining how conducive to television broadcasting such a program would be." Except for defendants' averment that the original plan, which did not include audience participation, had been "refined", the record was "barren of any other facts which indicate how and when [defendant] refined [the] format." Thus, the court held that the record did not present "conclusive evidence" of independent development, but that such remained as a factual issue to be determined at trial.

PART V.

BIBLIOGRAPHY**A. BOOKS AND TREATISES****1. United States Publications**

272. AMERICAN BAR ASSOCIATION. Section of Patent, Trademark and Copyright Law. 1974 Committee reports to be presented at the annual meeting, August 12-15, 1974, Honolulu, Hawaii. Editor: Beverly A. Vandenburg. Chicago, American Bar Center [1974] 356 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 copyright and copyright and new technology. Also included is the Report of Committee No. 410 on computer program protection.

2. Foreign Publications**1. In English**

273. LAHORE, JAMES CAMPBELL AND P. B. C. GRIFFITH. Copyright and the arts in Australia. Clayton, Victoria, Melbourne University Press [1974], 219 p.

The book is a result of a survey carried out at the request of the Australian Council for the Arts. "It is the first comprehensive study of Australian copyright law . . . [giving] a concise statement of the law and its application to each particular area of the arts." In addition, the Appendix includes such valuable information as sample publishing contracts, performing rights agreements, and the Recommendations of the Paris, 1973, Working Group on Reprographic Reproduction of Copyrighted Works.

2. In French

274. Confédération Internationale des Sociétés d'Auteurs et Compositeurs. Vingt-huitième congrès. Paris, Secrétariat Général de la Confédération [1974], 287.

Minutes of the 28th Congress held in Mexico, October 16-21, 1972.

3. In Italian

275. CIAMPI, ANTONIO. La durée du droit d'auteur dans le cadre de l'intégration européenne. La durata del diritto d'autore nel quadro dell'integrazione europea. Milano, F. Vallardi [1974]. 241 p.

A treatise on movements toward prolongation of the term of copyright protection within the framework of European integration, both in national and international legislation, with a historical introduction.

B. LAW REVIEW ARTICLES

1. United States

276. Adherence of the U.S.S.R. to the Universal Copyright Convention: Defenses under U.S. law to possible Soviet attempts at achieving international censorship. *Cornell International Law Journal*, vol. 8, no. 1 (Dec., 1974), pp. 71-91.

Citing the possibility of administrative censorship as the most probable Soviet response to adherence to the U.C.C., this Note argues for amelioration of that problem by U.S. publishers forming their own agency to bargain on a more equal basis with VAAP.

277. BUNGEROTH, MARC R. K. Copyright—photocopying as fair use. *Boston College Industrial and Commercial Law Review*, vol. 16, no. 1 (Nov. 1974), pp. 141-150.

A note on the Court of Claims decision in the *Williams & Wilkins* case, 487 F.2d 1345 (Ct. Cl. 1973), 21 BULL. CR. SOC. 112, Item 102.

278. The convention relating to the distribution of programme-carrying signals transmitted by satellite: A potshot at poaching. *New York University Journal of International Law & Politics*, vol. 7, no. 3 [Winter, 1974], pp. 575-596.

This Note analyzes the history and results of the 1974 convention, concluding that "the nations represented were in no position to resolve the essentially inchoate problem of poaching" since "the problem of satellite signal piracy is still in its infancy."

279. Copyright—Sound Recordings—California statute prohibiting music piracy is a valid exercise of retained state powers and does not conflict with federal copyright protection. *Florida State University Law Review*, vol. 2, no. 3 (Summer 1974), pp. 614-625.

A note on the decision in *Goldstein v. California*, 412 U.S. 546 (1973).

280. EVANS, H. DUANE. Computer program classification: a limitation on program patentability as a process. *Oregon Law Review*, vol. 53, no. 4 (Summer 1974), pp. 501-531.

"This Comment examines the statutory and judicial standards controlling the patentability of a computer program and proposes a classification scheme based upon the characteristics and the end use of the program. Such a classification scheme should rationalize the selection of which programs are and are not patentable." The Comment is premised on the proposition that "the protections afforded by copyright and trade secrets law are too limited."

281. GOODWIN, BEVERLY B. Misappropriation: a retreat from the federal patent and copyright preemption doctrine. *Fordham Law Review*, vol. 43, no. 2 (Nov. 1974), pp. 239-257.

A review of the *Sears-Compco* and recent Supreme Court decisions in regard to the extent to which the patent and copyright clause of the Constitution and the federal patent and copyright laws limit state activity and of "the preemption problems involved, with particular emphasis given to the effect these problems have had upon the law of misappropriation."

282. Has the Russian bear been tamed? The implications of the Soviet accession to the Universal Copyright Convention. ([A.B.A.] Copyright Symposium, Aug. 14, 1974). American Bar Association. Section of Patent, Trademark and Copyright Law. *1974 Summary of proceedings*, pp. 215-240.

A panel discussion, moderated by E. Gabriel Perle. The speakers were: Bernard Korman, Charles H. Lieb, Jon A. Baumgarten, and Homer O. Blair.

283. KAUL, DONALD A. Case: copyright infringement. *Trial*, vol. 10, no. 6 (Nov./Dec. 1974), pp. 36-38.

A brief explanation of a copyright infringement action written for the trial attorney.

284. KEEGAN, ROBERT R. Some intelligence on intellectual property—an article on patents, trademarks and copyrights for general practitioners. *The Arkansas Lawyer*, vol. 8, no. 3 (July 1974), pp. 120-124.

A brief survey of the respective boundaries of patent, trademark and copyright protection.

285. PERWIN, JEAN S. Copyright—infringement—fraudulent material copyrightable. *Boston College Industrial and Commercial Law Review*, vol. 16, no. 1 (Nov. 1974) pp. 132-141.

A critical note on the decision in *Belcher v. Tarbox*, 486 F.2d 1087 (9th Cir. 1973), *digested in* 21 BULL. CR. SOC. 331, Item 306. A slightly different version of the note was submitted to the 1974 Nathan Burkan Memorial Competition.

286. PRASINOS, NICHOLAS. Worldwide protection of computer programs by copyright. *Rutgers Journal of Computers and the Law*, vol. 4, no. 1 (1974), pp. 42-85.

A conclusion is reached that "[a]lthough the scope of protection of copyright is not so broad as to proscribe the unauthorized use of ideas contained in the program, it can protect the tremendous creative skill and effort involved in the preparation of a computer program."

287. REISMAN, GLENN M. The war against record piracy: an uneasy rivalry between the federal and state governments. *Albany Law Review*, vol. 39, no. 1 (1974), pp. 87-117.

A discussion of "the judicial and statutory problems caused by record piracy and the lack of federal copyright protection before 1972," including an examination "of the federal and state cases which, with a notable lack of uniformity, have considered the constitutional question of federal preemption of copyright." An abridged version of this paper, entitled "The constitutional validity of state legislation concerning record piracy," won a prize in the 1974 Nathan Burkan Memorial Competition.

288. RINGER, BARBARA A. Luncheon address. American Bar Association. Section of Patent, Trademark and Copyright Law, 1974 *Summary of proceedings*, pp. 203-214.

The Register of Copyrights, in the address delivered on August 14, 1974, at a luncheon of Division III (Copyrights) gave an interesting insight into the past, present and future of the Copyright Office.

289. WEINTRAUB, HARRY. Exhibiting without copyright: the visual artist's dilemma. *Art & the Law*, Jan. 1975, pp. 1, 3.

A discussion of the lack of clarity in the copyright law in regard to whether the exhibition of an uncopyrighted work of art in a gallery or museum constitutes publication resulting in loss of valuable rights.

2. Foreign

1. In English

290. DITTRICH, ROBERT. The Brussels satellite convention. *EBU Review: Programmes, Administration, Law*, vol. 25, no. 6 (Nov. 1974), pp. 60-64.

An account of the content and scope of the new convention.

291. FRANÇON, ANDRÉ. Letter from France. *Copyright*, vol. 10, no. 12 (Dec. 1974), pp. 316-321.

A survey of judicial and international copyright developments in France since the publication of the author's last letter (*Copyright*, 1971, p. 173).

292. GAVRILOV, E. General study: organization of the office for the protection of copyright in the U.S.S.R. *Copyright Bulletin* (Unesco), vol. 8, no. 2/3 (1974), pp. 25-29.

The organization in the second half of 1973 of the Copyright Agency of the U.S.S.R., known by its Russian initials as VAAP.

293. LOEBER, DIETRICH A. Samizdat under Soviet law. The Hague, Martins Nijhoff [1974]. 39 p.

The Article is an offprint from *Contemporary Soviet Law: Essays In Honor of John N. Hazard*, ed. by Donald D. Barry, William E. Butler, and George Ginsburgs.

294. WALLACE, WILLIAM. Protection for designs in the United Kingdom. *IIC*, vol. 5, no. 4 (1974), pp. 421-427.

A German version appeared in 1974 GRUR Int. 403 under the title "Geschmackmusterschutz in Grossbritannien." See 22 BULL. CR. SOC. 226, Item 203.

295. WALTER, MICHEL M. Telediffusion and wired-distribution systems: Berne Convention and copyright legislation in Europe. *Copyright*, vol. 10, no. 12 (Dec. 1974), pp. 302-315.

An abridged version was previously published in *GRUR Int.*, no. 3 (Mar. 1974), pp. 119-127. See 21 BULL. CR. SOC. 363, Item 384 (1974).

2. In French, English & Spanish

296. A propos de l'adhésion de l'URSS à la Convention Universelle. *Revue Internationale du Droit d'Auteur*, no. 82 (Oct. 1974), pp. 66-149.

Three reports concerning the Soviet accession to the Universal Copyright Convention, submitted by their authors on the occasion of the Fourth Franco-Soviet Juridical Encounter, held in Moscow between June 3 and 14, 1974, under the auspices of the Society of Comparative Legislation. The first report is on copyright and the development of Franco-Soviet cultural, scientific and technical cooperation; the second is on copyright protection of Soviet works in France; and, the third is on the consequences for Soviet and French authors of the Soviet accession to the Universal Copyright Convention. *Contents*: 1. Le droit d'auteur et le développement de la coopération culturelle, scientifique et technique franco-soviétique, par Mark Mouseevitch Boguslavsky. 2. La protection par le droit d'auteur des oeuvres soviétiques en France, par André Françon. 3. Les conséquences pour les auteurs soviétiques et français de l'adhésion de l'URSS à la Convention universelle, par Andre Kerever.

297. IONASCO, AURELIAN. Le droit de repentir de l'auteur. *Revue Internationale du Droit d'Auteur*, no. 83 (Jan. 1975), pp. 20-55.

An article on the right of an author, notwithstanding transfer of exploitation rights to his work, even after publication, to "repent," that is, to rescind his contract, but thereby expose himself to the obligation of paying damages to the other party.

298. MATTHYSSENS, JEAN. L'obligation de représentation des titulaires de droits exclusifs. *Revue Internationale du Droit d'Auteur*, no. 83 (Jan. 1975), pp. 2-19.

The author maintains that, under the French copyright law, "in the field of performance contracts, the same principles are to be applied, *mutatis mutandi*, as those recognized in respect of musical publication." Accordingly, any transfer of an exclusive performance right which the transferee did not undertake to exploit was null and void.

299. PHILLIPS, JEREMY. Copyright: towards a positive approach? *Revue Internationale du Droit d'Auteur*, no. 82 (Oct. 1974), pp. 34-65.

The reader is taken on "a Cooks' Tour of the scarred battleground of copyright problems present and future," in which an effort is made "to apply the utilitarian techniques of the common law." The subjects covered are: the mode of protection, duration of protection, photocopying, copyright in computer programs, computer infringement of copyright, and library lending rights. The article is prefaced by a philosophical essay on "the nature of the British contribution to the cornucopia of legal [copyright] protection."

300. ROCHA, DANIEL. La nouvelle loi brésilienne sur le droit d'auteur. *Revue Internationale du Droit d'Auteur*, no. 82 (Oct. 1974), pp. 2-33.

The genesis, nature and analysis of the new Brazilian law on copyright and neighboring rights, which came into force on January 1, 1974.

3. In German

301. BRÜGGER, PAUL. Die Sowjetunion trat dem Welturheberrechtsabkommen bei; Bericht über die Sitzung der Schweizerischen Vereinigung für Urheberrecht vom 6. Februar 1974. *Schweizerische Mitteilungen über Gewerblichen Rechtsschutz und Urheberrecht*, 1974, no. 1, pp. 64-72.

A summary of the reports on the Soviet accession to the Universal Copyright Convention made at the February 6, 1974, meeting of the Swiss Copyright Association in Zurich.

302. MOVSESSIAN, VERA. Zum Abschluss urheberrechtlicher Gegenseitigkeitsverträge zwischen GEMA und sowjetischer Allunionsagentur für Urheberrechte; Anläufe und Grundlagen für eine vertrauensvolle Zusammenarbeit. *Film und Recht*, vol. 18, no. 12 (Dec. 15, 1974), pp. 770-774.

An article on the closing of an agreement, on July 11, 1974, retroactive to January 1, 1974, between the West German performing rights society, GEMA, and the newly formed Soviet copyright agency, VAAP, regarding the reciprocal payment of royalties for the exploitation of copyrighted works of each others' nationals.

303. PORTIN, GÖRAN. Zum Schutz von Computerprogrammen in Finnland. *Gewerblicher Rechtsschutz und Urheberrecht*, Int., no. 1 (Jan. 1975), pp. 19-21.

A comment on a Finnish Supreme Court decision of January 15, 1974, involving alleged copyright infringement of computer programs and breach of contract.

304. ROEBER, GEORG. Zum Thema: Urhebervertragsrecht; Arbeiten beim Institut für Film- und Fernsehrecht, Bericht. *Film und Recht*, vol. 18, no. 12 (Dec. 15, 1974), pp. 784-798.

An article on the progress and results of a meeting in Munich, on October 25, 1974, of a working group of the West German Institute for Motion Picture and Television Law, on the subject of contract law of the German Federal Republic, with emphasis on motion pictures and television. The report consists mainly of summaries of talks by Dr. Heinrich Hubman, Dr. Günter Hermann, Attorney Hans-Peter Hillig, and Dr. Gustav Brugger, and of the discussions which followed the talks.

305. WALTER, MICHEL M. Zur Revision de österreichischen Urheberrechts: Bemerkungen zum Entwurf einer österreichischen Urheberrechtsgesetz- Novelle 1974. *Gewerblicher Rechtsschutz und Urheberrecht*, Int., no. 12 (Dec. 1974), pp. 429-435; no. 1 (Jan. 1975), pp. 11-19.

A two-part article on a 1974 draft of a revision of the Austrian copyright statute. The first part is a commentary on the existing law, and the second part is an explanation of the proposed changes.

4. In Portuguese

306. VIERA MANSO, EDUARDO JOSÉ. Cessão dos direitos autorais. *Correio Braziliense* (Nov. 12, 1974), Sec. 2, pp. 8-9.

A comparison of the manner in which the rights to exploit or use a copyrighted work are treated under various foreign copyright laws and under the present Brazilian Copyright Law No. 5,988 of 14 December 1973 and its predecessors.

C. ARTICLES RELATING TO COPYRIGHT IN TRADE MAGAZINES

1. United States

307. BONGARTZ, ROY. Writers, composers and actors collect royalties—why not artists? *New York Times*, vol. 124, no. 42,743 (Feb. 2, 1975), sec. 2, p. 1, cols. 1-4; p. 25, cols. 1-8.

A case is made for the enactment of a federal law requiring resales of art works to include royalties to the artists, but a number of objections to the royalty idea on the part of dealers and collectors is given.

308. MITCHELL, BRIDGER M. Cable, cities, and copyrights, written in association with Robert H. Smiley. *The Bell Journal of Economics and Management Science*, vol. 5, no. 1 (Spring 1974), pp. 235-263.

"This paper examines the profitability of major market cable systems subject to the final FCC rules with particular attention to the effects of several copyright fee proposals, including one incorporated in pending legislation."

309. No deal in sight on copyright; broadcasters, cable operators argue over same old ground in FCC and federal bar symposium. *Broadcasting*, vol. 88, no. 10 (Mar. 10, 1975), pp. 40-41.

An article on a three-hour symposium, sponsored by the FCC and the Federal Communications Bar Association, and held on March 3, 1975, during which "[t]he conflict between broadcasters and cablecasters over the cable provisions in the Senate's copyright bill (S. 22) continued." Barbara Ringer, Register of Copyrights, "appealed for the two industries to support copyright revision 'with or without a cable section'."

310. Publishers respond to anti-trust suit; deny conspiracy in overseas sales. *Publishers Weekly*, vol. 207, no. 9 (Mar. 3, 1975), p. 20.

An article on the response of 19 of the 21 publishers to the complaint of the Antitrust Division of the Department of Justice charging them with "engaging in a combination and conspiracy in restraint of interstate and foreign commerce" in violation of the Sherman Act.

311. SCHWARTZ, ALAN U. Publishing détente in the time of VAAP. *Publishers Weekly*, vol. 207, no. 9 (Mar. 3, 1975), pp. 28-31.

It is maintained that "Soviet adherence to the U.C.C. has not changed Soviet policy with regard to its dissident writers but has merely provided the Soviets with additional potential tools of repression to be used against the communication of the ideas of these writers abroad." A conclusion is reached that if governments will not or cannot enforce the principles of the U.C.C. (article I, article III, clause 2, and article V, clause 1), then it will be up to authors and publishers to continue to do business with the Soviets "while at

the same time remaining firm in their commitment to principles of freedom of contract and expression."

312. THOMAS, ROBERT MCG., JR. Suspect in piracy of films is seized with 500 prints. *New York Times*, Feb. 20, 1975, p. 1, col. 3; p. 38, cols. 2-3 (city ed.).

An article on the arrest of a 57-year old Manhattan man described as "a major distributor of pirated motion pictures". The police called him "a 'chief operator' in a worldwide film piracy network said to cost the motion picture industry as much as \$50-million a year in lost sales."

313. TUSHER WILL. FBI agents set to run MPAA war on piracy. *The Hollywood Reporter*, vol. 235, no. 27 (Mar. 12, 1975), pp. 1, 13.

An article on the hiring of "[t]wo top FBI agents . . . to head the drive of the Motion Picture Assn. of America to plug up the estimated \$100 million annual loss suffered by major studios on pirated motion picture and television films."

314. TUSHER, WILL. Tough new anti-piracy bill lands in Assembly. *The Hollywood Reporter*, vol. 235, no. 5 (Feb. 7, 1975), pp. 1, 37.

An article on a new bill, aimed at increasing penalties for tape and record piracy (AB 684), which has been introduced in the California Legislature, and "would be tougher than the federal anti-piracy law that went into effect Jan. 1."

315. World-wide war on pix print pirates; U.S. loss a year up to \$700-mil. *Variety*, vol. 278, no. 2 (Feb. 19, 1975), p. 5, col. 2; p. 30, cols. 4-5.

An article on a private intelligence operation, known as the Print Security Office, being established in Hollywood by the Motion Pictures Association of America on behalf of its member companies. The security office will "assist worldwide police in tracking down and prosecuting feature film print pirates—who rob an estimated \$100,000,000 to \$700,000,000 in legitimate film revenues each year."

2. Foreign

1. In English

316. Addison-Wesley Publishing Company et al., *defendants*. "A combination and conspiracy"; publishers charged with violation of

Sherman Act. *The Bookseller*, nos. 3600 and 3601 (Dec. 21, 1974), pp. 2948-2949.

The text of the complaint charging a number of American publishers with violation of the Sherman Act, and naming the Publishing Association in London and publishing houses which are members of the association as co-conspirators. The basic charge is an alleged conspiracy by the defendants and co-conspirators "to divide the world market for book sales into exclusive territories and to allocate the exclusive territories among themselves."

317. FREEGARD, MICHAEL. Collective copyright licensing—surrender or safeguard? *The Author*, vol. 85, no. 4 (Winter 1974), pp. 141-148.

An attempt "to illustrate to authors how the 'collectivising' of their rights in certain limited, but important, spheres—far from constituting a threat to their economic, and ultimately their creative, freedom—in fact represents their best hope of economic survival in the modern world."

318. WIGHTMAN, G. B. H. The cassette revolution; an expert view of the cassette industry from the inside. *The Author*, vol. 85, no. 4 (Winter 1974), pp. 149-151.

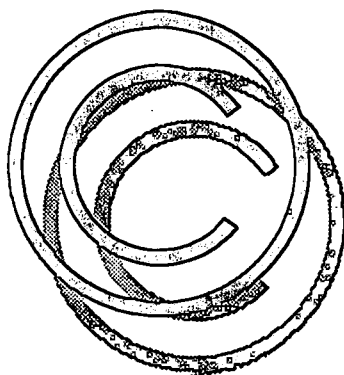
Includes some discussion of the economic effects of video cassette player/recorders on books and authors.

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319. REPORT OF THE PRESIDENT OF THE COPYRIGHT SOCIETY OF THE U.S.A. 1974-1975 (AS OF JUNE 1, 1975)*

By PAUL GITLIN

I. LEGISLATIVE DEVELOPMENTS

This report will include a rather brief review of the most significant legislative events which have occurred since last year's comprehensive report by my distinguished predecessor.¹ Developments since that time until a few months ago have been more fully reviewed in the "Letter from the United States" published in *Le Droit d'Auteur (Copyright)*, February 1975, and even more recently, in a report² by our Executive Director at CISAC. It should be pointed out that by far the most important event during the last year was the enactment by the Senate on August 9th of the McClellan bill, S. 3061, a complete copyright revision bill passed for the first time after a heated floor debate on five significant amendments on September 6 and 9, 1974.³ The final bill was passed on September 9 with a vote of 70 to 1, with some important changes from the earlier revision bill which had passed the House a few years ago. Since it was obvious that the House would have no opportunity to pass on the Senate version during the last Congress, it became necessary before the end of December to actually enact one partial amendatory bill.⁴ This was signed by President Ford, and it briefly embodies three important measures:

1. The Record Piracy Bill of 1971, which would otherwise have terminated on December 31, 1974, was extended permanently. The new enactment also increases the criminal penalties for infringement of copyrights in sound recordings.

2. All subsisting copyrights in their second term that would otherwise expire before December 31, 1976, are further extended so that they will continue in force through December 31, 1976. The extension is automatic and does not require any action in the Copyright Office. The new Act extends the total duration of those copyrights and of the renewal

*The views expressed in this report represent the personal views of the writer and not necessarily those of all officers or trustees.

¹ Reprinted in 21 BULL. CR. SOC. 289, Item 268 (1974).

² 22 BULL. CR. SOC. 1, Item 1 (1974).

³ CONG. REC., Sept. 6 and 9, 16064-75, 16146-86 (1974).

⁴ S. 3976 has been printed as Serial No. 59; the corresponding Hearing before the House Subcommittee on H.R. 13364 has been printed as Serial No. 40 under the heading "Extended Limited Copyright in Sound Recording".

copyrights scheduled to expire during 1975 and 1976, through the end of 1976.

3. The proposed National Committee on New Technological Uses of Copyrighted Materials was created in the Library of Congress. The purpose of the Commission is to study and provide data on the reproduction and use of copyrighted works, either in conjunction with automated information storage, processing, and retrieval systems or by various forms of machine reproduction, not including reproduction by or at the request of instructors for use in face-to-face teaching activities. The Committee is to report its findings and recommendations to the President and to the Congress within three years of enactment. A preliminary report is due within one year of the first sitting of the Commission. The President will appoint the members of the Commission, whose staff will be an administrative part of the Library of Congress.

As of the day of this report, no members of the National Commission have been appointed.

In conjunction with Senator McClellan, Mr. Kastenmeier (who remains Chairman and the only continuing member of the new House Subcommittee) also reintroduced a copyright revision bill on January 28, 1975. Moreover, since the McClellan Bill did not enact a royalty right for performing artists or the manufacturers of phonograph records, Senator Scott introduced S. 1111 separately on March 7, 1975. This will undoubtedly continue to create great controversy during the Congressional hearings.

S. 3976, as above mentioned, has already become the law.⁵

The Senate revision bill has been reintroduced by Senator McClellan in the 94th Congress on January 15, 1975 under S. 22; and the revised House revision bill was introduced by Congressman Kastenmeier in the 94th Congress under H.R. 2223.

The House subcommittee has already started hearings on H.R. 2223. These have been extensively commented upon in an article in *PTCJ*.⁶ I will therefore not burden this report with details of statements by those who have testified thus far; the testimony still shows that there is wide disagreement on such key issues as photocopying, the rights of educators, the so-called "neighboring" rights of performers and, of course, the unending controversy about proposed payments by CATV to copyright owners.

⁵ It may be found in Senate Hearing, Copyright Miscellany, before the appropriate Subcommittee of November 26, 1974 (Hearing before the Subcommittee on Courts, Civil Liberties, and the Administration of Justice of the Committee on the Judiciary, House of Representatives, 93rd Congress).

⁶ Published by the Bureau of National Affairs of May 15, 1975.

Hon. Barbara Ringer testified that: "A twentieth-century statute is long overdue in the United States, and the end for a revised law that will anticipate the twenty-first century is so obvious as to be undeniable."

The Acting Librarian of Congress also stated, *inter alia*: "H.R. 2223 does not provide all of the answers, but it does provide a modern framework for growth and change."

The State Department rightly objected to the retention of our present so-called manufacturing provisions as being "fundamentally inconsistent with basic U.S. policy in international trade." The Department added wisely that "the broad trading interests of the U.S. and its people . . . [are] best served by a general reduction of trade barriers." It was also pointed out that the special exception for Canada which is contemplated would violate this country's obligations under GATT. The Commerce Department generally approved the bill and likewise objected to the exclusion of Canada from the manufacturing provisions. The Department also proposed several important modifications of that part of the Bill (Title II) which deals with design protection.

The Department of Justice objected to any inclusion in the bill offering protection to ornamental designs. It also objected to Section 108 (the "fair use provision") as applied to librarians and others. It said, "to impose copyright liability impeding the storage of (research material, etc.) would be socially undesirable."

But most unexpectedly and regrettably, in the opinion of most of us, the Department objected to the proposed extension of the term of copyright to the author's life plus 50 years as being unnecessarily long, and it argued that Section 302 as written would go "far beyond the contemplation of the Framers of the Constitution." The Justice Department favors a term of 56 years or the life of the author, whichever is greater. It does however agree that the manufacturing clause "should be stricken from the bill." Other proposals by the Department not discussed here in detail refer to the enforcement of the federal laws against record piracy.

According to the just-published excellent *BNA* review of May 27, 1975, there have already been two further days of hearings devoted almost exclusively to the controversial subjects of use of copyrighted material by librarians and for educational purposes. As expected, there were wide differences of opinion. The librarians and educators asked for a wide range of "fair use" copying for library and educational purposes. Publishers and authors, on the other hand, speaking through the General Counsel of the Authors League, Irwin Karp, an old friend of our Society, Charles Lieb, our Trustee as Copyright Counsel for the book publishing industry, and numerous other witnesses, strongly objected to the educators' proposal. At the end of the two days of hearings, it was

announced that further hearings would be held on the issue of jukebox royalties, CATV, neighboring rights and other controversial issues. These hearings will be held on June 4, 5, 11, 12 and 19 and on July 9 and 10. Consequently, more conclusive reports on these matters may be expected in my annual report for 1976.

II. JUDICIAL DEVELOPMENTS

A few weeks ago there was announced a landmark decision by the Supreme Court in the *Williams & Wilkins* case which has already been comprehensively discussed in connection with the Court of Claims decision. The Court of Claims narrowly decided the legality of copying articles from medical journals in favor of the government. After receiving a considerable number of briefs *amicus curiae*, the Supreme Court, to the great disappointment of publishers and authors, upheld in a 4-to-4 decision the denial of copyright infringement. Justice Douglas, who was still present at the argument, participated in the opinion, while Justice Blackmun, although present at the oral argument, for personal reasons disqualified himself. Thus this all-important matter has been left in abeyance until the issue may be eventually dealt with by the Congress. In view of the great mass of literature—and indeed of a first volume specially devoted to this case—I will refrain in this report from further comment.⁸

The Supreme Court also, to the great disappointment of many copyright lawyers, further extended the protection of CATV owners against copyright owners even with regard to signals brought in from a distance.⁹

Finally, there has just been argued before the Supreme Court, but not yet decided, the important case of *Twentieth Century Music Corporation and Mary M. Bourne v. George Aiken*, in which the defendant restaurateur takes the position that the Supreme Court's famous *Jewel-Lasalle* decision¹⁰ has been overruled by its recent decisions on the community

⁷ The Court of Claims' decision was affirmed on February 25, 1975 and has not yet been officially reported.

⁸ See e.g., Goldstein, *The Private Consumption of Public Goods: A Comment on Williams Co. v. United States*, 21 BULL. CR. SOC. 204, Item 168 (1974).

⁹ *Teleprompter v. CBS*, 94 S.Ct. 1129, 181 U.S.P.Q. 65 (1975). The decision has been ably discussed and criticized in a lecture by our Assistant Treasurer, Richard Dannay, *An Overview of Teleprompter v. Columbia Broadcasting System, Inc. and Other Recent Developments—Omnibus Signal for Copyright Law*, 22 BULL. CR. SOC. 10, Item 2 (1974).

¹⁰ *Jewel-Lasalle Co. v. Buck*, 283 U.S. 202 (1931), which had held that transmission by loudspeakers of copyrighted music was an infringing "performance" for profit.

antenna problem, despite the fact that the Court never even mentioned the *Lasalle* case.

III. COPYRIGHT ADMINISTRATIVE PROPOSALS

We have reported in the past the retirement of George Cary as Register of Copyrights, and of Abe Goldman, formerly General Counsel of the Copyright Office, both of whom are this year also ending their valuable services to the Society. Fortunately for the Copyright bar, the Librarian of Congress before his own retirement appointed Barbara Ringer as Register of Copyrights. As we all know, she had already served the Office, the Bar generally and our Society in particular with unsurpassed distinction. She is now ably assisted by Ms. Dorothy Schrader as General Counsel and Mr. Hamilton as Assistant Register.

Under her leadership, negotiations were held with the Soviet Union after the accession of the latter to the UCC had been announced. This was reported upon at some length by my distinguished predecessor in our last annual report. Since that time, significant bilateral discussions have been held in Russia between the newly established Soviet agency and representatives of American book publishers, ASCAP, BMI, and other groups. The final outcome of all these negotiations is not altogether clear at the present time.

The Copyright Office also has under consideration a proposal to register original "type face" designs, as was more fully described in the Federal Register of November 18, 1974 (vol. 39, No. 223). Hearings were recently held by the Register with regard to this proposal, but no final decision was made at the time of this writing.

Finally, there is also under consideration a much debated proposal to deviate from previous practice and not treat the soundtracks of motion pictures as unpublished registrable works of music after the motion picture (including the track) has been generally published.¹¹

IV. SPECIAL ACTIVITIES AND EVENTS OF THE SOCIETY

Coming now to the activities of our Society, I am pleased to report as follows:

1. *Index*. I want to express renewed thanks to the Chairman of the Index Committee, our Vice President, Stanley Rothenberg. His and his Committee's activities have now resulted in final publication by our pub-

¹¹ See the comprehensive article by Dean G. Yuzek, *Publication and Protection: In Qualified Support of the Copyright Office Approach to Motion Picture Soundtracks*, BULL. CR. Soc. 19, Item 3 (1974).

See also, Sutak, *The Great Motion Picture Soundtrack Robbery*, *infra* p. 315.

lisher, Fred B. Rothman & Company, of a Cumulative Index covering volumes 1 to 20 (1953-1973). The Index offers a key to all major developments in copyright during the last two decades, and perhaps even more. While until now only leading articles could be found in the Index of Legal Periodicals, the user will now have access to administrative developments, both domestic and international. The Index, prepared by Meira Pimsleur, a professionally trained law librarian and editor (LAW BOOKS IN PRINT, etc.) includes not only an author index and a detailed subject index, but also all classifications of our BULLETIN (with the exception of the sections on bibliography which were too manifold to include). The Society is indebted, as it has been so many times before, to Harcourt, Brace & Jovanovich, which subsidized a substantial portion of the cost of publication.

2. *The Bulletin.* With regard to the BULLETIN itself, we remain, as always, indebted for valuable assistance to Mr. Fred B. Rothman as well as to the Librarian of the Copyright Office, Mr. Benjamin W. Rudd. Ben, unfortunately for us, will retire at the end of 1975. Barbara Ringer has already promised the Society the assistance of Ms. Wilma R. Davis, who originally prepared the Office's contributions and who has expressed willingness to resume this activity for the next few years.

Mention should also be made of the great assistance rendered to the BULLETIN continuously over past years by Ms. Dorothy Schrader, now General Counsel of the Copyright Office, not only for her own excellent articles but for her interest in bringing to our attention the writings of other outstanding members of the Copyright Office staff.

The Editorial Board has been enlarged by adding two copyright lawyers to its ranks, Mr. Richard Bennett and Mr. Martin Beran, both of the New York Bar. Our editorial policy has been changed in some significant respects, particularly with regard to the reporting of decisions. Concerning the BULLETIN as a whole, the Society has been most fortunate indeed to secure the services of Ms. Margaret F. Goldstein, who has continued to do a superb job in organizing the publication and bringing it out on time. She has been ably assisted by Ms. Carol Simkin, an associate of our former vice president, Alan Latman, whose firm, Cowan, Liebowitz & Latman has generously contributed a considerable portion of her retainer. Our thanks are due to both of them for their invaluable assistance.

3. *The Donald C. Brace Memorial Lecture.* As in the past, it has been possible, through the generosity of Harcourt, Brace & Jovanovich and Ms. Donna Ogilvie, the daughter of the late Donald C. Brace, to arrange for a lecture of extraordinary interest on domestic copyright. This year's lecture was given by William Jovanovich under the title, "Writing and Reading for Love and Money," published in our April 1975 BULLETIN. (It was also specially distributed in pamphlet form by Macmillan & Com-

pany.) The Brace Memorial Lecture was followed by a well-attended reception at the Time-Life Building. The Society is indebted to its Vice President, E. Gabriel Perle, for having made these arrangements as well as for the assistance by Charles B. Seton, Trustee and former Vice President, who also continues to arrange, together with our former President, Samuel W. Tannenbaum, the monthly lectures before the Copyright Luncheon Circle. In a special new series, The R. R. Bowker Memorial Lectures, sponsored by the R. R. Bowker Company, the first lecture was given earlier this year by The Hon. Barbara Ringer; it was entitled "The Demonology of Copyright" and is separately available from Bowker in pamphlet form.

4. *The Jean Geiringer Memorial Lecture.* Negotiations for the next lecture to be offered in the near future by an outstanding international authority are still continuing.

5. *Other Noteworthy Activities of Board Members, Officers and Editors.* Our former president and my immediate predecessor, Morton David Goldberg, will co-chair, with our Executive Director, a two-day Practising Law Institute symposium on copyright, to be held in July of this year. Many trustees of our Society, including your president, will participate.

While we have noted in the past with regret the retirement of Herman Finkelstein as General Counsel of ASCAP, we have now to express equal regret on the occasion of the retirement of another outstanding former president, Sydney M. Kaye. We are happy to learn, on the other hand, that our Trustee, Bernard Korman, to whom we owe so much, has in the meantime been appointed General Counsel to ASCAP and successor to Herman Finkelstein. He has already paid a visit to Russia for the purpose of negotiations with the newly created Russian copyright agency.¹²

I want to mention again the great loss the Society has suffered by the death of one of its founders, John Schulman.

6. *The CISAC Meeting.* At the annual meeting of CISAC only two weeks ago, many of our Trustees and members were present in Hamburg, Germany. Among them were our former presidents, Leonard Zissu and Sydney M. Kaye. The Legislative Committee of CISAC met separately in Madrid, and the usual annual report of our Executive Director was presented to the meeting. It has been published in the current issue of

¹² Talking about Russia, we should not leave unmentioned the book on United States and Soviet Copyright Relations by Mr. Jon M. Baumgarten, a member of our Editorial Board, who also recently offered a lecture on U.S.-Russian copyright relations at the American Bar Association meeting in Hawaii, which was particularly well received.

Interauteurs. Mr. Derenberg has since been reappointed to serve for another year as the United States delegate.

7. This report would be incomplete without mentioning the extraordinary success which our Board member, Ernest S. Meyers and his special counsel, Jules Yarnell, have had in their legislative and judicial fight in the record anti-piracy field. By the end of last summer, twenty-six states had adopted anti-piracy legislation, and many more have since followed. As already mentioned, the federal anti-piracy bill would have expired on December 31, 1974, but it applies only to recordings "fixed" after February 15, 1972. It becomes more and more apparent that, notwithstanding the Supreme Court's decision in the *Sears* and *Compco* cases,¹³ record piracy is considered an act of unfair competition under the theory of the *INS* case.¹⁴ Unauthorized dubbing of records will be considered an act of "misappropriation" and will not be subject, some isolated decisions to the contrary, to the compulsory license exception in Section 1(e) of the Copyright Law of 1909. Indeed, Senator Brock of Tennessee has just introduced S. 1782 which would so amend the Criminal Code as to put unauthorized taping in the same category as stolen automobiles or stolen securities.¹⁵ The Senator said, "the procedures are those with which every U.S. attorney is familiar."

8. Finally, I need not add that in these difficult times the office of Treasurer of our Society has been a particularly onerous one and that we owe a special vote of thanks to our treasurer, Alan J. Hartnick, who has generously agreed to serve in that capacity for another year.

9. The Society has now achieved such status that its cooperation is sought by numerous international organizations, including the Max-Planck Institute in Munich, WIPO in Geneva (recently declared a separate agency of the United Nations), and most recently, by a newly-formed organization entitled the International Copyright Institute, with headquarters at the University of Sao Paulo Law School in Brazil. The president of this Institute is Professor Antonio Chavez of the University of Sao Paulo, and the secretary is Dr. Natalio Chediak of Coral Gables, Florida. The Society has been invited to consider some form of membership in this institute, whose executive council includes the Hon. Barbara Ringer, Herman Finkelstein, and Walter Derenberg.

Close contact has also been established with the recently formed Australian Copyright Council. The Society is also following with some

¹³ *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp. v. Day-Brite Lighting, Inc.* 376 U.S. 234 (1964).

¹⁴ 248 U.S. 215 (1918).

¹⁵ According to *Billboard* of May 31, 1975.

concern the alleged anti-trust violations in the distribution of American books in England and in other English-speaking countries.

Let me conclude on the optimistic note that, despite the enormous economic and political difficulties of the United States, our Society has been able with your help not only to maintain its place but in some considerable respects increase its prestige both here and abroad. Thanks to the inestimable support given to the Society by New York University Law School, the School more and more becomes a national center of education in the copyright field, particularly since the appointment of Professor Alan Latman as Adjunct Professor (Prof. Latman argued the *Williams and Wilkins* case before the Supreme Court), and the continuation of the Advanced Seminar in Literary and Artistic Property, to which many of our officers and trustees have contributed at least one lecture annually for more than twenty years.

It is indeed most encouraging to observe the increasing significance which the subject of copyright now occupies in the curriculum of many leading law schools in the United States and elsewhere in the world.*

*See TEACHING OF THE LAW OF INTELLECTUAL PROPERTY THROUGHOUT THE WORLD (3rd ed., WIPO, 1972).

PART I.**ARTICLES**

Because of the exceptional depth and quality of the following paper, the Editorial Board has decided to publish it in full.

320. THE GREAT MOTION PICTURE SOUNDTRACK ROBBERY

By KEN SUTAK

INTRODUCTION

The status of the motion picture soundtrack within copyright law, not yet judicially settled, has lately emerged more indistinct than ever it was before the current commercial fascination with vintage film music tracks and film dialog tracks took substantial root. Until recent writings on the subject began to sprout suggestions or insistences that the king has no clothes, motion picture attorneys had long thought the film soundtrack to be fully protected under the grant of motion picture copyright. With genuine assault upon that fairly orthodox assumption now under way, the protectionist assumption can hardly be called orthodox at the present time. Altogether, the greatest mischief has been made of the matter, such that the matter itself has become a multi-leveled mess. Not surprisingly, motion picture attorneys, motion picture makers, and law enforcement authorities are very confused and/or very frightened, for the dimensions of the mischief-making are unprecedented, as to both their interrelationship and the necessity for their dual resolution.

There is first that branch of mischief wherein legal commentary has plunged dangerously into an intellectual affair with fallacy. One commentator has insisted that "the copyright statute is inapplicable to motion picture sound tracks" and "[n]o amount of mental or semantic effort will accommodate sound tracks to the present copyright law."¹ Another commentator, somewhat more charitably, rationalizes an accommodation of that law to the film dialog tracks while positing a theory which, if sustained, would force the fall of thousands of film music

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¹ Brylawski, *Copyrightability of Motion Picture Sound Tracks*, 18 BULL. CR. SOC. 357, 370 (1971). [hereafter, Brylawski.]

² Yuzek, *Publication and Protection: In Qualified Support of the Copyright Office Approach to Motion Picture Soundtracks*, 22 BULL. CR. SOC. 19 (1974). [hereafter, Yuzek.]

tracks into the public domain.² The anti-protectionist attack has been directed against the embrace by Professor Nimmer, the United States Congress, the Copyright Office, and the motion picture industry, of the theory that "the express statutory recognition of copyright protection for motion pictures must be deemed to include the vital element of sound as contained therein"³ Reasonably proper treatises and relevant cases have been culled and confronted in arriving at the anti-protectionist conclusions, to be sure. Yet settled motion picture history has been rewritten, orthodox motion picture theory has been disregarded, general motion picture industry practice has been misread and misrepresented, long established motion picture making techniques have been confronted with ignorance or not confronted at all, and the scan of the legislative histories has been as halting as the reading of relevant case law has been superficial. These lapses are serious, and they color the deviating conclusions to the point of unacceptability.

There is next that branch of mischief wherein anti-protectionist theory has been carried to the live and logical end of the great danger it presents. The world of record piracy needs no introduction here; the intricacies of that parasitic network have been well explored elsewhere and are generally understood by those who care.⁴ What is not so well known, however, is that the most brazen element of the national pirate fraternity has in recent years been energetically devoted to appropriating and marketing—with burgeoning financial success—precisely what anti-protectionist theory would allow to be taken legally: the music tracks and/or the dialog tracks of most motion pictures produced during the era of sound-on-film. The current confusion in legal theory as to the protection accorded motion picture soundtracks in copyright law has not gone unnoticed by the pirates. Domestic soundtrack piracy—well organized, large scale, still growing rapidly, yet unresisted by force of law, and operating with such promotions as "[t]he legal staff of the manufacturer stated that this recording does not violate U.S. copyright requirements"⁵—is, in fact, virtually the only species of record piracy in which record pirates, record bootleggers, and record counterfeiters expect to and do operate openly, both on a national level and in accord with distribution methodologies and financing arrangements so unique as to be elsewhere unknown.

³ 1 M. NIMMER, NIMMER ON COPYRIGHT 111-12 (rev. ed. 1974). [hereafter, NIMMER]

⁴ See Yarnell, *Recording Piracy Is Everybody's Burden: An Examination of its Causes, Effects, and Remedies*, 20 BULL. CR. SOC. 234 (1973).

⁵ See note 221 *infra*.

With this strange intertwining of promulgated theoretical sanction and proliferating physical expropriation now imbedded in our legal concern and in our economic concern with motion picture property, a collision course appears to have been charted which may well lead to the first frontal judicial consideration of the long dormant soundtrack copyrightability issue. The dominant purpose of this analysis is to unravel the legal confusion stirred and to undo the theoretical damage wrought. For it must be fact rather than fallacy, logic as opposed to antilogy, and a structurally harmonious perception of the relevant copyright law which neither breeds new confusions nor raises old problems into new prominence, that predicate whatever authoritative construction lies ahead regarding the precise reach of motion picture copyright.

Moreover, if the theoretical license of concern may be stripped of its analytical moorings, then the parameters and pitfalls of the collision course itself must be traced, analyzed, and fully understood. That charge rises if soundtrack piracy is to be effectively eradicated; thus, that charge rises as an ancillary purpose of this analysis. For if the motion picture soundtrack may be identified as protected by motion picture copyright, then, the implications of *Goldstein v. California*⁶ notwithstanding, the illicit soundtrack record product may be identified as occupying a unique position in the relationship of federal copyright law to state anti-piracy laws, such that the *same* piratical product or activity often may be brought simultaneously within the jurisdictional purviews of *both* the federal and the state criminal authorities.

It is, altogether, a copyright problem which can be settled only when the legal analyst borrows from the tools of the film historian, the musicologist, the psychologist, and the journalist, while employing more familiar insights in burrowing to the crux of copyrightability itself. The solution to the soundtrack problem lies necessarily within such a maze, and a journey through such a maze might best begin by identifying both the range of the problem and those attending technical and legal considerations that shape its solution.

1. THE SOUNDTRACK COPYRIGHTABILITY CONFLICT

(A) *The Motion Picture Soundtrack: Technical Identity and Legal Vulnerability*

To begin with, two things must be recognized, for they bear importantly on subsequent analysis.

⁶ 412 U.S. 546 (1973).

1. First, the motion picture soundtrack as a physical entity is, technically, a piece of film which contains the sound portion of a motion picture. As such, it is one half of any motion picture produced during the sound-on-film era; the second half consists of another piece of film which contains the photographic portion of a motion picture. The motion picture property, then, is a visually appreciable unity comprised of two integrated pieces of film. If the photographic piece of film (the visual track) and the sound piece of film (the soundtrack) are separated, the former still lends itself to some visual appreciation, but the latter does not.

The isolated soundtrack actually consists of a number of soundtracks which have individual identities. The unified soundtrack is born in the process known as dubbing. In dubbing, all of the sound elements to be employed in the film, which may be spread over as many as several dozen individual soundtracks, are combined into a single soundtrack by recording all of the individual soundtracks concurrently. For instance, in any given motion picture, the final soundtrack will generally have been produced by combining several dialog tracks, from three to thirty music tracks, and from ten to twenty sound effects tracks.⁷

In the discussion which follows, usage of the term "soundtrack" refers to the final soundtrack produced by the synthesis of all individual soundtracks. When the dialog tracks, the music tracks, or the sound effects tracks are intended to be considered separately, they are noted specifically. It is also important to note that the music tracks contain the underlying film music of a motion picture, while the dialog tracks contain the underlying dramatic work of a motion picture.

2. Second, identification of the legal vulnerability of the motion picture soundtrack is necessary, if only to fully understand the consequences of soundtrack uncopyrightability. It is quite incorrect to suggest, as at least one anti-protectionist commentator has done,⁸ that there has ever been anything like an "industry practice" by which motion picture companies have sought to protect the film music heard on their music tracks independently or in lieu of whatever protection is afforded by motion picture copyright. It is more correctly the case that where motion picture companies have perceived some commercial value in musical themes, songs, or other musical compositions contained within their music tracks, then, and only then, have these isolated musical compositions been treated

⁷ Gold, *Ernest Gold on the Mechanics of Scoring*, in T. THOMAS, MUSIC FOR THE MOVIES 26, 29 (1973).

⁸ Yuzek, *supra* note 2, at 26.

apart from the motion picture copyright, by lending them separate notice and registration.⁹

For the vast majority of motion pictures made in this country since the era of sound-on-film began, such commercial perception has not occurred, and separate registration has been the exception, not the rule. Almost all of the original film scores composed during the 1930s and 1940s, as well as most of those composed during the 1950s and 1960s, were deemed inherently non-commercial save for their theatrical function in movie theaters. Hence, tens of thousands of hours of motion picture music are protected, if at all, only by grant of motion picture copyright.¹⁰

Similarly, motion picture screenplays were and are very rarely copyrighted as dramatic compositions apart from the protection afforded by grant of motion picture copyright.¹¹ Thus, the story-telling elements or dramatic works which inhere in the dialog tracks of thousands of motion pictures are protected, if at all, only by grant of motion picture copyright.¹²

(B) *The Protectionist Claim*

Since there is no judicial decision holding the motion picture soundtrack protected by motion picture copyright, protectionist theorists have extrapolated their views from a number of judicial and legislative developments which, combined, lend weight to an assertion of soundtrack

⁹ So long as the Copyright Office maintained a neutral position on the copyright status of film soundtracks (see text accompanying notes 39-44 *infra*), separate treatment of film music could be granted via section 12 registration as unpublished musical works, either before or after release of the motion picture. Section 5(e) registration was alternatively permissible once film music was separately published.

¹⁰ See Bernstein, *Collection News*, FILMMUSIC NOTEBOOK, Autumn, 1974, at 3, 4. Note that "most of the materials, that is, scores and parts (for the musicians) of motion pictures made before the 1950's, have either been destroyed, lost, or stored in such a way that it is impractical to attempt to retrieve them." *Id.* Hence, not only have most film scores not been separately registered in printed form, most of them no longer exist in printed form.

¹¹ Under a Copyright Office position of neutrality, the film screenplay manuscript, rather than its embodiment on film, could be registered in section 5(d) as a dramatic composition, or in section 12 as an unpublished dramatic composition. The registration could be made in section 5(c) as an address prepared for oral delivery if the manuscript contained only the words spoken on the film soundtrack. See A. LATMAN, *HOWELL'S COPYRIGHT LAW* 37 (rev. ed. 1962). [hereafter, LATMAN.]

¹² NIMMER, *supra* note 3, at 114.

copyrightability. Perhaps the best summary of the protectionist theory to be found in the treatises is Professor Nimmer's presentation:

It would seem more realistic to recognize that "talkies are but a species of the genus motion pictures" and that indeed "talkies" or sound motion pictures have become virtually the only form of motion pictures now being produced. Therefore, the express statutory recognition of copyright protection for motion pictures must be deemed to include the vital element of sound as contained therein, and that to that extent Congress has modified the then extant general principle of denying copyright to sound recordings.¹³

This statement is not devoid of difficulties, as the motion picture classifications were added to the federal copyright law by the Townsend Amendment¹⁴ in 1912, a time substantially predating the technological attachment of film soundtrack to film visual track. Nimmer argues that the congressional modification alluded to above flows from the reasonable meaning of the statutory language rather than from any analysis of legislative intent.¹⁵ The assumed irrelevance of the latter, as well as an isolation in time of the sound-on-film era without regard to the possible relevance of historical precedents, has been characteristic of the protectionist theory.

The protectionists instead support a "reasonable meaning" argument by drawing arrows from a legal quiver of a wholly different sort—the doctrine known as "species of the genus". According to this doctrine, a later-appearing "species" is sought to be protected in a federal statutory sense by reach of the antecedent copyright recognition extended to an invisibly pregnant "genus". The "species of the genus" doctrine first emerged judicially in a motion picture soundtrack setting in *L.C. Page v. Fox Film Corp.*,¹⁶ and then only in dictum:

The development of mechanism making it possible to accompany the screen picture with the sound of spoken words was but an improvement in the motion picture art. As the plaintiff well says, "talkies" are but a species of the genus motion pictures; they are employed by the same theaters, enjoyed by the same audiences, and nothing more than a forward step in the same art. Essentially the form and area of exploitation were the same. The mere fact

¹³ *Id.* at 111-12.

¹⁴ Act of Aug. 24, 1912, 37 Stat. 488.

¹⁵ NIMMER, *supra* note 3, at 112 n. 466.

¹⁶ 83 F.2d 196 (2d Cir. 1936).

that the species "talkies" may have been unknown and not within the contemplation of the parties in their description of the generic "moving pictures" does not prevent the latter from comprehending the former.¹⁷

Despite the *Page* court's application of the "species of the genus" doctrine in dictum, this application has been cited with approval in one other case,¹⁸ and anti-protectionist theorists have been unable to refute its logical relevance to the issue of soundtrack copyrightability.¹⁹ The *Page* court spoke while construing the assignment of "exclusive motion picture rights." As one commentator has accurately noted, the issue of soundtrack copyrightability was not involved in the case and was probably removed from the court's thinking.²⁰ That hardly settles the matter, however, and even another anti-protectionist commentator concedes the transposition to and sustenance within a federal copyrightability setting of the "species of the genus" doctrine.²¹ Yet the matter still remains alive, its heart carried in the question of *what to do* with the doctrine when approaching copyrightability analysis.

Three major developments occurred after the *Page* decision to buttress both the ranks of the protectionists and the conceptual support of their argument. None of these was judicial in setting, and all were logically derived.

1. The first development arose out of the legislative proposals made in 1952 to amend the copyright law so that the United States could participate in and comply with the provisions of the Universal Copyright Convention. Article I of the Convention states the protectionist philosophy of the Convention in terms of "cinematographic works" where motion pictures are concerned.²² During the hearings on the amendments before the Senate Subcommittees on Foreign Relations and the Judiciary, several motion picture companies objected "that the motion picture industry would suffer serious prejudice from acceptance of the

¹⁷ *Id.* at 199.

¹⁸ *Jerome v. Twentieth Century Fox-Film Corp.*, 67 F. Supp. 736, 742 (S.D.N.Y. 1946), *aff'd*, 165 F.2d 784 (2d Cir. 1948).

¹⁹ This inability arises because the *Page* court, in construing the words of a contract, analogized to the statutory construction case of *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911), where the "species of the genus" doctrine was applied in a motion picture context. See text accompanying notes 126-28 *infra*.

²⁰ Brylawski, *supra* note 1, at 358.

²¹ Yuzek, *supra* note 2, at 32.

²² Article I, Universal Copyright Convention.

convention by the United States."²³ One specific objection made was "that the convention does not protect acoustic works such as the soundtracks of motion pictures."²⁴

As the Senate Judiciary Committee report made clear,²⁵ other testimony given during the hearings, together with statements received thereafter from spokesmen for other motion picture companies, did not support the apprehensive claims.²⁶ Nevertheless, the fears of five motion picture companies were not allayed until a communication²⁷ from the Register of Copyrights to the chairman of the Senate Judiciary Committee was made available to attorneys representing the objecting companies. This communication relayed the following information.

The precise problem of soundtrack protection by means of the protection accorded "cinematographic works" by the Convention had been submitted in May, 1954, to the interim Inter-Governmental Copyright Committee,²⁸ convened pursuant to a resolution adopted by the Conference at Geneva, at a meeting of the interim committee held in Paris.²⁹ It had been the unanimous finding of the interim committee that:

²³ S. Rep. No. 1936, 83d Cong., 2d Sess. 10 (1954).

²⁴ *Id.*

²⁵ *Id.*

²⁶ Samuel W. Tannenbaum, representing the Copyright Association of America, appeared before the Subcommittees and expressed the opinion that "a motion picture film including the sound track either separately or as a whole, whether it be deemed a published or unpublished work, has protection under the Convention." Tannenbaum, *The Principle of 'National Treatment' and Works Protected*, in *UNIVERSAL COPYRIGHT CONVENTION ANALYZED* 13, 18 (T. Kupferman & M. Foner, eds., 1955). [hereafter, Tannenbaum.] See *Hearings on S. 2559 Before the Subcommittees on Foreign Relations and the Judiciary of the Senate*, 83d Cong., 2d Sess. 64 (1954). [hereafter *1954 Hearings*]. The same view was expressed in a report prepared by the American Bar Association which was "overwhelmingly approved by the patent, trade-mark, and copyright law section of the American Bar Association at its annual meeting in Boston during August 1953." S. Rep. No. 1936, 83d Cong., 2d Sess. 11 (1954). See ABA, *REPORT OF THE COMMITTEE ON INTERNATIONAL COPYRIGHTS*, in *1954 Hearings* 193, 201-02. Other spokesmen, appearing as counsel for independent motion picture companies, expressed similar views, e.g., that "the sound track which is a part of a motion picture and which is presently protected will not be thrown into the public domain by any provision or application of the UCC." Statement of Adolph Schimel in Support of Executive M, and S. 2559, in *1954 Hearings* 188, 190.

²⁷ Letter from Arthur Fisher to Senator Alexander Wiley, June 8, 1954, in *1954 Hearings*, *supra* note 26, at 206.

²⁸ The Committee was comprised of five foreign delegates and Arthur Fisher, the United States Register of Copyrights. Tannenbaum, *supra* note 26, at 17.

²⁹ S. Rep. No. 1936, 83d Cong., 2d Sess. 10-11 (1954).

Cinematographic works are provided for in [Article I] as forming a unified whole. In the case of a sound film (and these films were practically the only ones to be shown in cinemas at the time the Universal Convention was signed, 6 September 1952) the cinematographic work as such covers not only the part thereof comprising images but also sound.³⁰

This finding of the interim committee was not offered as an official interpretation of the Convention's substantive treatment of motion pictures, but rather as the response of "individuals experienced in copyright and participants in the development of the Universal Copyright Convention."³¹ Still, the opinion carried great weight with the Senate Judiciary Committee and the motion picture companies. The Committee, noting the express repudiation of the contrary view by the American Bar Association,³² stated: "The opinion makes it abundantly clear that nothing in the present convention will result in the loss of any protection for the integrated sound portion of a motion picture which it now enjoys."³³ Prior to the submission of the Committee's report, attorneys representing the concerned companies formally withdrew their objections in a letter also stating:

Each of us and the copyright counsel of our respective corporations are of the considered opinion that the present United States copyright law protects the sound and other parts of a motion picture as a unified whole. We are informed that counsel for other American producers of sound motion pictures are of the same opinion.³⁴

2. That the United States Congress agreed with this view as early as 1954 was amply demonstrated in 1971 when Congress passed the Sound

³⁰ Letter from Professor Henri Puget to Luther Evans, May 20, 1954, in S. Rep. No. 1936, 83d Cong., 2d Sess. 11 n.1 (1954).

³¹ *Id.*

³² ABA, REPORT OF THE COMMITTEE ON INTERNATIONAL COPYRIGHTS, in 1954 *Hearings*, *supra* note 26, at 193.

³³ S. Rep. No. 1936, 83d Cong., 2d Sess. 11 (1954). Note that the Committee's statement can be read as saying that "no protection for the integrated sound portion of a motion picture will be lost because no protection is now enjoyed." However, even the intimation of that notion by the Committee would have caused an uproar in the motion picture industry, so there is little doubt that the Committee's view on soundtrack protection in the United States was positive.

³⁴ Letter from Austin Keough to Senator Alexander Wiley, June 8, 1954, in 1954 *Hearings*, *supra* note 26, at 207, 208.

Recording Act,³⁵ which may be identified as the second non-judicial development partially based upon and altogether supportive of protectionist theory. The amendment excludes from its coverage "sounds accompanying a motion picture".³⁶ The report of the House Judiciary Committee discusses the derivation of such treatment as follows:

In excluding "the sounds accompanying a motion picture" from the scope of this legislation the Committee does not intend to limit or otherwise alter the rights that exist currently in such works. The exclusion reflects the Committee's opinion that soundtracks or audio tracks are an integrated part of the "motion pictures" already accorded protection under subsections (1) and (m) of Section 1 of title 17, and that the reproduction of the sound accompanying a copyrighted motion picture is an infringement of copyright in the motion picture. This is true whatever the physical form of the reproduction, whether or not the reproduction also includes visual images, and whether the motion picture copyright owner had licensed use of the soundtrack on records.³⁷

Thus, the Committee essentially reiterated what had earlier been postulated—that the statutory copyright accorded motion pictures must be reasonably deemed to embrace the later developed soundtrack, with the preceding congressional policy of denying copyright to sound recordings being seen as modified by the dual impact of technological circumstance and legal implication. The Committee did not, however, deal directly with either the film music underlying the film music tracks or the film dramatic work underlying the film dialog tracks. Nor had protectionist theorists much confronted these ancillary issues previously, except to assume implicitly, in accord with the statutory recognition that a copyright shall protect all of the copyrightable component parts of a work copyrighted,³⁸ that a motion picture copyright protecting the soundtrack would also protect the film music and the film dramatic work underlying the music tracks and the dialog tracks, respectively, from which the soundtrack itself had been constructed.

³⁵ Act of Oct. 15, 1971, 85 Stat. 391.

³⁶ The Sound Recording Act provides for the copyrightability of sound recordings, which are defined as "works that result from the fixation of a series of musical, spoken, or other sounds, but not including the sounds accompanying a motion picture." Act of Oct. 15, 1971, 85 Stat. 391, *amending* 17 U.S.C. §26.

³⁷ 117 Cong. Rec. 1566, 1570-71 (1971).

³⁸ 17 U.S.C. §3.

3. However, administrative attention to these issues and to the parent issue as well arrived swiftly once the Sound Recording Act became effective.³⁹ The amendment presented a number of sound recording registration problems for the Copyright Office. One of these was the question of what to do with recordings submitted for registration and identified as soundtrack albums.⁴⁰ The direction of the administrative inquiry elected was toward whether the sounds of the submitted article were originally fixed in a motion picture soundtrack and first published by distribution of the integrated motion picture.⁴¹ Notwithstanding the divergence of decisions⁴² as to whether or not the lease, exhibition, or release of a motion picture constitutes a publication of the motion picture, the procedural administrative inquiry necessitated by the Sound Recording Act with respect to registration of soundtrack albums also mandated the establishment of a symmetrical administrative policy with respect to registration of the underlying film music. The Copyright Office's position on the copyright status of motion picture soundtracks had formerly been neutral,⁴³ but the spur provided by the new procedural necessities made elimination of this neutrality a necessity itself. Whereas applications for unpublished copyright in musical compositions appearing on the soundtracks of distributed motion pictures had formerly been accepted by the Copyright Office, this policy was suddenly reversed, with the Copyright Office taking "an affirmative position that a sound motion picture is an

³⁹ The provisions for copyrightability of sound recordings in the Sound Recording Act took effect on Feb. 15, 1972.

⁴⁰ Keziah, *Registration Problems Encountered by the Copyright Office Under the Recent Sound Recording Amendment*, 20 BULL. CR. SOC. 3, 13 (1972).

⁴¹ *Id.*

⁴² The assumption has always been that commercially leased motion pictures are published, upon analogy to *Jewelers' Mercantile Agency Ltd. v. Jewelers' Weekly Pub. Co.*, 155 N.Y. 241, 49 N.E. 872 (1898) (commercial leasing of books to subscribers constitutes publication). See also: *Patterson v. Century Productions, Inc.*, 93 F.2d 489 (2d Cir. 1937), *cert. denied*, 303 U.S. 655 (1938) (limited, non-commercial exhibition of motion picture does not constitute publication); *Blanc v. Lantz*, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949) (musical laugh recorded on motion picture soundtrack and distributed via commercial leasing of motion picture is published, under state law defining publication, so as to divest common law rights). *Contra*, *Brandon Films v. Arjay Enterprises*, 33 Misc. 2d 794, 230 N.Y.S.2d 56 (1962) (general, commercial exhibition of motion pictures does not constitute publication). Note that the state statute involved in *Blanc* has since been repealed, and that the investiture of statutory rights via publication was not an issue in the case.

⁴³ Letter from Barbara Ringer to Dean Yuzek, April 29, 1974, in Yuzek, *supra* note 2, at 20 n.4.

entity, that copyright in a motion picture extends to all-copyrightable component parts of the motion picture including those reproduced on soundtrack"⁴⁴

If the implication born of the wedding of protectionist theory with legislative sanction was not to remain administratively unattended for long, neither would an administrative effort to adjust a procedural inattentiveness of an earlier era, in view of its dislocating thrust,⁴⁵ escape criticism. One critic of the Copyright Office's action in this regard summarizes the theoretical parameters of that action as follows:

... the Copyright Office has adopted the position that motion picture release is not only divestive of common law protection of film music but is also capable of resulting in the investiture of statutory protection. The Copyright Office suggests that in order to protect their rights in film music, music publishers rely on the principle that the motion *picture* copyright includes, and therefore affords protection to, such film music.⁴⁶

The statement would appear to be correct on its face as to the current Copyright Office position on soundtrack protection. It is to be noted, though, that any suggestion that the Copyright Office's proposed reliance is something *new* as to a general industry reliance *in fact* is decidedly specious. The vast preponderance of film music written during the sound-on-film era has been treated by motion picture companies exactly as the Copyright Office now insists that it be treated—as protected by motion picture copyright and nothing more.⁴⁷ The Copyright Office

⁴⁴ *Id.*

⁴⁵ Although most film music had never been separately registered, the film music which had been separately registered comprised enough of a publishing activity to generate confusion among publishers of film music when the Copyright Office changed its practices. See Yuzek, *supra* note 2, at 26.

⁴⁶ Yuzek, *supra* note 2, at 1-2. (emphasis in original).

⁴⁷ This insistence operates only once the motion picture is commercially released and thereby published. Copyrighting printed versions of the film screenplay or the film music as section 12 unpublished works is still possible. Such pre-copyrighting via section 12 is, in fact, the solution urged by anti-protectionist theorists to prevent what are claimed to be otherwise unprotected film materials inhering in the film soundtrack from falling into the public domain. Brylawski, *supra* note 1, at 368; Yuzek, *supra* note 2, at 42. Since section 12 pre-copyrighting of current film materials of this nature, and even a prospective judicial application of anti-protectionist theory with regard to post-release copyrighting of these film materials in the past, would do nothing to prevent the vast preponderance of all such materials from falling into the public domain if anti-protectionist theory is judicially adopted, the anti-protectionist "solution" emerges at best as icing without the cake.

action, then, actually does little more than administratively affirm the theoretical base of a general, industry-wide practice which was ingrained long before the *Page* court, the Congress, and finally the Copyright Office itself, embraced a protectionist posture. Whether the protectionist voices have been correct, of course, is another matter, and one which subsequent analysis shall penetrate.

A number of loose analytical ends do emerge from what has been offered here as a summary of the protectionist claim as yet enunciated and of what is largely its extra-judicial direct support. Generally, these may be best identified within the realm in which they have received their most searching attention—that of anti-protectionist thought. However, mention may be made here of one issue which need not be resurrected as a point of contention germane to the issue of soundtrack protection—publication of the motion picture itself. That issue has arisen because the procedural symmetry which inheres in the Copyright Office's twin policies toward registration of soundtrack album recordings and registration of film music underlying film music tracks has been derived by positing a substantive symmetry between motion picture publication and functional protection of the soundtrack and its underlying elements. That there is considerable authority in support of the Copyright Office's position on motion picture publication has been urged and amply demonstrated elsewhere⁴⁸ and even within the context of anti-protectionist argument.⁴⁹ Hence, the issue need not be directly confronted here, though certain of its legal underpinnings carry relevant import to the issue of protection and must be considered accordingly.⁵⁰

More importantly, "the ability to sustain the Copyright Office position on protection of the soundtrack would render its approach to divestive publication consistent with the symmetrical theory of copyright publication and protection . . ."⁵¹ This result, in the context of anti-protectionist argument, has been claimed to be "not mandated by law but equally satisfying nonetheless."⁵² Since it is through the identification and untying of those "loose analytical ends" of the protectionist claim that the fabric of protectionist theory may be wholly undone or reinforced, it is to the thrust of anti-protectionist theory that we now look.

⁴⁸ NIMMER, *supra* note 3, at 216-17.

⁴⁹ Yuzek, *supra* note 2, at 22-24.

⁵⁰ Since the anti-protectionists link cases dealing with the publication of music via distribution of phonograph records with authorities supporting motion picture publication, they proceed to equate phonograph records with motion picture soundtracks. For a consideration of this attempted equation, *see* text accompanying notes 63-73 *infra*.

⁵¹ Yuzek, *supra* note 2, at 30.

⁵² *Id.*

(C) *The Anti-Protectionist Attack*

The promulgation of anti-protectionist theory has been as splintered as the derivation of protectionist rationale has been logically uniform. While protectionist voices have remained congruent as to conceptual push, anti-protectionist tracts manifest some disagreement even while assailing the protectionist reasoning. Nevertheless, whether the consequence of a particular attack be the toss into the public domain of part or of all of the motion picture soundtrack and its underlying elements, anti-protectionist theorists share a strategical kinship through which the body of protectionist theory is penetrated and dealt its intended death blows not at its ideological jugular, but at its ramificatory veins.

Here, at least, the issue of the direction of legislative intent, so indelicately sidestepped by Professor Nimmer and others in traveling to an embrace of "species of the genus", is fully hauled into prominence. The impact of the asserted inability to bind an original legislative intent to the "reasonable meaning" thesis is by no means claimed to be devastating. However, it is suggested to be detrimental:

The Act of August 24, 1912 amended the copyright law to embrace for the first time copyright in motion pictures. Such motion pictures at that time, of course, were only silent motion picture productions and "talkies" were not even in contemplation. . . .

Some sixteen years later when sound motion pictures were made, first by the addition of a recording disc and subsequently by means of a sound track affixed to the film itself, the question became real whether the sound track was a copyrightable component of the entire motion picture production.

That a sound track is not a copyrightable component of a motion picture derives partly from the fact that sound tracks as adjuncts to motion pictures were not in existence or contemplation at the time of the 1912 Act and, hence, it could not have been the intention of Congress to have included sound tracks at that time.⁵³

That protectionist voices have not quarreled with this historical summary has been noted; that this historical summary has been accepted as an axiom from which springs further penetration into the protectionist claim is also evident. Thus, a devoted attention has been paid to the level of legal thought to which the absence of an original legislative intent leads: the "species of the genus" doctrine. What the protectionists have gripped on an *a priori* basis at this level of legal reasoning, the anti-

⁵³ Brylawski, *supra* note 1, at 360.

protectionists have been sharply—and divergently—circumspect in qualifying.

Thus, while one commentator has called for the rejection of any application of the *Page* court's "species of the genus" rationale to a determination of the soundtrack copyrightability question,⁵⁴ another has directed inquiry to the logical relevance of that rationale to the same question.⁵⁵ The latter pursuit has led to mention of the fact that prior to the passage of the Townsend Amendment, the motion picture had been judicially recognized as a protectible species of the genus "photograph" in *Edison v. Lubin*.⁵⁶ The *Edison* court had characterized the process by which the motion picture before it⁵⁷ was made as an "advance in making photographs".⁵⁸ In applying a "species of the genus" approach, the *Edison* court then held the film copyrightable as a photograph under a congressional amendment of 1865 extending copyright protection to photographs. In the context of anti-protectionist thought, however, the *Edison* analogy has been deemed unsatisfactory as authority for the application of a "species of the genus" rationale to the problem of soundtrack copyrightability, because:

In *Edison*, both the "species" motion picture and the "genus" photograph were visually appreciable. The problem of the motion picture soundtrack is complicated by the presence of a visually appreciable genus (the motion picture) and an "integrated" element (the soundtrack) that renders the species ("talkies") decidedly *aural* in nature, as well as visual. It is this aspect of the problem which mitigates against complete acceptance of Professor Nimmer's "integrated element" approach to ultimate protection of the material recorded on a motion picture soundtrack.⁵⁹

This analysis is not without problems of its own. One of these problems is that the analysis apparently offers a purely physical symmetry between genus and species as dispositive of whatever reasonable legal construction is called for by application of the "species of the genus" doctrine. However, the *Edison* court saw its responsibilities to reason mandated as a function of the object of the specific copyright act in question; this in turn

⁵⁴ *Id.* at 362.

⁵⁵ Yuzek, *supra* note 2, at 31-32.

⁵⁶ 122 Fed. 240 (3d Cir. 1903).

⁵⁷ The motion picture before the *Edison* court was an unedited film loop. See text accompanying note 110 *infra*.

⁵⁸ 122 Fed. at 242.

⁵⁹ Yuzek, *supra* note 2, at 33 (emphasis in original).

was identified as a function of the object of the constitutional grant of power "to promote the progress of science and useful arts."⁶⁰ The analytical erosion of what might be called a "reasonableness" requisite—a requisite potentially imbedded in "species of the genus" doctrine itself—apparently has been sensed as insupportable even while being tendered, for the analysis has been qualified:

Reference was made earlier to the difficulty of applying a "species of the genus" approach, when the integral element for which protection is sought is aural in nature. Perhaps it is fair, however, to fall back upon the reason of the thing. Since the picture track of a film alone is relatively unintelligible, it is not unreasonable to say that the nature of the whole, when the soundtrack is joined with the visual band, is indeed different than the nature of the individual parts of that whole. The soundtrack, however, may be comprised of both dialogue and music. There may in fact be a valid dividing line to be perceived here; on one side may fall material contributions to beneficial use. Such contributions may be copyrightable as validly proclaimed *integral* elements of the whole. On the other side may fall those contributions to the whole which merely enhance enjoyment. If uncopyrightable individually, such contributions would remain uncopyrightable even when joined with a copyrightable work. Under the above analysis, the justice of the result would lie in the fact that the element which merely enhances enjoyment—as opposed to that which materially contributes to beneficial use—neither has its nature modified by association with the whole nor causes the nature of the whole to be materially modified. The dialogue portion of the soundtrack may be viewed as a material contribution to the beneficial use of the motion picture, the film music as an enhancement of enjoyment. It is our contention, then, that it may be proper in certain circumstances to afford protection to an aural element of an otherwise visual whole, on the basis of an "integral" element or "species of the genus" approach.⁶¹

It is a matter of no small importance that the originator of this "material contribution/enhancement of enjoyment" theory considers the film dialog tracks the only part of the motion picture soundtrack which can "even reasonably be deemed an integral element of the film under a species of the genus or entity approach to sound motion pictures."⁶² Be

⁶⁰ 122 Fed. at 242, *quoting* U.S. CONST. Art. I, §8, cl.8.

⁶¹ Yuzek, *supra* note 2, at 35 (emphasis in original).

⁶² *Id.* at 37.

that as it may, the attachment of a "reason of the thing" or a "reasonableness" approach to considerations of visual appreciability and intelligibility does confer a substantial and embryonic conceptual importance to the analysis: one which may operate legally as well as independently of any arbitrary aesthetic distinctions drawn as to motion picture intelligibility itself. The legal ramifications of this conceptual frame will be considered fully in subsequent analysis, but a number of points concerning the peculiar anti-protectionist theory wedged into this conceptual frame may be noted here.

First, the substantive analysis as to what is integral and what is not establishes motion picture aesthetics as a frontal matter of legal consideration in application of the "species of the genus" doctrine to the soundtrack copyrightability question. Second, this particular entry into the domain of aesthetic analysis has been made without regard to the responsibilities attending aesthetic analysis itself. That is to say, the film dialog tracks may be material to motion picture intelligibility, and the film music tracks may be immaterial to such intelligibility, but it is hardly sufficient merely to state that the former are and the latter are not and then to offer a legal theory grounded in aesthetic distinctions drawn *a priori*. Third, any aesthetic analysis that might be made regarding the anti-protectionist theory posited within the conceptual frame introduced must look for support independent of motion picture aesthetic theory itself. For the concept of the motion picture art which emerges from this anti-protectionist rationale entirely contradicts that which has operated in motion picture making and motion picture theory since the motion picture was invented—*i.e.*, the quite universally accepted aesthetic notion that the motion picture art is a mosaic art in which elements of all the arts are integrated and interrelated.

Notwithstanding the difficulties attending the anti-protectionist theory constructed within the conceptual frame introduced, the frame itself remains symmetrically formidable because visual appreciability and intelligibility considerations may be as much mandated by law as a "reasonableness" factor may be legal part and parcel of a "species of the genus" analysis applied in a copyrightability setting. Attention in this respect has been drawn to *White-Smith Music Publishing Co. v. Apollo Co.*,⁶³ a case which the protectionists prefer to consider "tacitly modified insofar as motion picture sound tracks are concerned by the subsequent amendment which expressly added motion pictures as copyrightable works,"⁶⁴ despite the preservation of its rule with respect to phonograph records

⁶³ 209 U.S. 1 (1908).

⁶⁴ NIMMER, *supra* note 3, at 442.2. *Accord*, LATMAN, *supra* note 11, at 148-49.

until passage of the Sound Recording Act. The protectionist preference imbues protectionist theory with at least an uncomfortably facile analytical quality. The anti-protectionists will have no part of the "tacit modification" argument, and they may be as correct as they have been uniform in their objections, albeit in unforeseen fashion.

The Court in *White-Smith* held that a perforated piano roll was not an infringing copy of the musical composition embodied in the roll, because the roll was not a written or printed record of the musical composition in intelligible notation. The Court's equation of copyrightability with protectibility was clear,⁶⁵ and if the relevance of "copy" reproduction to copyrightability is familiar, it is also well known that the twin requirements of visual appreciability and intelligibility provide the two-fold test by which a *White-Smith* copy may be established. Just what analytical relation exists between these twin requirements is not quite clear. It has been suggested that application of the intelligibility test is a procedural function of positive application of the visual appreciability test.⁶⁶ Yet *how* to apply an intelligibility test, and *against what* to apply the visual appreciability test or the intelligibility test, can in certain circumstances become controversial issues.

Hence, it has been argued that "[a]s to soundtrack protection through the motion picture copyright, intelligibility breakthroughs matter little if the initial hurdle of visual perception remains extant."⁶⁷ However, this argument has been introduced by first *divorcing* the soundtrack from the visual track of the motion picture and then directing consideration to the soundtrack in isolation. Since the isolated soundtrack is not visually appreciable as to its underlying elements, the argument then continues to identify the soundtrack as uncopyrightable because it cannot be a copy of its underlying elements, in accord with the rule of *White-Smith*. Support for this argument is claimed to rise from the Copyright Office's practice of refusing to register either a lone soundtrack or a soundtrack offered as the only new matter in a previously published or registered motion picture.⁶⁸

⁶⁵ After defining "copy" and denying that the piano roll was a copy, the Court stated, at 209 U.S. 17:

The statute has not provided for the protection of the intellectual conception apart from the thing produced . . . but has provided for the making and filing of a tangible thing, against the publication and duplication of which it is the purpose of the statute to protect the composer.

⁶⁶ Yuzek, *supra* note 2, at 34. Note that the intelligibility test went unapplied in *White-Smith* when the piano roll was deemed incapable of visual appeal.

⁶⁷ *Id. Accord*, Brylawski, *supra* note 1, at 361.

If this argument initially appears salient, it palls considerably when examined as to its logical ramifications. The most immediately apparent of these is that a symmetrical analysis applied to the isolated visual track of the motion picture may result in deeming the isolated visual track as theoretically uncopyrightable as the isolated soundtrack has been claimed to be. For if the visual track of the motion picture is unintelligible in isolation which the soundtrack of the motion picture is visually unappreciable in isolation, then the former must fail the *White-Smith* test as easily and as severely as the latter. If this consequence is to be deemed legal lunacy, then so must any anti-protectionist argument constructed by isolating half of a motion picture be deemed unacceptable.

However, the absurdity of chopping up the motion picture in this fashion in order to posit anti-protectionist argument becomes clear only if the motion picture visual track is indeed unintelligible in isolation and therefore fails the *White-Smith* test in fact. Quite obviously, the judicial meaning accorded the intelligibility maxim emerges as a paramount analytical consideration. That the intelligibility maxim is ideational in essence we know from *White-Smith* itself.⁶⁸ Just how consummately ideational it is—and just how much the legal concern with aesthetic analysis already advanced is mandated by application of the conceptual frame of “species of the genus” doctrine already introduced—will shortly be seen.

The tactic of directing attention to the isolated soundtrack, adopted in order to invoke the bludgeon of *White-Smith*, and however discreditable in view of the impact which the identical legal ax may have on the isolated visual track, does allow the anti-protectionists to flesh out their theory with analogies to the judicial and legislative treatment of phonograph

⁶⁸ Brylawski, *supra* note 1, at 362. *Accord*, Yuzek, *supra* note 2, at 32. Brylawski claims that the Copyright Office recognized *White-Smith* as authority for denying the copyrightability of motion picture soundtracks when it issued the following rules in the *Copyright Office Rules of Practice*, No. 2.14.1, Chapter 2, page 47 of the “Compendium of the Copyright Office Practices 1967” under the sub-heading “III. Sound Tracks”:

b. Registration is not made for a sound track alone, or for a sound track as the only new matter in a previously published or registered motion picture.

Examples: (1) An old silent picture with a new sound track

(2) A previously published foreign film with a dubbed sound track in English.

⁶⁹ In arriving at its definition of a copy of a musical composition as “a written or printed record of it in intelligible notation,” the Court in *White-Smith* quoted with approval the definition given by Bailey, J., in *West v. Francis*, 5 Barn. & Ald. 743: “A copy is that which comes so near to the original as to give every person *seeing* it the *idea* created by the original.” 209 U.S. at 17 (emphasis added).

records. In this regard there has been a concerted effort to equate the isolated soundtrack with the phonograph record. Indeed, once the soundtrack has been isolated, the effort seems a logical imperative of anti-protectionist thought, for the preservation of the rule of *White-Smith* with respect to phonograph records and the traditional inability to secure statutory protection for phonograph records do confer an aura of uncopyrightability on the isolated soundtrack *if* the equation can be made.

Thus, attention has been drawn to the equation made between the isolated soundtrack and the phonograph record by some courts for other purposes.⁷⁰ It has also been argued that the isolated motion picture soundtrack is really of the genus "mechanical recordings".⁷¹ Even where the dialog tracks of the (integrated) soundtrack have been proffered as protectible, the music tracks have still claimed to be expendable because:

There is a clear practical distinction between the dialogue and music portions of the soundtrack. The music portion of the soundtrack may have a useful life above and beyond that of the motion picture itself, and is capable of being exploited long after the picture is no longer useful. On the other hand, the market for the dialogue portion of the soundtrack normally exists only as long as, and in conjunction with, the exploitation of the film. Such industry realities as these increase the tenability of the analogy of film music to phonograph records.⁷²

However, the only clear thing about the "clear practical distinction" urged is that it has nothing to do with matters of integration or intelligibility vis-à-vis the aesthetic functions performed by the dialog and the music in the copyrighted motion picture. Moreover, even if irrelevant to the dominant motifs of copyrightability analysis, the purported "industry realities" emerge as fallaciously asserted when we note such historical realities as the fact that fully fifteen years of sound-on-film production had passed before *even one* original film score of an American film was considered to have a "useful life of its own" and was commercially ex-

⁷⁰ *Foreign & Domestic Music Corp. v. Licht*, 196 F.2d 627 (2d Cir. 1952) (license to publicly perform songs does not carry the right to reproduce the songs on film soundtrack); *Encore Music Publications, Inc. v. London Film Productions, Inc.*, 89 U.S.P.Q. 501 (S.D.N.Y. 1951) (reproduction of songs on film soundtrack without synchronization license infringes recording rights). In *Foreign & Domestic Music*, Judge Learned Hand noted that the soundtrack reproduction infringed the copyrights in the songs by falling within section 1(e)'s grant to the copyright owner of an exclusive right to make any arrangement or setting of a musical composition in any form of record. 196 F.2d at 629.

⁷¹ Brylawski, *supra* note 1, at 363.

⁷² Yuzek, *supra* note 2, at 24.

ploited apart from its functional purpose in movie theaters.⁷³ While this “useful life of its own” consideration has shifted appreciably in recent years, it is still the case that the vast preponderance of film music written during the half-century sound-on-film era has in no way been commercially exploited apart from its functional cinematic purpose.

In further asserting the validity of the soundtrack/phonograph record equation, attention has been drawn to Professor Nimmer’s contention that the motion picture soundtrack, unlike the phonograph record, is not the type of mechanical reproduction to which the compulsory license provision of section 1(e)⁷⁴ applies.⁷⁵ Nimmer’s argument has been attacked because:

⁷³ Wick, *The Birth of the Spellbound Concerto*, PRO MUSICA SANA, Spring, 1973, at 4. Note that even when such commercial exploitation arrived, it literally had to be forced upon the record companies: the movie producers financed it. In 1943, David O. Selznick spent \$12,000 to produce 1,000 transcription discs of some of Max Steiner’s music from “Since You Went Away” (’43); these were unavailable commercially but received wide radio play, thus publicizing the film. The following year, Selznick employee Ted Wick tried to convince the record companies to record some of Miklos Rozsa’s music from “Spellbound” (’44), but was turned down everywhere. Wick notes: “Jim Conkling, then head of Capitol, turned me down flat, adding that “the record-buying public isn’t at all interested in movie music.” *Id.* In desperation, the Selznick corporation subsidized a commercial release of a *Spellbound* recording, which became one of the most popular disc successes of the year. In response, record companies began issuing selected film music suites and soundtrack albums in 1945. However, such recordings remained few and far between until the mid-1950s, when at least a dozen or more soundtrack albums began to appear regularly each year—drawn from the several hundred original film scores recorded for motion picture soundtracks each year.

⁷⁴ 17 U.S.C. §(e) reads in appropriate part:

And as a condition of extending the copyright control to such mechanical reproductions, that whenever 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 2 cents on each such part manufactured, to be paid by the manufacturer thereof . . .

⁷⁵ NIMMER, *supra* note 3, at 442.1. Nimmer notes, *id.* at 442:

The motion picture industry has never relied upon the compulsory license provision for the purposes of its sound tracks. Therefore, instead of paying 2 cents for each motion picture film print containing a sound track upon which is recorded a musical composition, motion picture producers obtain a synchronization license, sometimes paying very considerable sums for this right.

The musical compositions referred to here, of course, are those additional to music composed specially for source films.

... it relies on a "species of the genus motion picture" analysis in order to assert the non-amenability of soundtracks to the compulsory license. Any theory which erodes the applicability of the compulsory license to soundtracks by employing "species of the genus" notions on an *a priori* basis, is incapable of then positing the inapplicability of section 1(e) as authority for the species of the genus approach.⁷⁶

Clearly, the criticism is well made. Similarly, any theory which seeks to deny the copyrightability of half of a copyrightable motion picture, by directing attention to that half alone without regard to the intellectual legitimacy of the tactic of isolation for analytical purpose, cannot be taken seriously unless and until the conceptual act of isolation can be legally justified. Thus, the path opened by the introduction of *White-Smith* as anti-protectionist support emerges as circular. It leads the concerned analyst back to confrontation with the dominant considerations of copyrightability itself. And what emerges at best from anti-protectionist theory is not yet a formidable theory at all, but rather a valuable indication of a conceptual frame in which theory may be tested once the frame has been corroborated by law.

As we approach that corroboration and test while emerging from this overview of the conflict, both the practical and substantive parameters of our journey rise prominently from the initial analysis undertaken. It is evident that protectionist theory raised solely on *a priori* legal perceptions and extra-judicial opinions will not escape assault so as to regain the mantle of orthodoxy it has lost. It is equally evident that anti-protectionist theory based upon arbitrary aesthetic distinctions and suspect tactical maneuvers will do much to confuse the issue of soundtrack protection, nothing to clarify that issue, and very little toward reducing protectionist theory to a hollow. Moreover, if clarification of the soundtrack copyrightability issue is to come, it would be advantageous, and perhaps even terminally productive, to separate new mythology from old history. Further, if we must seek beyond the proofs of history, it would appear sensible to assume that a legitimate path to legal clarity begins somewhere in the midst of "species of the genus" doctrine. Finally, wherever that path may lead, it is evident that it may not be followed within an analytical vacuum, as attending that doctrine is at least a mandated consideration of the *White-Smith* copyrightability tests, and perhaps a mandated consideration of "reasonableness" as well. As to this conceptual frame, it may be noted that a matrix bounded by "reasonableness" and *White-Smith*

⁷⁶ Yuzek, *supra* note 2, at 41.

considerations would appear to be an agreeable frame in which to assume that the "species of the genus" doctrine operates. For "reasonableness" analysis and visual appreciability/intelligibility tests, underlaid by notions of legislative intent and aesthetic distinction which remain to be verified, have been the polar tools most frontally waved by anti-protectionist theorists. There can be little objection if these tools are used precisely and are then seen to construct rather than to dismantle.

Be that as it may, the maelstrom of "species of the genus" analysis, bordered potentially by reason and certainly by *White-Smith*, and resting beyond or within the impact of history, may now be entered.

II. TOWARD AN AFFIRMATION OF SOUNDTRACK COPYRIGHT-ABILITY

(A) *The Matter of An Original Legislative Intent*

If there is one notion which the protectionists and the anti-protectionists accept as axiomatic, it is the supposition that soundtracks as adjuncts to motion picture visual tracks did not exist and were not even in contemplation at the time of the Townsend Amendment, and therefore could not have been comprehended directly by the grant of motion picture copyright. The agreement in the matter of "silent films", "talkies", and the intervening legislative action is quite astonishing. For, etymologically curious though it may be, it is well established in motion picture histories that "silent films" were never silent, and that "talkies" did not remain all-talking for very long.

The motion picture was actually invented by Thomas Edison and his assistant, William Dickson, as a visual-aural mechanism. The following summary of the birth of the new art form denotes what was technologically as well as aesthetically contemplated from the outset:

In 1888, after more than a decade of experiment, Edison produced the phonograph, an instrument for recording and playing back sound on wax cylinders. He had already seen the motion photographs of [Eadweard] Muybridge, and the idea of combining moving pictures with sound seems to have been in his mind even before the perfected phonograph was offered to the public. In fact, his first efforts in this direction consisted of a strip of small photographs wrapped spirally about just such a cylinder. "Everything should come out of one hole," Edison maintained. When this failed, Edison turned the project over to Dickson—and with it a new film base developed by George Eastman. . . . It was Dickson who solved the mechanical problem of moving [the film] through the camera, devising the sprocket system that is still stan-

dard on 35mm film today. Indeed, this ingenious man even managed to link up the pictures with the phonograph, demonstrating the Kinetoscope to his employer on October 6, 1889, with a brief film in which Dickson both appeared and spoke. What was in all probability the first actual presentation of a motion-picture film also marked the debut of the talkies!⁷⁷

Edison patented the Kinetoscope in 1891. His first commercial efforts were not directed toward film projection, but rather toward popularizing the Kinetoscope as a penny-in-the-slot "peep show" attraction. In 1893, he momentarily put aside the sound aspects of the Kinetoscope and began producing one-minute-long film loops to supply the Kinetoscopes of the "peep show" parlors which became prevalent in the United States by 1894. Other inventors quickly designed projectors to accommodate these film loops. For a few years these film loops, portraying brief incidents like a kiss, an execution, or an on-rushing locomotive, intrigued the public. The novelty wore off rapidly. Before the turn of the century, a bored American public had deserted the "peep show" parlors, and the film loops had been relegated to the oblivion of one-minute vaudeville acts—ones which cleared the vaudeville houses for the next show.⁷⁸ Since the vaudeville houses sported pit orchestras, it became general practice for the film loops to be accompanied by orchestral music as they ran.⁷⁹

Meanwhile, the Kinetoscope, unprotected abroad,⁸⁰ impressed a number of inventors in England, France, and Germany, who promptly invented equivalent machines of their own. The most important of these was the Cinematograph, a machine which took, printed, and projected pictures. The Cinematograph was perfected in France by Louis and Auguste Lumière.⁸¹ The Lumière Brothers immediately conceived of commercializing the new art form in visual-aural terms. When the Lumière Programme debuted in a Paris basement cafe on December 28, 1895, the program was accompanied by music played on a piano.⁸²

In addition to exhibiting their film projections with musical accompaniment, the Lumière Brothers also attempted to add sound effects to their program. In 1896, the Lumière Programme was given its first public performance in Great Britain, accompanied by music played on a harmonium. To imitate engine noises for a scene in the program subtitled

⁷⁷ A. KNIGHT, *THE LIVELIEST ART* 16-17 (1957). [hereafter, KNIGHT.]

⁷⁸ *Id.* at 17-23.

⁷⁹ Limbacher, *How It All Began*, in *FILM MUSIC* 13, 14 (J. Limbacher ed. 1974).

⁸⁰ When Edison patented the Kinetoscope, he neglected to pay the additional \$150 fee that would have secured international protection. KNIGHT, *supra* note 77, at 17.

⁸¹ *Id.*

"The Arrival of a Train in a Station", a cylinder of compressed air was used. During the same year, various music halls in England ran film projections, for which the music hall orchestras provided full musical accompaniment.⁸³

Back in France, Georges Méliès, "without question the movies' first creative artist,"⁸⁴ introduced the narrative, or story-telling, film. All of the films of Méliès were accompanied by musical scores. In fact, the earliest piano scores still extant are those written for the films of Méliès during the last years of the 19th century.⁸⁵ Méliès' films were very popular in France—so popular that soon they were being shown in America. Here they were widely seen through the first decade of the 20th century. From the time of their introduction in this country, they ignited public interest in the motion picture art as a narrative medium. They also convinced American producers that sound accompaniment and a running time substantially longer than one minute were indispensable to successful commercialization of the motion picture.

As early as 1900, film makers were experimenting with recording discs to give their films their necessary sound. The first commercialized attempt of this nature apparently took place in England in 1900.⁸⁶ Shortly afterward, various phonograph synthesizers were developed in England (in 1904) and in the United States (in 1907) to be used in film exhibition, the films being limited in running time by the playing time of the recording discs.⁸⁷ Hundreds of these synchronized films appeared during this period, often produced by music halls or opera companies. However, the quality of their synchronized sound was poor, and the elaboration and advancing popularity of the motion picture soon made it necessary for the productions to incorporate "live" sound provided by piano and/or orchestra.⁸⁸

⁸² R. MANVELL & J. HUNTLEY, *THE TECHNIQUE OF FILM MUSIC* 17 (1957). [hereafter, MANVELL & HUNTLEY].

⁸³ *Id.*

⁸⁴ KNIGHT, *supra* note 77, at 24.

⁸⁵ Bernstein, *What Ever Happened to Great Movie Music?*, *HIGH FIDELITY*, July, 1972, at 55. [hereafter, Bernstein.]

⁸⁶ The film was entitled "Little Tich and His Big Boots"; a phonograph record was used to give the film its sound. MANVELL & HUNTLEY, *supra* note 82, at 17.

⁸⁷ *Id.* at 17 n.1.

⁸⁸ *Id.* Professor Knight explains further in KNIGHT, *supra* note 77, at 145:

Until about 1912 inventors persisted in their efforts to join together sound and visuals, going so far as to run endless belts from the projector motor through the entire length of the theater to a phonograph installed behind the screen. But they soon discovered, as houses continued to grow larger, that the problem was one not merely of synchronization but of amplification as well. The ordinary talking machine simply could not produce the volume of sound required to fill an entire auditorium.

Thus, the piano player and often the orchestra became as uniformly necessary to film exhibition as the projectionist. The first original orchestral score that we have a record of, variously dated at 1907 or 1908, was composed by Camille Saint-Saëns for "L'Assassination du Duc de Guise" in France.⁸⁹ In America, the first "suggestions for music" sheets of which we have a record was issued in 1909 with films made by Thomas Edison's company.⁹⁰ In 1913, *The Sam Fox Moving Picture Volumes* were published in the United States, offering pieces for film pianists compiled by J. S. Zamecnik.⁹¹

What was the state of motion picture production, exhibition, and art in 1912 as Congress considered the Townsend Amendment? The following summary is on point:

The year 1912 was the beginning of the greatest and most prosperous era in the history of the American amusement industry. . . .

Nothing that happened in the rapidly expanding world of musical comedies, operettas, and vaudeville was comparable, however, to the breath-taking development of the silent movies. The men who became the giants of the film industry were beginning to produce films on a large scale in Hollywood. Big movie theaters were erected, not only in New York but in every town and village. This was of tremendous consequence to the music business. The silent film needed music to bring it to life.

"On the silent screen music must take the place of the spoken word" had become one of the credoes of the film industry. Huge theater orchestras were hired to play in the movie palaces of the big cities, and smaller ensembles, trios, or simply an organist or a pianist, were employed in thousands of towns and villages.⁹²

Before we consider the specific matter of legislative contemplation, it must be noted that as Congress met to consider the Townsend Amendment, and for many years thereafter, the underlying musical works of this primitive motion picture sound were either incapable of receiving copyright protection or did not need copyright protection independent of that being claimed. Early in 1912, the first of the large "cue sheet" music publishers went into business to meet the huge demand for motion

⁸⁹ MANVELL & HUNTLEY, *supra* note 82, at 18.

⁹⁰ *Id.*

⁹¹ *Id.* at 212.

⁹² Winkler, *The Origin of Film Music*, in *FILM MUSIC* 15, 15-16 (J. Limbacher ed. 1974).

picture music.⁹³ These organizations were staffed by hosts of composers specializing in film music. Their “cue sheets” were registered and published like any other musical compositions; the film music publishing houses made their money by supplying enough “cue sheets” to cover every print of every film produced by every film producer for many years following 1911. Moreover, the demand for “cue sheets” soon grew so staggering that many of the publishing houses no longer had to register much of their “cue sheet” music because, as one practitioner of the art of the era put it:

In desperation we turned to crime. We began to dismember the great masters. We began to murder the works of Beethoven, Mozart, Grieg, J. S. Bach, Verdi, Bizet, Tchaikovsky, and Wagner—everything that wasn't protected by copyright from our pilfering.⁹⁴

This manner of providing sound for motion pictures changed radically toward the end of the 1920s. Experiments in linking film projections with sound on recording discs did not end entirely in 1909, but rather continued on a special attraction basis⁹⁵ until, in 1926, the Bell Telephone Laboratories developed a special turntable and 13" to 17" records large enough to produce continuous recorded sound for an entire reel of film. Later that year, Warner Brothers, a major film company facing bankruptcy at the time, invested its remaining assets to acquire the novel sound process, which it named Vitaphone.⁹⁶

Warners first used the Vitaphone process to produce short novelty attractions; a selection of these shorts was premiered with recorded musical scores in August, 1926. Audiences were interested but not excited. In 1927, Fox Films, another major film company, acquired the rights to a German process by which sound could be photographed directly onto

⁹³ *Id.* at 20.

⁹⁴ *Id.* at 22.

⁹⁵ *E.g.*, “Dream Street” (’15), directed by D. W. Griffith, was presented in New York with a battery of synchronized records of music. MANVELL & HUNTLEY, *supra* note 82, at 212. Ambitious experiments without phonograph records included Griffith’s “Birth of a Nation” (’15), which featured a long score performed by live orchestra in major city engagements. KNIGHT, *supra* note 77, at 35. During showings of “Birth of a Nation”, paid “noisemakers” were often stationed behind the screens to produce sound effects. Limbacher, *supra* note 79, at 15.

⁹⁶ KNIGHT, *supra* note 77, at 146.

film itself.⁹⁷ Later that year, Fox released sound-on-film novelty shorts, added music-on-film to its feature film production, and introduced the first sound-on-film newsreels. However, the public did not enthusiastically embrace the new sound film until October 6, 1927, when Warner Brothers released the first feature length "talkie" with a star personality: "The Jazz Singer", starring Al Jolson.⁹⁸

The term "talkie" has been much abused by the courts and commentators in this area. Strictly speaking, "talkies" were "all-talking" movies, so named because "[t]hey just never stopped talking!"⁹⁹ In the world of "talkies," the camera was no longer seen to move and the music was no longer heard to sound; the microphone and the sound technician dominated movie making. The popularity of the "talkies" immediately caused the collapse of all the "cue sheet" music publishing houses. Tremendous stocks of film music became worthless overnight.¹⁰⁰

However, the public enthusiasm for "talkies" lasted little more than a few years. Audiences quickly grew tired of movies which did nothing but talk. By the early 1930s, film producers had realized that the sound-on-film picture was unacceptable commercially and artistically so long as it did nothing but talk. Swiftly, the sound technician was made subservient to the film director, the camera was liberated, and music was reinstated in films.¹⁰¹ The era of the "talkies" was over, and the era of a mosaic sound-on-film art had begun.

⁹⁷ The development of the German sound-on-film process actually antedated the development of Vitaphone. Moreover, the German sound-on-film process appears to have antedated another sound-on-film process, called Phonofilm, which was developed by Lee De Forest several years before Vitaphone was developed. Beginning in 1923, De Forest presented his phonofilms as novelty attractions in vaudeville theaters throughout the United States. Inexplicably, these first sound-on-film movies produced little stir in the motion picture industry. *Id.* at 145-46.

⁹⁸ *Id.* at 147. For the next three years, the film industry's universal embrace of recorded sound coincided with a struggle for dominance between the proprietor of the sound-on-disc system and the proprietors of various sound-on-film systems. A "patents pool" arrangement ended the competition, and by the end of 1931 sound-on-film was standard. *Id.* at 150.

⁹⁹ *Id.* at 143.

¹⁰⁰ Winkler, *supra* note 92, at 24.

¹⁰¹ This reinstatement bore an important musical shift. At first the film companies turned for the necessary film music to the music publishers they had dealt with beginning in 1912. The catalogs of the "cue sheet" publishers immediately rose in value as tremendously as they had recently dropped in value. Putting music back into films in this manner became so expensive that soon the film companies found it more economical to hire their own composers to write original film scores tailored to the needs of individual films. Thus appeared the film composer and the film score as we know them today. *Id.* at 24-25.

Roughly forty years separate the invention of the motion picture as a visual-aural art and the perfection of the motion picture as a visual-aural art. The action of Congress extending copyright recognition to the motion picture art occurred almost exactly halfway through this approximately forty year period of development. Quite clearly, it may not be asserted that the visual-aural character of the art was not contemplated by 1912, for nothing but such a character had been contemplated since the invention of the new art form. It is perhaps true that soundtracks as technological adjuncts to visual tracks could not be specifically foreseen in 1912; yet the technological antecedents of soundtracks—the recording discs employed with phonograph synthesizers and the live musical accompaniment—were not only in contemplation by 1912, they were in proliferate existence for twelve years prior to 1912. More importantly, the aesthetic continuity of a commercialized visual-aural motion picture art remained intact in this country at least from 1900 onward, and was therefore the only aesthetic ambience of that art of which the members of the 62nd Congress could have been substantially aware. Due to the technologically primitive manner in which this aesthetic ambience was produced, via “canned” visual track projection and live or independently recorded musical sound, the visual track was judicially protectible as a photograph and the musical compositions were protectible as physically registered and published music, before and while Congress considered a specific grant of copyright protection to the motion picture. What, then, may be said about Congress’ contemplation of the matter?

If we are to be logical, we would have to expect that the 62nd Congress, while not collectively quite sure about how the motion picture would develop technologically, saw itself as protecting something other than, or at least potentially other than, a mere photograph, which was, of course, already recognized by statute.¹⁰² However, perhaps even this rudimentary aesthetic perception is too much to attribute to the 62nd Congress. As one commentator has noted:

... Congress in its 1912 enactments to include motion pictures as a copyrightable class failed to even review and change other sections of the copyright law in order to make them compatible with the new class, thereby evidencing little legislative thought about what it was doing. As a result, today we are called upon to fit motion pictures into the language of other sections of the copyright law inapplicable to motion pictures, such as what constitutes the “best

¹⁰² This class was first included in 1865 by 13. Stat. 540.

edition" under the deposit requirements of section 12 or what is "twice the amount of the retail price of the best edition" insofar as the failure to deposit under Section 13.¹⁰³

Actually, the bulk of legislative thought relative to the Townsend Amendment was directed to the capacity of motion pictures to infringe. The report of the House Committee on Patents relative to the Townsend Amendment noted that the production of films had grown into a business of vast proportions, necessitating a definite recognition and protection for the films themselves.¹⁰⁴ The dialogue on the floor of Congress was chiefly concerned with protecting the film producers from the hazard of bankruptcy, such a threat being alive so long as an inadvertently infringing film could be exhibited numerous times by numerous exhibitors within a short time period, thereby tolling multiple infringements and auguring unlimited recovery against one film producer.¹⁰⁵

Thus, in bringing motion pictures into the copyright statute, the Townsend Amendment also embraced additions to the copyright law having a relation to motion pictures only to the extent of the film's capacity to infringe. Just as section 5 was amended to incorporate subsections (1) and (m), section 11 was amended to provide for the deposit of dramatico-musical compositions as well as the deposit of motion picture prints.¹⁰⁶ Section 25 was also amended to limit the recovery available against a motion picture company which inadvertently infringed a copyrighted dramatic or dramatico-musical work.¹⁰⁷ That a motion picture might infringe a dramatico-musical work without actually infringing the musical aspect of the dramatico-musical work is entirely possible: an example would occur where a dramatic film appropriated the story-telling element of an opera without appropriating its musical effects.¹⁰⁸ However, to the extent that the framer of these amendments considered the capacity of the motion picture to infringe a dramatico-musical work, the following exchange on the floor of Congress during the discussion of the amendments provides interest:

¹⁰³ Brylawski, *supra* note 1, at 360.

¹⁰⁴ H.R. Rep. No. 756, 62d Cong., 2d Sess. 1 (1912); S. Rep. No. 906, 62d Cong., 2d Sess. 1 (1912).

¹⁰⁵ H.R. Rep. No. 756, 62d Cong., 2d Sess. 3-4 (1912); S. Rep. No. 906, 62d Cong., 2d Sess. 3 (1912). *See* 48 CONG. REC. 8288-92 (1912).

¹⁰⁶ Act of Aug. 24, 1912, 37 Stat. 488, *amending* 17 U.S.C. §§5 & 11.

¹⁰⁷ Act of Aug. 24, 1912, 37 Stat. 488, *amending* 17 U.S.C. §25.

¹⁰⁸ An opera is perhaps the most obvious example of a dramatico-musical composition. *See* LATMAN, *supra* note 11, at 26.

Mr. Mann: There has been at different times considerable controversy with reference to the copyright on musical reproductions. What effect will this change have on that, if any?

Mr. Townsend: It enlarges the scope embraced within that classification. Heretofor, I believe, the classification has been "dramatic or musical productions." There is now recognized, I think, in the theatrical world a third class of performances, commonly known as "dramatico-musical." This amendment makes the manufacturers of motion pictures or other infringers of copyright liable in the case of the infringement of a dramatic or musical or dramatico-musical performance.¹⁰⁹

Mr. Townsend's statement is perhaps capable of meaning different things to different people. However, when we note that the motion picture of 1912 and even much earlier was entirely capable of infringing the musical as well as the dramatic effects of a dramatico-musical composition, and when we consider that Mr. Townsend was thinking in "performance" terms about the particular infringement issue, the impression emerges distinctly that sound as well as sight was on the mind of the man who brought the motion picture amendments before the 62nd Congress. As to what was on the minds of the other members of that Congress, we know only the historically obvious: if they had seen commercially exhibited motion pictures of the day at all, they had experienced an art form combining sight and sound, irrespective of what transient manner in which the visual was combined with the aural.

If we are to be reasonable, then, we must impute to the 62nd Congress an intention to protect the motion picture art to the extent that the aesthetic distinctions of that art permeated congressional awareness at the time of statutory recognition and mandated continued aesthetic unity after statutory recognition. That would appear to be the heart of any action undertaken as a function of the power "To promote the Progress of Science and useful Arts. . . ."

But *must* we be reasonable, and *is* that the heart of an action extending copyright recognition? Further, if such perceptions are valid, do they operate whether we rest on a protective legislative intent or proceed to "species of the genus" analysis itself? Let us see if our instincts are not only salutary but also mandated by law.

(B) *The "Species of the Genus" Doctrine*

It is apparent from our earlier discussion that a "species of the genus"

¹⁰⁹ 48 CONG. REC. 8289 (1912).

theory of copyrightability has been born of a body of judicial thought meandering enough to lend itself to malleable and therefore divergent treatment in the commentaries. Since application of the doctrine may be crucial to resolution of the soundtrack copyrightability question, a searching examination of the doctrine is demanded if the *Page* court's protective application of the doctrine to motion picture soundtracks is to be identified as valid law rather than as too generous dictum. Such an examination should rightfully proceed on the assumption that the "species of the genus" theory possesses structure in addition to substance, for it is through structure that substance may most readily be identified.

It was suggested earlier that a "reasonableness" maxim might prove as much a wing of such structure as requisite *White-Smith* considerations, and hence, that a conceptual frame established by these two poles might emerge as the legal path by which a "species of the genus" analysis should proceed. The question which initially presents itself here, then, is singular. Is such a conceptual frame the structure in law through which credence may be given to a "species of the genus" copyrightability analysis in a federal statutory sense?

We have noted two cases wherein a "species of the genus" theory was applied in a motion picture context: the decision in *Page*, where copyrightability was not an issue, and the decision in *Edison v. Lubin*, where copyrightability was an issue. Only in *Edison* did the court pay specific deference to an implicit "reasonableness" maxim. In holding a motion picture consisting of one continuous film sequence (*i.e.*, an unedited, one-camera position film loop) copyrightable as a photograph, the court identified the motion picture itself as a photograph since it was "a picture produced by photographic process."¹¹⁰

¹¹⁰ *Edison v. Lubin*, 122 Fed. 240, 242 (3d Cir. 1903).

¹¹¹ *E.g.*, Meagher, *Copyright Problems Presented By a New Art*, 30 N.Y.U. L. REV. 1081, 1085 (1955).

¹¹² The *Edison* court, at 122 Fed. 242, reasoned as follows:

To say that the continuous method by which this negative was secured was unknown when the act was passed, and therefore a photograph of it was not covered by the act, is to beg the question. Such construction is at variance with the object of the act, which was passed to further the constitutional grant of power "to promote the progress of science and useful arts." When Congress, in recognition of the photographic art, saw fit in 1865 to amend the act of 1831 . . . and extend copyright protection to a photograph or negative, it is not to be presumed it thought such art could not progress, and that no protection was to be afforded such progress. It must have recognized there would be change and advance in making photographs, just as there has been in making books, printing chromos, and other subjects of copyright.

However, to note only that the *Edison* court looked at the “sameness” of the process by which a film loop and a photograph are produced¹¹³ is to misconstrue the dominant strain of the *Edison* court’s analysis, for the *Edison* court looked to the Constitution to resolve *what to do* about this “sameness” of the new art and the old within a copyrightability setting. And it was through that perception that the *Edison* court decided what to make of the matter of legislative intent—a making seemingly bound to the constitutional charge by reason.¹¹²

The *Edison* decision was sanctioned two years later in *American Mutoscope & Biograph Co. v. Edison Mfg. Co.*,¹¹³ just as the *Page* dictum was given further credence ten years afterward in *Jerome v. Twentieth Century Fox-Film Corp.*¹¹⁴ In *American Mutoscope* the issue was whether a motion picture consisting of multiple film sequences (*i.e.*, an edited, multiple-camera position film) was copyrightable as a photograph. The court held that it was, citing *Edison* for support. However, unlike the *Edison* court, which had discussed the “sameness” of the motion picture and the photograph in terms of the physical process by which both had been created, the court in *American Mutoscope* discussed this “sameness” in terms of the “light-written” manner by which the motion picture and the photograph expressed ideas, thoughts, and conceptions so as to come within the constitutional identification of “writings.”¹¹⁵ This aesthetic dimension of the court’s constitutional awareness of the manner in which to pose a copyrightability question also appears to have been rooted in the substantive underpinnings of *Edison*. Like the court in *American Mutoscope*, the *Edison* court cited the United States Supreme Court decision in *Burrow-Giles Lithographic Co. v. Sarony*¹¹⁶ in support of its decision as to what to do within a copyrightability setting with a new art extension of the old. The impact of *Burrow-Giles* in this setting, particularly via the idea-

¹¹³ 137 Fed. 262 (C.C.D.N.J. 1905).

¹¹⁴ 67 F. Supp. 736 (S.D.M.Y. 1946), *aff’d*, 165 F.2d 784 (2d Cir. 1948).

¹¹⁵ After defining a “writing” in the constitutional sense, the *American Mutoscope* court noted that “if a photograph be not only a light-written picture of some object, but also an expression of an idea, or thought, or conception of the one who takes it, it is a writing within the Constitutional sense, and the proper subject of copyright.” 137 Fed. at 265. Continuing, *id.* at 266, the court stated that it was:

... unable to see why, if a series of pictures of a moving object taken by a pivoted camera may be copyrighted as a photograph, a series of pictures telling a single story like that of the complainant in this case, even though the camera be placed at different points, may not also be copyrighted as a photograph. Though taken at different points, the pictures express the author’s ideas and conceptions embodied in the one story.

¹¹⁶ 111 U.S. 53 (1884).

tional character it confers upon the "reasonableness" factor of "species of the genus" copyrightability analysis, may be momentarily reserved for subsequent discussion. We now note that to the extent the *Edison* and *American Mutoscope* courts embraced a "reason of the thing" thinking, it was a "reason of the copyright protection" motif of constitutional proportion that underlay their analyses.

The decision in *Jerome v. Twentieth Century Fox-Film Corp.*, sanctioning the *Page* analysis itself, falls outside of motion picture copyrightability analyses in which what might be called "reasonable relations" of an ideational and/or legislative sort have arguably been sought. However, the *Jerome* court, like the *Page* court, was equally determined to be reasonable, if only in dictum. In *Jerome*, the plaintiff argued that the defendant motion picture company had not acquired any right to use the plaintiff's musical composition in defendant's motion picture. The court found that the defendant did acquire such a right from the plaintiff. Though this finding in and of itself disposed of the plaintiff's suit,¹¹⁷ the court felt compelled to consider certain defenses pleaded by the defendant. One of these was the assertion that the plaintiff's failure to file a notice of use in accord with the compulsory license requisite of section 1(e), after the plaintiff had previously licensed others to use the musical composition in motion pictures, constituted a complete defense to any suit for copyright infringement, in accord with section 1(e).¹¹⁸

Though the *Jerome* court considered the point in dictum, the issue was considered by the court to be "so novel and important"¹¹⁹ that the music publishers and songwriters were permitted to file a brief *amicus curiae* through counsel for their associations. Agreeing with the claim that the motion picture soundtrack is not the type of mechanical reproduction to which the compulsory license provision of section 1(e) applies,¹²⁰ the court stated:

It was not intended that motion picture films should be in the same class as mechanical reproductions. Since "talkies" have been pro-

¹¹⁷ With one qualification: the plaintiff, in alternative argument, requested and was denied a finding of forfeiture as to rights acquired by the defendant. 67 F. Supp. at 737-38.

¹¹⁸ 17 U.S.C. §1(e) reads in appropriate part:

It shall be the duty of the copyright owner, if he uses the musical composition himself for the manufacture of parts of instruments serving to reproduce mechanically the musical work, or licenses others to do so, to file notice thereof, accompanied by a recording fee, in the copyright office, and any failure to file such notice shall be a complete defense to any suit, action, or proceeding for any infringement of such copyright.

¹¹⁹ 67 F. Supp. at 740.

duced commercially, we have had the decision in the *Page* case interpreting the Act as to motion picture rights. There has been no amendment of the Act to deal separately with "talkies," because they are so clearly of the genus "motion pictures."¹²¹

The willingness of the courts in *Edison* and *American Mutoscope* directly, and in *Page* and *Jerome* in dictum, to look for "reasonable relations" when faced with a motion picture copyrightability question, or to *be* reasonable when considering the issue of motion picture rights, perhaps should not automatically be equated with the necessity of following a "reasonableness" maxim when applying the "species of the genus" theory to the soundtrack copyrightability issue. Yet, as a line of authority implicating such a maxim, these motion picture cases should not be taken lightly. Nonetheless, it has been noted that whatever form of "species of the genus" analysis may be generated by law, the application itself of that analysis may be seen to fall into two distinct categories:

... the cases dealing with this general question of reading a copyright statute upon a subsequently developed art fall into two classes: those in which it is sought to hold that activities in the new art may constitute an infringement, under the statute in question, of a copyrighted work of an older art of recognized copyrightability; and those in which it is sought to hold that a work produced by the new art is itself copyrightable under the statute.¹²²

Thus, as in the *Page* and *Jerome* cases, the courts have employed the "species of the genus" theory to decide copyright matters which fall outside the narrow realm of copyrightability itself. Moreover, the courts have been so demonstrably reasonable about using "species of the genus" notions in "new art infringement" cases as to invite the suggestion that

¹²⁰ The *Jerome* court noted that a distinction between mechanical recordings (music rolls, phonograph records, *et al.*) and motion pictures had been drawn in the legislative history attending the Townsend Amendment. *Id.* at 742, citing H.R. Rep. No. 756, 62d Cong., 2d Sess (1912). The court did not specify where that distinction appears in the House Report. The court may have been referring to the House Committee's note that the Townsend Amendment would not affect the compulsory license provision of section 1(e). H.R. Rep. No. 756, 62d Cong., 2d Sess. 2 (1912); S. Rep. No. 906, 62d Cong., 2d Sess. 2 (1912). The court may also, or alternatively, have been referring to the House Committee's note that the motion picture amendments would not operate as a compulsory license. *Id.* at 4; S. Rep. No. 906 at 3.

¹²¹ 67 F. Supp. at 742.

¹²² Meagher, *supra* note 111, at 1082.

"reasonableness" enters the structure of "species of the genus" doctrine *only* when "new art infringement", and not "new art copyrightability", is in issue.

Thus, in *Rossiter v. Hall*,¹²³ it was held that the plaintiff's copyrighted engravings had been "copied" when the defendant produced and sold photographs of these engravings, thereby infringing the plaintiff's exclusive rights attending the copyrights owned. The plaintiff's rights were claimed under an Act of 1831. Photographs had recently been extended statutory recognition under an Act of 1865. The defendant argued that his photographs could not "copy" the plaintiff's engravings under the Act of 1831 because the art of photography had not been known when that statute was passed. In denying the defendant's claim, the *Rossiter* court noted that to hold otherwise would work to repeal the protection accorded by copyright law in many cases.¹²⁴ The unreasonableness of such a result was further considered when the court noted that since the protection against infringing copying extended to photographs by the Act of 1865 was dependent upon the construction of the language of the Act of 1831, the construction given to the Act of 1831 was necessary to render protective effect to the Act of 1865.¹²⁵

In *Kalem Co. v. Harper Bros.*¹²⁶—relied upon by the *Page* court as authority for its application of "species of the genus" theory to sound-on-film motion pictures—the United States Supreme Court held that the plaintiff's exclusive right to dramatize a novel had been infringed by the defendant's manufacture and sale of a motion picture version of that novel. The plaintiff's rights were claimed under an Act of 1891. Motion pictures were not to receive legislative recognition as copyrightable until a year after *Kalem* was decided, and it is not likely that Congress was aware of the existence and future of Mr. Edison's invention by 1891. The Court, noting the purpose of the statutory clause extending the exclusive right to dramatize,¹²⁷ and after discussion of the aesthetic fluidity of a

¹²³ 20 Fed. Cas. 1253, No. 12,082 (C.C.E.D.N.Y. 1866).

¹²⁴ The *Rossiter* court noted that books could be reproduced as easily as engravings by a photographer, and that books, therefore, would emerge as unprotectible as engravings if the defendant's argument was accepted. *Id.* at 1254.

¹²⁵ The *Rossiter* court noted that the Act of 1865 extended protection to photographs by providing that the provisions of the Act of 1831 be extended to apply to photographs. *Id.*

¹²⁶ 22 U.S. 55 (1911).

¹²⁷ The Court noted that "[t]he law confines itself to a particular, cognate and well known form of reproduction," *id.* at 63, such that it protects against a reproduction in the form of action.

“dramatization”,¹²⁸ brought the defendant’s activities within the terms of a right defined before motion pictures were known beyond the laboratory.

Language immediately suggestive of a mandated “reasonableness” approach to “new art infringement” cases began to appear with the decision in *Jerome H. Remick & Co. v. American Automobile Accessories Co.*¹²⁹ In this case the plaintiff argued that its exclusive right to perform a copyrighted musical composition publicly for profit had been infringed by the defendant’s commercial radio broadcast of that musical composition. The plaintiff’s rights were claimed under the Act of 1909, enacted before the radio was developed. The court held that the plaintiff’s exclusive right had been infringed by the defendant’s radio broadcast, reasoning that:

... the statute may be applied to new situations not anticipated by Congress, if, fairly construed, such situations come within its intent and meaning. [The court then noted earlier recognitions of this proposition, citing *Rossiter v. Hall*.] While statutes should not be stretched to apply to new situations not fairly within their scope, they should not be so narrowly construed as to permit their evasion because of changing habits due to new inventions and discoveries.¹³⁰

Both the decision and rationale of *Remick* were given specific sanction by the United States Supreme Court in *Buck v. Jewell-LaSalle Realty Co.*¹³¹ In this case the plaintiff’s exclusive right to publicly perform a copyrighted musical composition was held to have been infringed by the defendant hotel proprietor’s installation and use of a radio receiving set and loudspeakers in his hotel, where the defendant’s patrons could be entertained by radio broadcasts of the plaintiff’s musical composition. In view of the earlier decisions in *Kalem* and *Remick*, the defendant did not contend that radio broadcasting could not be brought within the scope of the Act of 1909, under which the plaintiff claimed his rights. Rather, the defendant argued that no two or more performances could be perceived within a single rendition of a copyrighted musical composition, since Congress could not have been aware of the possibility of effecting multiple performances from a single rendition when the 1909 statute was passed. Rejecting this argument, Mr. Justice Brandeis noted a judicial

¹²⁸ The Court confined its analysis to the manners by which “drama may be achieved by action” without speech. *Id* at 61.

¹²⁹ 5 F.2d 411 (6th Cir. 1925).

¹³⁰ *Id.* at 411.

¹³¹ 283 U.S. 191 (1931).

duty of reasonable construction relative to the statutory construction issue before the Court.¹³² Both *Kalem* and *Remick* were cited as authority for the derivation of this duty.

While *Rossiter*, *Kalem*, *Remick*, and *Buck v. Jewell*, by virtue of their frontal concern with "fair constructions" and "protective duties", lend considerable weight to the argument that a "reasonableness" maxim inheres in proper "species of the genus" analysis, they perhaps fail as an additional line of authority to lend conclusive weight to that argument, for the "reasonableness" maxim they espouse operates within this line of authority only as to a "new art infringement" issue. Despite the "reasonable relations" of a constitutional dimension frontally identified in *Edison v. Lubin* and *American Mutoscope* within a "new art copyrightability" setting, it has been suggested that the "reasonableness" maxim employed in "species of the genus" analysis by the courts in *Rossiter*, *Kalem*, *Remick*, and *Buck v. Jewell*, "while appropriate to prevention of new-art 'evasions' of the rights in recognized copyright subjects, is not particularly applicable to the new-work-copyrightability question"¹³³ itself.

However, no reason has been offered as to why that approach may be deemed inappropriate in a "new art copyrightability" setting. More importantly, what evidence we have other than that provided by the motion picture cases already noted suggests not only that the "reasonableness" maxim is as appropriate in a "new art copyrightability" setting as in a "new art infringement" setting, but that it is as mandated by law in the copyrightability context as in the infringement context.

Surely there has been no erosion of a "reasonableness" approach when a "species of the genus" analysis has been applied in cases which fall into a third class distinguishable from the two previously noted: those in which it is sought to hold that a newly copyrighted art itself is infringed as to rights claimed to arise under statutory language enacted prior to the development of the new art. Such cases arise when the section 1 general enumeration of rights is not appropriately amended to accommodate a section 5 amendment extending new art copyrightability. Since the legis-

¹³² Mr. Justice Brandeis stated, *id.* at 198:

... nothing in the Act circumscribes the meaning to be attributed to the term "performance," or prevents a single rendition of a copyrighted selection from resulting in more than one public performance for profit. While this may not have been possible before the development of radio broadcasting, the novelty of the means used does not lessen the duty of the courts to give full protection to the monopoly of public performance for profit which Congress has secured to the composer.

¹³³ Meagher, *supra* note 111, at 1086.

lative treatment accorded motion pictures in 1912 provides a classic instance in which such a lapse led to *sui generis* treatment under the Copyright Act, it is not surprising to find that the better known cases of this class are, in fact, motion picture cases.

Thus, in *Tiffany Productions, Inc. v. Dewing*,¹³⁴ *Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theatre Co.*,¹³⁵ and *Universal Pictures Co., Inc. v. Harold Lloyd Corp.*,¹³⁶ it was held that a motion picture photoplay was a "dramatic work" as that term is used in section 1(d), and that plaintiff proprietors of various copyrighted motion picture photoplays were entitled to invoke the protection of section 1(d) to prevent unlicensed exhibition, performance, or reproduction. The courts in *Tiffany* and *Metro* rejected the argument that section 1(d) was inapplicable to motion picture photoplays because motion pictures were not commercially known when the Copyright Act was passed in 1909. Both courts cited *Kalem* and Mr. Justice Brandeis' "reasonableness" thesis in *Buck v. Jewell* in support of their holdings. The *Tiffany* decision was expressly approved by the First Circuit in *Metro* and later by the Ninth Circuit in *Universal*.

The *Metro* disposition underwent an evolution worth noting. The case was remanded after decision by the First Circuit,¹³⁷ whereupon the defendants' argument was again rejected, again on authority of *Buck v. Jewell* and *Kalem*.¹³⁸ However, the district court also found another reason why the defendants' argument was without merit. In one of the few instances where film history was judicially examined to glean legal relevance in a "species of the genus" setting, the district court took judicial notice of the development of the motion picture from 1888 to 1908 and concluded that motion pictures were commercially known prior to 1909.¹³⁹ The attention to "reasonableness" in "species of the genus"

¹³⁴ 50 F.2d 911 (D. Md. 1931).

¹³⁵ 59 F.2d 70 (1st Cir. 1932).

¹³⁶ 162 F.2d 354 (9th Cir. 1947).

¹³⁷ The First Circuit's protective holding applied to motion picture photoplays. The court was not called upon to decide whether the unlicensed exhibition of a motion picture other than a photoplay would infringe any section 1(d) rights. Since the original bill of complaint drawn by the plaintiff motion picture proprietors did not identify the specific type of motion picture as to which infringement was alleged, the First Circuit set aside a district court decree dismissing the plaintiffs' bill of complaint and remanded with direction to allow any desired amendment to the bill. 59 F.2d at 76-77.

¹³⁸ *Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theatre Co.*, 17 U.S.P.Q. 124 (D.C. Mass. 1933).

¹³⁹ *Id.* at 130.

statutory construction exhibited by the various courts in these “new art infringed” cases may best be summarized by the First Circuit’s statement in *Metro* that:

The copyright statutes ought to be reasonably construed with a view to effecting the purpose intended by Congress. They ought not to be unduly extended by judicial construction to include privileges not intended to be conferred, nor so narrowly construed as to deprive those entitled to their benefits of the rights Congress intended to grant.¹⁴⁰

The “new art infringed” cases are clearly more analogous to “new art copyrightability” cases than to “new art infringement” cases. For in “new art infringement” cases, the courts have been concerned with new art evasions of the rights attending other copyright subjects, while in “new art copyrightability” cases and in “new art infringed” cases, the courts have been concerned with protection of the new art itself. Yet, contrary to the assertion of a dichotomous “species of the genus” approach to statutory construction, a “reasonableness” maxim has operated as forcefully in the “new art infringed” cases where the concern was new art protection, as it has operated in the “new art infringement” cases where the concern was new art evasions of the rights in recognized copyright subjects. It would seem, then, that the same maxim should also operate in the field in which *Edison v. Lubin* and *American Mutoscope* indicate that it holds equal sway—in “new art copyrightability” cases, where new art protection is entirely at issue.

Before further exploring the tenability of this position, it may be appropriate to ask: if “reasonableness” may be shorn from “species of the genus” statutory construction in “new art copyrightability” cases, what, then, shall be its analytical replacement? Reference was made earlier to the anti-protectionist suggestion that a purely physical symmetry between genus and species might dispose of whatever reasonable legal construction is called for in application of the “species of the genus” theory within a copyrightability setting. That suggestion was identified as suspect when noted because a physical symmetry analysis cannot alone dispose of whatever constitutional problem inheres in “species of the genus” analysis. As we have seen, the courts in *Edison v. Lubin* and *American Mutoscope* employed physical symmetry to identify an aesthetic symmetry by which the early motion picture, like the photograph, could be considered a light-written “writing”. Correspondingly, as to statutory construction of the

¹⁴⁰ 59 F.2d at 76.

motion picture amendments, the visual/visual-aural nature of the physical symmetry posited in anti-protectionist theory is historically insupportable, at least aesthetically. It is extremely unlikely that the members of the 62nd Congress ever saw a motion picture without sound accompaniment. Hence, both genus and species of aesthetic concern here are arts enjoyed as sight and sound experiences, the species being distinguished from the genus only by virtue of the technological attachment of sight and sound.

Nevertheless, the physical "sameness" quotient appears to be the agreeable replacement for reason where a dichotomous rule of "species of the genus" statutory construction has been urged. For, independently of but in accord with the physical symmetry position, it has been argued that:

One might therefore conclude . . . that the rule concerning copyrightability of a new work under a pre-existing statute stands as follows: where the new work is the result of an "advance" in an old art, the products of which had had recognized copyrightability under the statute, but is still basically the product of the same "processes" as the recognized class of works, the fact that the statute was enacted prior to knowledge or development of the "advance" will not bar copyrightability of the new work; but, where the new work is not the result of such an "advance" or "new development" in the old art, nor an "extension of the old processes," but rather the product of methods "entirely original and independent" of the recognized arts, the new work cannot be brought under the old-art terms of copyrightable subjects in a statute passed before knowledge and development of the new methods.¹⁴¹

The problem with this analysis is that it mistakes the trees of physical process for the forest of copyrightability concerns. Certainly physical symmetry may be identified as *a* concern of "species of the genus" copyrightability analysis. Yet to say that it is the determinative factor of

¹⁴¹ Meagher, *supra* note 111, at 1085. The rule proposed by Meagher is compounded from a reading of *Wood v. Abbot*, 30 Fed. Cas. 424, No. 17,938. (C.C.S.D.N.Y. 1866), as well as a reading of *Edison v. Lubin*. In *Wood v. Abbott* it was held that a photograph was not copyrightable as a print or an engraving under a pre-existing statute; thus, the plaintiff's photographs could not be protected from the defendant's copying as "prints, cuts, or engravings" under the terms of the antecedent statute. There is neither physical symmetry nor aesthetic symmetry between the art of photography and the arts of printing or engraving. The *Wood* court's discussion of the radical differences between these arts began with a denial of physical symmetry and ended with a denial of aesthetic symmetry. *Id.* at 425.

that analysis is to turn a mere utility into an analytical tool of little legal value to the analyst. Physical symmetry, for instance, cannot override the failure to meet *de minimis* requisites of copyrightability, no matter how identical the creative processes involved, no matter how same the "sameness" claimed.¹⁴² Physical symmetry would rather appear to be a valuable consideration in "species of the genus" copyrightability analysis only when used to identify an aesthetic symmetry which springs from the basically similar manners in which old and new art processes are employed to project the "writings" of "authors". That would harmonize the utility of physical symmetry with the core consideration of copyrightability itself. That is also precisely the use made of physical symmetry in *Edison v. Lubin* and *American Mutoscope*.

Such use is special, however, for it mandates the application of reason in a "species of the genus" copyrightability analysis. Indeed, just as there can be no ideational concern in copyright law without an aesthetic concern, there can be neither ideational nor aesthetic concern in a "species of the genus" copyrightability analysis without an application of reason. In this regard, it must not escape notice that all copyrightable subjects are nothing less than "species" of the "genus" identified as "writings" in the Constitution—a statute enacted substantially prior to the technological development of many subjects later deemed copyrightable. When that is remembered, it may be conclusively established that a "reasonableness" maxim has been part and parcel of "species of the genus" copyrightability analysis since the implicit inception of that analysis. No lengthy turning of the judicial pages of copyright history is necessary to prove the point.

The courts in *Edison v. Lubin* and *American Mutoscope* supported their searches for "reasonable relations" of a constitutional dimension with reference to *Burrow-Giles Lithographic Co. v. Sarony*, where the congressional grant of copyright protection to photographs in 1865 was upheld as constitutional. In *Burrow-Giles*, a unanimous United States Supreme Court identified photographs as one of the classes of literary productions embraced by the term "writings", as that term is used in the Copyright Clause of the Constitution, and as that term was construed by Congress in 1790 and later in 1802. The constitutional identification operated at least in so far as photographs represented "original intellectual conceptions",¹⁴³ and despite the fact that the art of photography was entirely unknown as late as 1802. It is well known that the boundary between the new art and "writings" was measured in *Burrow-Giles* by the

¹⁴² The *de minimis* rule pervades all classes of copyrightable subject matter. LATMAN, *supra* note 11, at 19.

¹⁴³ *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

¹⁴⁴ *Id.*

application of reason to statutory construction, and that this boundary was closed by positing an embryonic aesthetic symmetry among the various manners "by which the ideas in the mind of the author are given visible expression."¹⁴⁴

That this "reasonableness" motif has assumed the force of an analytical maxim in the practice of copyrightability analysis is quite demonstrable. Judicial condonation has consistently been accorded to the congressional expansion of copyright to embrace new art expressions of the ideas of "authors".¹⁴⁵ Moreover, that this "reasonableness" maxim most appropriately takes the form of a "reasonable relation" search of aesthetic character in "species of the genus" copyrightability analysis was the apparent thesis of Judge Learned Hand. In *Reiss v. National Quotation Bureau, Inc.*¹⁴⁶ it was held that a code book containing a large number of coined words having no known meaning, but aesthetically and practically useful once adapted to convey an agreed meaning via cable correspondence of ideas, was a "writing" under the Constitution. Rejecting the defendant infringers' argument that certain English cases favorable to the plaintiff's cause were distinguishable because they arose under an act of Parliament which was not limited by any Constitution, Judge Hand stated:

So, indeed, they were, and if our Constitution embalms inflexibly the habits of 1789 there may be something in the point. But it does not; its grants of power to Congress comprise, not only what was then known, but what the ingenuity of men should devise thereafter. Of course, the new subject-matter must have some relation to the grant; but we interpret it by the general practices of civilized peoples in similar fields, for it is not a strait-jacket, but a charter for a living people.¹⁴⁷

If, on authority of *Burrow-Giles*, *Reiss*, *Edison v. Lubin*, and *American Mutoscope*, we must accept the "reasonableness" maxim as a structural wing of the "species of the genus" analysis applied in a "new art copyright-

¹⁴⁵ E.g., note the continuum of judicial sanction in the field of photography following the *Burrow-Giles* decision: *American Mutoscope & Biograph Co. v. Edison Mfg. Co.*, 137 Fed. 262 (C.C.D.N.J. 1905) (see note 115 *supra*); *Pagano v. Chas. Beseler Co.*, 234 Fed. 963 (S.D.N.Y. 1916) (photograph of street scene and public building, taken after creative decision making, is a "writing"); *Jewelers' Circular Pub. Co. v. Keystone Pub. Co.*, 274 Fed. 932 (S.D.N.Y. 1921) (every photograph must be a "writing" because no photograph, however simple, can be unaffected by personal influence of photographer).

¹⁴⁶ 276 Fed. 717 (S.D.N.Y. 1921).

¹⁴⁷ *Id.* at 719.

ability" context, we may properly inquire as to the direction by which a responsible "reasonable relation" inquiry should proceed. Since there are two genus/species patterns which have emerged from copyrightability analyses of the past, it would appear that two relationships are of independent or correlative importance in seeking to fashion rules of copyrightability analysis.

When the statutory "genus" is contained within the Constitution ("writings"), and a newly developed "species" is claimed to rest constitutionally within a protection announced by Congress, then a simple rule of reason operates. In this case, the newly developed "species" may be identified with the statutory "genus", to the extent the aesthetic distinctions of the newly developed "species" render it reasonably compatible with both the traditional judicial construction of "writings", and the constitutional mandate "To promote the Progress of Science and useful Arts . . ." Such was the relation of the idea-expressing photograph in *Burrow-Giles*, and of the aesthetically or practically useful code book in *Reiss*, to "writings" and to the promotive/protective constitutional charge.

When, however, the statutory "genus" has already been identified as a "species" itself, of the constitutional "genus" called "writings", and as a legitimate effectuation of the promotive/protective constitutional charge, and a newly developed "species" is claimed to assume the protection legislatively accorded the antecedent "genus", then a somewhat different rule of reason operates. In this case, the newly developed "species" may be identified with the antecedent "genus", not only to the extent its aesthetic distinctions render it reasonably compatible with the antecedent "genus", but also to the extent the "reason of the copyright protection" accorded the antecedent "genus" would be undercut or nullified unless the newly developed "species" is embraced within the copyright protection accorded by statute to the antecedent "genus". Such was the relation of idea-expressing, light-written motion picture to idea-expressing, light-written photograph in *Edison v. Lubin* and *American Mutoscope*.

Clearly, application of the second rule guards fully against mitigation of any protective effect established by application of the first rule. The point may be illustrated in motion picture terms when we consider that in denying protection to the dialog tracks and/or the music tracks of a motion picture, we may also eliminate the protection covering much of the idea-expression of the motion picture work, and thereby remove that work from the category of "writings" as it was presented by its "author" to lie therein. If the aesthetic distinctions of a motion picture, when its soundtrack or solely its music tracks are deemed unprotectible, render the motion picture no longer as fully compatible with a "writing" as it was when intact, or no longer fully compatible with the constitutionally charted protection extended by Congress to motion pictures, then the

newly developed “species” (motion pictures with soundtracks) must be identified with and embraced within the statutory protection accorded the antecedent “genus” (motion pictures without soundtracks). Given the stated condition, that result must follow, unless we are to nullify the congressional grant and render meaningless the promotive/protective constitutional charge vis-à-vis motion pictures. The alternative does not in any way commend itself to reason. Since it is “reasonableness” that we have seen to form one wing of the framing structure of “species of the genus” copyrightability analysis, the alternative would not be available, at least in the context of a *legal* “species of the genus” copyrightability analysis.

As was noted earlier, that “reasonableness” is by logic a requisite of “species of the genus” copyrightability analysis has been at least sensed in anti-protectionist circles. As is now evident, there is by law very little “perhaps”, no mere “falling back”, and much more than “fairness” to the casual copyrightability suggestion: “Perhaps it is fair . . . to fall back upon the reason of the thing.”¹⁴⁸

However, we have not yet examined the extent to which the motion picture may be disemboweled as to its ideational distinctions by severing its sound from its visuals. It was suggested elsewhere, remember, that one could look responsibly at “the reason of the thing” and *at least* deem the motion picture music tracks unprotectible. That is an aesthetic concern. That concern has not been transposed to any aesthetic analysis supportive of the anti-protectionist claim. It has not previously lent itself to appropriate aesthetic analysis here. Yet that analysis may lie at the heart of a constitutionally proper soundtrack copyrightability inquiry. As to its legal implications, it may be our largest responsibility to undertake that analysis.

As we pass into such a confrontation, several salient implications arise from the preceding analysis which can bear conceptual fruit only after our aesthetic examination has been made. We have seen that a “reasonableness” maxim is as mandated a legal consideration in “species of the genus” copyrightability analysis as are the copyrightability tests of *White-Smith*. Our question as to this framing structure of “species of the genus” copyrightability analysis was initially posed as singular. With our answer in tow, another question emerges now and will be considered shortly.

We may ask: what relationship, if any, exists between the “reasonableness” maxim and the *White-Smith* tests when the “species of the genus”

¹⁴⁸ See text accompanying note 61 *supra*.

theory is applied to a copyrightability issue? As to the motion picture soundtrack copyrightability issue, we have already had more than a hint of a relationship of compatibility between these two poles, for both "reasonableness" and "intelligibility" notions derive most understandably from aesthetic perceptions, be they the courts' or Congress', and as they were derived in *Burrow-Giles* and *Reiss*.

But if there is indeed a relationship between the two poles when the "species of the genus" theory is applied within a copyrightability setting, may it be one of interaction as well as of compatibility? Of this we have had a strong indication also. The denial of motion picture copyrightability to an isolated motion picture visual track, as a potential function of the denial of motion picture copyrightability to an isolated motion picture soundtrack, would not be a result commending itself to reason, though the twin denials be based on *White-Smith* analyses which might appear to be proper in themselves.

However, whatever the dimensions of the anticipated relationship, it is through aesthetic analysis that we may come to appreciate any identified bridge, and it is to motion picture aesthetics that we now turn.

(C) *The Aesthetic Identity of the Motion Picture Soundtrack*¹⁴⁹

"Music," as Judge Hand noted in *Reiss*, "is not normally a representative art."¹⁵⁰ A distinguishing characteristic of film music, however, is that it is always a representative art—and one which operates visually as well as aurally. For that reason, film music has often been identified as the only new form of music to have been developed in the 20th century. Since their evolution from "peep show" curios to narrative art during the final years of the 19th century, movies have simply never been without music. Can it be, as anti-protectionist theory at its bottom line would have us believe, that such a new form of music, entirely bequeathed by the motion picture art, has made no material contribution to the integrated motion

¹⁴⁹ Since the importance of the dialog tracks incorporated in the film soundtrack has been conceded in anti-protectionist theory when a look at the "reason of the thing" is deemed fair, it is unnecessary to explore that importance when "reasonableness" is seen to be mandated. We deal here, then, only with the importance of the music tracks incorporated in the film soundtrack. Moreover, even within the context of a music track analysis it appears unnecessary to explore the aesthetic identity of on-screen vocal numbers or off-screen songs, since the relationship of lyricised music to dialog or narration is obvious. Thus, the aesthetic identity of the dramatic orchestral music incorporated in the film music tracks emerges as our only necessary concern with the aesthetic identity of the motion picture soundtrack.

¹⁵⁰ *Reiss v. National Quotation Bureau, Inc.*, 276 Fed. 717, 718 (S.D.N.Y. 1921).

picture art, but rather has served extraneously to merely enhance the enjoyment of that art? If aesthetics must be considered frontally—and indeed they must when aesthetic distinctions are claimed, without benefit of aesthetic analysis, to deny copyrightability to part of an artistic unity—then here we shall delve into aesthetics to attain that most subjective of copyright identifications: the aesthetic explanation.

For the legal analyst, however, it is hardly the most familiar of intellectual sojourns. As one writer in the area has noted,¹⁵¹ describing the values and functions of the mysterious art of combining moving pictures with music is rather like describing a beautiful woman—if it must be done fully, it cannot be done adequately. If, then, the aesthetic analysis is to be achieved in reasonably precise fashion, it is perhaps best to allow those who understand that mysterious art most fully—and who share with their employers the most to lose should the aesthetic claims of anti-protectionist theory be adopted judicially—speak for both their musical art and their role in a motion picture art. That shall be the format employed here.

A recognition of the indispensability of music to film—not as to all films, but rather as to the aesthetic arsenal of film making techniques from which all films are selectively constructed so as to present “ideas” in cinematic fashion—can arise only as a function of the basic recognition of the film art as a mosaic art. As to the creative distinctions of the motion picture, that was the concept urged by George Méliès in France before the turn of the century and refined by D. W. Griffith in America after the turn of the century.¹⁵² For three quarters of a century that concept has not been questioned in film theory; yet now we find it denied in legal theory. As to the role of music within that art, we shall let a film historian introduce our analysis, lest the explanations of film composers which follow appear self-serving to the uninitiated.

At its most general level, film music serves as a kind of cohesive, filling in empty spaces in the action or dialogue—this is neutral,

¹⁵¹ T. THOMAS, *MUSIC FOR THE MOVIES* 17 (1973). [hereafter, THOMAS.]

¹⁵² See KNIGHT, *supra* note 77, at 23-37. Note that expressions of this mosaic concept evidence the degree to which the mosaic nature of the film art is cherished by film artisans. *E.g.*, director King Vidor speaks of “an indellible oneness about music and film,” K. VIDOR, *KING VIDOR ON FILM MAKING* 145 (1972), and notes: “. . . I do know that cinema embraces all the arts and brings them all to her ample bosom.” *Id.* at 142. Composer Ralph Vaughan-Williams identified the disposition of the film composers when he averred that “the film contains potentialities for the combination of all the arts such as Wagner never dreamt of.” Johnson, *Face the Music*, *FILM QUARTERLY*, Summer, 1969, at 3, quoting R. Vaughan-Williams.

background music and the composer's most ungrateful job since it must enliven and colour scenes without drawing attention to itself.

Film music must also build a sense of continuity, uniting the visual parts—this is most important because a theatrical film is like a jig-saw puzzle. The most obvious example of this is the cinematic montage—a cascade of varying shots that would be chaotic without some unifying musical thought.

Something else that skilful scoring can accomplish is underlining the theatrical build-up of scenes, pinpointing various emotions and actions, and then rounding it off with a sense of finality. In this sense, music is a definite story-telling device. Another aspect of this device is that of utilizing "source music," that is, music that can be seen on the screen—coming from a radio, or a record player or from a dance band, a circus, a cafe or an actor playing an instrument.

On a higher level of accomplishment, film music can do two greatly important things (how well depends on the composer). One: create an atmosphere. Two: colour the tone of the picture. Atmosphere music can be quite obviously geographical or historical, placing the story in a certain locale at a certain time with certain kinds of people in certain kinds of situations, but it's a test of the composer's knowledge and imagination how well he does this.

.... This is the psychology of scoring, being able to shade emotions, to lighten or darken moods, to heighten sensitivities, to imply, to suggest, to define character and refine personality, to help generate momentum or create tension, to warm the picture or cool it, and—most subtle of all—to allude to thoughts that are unspoken and situations that remain unseen. Such music plays upon the minds of the audience.¹⁵³

The most familiar musical device through which this psychology of scoring is achieved is the leitmotif—"a specific theme continually used to identify a specific character, situation, or emotion."¹⁵⁴ Through use of this device, the film makers can project what the visual alone may not project: a specific thought process of a character.¹⁵⁵

Thus, in Max Steiner's score for "The Informer" ('35), the motivations which drive Gypo Nolan to an act of betrayal (the desire to obtain money to provide passage from war-torn Ireland to America) are repeatedly identified musically. Whenever Gypo stares at a reward poster picturing his friend's face, recognizably American tunes are interjected within an otherwise murking musical atmosphere of Irish character. In "Laura" ('44), the process by which the detective falls in love with a woman he believes to be dead is demonstrated musically. Throughout the first

¹⁵³ THOMAS, *supra* note 151, at 17.

¹⁵⁴ Bernstein, *supra* note 85, at 56.

half of the film, Laura exists in the present only by virtue of her portrait and her representation in David Raksin's music. In "A Place In the Sun" ('51), the murderous impulses which stir within George Eastman are not described by dialog prior to the climactic "murder". Rather, composer Franz Waxman represents these impulses with "low-pitched, regularly accented eighth notes that [are] readily recognizable whenever they occur. . . ." ¹⁵⁵ The terrors and guilts imbedded within Blanche DuBois' tragic past are central to an understanding of her disintegration in the final scenes of "A Streetcar Named Desire" ('51). Until that disintegration occurs, its dramatic justification enters the structure of the film musically, through Alex North's fracturing interjection of the "Varsouviana" (capped by an echoing gunshot) within an otherwise piercingly delicate musical fabric.

Most films depend upon the use of the leitmotif to some extent to present ideas which cannot be—or which have not been elected to be—otherwise expressed. It is not surprising, then, to find the leitmotif employed as a central element in the structure of the film often described as the greatest film ever made.

"Citizen Kane" ('41) operates on many intellectual levels, and not the least of its successes is this film's achievement as mystery. Indeed, every dramatic element of *Kane* springs from the cinematic use of artifice—the search for the meaning of "Rosebud". This meaning is made obviously evident at the very end of the film as the camera approaches the furnace at Xanadu to discover that little sled before it is consumed by fire. However, no mystery succeeds as mystery unless the solution has been made elliptically evident long before it is made obviously evident. It was director

¹⁵⁵ There is also an accepted language by which the motion picture camera may identify some specific thought processes of a character, but that language is much more limited in this respect than is the language of film music, which, with the visual, can explore a wide range of character thoughts. *E.g.*, Professor Sarris notes, in A. SARRIS, *THE AMERICAN CINEMA* 55 (1968):

The opening, wordless sequences in *Rio Bravo* [59] present all the moral issues of the film. The low-angle shot of [John] Wayne looking down at [Dean] Martin with sorrowful disdain tells the audience all it has to know about the two men, and [director Howard] Hawks even tilts his camera to isolate the relationship from its background and to intensify the reciprocal feelings of shame and disappointment.

It is important to note that there is only so much that one can do with camera positioning vis-à-vis the thoughts of characters, and that even then music is often employed with the camera to identify the thoughts. In "Rio Bravo", for instance, the opening camera shots described above are accompanied by suspended, dissonant musical chords.

¹⁵⁶ Hendricks, *Film Music Comes of Age*, in *FILM MUSIC* 45 (J. Limbacher ed. 1974).

Orson Welles' intention to identify "Rosebud" at the very beginning of the film—but subtly. Thus, as the film begins, with the camera passing above a "No Trespassing" sign to descend upon the voluminous contents of Xanadu, composer Bernard Herrmann deploys twin leitmotifs to identify, through the scoring, the two central ideas of the film: the unspoiled innocence of Kane's childhood ("Rosebud"), and its antithesis, Kane's consumptive lust for power throughout his maturation ("Kane's Ambition"). The "Ambition" motif is played against the "Rosebud" motif, the latter entering the structure of the film at this point to indicate that "Rosebud" itself is buried within the debris seen on-screen, the former entering in counterpoint to note that Kane's whole adult life has been lived in contradiction of the ideal represented by "Rosebud". Then, as Kane dies on-screen and the audience is given to wonder what a fading colossus thinks of as he expires, all of the musical motifs and atmospheres of Kane's childhood are presented on the soundtrack. Minutes later, in the first of many flashbacks through which Kane's life story is told, Kane is shown as a child playing with his sled in the snow, while the "Rosebud" motif is boldly and lyrically developed in the scoring. And so, in one of many similarly constructed scenes of this film, the music of "Citizen Kane" assumes its position as a major part of the ideational structure of the movie.¹⁵⁷ Without its music, *Kane* is virtually a digest version of the artistic whole.

It is unnecessary to examine every foot of "Citizen Kane", or of any other film, to determine just how much a part of a film's ideational content music can be and often is. The initial point, it is assumed, has been made by reference to one enduringly famous example. Leitmotifs are not always necessary to the structural fabric of a film, but music itself almost always is. The composer of "Citizen Kane" explains why:

The real reason for music is that a piece of film, by its nature, lacks a certain ability to convey emotional overtones. Many times in many films, dialogue may not give a clue to the feelings of a character. It's the music or the lighting or the camera movement. When a film is well made, the music's function is to fuse a piece of film so that it has an inevitable beginning and end. When you cut a piece of film you can do it perhaps a dozen ways, but once you put

¹⁵⁷ The limited "Citizen Kane" analysis offered here has been drawn from, and explanations of other scenes in "Citizen Kane" may be found within, the following: Palmer, *The Classic Film Scores of Bernard Herrmann* (RCA brochure published with RCA LP ARL 1-0704, 1974); Cook, *Bernard Herrmann*, 18 *FILMS IN REVIEW* 398 (1967); Gilling, *The Colour of the Music*, *SIGHT AND SOUND*, Winter, 1971-72, at 35 [hereafter, Gilling].

music to it, that becomes the absolutely final way. . . .

Music essentially provides an unconscious series of anchors for the viewer. It isn't always apparent and you don't have to know, but it serves its function. I think Cocteau said that a good film score should create the feeling that one is not aware whether the music is making the film go forward or whether the film is pushing the music forward.¹⁵⁸

Bernard Herrmann's reference to the manner in which the viewer perceives the phenomena of movement and emotionality in film lends itself to exposition by examples. As to the cinematic phenomenon of movement, the following summary is indicative of the aesthetic rationale of this point:

Why does film need background music? As Ernest Lindgren points out in *The Art of Film*, music and film each depend upon the phenomenon of movement, and are thereby allied aesthetically. Second, sound movement reinforces visual movement. Third, and most important, music balances the sensual experience of sight with that of sound, and we are more relaxed when we are not straining to comprehend through one sense alone.¹⁵⁹

Thus, composer Elmer Bernstein has noted that his initial scoring of the long exodus scene in "The Ten Commandments" ('56), where Moses leads the Hebrews out of Egyptian bondage, was emphatically rejected by director Cecil B. DeMille precisely because the music accurately reflected the pace of the scene, as it had been filmed and edited, with some 8000 extras marching in passive and lumbering fashion. DeMille insisted that the young composer write music for the scene having a much faster pace than that possessed by the isolated visual. The director explained that the visual would then assume the hurried pace and jubilant message of the music. Bernstein rescored the scene as directed, and thereby learned early in his career, and from an experienced teacher, exactly how cinematic energy is achieved. Later Bernstein wrote the music for the slowly paced "The Magnificent Seven" ('60) in tempos always faster than those of the isolated visual. The film thus became one of the most rhythmically vigorous of westerns.¹⁶⁰

As Composer Leonard Rosenman notes:

You're dealing with two arts that are very similar—sight and sound—both move in time and both require memory for the per-

¹⁵⁸ Gilling, *supra* note 157, at 37, quoting B. Herrmann.

¹⁵⁹ Embler, *The Structure of Film Music*, in *FILM MUSIC* 61 (J. Limbacher ed. 1974). [hereafter, Embler.]

¹⁶⁰ Bernstein, *supra* note 85, at 57-58.

ception of organization. . . . The film composer has to bear in mind that we are a visually oriented society. In fact, it's biological; more of our brain is given to vision than to hearing. Film music should be an analogue to the action of the film, and likewise, the film should become an analogue of the dramatic action of the music. This is the value of a director and composer working together in the construction of the film.¹⁶¹

Music has been regarded as especially valuable in achieving a cinematic sense of movement where movement itself is most difficult to achieve in films—in battle scenes, particularly massive ones. Music is almost always used to lend structure, progression, and often meaning to battle footage which, without music, would generally be chaotic and incomprehensible beyond the accepted muscularity of the images themselves. For the visually cumbersome “Battle On the Ice” fought between the Russians and the German invaders in “Alexander Nevsky” (’38), Sergei Prokoviev’s music adds terror to the otherwise static approach of the Teutonic knights through the mist, creates an overpowering combative energy as the ancient military forces meet on the ice, and continues almost as the propelling force of the battle itself, until finally it explodes in hymnal thanksgiving to announce that the Grand Duke Alexander has carried the day. Director Laurence Olivier was so intent that the structure, tension, and meaning of the Battle of Agincourt be fully perceived in “Henry V” (’46), that William Walton’s music for the scene was given full prominence therein; even sound effects were omitted from the soundtrack during the battle scene. For the longest sustained, most intricately edited scenes of mass warfare yet produced, Dimitri Tiomkin’s battle scoring in “The Alamo” (’60) reads like an audio-visual symphony, its successive movements devoted to plunging the audience into various patterns of warfare until the large orchestra, announcing “No Quarter”, joins the camera to hurl on-screen enemy army and off-screen audience against and into the famed chapel where the last stand of the wounded is made, where the camera freezes, and where the music ends. So successful is the marriage of sight and sound in this last example, that not only is a cinematic sense of propulsion created, but the creation apparently causes all sense of time to be lost. Though the sequence consumes about twelve minutes of screen time, reviewer after reviewer reported it as encompassing a full hour.

¹⁶¹ THOMAS, *supra* note 151, at 207, quoting L. Rosenman. For information about the impact of film music on the human body, in the physiological sense, see: Johnson, *Face the Music*. FILM QUARTERLY, Summer, 1969, at 3, 3-5.

This losing of time sense often operates concurrently with the manipulated perception of movement in the motion picture art. It is particularly endemic to films which seek to frighten an audience as well as to create movement within an audience perception. Moreover, the lost sense may take cinematic form as a time contraction as well as a time extension. Bernard Herrmann explains the attention paid this phenomenon in the creation of "Psycho" ('60):

A scene without dialogue may seem endlessly long by itself, but appears to shorten with the music. *Psycho* has many scenes like this which seemed to take place in a few seconds, but the sequences are quite long. The opposite happens with the shower murder, which only lasts about ten seconds. People will tell you that it goes on for ever, but it's the intensity of the music which makes it seem so.¹⁶²

Movement and timing are so essential to most films, and music is so essential to the manner in which most films achieve movement and timing, that the marriage of sight and sound in this respect is often thought of by film makers to be an extension of the art of ballet.¹⁶³ Yet as important as these achievements are to the film art, they are basically sought as means by which an ideational end of emotional dimension may be created. Though not all films are successful in generating an emotional reaction in viewers, one would be hard pressed to cite a film which does not aim at generating a certain emotional impact. For that is the goal most generally identified with art and entertainment, and it is often the manner in which the expression of "ideas" is made manifest and affective. It is as to this emotional dimension of the film art that music again assumes a paramount importance. For instance, it has been noted that:

Film can show fear or loneliness, but because these are feelings and not acts, the shots depicting them are static. Quite often they cannot be sustained long enough to tell the story. But, by the addition of music, moods can be strengthened and protracted. Thus, music can bring movement when film cannot.¹⁶⁴

¹⁶² Gilling, *supra* note 157, at 38, quoting B. Herrmann.

¹⁶³ Composer Dimitri Tiomkin explains, in Tiomkin, *Composing For Films*, in *FILM Music* 55, 58 (J. Limbacher ed. 1974) [hereafter, Tiomkin]:

There is a much closer affinity between ballet and movies than casual thought suggests. The story is more involved in ballet, for the screen is a more plastic medium, and its story-telling is therefore simpler. Nevertheless, the eloquence of music is as indispensable to film as to ballet. Sometimes I think a good picture is really just ballet with dialogue.

¹⁶⁴ Embler, *supra* note 159, at 62.

So, we find that the grandly romantic spiritual passion which torments Heathcliff, and from which Cathy cannot escape, is continuously evoked throughout "Wuthering Heights" ('39) by Alfred Newman's music. In "The Best Years of Our Lives" ('46), it is through the frightening implications in Hugo Friedhofer's music that the audience immediately recognizes and understands the emotional terrors sparked in the mind of a former World War II bombardier pilot as he sits in the cockpit of a wrecked B-36 after the war has ended. That Emma Bovary's fascination with the aristocratic Rudolph is decidedly sexual is made first elegantly and then fiercely evident during the ball sequence of "Madame Bovary" ('49) by the celebrated waltz which highlights Miklos Rozsa's score, and which undergoes changes in momentum, melodic contour, and orchestral support until the music, like the on-screen dancers, collapses in near frenzied exhaustion. That audiences are able to sympathize with the speechless Kong of "King Kong" ('33) and Frankenstein of "The Bride of Frankenstein" ('35) is due to the music of Max Steiner and Franz Waxman, respectively, which gives voice to the feelings of these inhuman but so humanized beings. Entry into the delicate and mystical world of children's perceptions, rationalizations, fears, and loves, so central to a comprehension of "To Kill a Mockingbird" ('62), is achieved through the guide provided by Elmer Bernstein's exquisitely fragile scoring.

As composer Elmer Bernstein explains on the subject of cinematic emotionality and the role of music in establishing that emotionality:

The job of the composer is really very varied. You must use your art to heighten the emotional aspects of the film—music can tell the story in purely emotional terms and the film by itself cannot. The reason it can't is that it's a visual language and basically intellectual. You look at an image and then you have to interpret what it means, whereas if you listen to something or someone and you understand what you hear—that's an emotional process. Music is particularly emotional—if you are affected by it, you don't have to ask what it means. [At this point, Mr. Bernstein is asked: Film music is almost an idealization of the visual image?] Yes, even with a subject as kinetic as *The Magnificent Seven*, the moment you translate into music the scene of horsemen riding over the plains it becomes an emotional accompaniment to the action. That's part of the fun of being a film composer, that you are reaching people at a subliminal level, where they are relatively defenseless. That's an exciting thing because you can make people feel a certain way, even though they may not understand why they feel that way.¹⁶⁵

¹⁶⁵ THOMAS, *supra* note 151, at 193, quoting E. Bernstein.

This is not to say that music in films does not become an intellectual force in association with the visual, once the rudimentary intellectual visual has been given an emotional character by the attachment of musical sound to light-written sight. As the author of "The Structure of Film Music" explains:

There is practically no film without music, but the music is *consciously* heard by very few. However, *everybody* hears it unconsciously, and it is undeniable that music helps to shape the concepts and emotions which a film creates in our minds. This is so importantly true that parts of Alex North's music for *A Streetcar Named Desire* were attacked by the Legion of Decency as "too suggestive."¹⁶⁶

That the emotional impact provided by music in films becomes perceptible in intellectual fashion once music and films are joined, so as to offer an intended ideational content, is so important a fact of film making life that the absence of music, or silence, has long been considered a musical concern of film making itself. The power of film music to project intended ideas also embraces the power to project unintended ideas. Moreover, the projection of what are perceived in some quarters to be dangerous or offensive ideas can arise in either manner. The attempted (and partially successful) censorship of some of the *Streetcar* music is a famous case in point.¹⁶⁷ Other examples are more illustrative of the potential of film to be misinterpreted as to its ideational content by virtue of the use of music.

Thus, the final scene of "The Nun's Story" ('59), in which Sister Luke leaves her religious order, contains no music other than the tolling of a convent bell. The scene had originally been scored by Franz Waxman, the composer on the film, but director Fred Zinnemann removed the finale music from the film soundtrack prior to the film's release. That action was taken because the finale of "The Nun's Story" was considered to be too potentially controversial to be given anything but an ambiguous ideational character. As director Zinnemann later explained, if the music for this scene expressed gloom, the film would imply that it was unfortunate that Sister Luke left the convent. Yet if the music expressed exultation, even an exultation relative merely to Sister Luke's courage, that could be perceived as a corporate act of encouraging nuns to leave the convent.¹⁶⁸

¹⁶⁶ Embler, *supra* note 159, at 61 (emphasis in original).

¹⁶⁷ See M. SCHUMACH, *THE FACE ON THE CUTTING ROOM FLOOR* 71-78 (1964).

¹⁶⁸ *An Interview With Fred Zinnemann*, *FOCUS ON FILM*, Spring, 1973, at 26.

More recently, composer and UCLA/USC Professor David Raksin was asked why, in view of the obvious musical care he had devoted to the occasionally gruesome "What's the Matter With Helen?" ('71), he had allowed the roll-up of cast credits which ends the film to proceed in disquieting silence, when that seemingly would have been the perfect place to voice a postlude of empathy for the slain heroine of the film.¹⁶⁹ Professor Raksin explained:

Just as it is pointless to extend sympathy to deaf ears (such as those of the dead), it is pointless to try to evoke sympathy unless that is *the purpose of the picture*. . . . [T]here was no question in our minds about that being the way to end the picture, abrupt cut-off and all, and no music for the end cast-titles. As I said, sympathy in such a situation is not only superfluous, it is impossible. To have mourned the dead, or even the bereaved, at that point, would have been to swallow the delusion that sympathy could have made any difference at all. It is, in my mind, questionable enough to "legitimately" manipulate the multiple arts which comprise the film medium without having the gall to butt in when it is better to leave things unsaid.¹⁷⁰

The use of silence, then, may be seen to be as essential to the structuring of the ideational content of film as the use of music. It should not be surprising, therefore, to note that the decision as to where *not* to employ music in a film is most often left to the composer.¹⁷¹ It is in this sense that "silence itself becomes a kind of music, and the impact when music stops is as great as when it begins."¹⁷² This is especially true when the relationship of the music on the film's music tracks to the dialog on the film's dialog tracks is considered. For, as composer Bronislau Kaper notes:

With dialog, the most effective technique is the use of silence, to lull the audience with neutral music into a sense of half security and then to stop when something really important is said—nothing is as loud in films as silence.¹⁷³

The cinematic relationship of music, including the use of silence, to

¹⁶⁹ Cook, *What's the Matter With Helen?*, in *FILM MUSIC* 114, 118 (J. Limbacher ed. 1974).

¹⁷⁰ *Id.*, quoting D. Raksin (emphasis in original).

¹⁷¹ Bernstein, *supra* note 85, at 58.

¹⁷² Rosenthal, *Laurence Rosenthal on the Aesthetics of Scoring Films*, in T. THOMAS, *MUSIC FOR THE MOVIES* 33 (1973). [hereafter, Rosenthal.]

¹⁷³ THOMAS, *supra* note 151, at 90, quoting B. Kaper.

dialog, may be seen to have multiple dimensions beyond that noted above. First, music is often employed to make the sound of spoken dialog variant and/or emotionally affective. Second, music is often used in place of dialog. Third, music is sometimes used to deliberately obscure dialog. Fourth, music is sometimes used to contradict what is being said in the dialog. Fifth, music is often used to introduce the movement of an otherwise unseen force while dialog is being spoken.

Just as the interrelationship of sight and sound confers movement, timing, and emotional/intellectual overtones to a motion picture in the manner of ballet, the interrelationship of music-sound and dialog-sound, operating on one side of the sight and sound equation, is often conceived in film theory to derive aesthetically from the art of opera. This may seem curious initially, for dialog is at least more obviously important to the comprehensibility of most films than is music, and thus the film art is sometimes mistaken by non-film makers to be an extension of the art of theater. However, as composer Laurence Rosenthal explains:

Film, unlike the theater, is essentially a visual-aural rather than a verbal-intellectual medium. Even though the two obviously share certain properties, such as dramatic action, dialogue, and character, the basic nature of the film is quite different.

One of the differences is that, in a film, sound becomes a highly sensory element, whether it be music, sound effect, or speech. Total silence is an unnatural vacuum in a film. The ear seems to insist on filling it—whether with a few harp notes, the rustle of clothing, or a human voice. Of course, a great express train could race by on the screen, accompanied by perfect silence or with its natural sound replaced by that of a plaintive woodwind, and that might be enormously effective, but the point is that some sound—or silence—in relation to preceding and subsequent sounds, seems essential. In principle, dialogue plays a lesser role in the aural complex of a film than it does on the stage, where, of course, it enjoys complete supremacy. Hence the correspondingly greater importance of music and sound in motion pictures.¹⁷⁴

The first to postulate an operative equation between film music and film dialog was Erich Wolfgang Korngold, himself a composer of operas and one of the few musical “wunderkinds” of the 20th century.

¹⁷⁴ Rosenthal, *supra* note 172, at 34. Rosenthal adds, *id.*:

I would wish, however, to avoid giving the impression that music is an absolute essential in any film. It is quite possible, for example, to make a dry, hard, factual, journalistic picture which music would completely destroy by softening or theatricalising.

Korngold's experimentation with respect to the operatic equation lay in composing film music just below the pitch of actors' voices. In this manner the composer introduced subtle support to spoken words and infused many a love scene with the emotional impact of an operatic love duet.¹⁷⁵

Now, it is not generally realized that all human voices have octaves and that these octaves exhibit wide variations in pitch and timbre. Just as music can "soften" or "harden" the faces of actors perceived visually, music can complement the speaking voice perceived aurally so as to give it qualities it does not possess inherently. Dimitri Tiomkin, another film artisan who favors the operatic equation, identifies actors like John Wayne, James Stewart, and Jean Arthur as a film composer's delights, because the voices of these actors have so little color in themselves that their pitch and timbre can be complemented with almost any pattern of instrumentation, thereby lending such voices, when perceived cinematically, a flexibility which surpasses that available in a naturally flexible voice.¹⁷⁶ Composer Leonard Rosenman notes that music deployed with dialog in films "should generate that dramatic excitement which the marriage of the arts . . . should bring about, almost in an operatic sense—except that the 'arias' are spoken rather than sung."¹⁷⁷ These precepts were demonstrated by Rosenman in his music for "East of Eden" ('55), of which the composer notes:

. . . when scoring under dialogue I took into account that Julie Harris is a high soprano, James Dean is a tenor, and Raymond Massey a bass-baritone. The design of the instrumentation and of the thematic material itself was influenced by consideration of these voice ranges and qualities. Often "holes" were left in the scoring for the voice to be utilized as a sort of speaking instrument.¹⁷⁸

As important as the complementary function of music vis-à-vis dialog is music's substitutional function vis-à-vis dialog. The decision to eliminate dialog and to let music speak for the actors is made by the film director. Sometimes there is no choice in this respect, as where the central "speaking" character is a Kong, a Frankenstein, or a mute such as the protagonist of "Johnny Belinda" ('48). Where there is a choice, many of the most famous film directors—John Ford and Alfred Hitchcock are

¹⁷⁵ G. Korngold, *The Classic Film Scores of Erich Wolfgang Korngold*, (RCA brochure published with RCA LP LSC-3330, 1972).

¹⁷⁶ Tiomkin, *supra* note 163, at 58-59.

¹⁷⁷ Rosenman, *East of Eden*, in *FILM MUSIC* 86, 87 (J. Limbacher ed. 1974).

¹⁷⁸ *Id.*

exalted examples—have consistently elected to eliminate dialog in favor of exposition by music. As to the manner in which this decision manifests itself artistically, composer Bernard Herrmann explains his association with Alfred Hitchcock:

You always work with Hitchcock from the beginning, from the time of the script. He depends on music and often photographs a scene knowing that music will complete it. If that is the case, he may eliminate dialogue completely. When we worked on *Vertigo*, he said when we came to the famous recognition scene, 'If we're going to have music, we won't have one word of dialogue; we'll just have the camera and you.'¹⁷⁹

Often the script itself omits dialog at certain points, so as to implicitly demand the use of music to give "speech" to a character in a particular situation to be filmed. Joseph Mankiewicz, the director-writer of "Cleopatra" ('63), noted of Alex North's music for the sequence in that film in which a lone Mark Antony, deserted by his army in payment for his abdication at Actium, silently charges Octavian's army to force an engagement: "As the muted trumpets scream, in Antony's name, for honourable death, they scream an anguish which cannot be written, in a voice no actor can project."¹⁸⁰ In "Ben-Hur" ('59), the script specified that at no time was Christ's voice to be heard in the film. Yet it also called for the sequence in which Christ appears before thousands of listeners to deliver the Sermon on the Mount. What might seem an incongruity to the layman was an effective projection on the part of the film maker. For it became the function of Miklos Rozsa's music during this scene to intimate the words of the sermon. That is precisely what the composer did in this sequence, by ingeniously molding the notes of the Christ motif of the score to the unheard but well-known words of the sermon.

A more rarely deployed but equally powerful use of music in association with dialog is the functional obliteration of spoken words by music. This technique lends itself to a number of sophisticated uses:

... such as the device in *On the Waterfront* of obscuring with Leonard Bernstein's music certain lines of dialogue, emphasizing

¹⁷⁹ Gilling, *supra* note 157, at 38, quoting B. Herrmann. For further insights into the director/composer working relationship, see: Bernstein, *The Annotated Friedkin*, FILMMUSIC NOTEBOOK, Winter, 1974-75, at 10; Goldsmith, *Vital Dialog in Film Making Between Director and Composer*, Variety, May 15, 1974, at 61, col. 4.

¹⁸⁰ Mankiewicz, *Cleopatra* (notes published with 20th Century-Fox LP SXG/5008, 1963).

their intended banality. Here the emotional line of music tells much more than would the obliterated words. In another scene in the same film, sound and music violently drown out the actors to produce an extraordinary feeling of frenzied impotence. The spectator may not be aware of how this is achieved, but he is nevertheless affected by it.¹⁸¹

The most daring use of music in films occurs when it becomes the function of the music to either balance or contradict that which the dialog appears to be saying in terms of dramatic thesis. Great artistic risks are involved in using music for these ends; if the composer fails, then the film fails at its most crucial artistic level. For example, it was the thesis of the makers of "Who's Afraid of Virginia Woolf?" ('66) that George and Martha, despite the unrelievedly excoriating words they hurl at each other, actually share a compatible relationship of love underlying the relationship of mutual hatred which operates prominently in the dialog. Thus, it was left to composer Alex North to create a musical ambience for *Virginia Woolf* specifically designed to carry the underlying thesis of the film. North discarded one musical approach after another before he settled upon the quasi-baroque, exquisitely tender music by which this film subtly delivers its most important message. Somewhat similar is the use of music throughout "Fahrenheit 451" ('66). Here, the characters of a futuristic society are politically repressed from uttering anything but banalities about happiness. What emotions and torments still grace their feelings and thoughts are identified through Bernard Herrmann's omnipresent musical translation.

The use of music to interject movement of an unseen force while dialog is being spoken is so familiar a cinematic device that the more famous examples of this technique have become cues to which audiences respond immediately: the thumping musical effects which grow in thunder to announce the approach of the monster ("King Kong"); the bugles which rise above the visual fracas and the musical fray to signal rescue by the cavalry ("Stagecoach", '39); the chilling mixture of woodwinds and searing strings (Max Steiner) or simply the softly beating drums (Dimitri Tiomkin) which mirrors the pioneers' realization that the Indians are about to attack ("They Died With Their Boots On", '42, and "Red River", '48). A richer use of music for such purpose is offered by the availability of stereophonic recording techniques. Thus, for the sequence in which Brutus commits suicide in the film version of William Shakespeare's

¹⁸¹ Rosenthal, *supra* note 172, at 35.

"Julius Caesar" ('53), the film makers were able to achieve that which Shakespeare might have given his eye teeth to accomplish. Composer Miklos Rozsa explains what, why, and how:

Throughout these scenes I wanted to give the impression that the victorious armies of Antony and Octavian are continuously advancing and coming nearer and nearer. This scene, however, is the culmination of the tragedy, when its noblest character, Brutus, like a Greek hero in a Greek drama, faces his inescapable fate. I wrote, therefore, two entirely different scores, contrapuntally worked out, but in content completely independent. The one, which represents Antony's nearing army, is a march based on Caesar's theme and is scored for brass, woodwind, and percussion instruments. The other, which plays the scene in the foreground and underlines the tragedy of Brutus, is scored for strings only. Thus there is a complete contrast of color between the two, apart from their emotional, rhythmic and thematic differences. The stereophonic technique, with three loud speakers behind the screen, came to my help. As the direction of the approaching army is from the right corner of the screen, we put the march track on this loud speaker and the string track on the two others, screen center and left corner. Thus there is a complete separation of the two scores, which were recorded separately, and geographically the listener immediately feels that the army is marching from the right corner of the screen. As Brutus dies the march becomes louder and louder and as the servant runs out from the scene it completely overpowers Brutus' string music and dominates the whole screen.¹⁸²

The ideational importance of music in films has thus far been discussed by isolating a number of aesthetic dimensions by which the art of combining moving pictures and music may be understood. When we consider that all of these individual dimensions are interrelated, we reach that level at which film music may be consummately distinguished from all other forms of music. The motion picture art is a narrative art, and film music is one of the linguistic means by which the visual-aural nature of motion picture narration is identified and achieved. The impact of this equation upon so special a form as film music is to aesthetically divorce this particular form of music from that which has generally been considered music throughout centuries previous to the 20th.

As composer Leonard Rosenman explains:

¹⁸² Rozsa, *Julius Caesar*, in *FILM MUSIC* 132, 135 (J. Limbacher ed. 1974).

[Film music] has all the attributes of music—melody, harmony, counterpoint—but it is something less than music because its motivating pulsation is literary and not musical. Unlike other mixed media forms, such as opera, the composer has no control over the text, over the *mise-en-scène*; he is writing to a circumscribed form.¹⁸³

Whether it be called “something less” or “something more” than “music”, there is little doubt that film music is a literary form of music, that it is the representative art which Judge Learned Hand correctly identified “music” itself as normally not being. Composer Jerry Goldsmith probably speaks for most serious composers who have been attracted to the communicative potential of the motion picture art when he says:

The function of a score is to enlarge the scope of a film. I try for emotional penetration—not for complementing the action. To me, the important thing about music is *statement*.¹⁸⁴

A recent example of such statement making is provided by “Papillon” (’73), which was scored by Goldsmith. The expository portion of this film ends with the title character surviving a live-or-die escape attempt from a French penal colony. The audience is then informed of the success of the escape attempt, and of the later dissolution of the French penal colony system, the brutalities of this system having been well explored earlier. As the production credits are mounted on-screen, the camera returns to the penal colony and records its decay through the following years as jungle growths swallow it up. Goldsmith’s music, so devoted to emotional penetration of human relationships throughout the expository drama, turns extremely harsh for this finale. Unrelated to the preceding scoring except for its summational objective, this finale music simply and totally damns a penal system too inhumane for a civilized nation to tolerate.

That motion pictures make statements, and that music when employed in motion pictures is one of the means by which such statements are made, becomes emphatically clear when it is noted that the films which have made the most classically important statements in the weightiest of fashions have, without exception, employed music as a vital element in the structuring as well as the making of those statements. The great literary themes of what might be called ideological cinema generally fall into two

¹⁸³ THOMAS, *supra* note 151, at 207, quoting L. Rosenman.

¹⁸⁴ THOMAS, *supra* note 151, at 210, quoting J. Goldsmith (emphasis in original).

generic categories: the spiritual and the political, both of which operate in humanistic terms.

Such films, being cinematic essays in essence, lend themselves to certain pretensions, but they always adhere to the requisite structure of essay: they make a statement of purpose or theme at the outset, they delve into a long exposition of purpose or theme thereafter, and they conclude with a restatement of purpose or theme. As we have seen, there are any number of ways in which the exposition may be made, and all of the film arts are employed to varying degrees at various moments to achieve this exposition. As to the introductory statement and the concluding restatement, however, only two cinematic devices are available. One is to simply announce, by means of an off-screen voice or an on-screen title card, exactly "what this film is about" and, later, "what this film has been about." The other is to allow the introductory statement and the concluding restatement to be made by musical composition associated with a well planned visual. Since the former technique bears all the earmarks of an inartistic hammering of the head, while the latter can be achieved subtly and emotionally as well, it is the musical narrative which is usually elected. Of course, once this technique is employed, it is then indispensable to the structural integrity of the motion picture.

Thus, in "Quo Vadis" ('51), the opposing ideological forces of the expository drama are forcefully set forth in the prelude by Miklos Rozsa's juxtaposition of antithetical musical forces. Against a visual portrayal of a Roman stone relief identifying the historical stage, a chorus of one hundred—the "Voices of Humanity"—offers a bold musical setting of the words, "Quo Vadis Domine?", and their English translation, "Lord, Wither Goest Thou?". The chorus represents the urging question of Christianity. An orchestra of seventy-five, representative of the raw power of an Imperial Rome under Nero, repeatedly lashes at the chorus with fanfare interruptions. These eventually lock with the chorus in a sustained musical cataclysm. As the prelude rushes to its conclusion, the chorus is heard saliently to overlay the orchestra. Much later, as the film ends, the "Voices of Humanity" return; after reprising the "Quo Vadis Domine?" question, they conclusively answer that question by speaking as the voice of Christ. The words introduce a hymn, and the powerful announcement of spiritual conquest rises jubilantly above the dying fanfares which signify the end of Nero's Rome.

Such musical developments as these represent a highly sophisticated approach toward positing literary statement in films, and many of the recognized masterpieces among film scores themselves derive from this kind of musical confrontation with great spiritual and political events. Ideological cinema itself reached a zenith in the United States in 1960 with the release of a triumvirate of "Armageddon epics": "Spartacus",

"The Alamo", and "Exodus". The ideological aspirations of these three films are political in nature, and the characters of their political statements are virtually identical. All three films deal centrally with the struggle for human freedom and dignity, and all three films basically assert that "the eternal choice of all men—to endure oppression or resist"¹⁸⁵—must manifest itself as an affirmative act of resistance when the alternative is totalitarian subjugation. Films can hardly make statements more vital to twentieth century experience, and once again such statement is structured and introduced musically.

Thus, in "Spartacus", Alex North's prelude music surges with modern dissonance and brooding harmony, these to announce immediately that although the seventy thousand slaves so brutally crushed in their rebellion against Imperial Rome were ancient slaves, their experience is directly relevant to 20th century experience. As the camera traces the contours of elegantly formed Roman statuary and reliefs, North's martial rhythms are suddenly deployed to posit a liberation theme of heroic stature. The theme representing the pursuit of freedom swells as new orchestral forces are progressively introduced to expand the literary thesis. Finally, the camera lights upon a solitary Roman bust and remains stationary as the music becomes a political force itself. Strident sound patterns flay at the symbolic bust until the head, unable to withstand assault by the massive force of the musical statement, cracks, shatters, and then disintegrates.

In the prelude of "The Alamo", the camera serves up a series of portraits of the famous mission chapel as it looked in 1836. Dimitri Tiomkin's music, meanwhile, subtly and hauntingly posits the meaning of the event associated with this American shrine. The composer first offers an eerie restructuring of the *deguello*, an historically infamous trumpet call descended from the Moors and carried from Mexico to Texas by the dictator Santa Anna, who employed it to signal that no quarter would be given the less than two hundred American men and women who held back an army of many thousands for thirteen days, thus providing the rest of Texas time to organize an army to repel the invasion. In Tiomkin's vision, the *deguello* represents the totalitarian alternative, and thus it becomes the leitmotif by which "the eternal choice of all men" is identified in the prelude and throughout the film. Structurally, its use in the prelude demands an answer in the prelude. Tiomkin's interjection of the nostalgic and deeply moving theme known as "The Green Leaves of Summer" identifies that answer as bearing a character conceived not in terms of a raw and antithetical force, but rather in terms of the love of men for the

¹⁸⁵ J. E. GRANT, *THE ALAMO* (narrative titles 2 of screenplay embodied in Bajac motion picture, 1960).

simple beauties of life—a love directed so centrally to those beauties that it predicates the willingness of men to give their lives so that their families, friends, and neighbors might enjoy that which is personally expendable in the extreme sacrifice. The visuals and music of this prelude consume little more than two minutes of screen time, yet they structure the power to move audiences to tears through one of the quietest but most powerful utilizations of the representative screen arts yet achieved.

The structural prelude of “Exodus” is similar in its emotional impact but entirely singular in its ideological statement. As an empty blue screen suddenly sparkles with the low flicker of the Eternal Light, a towering horn figure announces the theme composed by Ernest Gold to represent the emerging state of Israel. As a large orchestra takes up this theme, the flame, a visual representation of the survival of the Jewish people, begins to grow. As the flame expands and approaches the upper level of the screen, the orchestral forces expand to give the fire a consummate emotional and intellectual import. Finally, the fire entirely consumes the visual. As the screen turns to its brightest hues, a massive orchestra carries the “Exodus” theme toward a crescendo which floods the theater, leaving the audience in no doubt as to the sympathies of the film makers.

There is, of course, an artistic thought process by which composers assume a creative literary posture when they structure all of the statements and posit some of the statements in a motion picture which has something vital to say. The following explanation by the doyen of American film composers, concerning one of the recognized masterworks among film scores, is illustrative. For the scoring of George Stevens’ film “The Diary of Anne Frank” (’59), Alfred Newman visited the house in Amsterdam where the Frank family had lain in hiding for so long. Later he reported:

It was a strange experience—standing in that room where Anne had lived and from where she was eventually led away to die, I had a feeling mixed of exaltation and repugnance. George Stevens had decided that the film shouldn’t be one of gloom, but that we should concentrate on the love and humour of these people. During my visit, I had lunch with Anne Frank’s father, a charming man, and he wanted to know what my music would be like. I could only tell him in the abstract that what touched me most about the book was its spirituality, and that was what I wanted to say in the music. This seemed to please him. When it came to the actual scoring—I didn’t try to illustrate, except in a few places, what was happening on the screen, so much as to invoke in the music the remembrance of happier times, the longings for the future—the longings of an oppressed people.¹⁸⁶

¹⁸⁶ THOMAS, *supra* note 151, at 60, quoting A. Newman.

And thus we may ground our perception of what is meant when motion picture analysts assert: "Writing film music is unique in one respect—it is needed, and this is a situation found nowhere else in contemporary musical life."¹⁸⁷

It has been deemed necessary to offer only an overview of the aesthetic principles of the visual-aural motion picture art, as these principles have been worked out in the practice of that art, and as they have been identified in the literature which seeks to explain that art. In a sense, even this overview constitutes a regrettable trespass. For the achieved motion picture art arises from the interaction of various arts which operate to produce "a wonderful piece of tailoring."¹⁸⁸ in which the stitches are intended to remain unseen and untampered with. As to the contribution of music to that tailoring, it is clear that film music is no less than "the communicating link between the screen and the audience, reaching out and enveloping all in one single experience."¹⁸⁹

It is of no legal concern, of course, that film music often fails to meet the aesthetic potential of its artistic goals; that is the concern of the film critic and the film music critic, not of the legal analyst weighing copyrightability.¹⁹⁰ Nor does it matter that film music communication may be often perceived unconsciously or sometimes ignored; for "[w]hat a composer does may not be obvious to everyone but that's part of art, that's part and parcel of creativity. . . ."¹⁹¹

What are we to make, then, of a legal theory, predicated upon aesthetic distinctions, the distinctions themselves offered without even the remotest recourse to aesthetic analysis, which insists at the least, that the music tracks of a motion picture are immaterial to the artistic integrity or "beneficial use" of the motion picture, and may therefore be severed from the constitutionally charted copyright protection extended to the motion picture and, inclusive of underlying works, fed by the tens of thousands into the public domain?

Apart from the conclusions forced by aesthetic analysis itself, the intellectual arrogance which inheres in an anti-protectionist position so urged would alone appear to mandate dismissal of this odd legal theory. For it is patently absurd to urge the denial of copyrightability to certain stitches necessary to the construction of an artistic tailoring, merely by virtue of the assumption that if these stitches remain substantially unseen,

¹⁸⁷ THOMAS, *supra* note 151, at 19.

¹⁸⁸ Gilling, *supra* note 157, at 37, quoting B. Herrmann.

¹⁸⁹ Palmer, *Music in the Hollywood Biblical Spectacular*, CHURCH MUSIC, Dec., 1972, at 5, 9, quoting B. Herrmann.

¹⁹⁰ See LATMAN, *supra* note 11, at 15.

¹⁹¹ THOMAS, *supra* note 151, at 185, quoting A. North.

then they must, in fact, be immaterial to the tailoring itself, and thereby may be uprooted and dispensed with.

It is true that the motion picture art is a subtle and mysterious art. And it is axiomatic that the motion picture art is an art which, to a substantial degree, no longer works its phenomena so consummately if and when it seeks to make the integral elements of its communicative structure self-evident.

Responsibilities, however, do arise, and they are, in this area, not light. As the preceding commentary discloses, the aesthetic distinctions which characterize the motion picture art are not inscrutable. In certain quarters they are well known, and to all quarters their identification is easily available. That which operates at the bottom line of anti-protectionist theory and which is claimed to be reasonable should properly be acknowledged not as a legal theory at all, but rather as a cultural ignorance masquerading as legal theory. As such it may be identified as bearing no intellectual validity and no legal import, for a cultural ignorance posing as legal theory is neither legitimate as aesthetic distinction nor acceptable as a basis for sound copyright law.

The question remains as to the protective features conferred upon the motion picture soundtrack itself, within a "species of the genus" copyrightability analysis, by the legitimate aesthetic distinctions of the visual-aural motion picture art. The appointed consideration rests with the impact and interrelationship of the "reasonableness" and *White-Smith* maxims within a "species of the genus" copyrightability setting, wherein aesthetic analysis has not remained unattended. That appointment may now be kept.

(D) The Impact of White-Smith on "Species of the Genus" Analysis

It was contended earlier that if we are to be reasonable in weighing the issue of soundtrack copyrightability, we must impute to the 62nd Congress an intention to protect the motion picture to an extent which would allow us to deem such copyright protection inclusive of the later developed motion picture soundtrack. That particular use of reason was claimed to flow as a logical imperative sprung from historically identifiable aesthetic perceptions and technological parallels.

The call to reason was next demonstrated to be a legal maxim as well as a logical imperative of "species of the genus" analysis when that analysis is applied to a copyrightability question. However, the application of a "reasonableness" maxim in such a context was not claimed to be limited in direction to the symmetry of aesthetic perceptions or technological parallels which may attend, in historically chartable fashion, the protection of a "species" through legal construction of the legislative intent underlying

the copyright protection extended to a "genus". While it has been suggested here that a reasonable construction of the legislative intent underlying the motion picture amendments should alone be dispositive of the soundtrack copyrightability question—whether we proceed to "species of the genus" analysis or not—the luxury of such a dispositive use of reason is not always available in or apart from "species of the genus" analysis itself.

Further, it is arguable, as to the particular copyrightability question presented, that a symmetry founded upon aesthetic perceptions and technological parallels, however historically documented, is yet too slight a hanger upon which to hinge an imputation of protective legislative intent. The full weight of the "reasonableness" maxim thus drew our concern, both to carry our analysis of the "species of the genus" doctrine to its logical end within a copyrightability context, and to identify the parameters of that end should our use of reason in a legislative context be deemed fallible as to soundtrack copyrightability itself.

In this respect, it has been urged here that when the "species of the genus" doctrine is employed to determine the copyrightability of a later developed "species" of an antecedent "genus", application of the "reasonableness" maxim mandates attention to the constitutional fabric which underlies copyright recognition of the antecedent "genus". Such attention was claimed to be required for two reasons.

The antecedent "genus", if legitimately protected by copyright itself, must bear a "reasonable relation" to the constitutional definition of "writings," and to the constitutional mandate "To promote the Progress of Science and useful Arts. . . ." If the "species" may be contained within the protection accorded to the antecedent "genus", then that protection must operate as fully in the case of the "species" as in the case of the "genus"—i.e., the extent to which the classified "writing" is protected must not shift.

Further, when the "species" has sprung from the "genus" in aesthetically symmetrical fashion, attention must then be paid to the consequences of denying to the "species" a containment within the protection accorded to the antecedent "genus". If the "genus" has come to be represented only by production of its aesthetically symmetrical "species", then the denial of functional protection to the "species" undercuts the "reason of the copyright protection" accorded the antecedent "genus". That result effectively nullifies the congressional grant and vitiates the meaning of the promotive/protective constitutional charge.

With these considerations in mind, the aesthetic distinctions of the visual-aural motion picture art were then investigated, not only to test a curious anti-protectionist theory claimed to be reasonable and now identified as irredeemably specious, but also to lay the aesthetic foundation

necessary to confront the constitutional dimensions of “species of the genus” copyrightability analysis in the present context.

These constitutional dimensions cannot be deemed slight. If, as the Court in *Burrow-Giles* said, “writings” in the Copyright Clause embraces the various forms of creativity “by which the ideas in the mind of the author are given visible expression,”¹⁹² then the motion picture is constitutionally protectible as a “writing” only if (1) it bears “ideas” of its “author”, and (2) these “ideas” are given visible expression. It is the concurrent teaching of *White-Smith* that copyright protection is dependent upon the ability to produce the creative work in the form of “copies”—“copy” being defined in joint terms of visual appreciability and intelligibility.¹⁹³ But can *Burrow-Giles* be taken to mean that the sound-on-film motion picture is no longer protectible as a “writing” because the “ideas” of its “author” are given visible expression only when ideational expression is achieved through use of visual and aural coordinates? Can *White-Smith* be taken to mean that the sound-on-film motion picture is uncopyrightable because its isolated soundtrack is not visually appreciable and its isolated visual track is not intelligible? Yes: if we divorce all semblance of sanity from the propulsion of abstract logic forced by analytical maneuvers adopted *a priori*. No: if we decline to violate either the constitutional charge or the congressional will, and instead apply the “reasonableness” maxim of “species of the genus” copyrightability analysis which has been identified as the mandate of law.

It may be noted that *Burrow-Giles* and *White-Smith* do not appear to contradict each other as to their identification of copyrightability concerns. The idea expression of *Burrow-Giles* would seem to relate to the intelligibility motif of *White-Smith* just as the visible expression of *Burrow-Giles* would seem to relate to the visual appreciability notion of *White-Smith*—as equivalent substantive poles of copyrightability analysis. Neither case presents a problem in motion picture copyrightability investigations, so long as it is actually the motion picture that is tested for copyrightability. The aesthetic distinctions of the sound-on-film motion picture are such that the idea expression of a motion picture “author” is imbedded within a mosaic technology which both subsumes the visual and springs its interior interrelationships from the visual.

Thus, the intelligibility of this idea expression presents itself as functionally related not to just the isolated visual track of the motion picture, but to the visually appreciable mosaic integration of motion picture visual

¹⁹² *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 58 (1884).

¹⁹³ See text accompanying notes 63-65 *supra*.

track and motion picture soundtrack. Conversely, the visual appreciability of this idea expression presents itself as functionally related not to just the isolated soundtrack of the motion picture, but to the intelligible mosaic integration of motion picture soundtrack and motion picture visual track. That, at least, is the aesthetic case. More importantly, that is the legal case if by idea expression and intelligibility, and by visible expression and visual appreciability, *Burrow-Giles* and *White-Smith* refer to the *aggregation* of "ideas" which marks the authorship of a single "writing".

It is apparent that *Burrow-Giles* and *White-Smith* implicitly sanction a concept of full ideational impact in authored expression when it comes to applying copyrightability tests; there would be little deference to the promotive/protective constitutional charge if they did not. At the least these cases are compatible with the concept. A photograph presents the *full* ideational expression of its photographer. A musical composition presents the *full* ideational expression of its composer, at least if the composition is of the non-representative musical character which Judge Learned Hand would call general.

Yet that a full ideational expression of one "author" can be carried in singular technological fashion does not mean that another full ideational expression of a different "author" cannot be carried otherwise. Nor must the latter be denied full protection when it is carried by means of a "species", of mosaic technology, which has sprung in aesthetically symmetrical fashion from a "genus", of singular technology, or even of separate technologies. For the base, against which copyrightability tests are to be applied, logically presents itself as a function of the technology which carries the full ideational expression of an "author".

If, for instance, intelligibility via *White-Smith* and idea expression via *Burrow-Giles* are equivalent substantive poles of copyrightability analysis provided by law, then their applied relationship tête-à-tête would appear to be the mandate of law. Their use in law would be chaotic, however, if that which an "author" expresses as a "writing" is not to be considered the object of a reading for intelligibility.

That it is the full ideational impact in authored expression which is of concern in copyrightability analysis is not only the implication of *Burrow-Giles* and *White-Smith*, it was the stated thesis of Mr. Justice Holmes. Concurring specially in *White-Smith*, Holmes noted that the ground of the constitutionally charted grant of copyright itself is:

... that the person to whom it is given has invented some new collocation of visible or audible points,—of lines, colors, sounds, or words. The restraint is directed against reproducing this collocation, although but for the invention and the statute any one would

be free to combine the contents of the dictionary, the elements of the spectrum, or the notes of the gamut in any way that he had the wit to devise. The restriction is confined to the specific form, to the collocation devised, of course, but one would expect that, if it was to be protected at all, that collocation would be protected according to what was its essence.¹⁹⁴

In *White-Smith*, Holmes drew upon the cruxal definition of a subject of copyright so as to further argue that protection should be coextensive with the invention and its social and commercial value. It was his position that a mechanical reproduction of a collocation of sounds, since it gave meaning and worth to the collocation of written notes invented, should be considered a “copy”.¹⁹⁵ The Court’s decision rejected Holmes’ argument as to the extension of “copy” urged on principle. However, that rejection in no way undercut the definition of a copyrightable subject of expression as “the collocation devised”. While Holmes argued for protection of a collocation devised of audible points (sounded notes), the Court limited protection to a collocation devised of visible points (written notes). The latter emerged as protectible because it was intelligible and visually appreciable; the former emerged as unprotectible because it was visually unappreciable, though (presumably) intelligible.¹⁹⁶

As to our own question, however, we have seen that the idea expression of the sound-on-film motion picture is such that the collocation of concern is composed of visible *and* audible points. The argument therefore arises that if the idea expression of motion pictures means anything in a constitutional sense, it means that intelligibility and visual appreciability tests must be applied to “the collocation devised” by the motion picture “author”—and not to visible or audible points of that collocation held in isolation under an analytical maneuver which, at any given instant, leaves some ideas and half-ideas floating in limbo while other ideas and half-ideas are brought under the double-edged ax of *White-Smith*.

Thus, we find that the authority for applying the *White-Smith* copyrightability tests to “the collocation devised” arises not merely as the dictate of a logic which seeks harmony among different copyrightability considerations, but also as the mandate of a “reasonableness” maxim which is not without constitutional support when operating in a “species of the genus” copyrightability setting. For if “the collocation devised” by the “author” is a “writing” in the sense of that which is copyrightable, then—logically, reasonably, constitutionally—the purported “writing”

¹⁹⁴ *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 19 (1908).

¹⁹⁵ *Id.* at 20.

¹⁹⁶ *Id.* at 17.

must be treated as "the collocation devised" when tested as to its copyrightability.

It is possible, of course, for "the collocation devised" by the motion picture "author" to inhere predominantly in the motion picture visual track. Pre-sound-on-film motion pictures, for instance, generally contained an abundance of title cards to present on-screen that dialog which, at the time, could not be rendered as audible points of "the collocation devised".¹⁹⁷ These films also made large use of narrative title cards and exaggerated facial and bodily movements, so as to represent on-screen that emotional or other information which the film makers could not always depend upon being delivered musically, as "live" or independently recorded audible points of the collocation.¹⁹⁸

With the advent of sound-on-film motion pictures, "the collocation devisable" by the motion picture "author" assumed a wider practical potential. Certain purely visual techniques all but disappeared, as much of the idea expression of the motion picture art was shifted to audible carriage in the motion picture soundtrack, there to operate and take substantive meaning in integrated association with the visual track.

Yet that a motion picture of 1920 might be deemed intelligible when considered as to its visual narrative does not mean that a motion picture of 1930 may have its intelligibility weighed only as to its visual track, or that we may apply such a copyrightability test to its isolated soundtrack also. The motion picture of 1930 represents a "species", but the motion picture of 1920 represents a "genus". While the copyrightability of the 1920 motion picture remains a matter of statutory recognition, the copyrightability of the 1930 motion picture is a matter of reasonable construction of the reach of that statutory recognition.

Further, the "species" may be distinguished from the "genus" because the "species" represents a shift in the "author's" manner of structuring "the collocation devised". This shift has been made by virtue of a

¹⁹⁷ The preclusion worked in the practical sense: technical possibilities were overridden by the realistic necessities attending the distribution of hundreds of prints of each film to thousands of movie theaters. In this market context, dialog-on-records could not meet required levels of amplification, bulk weight transport, prevention of wear, security from breakage, synchronization, etc. See note 88 *supra* and accompanying text.

¹⁹⁸ The insurance was again a practical one: while the movies always had music, the film producers were unable to exercise artistic control over the music provided their films until the soundtrack appeared. Thus, while pre-soundtrack film music could be very functional in limited respects, it was never as multi-dimensional in its linguistic functions as post-soundtrack film music. See note 94 *supra* and text accompanying notes 93-94 *supra*.

means which technologically did not attend the “author’s” structuring of “the collocation devised” for carriage by the antecedent “genus”. Yet the “species” is not a protectible outgrowth of the “genus” at all unless, like the “genus”, it is a “writing”. If, as with the “genus”, it is “the collocation devised” for carriage by the “species” which a copyright shall protect if it may be conferred, then it is “the collocation devised” to which the tests of copyrightability must be applied. Any other procedural application of those tests could negate the benefit of the copyright recognition extended to the “genus”, for the antecedent “genus” may be then or eventually represented only to the extent its “species” is produced. That negation—perhaps even the threat of that negation—violates both the congressional grant and the promotive/protective constitutional charge underlying recognition of the antecedent “genus” as a “writing”. Such violations simply may not pass where reason stands watch.

The tenability of these principles becomes especially clear when we consider the unreasonableness of applying the intelligibility and visual appreciability tests in contradiction to the procedure urged here as legal. Reference was made earlier to the idea expressions contained within certain segments of the film “Citizen Kane”. We have seen, for example, that at one point of this film part of “the collocation devised” by the “author” concerns a structural identification of “Rosebud”. During the scene in which this structural identification is made, the isolated visual track shows a young boy playing with a sled in the snow. The isolated dialog tracks for this scene carry the voice of a woman calling the name “Charles” in the foreground, and they also carry the sounds of a child’s playful cries in the background. The isolated music tracks for this scene carry a musical narrative in which the “Rosebud” leitmotif is lyrically proclaimed. The isolated visual track may be visually appreciable, but it is not intelligible vis-à-vis the idea expression of the motion picture. All that the isolated visual track can say is: here is a young boy playing with a sled in the snow. The isolated soundtrack is not visually appreciable, nor is it intelligible via-à-vis the idea expression of the motion picture. All that the isolated soundtrack can say is that which the dialog tracks and music tracks say: the name “Charles” is being called to a happy child, and “Rosebud” is germane to this moment in his life. Only when “the collocation devised” of visible and audible points is considered as an entirety do we have the idea expression of the “author”, as well as the visual appreciability and intelligibility of that idea expression. Only then does the application of these copyrightability tests make any sense as concerns protection of “the collocation devised” by the “author”. Only then can we read: a young boy is playing with a sled in the snow; this young boy is “Charles” Foster Kane, and he is happy at this moment; and the physical identity and philosophical significance of “Rosebud” are rooted in this scene.

It may be noted that there is nothing unreasonable about the notion that we are *reading* these motion picture messages, even though these messages are delivered by use of audible points of reference as well as visible ones. What is involved is the physiological/psychological/aesthetic concept known as *synesthesia*; this refers to the sensation or image of a sense (as of color) other than the one (as of sound) being stimulated.¹⁹⁹ In the case of a sound-on-film motion picture, the manner in which cinematic phenomena are perceived is often grounded in this concept as applied. Viewers may attribute to the motion picture visual track effects that are owing primarily to elements incorporated on the soundtrack, or listeners may attribute to the motion picture soundtrack effects that are owing primarily to manipulation of the visual track. But the end of the current perception becomes, in fact or as potential, reception of the idea expression of—"the collocation devised" by—the motion picture "author".²⁰⁰

One need not push the implications of synesthesia so far as to encounter conceptual problems with certain mechanical recordings themselves. Where the sound-on-film motion picture is concerned, a visual coordinate is obviously present. In this context, the function of an aural coordinate is to bring the scope of the visual in line with the scope of the authorship which inheres in a motion picture work. A visual coordinate of idea expression of—"the collocation devised" by—the motion picture visual appreciability requisite of copyrightability.

¹⁹⁹ Anderson, *The Invisible Music*, STEREO REVIEW, Sept., 1974, at 4. Note that the concept of synesthesia has been posited by some writers as a justification for denying the viability of film music as "music" when film music is recorded or performed in concert so as to be enjoyed apart from its functions in motion pictures. *E.g., id.*

²⁰⁰ Directors and composers experienced in working with this phenomenon have attempted to explain it in simple terms. William Walton calls the film composer "the servant of the eye" and notes that "music offers orchestral 'color' to the mind's ear in such a way that at every stage it confirms and reinforces the color on the screen which is engaging the eye." Walton, *Music For Shakespearean Films*, in FILM MUSIC 128, 130 (J. Limbacher ed. 1974). George Antheil called film music "a public communication" and noted: "You *see* love, and you *hear* it. Simultaneously. It makes sense. Music becomes a language for you, without your knowing it." THOMAS, *supra* note 151, at 171, *quoting* G. Antheil (emphasis in original). Sergei Eisenstein, the father of all film theoreticians, attempted to explain the music in his films as "no mere imprint of phenomena but their piercing light expressed in rays of sound." Eisenstein, *PRKFFV*, in FILM MUSIC 159, 162 (J. Limbacher ed. 1974). Bronislau Kaper offers an apt analogy: "At certain moments in films, nobody knows the difference between what is visual and what is acoustical. It all comes together. It's like seeing and hearing lightning—it's one effect." THOMAS, *supra* note 151, at 90, *quoting* B. Kaper.

There would seem, then, to be nothing disturbing about employing intelligibility and visual appreciability tests in strict accord with the constitutional essence of copyrightability itself. Indeed, such use appears to be functionally ordained by the “reasonableness” maxim which inheres in “species of the genus” copyrightability analysis, and which operates to safeguard certain constitutional proprieties in that analysis. Moreover, such use has been sanctioned even where only aesthetic logic, rather than something as weighty as constitutionally charted logic, has been perceived as the analytical impetus.

Reference was made earlier to the protection extended to motion pictures as “cinematographic works” under the Universal Copyright Convention. That protection was seen to embrace motion picture soundtracks. However, the isolated motion picture soundtrack is incapable of being visually perceived as to its underlying works; and works must be capable of visual perception to be published and protected under the Convention.²⁰¹ The motion picture soundtrack and the visual perception requirement of the Convention have been harmonized, within that non-judicial context, simply by directing to the sound-on-film motion picture the analytical attention which its aesthetic distinctions demand. The commentary by Bogisch on this issue first defines a “cinematographic work” as “the sum total of different arts” which “are amalgamated in a unified whole and incorporated by the cinematographic film.”²⁰² Then it notes:

...there is a possibility that the words “read or otherwise visually perceived” may lead to misunderstanding if applied to cinematographic works. A cinematographic work is perceived both visually and by the ear, at least if it is a sound film, as the overwhelming majority of modern cinematographic works are. There is no doubt that the negative and positive films (comprising both picture band and sound track) are copies of the cinematographic work; and that if these copies are generally distributed to the public, for example, by selling thousands of copies, the cinematographic work will be published. However, it may be argued that not any copy can cause publication but only copies serving visual perception; that sound films serve not only visual perception but also perception by the ear. There may be some merit in this argument. However, sound

²⁰¹ Article VI of the Universal Copyright Convention reads:

‘Publication’, as used in this Convention, means 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.

²⁰² A. BOGISCH, *THE LAW OF COPYRIGHT UNDER THE UNIVERSAL CONVENTION* 71 (1964).

films are also intended for visual perception. Once this element is present, it satisfies the words "read or otherwise visually perceived" of Article VI.²⁰³

Neither the logic of the analysis nor the justice of the result is undercut by any legislative action or administrative procedure noted earlier as regards treatment of the motion picture soundtrack. Indeed, the attitude of the House Judiciary Committee on soundtrack protection, identified in the Committee's report on the Sound Recording Act and effectuated by action of the Copyright Office, is supported by this analysis.²⁰⁴

As noted earlier, the Copyright Office's practice of refusing to register an isolated motion picture soundtrack, or a soundtrack offered as the only new matter in a previously published or registered motion picture, has been urged in anti-protectionist theory as authority for denying the copyrightability of all motion picture soundtracks.²⁰⁵ However, nothing even remotely suggestive of such authority need be read in this practice. A lone soundtrack, bearing sounds which are not integrally conjoined with photographic images, is neither visually appreciable nor intelligible vis-à-vis the collocated idea expression of a motion picture "author". Its rejection is a logical mandate of the very approach under which it is protectible as an integrated part of a motion picture when offered for registration as such.

²⁰³ *Id.* at 73-74.

²⁰⁴ The Committee's attitude is reflected in the text accompanying note 37 *supra* and in the following continuance thereof, at 117 CONG. REC. 1566, 1571 (1971):

Under the existing title 17, "motion pictures" represent a broad genus whose fundamental characteristic is a series of related images that impart an impression of motion when shown in succession, including any sounds integrally conjoined with the images. Under this concept the physical form in which the motion picture is fixed—film, tape, discs, and so forth—is irrelevant, and the same is true whether the images reproduced in the physical object can be made out with the naked eye or require optical, electronic, or other special equipment to be perceived.

Note that no mitigation of this attitude inheres in the proposed Copyright Revision Bill, S. 1361, 93d Cong., 1st Sess. (1973). Motion pictures are identified in the proposed legislation as a sub-class of "audio visual works" and are defined thus, *id.* §101:

"Motion pictures" are audiovisual works consisting of a series of related images which, when shown in succession, impart an impression of motion, together with accompanying sounds, if any.

²⁰⁵ See note 68 *supra* and accompanying text.

The logic which mandates rejection of a soundtrack offered as the only new matter in a previously published or registered motion picture is almost identical. The added difference in this instance is that the motion picture proprietor has earlier made his bargain with the public by publishing or registering the motion picture without inclusion of the later proffered soundtrack. The examples provided by the Copyright Office in this regard are illustrative of how that bargain can be made without also jeopardizing the copyrightability of the motion picture itself, though it be considered independent from the later proffered soundtrack for purpose of *White-Smith* analysis. "An old silent picture with a new soundtrack"²⁰⁶ bears "the collocation devised" by its "author" without attachment of the new soundtrack, because "the collocation devised" was structured at a time when certain visual techniques, now antiquated, could be utilized to posit elements of the collocation which today would be structured aurally. "A previously published foreign film with a dubbed soundtrack in English"²⁰⁷ bears "the collocation devised" by its "author" without attachment of a dubbed soundtrack in English, because "the collocation devised" was originally structured by inclusion of a foreign language soundtrack. Just as the motion picture soundtrack is protectible as part of an integrated motion picture when offered for registration as such, these Copyright Office examples are protectible while their later included soundtracks are not protectible under a *White-Smith* analysis which neither violates the analytical strictures of *White-Smith* nor the copyrightability concerns of the Constitution.

If anything further need be said of *White-Smith* germane to the soundtrack copyrightability issue, it is this. While *White-Smith* may appear superficially to be the most threatening of explosives set by anti-protectionist theorists under the wings of a protectionist rationale, the case emerges substantively as the most devastating of legal mines which discharge their conceptual loads in the face of anti-protectionist theory itself. More than reason determines such a result, for intelligibility and visual appreciability tests are copyrightability tests. Copyrightability tests exist to examine amenability to a statutory charter in which inheres a special kind of constitutionality. *White-Smith* cannot be applied to resolve a copyrightability question in a manner which deems constitutionality of no or merely piecemeal relevance. Nor need *White-Smith*, properly understood, be in any way ignored. In the context of an applied "species of the genus" copyrightability analysis, *White-Smith* may be deemed useful as an analytical tool when wedded to a reason which preserves constitutional

²⁰⁶ See Example 1 in note 68 *supra*.

²⁰⁷ See Example 2 in note 68 *supra*.

propriety. The substance of its rules and the sense of their utility derive from an aesthetic constitutional definition and a promotive/protective constitutional charge, and these the courts have consistently approached in reasonable fashion when applying "species of the genus" doctrine to a copyrightability issue. Thus, *White-Smith* emerges as no less than a structural support of protectionist rationale itself. Failing as an arm in the arsenal of anti-protectionist thought, it may be identified not only as leaving that arsenal, but as leaving that arsenal empty.

Unfortunately, the absence of logical and legal support does not leave that arsenal without societal meaning. The promotion of anti-protectionist theory is recent, yet its history may be measured in years. The attack on motion picture property during the 1970s has involved a purely intellectual assault on motion picture copyright, but it has embraced as well the drawing of economic blood. No analysis of the former would be complete or even practical without investigation of the latter, given its continuing presence and projected growth. We pass, then, from an analytical consideration of intellectual mischief to a confrontation with crime—and element which has accorded anti-protectionist theory its most unctuous approval.

III. MOTION PICTURE SOUNDTRACK PIRACY

(A) *The Economics of Soundtrack Piracy*

Organized soundtrack piracy did not even exist in the United States until the very beginning of 1973. Upon arrival, its practice evidenced a marketing insight and an operational style which left the rampant jazz piracy of the early 1950s looking like the invention of amateurs.²⁰⁸

In January of 1973, the first record piracy operation wholly devoted to the marketing of appropriated motion picture soundtracks entered the United States record market. Its organizers billed the company as "Cinema Records". "Cinema's" marketing activities were relatively unconcealed,²⁰⁹ and its commercial success was instantaneous. The outfit was immediately followed into the soundtrack piracy business by "Sound/Stage Recordings". "Cinema" and "Sound/Stage" operated from

²⁰⁸ See *Piracy on Records*, 5 STAN. L. REV. 433 (1953).

²⁰⁹ The organization's product packaging did, however, attribute performances of the pirated/bootlegged soundtrack material to a fictitious orchestra. Other "throw-off" devices employed by soundtrack piracy organizations are "Recorded in Europe" tags, phony conductor credits, "Not for Profit" disclaimers, and even copying prohibition warnings.

bases in California, but their products reached record retail outlets throughout the nation. Neither organization encountered any legal resistance from federal or state anti-piracy authorities. Both organizations, however, were carefully watched by would-be record pirates, bootleggers, and counterfeiters savoring the small fortunes being made by the soundtrack raiders. When it was apparent by mid-1973 that "Cinema" and "Sound/Stage", for whatever reason, had incurred not opposition but rather a de facto license to loot, the would-be's became active coast to coast. In the ensuing two years, some two dozen soundtrack piracy operations have taken the domestic field.

The new record piracy—new in the sense that its objective was virgin, its de facto immunity was unprecedented, and its generally open marketing procedure was unheard of—is essentially an illicit economic response to two developments. The first and earlier of these was the appearance in the United States of what has been identified as the soundtrack market.²¹⁰ The second was the recognition and demonstration, by legitimate record companies, of the large profit opportunities inhering in that market.

As to the former, it may be defined as a sub-market within the market for records, itself quite vast. Consumers within the soundtrack market purchase soundtrack albums of musical significance. These are records of original, serious musical scores or scoring excerpts from motion pictures. Many soundtrack consumers are soundtrack collectors—persons who have acquired or who intend to acquire hundreds of film music records and whose hobby it is to acquire virtually all important film music records which exist.

The soundtrack market finds its origin in the practice of record companies and/or film companies to release soundtrack albums concurrently with the release of source films. For the past thirty years, such albums have been manufactured and marketed at an approximate retail price of \$5. Though such releases now number in the thousands, they have always been very few relative to the number of original film scores composed each year. Generally, these albums remained "in print" so long as the source films remained in theatrical release. Unless such albums became surprise money makers, they went "out of print" when their source films were withdrawn from release. With production of the individual albums halted in this manner, the albums themselves became rare records as retail stores sold out or returned their stock.

The appetite for such albums remained intact with the passage of years, however. By the beginning of the 1970s, demand for the old, out of

²¹⁰ Sutak, *The Investment Market in Movie Music Albums*, HIGH FIDELITY, July, 1972, at 62.

print soundtrack album releases was intensive enough to establish market prices for the rare records which begin at the \$20-\$25-\$30 range, average out at the \$40-\$50-\$60 range, start to tip at the \$100-\$150-\$200 range, and in exceptional cases peak at the \$1000-\$1500-\$2000 range.²¹¹

One journalist has attempted to define the rationale of this phenomenon. His research question was economic; his answer was aesthetic as well:

Why these prices, and who is paying them? The *why* is attributed to the current demand-versus-supply factor—original press runs were minimal and those not sold were scrapped and melted down, leaving an inventory of zero. The *who* is a market not existing ten and twenty years ago—the young students and film enthusiasts of today, who are more knowledgeable and appreciative of the history of film scoring, an art which they contend to be the only innovative musical medium of this century.²¹²

The direction of this film music demand is linked with a history of film music composition. As we have seen, the forms of film music composition were relatively established by the early 1930s. Thereafter, the contributions of “old masters” like Max Steiner, Erich Korngold, Alfred Newman, Dimitri Tiomkin, Franz Waxman, Victor Young, Bronislau Kaper, David Raksin, Hugo Friedhofer, Miklos Rozsa, and Bernard Herrmann, together with the works of “new wave” composers like Alex North, Elmer Bernstein, Leonard Rosenman, Andre Pevin, Ernest Gold, Jerome Moross, Henry Mancini, and Jerry Goldsmith, created a “Golden Age of Film Scoring” in American films, the effects of which may still be felt in the better-made films of today.

It was the out of print recorded music of composers such as these which ran rare soundtrack album prices up to astonishing levels by the beginning of the 1970s. The legitimate record companies were hardly unmoved by news that items such as \$50 or \$1500 records existed, especially since such prices continued to climb. Yet convinced as they were about the intensity of this demand, the decision makers at these companies were quite skeptical about the extent of this demand. However, the waters of the vintage film music phenomenon did seem worthy of an

²¹¹ The market price record is currently held by the RCA LP of Max Steiner's score for “The Caine Mutiny” (‘54) (currently over \$2,000 per copy). Runners-up include the GE LP of Bernard Herrmann's television opera “A Child Is Born” (‘55) and the Ford LP of Alex North's score for “American Road” (‘53) (both currently about \$1,500 per copy).

²¹² Considine, *Soundtracks: Bon-Bons, Yip-ee-i-o's . . .*, N.Y. Times, Aug. 27, 1972, §D, at 20, col. 1.

experimental dip, and one was taken. It was entitled "The Sea Hawk: The Classic Film Scores of Erich Wolfgang Korngold", an album produced by RCA featuring newly recorded excerpts from several film scores composed by a deceased musician whose deification had remained a matter of musical controversy for more than half a century. The disc was released shortly before Christmas of 1972. By that Christmas, the record was the largest selling classical recording of 1972; today it is almost the largest selling classical record of all time. And: after "The Sea Hawk" came the deluge.

It has been two years since the renaissance began, and in that time the world of serious musical recordings has shifted mightily. The best sellers of that changed world have not been performances of Tchaikovsky, Brahms, or Beethoven, but rather performances of vintage Korngold, Steiner, Newman, Rozsa, Waxman, and Herrmann. Recordings of vintage Tiomkin, Friedhofer, Raksin, Kaper, and Young are slated for future market success. Film music societies have been formed to issue recordings of full scores, these produced either through the independent rerecording of old scores or by the independent licensing of soundtrack recording rights in newer scores. Film music works by the "old masters" are being joined with those of the second generation "new wavers" in invariably sold out concerts held in cities as diverse as Hollywood, Buffalo, and London. Symphonies, concertos, cantatas, and chamber works by the same composers are being released by record companies. Walton, Vaughan-Williams, Bliss, Copland, Antheil, Thomson, Prokofiev, and Shostakovich are being discovered by youngsters weened on rock music and movie music, simply because these classicists have written some of the finest of all movie music. A half-dozen major record companies have embarked on reissue programs, returning many repackaged soundtrack recordings of the 1950s to the current marketplace. Most importantly, film producers, many of whom sent movies and movie music spiraling into a decade-long artistic depression by insisting on "pop song" scoring in recent years, have reacted to the huge box-office success of recent seriously scored films by perceiving anew that movies are less than moving when their soundtracks are aesthetically defective.²¹³

If the renaissance is multi-leveled, its only negative aspect is the proliferation of soundtrack piracy. This development is particularly unsettling, for the motion picture industry is beset by many more internal problems than one which has, until recently, affected only record man-

²¹³ See Bernstein, *supra* note 85; Raksin, *Whatever Became of Movie Music?*, FILMMUSIC NOTEBOOK, Autumn, 1974, at 22.

ufacturers and performers.²¹⁴ In two years, over one hundred vintage motion pictures have had their soundtracks fall prey to piracy, and the economic loss represented by the appropriation is not inconsiderable.²¹⁵

More importantly, the two year tally appears to represent only the beginning of the robbery. New soundtrack piracy organizations appear almost monthly. Solicitations appear regularly in soundtrack market literature, seeking to tap any and all sources, in the film industry or out, that can supply vintage film music tracks for eventual delivery in the marketplace. Certain well known repositories of such materials

²¹⁴ Most seriously, there is the problem of *film* piracy, which has grown rapidly in recent years and now costs the motion picture industry an estimated \$50,000,000 to \$100,000,000 in lost revenues each year. The rapid growth of film piracy is largely attributable to the motion picture industry's past attempts to ignore piracy out of existence. However, the need for a coordinated industry-wide attack on film piracy was recognized in 1974, and on Feb. 19, 1975, the Motion Picture Industry Association of America disclosed plans to establish a security organization (now the MPAA Print Security Office) to combat film piracy. The MPAA organization operates as the "prime instrument in locating pirates, and cooperating with the police authorities and prosecutors' office in putting these pirates in jail." *World-Wide War on Pix Print Pirates*, Variety, Feb. 19, 1975, at 5, col. 3. *quoting* J. Valenti, MPAA president. In one sense, film piracy may be regarded as subsuming soundtrack piracy, since film pirates duplicate film soundtracks as well as film visual tracks when they duplicate motion pictures. However, the film piracy network and the soundtrack piracy network are otherwise quite distinct in their marketing operations, such that the soundtrack piracy network has remained unscathed throughout the present war on film piracy as well as throughout the continuing war on record piracy. To date, a number of criminal indictments, both state and federal, have been returned against various film piracy organizations, but no indictments, either state or federal, have been returned against soundtrack piracy organizations. The de facto immunity of the soundtrack piracy network from state and federal criminal laws has operated despite the fact that the various film pirates presently under criminal indictment are charged, in part, with violation of the same criminal laws which are violated by soundtrack piracy organizations. *See: Id.*; *Suspect in Piracy of Films is Seized*, N.Y. Times, Feb. 20, 1975, at 40, col. 1; *Raid On Print Pirate; Title Range Shock*, Variety, Feb. 26, 1975, at 28, col. 1; *Movie Bootlegger Suspect Seized*, N.Y. Post, Feb. 20, 1975, at 40, col. 1.

²¹⁵ Base fees paid for licenses to record motion picture music tracks range from \$5,000 to \$10,000 per source film, plus a percentage of net profits earned by the record manufacturer. Thus, the revenue loss to the motion picture industry represented by the current tally of appropriated soundtracks is probably over \$1,000,000. This loss appears relatively slight when contrasted with annual lost revenues caused by film piracy. *See* note 214 *supra*. It is important to note, however, that annual lost revenues caused by film piracy have reached greater amounts only because film piracy drew no organized opposition when film piracy first appeared on an organized basis.

—university libraries which have been storing film scores and music tracks donated by composers and film companies for the purpose of making these available to film and music scholars now and in the future—have been forced to cancel general accessibility to much of their research collections as a result.²¹⁶

Yet the universities have been alone in their activated response to organized soundtrack piracy. Legitimate record companies, which in many cases are licensees of the right to record the music tracks now being pirated, have not acted because their predominant anti-piracy concern is with appropriation of current product.²¹⁷ Film composers have not acted because, almost without exception, they have no standing to act.²¹⁸ Federal and state criminal authorities have not acted for reasons which will become evident when we consider the operation and legal status of soundtrack piracy. Independent of some confusing legal implications, the soundtrack piracy situation has become so frustrating to some of the interests being harmed that one famous composer is reported to have attacked, with swinging cane in hand, a shelf full of pirated soundtrack albums containing his music in a New York City record shop.²¹⁹

The problem of soundtrack piracy cannot, of course, be settled by waving a cane in vehement assault upon recordings which either are or are not stolen goods provided by persons who either are or are not criminals. But the problem can be settled. And if the settlement lies beyond the beclouding of the issue which has occurred in the theorizing of the law, it also lies beyond the confusions which cling to the enforcement of the law.

B. The Operation of Soundtrack Piracy

Most of the domestic soundtrack piracy outfits operate from California. However, the largest of all such organizations—"Curtain Calls Records"—operates from a base in New York. Given what is perceived to be an immunity produced by legal confusion and litigative inconvenience, few soundtrack piracy operatives make any attempt to cloak their activities. The distribution channels through which their products pass to consumers are multiple, and the most important of these channels is even

²¹⁶ The major university film music libraries are located at Syracuse University (The George Arents Research Library) and at the University of Wyoming (The Division of Rare Books and Special Collections).

²¹⁷ This explanation was uniformly offered—on a not-for-attribution basis—by representatives of record companies queried by the author.

²¹⁸ See Lees, *When the Music Stopped*, HIGH FIDELITY, July, 1972, at 20.

²¹⁹ *Pirates*, PRO MUSICA SANA, Summer, 1974, at 16.

unique. So, too, is a specialized financing arrangement often employed by soundtrack pirates to generate the income which makes large scale soundtrack piracy immediately profitable.

Like other forms of record piracy, soundtrack piracy embraces three distinct methods of stealing sound: piracy, bootlegging, and counterfeiting. The soundtrack pirate engages in piracy *per se* when he duplicates a legitimate recording and then sells the pirated disc under a pirate label and in pirate packaging. The soundtrack pirate engages in bootlegging when, without a license, he transfers the never-before-recorded music tracks of a film to records which are then made available for sale. Occasionally, the source of such booty is not a film soundtrack but rather a tape of a radio broadcast of concertised film music. The soundtrack counterfeiter, as he operates within the context of organized soundtrack piracy, duplicates the recording, the label, and the packaging of the bogus product produced by his pirate/bootlegger competitor.

Unlike the practices which characterize record piracy in general, the piracy and counterfeiting which inhere in organized soundtrack piracy are never directed toward duplication of currently available legitimate recordings. The legitimate records duplicated by soundtrack pirates are invariably out of print, rare soundtrack albums which sell for extremely high prices as legitimate issues. This type of piracy is highly profitable because a pirate edition of a legitimate album which sells for \$100 per copy can be sold for anywhere from \$5 to \$25. Similarly, the soundtrack pirate's style of counterfeiting is highly profitable because, by adopting a credo of dishonor among thieves, a competitor who manufactures and sells pirate or bootleg soundtrack albums can be undercut in price when *his* efforts are appropriated. Soundtrack piracy may also be distinguished from generic record piracy in that soundtrack pirates deal more in the manufacture and sale of records than in the manufacture and sale of tapes.

One other feature of the soundtrack pirate's product invites close attention: it sometimes may be defined in terms of an eclectic illegality.

For reasons owing to concern with technical sound quality,²²⁰ soundtrack albums issued by legitimate record companies do not always contain the same recording of the motion picture score as was used in the source film itself. Sometimes these albums contain a rerecording of the score—a recording made independently of that made for the film soundtrack, though the same personnel may be employed to produce both. Sometimes these albums contain a mixture of rerecorded excerpts from the

²²⁰ See Margolis, *Why Soundtrack Albums Don't Sound Better*, HIGH FIDELITY, July, 1972, at 59.

score and excerpts taken directly from the film soundtrack. Even where the legitimate soundtrack album contains material taken exclusively from the film soundtrack by direct transfer, the disc often omits other musical material contained on the film soundtrack. The omitted material may often exist, as a rerecorded excerpt (especially in the case of songs) or as a direct soundtrack quotation, on *another* legitimate record album.

Thus, in compiling musical material to produce a bogus soundtrack album, the soundtrack pirate often has a range of material from which to draw. He may produce an album which contains only the duplication of a legitimate soundtrack album, and this bogus product may be (1) a duplication of an original, direct transfer soundtrack album, (2) a duplication of a soundtrack album containing a rerecorded score, or (3) a duplication of a soundtrack album which mixes direct transfer soundtrack quotations with rerecorded excerpts from the score. To his duplication of an original, direct transfer soundtrack album, he may add the duplication of a recorded song, from the same score, which appeared originally in rerecorded form on another legitimate album. Similarly, to his duplication of a soundtrack album containing a rerecorded score, he may add recorded excerpts from the same score taken directly from the film soundtrack. He may even offer excerpts from two or more film scores in one bogus package, some taken directly from film soundtracks (or from legitimate soundtrack albums which contain direct transfer quotations), the rest taken from legitimate rerecordings of film music materials.

Thus, in many instances the soundtrack pirate's product represents a combination pirate/bootleg soundtrack album. And counterfeit product produced by soundtrack pirates represent combination counterfeit/pirate soundtrack albums, combination counterfeit/bootleg soundtrack albums, or combination counterfeit/pirate/bootleg soundtrack albums.

As will be seen, these distinctions become crucial when the issue of the legal culpability of soundtrack pirates arises. Our present consideration, however, mandates attention to the interesting manner by which the fruits of soundtrack piracy are served to their consumers.

Just as the "demand" side of the domestic soundtrack market exhibits unique economic characteristics relative to pricing, the "supply" side of this market evidences certain marketing attributes not shared by more common record distribution networks. As was suggested earlier, the recognition of a widespread consumer demand for serious film music recordings occurred at three levels and at three times. Initially, this demand was recognized and attended to "informally" during the mid-1960s by small scale entrepreneurs. Later, when the great success of the "informal" marketers began to generate magazine and newspaper reports during the early 1970s, the "formal" record companies recognized this demand and proceeded to tap it in earnest. Finally, the re-

ported success of the "informal" marketers, the more obvious success of the "formal" marketers, and the sudden legal confusion stirred by anti-protectionist claims in the area of motion picture soundtrack protection, encouraged record pirates, bootleggers, and counterfeiters to enter the soundtrack market, where they have remained and where more continue to migrate at great profit, while carving a truly different form of record piracy out of the generic record piracy pie.

The supply network of prime concern in this analysis derives from the growth of those responsible for the first instance of demand recognition: the small scale entrepreneurs, who are no longer so small in terms of their market importance. Originally, these market actors operated solely from retail record stores located in large cities like New York and Los Angeles. Perceiving a new, high price demand for out of print soundtrack albums in the mid-1960s, these retailers conducted or authorized wide-ranging supply hunts throughout the nation. At the same time, they converted portions of their stores into rare soundtrack album repositories. Within time, they gained reputations as high priced soundtrack album specialists.

Their activities were watched closely by other small entrepreneurs, who quickly concluded that the high price demand for old soundtrack albums was geographically broad and, hence, could be tapped by mail. Like the record store retailers-turned-soundtrack specialists, the mail-order marketers traveled from town to town, city to city, and state to state buying up old soundtrack album stock found in out-of-the-way record shops, discount record bins, and flea markets. Like some of the record store retailers themselves, the mail-order salesmen published catalogs listing their large inventories and high prices, advertised in music and film magazines, and both collected their money and distributed their wares through mail-order operations.

Today, and together, the mail-order soundtrack dealers and the record store soundtrack specialists manage to blanket the United States and foreign countries in terms of tapping demand for the old soundtrack albums at their new prices. Most of the business done in this market goes to approximately a dozen dealerships, evenly divided as to both mail-order/record store type and West Coast/East Coast location. While the record store retailer type of dealership is the most visible of these marketing systems, the mail-order seller type of dealership looms as the most important. For the mail-order dealers' catalog and brochure publications bind many thousands of interested consumers, located in all states and in several countries, to a handful of major distribution centers. The mail-order dealers themselves usually possess resale and occupancy licenses issued by their respective states, their organizations are each

staffed with several employees, and their operations are entirely legitimate with one possible exception: the mail-order dealers provide the primary means utilized by soundtrack piracy organizations for the sale of pirated, bootlegged, and counterfeited soundtrack albums to thousands of consumers.

This was much less the almost uniform case which exists today when the soundtrack piracy outfits made their market debut early in 1973. When "Cinema Records" and "Sound/Stage Recordings" began to issue large quantities of pirate and bootleg soundtrack discs from California, and as "Curtain Calls Records" appeared shortly afterward in New York to offer both a large catalog of high priced bootleg soundtrack albums and an integrated mail-order system to handle national distribution, the feeling was widespread among legitimate soundtrack sellers that "Cinema", "Sound/Stage", and "Curtain Calls" could not appropriate so many motion picture music tracks and record company soundtrack albums, or make so much money from the appropriations, or operate so brazenly, without incurring a legal reckoning. Thus, the wares pushed by these organizations were handled very sparingly at first by mail-order dealers.

Yet not only did the trio of soundtrack piracy pathfinders remain legally unopposed, the three organizations so flaunted their perceived immunity that within six months of their appearance, "Curtain Calls" had achieved a roaring nationwide mail-order success while "Cinema" and "Sound/Stage" had won nationwide distribution through legitimate wholesalers supplying key retail outlets throughout the country. This half-year period of sustained motion picture soundtrack looting, attended by a de facto license to loot, ended all hesitation on the part of major soundtrack marketers. Soundtrack piracy organizations were then swiftly and almost universally embraced by the mail-order distributors as key suppliers, and a score of new soundtrack piracy organizations rose east and west to join "Cinema", "Sound/Stage", and "Curtain Calls" on the front lines of the great motion picture soundtrack robbery.

The embrace of soundtrack piracy by the soundtrack market's major actors also marked a vital shift in the financial arrangements which attend the manufacture and distribution of pirate, bootleg, and counterfeit records within this market. For with distribution through the mail-order organizations came direct contact with an international market of inveterate soundtrack collectors, film music addicts, and old fashioned suckers. Given that breakthrough, and with a burgeoning profit outlook and a perceived practical immunity to spur them on, the soundtrack piracy organizations next introduced a game plan for motion picture soundtrack appropriation which was not to be surpassed in its financial allurements by any gambit yet devised within the world of record piracy. No longer, it was

seen, need soundtrack piracy organizations manufacture bogus soundtrack albums and *then* invade the marketplace with their product. Now, instead, the musical chairs of manufacture and sale could be switched: the market itself could be used to finance the movie music depredation *in advance*.

That is to say, the soundtrack piracy organizations could now inform the mail-order soundtrack dealers of pirate and/or bootleg soundtrack albums *to be produced*. The dealers, in turn, could announce the news of the upcoming productions to thousands of consumers through promotions inserted in the internationally distributed periodic sales letters and brochures published by the dealers. Though the present unavailability of the bogus soundtrack albums would have to be conceded, consumers could be invited to mail in their payments for the discs *immediately*. Indeed, consumers could be urged to place their "reservations" quickly, perhaps at special "pre-release prices", for records which "might" become available in "very limited quantities" at some time in the near future ("If enough response is generated you will receive your record in April"). The dealer-solicitor generally could deny guaranteed delivery of the soundtrack spoils "except to reserve order customers". To hopefully protect from possible implication in an illegal enterprise, the mail-order dealer could even tell his customers something like: "The legal staff of the manufacturer stated that this recording does not violate U. S. copyright requirements."²²¹

Thereafter, payments from hundreds to thousands of customers desiring the bogus disc would flow through the mails to the mail-order distributors. A certain amount of the receipts would be channeled back to the "independent label" manufacturer. The manufacturer would take his immediate profit out of his receipts. The rest of the money would be used to make robbery a reality.

If the procedure appeared initially to be a record pirate's fantasy, it nevertheless worked wonderfully in fact. "Foreign American Productions" led the way with bravado, announcing an intention "if enough response is generated" to begin a large scale piracy operation by which various motion picture soundtrack recordings would be lifted off of their foreign release labels to be made available in the United States at \$8 per pirated disc.²²² Other soundtrack piracy organizations quickly adopted the consortium technique of record piracy. Soon the soundtrack market mail-order exchange system was awash in announcements of upcoming

²²¹ *Special Pressing Advance Notice 1* (Promotion distributed by Sound Track Album Retailers, Winter, 1974).

²²² *Id.* at 1-2.

appropriations and invitations urging the placement of "reservations" at "pre-release prices", these distinguishing an unprecedented system of manufacture and distribution in the world of record piracy. The system has, in fact, bequeathed the worst of all possible record piracy worlds: one in which pirate and bootleg recordings are conceived in union with the public, nursed in disregard of any applicable law with the participation of otherwise legitimate distributors, and delivered—after the fact of profit—first through the mails and then also through nationwide retail stores serviced by otherwise legitimate wholesalers.

It is this consortium system of soundtrack piracy, together with the integrated form of piracy whereby a manufacturer wields its own mail-order distribution network, which operate and flourish in the United States today. Announcements of projected soundtrack appropriations appear in soundtrack market literature at a rough average of two or three forthcoming production news breaks each month. Where soundtrack appropriations are made by an integrated manufacturer/distributor, brochures listing the organization's ever expanding catalog of soundtrack booty are advertised in national film and music magazines in classic record piracy fashion, supplying box addresses but mentioning no names other than that of the soundtrack piracy organization itself.

Such developments as these, however unfortunate, may have proved valuable in two respects. Organized soundtrack piracy, by dealing motion picture property the kind of sustained economic blows which generally would be legally permissible if the anti-protectionist claims we considered could be supported in law, has served to demonstrate the implicit end of anti-protectionist theory itself. At the same time, by delivering such blows irrespective of the protection accorded motion picture property by law, and pursuant to the perception that protection of property by law may be disregarded when prolonged non-application of law leaves the same property to be savaged, organized soundtrack piracy has served to demonstrate the harms which follow when protectionist laws go unenforced, whether because they are insisted to be groundless or because they present a small mire of procedural difficulties too frontally confusing to be faced.

As every vestige of anti-protectionist theory is seen to crumble analytically, the organized economic activity which bears a clearly illegal status once its theoretical sanction is discredited may be identified as necessitating the application of law. Still, if motion picture soundtrack protection is to be more than a meaningless notation imbedded in written copyright law, then the proceedings which give effect to such protection must be precisely reasoned, their pitfalls fully understood. Such requisites arise because, paradoxically, the soundtrack pirate and certain of his distributors stand as the most vulnerable and the most slippery of all criminal

actors operating within the field of record piracy. Our final analysis will evidence why this is so, and why vulnerability remains singularly pronounced when the oils provided to the criminal actor by copyright law are understood and thereby dissolved.

(C) *The Challenge of Soundtrack Piracy*

As we have seen, no element of generic record piracy has enjoyed a freedom from legal interference comparable to that accorded to organized soundtrack piracy. How incongruous to note, then, that no element involved in organized record piracy is as ripe for plucking by law enforcement authorities, or as legally pluckable, as is organized soundtrack piracy. The explanation of so unique a paradox lies in the peculiar interrelationship of the copyright law of the United States, the anti-piracy laws of the several states, and the variant nature of the stolen beast itself—the illicit soundtrack recording.

The Copyright Act has long provided that certain infringements of copyright are not only civil violations but also criminal violations. Section 104(a) provides that any person who, for profit, willfully infringes a federal copyright shall be deemed guilty of a federal misdemeanor.²²³ Punishment of such a person, upon conviction, is by imprisonment in federal prison lasting up to one year and/or by fine of up to \$1000.²²⁴ Moreover, the same criminal penalties apply to any person who knowingly and willfully aids or abets such an infringement.²²⁵

Prior to October 15, 1971, there was an express exception to this rule of criminal liability within the Copyright Act. This exception held that when a person, by the unauthorized manufacture, use, or sale of records or tapes, infringed a musical copyright held by a copyright owner who had given up his exclusive right to record under a compulsory license agreement, that infringer would not be subject to criminal liability.²²⁶

This exception was entirely deleted from the Copyright Act on October 15, 1971.²²⁷ At the same time, it was superseded by one of the

²²³ 17 U.S.C. §104 was recently amended by 88 Stat. 1873 (1974), Pub. L. 93-573. 17 U.S.C. §104(a), amending 17 U.S.C. §104 reads in appropriate part:

Except as provided in subsection (b), any person who willfully and for profit shall infringe any copyright secured by this title, or who shall knowingly and willfully aid or abet such infringement, shall be deemed guilty of a misdemeanor, and upon conviction thereof shall be punished by imprisonment for not exceeding one year or by a fine of not less than \$100 nor more than \$1,000, or both, in the discretion of the court . . .

²²⁴ 17 U.S.C. §104(a), amending 17 U.S.C. §104. See also note 230 *infra*.

²²⁵ 17 U.S.C. §104(a), amending 17 U.S.C. §104. See also note 230 *infra*.

provisions of the Sound Recording Act.²²⁸ The new provision became available to protect the owner of a musical copyright immediately—on October 15, 1971.

The balance of the sound recording amendment, providing for the copyrightability of records and tapes,²²⁹ became effective on February 15, 1972. Thus, working in two directions within one legislative act, Congress brought record piracy itself within the terms of the federal copyright law providing for federal criminal penalties.²³⁰ Hence, unauthorized duplication of copyrighted records and tapes is now a federal crime, and infringement of a musical copyright via the duplication of copyrighted or uncopyrighted records and tapes appears to be a federal crime as well.²³¹

²²⁶ Act of March 4, 1909, ch. 320, §25, 35 Stat. 1081, as amended 17 U.S.C. §101(e), read in appropriate part:

Whenever the owner of a musical copyright has used or permitted the use of the copyrighted work upon the parts of musical instruments serving to reproduce mechanically the musical work, then in case of infringement of such copyright by the unauthorized manufacture, use, or sale of interchangeable parts, such as disks, rolls, bands, or cylinders for use in mechanical music-producing machines adapted to reproduce the copyrighted music, no criminal action shall be brought, but in a civil action an injunction may be granted upon such terms as the court may impose, and the plaintiff shall be entitled to recover in lieu of profits and damages a royalty. . . .

²²⁷ Act of Oct. 15, 1971, 85 Stat. 391, Pub. L. 92-140 §2.

²²⁸ *Id.*

²²⁹ Act of Oct. 15, 1971, 85 Stat. 391, Pub. L. 92-140 §1.

²³⁰ An expiration date contained in the Sound Recording Act has since been removed, and the criminal provisions of 17 U.S.C. §104 have since been expanded to increase the penalties covering unauthorized duplication of copyrighted sound recordings. 17 U.S.C. §104(b), *amending* 17 U.S.C. §104, reads:

Any person who willfully and for profit shall infringe any copyright provided by section 1(f) of this title [providing for the copyrightability of sound recordings], or who shall knowingly and willfully aid or abet such infringement, shall be fined not more than \$25,000 or imprisoned not more than one year, or both, for the first offense and shall be fined not more than \$50,000 or imprisoned not more than two years, or both, for any subsequent offense.

²³¹ The issues of whether or not record pirates may be prosecuted and convicted under federal copyright law for a crime of *infringement of a musical copyright via unauthorized duplication*, and of where that leaves the constitutionality of state anti-piracy laws if they can, are believed to be beyond the scope of the present analysis. However, since approaching discussion focuses on the ability of the

Of these two crimes, that of unauthorized duplication has won prime attention in recent years, for the reason that sound recordings produced prior to the effective date of the Sound Recording Act's extension of copyright remain unprotected by the criminal sanctions of the federal copyright law which apply to copying *per se*. However, passage of the Sound Recording Act bore no effect on motion picture soundtrack protection as to location in time. As noted earlier, when Congress amended the copyright law on October 15, 1971, Congress excluded the film soundtrack from the net of criminal liability established by the Sound

state anti-piracy authorities as well as the ability of federal anti-piracy authorities to attack soundtrack piracy, some preliminary observations on the problems which spring from these issues may be made.

The issue of the viability of a crime of *infringement of a musical copyright via unauthorized duplication* arises for two reasons. For one, the provision of former law excepting record piracy from criminal liability for infringement of a musical copyright was deleted from the federal copyright law on Oct. 15, 1971, effective that date; this action implicates the existence of such a crime under federal law since that date. See notes 226-27 *supra* and text accompanying notes 226-28 *supra*. For another, several Circuit Courts of Appeal have held that the compulsory license provision of the federal copyright law does not entitle record pirates to duplicate uncopyrighted sound recordings. *E.g.*, *Edward B. Marks Music Corp. v. Colorado Mag., Inc.*, 497 F.2d 285 (10th Cir. 1974), *appeal pending*, 95 S.C. 36 (1975); *Duchess Music Corp. v. Rosner*, 458 F.2d 1305 (9th Cir. 1972), *cert. denied*, 409 U.S. 847 (1972).

Difficulties with such a crime spread to the area of state anti-piracy laws for two reasons. For one, the crime of *unauthorized duplication per se* (copying) and the crime of *infringement of a musical copyright via unauthorized duplication* (infringement-via-copying) appear to present a problem of merger. For another, it is difficult to reconcile any such merger with the impact, though not the facts, of *Goldstein v. California*, 412 U.S. 556 (1973).

Approaching discussion notes that *Goldstein* allows the states to deal with record piracy by employing state anti-piracy laws which protect against *unauthorized duplication*. See text accompanying notes 233-235 *infra*. Approaching discussion also notes the strong implication in *Goldstein* that the states may protect from illicit copying only those recordings which the federal copyright law does not protect from copying. See note 128 *infra* and accompanying text. However, if the federal copyright law allows prosecution and conviction of record pirates for a crime of infringement-via-copying, then the federal copyright law may be used in federal criminal enforcement against any type of record piracy, whether the piracy involves copyrighted or uncopyrighted sound recordings. Yet, if that is so, and the preclusive implication in *Goldstein* is a valid one, and copying and infringement-via-copying are to be considered a merged crime, then the states are effectively precluded from applying state anti-piracy laws to all post-Oct. 15, 1971 acts of record piracy. Since *Goldstein* involved a state conviction for acts of record piracy which were not only pre-Feb. 15, 1972 but also pre-Oct. 15, 1971, the case on its facts can be harmonized with (1) the viability of a federal crime of infringement-via-copying, (2) the preclusive implication in *Goldstein*, and (3) a merger of the

Recording Act. Congress did so because the film soundtrack was perceived to be already covered by another criminal liability net—the one which had long been in the Copyright Act to protect motion picture copyrights, among other copyrights, from infringement.²³²

In June of 1973, a third net of criminal liability relative to record piracy was authorized. That authorization, of course, came by way of the United States Supreme Court's decision in *Goldstein v. California*.²³³ The *Goldstein* case involved a California record pirate who had been convicted under a California anti-piracy law which made unauthorized duplication a state crime.²³⁴ The defendant sought to have that law and his conviction

crime of copying and the crime of infringement-via-copying. Such a harmonization, however, breeds the unsettling consequence of presently denying the states *any* power to protect against record piracy, since the statute of limitations has run on pre-Oct. 15, 1971 acts of record piracy.

On the other hand, if *Goldstein* is to be taken as a continuing sanction of present state anti-piracy laws which protect against the copying crime, *and* if the preclusive implication in *Goldstein* is a valid one, then the crime of copying and the crime of infringement-via-copying must be considered separate and distinct crimes. This consideration breeds the strange consequence that one class of record piracy actions (involving copyrighted recordings) is amenable to federal conviction for two crimes, each of which carries different penalties under section 104(a)&(b), while another class of record piracy actions (involving uncopyrighted recordings) is amenable simultaneously to state conviction for the crime of copying and to federal conviction for the crime of infringement-via-copying.

Whatever the case, inevitably we shall have answers as to which case is law and how that case can be law. The Justice Department has recently decided to supplement its prosecutions of the copying crime (under section 104(b)) with prosecutions of the infringement-via-copying crime (under section 104(a)). See *Justice Dept. To Step Up War Vrs. Pirates, U.S. Atty. Tells NARM, Variety*, March 12, 1975, at 61, col. 6. Meanwhile, prosecutions and convictions for the copying crime proceed at the state level under state anti-piracy laws in those cases where federal authorities cannot apply federal copyright law to copying *per se*, though in the same cases they may very well be able to apply federal copyright law to a crime of infringement-via-copying.

If both processions are permissible, *and* if the implication in *Goldstein* is valid, then *unauthorized duplication* and *infringement of a musical copyright via unauthorized duplication* must be deemed separate and distinct crimes. In that case we may note that even if a federal criminal copyright law may be used against *any* record pirate, jurisdiction over recording piracy remains dichotomous with regard to the crime of copying. Approaching discussion explores both this dichotomy in its initial posture and the degree to which such a dichotomy fades when the eclectically illegal product of soundtrack piracy is examined. See text accompanying notes 239-40 *infra*.

²³² See text accompanying notes 35-37 *supra*.

²³³ 412 U.S. 556 (1973).

²³⁴ CAL. PENAL CODE §653(h).

thereunder overturned as unconstitutional. In a 5/4 decision, the Court held that the area of copyright law was not an exclusively federal concern which disallowed state action in protecting record companies and music publishers. Instead, ruled the Court, the states were free to deal with record piracy by employing state anti-piracy criminal laws;²³⁵ hence, the state anti-piracy law and the criminal conviction thereunder were upheld as constitutional.

California had adopted its anti-piracy statute in 1967, following the lead set by New York in 1966.²³⁶ Several other states had passed anti-piracy laws before or while *Goldstein* was in the judicial process, on its way to the nation's highest court. The Court's decision in *Goldstein* not only sanctioned these state actions; it invited more states to pick up the gauntlet spread by the nation's record and tape pirates. New York and California—the major bases of organized soundtrack piracy if not of organized record piracy itself—have now been joined in their anti-piracy posture by twenty-five other states. Some of these states—but not New York or California—provide felony sanctions in the area of record piracy. Legislative movement along the state anti-piracy route is predicted for those states which have not yet adopted their own anti-piracy laws.²³⁷

It is not absolutely clear whether these state laws afford protection against all pirated, bootlegged, or counterfeited recordings, or whether they protect from unauthorized duplication only those recordings which the federal copyright law does not protect from unauthorized duplication *per se*. The Court in *Goldstein*, though it did not consider the issue directly, strongly implied that the states may protect from unauthorized duplication those recordings which the federal copyright law does not protect from unauthorized duplication.²³⁸

²³⁵ The *Goldstein* ruling operates at least with respect to recordings fixed prior to February 15, 1972. No question was raised in *Goldstein* as to the power of the states to protect recordings fixed after that date. 412 U.S. at 552 n.7. *But see* note 238 *infra* and accompanying text *infra*.

²³⁶ N.Y. PENAL LAW §441(c).

²³⁷ *Justice Dept. To Step Up War Vrs. Pirates, U.S. Atty. Tells NARM, Variety*, March 12, 1975, at 61, col. 5.

²³⁸ The Court ended its opinion in *Goldstein* by declaring, at 412 U.S. at 571 (emphasis added):

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. Accord, Goldstein, Inconsistent Premises and the Acceptable Middle Ground: A Comment on Goldstein v. California, 21 BULL. CR. SOC. 25, 27 (1973); *The Supreme Court, 1972 Term—Patent and Copyright Law*, 87 HARV. L. REV. 282, n.5 (1973).

If this is indeed the case, then a record pirate in most areas of the United States may be identified as violating a criminal law which protects against unauthorized duplication—but he will commit that crime either under federal law or under a state law, depending upon the exact identity of the recording he appropriates. To this general rule born of the holding and implication of *Goldstein* there is, however, one salient exception: a record pirate who happens to engage in soundtrack piracy may bring his illegal activity under the concurrent purviews of federal and state criminal laws which protect against unauthorized duplication.

Reference was made earlier to the fact that the soundtrack pirate's product sometimes bears features which establish an eclectic illegality. If, for instance, a record pirate duplicates a legitimate recording which was "fixed" prior to the effective date of the Sound Recording Act, it is generally the case that he is immune from federal criminal liability as regards the crime of unauthorized duplication; as to that crime, only the state criminal laws may be used against this pirate within the criminal sphere.²³⁹ If, however, a soundtrack pirate duplicates a legitimate recording which was "fixed" prior to the effective date of the Sound Recording Act, but that legitimate recording happens to be a soundtrack album upon which were "fixed" excerpts drawn by direct transfer from the music tracks of a motion picture, then the pirate's criminal liability posture, as to his unauthorized duplication, operates as a function of his violation of a motion picture copyright. The federal criminal law may be applied to this violation, in the same manner as the federal law would be applied had the appropriated music tracks not been licensed to a legitimate record company but bootlegged by the soundtrack pirate.

Further, if a soundtrack pirate duplicates a legitimate recording which was "fixed" prior to the effective date of the Sound Recording Act, and that legitimate recording happens to contain a mixture of direct transfer quotations from the music tracks of a motion picture and rerecorded quotations from the same motion picture score, then the pirate's criminal liability posture, as to his unauthorized duplication, operates both as a function of his violation of a motion picture copyright *and* as a function of his violation of an applicable state anti-piracy law. In this instance, the soundtrack pirate, with one illegal product, has violated the federal criminal law protecting the motion picture *and* the state criminal law protecting sound recordings issued before the sound recording amendment was enacted. These separate laws apply with equal force to the illegally duplicated product because the excerpts contained on the product bear separate legal identities, just as they would if the soundtrack

²³⁹ See note 231 *supra*.

pirate *bootlegged* music tracks from one motion picture on one side of his product while he *pirated* rerecorded material from another motion picture on the other side of his product.

We may note, therefore, that the dimensions of the criminal liability network relative to organized soundtrack piracy operate as a function of a "bouncing ball" technical analysis of illicit soundtrack product where the crime of unauthorized duplication is concerned. Such a technical analysis is mandated before law enforcement authorities move against organized soundtrack piracy on an unauthorized duplication charge, because if different or dual criminal liability nets apply to this crime, then different or dual law enforcement authorities carry the power to move against an isolated instance of organized soundtrack piracy upon a charge of this crime. Since the "bouncing ball" technical analysis must be deemed at least initially confusing to those unfamiliar with the reasons why it is required, and since the emphasis in the area of enforcement of anti-piracy laws has so far been on enforcement of unauthorized duplication laws,²⁴⁰ it is small wonder that organized soundtrack piracy has thus far been granted a full de facto immunity within the war on record piracy.

A number of examples suffice to demonstrate how the "bouncing ball" technical analysis might be applied in the enforcement of unauthorized duplication laws relative to organized soundtrack piracy. "Curtain Calls Records"—the largest soundtrack piracy organization operating in the United States—builds its catalog mostly by appropriating the original music tracks of copyrighted motion pictures, primarily musicals of the 1930s and 1940s. "Curtain Calls" operates from a base in New York. At the same time, an off-shoot soundtrack piracy organization operating from California devotes its activities wholly to counterfeiting the original "Curtain Calls" records, which are bootlegged discs to begin with. The internal pirate war is based on price positions: "Curtain Calls"-New York invades the market first with products selling at an \$8 to \$15 range, and "Curtain Calls"-California follows soon after with counterfeit/bootleg discs selling at a \$5 level. Now, both New York and California have anti-piracy criminal laws which protect against unauthorized duplication. But "Curtain Calls"-New York and "Curtain Calls"-California deal only in illicit recordings which carry original motion picture music track transfers. If the jurisdictional dichotomy implicated by *Goldstein* is a valid one, then the activities of "Curtain Calls"-New York and "Curtain Calls"-California are solely a federal criminal concern.

Both "Cinema Records" and "Sound/Stage Recordings" operate otherwise, however, and so their posture in law emerges differently. Both

²⁴⁰ See note 231 *supra*.

soundtrack piracy organizations offer titles in their catalogs which may be identified solely as bootlegged recordings of motion picture music tracks—a federal criminal concern. Both organizations also offer titles in their catalogs which may be identified solely as pirated recordings of legitimate label rerecordings of excerpts from one or more motion picture scores—a state criminal concern. Further, both organizations offer titles in their catalogs which may be identified as pirate/bootleg recordings: these combine pirated rerecorded film music quotations (the state criminal concern) and bootlegged direct transfer quotations from film soundtracks (the federal criminal concern). Irrespective of the validity of the jurisdictional dichotomy implicated by *Goldstein*, both the federal and the state law enforcement authorities may move against such organizations upon a charge of unauthorized duplication. That is, the twin moves may be made as long as the illicit product produced by such organizations is carefully targeted so that the varying legal identities born by different products do not conflict with either or both of the two jurisdictional nets which may be cast.

There is more to organized soundtrack piracy than manufacture and sale to mandate the attention of law enforcement authorities. There is also the element of distribution. Just as the manufacture/sale element of soundtrack piracy occupies a unique legal position within the general field of record piracy, producing an unusual vulnerability to the applied force of law once the avenues by which that force may proceed are carefully weighed, so the distribution/sale element of soundtrack piracy—operating at the retail store or mail-order level—may be clearly distinguished from that distribution/sale element which inheres in general record piracy itself.

The distinctions in this case are two-fold. First, and correlatively, the distribution/sale element of soundtrack piracy is subject to the same “bouncing ball” technical analysis as is the manufacture/sale element. If the distributors aid or abet infringements of copyright which the federal law protects against, then their liability is a federal concern. When their actions relate to infringing articles which the state laws protect against, then their liability is a state concern. And when, by their actions, the distributors come within the twin ambits of both federal and state law, then their liability emerges as dual as does the liability of their suppliers.²⁴¹

²⁴¹ The issue of possible liability of the distribution/sale element as to aiding or abetting the commission of more than one crime is believed to be beyond the scope of the present analysis. See note 231 *supra*.

Second, and perhaps more importantly, the marketing characteristics which distinguish the distribution network which operates in the soundtrack market from the distribution network which operates in the overall record market, also establish the former network as much more vulnerable to the force of law—in the practical sense of enforcement—than is the latter network. As is well known, the aiding or abetting provision of the federal copyright law has very rarely been applied against retail distributors who sell pirate, bootleg, or counterfeit recordings from their inventories of such articles.²⁴² There is little mystery about this lapse, for the logic of the prosecutorial abstinence in this area is a simple and practical one.

To establish criminal liability on the part of retail distributors of infringing articles under the federal copyright law, it apparently is not necessary to prove that one charged with aiding or abetting a copyright infringement did so for profit, so long as the infringer aided or abetted was infringing a copyright for profit.²⁴³ It is necessary, however, to prove that the aiding or abetting was knowingly and willfully done.²⁴⁴ Equivalent “knowledge” requisites are also included in the state anti-piracy laws which outlaw distribution of pirate, bootleg, and counterfeit recordings.²⁴⁵

“Knowledge” at the distribution/sale level of record piracy is difficult to prove before a jury. For one, the penal provision must be strictly construed against the prosecution and in favor of the defendant.²⁴⁶ For another, when a distributor handles thousands of record titles, released on scores of labels, and containing a dozen broad classes of recorded music, he is able to claim that he can hardly be expected to be intimately aware of, or even generally knowledgeable about, each and every article he sells—including those which are illegal. Whether or not they are uniformly honest, the distributors’ claims of ignorance in the area of

²⁴² 2 M. NIMMER, NIMMER ON COPYRIGHT 709 (rev. ed. 1974). See also *Feds In Frisco Zero In On Disk Retailers To Head Off Pirates*, Variety, Feb. 26, 1975, at 49, col. 6.

²⁴³ NIMMER, *supra* note 242, at 708 n.9.

²⁴⁴ See note 223 *supra*.

²⁴⁵ E.g., N.Y. PENAL LAW §441(c) reads in appropriate part:

Any person who:

....

(2) Shall sell any [pirate, bootleg, or counterfeit recording] with the knowledge that the sounds thereon have been so transferred thereon without the consent of the owner,

Shall be guilty of a misdemeanor.

²⁴⁶ NIMMER, *supra* note 242, at 708.

record piracy have been uniformly persuasive enough to discount criminal prosecution.²⁴⁷ Thus, since the burden of proof carried by prosecutorial forces generally looms as insurmountable so as to remove the threat of prosecution from the activities of retail distributors, these distributors generally enjoy a de facto immunity which the manufacture/sale element generally does not enjoy.

However, the distribution/sale element which operates in the soundtrack market operates therein in a fashion which, by its peculiar marketing distinctions, excludes all benefit of the cloak of practical immunity worn by other record distributors. The stock-in-trade of this element happens to be rare soundtrack albums. The soundtrack market distributor, whether he operates by use of the mails, a store, or both, must know every title released, every label, every cover design, every market price, and every dimension of rarity relative to several hundred out of print legitimate soundtrack albums so as not to incur any opportunity loss in his elected specialty. "Knowledge" becomes something other than an insurmountable burden of proof when a specialty distributor sells the legitimate Capitol soundtrack album of "The Pride and the Passion" for \$50 and its pirated counterpart for \$5. This is even more the case when the distributor's widely circulated sales literature informs his consumers that pirate soundtrack albums do not adversely affect the market prices of their legitimate antecedents, and that all bootleg soundtrack albums listed for sale have indeed been produced by employing the original music tracks of the films which bear their titles.

The distribution/sale element of soundtrack piracy rises to a higher level of practical legal vulnerability when it participates in the consortium style of soundtrack piracy. As was seen earlier, consortium-style soundtrack piracy can only work when its operation is made very public. Here, the public must be informed directly by the distribution/sale element of its posture of aware assistance, in order that the tail which secures capital by brochure solicitation may wag the dog supplied with capital to commit an act of soundtrack piracy. We may note, then, that if it is the manufacture/sale element of organized soundtrack piracy which has been most prominent in defying both federal and state law enforcement authorities to bear the inconvenience of analysis and application of copyright law, it is the distribution/sale element of that piracy which has been mailing out the invitations.

²⁴⁷ See *Blues Over Bootleg Record Boom Here*, N.Y. Post, Jan. 4, 1975, at 2, col. 3. But see *Feds In Frisco Zero In On Disk Retailers To Head Off Pirates*, Variety, Feb. 26, 1975, at 49, col. 6.

Finally, the practical legal vulnerability of the distribution/sale element of organized soundtrack piracy may be identified as most pronounced when the distribution/sale element and the manufacture/sale element are one and the same. This occurs in the case of an integrated soundtrack piracy organization, where the manufacturer employs its own mail-order and/or retail store network to achieve distribution. Here, "knowledge" may simply be deemed an implicit function of the integrated marketing activities.

CONCLUSION

Few developments in the history of motion picture copyright concerns have been more unfortunately bred than the promulgation of anti-protectionist theory with regard to the motion picture soundtrack. Nor have many developments in that history been more strangely sanctioned than the appearance and widening of a mini-industry devoted to seizing and marketing that which anti-protectionist theory would largely free into the public domain. The consummate challenge produced by these twin developments cannot be ignored. If the motion picture soundtrack is not protected by motion picture copyright, then we are living within the biggest musical and literary public domain ever accidentally bequeathed by the twentieth century entertainment industry. Yet if the motion picture soundtrack is protected by motion picture copyright, then we are tolerating, and encouraging by catatonic reaction, an economic climate of burgeoning criminal assault upon motion picture property, as to which protection in law must inevitably assume the mantle of meaningless formality.

Both in legal theory and in economic practice, these lines of conflict have not so much been drawn as they have been imposed. If they are not to multiply, they must be attended to in legal fashion. Where they are tolerable at all, intellectual mischief and economic mischief are tolerable only up to the point where they feed or feed off of each other. The impact of their appointed union places the societal importance of that appointment squarely in legal focus. For the reckoning invited, if it awaits at all, lies in law.

If such challenge must be met, the meeting must follow irrespective of any attending embarrassments. The argument which emerges from the present analysis is not only that anti-protectionist theory is wrong in its conclusions, but that it is also defective in its legislative assumptions, imprecise and often incorrect in its historical references, objectionable in its predicate analytical maneuvers, ignorant in its aesthetic awareness,

misinformed as to the seriousness of its pursuit, and altogether insupportable in law.

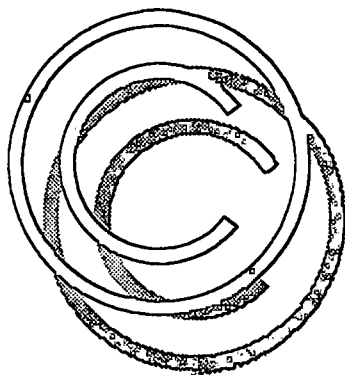
Still, it has not only been born in the commentaries, it has sprung therein as fully matured and as insistently armored as we are likely to see it stand. Until the status of the motion picture soundtrack within copyright law is judicially settled, the challenge presented by anti-protectionist theory will have to be met where the roots of the great motion picture soundtrack robbery have been planted: in the commentaries. Here, anti-protectionist theory should speedily be returned to its proper position in copyright law, stamped with the label of dangerous legal mythology. Here also, the protectionist theory urged by Professor Nimmer should be returned to a position of legal orthodoxy. As the preceding analysis evidences, whether the protection of the motion picture soundtrack be deemed an objective correlative of the legislative intent attending the express statutory recognition of motion picture copyright, or whether it be identified as a function of applying "species of the genus" analysis to the soundtrack copyrightability issue, Professor Nimmer's protectionist summary states the only conclusion that a necessarily wide-ranging investigation of law will support.

It might be argued, independently of substantive analysis, that the courts would not look with favor upon the prospect of a huge and sudden artistic anarchy in the area of motion picture property, and that therefore the courts would not allow such a result to flow. It might be more saliently contended, in accord with substantive analysis, that the courts would never plunge the motion picture industry into so fracturing a chaos as the judicial adoption of anti-protectionist theory would provide, when the case law, the legal authorities, the extra-judicial administrative positions, and an examination of legislative intent argue overwhelmingly on behalf of motion picture soundtrack protection. Either of these perceptions might be very sound, and yet they are insufficient as notations with which to lay the issue of soundtrack protection to analytical rest. The final embarrassment which inheres in the matters we have explored is that a criminally parasitic industry, much beyond the budding state, has been allowed to defy so many copyright laws, to operate so openly and profitably, to grow so quickly, and to present so substantial and continuing a threat to motion picture property and to the viability of penal copyright laws, without incurring any opposition.

As we have seen, a catatonic response to such an assault on motion picture property has not been without some justification. Apart from the fears fired by the promotion of anti-protectionist theory, the manner in which enforcement of law may proceed in this area is multi-dimensional and often confusing. An attempt has been made here to identify the pitfalls which exist in this area. A guide has been provided by which travel

may progress through the maze of eclectically illegal product, functionally applicable law, isolated and concurrent jurisdictional networks, and practical barriers or vulnerabilities attending problems of proof. An excuse for prolonged inaction in opposing the physical dimension of the assault upon motion picture property no longer will lie. Unlike the cause of mitigating mere intellectual damage, the eradication of continuing economic damage cannot be made a reality in the commentaries alone. That is first and foremost the charge of the federal law enforcement agency, for it is at the federal level where protection of the motion picture soundtrack began, and it is at that level where that protection remains to be frontally enforced and finally sustained.

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PART I.

ARTICLES

321. THE SCOPE OF COPYRIGHT PROTECTION IN THE UNITED STATES UNDER EXISTING INTER-AMERICAN RELATIONS: *ABROGATION OF THE NEED FOR U.S. PROTECTION UNDER THE BUENOS AIRES CONVENTION BY RELIANCE UPON THE UCC*

By ALFRED L. RINALDO, JR.*

INTRODUCTION

Examination of the United States' inter-American copyright relations reveals that the United States has not ratified an inter-American copyright convention since the Buenos Aires Convention of 1910.

In the sixty-five years that have passed since the creation of the Buenos Aires Convention, however, copyright has undergone tremendous changes. Modern technology has broadened the scope of copyright protection. Similarly, the increased transfer of technology and the rising exchange of literary and artistic property have expanded the need for more sophisticated inter-American copyright relations.

To meet these needs of a growing copyright industry, inter-American countries have twice met since 1910 to discuss and ratify superseding inter-American conventions. The articles of these conventions have vastly increased the scope of copyright protection over that available under the Buenos Aires Convention of 1910. Yet, the United States has remained firm in its reliance upon the Buenos Aires Convention.

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This paper examines the scope of United States copyright protection under existing inter-American relations. In doing so, it directs itself to the issue of whether the United States has really relied upon the Buenos Aires Convention of 1910; or whether the United States has turned, instead, to international protection under the Universal Copyright Convention—copyright protection which has abrogated the need for reliance upon existing inter-American copyright conventions, most notably the Buenos Aires Convention of 1910.

1. *THE STATUS AND SCOPE OF UNITED STATES COPYRIGHT PROTECTION UNDER EXISTING INTER-AMERICAN CONVENTIONS AND BILATERAL AGREEMENTS*

In October of 1889, the United States entered into its first inter-American bilateral agreement with Costa Rica for the reciprocal protection of literary and artistic property.¹ As United States' inter-American trade began to expand, so too did the need for further copyright protection with her neighbors to the south. Thus, in 1896 the United States entered into similar bilateral agreements with Mexico and Chile.² Under these bilateral agreements, the United States, finding adequate assurances that United States citizens enjoyed copyright protection equivalent to the nationals of the other country, extended reciprocal national treatment to the copyrightable works of the citizens of the other country in the United States.

The continued growth of inter-American trade, prompted by the advent of the industrial revolution, and the creation of the Berne Union for the international protection of copyright, led to the first inter-American copyright convention for the protection of literary and artistic property, namely the Mexico City Convention of 1902, which the United States ratified on March 31, 1908.³

In 1903, the United States extended reciprocal national treatment for copyright protection to the citizens of Cuba. In April of 1910, reciprocal national treatment, based upon the United States Copyright Act of

¹ PAN AMERICAN UNION, *COPYRIGHT PROTECTION IN THE AMERICAS* 140 (3d ed. 1962). [hereinafter PAN AMERICAN UNION]

² *Id.*

³ Convention on Literary and Artistic Copyrights Signed at Mexico City, January 27, 1902, at the Second International Conference of American States, in *ORGANIZATION OF AMERICAN STATES, INTER-AMERICAN TREATIES AND CONVENTIONS*, No. 9 (1971), at A-5 [hereinafter cited as Mexico City Ratifications]. The Mexico City Convention text appears at PAN AMERICAN UNION, *supra* note 1, at 145 [hereinafter cited as Mexico City Text]

1909, was extended to Chile, Costa Rica, Cuba, and Mexico. Such treatment, however, did not extend to Section 1(e) mechanical reproduction rights in recordings.⁴

In the meantime, the United States had attended, but had failed to ratify the Rio Convention of 1906.⁵ But new inter-American discussion got under way in July of 1910 for an even more expanded copyright convention. These talks resulted in the United States ratification of its second inter-American copyright convention, the Buenos Aires Convention of 1910. Far and away the most progressive convention in copyright protection in its time, this convention was ratified by eighteen of twenty-one eligible inter-American countries, making it the single most ratified inter-American convention in inter-American copyright relations.⁶

For a long while, the United States relied primarily on the copyright protection available under the Buenos Aires Convention of 1910 in its copyright relations with other American countries. In the meantime, the growth in the scope of copyrightable works and the increased need for expanded authors' rights led to subsequent inter-American conventions at Havana in 1928⁷ and at Washington, D.C., in 1946.⁸ Among those countries which were ratificants to either the Havana Convention or the Washington Convention and the Buenos Aires Convention, these two conventions expressly superseded the provisions of the Buenos Aires

⁴ PAN AMERICAN UNION, *supra*, at 140.

⁵ Convention on Patents of Invention, Drawings and Industrial Models, Trade Marks, and Literary and Artistic Property, Signed at Rio de Janeiro, August 23, 1906, at the Third International Conference of American States, ORGANIZATION OF AMERICAN STATES, *supra* note 3, at A-12 [hereinafter cited as Rio Ratifications]. The Rio Convention text appears at PAN AMERICAN UNION, *supra* note 1, at 148 [hereinafter cited as Rio Text].

⁶ Convention on Literary and Artistic Property Signed at Buenos Aires, August 11, 1910, at the Fourth International Conference of American States, in ORGANIZATION OF AMERICAN STATES, *supra* note 3, at A-16 [hereinafter cited as BAC Ratifications]. The Buenos Aires Convention text appears in PAN AMERICAN UNION, *supra* note 1, at 152.

⁷ Revision of the Convention of Buenos Aires on the Protection of Literary and Artistic Copyright, Signed at Havana, February 1, 1928, at the Sixth International Conference of American States, ORGANIZATION OF AMERICAN STATES, *supra* note 3, at A-30 [hereinafter cited as Havana Ratifications]. The Havana Convention text appears at PAN AMERICAN UNION, *supra* note 1, at 157 [hereinafter cited as Havana Text].

⁸ Inter-American Convention on the Rights of the Author in Literary, Scientific, and Artistic Works, Signed at Washington, D.C., June 22, 1946, at the Inter-American Conference of Experts on Copyright, ORGANIZATION OF AMERICAN STATES, *supra* note 3, at B-28 [hereinafter cited as Washington Ratifications]. The Washington Convention text appears in PAN AMERICAN UNION, *supra* note 1, at 160 [hereinafter cited as Washington Text].

Convention of 1910.⁹ Nevertheless, the United States failed to ratify either of these two subsequent inter-American conventions.

The United States did extend Section 1(e) mechanical reproduction rights in recordings (not covered under the Buenos Aires Convention) to Cuba in 1911, and to Chile in 1925. In 1934, it extended reciprocal national treatment, including Section 1(e) mechanical reproduction rights, to Argentina, and again to Brazil in 1957.¹⁰ Other than this, however, the extent of United States copyright protection under existing inter-American conventions remained dependent upon the Buenos Aires Convention of 1910.

An examination of the present status of inter-American copyright relations reveals the impact of the United States' dependence upon the Buenos Aires Convention of 1910. Among the three countries which did not ratify the Buenos Aires Convention, El Salvador continues to maintain copyright relations with the United States under the Mexico City Convention of 1902,¹¹ Venezuela enjoys no copyright relations with the United States under existing inter-American conventions,¹² and Cuba relies on its bilateral agreements for copyright protection with the United States.¹³

More important, however, is the present status of copyright relations among those countries which did ratify the Buenos Aires Convention. Among the eighteen ratificants of the Buenos Aires Convention, two countries, Panama and Colombia, now maintain inter-American copyright relations with Nicaragua, Guatemala, Ecuador, and Costa Rica under the Havana Convention of 1928, whose articles expressly supersede the Buenos Aires Convention.¹⁴ In addition, fourteen countries, thirteen of which are members of the Buenos Aires Convention, now

⁹ Havana Text, *supra*, Article 16, at 158; and Washington Text, *supra*, Article 17, at 164.

¹⁰ PAN AMERICAN UNION, *supra*, at 140.

¹¹ See Chart III, *infra*. El Salvador also enjoys copyright relations with the Dominican Republic under the Mexico City Convention, as well as copyright protection under the Rio Convention of 1906 with Brazil, Chile, Costa Rica, Ecuador, Guatemala, Honduras, Nicaragua, and Panama. See also Chart I, *infra*.

¹² *Id.* Venezuela enjoys limited copyright relations with Bolivia, Ecuador, and Peru under the Caracas Agreement of Literary and Artistic Property of 1911, in UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD (1956 with periodical loose-leaf supplements) [hereinafter cited as Caracas Agreement].

¹³ PAN AMERICAN UNION, *supra*, at 140.

¹⁴ Havana Ratifications, *supra*, at A-30. See Chart III, *infra*. Article 16 of the Havana Text provides that the Havana Convention shall replace the Buenos Aires Convention among Contracting States who are parties to both Conventions. See Havana Text, *supra*, at 158.

maintain inter-American copyright relations pursuant to the Washington Convention of 1946; its articles expressly supersede all prior inter-American conventions, including, *inter alia*, the Buenos Aires Convention of 1910.¹⁵

The cumulative result of these subsequent ratifications to superseding inter-American conventions upon the status of the Buenos Aires Convention has been devastating. Today, copyright protection under the Buenos Aires Convention exists only among three countries, the United States, Peru, and Uruguay, and in their relations with:

Argentina	Guatemala
Bolivia	Haiti
Brazil	Honduras
Chile	Mexico
Colombia	Nicaragua
Costa Rica	Panama
Dominican Republic	Paraguay ¹⁶
Ecuador	

The remaining fifteen inter-American countries rely on other inter-American conventions for copyright protection among themselves.¹⁷ In fact, absent the economic significance of continued United States reliance upon this outdated convention, other countries would probably be quick to abandon it altogether.

Notwithstanding the fact that but for United States reliance upon the Buenos Aires Convention, the convention itself would probably be abandoned, let us now consider the scope of protection available to United States citizens under the provisions of the Buenos Aires Convention, and the effect of subsequent inter-American conventions upon its scope.

The scope of copyright protection available under the Buenos Aires Convention of 1910 did not differ substantially from its two predecessors, the Mexico City Convention of 1902 which governed United States-El Salvador copyright relations, and the Rio de Janeiro Convention of 1906. The Rio Convention of 1906 expressly incorporated the articles of the Mexico City Convention of 1902.¹⁸ Similarly, although the Buenos Aires Convention did not expressly incorporate the articles of the two earlier

¹⁵ Washington Ratifications, *supra*, at B-28. See Chart III, *infra*. For provisions on supersession of Buenos Aires Convention, see Washington Text, *supra*, Article 17, at 164.

¹⁶ See Chart III, *infra*.

¹⁷ *Id.* See also Chart I, *infra*.

¹⁸ Rio Text, *supra*, Article I, at 148.

conventions, in many instances it reproduced almost textually the Mexico City Convention articles of 1902.¹⁹

For example, the author of a literary or artistic work enjoyed the exclusive power to dispose of, publish, assign, translate or authorize translation, and reproduce the work in any form whether wholly or in part.²⁰ In addition, the works protected included:

... books, writings, pamphlets of all kinds...; dramatic or dramatico-musical works; choreographic and musical compositions, with or without words; drawings, paintings, sculpture, engravings; photographic works; astronomical or geographical globes; plans, sketches or plastic works relating to geography, geology, or topography, architecture or any other science; and, finally, all productions that can be published by any means of impression or reproduction.²¹

The protection of lawful translations as original works,²² the prohibiting of indirect appropriations,²³ the reproductions in educational publications and chrestomathies,²⁴ and the seizure of piratical reproductions,²⁵ *inter alia*, also remained the same under the Buenos Aires Convention as under the two earlier conventions.²⁶

In short, the Buenos Aires Convention preserved the fundamental principle of the Mexico City Convention, "lex fori", or copyright protection according to the law of the country where the protection was claimed (national treatment).²⁷

The Buenos Aires Convention differed from the Conventions of Mexico City and Rio de Janeiro, however, in four respects. First, it abandoned the idea of creating an inter-American copyright union and the establishment of inter-American copyright bureaus. Second, it suppressed the notion of making inter-American copyright conventions open to accession by non-American republics. Third, it required that either the author or his legal representative claiming under him be a

¹⁹ PAN AMERICAN UNION. COPYRIGHT PROTECTION IN THE AMERICAS 63 (3d. ed. supp. 1967) [hereinafter cited as PAN AM SUPP.].

²⁰ BAC Text, *supra*, Article 4, at 152.

²¹ *Id.*, Article 2.

²² *Id.*, Article 9, at 153.

²³ *Id.*, Article 13.

²⁴ *Id.*, Article 12.

²⁵ *Id.*, Article 14.

²⁶ I. S. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 663 (1938).

²⁷ PAN AM SUPP., *supra*, at 53.

national or a domiciled foreigner in an American republic, and that the work be published in the territory of such republic. Lastly, it abolished the necessity of formalities required under the two prior conventions, except in the country of origin, but added that a notice indicating the reservation of a property right must appear on the work seeking convention protection (e.g., "All Rights Reserved" or "Derechos Reservados").²⁸

Under the Buenos Aires Convention, "lex fori" also governed the duration of copyright protection, except that such duration could not exceed the term given by the country of origin.²⁹

In short, these four areas marked the only differences between United States-El Salvador copyright protection under the Mexico City Convention and United States copyright relations with the other seventeen Buenos Aires Convention countries. In all other respects, the Buenos Aires Convention of 1910 reproduced the scope of the author's rights and the scope of the works protected under the two previous inter-American conventions. It is important to note, however, that the Buenos Aires Convention, like its predecessors, failed to define the term "publication", failed to provide any copyright protection for unpublished works, and most importantly, failed to provide protection for mechanical reproduction rights in recordings.³⁰

Of course, the Buenos Aires Convention of 1910 represented the most sophisticated copyright convention of its time in 1910. Expansion of the copyright industry, however, resulted in a need for even more sophisticated copyright protection. And so the scope of copyright protection began to broaden.

The Havana Convention of 1928 made some important changes in copyright protection. It expanded the list of works protectible to include lithographs, cinematographic works, reproductions by means of mechanical instruments destined to reproduce sounds, and "acts applied to any human activity whatever."³¹ It expanded the rights of authors of literary and artistic works to include the exclusive right to authorize the reproduction, adaptation and public presentation of their works by means of cinematography.³² It expanded the rights of authors of literary and musical works to include the exclusive right to authorize:

²⁸ I. S. LADAS, *supra*, at 659-662.

²⁹ BAC TEXT, *supra*, Article 6, at 152.

³⁰ T. Kupferman, "The Universal Copyright Convention Analyzed from the Inter-American Point of View", 6 BULL. CR. SOC. 227, 228 (1958-59).

³¹ Havana Text, *supra*, Article 2, at 157.

³² *Id.*, Article 4 bis.

1. the adaptation of said works to instruments that serve to reproduce them mechanically;
2. the public rendering of the same works by means of said instruments.³³

The convention also recognized an inalienable moral right in the author to oppose every reproduction or public exhibition of his works in an altered, mutilated, or revised form.³⁴ This was the first time that an author's moral rights had ever been recognized in any inter-American convention.³⁵

The convention made other changes, however, some of which may have been the reason for its overall lack of acceptance by the inter-American states, particularly the United States. First, it omitted Article 6 of the Buenos Aires Convention, and thus reverted to the principle of "lex soli" (the application of the law of the country of origin) in protecting copyrighted works.³⁶ Further, it expanded the formalities required under Article 3 of the Buenos Aires Convention, so that the notice now required to be affixed to the work was one which not only indicated the name of the person in whose favor the reservation was registered, the country of origin (the country in which first publication was made or those countries in which simultaneous publications were first made), and the year of the first publication.³⁷ Still further, it changed the duration of copyright protection to the author's life and fifty years after his death, with the stipulation that if this term was not adopted by all the signatory states, then the term of duration was to be governed by the law of the country in which protection was sought, not to exceed the term set by the country of origin of the work.³⁸

The Washington Convention of 1946 made even greater inroads with respect to the broadening of inter-American copyright protection. It added to the list of works protected under inter-American conventions the written or recorded versions of lectures, addresses, lessons, sermons, and other works of a similar nature.³⁹ For the first time in inter-American copyright, this convention recognized the rights of authors in unpublished works.⁴⁰ Likewise, for the first time in inter-American copyright,

³³ *Id.*, Article 5.

³⁴ *Id.*, Article 13 bis, at 158.

³⁵ I. S. LADAS, *supra*, at 666.

³⁶ *Id.*, at 665.

³⁷ Havana Text, *supra*, Article 3, at 157.

³⁸ *Id.*, Article 6, at 158. See also I. S. LADAS, *supra*, at 665.

³⁹ Washington Text, *supra*, Article 3, at 160.

⁴⁰ *Id.*, Article 4, at 161.

this convention protected the title of a copyrighted work whenever such work became internationally famous and its title thereby acquired such a distinctive character that it became identified with that work alone.⁴¹

Moreover, this convention abolished the necessity of a notice indicating the reservation of a property right as a prerequisite for copyright protection;⁴² such notice was fundamental to the Buenos Aires Convention of 1910. This convention further protected the moral rights of an author, but allowed him to waive these rights in accordance with the law where the contract was made.⁴³ Finally, this convention established that the duration of copyright protection should be in accord with the law of the contracting state in which the protection was originally obtained, but that it should not exceed the duration fixed by the law of the contracting state in which protection was claimed.⁴⁴

Thus, by 1946, subsequent inter-American conventions had substantially broadened the scope of available copyright protection over that available under the Buenos Aires Convention of 1910. Ratification by thirteen of the eighteen members of 1946⁴⁵ only emphasized the unacceptable narrowness of copyright protection relied upon by the United States under the Buenos Aires Convention.

II. UNITED STATES PARTICIPATION IN THE U.C.C.—ABROGATING THE NEED FOR COPYRIGHT PROTECTION UNDER EXISTING INTER-AMERICAN CONVENTIONS

Although the Buenos Aires Convention today governs the extent of copyright protection available under existing inter-American conventions, one must not be let to conclude that the United States has been derelict in obtaining contemporary copyright protection equivalent in scope to the subsequent superseding inter-American conventions of Havana and Washington.

To the contrary, the United States delegations to both the Havana and Washington conventions worked diligently to secure copyright protection that would not be totally juxtaposed to existing United States copyright law, in an effort to secure subsequent ratification of each convention by the United States. At the Washington Convention of 1946, it was the United States delegation that successfully lobbied for increasing

⁴¹ *Id.*, Article 14, at 163.

⁴² *Id.*, Article 9, at 162.

⁴³ *Id.*, Article 11.

⁴⁴ *Id.*, Article 8. See PAN AM SUPP., *supra*, at 56.

⁴⁵ Washington Ratifications, *supra*. See also Chart III, *infra*.

the scope of copyright protection over that available under the Buenos Aires Convention, and for abolishing the use of the "All Rights Reserved" notice, by providing, in the alternative, a recommended use of the word "Copyright", "Copr.", or the letter "C" in a circle (the equivalent of the United States copyright notice). Unfortunately, in spite of their efforts, the United States refused to ratify either of these conventions, because of their inherent incompatibility with United States domestic copyright legislation.⁴⁶

Finally, after continued efforts to establish a convention that would not be totally incompatible with existing United States copyright legislation, the Universal Copyright Convention of 1952 was signed and ratified by the United States, and entered into force on September 16, 1955.⁴⁷

Today, it is the Universal Copyright Convention (hereinafter referred to as the UCC) which the United States has turned to for increasing its scope of copyright protection over that available under existing inter-American copyright conventions, most notably the Buenos Aires Convention. And this is true in spite of Article 18 of the UCC, which provides:

This Convention shall not abrogate multi-lateral or bilateral copyright conventions or arrangements that are or may be in effect exclusively between two or more American Republics . . .

Examination of the scope of copyright protection available under the UCC and of the practical effect of Article 18 of the UCC reveal the integrity of this statement.

First, the principle of non-abrogation expressed in Article 18 of the UCC must be reconciled with a second principle also expressed in Article 18, dealing with the situation in which differences exist between the UCC and an inter-American convention, to wit:

. . . In the event of any difference either between the provisions of such existing conventions or arrangements and the provisions of this Convention, or between the provisions of this Convention and those of any new convention or arrangement which may be formulated between two or more American Republics after this Convention comes into force, the convention or arrangement most recently formulated shall prevail between the parties thereto . . .

⁴⁶ V. Doyle, et al., *Notice of Copyright* 26, Library of Congress (1958) (GENERAL REVISION OF COPYRIGHT LAW STUDY No. 6).

⁴⁷ Universal Copyright Convention of 1952, in UNESCO, *supra*, note 12 [hereinafter cited as UCC].

Applying this principle to differences between the UCC and the Buenos Aires Convention, since the UCC is that convention formulated later in time, it follows that the UCC should prevail over the Buenos Aires Convention with respect to any differences between the two conventions. What, then, is left of the practical importance of the first sentence in Article 18, e.g., that the UCC shall not abrogate inter-American conventions or arrangements? Mr. Bogsch answers succinctly:

As long as two countries are bound by both the Universal and an earlier inter-American convention or arrangement, the fact that they are also bound by the inter-American does not have any practical significance. On points where the two differ from each other, the Universal Convention prevails; this means that the situation would be the same if the inter-American would not exist. On points where the two do not differ from each other, any of them may be applied, and the protection would remain the same even if the inter-American would not exist. "Non-abrogation" under such circumstances and for the said purposes, consequently has no practical effect.⁴⁸

Mr. Bogsch adds that the only time this first sentence of Article 18 has any effect is under circumstances where one or both of the two countries already bound under both an inter-American convention and the UCC cease or ceases to be bound under the UCC. In such cases, the copyright relations of the two countries will be governed under the inter-American convention without the necessity of having to adhere to it anew. Thus, the principle of non-abrogation will apply only to restore copyright relations under a previously dormant inter-American convention which is brought back to life by a subsequent denouncement of the UCC.⁴⁹

In short, the principle of non-abrogation is not the general rule. Instead, the principle of the later convention in time prevailing over the earlier is the general rule. This general rule is limited by the principle of non-abrogation only in the situation discussed above, and by the third sentence of Article 18, which expresses that the general rule shall not apply if its application would affect rights in works acquired under a convention or arrangement earlier than the UCC.⁵⁰

⁴⁸ A. BOGSCH, *THE LAW OF COPYRIGHT UNDER THE UNIVERSAL CONVENTION* 133 (1964).

⁴⁹ *Id.*, at 134.

⁵⁰ *Id.* The third sentence of Article 18 provides that: "Rights in works acquired in any Contracting State under existing conventions or arrangements before the date this Convention comes into force in such State shall not be affected."

Notwithstanding the practical effect of Article 18, in fact, the scope of copyright protection available under the UCC is so substantially greater than that available under the Buenos Aires Convention (and at least equivalent to that available under subsequent inter-American Conventions),⁵¹ that ratification of the UCC abrogates the need for copyright protection under the Buenos Aires Convention or any other inter-American Convention, among those countries adhering to the UCC.⁵²

Unlike the other inter-American and international copyright conventions, the UCC does not establish any rigid lists of author's rights or works to be protected. Instead, it leaves the extent of copyright protection to the discretion of "lex fori", or national treatment. Thus, a work protected under the UCC is guaranteed copyright protection equivalent to that protection available to the nationals of the UCC country where the work is seeking protection.⁵³

The UCC, however, does establish minimum copyright protection which must be guaranteed in all member countries.⁵⁴ These minima include protection for unpublished works (Article II). Under the Buenos Aires Convention, the availability of protection for unpublished works is highly questionable,⁵⁵ if not non-existent. These minima also include the author's exclusive right to translation for seven years, after which a compulsory license may be granted (Article V). Under the Buenos Aires Convention, the right to authorize translations does exist, subject, however, to neither any specific time guarantee, nor any subsequent right of compulsory license. As a result, a country subject to the Buenos Aires Convention can arbitrarily limit the translation rights of an author to one or two years, after which this right can be lost altogether.

These minima further include a minimum duration of copyright protection, which must be not less than the author's life and twenty-five years after his death, or twenty-five years from the date of the first publication (Article IV). Under the Buenos Aires Convention, the duration of copyright is limited to the term established in the country where the work is seeking protection, not to exceed the term established in the country of origin.⁵⁶ A survey of the fifteen inter-American UCC countries

⁵¹ Compare the scope of copyright protection available under the UCC, discussed *infra*, with the scope of protection available under the Havana and Washington Conventions, discussed *supra*, at 12-15, beginning with Havana Convention.

⁵² See Chart 1, *infra*.

⁵³ PAN AM SUPP., *supra*, at 53.

⁵⁴ T. Kupferman, *supra* note 30, at 230.

⁵⁵ *Id.*, at 228.

⁵⁶ BAC TEXT, *supra*, Article 6, at 152.

reveals, however, that their domestic legislation offers at least equivalent copyright duration.⁵⁷

The UCC minima also guarantee that no formalities shall be required for works of UCC nationals or works first published in a UCC country which subsequently see copyright protection in another UCC country, provided that such work bears the letter "C" in a circle, accompanied by the name of the copyright proprietor and the year of first publication on all its copies, and provided that this notice is placed in such a manner and location as to give reasonable notice of claim of copyright (Article III). Under the Buenos Aires Convention the words "All Rights Reserved" or "Derechos Reservados" serve the same function. The UCC notice, however, extends to sixty-five member countries throughout the world,⁵⁸ while the Buenos Aires Convention notice is limited to the inter-American countries still adhering to its provisions.⁵⁹

Notwithstanding the fact that the UCC does not establish any rigid lists of author's rights and works to be protected, the UCC does guarantee minimum copyright protection in Article I:

Each Contracting State undertakes to provide for the adequate and effective protection of the rights of authors and other copyright proprietors in literary, scientific and artistic works, including writings, musical, dramatic and cinematographic works, and paintings, engravings and sculpture.

This provision, however, is general in its approach. Since it is not intended as a definitive list of either author's rights or works to be protected, one must turn to the national legislation of each inter-American UCC member in order to judge the extent to which the scope of copyright protection available under the UCC exceeds that available under the Buenos Aires Convention. Of course, a survey of the copyright protection available under each of the fifteen inter-American UCC countries is beyond the scope of this work. Nevertheless, evidence that the scope of copyright protection available under the UCC (based upon the domestic copyright law of its inter-American members) exceeds the scope of copyright protection available under the Buenos Aires Convention can be established by deduction. Since the scope of copyright protection available under the Washington Convention has been shown to exceed the scope of copyright protection available under the Buenos Aires

⁵⁷ See PAN AMERICAN UNION, *supra* note 1, at 3-125.

⁵⁸ E. Sargoy, *U. S. Copyright Law Digest*, in MARTINDALE-HUBBELL LAW DIRECTORY 2772 (1975).

⁵⁹ See Chart III, *infra*.

Convention,⁶⁰ and since twelve of the fourteen Washington Convention members are also members of the UCC,⁶¹ it follows that the national copyright law of these twelve UCC members (including the law of the Washington Convention) must be greater in scope than that available under the Buenos Aires Convention. This inference, together with the UCC minima discussed earlier, suggests only one possible result: namely, that for at least twelve of the fifteen inter-American UCC members, the scope of copyright protection available under the UCC exceeds the scope of copyright protection available under the Buenos Aires Convention.

III. CONCLUSION

From the foregoing discussion, some final observations can be made concerning the scope of United States inter-American copyright relations.

First, it has been shown that the United States copyright relations based solely upon inter-American conventions and bilateral agreements are inadequate. The United States enjoys limited copyright protection under the Mexico City Convention of 1902 with El Salvador. It enjoys no protection with Venezuela, and only limited protection with Cuba under bilateral agreements which probably have no significance at all in light of contemporary United States-Cuba relations. Finally, the United States enjoys limited copyright protection under the sixty-five year old Buenos Aires Convention of 1910, with the seventeen other inter-American ratificants.⁶²

The United States, however, has redeemed itself from its failure to ratify subsequent superseding inter-American copyright conventions, by its ratification of the UCC. Ratification of the UCC has been shown to increase the scope of United States copyright protection to a status at least equivalent to the superseding Havana and Washington conventions. And ratification of the UCC has been shown to increase the scope of United States copyright protection to a status greater than that available under the Buenos Aires Convention.

Based upon these two premises, United States participation in the UCC has, in fact, abrogated the need for copyright protection under existing inter-American conventions and bilateral agreements in all but two situations:

⁶⁰ See text at fn. 31-44.

⁶¹ See Chart I, *infra*.

⁶² See Chart III, *infra*.

1. United States-El Salvador copyright relations under the Mexico City Convention of 1902, and;
2. United States copyright relations with Colombia, Dominican Republic, Honduras, and Uruguay under the Buenos Aires Convention of 1910.⁶³

Moreover, ratification of the UCC by the United States and thirteen other inter-American countries has extended copyright protection in the Americas to sixty-five countries worldwide.⁶⁴ If, as Mr. Bogisch asserts, the notice required under the UCC is in itself sufficient to qualify as a notice indicating the reservation of a property right required under the Buenos Aires Convention, then, as a practical matter, United States copyright protection under the Buenos Aires Convention with Colombia, Dominican Republic, Honduras, and Uruguay, can be maintained without the necessity of the additional notice: "All Rights Reserved."⁶⁵

⁶³ See Chart IV, *infra*.

⁶⁴ E. Sargoy, *supra*, at 2772.

⁶⁵ A. BOGISCH, *supra*, at 131.

APPENDIX

**The following charts are based upon the combined data
of six independent sources.⁶⁶**

- Chart I - The Relevant Inter-American and International Conventions
Ratified by the Individual Inter-American Countries**
- Chart II - The Relevant Inter-American and International Convention
Ratified by the United States of America, and the Relevant United
States Bilateral Agreements**
- Chart III - The Status of Inter-American Relations Absent the Effect of the
UCC**
- Chart IV - The Effect of UCC Membership Upon The Status of Inter-American
Relations**

⁶⁶ See E. Sargoy, *supra*, at 2724, 2772; UNESCO, *supra* note 12; ORGANIZATION OF AMERICAN STATES, *supra* note 3, at A-5, 12, 15, 30, and B-28; PAN AMERICAN UNION, *supra* note 1, at 137-142; PAN AM SUPP, *supra* note 19, at 63-67; and COPYRIGHT OFFICE, INTERNATIONAL COPYRIGHT RELATIONS OF THE UNITED STATES, *Circular 38A* (1974).

CHART I

**THE RELEVANT INTER-AMERICAN AND INTERNATIONAL
CONVENTIONS RATIFIED BY THE INDIVIDUAL
INTER-AMERICAN COUNTRIES**

	Universal Copyright Convention	International Berne Union	Washington Convention of 1946	Havana Convention of 1928	Buenos Aires Conven- tion of 1910	Rio de Janeiro Convention of 1906	Mexico City Convention of 1902
Argentina	X	X	X		X		
Bolivia			X		X		
Brazil	X	X	X		X	X	
Chile	X	X	X		X	X	
Colombia				X	X		
Costa Rica	X		X	X	X	X	X
Cuba	X		X				
Dominican Republic			X		X		X
Ecuador	X		X	X	X	X	X*
El Salvador						X	X
Guatemala	X		X	X	X	X	X
Haiti	X		X		X		
Honduras			X		X	X	X
Mexico	X	X	X		X		
Nicaragua	X		X	X	X	X	X
Panama	X			X	X	X	
Paraguay	X		X		X		
Peru	X				X		
United States	X				X		
Uruguay		X			X		
Venezuela	X						

*Ratified, but ratification not deposited.

CHART II

**THE RELEVANT INTER-AMERICAN AND INTERNATIONAL
CONVENTION RATIFIED BY THE UNITED STATES
OF AMERICAN AND THE RELEVANT UNITED
STATES BILATERAL AGREEMENTS**

	Bilateral Agreement(s) with the United States	Buenos Aires Conven- tion of 1910	Universal Copyright Convention of 1952	Phonogram Convention of 1971
Argentina	X	X	X	X
Bolivia		X		
Brazil	X	X	X	
Chile	X	X	X	
Colombia		X		
Costa Rica	X	X	X	
Cuba	X		X	
Dominican Republic		X		
Ecuador		X		
El Salvador	X*			
Guatemala		X	X	
Haiti		X	X	
Honduras		X		
Mexico	X	X	X	X
Nicaragua		X	X	
Panama		X	X	X
Paraguay		X	X	
Peru		X	X	
Uruguay		X		
Venezuela			X	

*Mexico City Convention of 1902.

CHART III
THE STATUS OF INTER-AMERICAN RELATIONS
ABSENT THE EFFECT OF THE UCC

Between	And	
1. Venezuela	Bolivia Ecuador Peru	Caracas of 1911
2. El Salvador	United States Dominican Republic	Mexico City of 1902
3. El Salvador	Brazil Chile Costa Rica Ecuador Guatemala Honduras Nicaragua Panama	Mexico City of 1902 as incorporated into Rio of 1906
4. Peru United States Uruguay	Argentina Bolivia Brazil Chile Colombia Costa Rica Dominican Republic Ecuador Guatemala Haiti Honduras Mexico Nicaragua Panama Paraguay	BAC of 1910
5. Panama Colombia	Costa Rica Ecuador Guatemala Nicaragua	Havana Convention of 1928
6. Argentina Bolivia Brazil Chile Costa Rica Cuba Dominican Republic Ecuador Guatemala Haiti Honduras Mexico Nicaragua Paraguay		Washington Convention of 1946

CHART IV

THE EFFECT OF UCC MEMBERSHIP UPON THE
STATUS OF INTER-AMERICAN RELATIONS

A. UCC applies between:

Argentina	Mexico
Brazil	Nicaragua
Chile	Panama
Costa Rica	Paraguay
Cuba	Peru
Ecuador	United States
Guatemala	Venezuela
Haiti	

B. If UCC abrogates need for other protection among themselves, results:

1. Between	And	
Venezuela		Caracas of 1911
Bolivia		
2. No change		
3. No change		
4. Between	And	
Peru	Colombia	BAC of 1910
	Dominican Republic	
	Honduras	
	Uruguay	
United States	Colombia	BAC of 1910
	Dominican Republic	
	Honduras	
	Uruguay	
5. Between	And	
Colombia	Costa Rica	Havana of 1928
	Ecuador	
	Guatemala	
	Nicaragua	
	Panama	
6. Between	And	
Bolivia	Argentina	Washington of 1946
Dominican Republic	Brazil	
Honduras	Chile	
	Costa Rica	
	Cuba	
	Ecuador	
	Guatemala	
	Haiti	
	Mexico	
	Nicaragua	
	Paraguay	

322. PROTECTION FOR DESIGNS IN THE UNITED KINGDOM

By WILLIAM WALLACE*

Design protection, as such, is usually a neglected child — a younger and less considered brother of those two better known individuals, patents and copyright. When the precious time of Parliament is spared for the discussion of intellectual property matters, it is one or other of the big brothers that gets it. Designs legislation, if discussed at all, is usually considered as an appendage either to patents legislation or to legislation on copyright. This at least has been true of the United Kingdom. Judging from the lack of international discussion it is probably true of many other countries.

One difficulty is that there is no agreement either nationally or internationally on whether it is better to adopt what I have christened a “patents approach” or a “copyright approach” to design protection. By a “patents approach” I mean a system like the patents system wherein the criterion for protection is that the design must be new: if it closely resembles a design which has already been made public, it is not protected; but if it is protected, the proprietor can stop anyone else marketing articles bearing that design, without having to prove that they were copied from him. On the other hand, under a “copyright approach” the criterion for protection is that the design must be original — the designer’s own work and not something he has copied; even if virtually identical with someone else’s earlier design, he can claim protection if he can satisfy the Court that he did not copy, directly or indirectly, from that earlier design; but, as a corollary, his protection is only against copying, directly or indirectly, from him. In other words he will not succeed against a defendant who satisfies the Court that the allegedly infringing design was original and not copied. The United Kingdom, like most of Continental Europe, now adopts both these approaches simultaneously, though taking the copyright approach further than most. A review of the recent history of design protection is necessary to explain why.

Between 1883 and 1949, design protection was given by successive combined Patents and Designs Acts. In 1949, designs and patents were each given Acts to themselves. The Registered Designs Act 1949, which is still law, protects “features of shape, configuration, pattern or ornament”

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applied to any article.¹ Protection, which depends on registration at the Patent Office, lasts for a maximum of 15 years (3 renewable 5-year periods). Since that Act speaks of "the copyright in the design"² you would be forgiven for thinking that it adopts the copyright approach; but you would be wrong. The case law makes it abundantly clear that the criterion for protection is novelty rather than originality, and that the owner of a valid registration enjoys, like the patentee, a monopoly: he can prevent someone else making or marketing articles, within his registration, bearing the same or a similar design, whether or not there was any copying. The test is simply whether the second design is "not substantially different" from that registered, in which case it infringes. It may be that the Judge, being only human, is more likely to find the resemblance too close when he thinks the defendant copied than when he believes the defendant's design to be original. But in theory, if not in practice, copying is immaterial.

Under this system, application for protection must be made before the goods are placed on the market. A search is made at the Patent Office through previous registrations, trade periodicals etc., to find out whether the design, or a design closely resembling it, has already been published. Only prior publication in the United Kingdom is a bar to registration.³ In other words, the system looks for "local", rather than "absolute" novelty.

So much for the main features of the registration system. But, like all other countries, the United Kingdom has had to face the problem of the artistic work protected by copyright, which subsequently is applied to mass-produced articles of commerce, and marketed. I should say straight away that the main point of difference between us and the countries of Continental Europe is that our Judges and legislators have, with one exception, traditionally been unwilling to apply the test implicit in the wording of the Berne Convention and in that of many laws — namely — is the article in question a "work of applied art": is it "artistic" as distinct from merely utilitarian? I know this test is one which, in Germany and other European countries, Judges are called on to apply. But it is one which seems, to me at least, far from easy. I can readily accept that a carpet, or curtains, or a tea tray, on which is reproduced a picture by Picasso is a work of applied art and that this is true whether or not I happen to like Picasso's picture. I can also readily see that the crankshaft of a motor car engine is not. But in between lies a vast range of articles — jewellery, furniture, household utensils, cutlery and crockery — where

¹ See Registered Designs Act 1949, Sec. 1(3).

² See Registered Designs Act 1949, Sec. 7(1).

³ See Registered Designs Act 1949, Sec. 1(2).

the designer has been influenced both by functional and aesthetic considerations, under which the choice is extremely difficult to make. The designer hopes the public will buy his article because they feel it is suited to the purpose to which it is to be put, and he designs accordingly. Most design Associations would say that the more fit for its purpose an article appears, the better the design aesthetically. Conversely, the addition of non-functional excrescences makes for bad aesthetic designs. So, clearly, when deciding whether or not something is a work of applied art, one cannot have regard only to non-functional features.

The problem which I mentioned earlier of the borderline between what is properly protected by the copyright law and what must seek its protection, if any, under the law of design registration was, under the United Kingdom's 1911 Copyright Act, solved, by looking to the intention of the artist. That Act provided that its protection should not apply to "designs capable of being registered, except designs which are not used or intended to be used as models or patterns to be multiplied by any industrial process".⁴ The registered designs legislation laid down a list of articles "primarily literary or artistic in character" — wall plaques, medals, greeting cards, book jackets, maps, etc., whose designs were incapable of registration⁵ and these designs therefore automatically enjoyed copyright protection. A design was "multiplied by an industrial process" if it was applied to 50 single articles or to carpets or textile piece goods.⁶ The test therefore, for the designs of the vast majority of mass-produced goods, was the intention of the designer. In a case decided in 1941⁷ about a drawing originally intended merely as a cartoon figure ("Popeye the Sailor Man") from which the copyright owner subsequently made dolls and brooches, the House of Lords decided that it was the original intention of the artist at the time of first making his drawing which prevailed, whatever he subsequently did with it, and the dolls and brooches were therefore protected by the copyright law.

Both the Patents and Designs Committee of 1947⁸ and the Copyright Committee of 1952⁹ felt that this was unsatisfactory. Both felt that the possibility of double protection under two Acts simultaneously was undesirable. And the Copyright Committee felt that the artist's original drawing should enjoy copyright protection even if the mass-produced articles

⁴ Copyright Act, 1911, Sec. 22.

⁵ See now the Rule 26 of the Designs Rules 1949 S.I. No. 2368.

⁶ See now the Copyright (Industrial Designs) Rules 1949 S.I. No. 2367.

⁷ *King Features Syndicate v. Kleeman*, 58 R.P.C.P. 207.

⁸ Final Report, Cmnd 7206, Paragraphs 311-312.

⁹ Report, Cmnd 8662, Paragraphs 237-238.

made from it did not. The 1956 Copyright Act therefore changed the law. Under that Act, copyright subsists in all artistic works defined as:

- (a) the following, irrespective of artistic quality, namely paintings, sculptures, drawings, engravings and photographs;
- (b) works of architecture, being either buildings or models for buildings;
- (c) works of artistic craftsmanship, not falling within either of the preceding paragraphs.¹⁰

It is an infringement to reproduce the work either in 2 or 3 dimensions providing the 3 dimensional article is recognisable by a non-expert to be a reproduction of the original.¹¹ But Section 10 of that Act provided that if the copyright owner applied the work industrially — *i.e.* to textiles or to more than 50 single articles — and sold them, he immediately lost his copyright protection in *respect of these articles*; the protection available to him, if any, for them, was by registration under the Registered Designs Act.¹² After 15 years he lost protection over the whole industrial field. An exception continued to be made for the “literary or artistic articles” — book jackets, greeting cards etc. — which I have already mentioned.¹³

In 1959 a Committee was appointed to examine the whole question of the protection of industrial designs. Its report in 1962¹⁴ recommended retention of the existing “patents approach”, registration, system with a number of modifications, and the introduction of a “copyright approach” system, also depending on registration at the Patent Office, protection being available for the same article under both systems simultaneously. The acceptance of simultaneous design and copyright protection was a big step towards the systems operating in Continental Europe.

Though some preliminary drafting work was done on the Bill to implement this Report, it had difficulty in finding a place in the Parliamentary timetable. It would have meant a highly technical bill of some 30 clauses and Ministers had other things on their minds. In 1968 a Private Member of Parliament, with some Government help, introduced what was virtually a one clause Bill, the effect of which was to amend Section 10 of the Copyright Act 1956 so as to postpone the loss of copyright in mass-produced articles for 15 years from the date on which the articles were first marketed. Somewhat to my surprise the Bill went

¹⁰ See the 1956 Copyright Act, Sec. 3(1).

¹¹ See the 1956 Copyright Act, Sec. 9(8).

¹² See the Copyright Act 1958, Sec 10(1-3).

¹³ See the Copyright Act 1958, Sec. 10(4).

¹⁴ Cmnd 1808.

through without opposition, and is now the Design Copyright Act 1968. All original artistic works are therefore now protected, even when mass-produced, against copying, for 15 years, under the copyright law, and this protection is given to all Berne and Universal Copyright Convention nationals as well as to Britons.

This Act, though carrying out in broad terms the principal recommendation of the Designs Committee, namely a 15 year period of copyright protection running in addition to any protection sought under the Registered Designs Act, has given our design copyright law a number of rough edges. Since, in the normal case, no test of artistic merit or artistry is provided, it goes deep into the industrial field. Though a number of trade associations and the main professional bodies were consulted when the 1968 Bill was before Parliament, it took British industry a year or two to appreciate the weapon they had in their hands against copiers. Since then it has been held to protect such things as the shape of an electrical ammeter¹⁵ and that of spare parts for weaving machines.¹⁶

Two of the more controversial features of the law are that:

1. In the copyright law there is no provision for compulsory licenses, *e.g.* to supply spare parts even where the original manufacturer himself fails to do so.
2. Unlike the Registered Designs Act 1949¹⁷ no exception from protection is made in respect of "features of shape or configuration which are dictated solely by the function which the article to be made in that shape or configuration has to perform". Since the scope of this exception was, until recently, thought to be very narrow indeed — the only example anyone could think of was the shape of a key to fit a particular lock — its omission from design copyright scarcely seemed to matter. But in 1972 the House of Lords, in refusing protection under the Registered Designs Act to the shape of certain electric terminals, gave a wider construction to the exception, suggesting that if the designer was influenced by practical rather than aesthetic considerations, protection is denied.¹⁸ If, as a result of this decision, the registration system is held to deny validity to a number of "functional" designs, it is clearly arguable that they should also be deprived of copyright protection. I say "arguable" rather than axiomatic because, as I have said, unlike the

¹⁵ *Sifam Electrical v. Sangamo Weston*, June 1971, FSR, p. 337.

¹⁶ *British Northrop v. Texbeam Blackburn*, May 1973, FSR, p. 261.

¹⁷ See the Registered Designs Act 1949 Sec. 1(3).

¹⁸ *Amp v. Utilux*, 1972, R.P.C. p. 103.

registration system, design copyright protects only against copying. If the plaintiff's design was dictated solely by the function the article was to perform, so must the defendant's design have been. In other words, the defendant would automatically arrive at the shape in question without copying. Without direct evidence (which is rare) the plaintiff would have great difficulty in satisfying a court that there was infringement.

Another criticism of the present design copyright system is that the remedies provided by the Copyright Act include both damages and the delivery up to the plaintiff of all infringing copies, plus the value of infringing copies already sold.¹⁹ This is very harsh on an unsuccessful defendant. It is argued that these remedies, though they may be appropriate for books, records etc., are too severe in the industrial design field.

What is protected, under both approaches, is of course, only the actual shape or pattern in question and not the idea behind it and this is stressed in a, so far, unreported case in December 1972, in which Whitford J., in an action concerning a shirt and special collar to be worn by Ministers of Religion, held that what had been indirectly copied was not the plaintiff's drawings but the constructional idea behind them.²⁰

The basic questions are: should there be an area of design, functional or mechanical, in which copying of the features of shape or pattern is freely permitted; and if so how to define it. United Kingdom opinion seems divided on this, one school of thought feeling it intolerable that copyright should stretch to such things as machine tools and parts of machines, and another saying: why should anyone be allowed, even in the functional mechanical field, to save himself the cost of employing designers by cashing in on someone else's design expenditure?

The main indisputable advantage of the Design Copyright Act is that, by affording the reciprocity required by the Berne Copyright Convention, it enables British exporters to claim such protection against copying as is afforded by copyright law in those Berne Convention countries, particularly in Europe, which protect works of applied art; and most importantly, that this protection is available without any formality such as registration. It is, in my view, unrealistic to expect manufacturers to register their designs in all the countries to which they may conceivably export. Unless and until there is a European Convention on designs this is clearly of prime importance within the Common Market.

¹⁹ See the Copyright Act 1956, Sec. 18.

²⁰ *Gleeson v. Denne*.

I mentioned earlier one exception to the proposition that British Judges do not normally consider the artistic merits of designs. This was in a recent case involving the copying of the design for a chair. I quoted earlier Section 3(1) of the Copyright Act which includes, in the definition of artistic works, "works of artistic craftsmanship". If the Plaintiff, in that case, had been able to produce his working drawings, the question of artistic quality would not have arisen. But apparently he could not. He therefore sought to found his protection on the original prototype for the chairs he made and marketed, as a work of artistic craftsmanship.

The trial Judge, Graham J., found in his favour, but this was reversed in the Court of Appeal and the final decision was left to the House of Lords.²¹ The five Judges there all agreed that the prototype was not a work of artistic craftsmanship, but on little else. Some appeared influenced by the fact that protection would have been available under the registration system but was not sought; others by the fact that the admittedly original design did not appeal aesthetically to a number of the expert witnesses. The last Judge to give his opinion said: "Your Lordships House has been offered 'definitions' of the word 'artistic' framed by each of Graham J., the Court of Appeal, counsel for the Appellant, together with two by counsel for the Respondent, and has rejected them all. In addition I rather gather that there is no definition framed by a member of this Appellate Committee which is altogether acceptable to any other member; this means that each of their Lordships has rejected, or at least refrained from adopting, nine solutions to the problem". The case does nothing to alter my view as to the difficulties involved.

One of the tasks of the Committee recently appointed to look into our law of copyright, under the Chairmanship of Mr. Justice Whitford, will be to hear evidence and make recommendations over the whole field of protection for designs. As a member of that Committee I look forward to some interesting discussions.

²¹ See "The Times" Law Report of May 2, 1974.

323. COMMON ERRORS AS EVIDENCE OF COPYING

By JOHN A. TAYLOR*

The law of common errors in copyright can be stated very succinctly: the appearance of errors common to a copyrighted work and an accused work is the strongest evidence of copying.¹ Nevertheless, a defendant can escape the stigma of common errors by proving copying from a common source.² Beyond that, not much has been written on the subject. There are no articles in legal periodicals; the subject is given only general treatment in Weil (1917),³ Amdur (1936),⁴ Ball (1944),⁵ Wittenberg (1957),⁶ and Nimmer (1963).⁷ It is the purpose of this paper to examine the United States cases on the subject to see if anything more can be learned and, more importantly, to satisfy a student's curiosity as to what kinds of common errors have arisen. Perhaps a formula can be derived for planting errors to trap copyists; perhaps an excuse can be derived for not proofreading one's work.

The job, at first, seemed easy enough. There could not be more than fifteen cases that discussed common errors. Each digest, however, led to a new batch of cases, and many of the cases led to further cases. In the end I turned up fifty-two cases; these are listed in a table at the end of the paper, and they comprise the universe for the purposes of this discussion.⁷ The cases are numbered from one to fifty-two and for convenience will be referred to by number instead of by name. Footnotes to the facts of the cases will be omitted when it is obvious that the facts are from a given case.

The first question that arises is a general one: which courts have decided these cases? A complete breakdown is given in Table I as follows:

* Mr. Taylor is a member of the New York Bar and a registered patent attorney, having received a J.D. from Columbia University Law School and an LL.M from New York University School of Law.

¹ NIMMER, NIMMER ON COPYRIGHT §143.3 (1963)

² *Id.*

³ WEIL, AMERICAN COPYRIGHT LAW 460-63 (1917).

⁴ AMDUR, COPYRIGHT LAW AND PRACTICE 665-69 (1936).

⁵ BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 310, 608-16 (1944).

⁶ WITTENBERG, THE LAW OF LITERARY PROPERTY 139-41 (1957).

⁷ In Cases 20, 23, 30, 41 and 49, lower courts also discussed the common errors, but only the upper court cases are included in the table.

Table 1

	Number of Cases
Supreme Court	1
Courts of Appeals	
2nd Circuit	9
Other	8
Circuit Courts (old)	
S.D.N.Y.	2
Other	10
District Courts	
S.D.N.Y.	12
Other	8
N.Y. Supreme Court	2
	52

The cases range from Case 7, decided by the United States Supreme Court, to Cases 37 and 47, decided by the Supreme Court of New York. All of the cases are federal cases arising under the federal copyright laws except for the two New York Supreme Court cases which were based on common law copyright. The years in which the cases were decided range from Case 48, decided in 1847, to Case 38, decided last year. The law of common errors in copyright has a long and diverse history.

Having accomplished a little in the way of knowledge and a lot in the way of classification, it is now time to turn to the second question, which is also one of classification. In which classes of copyrightable works have the common errors arisen? A complete breakdown is provided in Table 2 as follows:

Table 2

		Number of Cases	
Class A—Books		43	82.7%
Books	11*		
Compilations	8		
Directories	17*		
Catalogs	7		
Class B—Periodicals		1	1.9
Class E—Music		1	1.9
Class F—Maps		5	9.6
Class G—Works of Art		2	3.9
		52	100%

* Includes one N.Y. common law case.

As can be seen from the table, the vast majority of the cases have arisen in Class A—Books. The forty-three cases in Class A fall neatly into four subclasses—books, compilations, directories, and catalogs. Class F—Maps is the only other class with any significant number of cases. The class or subclass for each case is included in the Table of Cases.

The cases in the various classes and subclasses are as interesting as they are varied. In order to illustrate the variety of the common errors that have arisen, at this point I cannot resist reciting a few of the cases.

In Case 4 (books), the defendant, Matthew Bender, among other things copied the following purpose for the Interstate Commerce Act from the plaintiff's book—"To preserve legitimate competition between public carriers, and to prevent that competition which is illegitimate, that is, competition which is *not* contrary to the public interest . . ." [emphasis added]. Surely, the copier could not even have been thinking while he copied. One of the advantages of requiring authors to consult original sources is to prevent perpetuation of such errors. As might be expected, the preliminary injunction against the defendant's book was continued.

In Case 29 (compilations), Ford Frick, then a sports writer-radio announcer, later Commissioner of Baseball, compiled a booklet of sports records for the Richfield Oil Corporation. The only trouble was, among other things, he followed the plaintiff in crediting Theseus, son of Argus, King of Athens, as the originator of boxing. Theseus's father was Aegeus, King of Athens. Small slips like that resulted in a preliminary injunction against Ford Frick's booklet.

In Case 45 (directories), among the two hundred seventy common errors in their contractors directory, the defendants listed a musician as a plastering contractor. There might be more money in contracting than in music, but not for these defendants. The plaintiff obtained summary judgment.

In Case 28 (catalogs), the defendant, like the plaintiff, identified one of his easels with the model number LE-2. The only trouble was that neither had an LE-1. It would not have taken a Sherlock Holmes to figure that one out. The preliminary injunction was affirmed.

In Case 31 (periodicals), the defendants traced common errors in their monthly magazine on air travel to common sources. The plaintiff's complaint was dismissed.

In Case 11 (music), among other things, the defendant, like the plaintiff, failed to carry over a slur mark indicating that a group of notes is to be sung as a single syllable. The plaintiff obtained a preliminary injunction.

In Case 14 (maps), among other things, the defendants, like the plaintiff, located the Walkill River in New York State on the wrong side of the road. Picture the argument that must have been enacted over and

over again as the occupants of a car with the map before them tried to reconcile what they *knew* to be the right direction with the fact that the old Walkill was to their left instead of to their right or vice versa. I am happy to report that the plaintiff won, thus exterminating one source of the error. They should have both been enjoined.

In Case 19 (works of art), the plaintiff sold a doll called "G I Joe." Subsequently, the defendants came out with a similar doll called "Fighting Yank." "Fighting Yank" was manufactured in Hong Kong with the same misplaced right thumbnail as "G I Joe." The plaintiff obtained a preliminary injunction, although the common error did not play a large part in it.

In Case 39 (also works of art), the defendants copied the plaintiffs' doll, "Zippy," which was based on a chimpanzee that appeared in the Howdy Doody television show. Apparently the defendants were not very sophisticated, for they not only copied the plaintiffs' mold number, but they even copied the plaintiffs' copyright notice! The case was remanded for a preliminary injunction.

I could go on and on reciting cases. The foregoing examples, however, cover a good range of classes and are good examples of the kinds of common errors that could arise in other classes.

Having thoroughly classified the cases and given an example from each class and subclass in which cases appear, it is now appropriate to consider a third question. How did the errors arise in the first place? The short answer is unintentionally, intentionally, or from a common source. The cases that discuss a common source are easy enough to identify, but it is hard to determine from the cases whether a misspelled word, for example, is unintentional or intentional. It is so hard, in fact, that the only errors that I can positively identify as being unintentional are those that are labeled typographical errors, and the only errors that I can positively identify as being intentional are those that are labeled trap, catch, nonexistent, or fictitious. There can even be arguments about those. A typographical error could be an intentional trap; a nonexistent or fictitious fact could be an unintentional mistake. Nevertheless, I feel confident of the data in the following tables:

Table 3

	Number of Cases
Common source errors	4
Typographical errors	4
Traps	8

Table 3A

Trap Cases	Winner	Year	Class
Case 2	P	1925	directory
Case 18	P	1906	directory
Case 25	D	1967	directory
Case 26	P	1887	directory
Case 30	P	1921	catalog
Case 35	D	1952	directory
Case 37	P	1950	directory
Case 46	P	1903	directory

The common source cases are Cases 15, 16, 31, and 47. In each instance the defendant successfully proved that the errors in common with the plaintiff's work resulted from copying from a common source. Therefore, the defendant escaped liability.

The typographical error cases are Cases 13, 22, 24, and 26. The plaintiff prevailed in each instance. In Case 22, the copying of typographical errors from an investment directory was the principal reason for the plaintiff's victory.

The trap cases are listed in Table 3A. It is interesting and instructive to examine some of the cases in detail to see just what kinds of traps have been used and with what result.

In Case 2 the plaintiff listed five nonexistent hotels in its hotel directory. In addition, the plaintiff estimated from a picture of a hotel that had not yet been built that the hotel had three hundred twelve rooms. The defendant copied it all, and it was decisive in the plaintiff's victory. My sympathies, however, are with the weary traveler who late at night tries to locate one of the trap hotels.

In Case 25, among other things, the defendant copied five out of one hundred trap towns in the plaintiff's shipping rate directory. The judgment for the defendant was affirmed. Apparently, the defendant escaped liability because the trap towns accounted for only five out of some ninety thousand entries in his shipping rate directory.

In Case 30, the plaintiffs included twelve fictitious models in their piston ring catalog. The defendant copied ten of them from a catalog that had admittedly been copied from the plaintiff's catalog. The decree for the plaintiffs was affirmed.

In Case 35, the plaintiff listed ten fictitious people and four fictitious streets in its city directory for Lebanon, Pennsylvania. The defendants copied them all. Nevertheless, the court held that there was no substantial copying. The fourteen fictitious entries were among over forty-seven thousand persons and streets in the defendants' directory.

In Case 37, among other things, the plaintiff included fictitious information as to conveyances in its real estate directory. The defendant copied the fictitious information and was permanently enjoined.

If anything can be learned from the trap cases, it is that the inclusion of traps is no guarantee of victory for the plaintiff even if the defendant copies all of them. Although the defendant was the winner in only two out of the eight trap cases, they were the two most recent cases. All of the trap cases involved directories except Case 30 which involved catalogs.

After classifying the cases and illustrating what kinds of errors arise, a fourth question comes to mind. Can the common errors be quantified? Unfortunately, very few of the cases provide enough data. Only eight out of the fifty-two cases provide enough data to make calculations for at least one of the parties. The results are tabulated in Table 4 as follows:

Table 4

	Common Errors	P's total entries	D's total entries	P's %	D's %	Winner	Year
Case 1	21	1,400	?	1.5	-	P	1942
Case 8	67	?	60,000	-	0.1	P	1895
Case 9	73	2,365	2,401	3.1	3.0	P	1941
Case 25	5	?	90,000	-	0.006	D	1967
Case 26	39	6,000	3,500	0.7	1.1	P	1887
Case 35	14	?	47,000	-	0.03	D	1952
Case 40	13	114	114	11.4	11.4	P	1941
Case 45	270	7,910	7,890	3.4	3.4	P	1946

From the table, one main conclusion can be drawn. When the number of common errors is small and the percentage of the total entries that are common errors is less than one-tenth of one percent, the defendant has a very good chance of winning. The defendant won in Cases 25 and 35 even though they were trap cases. They are also the most recent cases on the list. The only other trap case on the list is Case 26. It and the only other case with a very small percent, Case 8, are the oldest cases on the list, having been decided at the end of the nineteenth century. All of the cases involved directories, except Case 9, which involved books on French vocabulary.

While going through the cases, it occurred to me that a fifth and final question could be answered. What effect did the existence of common errors have on the decision in the copyright infringement portion of the case? I found that the answers, even though based on my subjective analysis, fell neatly into a five-tier grading system. I gave an *A* to those cases in which the existence of common errors in the defendant's work was the only reason given for the plaintiff's victory. I gave a *B* when common errors *greatly* helped the plaintiff, a *C* when they just helped the plaintiff, and a *D* when they had no effect in helping the plaintiff. No case

was found in which the existence of common errors hurt the plaintiff. I have an *E* to all of the cases that the defendant won no matter how much the common errors were discussed, on the theory that the common errors could not have helped the plaintiff since he lost. I did not mean to parallel the academic grading system, and in fact I originally had only four tiers, *A* to *D*. Since all of the cases that the defendant won fell into grade *D*, I found it useful to separate them out into a fifth grade, grade *E*. I resisted the temptation to grade them *F* in order to maintain an original grading system and to leave no gaps. I did not want people to wonder what happened to grade *E*. Using the foregoing grading system, the cases are distributed in Table 5 as follows:

Table 5

Grade	Number of Cases	
A (decisive)	9	17.3
B (greatly helped)	13	25.0
C (helped)	15	28.8
D (no help)	4	7.7
E (D won)	11	21.2
	52	100.0%

I have included the grade given to each case in the Table of Cases. As can be seen from Table 5, the existence of common errors helped the plaintiff in most of the cases that the plaintiff won. Of the five cases that the plaintiff won without help from the common errors, two of them, Cases 27 and 50, were won only on appeal. The common errors were not discussed by the appellate court. Notwithstanding the existence of common errors, the defendant won one out of every five cases. As mentioned before, in four of the eleven cases that the defendant won, the defendant proved that the common errors came from a common source. In order to illustrate the range of my grading system, I will discuss three cases—one from grade *A*, two from grade *E*.

In Case 16 the defendants, like the plaintiff, located the city of Great Falls, Montana, on the wrong side of the Missouri River on their inflatable globe map and the city of Suez on the wrong side of the canal. Nevertheless, this is not the grade *A* case. I gave it a grade of *E* because the defendants won. They proved copying from a common source.

Case 41 is the grade *A* case. In Case 41 the plaintiff proved one hundred thirty-eight common errors including thirteen citations that never existed. The plaintiff was the publisher of *Shepard's Citations*, which

made me wonder as I Shepardized my fifty-two cases. Although sixty-five of the common errors appeared in works that the plaintiff had neglected to copyright, proof of twenty-nine common errors was sufficient to win.

In Case 21, the National Broadcasting Company sought to do a television show on the life of Ira Hayes, an American Indian who participated in one of the greatest moments in American history—the flag raising on Mount Suribachi, Iwo Jima, during the Second World War. Unfortunately, the show copied some fictional incidents from the plaintiff's book. Indeed, the flag raising itself was a staged event for a photographer. Nevertheless, a preliminary injunction was denied. The plaintiff was estopped from maintaining that his fictional incidents were not historical facts.

Although I had to go through many more cases than I had expected, I found the research for this paper very rewarding. It satisfied my curiosity, the cases were very interesting, and I was able to come to some original conclusions. In order to limit my research to manageable proportions, I restricted it to common errors that are truly errors. Wittenberg, in his 1957 book, includes the copying of names of fictional characters under common errors.⁸ I omitted fictional characters because if you are willing to go that far you could go all the way and include all fiction. It can be argued that copying anything that is fiction or art is a common error. Since historical facts are not copyrightable, common errors would then include virtually everything, and there would be a merger of the law of common errors with the law of substantial similarity. I found no case in which the copying of the name of a fictional character was labeled a common error. If further research is desired, however, someone could give the law of substantial similarity the same treatment that I have given the law of common errors. The cases could be classified by courts and by classes of copyrightable works. Types of copying could be identified, and where possible, percentages of the amount lifted could be calculated. Finally, each case could be graded as to the effect of the copying on the decision. But, that is for another paper and another day.

⁸ NIMMER, NIMMER ON COPYRIGHT §143.3 (1963).

⁹ WITTENBERG, THE LAW OF LITERARY PROPERTY 139-41 (1957).

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2. *American Travel and Hotel Directory Co. v. Gehring Publishing Co.*, 20 Cr. Dec. 8 (S.D.N.Y. 1925) [directory] [A]
3. *Anderson Co. v. Baldwin Law Publishing Co.*, 20 Cr. Dec. 12 (6th Cir. 1928) [compilation] [B] *
4. *Bisel Co. v. Bender*, 190 F. 205 (Cir. Ct. N.D.N.Y. 1911) [book] [B]
5. *Bisel Co. v. Welsh*, 131 F. 564 (Cir. Ct. E.D. Pa. 1904) [compilation] [A] *
6. *Burndy Engineering Co. v. Penn-Union Electric Corp.*, 39 U.S.P.Q. 321 (W.D. Pa. 1938) [catalog] [C] *
7. *Callaghan v. Myers*, 128 U.S. 617 (Sup. Ct. 1888) [compilation] [C]
8. *Chicago Dollar Directory Co. v. Chicago Directory Co.*, 66 F. 977 (7th Cir. 1895) [directory] [B]
9. *College Entrance Book Co. v. Amsco Book Co.*, 24 Cr. Dec. 150 (2nd Cir. 1941) [book] [B]
10. *Colonial Book Co. v. Amsco School Publications*, 24 Cr. Dec. 155 (S.D.N.Y. 1941) [book] [B] *
11. *Consolidated Music Publishers v. Ashley Publications*, 33 Cr. Dec. 113 (S.D.N.Y. 1961) [music] [C]
12. *Crocker v. General Drafting Co.*, 58 U.S.P.Q. 60 (S.D.N.Y. 1943) [map] [C] *
13. *Donnelley & Sons v. Haber*, 24 Cr. Dec. 219 (E.D.N.Y. 1942) [catalog] [C]
14. *General Drafting Co. v. Andrews*, 20 Cr. Dec. 263 (2d Cir. 1930) [map] [B]
15. *Hammond & Co. v. International College Globe*, 30 Cr. Dec. 331 (S.D.N.Y. 1956) [map] [E]
16. *Hammond & Co. v. International Globe*, 135 U.S.P.Q. 56 (S.D.N.Y. 1962) [map] [E]
17. *Hartfield v. Peterson*, 21 Cr. Dec. 154 (2d Cir. 1937) [compilation] [C] *
18. *Hartford Printing Co. v. Hartford Directory & Publishing Co.*, 146 F. 332 (Cir. Ct. D. Conn. 1906) [directory] [A]
19. *Hassenfeld Bros. v. Mego Corp.*, 150 U.S.P.Q. 786 (S.D.N.Y. 1966) [work of art] [C]
20. *Hayden v. Chalfant Press*, 32 Cr. Dec. 202 (9th Cir. 1960) [map] [E] *
21. *Huie v. National Broadcasting Co.*, 125 U.S.P.Q. 226 (S.D.N.Y. 1960) [book] [E]
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24. *Lawrence v. Dana*, F.Cas. No. 8, 136 (Cir. Ct. D. Mass 1869) [book] [C]
25. *Leonard & Co. v. Stack*, 386 F. 2d 38 (7th Cir. 1967) [directory] [E]

26. List Publishing Co. v. Keller, 30 F. 772 (Cir. Ct. S.D.N.Y. 1887) [directory] [A]
27. Markham v. Borden Co., 108 F. Supp. 695 (D. Mass. 1952), *reversed*, 206 F. 2d 199 (1st Cir. 1953) [catalog] [D]
28. Meier Co. v. Albany Novelty Manufacturing Co., 236 F. 2d 144 (2d Cir. 1956) [catalog] [C]
29. Menke v. Richfield Oil Corp., 20 Cr. Dec. 442 (S.D.N.Y. 1932) [compilation] [B]
30. No-Leak-O Piston Ring Co. v. Norris, 19 Cr. Dec. 301 (4th Cir. 1921) [catalog] [C]
31. Official Aviation Guide Co. v. American Aviation Associates, 150 F. 2d 173 (7th Cir. 1945) [periodical] [E]
32. Orgel v. Clark Boardman Co., 128 U.S.P.Q. 520 (S.D.N.Y. 1960) [book] [C] *
33. Oxford Book Co. v. College Entrance Book Co., 39 U.S.P.Q. 7 (2d Cir. 1938) [book] [D] *
34. Pic Design Corp. v. Sterling Precision Corp., 231 F. Supp. 106 (S.D.N.Y. 1964) [catalog] [C] *
35. Polk & Co. v. Musser, 28 Cr. Dec. 399 (E.D. Pa. 1952) [directory] [E]
36. Produce Reporter Co. v. Fruit Produce Rating Co., 20 Cr. Dec. 575 (N.D. Ill. 1924) [directory] [B] *
37. Real Estate Register v. Baird, 27 Cr. Dec. 385 (N.Y. Supr. Ct. 1950) [directory] [A]
38. Rexnord, Inc. v. Modern Handling Systems, 183 U.S.P.Q. 413 (D. Del. 1974) [catalog] [B]
39. Rushton v. Vitale, 218 F. 2d 434 (2nd Cir. 1955) [work of art] [B]
40. Sammons v. Larkin, 38 F. Supp. 649 (D. Mass. 1941) [directory] [B]
41. Shepard Co. v. Taylor Publishing Co., 193 F. 991 (2nd Cir. 1912) [compilation] [A]
42. Simms v. Stanton, 75 F. 6 (Cir. Ct. N.D. Cal. 1896) [book] [E] *
43. Social Register Ass'n v. Murphy, 128 F. 116 (Cir. Ct. D.R.I. 1904) [directory] [C] *
44. Southwestern Bell Telephone Co. v. Nationwide Independent Directory Service, 182 U.S.P.Q. 193 (W.D. Ark. 1974) [directory] [C] *
45. Sub-Contractors Register v. McGovern's Contractors and Builders Manual, 25 Cr. Dec. 399 (S.D.N.Y. 1946) [directory] [B]
46. Trow Directory Printing & Bookbinding Co. v. United States Directory Co., 122 F. 191 (Cir. Ct. S.D.N.Y. 1903) [directory] [A]
47. Turner v. Century House Publishing Co., 159 U.S.P.Q. 699 (N.Y. Sup. Ct. 1968) [book] [E]
48. Webb v. Powers, F.Cas. No. 17,323 (Cir. Ct. D. Mass. 1847) [book] [E]
49. West Publishing Co. v. Lawyers' Co-operative Publishing Co., 79 F. 756 (2d Cir. 1897) [compilation] [C] *

50. West Publishing Co. v. Thompson Co., 169 F. 833 (Cir. Ct. E.D.N.Y. 1909),
modified, 176 F. 833 (2d Cir. 1910) [compilation] [D]
 51. White v. Bender, 185 F. 921 (Cir. Ct. N.D.N.Y. 1911) [book] [E] *
 52. Williams v. Smythe, 110 F. 961 (Cir. Ct. M.D. Pa. 1901) [directory] [A] *
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* Not cited, but incorporated in the data

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. United States of America and Territories

324. U.S. CONGRESS. HOUSE.

H.R. 4965. A bill for the amendment of the Copyright Law, title 17 of the United States. Introduced by Mr. Won Pat, March 14, 1975, and referred to the Committee on the Judiciary. 4 p. (94th Cong., 1st Sess.)

A bill, which would, in effect, insure that cable systems in most non-contiguous areas are not treated differently under the U.S. copyright law from those located within the boundary of the 48 contiguous States. *See* remarks of Mr. Won Pat on the proposed introduction of this legislation in 121 CONG. REC. E1127 (daily ed. Mar. 13, 1975). *See also* 22 BULL. CR. SOC. 280, Item 247.

325. U.S. CONGRESS. HOUSE.

H.R. 5345. A bill to amend the Copyright Act of 1909, and for other purposes. Introduced by Mr. Danielson, March 21, 1975, and referred to the Committee on the Judiciary. 7 p. (94th Cong., 1st Sess.)

A companion bill to S. 1111, the "Performance Rights Amendment of 1975." *See* 22 BULL. CR. SOC. 281, Item 250.

326. U.S. CONGRESS. HOUSE.

H.R. 6057. 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 (for himself, Mr. Thompson, Mr. Koch, and Mr. Bell), April 16, 1975, and referred to the Committee on Ways and Means. 3 p. (94th Cong., 1st Sess.)

A companion bill to S. 1435. *See* Item 325, *infra*.

327. U.S. CONGRESS. HOUSE.

H.R. 6829. 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 composition, or similar property. Introduced by Mr. Koch (for himself, Mr. Beard of Rhode Island, Mr. Phillip Burton, Mr. Eilberg, Mr. Harrington,

Mr. Ottinger, Mr. Rees, Mr. Rosenthal, Mr. Scheuer, Ms. Spellman, Mr. Gilman, and Mr. Mikva), May 8, 1975, and referred to the Committee on Ways and Means. 2 p. (94th Cong., 1st Sess.)

A proposal to permit deductions from taxable income of the full market value, not reduced by the amount of appreciation, of contributions to public institutions of cultural property mentioned in the bill. The bill is identical to H.R. 697, introduced by Mr. Koch in the 93d Congress, and to H.R. 9103 and H.R. 15215, and similar to H.R. 9505, all introduced in the 92d Congress.

328. U.S. CONGRESS. HOUSE. *Jacobs, Andrew, Jr.*

Cable television. *Congressional Record*, vol. 121, no. 61 (daily ed. Apr. 21, 1975), pp. E1878-E1879.

In an extension of his remarks, Representative Andrew Jacobs causes to be inserted into the *Record* an exchange of correspondence between him and Mr. James F. Ackerman, Executive Director, Becker Communications Associates, Indianapolis. Mr. Ackerman calls attention to "the fact that cable television, an infant industry of much promise, is being crucified by its competitors, and that the FCC, a federal agency created by Congress, has been an active and knowing accomplice to this crime."

329. U.S. CONGRESS. SENATE.

S. 1435. 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 15, 1975, and referred to the Committee on Finance. 3 p. (94th Cong., 1st Sess.)

Identical to S. 1510 (*See* 20 BULL. CR. SOC. 343, Item 269 (1973)), also introduced by Mr. Javits during the 93d Congress and intended "to correct certain inequities created by the Tax Reform Act of 1969 which disallowed tax deductions for the market value of charitable contributions of art works by the original artist." — *See* statement of Mr. Javits on his introduction of the bill in 121 CONG. REC. S5939 (daily ed. Apr. 15, 1975), which includes a study made as to what has been lost in important manuscripts by the Library of Congress, because of the 1969 Act or at least attributable to the law, and also several similar reports from other research libraries.

330. U.S. CONGRESS. SENATE. *Committee on the Judiciary. Subcommittee on Patents, Trademarks, and Copyrights.*

Patents, trademarks, and copyrights. Report made pursuant to S. Res. 255, Ninety-third Congress, second session. Submitted by Mr. McClellan, April 22, 1975. Washington, U.S. Govt. Print. Off., 1975. 21 p. (94th Cong., 1st Sess., S. Rep. No. 94-92)

The annual report on the legislative activities of the subcommittee, covering the second session of the 93d Congress. Included in the report is a brief summary of the major provisions of the general revision bill, S. 1361 and the "copyright miscellany" bill, S. 3976, both passed by the Senate during the second session. The passage of S. 1361 is described as "an historical event" in the field of copyright revision legislation.

331. U.S. CONGRESS. SENATE. *Baker, Howard H., Jr.*

Musicians support performace royalty bill, S. 1111. CONG. REC., vol. 121, no. 68 (daily ed. Apr. 30, 1975), pp. S7127-S7129.

Senator Baker receives unanimous consent to have printed in the *Record* an article by Hal C. Davis which appeared in the latest issue of *International Musician* under the caption, "Extra Money in Your Pocket." The article endorses the performance royalty bill, S. 1111, introduced by Senator Scott and co-sponsored by Senator Baker.

332. 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: motion picture soundtracks. *Federal Register*, vol. 40, no. 54 (Mar. 19, 1975), pp.12500-12501.

"These amendments to the regulations of the Copyright Office are intended to adopt, for purposes of deposit and registration only, an affirmative position that a sound motion picture is an entity, and that any copyrightable component part of a motion picture soundtrack is considered an integral part of the motion picture as a whole." The amendments, which become effective on May 12, are entirely prospective in operation, and are not intended to affect in any way the validity or legal efficacy of registrations made or other actions taken in accordance with earlier practices of the Copyright Office. Interested persons are invited to submit written comments, suggestions, or arguments to the General

Counsel of the Copyright Office on or before May 5 for evaluation and consideration in making any determination as to whether or not to postpone the effective date of the Regulation or to revise the text.

333. U.S. FEDERAL COMMUNICATIONS COMMISSION.

Network program exclusivity nonduplication protection rules for cable television. *Federal Register*, vol. 40, no. 77 (Apr. 21, 1975), pp.17724-17742. "Dockets Nos. 19995 & 18785; FCC 75-413."

Major changes in cable television network program exclusivity or nonduplication rules, amending Subpart F of Part 76 of Title 47 of the Code of Federal Regulations. Among the changes are: specification of zones of protection for stations in the top 100 markets; permission for a cable system to carry the protected station's signals on the duplication channel(s) which would otherwise be blacked out, during periods when nonduplication protection is being provided to a local television station; exemption from the rules of systems which serve fewer than 1000 subscribers from their "headends"; and allowance of a one-hour grace period for the so-called "Heidi rule" that blacked out runovers of sports events.

334. U.S. FEDERAL COMMUNICATIONS COMMISSION.

Subscription television program rules and proposed rules relative to subscription use of series type programs. Inquiry to exclusivity practices of subscription and conventional TV operations. *Federal Register*, vol. 40, no. 67 (Apr. 7, 1975), pt. III, pp. 15545-15578.

"The FCC has formally completed revision of rules governing the use of feature film, sports and series type programs by subscription cable television (pay cable) for which a per-program or pre-channel charge is made.

"The Commission also amended its rules governing subscription over-the-air broadcast television operations (pay TV).

"In related actions, the FCC invited comments on whether its rules on series type programs by subscription operations should be revised further, and initiated an inquiry into whether the FCC should adopt rules restricting the ability of conventional television networks and stations to require program exclusivity against subscription operations.

.... "The new subscription program rules amend Sections 73.643 and 76.225 [of Title 47] of the rules. In general, they take a market approach in determining whether programs may be exhibited on a subscription basis." —Press release of March 28, 1975; Report No. 10491.

2. Foreign Nations

335. DENMARK. *Laws, statutes, etc.*

Bekendtgørelse af Lov om ophavsretten til litterære og kunstneriske værker. Nr. 130 [af] 15. april 1975. *Lovtidende A*, 1975, Nr. XV, pp. 462-470. "Herved bekendtgøres lov nr. 158 af 31. maj 1961 om ophavsretten til litterære og kunstneriske værker med de ændringer, der følger af lov nr. 174 af 21. marts 1973."

The official Danish text of Act No. 158 of May 31, 1961, on Copyright in Literary and Artistic Works, which incorporates the amendatory Act No. 174 of March 21, 1973.

336. DENMARK. *Laws, statutes, etc.*

Bekendtgørelse af Lov om retten til fotografiske billeder. Nr. 129 [af] 15. april 1975. *Lovtidende A*, 1975, nr. XV, pp. 459-461.

The official Danish text of Act No. 157 of May 31, 1961, on Rights in Photographic Pictures, which incorporates the amendatory Act No. 175 of March 21, 1973.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U.S. COURTS

1. Supreme Court Decisions

337. *Jondora Music Publishing Company v. Melody Recordings, Inc.*, 506 F.2d 392 (3rd Cir. As amended Jan. 16, 1975) (Weis, C.J.). *Cert. denied*, 43 U.S.L.W. 3646 (June 10, 1975).

Action for alleged "tape piracy". The District Court denied the allegations of copyright infringement on the basis that, under the compulsory license provision, 17 U.S.C. § 1(e), the defendant had made a "similar use" of the copyrighted works. On plaintiff's appeal, *held*, vacated and remanded.

Following the lead of *Dutchess Music Corp. v. Stern*, 458 F.2d 1305 (9th Cir.), *cert. denied*, 409 U.S. 847 (1972), the Court held defendant's re-taping of plaintiff's recordings *not* to be a "similar use" within the meaning of the compulsory license provision:

"... the duplicators or pirates do not 'use' the composer's work in a 'similar' fashion — indeed, they do not utilize the composer's work at all. It is a recording which is used. Rather than permit the use of a recording of the composition, the statute only authorizes the use of the copyrighted work, that is, the written score.

The use to which the original licensee put the composer's work, i.e., the musical score, was much more elaborate, involving as it did the preparation of an arrangement from the written composition and its performance by musicians and vocalists. The mere duplication of a recording by the pirate is not the same as, or "similar" to the efforts made by the original licensee in utilizing the characters on a piece of paper as the basic plan for producing harmonious sounds".

In addition to its interpretation of the words "similar use", the Court focused its opinion on the adverse affects of record piracy on the composer. This results from the decreased incentive for record manufacturers to record new compositions when pirated, low-cost copies undercut the market. The Court noted that the *Goldstein* decision did not affect its opinion in that the case was directed to the question of rights in recordings

and not to rights in the underlying compositions. Finally, the 1971 Legislative Report involving the 1971 Sound Recording Amendment (U.S. Code Cong. & Admin. News at 1569) was cited because it indicated that the Senate Committee's interpretation of the "similar use" clause was the same as the Court's.

338. *The Williams & Wilkins Company v. The United States*, 43 U.S.L.W. 4314 (Feb. 25, 1975).

Action for alleged infringement of copyright in plaintiff's medical journals arising out of defendant's photocopying of entire articles therefrom. The defendant's principal defense was that it had made a "fair use" of plaintiff's works. From a 4-to-3 decision adverse to plaintiff in the Court of Claims, plaintiff petitioned for a writ of certiorari, which was granted.

Held, per curiam, affirmed by an equally divided Court. Mr. Justice Blackmun took no part in the decision.

339. *Twentieth Century Music Corporation v. Aiken*, 43 U.S.L.W. 4799 (June 17, 1975).

Because of the unusual importance of this opinion, the Editorial Board has decided to reprint it in full.

MR. JUSTICE STEWART delivered the opinion of the Court.

The question presented by this case is whether the reception of a radio broadcast of a copyrighted musical composition can constitute copyright infringement, when the copyright owner has licensed the broadcaster to perform the composition publicly for profit.

I

The respondent George Aiken owns and operates a small fast-service food shop in downtown Pittsburgh, Pennsylvania, known as "George Aiken's Chicken." Some customers carry out the food they purchase, while others remain and eat at counters or booths. Usually the "carry-out" customers are in the restaurant for less than five minutes, and those who eat there seldom remain longer than 10 or 15 minutes.

A radio with outlets to four speakers in the ceiling receives broadcasts of music and other normal radio programming at the restaurant. Aiken usually turns on the radio each morning at the start of business. Music, news, entertainment, and commercial advertising broadcast by radio stations are thus heard by Aiken, his employees, and his customers during the hours that the establishment is open for business.

On March 11, 1972, broadcasts of two copyrighted musical compositions were received on the radio from a local station while several customers were in Aiken's establishment. Petitioner Twentieth Century Music

Corporation owns the copyright on one of these songs, "The More I See You"; petitioner Mary Bourne the copyright on the other, "Me and My Shadow." Petitioners are members of the American Society of Composers, Authors and Publishers (ASCAP), an association that licenses the performing rights of its members to their copyrighted works. The station that broadcast the petitioners' songs was licensed by ASCAP to broadcast them.¹ Aiken, however, did not hold a license from ASCAP.

The petitioners sued Aiken in the United States District Court for the Western District of Pennsylvania to recover for copyright infringement. Their complaint alleged that the radio reception in Aiken's restaurant of the licensed broadcasts infringed their exclusive rights to "perform" their copyrighted works in public for profit. The District Judge agreed, and granted statutory monetary awards for each infringement. 356 F. Supp. 271. The United States Court of Appeals for the Third Circuit reversed that judgment, 500 F.2d 127, holding that the petitioners' claims against the respondent were foreclosed by this Court's decisions in *Fortnightly Corp. v. United Artists*, 392 U.S. 390, and *Teleprompter Corp. v. CBS*, 415 U.S. 394. We granted certiorari. 419 U.S. 1067.

II

The Copyright Act of 1909, 35 Stat. 1075, as amended, 17 U.S.C. §1 *et seq.*,² gives to a copyright holder a monopoly limited to specified "exclusive" rights in his copyrighted works.³ As the Court explained in *Fortnightly Corp. v. United Artists*, *supra*:

¹ For a discussion of ASCAP, see *K-91, Inc. v. Gershwin Publishing Corp.*, 372 F. 2d 1 (CA9).

ASCAP's license agreement with the Pittsburgh broadcasting station contained, as is customary, the following provision:

"Nothing herein contained shall be construed as authorizing Licensee [WKJF-FM] to grant to others any right to reproduce or perform publicly for profit by any means, method or process whatsoever of the musical compositions licensed hereunder or as authorizing any receiver of any radio broadcast to perform publicly or reproduce the same for profit, by any means, method or process whatsoever."

² The Constitution gives 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." U. S. Const., Art. 1, §8, cl. 8. See, *e.g.*, *Burrow-Giles Lithographic Co. v. Sarony*, 111 U. S. 53, 58; *Trade-Mark Cases*, 100 U. S. 82, 94.

³ 17 U. S. C. §1 provides:

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

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

"The Copyright Act does not give a copyright holder control over all uses of his copyrighted work. Instead, §1 of the Act enumerates several 'rights' that are made 'exclusive' to the holder of the copyright. If a person, without authorization from the copyright holder, puts a copyrighted work to a use within the scope of one of these 'exclusive rights,' he infringes the copyright. If he puts the work to a use not enumerated in §1, he does not infringe." *Id.*, at 393-395.

Accordingly, if an unlicensed use of a copyrighted work does not conflict with an "exclusive" right conferred by the statute, it is no infringement of the holder's rights. No license is required by the Copyright Act, for example, to sing a copyrighted lyric in the shower.⁴

"(b) To translate the copyrighted work into other languages or dialects, or make any other version thereof, if it be a literary work; to dramatize it if it be a nondramatic work; to convert it into a novel or other nondramatic work if it be a drama; to arrange or adapt it if it be a musical work; to complete, execute, and finish it if it be a model or design for a work of art;

"(c) To deliver, authorize the delivery of, read, or present the copyrighted work in public for profit if it be a lecture, sermon, address or similar production, or other nondramatic literary work; to make or procure the making of any transcription or record thereof by or from which, in whole or in part, it may in any manner or by any method be exhibited, delivered, presented, produced, or reproduced; and to play or perform it in public for profit, and to exhibit, represent, produce, or reproduce it in any manner or by any method whatsoever. The damages for the infringement by broadcast of any work referred to in this subsection shall not exceed the sum of \$100 where the infringing broadcaster shows that he was not aware that he was infringing and that such infringement could not have been reasonably foreseen; and

"(d) To perform or represent the copyrighted work publicly if it be a drama or, if it be a dramatic work and not reproduced in copies for sale, to vend any manuscript or any record whatsoever thereof; to make or to procure the making of any transcription or record thereof by or from which, in whole or in part, it may in any manner or by any method be exhibited, performed, represented, produced, or reproduced; and to exhibit, perform, represent, produce or reproduce it in any manner or by any method whatsoever; and

"(e) To perform the copyrighted work publicly for profit if it be a musical composition; and for the purpose of public performance for profit, and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced. . . ." 17 U.S.C. §1.

⁴ Cf. *Wall v. Taylor*, 11 W. B. D. 106-107 (1882) (Brett, M. R.): "Singing for one's own gratification without intending thereby to represent anything, or to amuse anyone else, would not, I think, be either a representation or a performance, according to the ordinary meaning of those terms, nor would the fact of some other person being in the room at the time of such singing make it so. . . ."

The limited scope of the copyright holder's statutory monopoly, like the limited copyright duration required by the Constitution,⁵ reflects a balance of competing claims upon the public interest: Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts.⁶ The immediate effect of our copyright law is to secure a fair return for an "author's" creative labor. But the ultimate aim is, by this incentive, to stimulate artistic creativity for the general public good. "The sole interest of the United States and the primary object in conferring the monopoly," this Court has said, "lie in the general benefits derived by the public from the labors of authors." *Fox Film Corp. v. Doyal*, 286 U.S. 123, 127. See *Kendall v. Winsor*, 21 How. 322, 327-328; *Grant v. Raymond*, 6 Pet. 218, 241-242. When technological change has rendered its literal terms ambiguous, the Copyright Act must be construed in light of this basic purpose.⁷

The precise statutory issue in the present case is whether Aiken infringed upon the petitioners' exclusive right, under the Copyright Act of 1909, 35 Stat. 1075, as amended, 17 U.S.C. §1(e), "[t]o perform the copyrighted work publicly for profit."⁸ We may assume that the radio reception of the musical compositions in Aiken's restaurant occurred "publicly for profit." See *Herbert v. Shanley*, 242 U.S. 591. The dispositive question, therefore, is whether this radio reception constituted a "performance" of the copyrighted works.

When this statutory provision was enacted in 1909, its purpose was to prohibit unauthorized performances of copyrighted musical compositions in such public places as concert halls, theaters, restaurants, and cabarets. See H.R. Rep. No. 2222, 60th Cong., 2d Sess. (1909). An orchestra or individual instrumentalist or singer who performs a copyrighted musical composition in such a public place without a license is thus

⁵ See M. Nimmer, Copyright §5 (1974).

⁶ Lord Mansfield's statement of the problem almost 200 years ago in *Sayre v. Moore*, 1 East 361n., 102 Eng. Rep. 139n. (K. B. 1785) bears repeating: "[W]e must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labor; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded."

⁷ In *Fortnightly Corp. v. United Artists*, 392 U.S. 390, the Court stated: "[O]ur inquiry cannot be limited to ordinary meaning and legislative history, for this is a statute that was drafted long before the development of the electronic phenomena with which we deal here. In 1909 radio itself was in its infancy, and television had not been invented. We must read the statutory language of 60 years ago in the light of drastic technological change." *Id.*, at 395-396 (footnotes omitted).

⁸ See n. 2, *supra*.

clearly an infringer under the statute. The entrepreneur who sponsors such a public performance for profit is also an infringer — direct or contributory. See generally M. Nimmer, Copyright §§ 102, 134 (1974). But it was never contemplated that the members of the audience who heard the composition would themselves also be simultaneously “performing,” and thus also guilty of infringement. This much is common ground.

With the advent of commercial radio, a broadcast musical composition could be heard instantaneously by an enormous audience of distant and separate persons operating their radio receiving sets to reconvert the broadcast to audible form.⁹ Although Congress did not revise the statutory language, copyright law was quick to adapt to prevent the exploitation of protected works through the new electronic technology. In short, it was soon established in the federal courts that the broadcast of a copyrighted musical composition by a commercial radio station was a public performance of that composition for profit — and thus an infringement of the copyright if not licensed. In one of the earliest cases so holding, the Sixth Circuit Court of Appeals said:

“While the fact that the radio was not developed at the time the Copyright Act . . . was enacted may raise some question as to whether it properly comes within the purview of the statute, it is not by that fact alone excluded from the statute. In other words, the statute may be applied to new situations not anticipated by Congress, if, fairly construed, such situations come within its intent and meaning . . . While statutes should not be stretched to apply to new situations not fairly within their scope, they should not be so narrowly construed as to permit their evasion because of changing habits due to new inventions and discoveries.

“A performance, in our judgment, is no less public because the listeners are unable to communicate with one another, or are not assembled within an inclosure, or gathered together in some open stadium or park or other public place. Nor can a performance, in our judgment, be deemed private because each listener may enjoy it alone in the privacy of his home. Radio broadcasting is intended to, and in fact does, reach a very much larger number of the public at the moment of the rendition than any other medium of performance. The artist is consciously addressing a great, though unseen and widely scattered, audience, and is therefore participating in a public performance.” *Jerome H. Remick & Co. v. American Automobile Accessories Co.*, 5 F.2d 411-412 (1925).

⁹ Station KDKA, established in Pittsburgh in 1920, is said to have been the first commercial radio broadcasting station in the world. See *Buck v. Jewell-LaSalle Realty Co.*, 283 U. S. 191, 197 n. 2.

See also *M. Witmark & Sons v. L. Bamberger & Co.* 291 F. 776 (NJ 1923); *Jerome H. Remick & Co. v. General Electric Co.*, 4 F. 2d 160 (SDNY, 1924); *Jerome H. Remick & Co. v. General Electric Co.*, 16 F. 2d 829 (SDNY, 1926); *Associated Music Publishers, Inc., v. Debs Memorial Radio Fund*, 141 F.2d 852 (CA2, 1944). Cf. *Chappell & Co. v. Associated Radio Co. of Australia, Ltd.*, [1925] Vict. L.R. 350; *Messenger v. British Broadcasting Co., Ltd.*, [1927] 2 K. B. 543, rev'd on other grounds, [1928] 1 K. B. 660, aff'd, [1929] A. C. 151. See generally Caldwell, *Broadcasting of Copyrighted Works*, 1 J. Air L. 584 (1930); Note, 75 U. of Pa. L. Rev. 549 (1927); Note, 39 Harv. L. Rev. 269 (1925).

If, by analogy to a live performance in a concert hall or cabaret, a radio station "performs" a musical composition when it broadcasts it, the same analogy would seem to require the conclusion that those who listen to the broadcast through the use of radio receivers do not perform the composition. And that is exactly what the early federal cases held. "Certainly those who listen do not perform, and therefore do not infringe." *Jerome H. Remick & Co. v. General Electric Co.*, 16 F.2d 829. "One who manually or by human agency merely actuates electrical instrumentalities, whereby inaudible elements that are omnipresent in the air are made audible to persons who are within hearing, does not 'perform' within the meaning of the Copyright Law." *Buck v. Debaum*, 40 F.2d 734, 735 (SD Cal. 1929).

Such was the state of the law when this Court in 1931 decided *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191. In that case the Court was called upon to answer the following question certified by the Eighth Circuit Court of Appeals: "Do the acts of a hotel proprietor, in making available to his guests, through the instrumentality of a radio receiving set and loud speakers installed in his hotel and under the control and for the entertainment of his guests, the hearing of a copyrighted musical composition which has been broadcast from a radio transmitting station, constitute a performance of such composition within the meaning of 17 USC, Sec. 1(e)?" The Court answered the certified question in the affirmative. In stating the facts of the case, however, the Court's opinion made clear that the broadcaster of the musical composition was not licensed to perform it, and at least twice in the course of its opinion the Court indicated that the answer to the certified question might have been different if the broadcast itself had been authorized by the copyright holder.¹⁰

We may assume for present purposes that the *Jewell-LaSalle* decision retains authoritative force in a factual situation like that in which it

¹⁰ "[W]e have no occasion to determine under what circumstances a broadcaster will be held to be a performer, or the effect upon others of his paying a license fee." 283 U. S., at 198 (emphasis added). See also 283 U. S., at 199 n. 5.

arose.¹¹ But, as the Court of Appeals in this case perceived, this Court has in two recent decisions explicitly disavowed the view that the reception of an electronic broadcast can constitute a performance, when the broadcaster himself is licensed to perform the copyrighted material that he broadcasts. *Fortnightly Corp. v. United Artists*, 392 U.S. 390; *Teleprompter Corp. v. CBS*, 415 U.S. 394.

The language of the Court's opinion in the *Fortnightly* case could hardly be more explicitly dispositive of the question now before us:

"The television broadcaster in one sense does less than the exhibitor of a motion picture or stage play; he supplies his audience not with visible images but only with electronic signals. The viewer conversely does more than a member of a theater audience; he provides the equipment to convert electronic signals into audible sound and visible images. Despite these deviations from the conventional situation contemplated by the framers of the Copyright Act, broadcasters have been judicially treated as exhibitors, and viewers as members of a theater audience. Broadcasters perform. Viewers do not perform. Thus, while both broadcaster and viewer play crucial roles in the total television process, a line is drawn between them. One is treated as active performer; the other, as passive beneficiary." *Fortnightly Corp. v. United Artists*, 392 U.S., at 398-399 (footnotes omitted).

The *Fortnightly* and *Teleprompter* cases, to be sure, involved television, not radio, and the copyrighted materials there in issue were literary and dramatic works, not musical compositions. But, as the Court of Appeals correctly observed, "[i]f *Fortnightly* with its elaborate CATV plant and *Teleprompter* with its even more sophisticated and extended technological and programming facilities was not 'performing,' then logic dictates that no 'performance' resulted when the [respondent] merely activated his restaurant radio." 500 F.2d, at 137.

To hold in this case that the respondent Aiken "performed" the petitioners' copyrighted works would thus require us to overrule two very recent decisions of this Court. But such a holding would more than offend the principles of *stare decisis*; it would result in a regime of copyright law that would be both wholly unenforcible and highly inequitable.

¹¹ The decision in *Jewell-LaSalle* might be supported by a concept akin to that of contributory infringement, even though there was no relationship between the broadcaster and the hotel company and, therefore, technically no question of actual contributory infringement in that case. 283 U.S., at 197 n.4.

The practical unenforcibility of a ruling that all of those in Aiken's position are copyright infringers is self-evident. One has only to consider the countless business establishments in this country with radio or television sets on their premises — bars and beauty shops, cafeterias and car washes, dentists' offices and drive-ins — to realize the total futility of any evenhanded effort on the part of copyright holders to license even a substantial percentage of them.¹²

And a ruling that a radio listener "performs" every broadcast that he receives would be highly inequitable for two distinct reasons. First, a person in Aiken's position would have no sure way of protecting himself from liability for copyright infringement except by keeping his radio set turned off. For even if he secured a license from ASCAP, he would have no way of either foreseeing or controlling the broadcast of compositions whose copyright was held by someone else.¹³ Secondly, to hold that all in Aiken's position "performed" these musical compositions would be to authorize the sale of an untold number of licenses for what is basically a

¹² The Court of Appeals observed that ASCAP now has license agreements with some 5,150 business establishments in the whole country, 500 F. 2d, at 129, noting that these include "firms which employ on premises sources for music such as tape recorders and live entertainment." *Id.*, at n. 4. As a matter of so-called "policy" or "practice," we are told, ASCAP has not even tried to exact licensing agreements from commercial establishments whose radios have only a single speaker.

¹³ This inequity, in the context of the decision in *Buck v. Jewell-LaSalle Realty Co.*, 283 U. S. 191, was pointed out by Professor Zechariah Chafee, Jr., 30 years ago: "A rule which is very hard for laymen to apply so as to keep clear of litigation was established by the *LaSalle Hotel* case. The hotel was heavily liable if it rebroadcast unlicensed music, but how could it protect itself? Must it maintain a monitor always on the job to sit with a list before him pages long showing what pieces are licensed and turn off the master set the instant an unlicensed piece comes from the broadcasting? The dilemma thus created by the Copyright Act was mitigated for a time by the machinery of ASCAP, which was a device entirely outside the statute. The hotel could obtain a blanket license from ASCAP and thus be pretty sure of safety about all the music which came through its master set . . . [But] if any composer outside the ASCAP has his music broadcast, what is the hotel to do? Besides getting an ASCAP license, must the hotel bargain separately with every independent composer on the chance that his music may come through to the hotel patrons? "Such divergences from the ideal . . . are likely to be corrected . . ." Reflections on the Law of Copyright I, 45 Colum. L. Rev. 503, 528-529.

¹⁴ The petitioners have not demonstrated that they cannot receive from a broadcaster adequate royalties based upon the total size of the broadcaster's audience. On the contrary, the respondent points out that generally copyright holders can and do receive royalties in proportion to advertising revenues of licensed broadcasters, and a broadcaster's advertising revenues reflect the total number of its listeners, including those who listen to the broadcasts in public business establishments.

single public rendition of a copyrighted work. The exaction of such multiple tribute would go far beyond what is required for the economic protection of copyright owners,¹⁴ and would be wholly at odds with the balanced congressional purpose behind 17 U.S.C. §1(e):

“The main object to be desired in expanding copyright protection accorded to music has been to give to the composer an adequate return for the value of his composition, and it has been a serious and a difficult task to combine the protection of the composer with the protection of the public, and to so frame an act that it would 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, which might be founded upon the very rights granted to the composer for the purpose of protecting his interests.” H.R. Rep. No. 2222, 60th Cong., 2d Sess., at 7 (1909).

For the reasons stated in this opinion, the judgment of the Court of Appeals is affirmed.

MR. JUSTICE BLACKMUN, concurring in the result.

My discomfort, now decisionally outdated to be sure, with the Court's opinion and judgment is threefold:

1. My first discomfort is factual. Respondent Aiken hardly was an innocent “listener,” as the Court seems to characterize him throughout its opinion and particularly on pages 11 and 12 thereof. In one sense, of course, he was a listener, for as he operated his small food shop and served his customers, he heard the broadcasts himself. Perhaps his work was made more enjoyable by the soothing and entertaining effects of the music. With this aspect I would have no difficulty.

But respondent Aiken installed four loudspeakers in his small shop. This, obviously, was not done for his personal use and contentment so that he might hear the broadcast, in any corner he might be, above the noise of commercial transactions. It was done for the entertainment and edification of his customers. It was part of what Mr. Aiken offered his trade, and it added, in his estimation, to the atmosphere and attraction of his establishment. Viewed in this light, respondent is something more than a mere listener and is not so simply to be categorized.

2. My second discomfort is precedential. Forty-four years ago, in an unanimous opinion written by Mr. Justice Brandeis, this Court held that a hotel proprietor's use of a radio receiving set and loudspeakers for the entertainment of hotel guests constituted a performance within the meaning of §1 of the Copyright Act. *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191 (1931). For more than 35 years the rule in *Jewell-LaSalle* was a

benchmark in copyright law and was the foundation of a significant portion of the rather elaborate licensing agreements that evolved with the developing media technology. Seven years ago the Court, by a five to one vote, and with three Justices not participating, held that a community antenna television (CATV) station that transmitted copyrighted works to home subscribers was not performing the works, within the meaning of §1 of the Copyright Act. *Fortnightly Corp. v. United Artists*, 392 U.S. 390 (1968). The divided Court only briefly noted the relevance of *Jewell-LaSalle* and announced that that decision "must be understood as limited to its own facts." *Id.*, at 396-397, n. 18. I have already indicated my disagreement with the reasoning of *Fortnightly* and my conviction that it, rather than *Jewell-LaSalle*, is the case that should be limited to its facts. *Teleprompter Corp. v. CBS*, 415 U.S. 394, 415 (1974) (dissenting opinion.) I was there concerned about the Court's simplistic view of television's complications, a view perhaps encouraged by the obvious inadequacies of an ancient copyright act for today's technology. A majority of the Court, however, felt otherwise and extended the simplistic analysis rejected in *Jewell-LaSalle*, but embraced in *Fortnightly*, to even more complex arrangements in the CATV industry. *Teleprompter Corp. v. CBS*, *supra*.

I had hoped, secondarily, that the reasoning of *Fortnightly* and *Teleprompter* would be limited to CATV. At least in that context the two decisions had the arguably desirable effect of protecting an infant industry from a premature death. Today, however, the Court extends *Fortnightly* and *Teleprompter* into radio broadcasting, effectively overrules *Jewell-LaSalle*, and thereby abrogates more than 40 years of established business practices. I would limit the application of *Teleprompter* and *Fortnightly* to the peculiar industry that spawned them. Parenthetically, it is of interest to note that this is precisely the result that would be achieved by virtually all versions of proposed revisions of the Copyright Act. See, e.g., S. 1361, 93d Cong., 2d Sess. §110(5). See, also, §§48(5) and (6) of the British Copyright Act of 1956 which distinguishes between the use of a radio in a public place and "the causing of a work or other subject-matter to be transmitted to subscribers to a diffusion service."

Resolution of these difficult problems and the fashioning of a more modern statute are to be expected from the Congress. In any event, for now, the Court seems content to continue with its simplistic approach and to accompany it with a pragmatic reliance on the "practical unenforceability," *ante*, p. 11, of the copyright law against persons such as George Aiken.

3. My third discomfort is tactical. I cannot understand why the Court is so reluctant to do directly what it obviously is doing indirectly, namely, to overrule *Jewell-LaSalle*. Of course, in my view, that decision was correct at the time it was decided, and I would regard it as good law today under the identical statute and with identical broadcasting. But, as I have noted, the Court in *Fortnightly* limited *Jewell-LaSalle* "to its own facts," and in

Teleprompter ignored its existence completely by refusing even to cite it. This means, it seems to me, that the Court did not want to overrule it, but nevertheless did not agree with it and felt, hopefully, that perhaps it would not bother us anymore anyway. Today the Court does much the same thing again by extracting and discovering great significance in the fact that the broadcaster in *Jewell-LaSalle* was not licensed to perform the composition. I cannot join the Court's intimation, *ante*, p. 9 — surely stretched to the breaking point — that Mr. Justice Brandeis and the unanimous Court for which he spoke would have reached a contrary conclusion in *Jewell-LaSalle* in 1931 had that broadcaster been licensed. The Court dances around *Jewell-LaSalle*, as indeed it must, for it is potent opposing precedent for the present case and stands stalwart against respondent Aiken's position. I think we should be realistic and forthright and, if *Jewell-LaSalle* is in the way, overrule it.

Although I dissented in *Teleprompter*, that case and *Fortnightly*, before it, have been decided. With the Court insisting on adhering to the rationale of those cases, the result the Court of Appeals and the Court reaches here is compelled. Accepting the precedent of those cases, I concur in the result.

MR. CHIEF JUSTICE BURGER, with whom MR. JUSTICE DOUGLAS joins, dissenting.

In *Fortnightly Corp. v. United Artists*, 392 U.S. 390, 402 (1968), Mr. Justice Fortas observed that cases such as this call "not for the judgment of Solomon but for the dexterity of Houdini." There can be no really satisfactory solution to the problem presented here, until Congress acts in response to long standing proposals. My primary purpose in writing is not merely to express disagreement with the Court but to underscore what has repeatedly been stated by others as to the need for legislative action. Radio today is certainly a more commonplace and universally understood technological innovation than CATV, for example, yet we are, basically, in essentially the same awkward situation as in the past when confronted with these problems. We must attempt to apply a statute designed for another era to a situation in which Congress has never affirmatively manifested its view concerning the competing policy considerations involved.

Yet, the issue presented can only be resolved appropriately by the Congress; perhaps it will find the result which the Court reaches today a practical and equitable resolution, or perhaps it will find this "functional analysis"¹ too simplistic an approach, cf. *Teleprompter v. CBS*, 415 U.S. 394, 415 (BLACKMUN, J., dissenting), and opt for another solution.

¹ "[B]roadcasters perform: Viewers do not perform." *Fortnightly Corp. v. United Artists*, 392 U. S. 390, 398 (1968).

The result reached by the Court is not compelled by the language of the statute; it is contrary to the applicable case law and, even assuming the correctness and relevance of the CATV cases, *Fortnightly*, *supra*, and *Teleprompter*, *supra*, it is not analytically dictated by those cases. In such a situation, I suggest, "the fact that the Copyright Act was written in a different day, for different factual situations, should lead us to tread cautiously here. One major object . . . should be to do as little damage as possible to traditional copyright principles and to business relationships, until Congress legislates and relieves the embarrassment which we and the interested parties face." *Fortnightly*, *supra*, at 404 (Fortas, J., dissenting).

As the Court's opinion notes, *ante*, at 9, in *Buck v. Jewell-LaSalle*, 283 U.S. 191 (1931), answering a precisely phrased certified question, the Court construed the Copyright Act in a manner which squarely conflicts with what is held today. Congress, despite many opportunities, has never legislatively overruled *Buck v. Jewell-LaSalle*, *supra*. It was not overruled in *Fortnightly* but treated "as limited to its facts." 392 U.S. 396-397, n. 18. Even assuming the correctness of this dubious process of limitation, see *Fortnightly*, *supra*, at 405 (Fortas, J., dissenting), *Teleprompter*, *supra*, at 415 (BLACKMUN, J., dissenting), *Buck* is squarely relevant here since the license at issue expressly negated any right on the part of the broadcaster to further license performances by those who commercially receive and distribute broadcast music. Moreover, even accepting, *arguendo*, the restrictive reading given to *Buck* by the Court today, and assuming the correctness of *Fortnightly* and *Teleprompter* in the CATV field, it is not at all clear that the analysis of these latter cases supports the result here.² Respondent was more than a "passive beneficiary." *Fortnightly*, *supra*, at 399. He took the transmission and used that transmission for commercial entertainment in his own profit enterprise, through a multispeaker audio-system specifically designed for his business purposes.³ In short, this case does not call for what the Court describes as "a ruling that a radio listener 'performs' every broadcast that he receives . . ." *ante*, at 11. Here,

² Recent congressional proposals have treated the present problem distinctly from CATV questions. See, e. g., S. 1361, 93d Cong., 2d Sess. (1974). See also British Copyright Act, §48 (5) (6).

³ Indeed, in its consideration of S. 1361, the Senate Committee on the Judiciary undertook to distinguish use of "ordinary radios" from situations "where broadcasts are transmitted to substantial audiences by means of loudspeakers covering a wide area." S. Rep. No. 93-983, 93d Cong., 2d Sess., 130 (1974). The value of this distinction, without drawing a line on the number of outlets that would be exempt is at best dubious; this version leaves the obvious gap in the statute to be filled in by the courts.

respondent received the transmission and then put it to an independent commercial use. His conduct seems to me controlled by *Buck's* unequivocal holding that:

“ [O]ne who hires an orchestra for a public performance for profit is not relieved from a charge of infringement merely because he does not select the particular program to be played. Similarly, when he tunes in on a broadcasting station, for his own commercial purposes, he necessarily assumes the risk that in so doing he may infringe the performing rights of another.” 283 U.S., at 198-199.

See also *Herbert v. Shanley Co.*, 242 U.S. 591 (1917).

In short, as MR. JUSTICE DOUGLAS observed in the *Teleprompter* case, “[t]he Court can read the result it achieves today only by ‘legislating’ important features of the Copyright Act out of existence.” 415 U.S., at 421. In my view, we should bear in mind that “[our] ax, being a rule of law, must cut straight, sharp, and deep; and perhaps this is a situation that calls for the compromise of theory and for the architectural improvisation which only legislation can accomplish.” *Fortnightly, supra*, at 408, dissenting opinion of Fortas, J.

2. Federal Court Decisions

340. *Affiliated Hospital Products, Inc. v. Merdel Game Manufacturing Company*, 185 U.S.P.Q. 321 (2d Cir. March 31, 1975) (Waterman, C.J.).

Action for alleged infringement of plaintiff's copyrighted game rule book, as well as for trademark infringement, breach of contract and unfair competition arising out of defendant's alleged misuse of the trademarks “CARROM” and “KIK-IT”. From judgment for defendant, plaintiff appeals.

Held, affirmed.

Despite defendant's admission of access to and use of plaintiff's rulebook, the court affirmed the trial court's dismissal of plaintiff's allegation of copyright infringement. Defendant had not copied plaintiff's work verbatim. In fact, defendant's improvement and clarification of plaintiff's rulebook led the court to defeat plaintiff's claim, particularly in light of the simplicity of the game to which the rules pertained. The court reasoned that to afford any greater scope of protection to a copyright proprietor of a rulebook which expresses the rules of a game would create a monopoly in the game. And, since the game is in the public domain, the rules are, “perforce”, also in the public domain:

[A] contrary result would prevent publication of the rules of any simple game in the public domain unless the second entrant in the field developed his rules solely through watching the game being played; a result which would afford protection to the game itself.

341. *Simon & Flynn, Inc. v. Time, Incorporated*, 185 U.S.P.Q. 325 (2d Cir. April 2, 1975) (per curiam).

Action for copyright infringement, unfair trade practices and unfair competition arising out of defendant's alleged conversion of plaintiff's entertainment and educational series called "*VINCE LOMBARDI'S - THE SCIENCE AND ART OF FOOTBALL*" which had not been copyrighted pursuant to the provisions of the U.S. Copyright Act. From order dismissing complaint for lack of federal jurisdiction, plaintiff appeals.

Held, affirmed.

Because no copyright was alleged to have issued with respect to plaintiff's work, and since therefore no infringement of a statutory copyright was or could have been alleged, plaintiff had no claim under the Copyright Act and thus could not base federal jurisdiction thereon. Nor could plaintiff base jurisdiction on diversity of citizenship, as it appeared that between six and eight of the twelve defendants resided in the same state as plaintiff. The court therefore affirmed the lower court's dismissal, with the following comments:

Counsel seems also to have labored under the impression that an aroma of copyright suffices to make an action one "arising under any Act of Congress relating to . . . copyrights," 28 U.S.C. §1338(a). While such a view might not be unnatural for a layman, it . . . runs counter to "precedents going back for more than a century" . . .

Because plaintiff's real claim was for infringement of its common law rights, clearly a state claim, the court admonished the appellant for its uninformed appeal, awarding double costs:

There was no justification for taking up the time of two district judges with a complaint so far outside federal jurisdiction, still less for appealing from Judge Metzner's clear and correct decision. Counsel must realize that the decision to appeal should be a considered one, taking into account what the district judge has said, not a knee-jerk-reaction to every unfavorable ruling. . . .

342. *Fame Publishing Co., Inc. v. Alabama Custom Tape, Inc.*, 184 U.S.P.Q. 577 (5th Cir. 1975).

Action for infringement of plaintiff's copyrights in its recorded, musical compositions arising out of the reproduction thereof by defendant, which the court characterized as a "tape parasite" although popularly known as a "tape pirate". From summary judgment for plaintiff, defendant appeals.

Held, affirmed.

Bolstering its opinion by the language of the copyright statute, the congressional intent behind that statute, and the weight of judicial authority, the court held defendant's "use" of plaintiff's composition not to be "similar" to the original use by plaintiff — namely, the act of recording by live performers. Thus, defendant had no right to reproduce plaintiff's recording, was not entitled to a compulsory license, and was therefore an infringer.

Godbold, C.J., dissenting, challenged the standing of the copyright holder of the underlying work to sue, arguing that the exclusive right to a recording was only recently conferred by Congress in 1971, and that such right applied to the record manufacturer rather than to the owner of copyright in the underlying composition. According to the dissent, the copyright holder's sole right is to receive the statutory compulsory license fee.

343. *Nucor Corporation v. Tennessee Forging Steel Service, Inc.*, 185 U.S.P.Q. 332 (8th Cir. April 2, 1975) (Heaney, C.J.). For opinion below, see 9 BULL. CR. SOC. 324, Item 492.

Action for infringement of plaintiff's copyrighted architectural plans. The dismissal of the original action was reversed by the Circuit Court, which, in its opinion, held defendant liable for infringement of plaintiff's common law copyright and remanded to permit, among other relief, the recovery from defendant of the "fair value" of plaintiff's plans. When remanded, however, the defendant introduced evidence indicating that they received no benefit from the infringement in that non-infringing plans were ultimately used to construct the plant in question. As a result, the trial court awarded no damages to plaintiff. From said judgment for defendant, plaintiff appealed.

Held, modified.

The court reversed the trial court's determination that defendant was not liable for any damages because it had not benefited from its use of plaintiff's plans. The court again remanded in accordance with the terms of its opinion in the first appeal, namely, to award plaintiff what the court found to be the "fair value" of plaintiff's plans, as well as any other damages plaintiff could prove. The court held that its decision in the first appeal had finally determined that defendant was liable to Nucor for the fair value of the plans. Thus, on remand, the trial court was bound to that

decision by the doctrine of the law of the case and therefore erred in failing to award such damages. However, with respect to damages in addition to the fair value of the plans, which had not been submitted on the first appeal, the doctrine of the law of the case was inapplicable. Therefore, that issue was properly considered by the trial court and the resulting determination of no damage was affirmed.

344. *Reyher v. Children's Television Workshop*, 185 U.S.P.Q. 277 (S.D.N.Y. Jan. 6, 1975) (Canella, J.).

Action for alleged infringement of plaintiff's copyright in a children's book, "My Mother Is the Most Beautiful Woman in the World". The claim arose out of defendant's production on its "SESAME STREET" program of a segment called "The Most Beautiful Woman in the World" and Children's Television Workshop's subsequent publication in its "SESAME STREET" magazine in both English and Spanish, of an article entitled "The Most Beautiful Woman in the World".

Held, dismissed.

Despite the substantial similarity between plaintiff's book and defendant's program and articles, the court held defendant's works did not infringe plaintiff's copyright. Since plaintiff's book was based on a story told to her by her mother, which was, in turn, believed to be based on an old Russian folk tale, it was a "derivative work", namely, one that was substantially copied from a prior work in the public domain. Therefore, plaintiff was only entitled to protection against copying of its contribution to the work as distinguished from its use of pre-existing material. The court found, after comparing the works in issue, that while almost identical in plot and sequence, the defendant's works contained little, if any, paraphrasing or verbatim copying. As the court stated, "the most that could be said is that [the defendant] [has] read the plaintiff's work and [has] retold the story in [his] own words. Such a finding will not, given the derivative nature of plaintiff's work, support a cause of action for copyright infringement."

In addition, plaintiff alleged infringement by another defendant, Tuesday Publications, Inc. (TPI) of its copyright in a drawing depicted at the conclusion of its book. TPI had no doubt used plaintiff's drawing as its model, and, as a result, its copy reflected more than a "passing similarity". However, the difference between the two was determined to be "so substantial" as to defeat the claim of infringement. The court's decision on this issue was based on the familiar idea-expression dichotomy which led it to the opinion that the similarity between the two works was necessary for TPI to use the unprotectable "idea" expressed in plaintiff's work.

345. *SmokEnders, Inc. v. Smoke No More, Inc.*, 184 U.S.P.Q. 309 (S.D. Fla. Oct. 21, 1974)

Action for common law and statutory copyright infringement, trademark infringement and unfair competition arising out of the unauthorized copying by defendant of plaintiff's smoke cessation program including photocopying plaintiff's copyrighted manuals as well as oral deliveries thereof. Defendant's principal officers and directors were initially enrolled in plaintiff's program, ceased smoking as a result, and subsequently became employees of plaintiff as "moderators" and "registrars" which entitled them to acquire possession of copies of plaintiff's copyrighted manuals and other materials. In the promotion of its business which it styled after plaintiff's, defendants committed several acts which tended to confuse the public. Prior to enrolling in plaintiff's program and again prior to their employment by plaintiff, such individuals agreed in writing to maintain plaintiff's trade secrets in confidence.

Held, judgment for plaintiff.

1. *Copyright Claims*

The court held the defendant, as well as the defendant's principal officers and directors who had controlled and dominated the defendant, were all jointly and individually liable for all acts of copyright infringement, unfair competition and trade secret appropriation. Since plaintiff proved its ownership of a federally registered copyright in a variety of its materials, coupled with defendant's access thereto and their making of substantially similar copies, plaintiff was successful in its claim of statutory copyright infringement. Plaintiff also claimed that defendants infringed its common law copyright in its manual, which had not been federally registered, by oral delivery thereof. Plaintiff had loaned copies of this manual, on a return basis, to its employees (including defendant's principal officers) who were moderators and needed the text. In addition, plaintiffs had distributed certain copies to the press and had, in the course of its programs, delivered orally the text of such manuals. The court stated such distribution by the plaintiff was insufficient to divest its common law copyright, which the defendant had breached by using the material in an unauthorized manner in its competing business, including both its oral delivery and photocopying thereof. The court, characterizing the defendant's act as "piracy", awarded damages and issued a permanent injunction.

2. *Trade Secrets Violations*

The court held the defendant had violated plaintiff's protectable trade secret in its program of smoking cessation. The program was entitled to protection as a trade secret because it was only available to those who agreed to keep it confidential (rather than being publicly available), it

was the result of great expense and effort, and, in addition, it would be of value to a competitor. Plaintiff had not forfeited its rights although it had communicated its program to numerous persons, because all these were under contract to keep it secret. The court stated, in addition, that when agreements not to compete involved the protection of trade secrets, they were afforded a greater scope of protection.

346. *Clairol, Incorporated v. Cosway Company, Inc.*, 184 U.S.P.Q. 583 (C.D. Cal. 1974).

Action for unfair competition and trademark infringement arising out of defendant's deliberate copying, for use on its shampoo, of the packaging and label which had been developed by plaintiff for its shampoo. Plaintiff's trade dress had been carefully selected, was followed up with a substantial advertising campaign and proved to be an outstanding success. Evidence of consumer confusion included actual incidents of substitution or intermingling by retailers, as well as expert testimony and a market research study, both of which indicated that confusion was likely.

Held, judgment for plaintiff.

The court found defendant guilty both of unfair competition and violation of the false designation of origin provisions of the Lanham Act [15 U.S.C §1125(a)]. It was satisfied that the plaintiff's "distinctive" trade dress had acquired secondary meaning as a result of extensive advertising and sales, despite the short period of time since its use began. In addition to taking note of actual evidence of confusion, the court noted that, unless plaintiff's trade dress had acquired such secondary meaning, defendant would hardly have gone to the trouble of imitating it. The court enjoined the defendant and required it to account for and pay over to plaintiff all profits resulting from the sale of its shampoo which was sold in the unlawful packaging.

PART V.

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A summary of a two-day symposium which took place October 15-16 in Washington, D.C. and "evolved from a need to teach approximately twenty attorneys of the Copyright section of the Library of Congress how to distinguish between typefaces, the differences between the various typographic systems and their applications, the problems faced by a designer of new typefaces, and the relationship of technology to typeface design and use . . . Sponsors were the Library of Congress, the National Endowment for the Arts, and the Graduate School of the U.S. Department of Agriculture."

386. Copyright shows signs of weakening as issue at NCTA; acceptance of affordable liability is called key to FCC de-regulation, though some keep saying, "Never". *Broadcasting*, vol. 88, no. 16 (Apr. 21, 1975), pp. 22-23.

An article on the recent annual convention in New Orleans of the National Cable Television Association where the change of mood toward copyright liability seemed evident. Barbara Ringer, Register of Copyrights, "who in her appearance at a panel was generally sympathetic to cable, put the matter of the parties' acceptance of copyright most bluntly: 'the time is over for all this bad-mouthing and game-playing that has been going on for eight or ten years in this field.' The bill now pending in Congress, she said, is good for cable."

387. For openers: a promise and a threat at the NCTA; pay cable's hereness is bright spot of opening session, with ATC's Rifkin putting earth station money where his rhetoric was; Jack Valenti, copyright hardliner, warns cable operators not to welsh on commitment to pay. *Broadcasting*, vol. 88, no. 16 (Apr. 21, 1975), pp. 26-27.

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388. NCTA at staging area for battle over copyright; as bill approaches hearings in House, board meets, approves principle of payments, but last adjustments on position will be made later. *Broadcasting*, vol. 88, no. 18 (May 5, 1975), pp. 31-33.

An article on a meeting of the board of the National Cable Television Association in Washington on April 28 at which the board passed a resolution by a vote of 26 to 2 to support "reasonable copyright payments." The board did not define "reasonable" and left the formulation of a definitive NCTA copyright position to be resolved at a later meeting some time during May.

389. NCTA gives top billing in New Orleans to copyright, FCC strictures, pay cable; frustration and loss of patience by industry are said to be the backdrop for convention. *Broadcasting*, vol. 88, no. 15 (Apr. 14, 1975), pp. 55-56.

An article on the agenda of the annual convention of the National Cable Television Association that opened on April 13 in New Orleans. "Although only one panel is devoted exclusively to the copyright issue, the controversy is expected to filter through much of the convention."

390. New coalition aims for copyright protection. *Publishers Weekly*, vol. 207, no. 12 (Mar. 24, 1975), p. 15.

An article on the formation of a "broadly based coalition of literary, musical, news and educational publishing and audiovisual groups," which "will concentrate its efforts on passage of a revised Federal copyright law which retains provisions contained in the pending legislation covering 'fair use' of copyrighted works and library photocopying."

391. PENNINGTON, RON. Justice group hears bills to rap pirates. *The Hollywood Reporter*, vol. 235, no. 29 (Mar. 14, 1975), pp. 1, 28.

An article on "[t]hree separate bills—each aimed at imposing stiffer penalties for tape and record piracy—[which] were heard . . . [March 11] by the criminal justice committee of the California State Assembly."

392. SCOTT, HUGH. Performance royalty; an idea long overdue. *Interface*, volume 4, no. 1 (Winter 1975), pp. 1-3.

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393. TUSHER, WILL. FBI agents set to run MPAA war on piracy. *The Hollywood Reporter*, vol. 235, no. 27 (Mar. 12, 1975), pp. 1, 13.

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394. The Washington connection in New Orleans; 'Federal Architects' session at NCTA, featuring FCC, congressional and Justice Department panelists, touches base on numerous regulatory issues. *Broadcasting*, vol. 88, no. 16 (Apr. 21, 1975), pp. 28, 30-31.

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An article on the pending antitrust action against 21 American publishers accused of conspiring with British publishers to "divide the world market into exclusive territories and allocate [those] territories among themselves."

396. Public lending right in 1974. *The Author*, vol. 86, no. 1 (Spring 1975), pp. 19-21.

A brief account of steps that have been taken during 1974 to secure public lending right legislation in Great Britain.

397. Putting P.L.R. into operation; report on the technical aspects and costs. *The Bookseller*, no. 3615 (April 5, 1975), pp. 2010-2011.

The official summing up of the technical report on the Public Lending Right published on March 26, 1975, by the British Department of Education and Science. "The use by libraries of computer systems, the number of authors affected and time and cost factors involved in the introduction of a Public Lending Right are among the subjects included in the findings."

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