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A MEMOIR OF JUDGE LEARNED HAND (1872-1961)

By HERMAN FINKELSTEIN*

To us in The Copyright Society of the U.S.A., Judge Learned Hand has a special significance. His copyright opinions—fifty in number during the half century between 1910 and 1960—have substantially affected the development of the law of copyright.¹ We shall not take this occasion to review Judge Hand's contribution to the law of copyright in individual cases. They have already been ably summarized elsewhere.² Other phases of Judge Hand's contribution to the law are reviewed in a series of articles in the *Harvard Law Review* marking Judge Hand's seventy-fifth birthday.³

This brief sketch will be confined to a law clerk's view of Judge Hand during his clerkship and in later years. All who served in that capacity have had similar experiences. The relationship was always highly personal. No memoranda ever passed between Judge Hand and his law clerks; all discussions of cases were oral. At first, the clerk, just out of law school, was bound to be timid; Judge Hand, however, soon gave him confidence in his ability to size up a case independently, and to discuss it as an equal with the Judge. The clerks learned early to be careful of avoiding common errors of pronunciation, and to refrain from using current legal clichés. Forbidden were such phrases as "the functional approach" (popular in those days); or "the factual

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1. The opinions of Judge Hand up to 1952 will be found as an appendix to R. Cracas' "Judge Learned Hand and the Copyright Law", 7 ASCAP Copyright Law Symposium 55, 89 (1956). The following should be added to the cases there cited: *Harms v. Stern*, 222 Fed. 581 (S.D.N.Y. 1915); *International Film Service Co. v. Associated Producers*, 273 Fed. 585 (S.D.N.Y. 1921); *Foreign & Domestic Music Corp. v. Licht*, 196 F. 2d 627 (2d Cir. 1952); *Gibran v. National Committee of Gibran*, 255 F. 2d 121 (2d Cir. 1958); *Vacheron & Constantin Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F. 2d 637 (2d Cir. 1958); *Modern Aids Inc. v. R. H. Macy & Co.*, 264 F. 2d 93 (2d Cir. 1959); *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F. 2d 487 (2d Cir. 1960).
2. *Id.* 55; S. H. Philbin, *Judge Learned Hand and the Law of Patents and Copyrights*, 60 *Harv. L. Rev.* 394 (1947).
3. 60 *Harv. L. Rev.* 325-422 (1947). In addition to tributes by Mr. Justice Frankfurter, 325, and C. C. Burlingham, 330, there are articles on "The Literary Style of Learned Hand" by George Wharton Pepper, 333; "Judge Learned Hand and the Work of the American Law Institute" by Judge Goodrich, 345; "Judge Learned Hand's Contributions to Public Law" by Judge Wyzanski, 348; "Judge Learned Hand and the Interpretation of Statutes" by Archibald Cox, 370; "Judge Learned Hand and the Law of Patents and Copyrights" by Stephen H. Philbin, 394; and "Judge Learned Hand and the Criminal Law" by Orrin G. Judd, 405.

situation" (the individual facts of every case were important); or "the instant case" (we were dealing with "the case at bar").

Judge Hand considered the members of the Court as members of a family. When he referred to a judge as his "brother," he meant all that the term implied. He treated his law clerks as small brothers—"puisne judges," he called us, pronounced, of course, "puny." In speaking of his clerks to other judges, he was inclined to exaggerate the assistance he received from them, and rarely wrote a letter to a former clerk in after years without reminding him of the help he had given the Judge.

I shall never forget his telling me that Judge Cardozo had criticized him for relying too much on his law clerk. In view of Judge Hand's careful review of the record in each case, his thorough reading of every opinion cited by him, his writing of every word in every one of his opinions, it was then and still is difficult to imagine what it was that he told Judge Cardozo, which, in turn, prompted the latter's remark. But Judge Hand enjoyed telling his law clerk about it. This was his way of expressing appreciation.

Judge Hand expected his law clerks to know what they were talking about; to avoid loose reasoning, and to enjoy putting in a full day's work. He set an example of the joy of creative work as an end in itself—the search for an answer, or as he expressed it, the search for truth. In this search, we were dealing with hard facts which had to be met head on. No fictions were permitted; "... candid men . . . will not stomach those equivocations which keep the promise to the ear and break it to the hope." In copyright cases, we must not talk about "abandoning" common law rights upon "publication" of a work when we really mean that certain acts result in a "forfeiture" of such rights even in the absence of any intent to abandon them. Said Judge Hand in the *National Comics* case:⁴

"... it is necessary at the outset to distinguish between 'abandonment,' strictly speaking, and what for convenience we shall call 'forfeiture.' We do not doubt that the 'author or proprietor of any work made the subject of copyright' by the Copyright Law may 'abandon' his literary property in the 'work' before he has published it, or his copyright in it after he has done so; but he must 'abandon' it by some overt act which manifests his purpose to surrender his rights in the 'work,' and to allow the public to copy it . . . It is of course true that the publication of a copyrightable 'work' puts that 'work' into the public domain except so far as it may be protected by copyright. That has been unquestioned law since 1774; and courts have often spoken of it as a 'dedication' by its 'author or proprietor.' That, however, is a misnomer, for 'dedication,'

4. *National Comics Publications Inc. v. Fawcett Publications*, 191 F. 2d 594, 597-8 (2d Cir. 1951).

like 'abandonment,' presupposes an intentional surrender, which is in no sense necessary to the 'forfeiture' of a copyright. An author, whose work is 'forfeited,' need have had no such purpose, and ordinarily does not; it was indeed long doubtful whether he did 'forfeit' his rights by publication, and when it was settled that he did, the result was a consequence, imposed *invitum* upon him because of his failure to comply with the prescribed formalities."

On reading a later decision of Judge Hand exposing the fiction that a chattel can be "embodied in a document,"⁵ I commented on the importance of such judicial pronouncements. Judge Hand refused to recognize the compliment. He did send a word of acknowledgment in his own unique way: "Be brave," he wrote, "resist the hordes of savagery that threaten us on every hand. Carry high the banner of what the English like to pronounce 'Civileyezation,' and renounce the Devil and all his works . . ."

Judge Hand held certain views very strongly. The jurisdiction of the federal courts should not be impaired once it was properly invoked. A receivership case involving a contest between the state and federal courts had been before the Circuit Court of Appeals on three occasions, a different bench sitting each time, and expressing a different view. The final decision, written *per curiam*, adhered to the second ruling, but stated that the Court as then constituted would have held otherwise if it had been an original question. The Supreme Court then granted certiorari and affirmed.⁶ Judge Hand, in telling this story to Judge Coxe several years later, characterized the final *per curiam* decision of the Circuit Court by saying, "We stuck to our previous decision while we spat upon it." As he finished unfolding the story, he turned to me and said, "Now when I die you can perform an autopsy on my body. When you get to my heart you will see a scar, and if you lift that scar you will find underneath the words '*Hatch v. Morosco*'."

Judge Hand had many such battle scars, but he treasured them all. The life of a scholar on the bench involves as much of a struggle, albeit of another nature, as does the life of a leader in the world of politics or statecraft whose actions may determine the future course of a people. Judge Hand speaks of "the consecration of his [the scholar's] spirit to the pursuit of the truth."

5. *Barrett v. Bank of Manhattan Co.*, 218 F. 2d 763 (2d Cir. 1954).

6. *Riehle v. Margolies*, 279 U.S. 218 (1929), affirming *Hatch v. Morosco Holding Co.*, 26 F. 2d 247 (2d Cir. 1928). See also: *Hatch v. Morosco Holding Co.*, 19 F. 2d 766 (2d Cir. 1927) reversing order of District Court holding judgment in State Court not valid proof in bankruptcy action; *Hatch v. Morosco Holding Co.*, 5 F. 2d 1015 (2d Cir. 1925) reversing order of District Court staying action in State Court; *In re Morosco Holding Co.*, 296 F. 216 (S.D.N.Y. 1924) denying motion to dismiss petition.

He continues, "No one can keep a mind always open to new evidence, always ready to change its conclusions, who has other allegiance or commitments." ⁷

"You may take Martin Luther or Erasmus for your model," Judge Hand tells us, "but you cannot play both roles at once; you may not carry a sword beneath a scholar's gown, or lead flaming causes from a cloister. Luther cannot be domesticated in a university. You cannot raise the standard against oppression, or leap into the breach to relieve injustice, and still keep an open mind to every disconcerting fact, or an open ear to the cold voice of doubt. I am satisfied that a scholar who tries to combine these parts sells his birthright for a mess of pottage; that, when the final count is made, it will be found that the impairment of his powers far outweighs any possible contribution to the causes he has espoused. If he is fit to serve in his calling at all, it is only because he has learned not to serve in any other, for his singleness of mind quickly evaporates in the fires of passions, however holy." ⁸

Judge Hand was the embodiment of judicial detachment. The bitter struggles of the day—and his personal reactions to them—never influenced his decision in a particular case. He was passionately devoted to the integrity of the individual as the only salvation of our civilization. Any summary denial of one's right to his day in court was abhorrent. Judge Hand was not enthusiastic about extending the range of summary judgment. The particular cause involved was wholly immaterial; the thought of depriving a litigant of the right to cross examine his adversary in open court somehow seemed to have the possibility of leaving a litigant with the feeling that he had been denied his day in court.⁹

Perhaps Judge Hand carried this bias in favor of the liberty of the individual too far. It is still too early to know for certain. He certainly did not let his personal views even on this subject color his judgment on constitutional issues. Some who failed to understand Judge Hand's philosophy were surprised at his criticism of the Supreme Court in the Holmes lectures.¹⁰ These views, however, were made known in this summary of Chief Justice Stone's Conception of the Judicial Function:¹¹

"Even before Justice Stone became Chief Justice it began to seem as though, when 'personal rights' were in issue, something strangely akin to the discredited attitude towards the Bill of Rights of the old apostles

7. L. Hand, *Spirit of Liberty*, 136 (1952).

8. *Id.* at 138.

9. See opinion of Frank, J., in *Armstein v. Porter*, 154 F. 2d 464 (2d Cir. 1946); cf. Dissent of Clark, J., 154 F. 2d 475.

10. See Hand, note 7 *supra*, at 222.

11. L. Hand, *Chief Justice Stone's Conception of the Judicial Function*, 46 *Colum. L. Rev.* 696, 698 (1946).

of the institution of property, was regaining recognition. Just why property itself was not a 'personal right' nobody took the time to explain; and perhaps the primary inquiry would have been regarded as captious and invidious anyway; but the fact remained that in the name of the Bill of Rights the courts were upsetting statutes which were plainly compromises between conflicting interests, each of which had more than a merely plausible support in reason. That looked a good deal as though more specific directions could be found in the lapidary counsels of the Amendments than the successful school had been able to discover, so long as the dispute turned on property. It needed little acquiescence with the robust and loyal character of the Chief Justice to foretell that he would not be content with what to him was an opportunistic reversion at the expense of his conviction as to the powers of a court. He could not understand how the principle which he had all along supported, could mean that, when concerned with interests other than property, the courts should have a wider latitude for enforcing their own predilections, than when they were concerned with property itself."

In commenting on this statement, Professor Freund observes:¹²

"It is frequently true of memorial addresses that they provide a truer insight into the mind of the speaker than into that of the deceased. At all events, Judge Hand has put the problem of the double standard in sharp focus. What can we say about the priority or parity of the 'two market places' in constitutional law?"

It is a sad commentary on our system of selecting judges that Learned Hand was never elevated to our highest court;¹³ but it is a great tribute to the man that he was universally regarded as the foremost judge of his day in spite of the failure of successive presidents to reward him accordingly. As Mr. Justice Frankfurter observed at the ceremonies marking Judge Hand's fiftieth year on the bench, "He has demonstrated and given heartening proof of the fact that moral influence, achievement of excellence, the fertilization of thought are not dependent upon place."

Shortly before he died, Judge Hand and I were discussing the choice of professions. I volunteered that it had never been a problem to me; I had never considered following any other calling. I added: "I am sure that you too have been fortunate in that respect."

12. P. A. Freund, *Competing Freedoms in American Constitutional Law*, U. of Chicago Conf. on Freedom and the Law, 27 (1953).

13. As early as 1923, Mr. Justice Holmes expressed a desire to see Judge Hand on the Supreme Court. 2 Holmes-Pollock Letters, 114 (1941).

"Don't jump to conclusions," said the Judge. "As a Harvard undergraduate," he added, "I felt a keen desire to devote my life to philosophy. I was much impressed by William James, George Santayana, Josiah Royce and Hugo Münsterberg, then on the Harvard faculty. But so many of my forebears had been lawyers that my family expected me to follow suit. So I went into law to please them."

"Well," said I, "that's one decision you surely never regretted." To my surprise, Judge Hand said he was not sure he had made a wise choice. A reminder that he was the nation's number one judge, and could not have done better in philosophy, made little impression. That was Judge Hand. There was always a last lingering doubt about everything except a conviction that the pursuit of truth was the highest virtue. He ascribed this precept to his Harvard mentors. On his eightieth birthday, he told his fellow alumni ". . . you were in a company of those who thought that the noblest of man's works was the pursuit of truth; who valued the goal so highly that they were never quite content that the goal they had reached was the goal they were after; who believed that man's highest courage was to bet his all on what was no more than the best guess he could make; who asked no warranties and distrusted all such; who faced the puzzle of life without any kit of ready-made answers, yet trusting that, if they persevered long enough, they would find—in the words of John Dewey—that they might safely 'lean back on things.'"

Finally, a note about that much abused word "humility." The best display I have witnessed is Judge Hand's last collective letter to his law clerks—written on his eighty-fifth birthday. He wrote:

" . . . I wish I knew better than I do what the whole show is about; I wish, in short, that the years had brought wisdom, or at least a measure of illusion of wisdom. All I can see is that we do best when we think of ourselves as aiming at some constructive, some embodiment, some objective impress, in and upon the world about us that bears a resemblance to what appears to us fair and just and understanding and imaginative of others. You have all shown me examples of that purpose; most of you have already shown me successful realizations of it. I owe you more than you will be able to realize unless you too in your turn may have the good fortune to encounter youngsters like yourselves to help you over the high stiles and the craggy paths. . . ."

Since one of the main functions of The Copyright Society of the U.S.A. is to help its members and others "over the high stiles and the craggy paths" of copyright law, Judge Hand's life serves well as a guide in these adventures.

PART I.

ARTICLES

1. COPYRIGHT SYMPOSIUM ON GENERAL REVISION OF THE LAW, AMERICAN BAR ASSOCIATION Patent, Trademark and Copyright Section.

(*St. Louis, Missouri, August 5, 1961*)

Panel Discussion: "Copyright Office Recommendations for Revision of the United States Copyright Law."

Moderator: Professor Harry G. Henn, Cornell Law School.

Introductory Remarks by Prof. Henn

At this annual copyright symposium dealing with the Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law, we sorrowfully note the absence of our late friend and Register of Copyrights, Arthur Fisher, who died on November 12, 1960.

As the preface to the report attests (page xi):

"This report, and the studies that led up to it, are a testimonial to Arthur Fisher. The former Register of Copyrights . . . had planned and organized the entire general revision program, of which the studies and report are a part. Their ultimate purpose—the enactment of a new and better copyright law—was the goal of Mr. Fisher's career, and its accomplishment will be a tribute to his vision and energy."

In tribute to Arthur Fisher, The Copyright Society of the U.S.A. is planning to publish a memorial volume containing the 34 studies, the report, and a wealth of other relevant copyright materials.

Our present Register of Copyrights is the sixth incumbent of an office which was established in 1897. The six Registers have witnessed only one copyright revision. The first Register, Thorvald Solberg, who served 33 years from 1897 to 1930, witnessed the 1909 revision, and although he lived to be 97 years of age, saw no further revision.

The subject of copyright revision is complex. The report contains 172 pages, of which 12 pages are devoted to a mere listing of the recommendations themselves. Our panelists can only hit the highlights and, we would hope, interest you in reading the report itself.

Our introductory panelist is the Honorable Abraham L. Kaminstein, United States Register of Copyrights.

A résumé of the Copyright Office recommendations will be given by Abe A. Goldman, General Counsel of the Copyright Office. He was formerly Chief of Research and as such directly supervised the preparation of the 34 studies. Edward A. Sargoy, senior member of Sargoy & Stein, New York City, will discuss the recommendations relating to ownership and formalities. Formerly chairman of the Section's Copyright Division, he also served from 1938 to 1946 as chairman of the Section's Committee on Copyrights. The recommendations relating to duration will be summarized by John R. Peterson of Boston, Associate General Counsel of The First Church of Christ, Scientist. Assigned to Alfred H. Wasserstrom, a member of McCauley, Henry & Brennan, New York City, is the subject of the recommendations relating to rights and remedies. A Vice President of The Copyright Society of the U.S.A., he is presently the chairman of the Section's Committee on Copyright Law Revision.

2. COPYRIGHT LAW REVISION

By ABRAHAM L. KAMINSTEIN

Register of Copyrights

I invite you to participate in the writing of a new copyright law. If history is a reliable guide, you and I are not likely to have another opportunity to do so in our careers. The first Congress passed the original federal copyright statute in 1790 and there have been revisions in 1831, 1870 and 1909. The present law, amended slightly from time to time, is now 52 years old and is in urgent need of remodelling.

The death of Arthur Fisher, the fifth Register of Copyrights, marks the end of a particularly vital era in the history of copyright. Arthur Fisher came to the Office in 1946 as Associate Register and was appointed Register in 1951. In his nine years as Register, he established an enviable record of achievement. He was the architect of the Universal Copyright Convention, leading a long and determined drive which made the United States an adherent, for the first time, of a world-wide copyright agreement. He was vitally interested in international copyright relations and he became a symbol of the new role played by the United States in international copyright.

The Convention ratified, Arthur Fisher turned almost immediately to a revision of our own copyright law. He saw the need for a sound foundation for the effort, and he lived to see the completion of this groundwork: the 34 revision studies and their issuance as Senate Committee prints. He continued his work to the very end, speaking at the last annual meeting of this Association within three months of his death. He rebelled at a fate which would not permit him to see the enactment of a new and better copyright law. This was his goal, and its accomplishment will be a tribute to his vision and energy.

Each of the 34 studies was circulated to a panel of specialists. Their comments were studied by the staff of the Copyright Office in long meetings and we devoted a great deal of time to an analysis of each problem and the proposed solutions. This analysis was incorporated into a draft report, rewritten several times and then circulated to the panel.

After further study, the draft was revised and the *Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law* was submitted to Congress on July 10, 1961. Only a vast amount of hard work on the part of the staff enabled us to submit the Report when we did. I should also like to express my appreciation to the staff of the House Committee on the Judiciary for the amazing speed with which the Report was issued as a Committee print.

Your committee on general revision has kept in close touch with us and we hope they will continue to do so. Revision is a large undertaking. In the case of the 1909 bill, there were conferences in 1905-06, hearings in 1906-08 and finally, with a firm assist from President Theodore Roosevelt, a new copyright law in 1909. By strange coincidence, one of the works registered on November 18, 1960, when the Copyright Office registered its ten millionth application, was *THE BALLAD OF TEDDY ROOSEVELT*. If necessary, we intend to invoke the spirit of the old Rough Rider to expedite revision.

Both we and your committee have scheduled further meetings and symposia. The Report is not the final word on revision and one of its purposes is to stimulate discussion so that there will be widest possible agreement on the principles of the new law. The Report and the studies are available at the Government Printing Office. Read them and send us your comments. They will be carefully considered in the further work which must be done before a bill is prepared. We hope that a bill will be written and submitted to the next Congress.

Editor's Note: At the close of Mr. Kaminstein's remarks, Abraham A. Goldman, General Counsel of the Copyright Office, presented a résumé of the Copyright Office Recommendations contained in the Register's Report. A summary of these recommendations was printed at 8 BULL. CR. SOC. 333, Item 348 (August 1961).

3. DURATION OF COPYRIGHT*

By JOHN R. PETERSON

I am to talk on "Duration," that is, "How long should a copyright last?" Of necessity my discussion must be brief, and cannot deal exhaustively with any of the many topics involved. But it should be possible this morning to get a broad outline of the picture, to define the important issues.¹

Distinctions Between Patents, Trademarks, and Copyrights

In considering how long a copyright should last, it would be helpful to draw a clear distinction between copyrights and patents—perhaps also between copyrights and trademarks since this is largely an audience of patent and trademark attorneys and all of these subjects are interrelated in many fields. One of the officers of our section, Mr. William E. Schuyler, Jr., put the distinction very clearly to me in conversation recently. He pointed out that no one could patent or copyright the idea of a trip to the moon. A means of accomplishing the trip, if it met the various standards of invention, could be patented, and an article about such a trip, either scientific or fictional, could be copyrighted. The things used in accomplishing the trip could be trademarked, but the idea itself is not capable of exclusivity, and so cannot be protected. And rightly so.

Distinction between ideas and property. Ideas are free to all, and must be kept that way. They are not personal. Anyone can get an idea without interfering with anyone else getting the same idea, or another idea about the same thing. Ideas are not property.² In fact, they are quite different than property. The difference has been noted most cogently by someone who

* © 1961, John R. Peterson.

1. See the *Report of the Register*, on "Copyright Law Revision" herein cited as CLR.

2. But see "Rights and Writers" by Harriet Pilpel, p. 211:

"In theory an idea is not protectible. One may protect the exact words in which an idea is couched by means of copyright, but the copyright will not protect its owner from the possibility that someone else may use the same idea by means of a different set of words. Yet we live in a civilization where ideas as such may have tremendous commercial value; we have even coined a new descriptive job term—the 'idea man'. As the cases will indicate, the courts frequently protect the man who originates the idea, sometimes on the theory of unfair competition, but more often by finding that there was an implied agreement that the originator of the idea would be compensated if the idea was used."

See also *ibid.* p. 212 and case cited: *American TCP Corp. v. Strauss Stores Corp.*, 206 Misc. 1017, 136 N.Y.S. 2d 76 (N.Y. Sup. Ct., 1954), *aff'd* 285 App. Div. 1132, 140 N.Y.S. 2d 884 (1955).

once pointed out that if two men each had a dollar and each gave his dollar to the other, they would still each have just one dollar. But if each had an idea and each gave his idea to the other, they would then each have two ideas. The freer the interchange of ideas, the greater the progress of mankind. This is one of the fundamental reasons why the free world will inevitably triumph over Communism or any other form of despotism which attempts to enslave and restrict the thinking of mankind.

Experience has demonstrated, however, that creativity is stimulated by preserving a fair reward for those who think out a way to make an idea work or a way of presenting it—those who make it practical—those who give shape and body and substance to the idea. If someone spends the effort and time to invent a way to accomplish an idea, to make it work, a patent may be granted. If he takes the time and makes the effort to state the idea in words or present it concretely in certain forms, he may copyright his presentation of the idea. If he produces and sells something embodying an idea (and all things do—everything man makes is an embodiment of ideas), he may place a trademark on it to show that it was he who made it.

Duration of protection. The duration of these forms of protection is necessarily different. These differences are inherent in the nature and purposes of these forms of protection. The relatively short protection of seventeen years under a patent has been found appropriate for one who has invented a way of doing something, for during that period he has the exclusive right to that way of doing it. One who presents an idea in words or certain other forms has a much longer protection available to him, because even during that time anyone else may present the same idea in his own words or manner.³ As a matter of fact he can even present it in exactly the same way as long as he can prove that he worked out this presentation himself and did not merely copy.⁴

Protection of identification. Trademark protection is even longer—indefinitely, as long as the mark continues in use and certain formalities are complied with. This is logical, since the essential purpose of this form of protection is to identify the one who has produced the article. The independent creativity of others is not at all restricted by the protection of right identification by trademark. The only thing it restricts is deceit, and it is quite appropriate that such protection be permanent.

3. Rothenberg, "Legal Protection of Literature, Art and Music," 39 and cases cited: *Alexander v. Irving Trust Company*, 132 F. Supp. 364 (S.D.N.Y. 1955), and *Nichols v. Universal Pictures Corporation*, 45 F. 2d 119, 121 (2d Cir., 1930), cert. den. 282 U.S. 902.

4. *Dynow v. Bolton et al.*, 11 F. 2d 690 (1926).

Duration of Protection for Unpublished Writings

Protection under common law. The question of how long a copyright should last has two aspects, one for unpublished writings and the other for writings which have been made public. Let us first consider the recommendations of the Copyright Office with respect to unpublished writings.⁵ Under the common law in this country protection is perpetual as long as a writing is not published. You can pour out your innermost thoughts and comments in a letter to your wife, or a close friend, and be confident that even if someone else gets hold of the letter he will not be permitted to make copies of it and publish it and identify you with it without your consent.

Proposal. The Copyright Office proposes to Congress that after your letter is fifty years old, and provided someone had put it into a library or other archival institution for ten years or more, it will then go into the public domain and can be freely published by anyone unless you or your heirs or assigns happen to find out in time that it is in the library and register a claim to its copyright.⁶ If you do this, you and your heirs or assigns could protect it for twenty-eight years and renew this protection for forty-eight years after that. This would be a total of seventy-six years of copyright protection after the registration of the claim to copyright before anyone could publish the letter without your consent or the consent of your heirs or assigns. The original author would therefore have passed on before the letter could be forced into the public domain, provided he found out in time that it was in a library somewhere and registered his copyright in time.

Reason for proposal. Now the Copyright Office is not making this recommendation just because of an insatiable curiosity about personal letters and other unpublished writings. You notice the common law copyright is still permanent unless the unpublished writing gets into a library or similar institution. The purpose of the recommendation is to promote the public interest by making freely available to scholars and others the material in libraries which has not otherwise been published.

Element of identification. I wonder, though, if the Office may not want to give further consideration to the element of identification which is involved in unpublished writings. It is appropriate for trademark protection to be indefinite in duration in order to protect the right identification of one who has produced an article. May there not be a correlative to this, that one has the right to refuse to be publicly identified with something he has written as long as he doesn't want to publish it? It may have been intended

5. CLR 43.

6. CLR 43.

solely for one particular individual to read and to know or the author may later have changed his thinking completely on the subject, and the publication of his previous statement might conceivably be most misleading to the public as to his position on various questions.

Danger of proposal. The difficulty with the recommendation of the Copyright Office here is that any holder of the letter or manuscript can place it in a library or similar institution and thereby force it to pass eventually into the public domain in spite of any protest from its author or his representatives. The Copyright Office has carefully endeavored to balance public interest against private interests in this regard, but it may be that further consideration might well be given to the author's rights. After all, it is not the idea which he has written about which is restricted at all. Anyone is free to use the idea, and it is only his individual presentation or statement of the idea set forth in his writing which is now protected under the common law. Does the public interest really require that he be identified with it, and that his wording of it be freely published under his name? Might it not be better to require his consent, or the consent of his heirs and assigns, before permitting copying and publication? Certainly it would seem that the author or other owner of the literary property should at least be notified and given an affirmative opportunity to register his claim of copyright before the matter passes into the public domain.

Duration of Protection for Published Writings

Expiration during lifetime of author. The other question of copyright duration has to do with published writings which have been copyrighted.⁷ Here the question of how long the copyright lasts is really critical, as Samuel Clemens and other authors and composers have found out. Enough of Samuel Clemens' copyrights expired during his lifetime to inspire him to jot down a comment in his notebook which I would not feel free to quote to this meeting if I were not a copyright attorney myself and actively interested in the revision of the copyright law. His not too cryptic remark with full 19th century flavor was that "Whenever a copyright law is to be made or altered, then the idiots assemble."⁸ It also led him to comment that "Only one thing is impossible to God, to find any sense in any copyright law on the planet".⁹

Term. Our present copyright law extends protection for an initial period of twenty-eight years and an additional period of twenty-eight years if the

7. CLR Chap. V.

8. Mark Twain's Notebook, 1935 Ed. 382.

9. Ibid., 381.

copyright is renewed, a total of fifty-six years.¹⁰ The Copyright Office has proposed to Congress that the renewal period be extended to forty-eight years—a total protection of seventy-six years.¹¹ This would be most helpful to a number of authors and composers who have had to watch some of their earlier works pass into the public domain and royalties cease at a time in their lives when they most needed these royalties. Samuel Clemens was not the only one to have this experience. The noted composer of military marches, John Philip Sousa, saw a number of his best compositions written in his early 20's pass into the public domain while he was still living. And shortly after his passing a considerable portion of his royalties ceased coming to his daughter, whom he left surviving, as his other copyrights expired. There has been some talk from time to time that Congress should take cognizance of her loss of royalties from her father's significant contribution to the patriotic music of our country and award her some kind of a commemorative medal. Nothing has ever come of it, but his daughter might well consider that a longer term of copyright which would have continued her royalties would be a somewhat more appropriate and useful evidence of the country's appreciation of her father's work than a commemorative medal.

Subsisting copyrights—calendar year. The extended life would apply to all works still under copyright when the new law becomes effective.¹² All copyrights, including these, would run to the end of the calendar year in order to simplify the computation of the length of protection.¹³ All you would need to know would be the year of copyright. The exact date would not be required. Probably everyone will agree readily as to the desirability of this change.

Renewals. Two other recommendations are likely to meet with immediate acceptance. The first is that copyright can be renewed at any time within the last five years of the initial term instead of just during the last year, as at present.¹⁴ This will help reduce the danger of forgetting to renew within the time permitted. The second change is that the copyright may be renewed by anyone claiming an interest in it.¹⁵ This will automatically eliminate many of the technicalities which have caused hardship and injustice under the present law.

10. U.S. Code, Title 17, Sec. 24.

11. CLR 55, 56, 58.

12. CLR 57, 78.

13. CLR 56, 58.

14. CLR 52, 53, 58.

15. CLR 53, 54, 56, 58.

Dissemination. The question of when the term of copyright protection should start is particularly interesting. Here the Copyright Office has come forward with an interesting and constructive proposal. Our present law starts the term running upon publication. The Copyright Office points out that this was appropriate in the 19th century when copyright was concerned primarily with printed material, but that now publication is only one of several methods of public dissemination.¹⁶ It is proposed, then, that the term of copyright start to run upon public *dissemination* by any one of four methods: by publication, by registration in the Copyright Office, by public performance, or by the public distribution of sound recordings.¹⁷ Query, however—is it not going to be difficult to fix the date of the first public performance of many musical works?

Life plus 50 years. In most other countries copyright protection is for the life of the author plus fifty years.¹⁸ The term is measured from the death of the author rather than from the inception of copyright. Over the years there have been many efforts to place the United States law on that same basis, and many of us have gone on record in years past in favor of such an approach. It has never succeeded in Congress, however, and the most important argument for it, that of insuring protection to the author through his lifetime and to his heirs for a reasonable time after that, is really met by the present proposal of the Copyright Office for lengthening the term under our present system to a possible seventy-six years, although perhaps eighty-five years would be a safer period.

Several other points are involved in any consideration of a term of life of the author plus a period of years.

1. *When does the copyright end?* This is much easier to determine under the Copyright Office proposal than it would be under a term which depended on the date of the author's death. Just a glance at the copyright notice in the book shows the maximum time that the copyright can run under our present law and under the proposal, for copyright starts with that date. But if you have to find out when the author passed on you may have quite a task. The widespread destruction of life and public records in recent wars makes this literally impossible in many cases, and with the fast growing internationalization of books, periodicals, phonograph records, and other copyrightable and potentially copyrightable material, you may not even know in which country the author lived, much less the date of his death.

16. CLR 40.

17. CLR 41, 43.

18. See table, Finkelstein, *The Copyright Law—A Reappraisal*, 104 U. of Pa. L. Rev. 1025, 1046-1047 (June 1956).

The important users of copyrighted material, the larger publishers and the motion picture producers generally do not try to cut corners with their royalty payments. There have been cases where they have paid royalties to an author even when his copyright was technically invalid, and have taken other practical steps for his assistance. The Victor Talking Machine Company used its heart instead of a bookkeeping machine in arranging one of its early records. The 1909 copyright law provided for the first time for the payment of royalties on phonograph records, but only to works published after July 1, 1909.¹⁹ One of John Philip Sousa's best known compositions, "The Stars and Stripes Forever", had been copyrighted in 1897, and so was not entitled to royalties. Victor placed this march on one side of a record, and on the other side deliberately included one of Sousa's later compositions on which he was entitled to recording royalties instead of using one of his other earlier marches on which no royalties were due. "The Stars and Stripes" sold the record, and his lesser known march paid him the royalties.

However just and generous a publisher or record company or motion picture studio may be in arranging for royalties while the budget can still be planned accordingly, you cannot blame them for not wanting to be faced with a substantial claim for royalties for the first time after they have made a work successful which they thought was in the public domain. Certainty and facility of ascertainment of copyright status enables them to use many works which otherwise they could not afford to produce because of uncertainty of copyright status. The Copyright Office proposal is much superior in this regard to any term of life plus a period of years.

2. *Equal length of term.* About forty percent of all copyrighted material in this country consists of what is known as "corporate works", works prepared by employees of a corporation or institution.²⁰ Also many works are kept anonymous by their authors. In both these cases the laws of most countries which provide for a term of life of the author plus fifty years start the fifty years running from the date of publication. This would result in a much shorter term of protection for almost half of our copyrighted material. And a similar difficulty is presented in the cases of joint works in which two or more authors collaborate. The Copyright Office proposal would give an equal length of term to all works, and this does seem the fair way.

3. *Conformity with the laws of other countries.* It is true that most other countries have a term of life plus fifty years, but does that mean that if we have worked out a better system here we should abandon it just to

19. Copyright Act of 1909, 35 Stat. 1075, et seq., Sec. 1(e).

20. CLR 48.

follow their lead? The United States is by far the largest producer of copyrightable material in the world today, and if our experience has developed a better system, as many feel it has, it would be more in order for the other countries to follow our lead if uniformity is important. Actually uniformity is not as important now as it was before the Universal Copyright Convention went into effect. Before that the real argument for our adoption of life plus fifty years was to make it possible for the United States to subscribe to the Berne Convention and thereby secure greater international protection for our copyrights. Now, however, we and most of the other important countries of the world belong to the Universal Copyright Convention, and we get our international protection this way. If it still is desirable for us to join the Berne Convention, let this be made possible without abandoning a system which fits our needs.

To summarize this point, it really seems that the Copyright Office proposal for a total maximum term of seventy-six years gives our authors and composers the longer protection they need, or at least makes a good start in this direction, and does this with the least possible change in the established practices of the industries dealing with copyright protection in this country.

Advantage of renewal system. One of the most important advantages of our renewal system is that it does permit the vast bulk of the copyrighted material to pass into the public domain after only twenty-eight years. More than eighty-five percent of all our copyrights are not renewed.²¹ Under a term of life of the author plus fifty years all of these would still remain under copyright for the full term even though no one wanted the copyright.

Reversion of renewals. Within the time allotted to this subject we cannot cover all of the aspects of the duration of copyright, but one more point is important before concluding. That is the question of the reversion of the renewal period. Under the present law the copyright is supposed to revert to the author or for his benefit at the expiration of the first twenty-eight years. The reversion of copyright is supposed to help the author or composer, but frequently it does not. It is proposed that reversion be abolished, but that transfers of copyright be limited to twenty years unless they provide for continuing royalties.²² This should be welcomed by the authors and composers and should safeguard them much more effectively than does the present law. It may be, however, that a minimum should be specified for such continuing royalties so that they cannot be merely nominal.

21. CLR 51.

22. CLR 92-94.

Conclusion

These have been a few highlights of the recommendations to Congress by the Copyright Office as to how long a copyright should last both for published and unpublished writings. We hope now that you will present questions on the points in which you are particularly interested so that we can discuss these in more detail than is possible in a general summary of this character.

4. FORMALITIES AND OWNERSHIP

By EDWARD A. SARGOY*

INTRODUCTION

A. General Considerations.

There has been assigned to this panelist the recommendations of the Register of Copyrights as to "formalities" and "ownership" in his Report to the Congress proposing a general revision of the United States copyright law.

Our 52-year old federal copyright statute is obviously in need of modernization, despite the judicial engineering which has served to make it workable, after a fashion, in its application to our electronic era.

As the fruit of some 34 technical studies of various aspects of copyright over the past five years, the Register has now submitted to House and Senate his tentative views and recommendations as to what a general revision of such law should be. Some far-reaching changes have been suggested for public consideration and comment.¹

It will be appreciated that particular aspects of copyright cannot be considered *in vacuo*. Each must be treated and put into its appropriate niche as part of a general system. The desirability of change in one concept is

* © 1961, Edward A. Sargoy.

1. Prompted by a recommendation of our Section and its Committee on Program for Revision of the Copyright Law, and supported by Congressional authorization, these 34 technical studies of an historic, comparative and analytic nature were undertaken some years ago under the auspices of the Copyright Office and the inspiration and guidance of the then Register, the late Arthur Fisher. Upon the latter's death in November of 1960, the present Register, Abraham L. Kaminstein, took over the supervision of the project and preparation of the Report to Congress embodying the recommendations to be gleaned from the studies. Mr. Kaminstein pays warm tribute to the late Mr. Fisher in calling the Report, and the studies that led to it, a testimonial to the vision and energy of our former Register. On July 7 of this year, the Librarian of Congress, Mr. L. Quincy Mumford, transmitted the document to Senate and House as the "Report of the Register of Copyrights on the General Revision of the Copyright Law". On July 10, the House Judiciary Committee released it as a House Committee Print of the 87th Cong., 1st Sess., for comments and suggestions by the public preparatory to drafting legislation. The Subcommittee on Patent, Trademark and Copyright of the Senate Judiciary Committee had previously arranged for the public release of printed copies of the 34 studies, with the respective commentaries thereon by the members of the General Revision Panel and others. The studies will be referred to here as "Revision Study No. —".

likely to depend upon or require adjustments in other provisions. While this panelist is necessarily limited in the main to the recommendations concerning "formalities" and "ownership", such concepts are part of a whole structure. If, for example, a certain type of formality is to be "permissive" rather than "mandatory," but its utilization is strongly to be encouraged by otherwise withholding the availability of certain statutory remedies, one must weigh the recommendation in the light of the proposals concerning the "remedies" to be withheld. Or if it be proposed to change the concept of "authorship" so that a corporate employer for hire is no longer to be deemed the author of a work or of a contribution to a composite work, made by employees within the scope of their employment (although such employer will continue to be deemed the first owner of any such copyright), what will be the effect of the newly proposed recapture rights to be given to individual "authors" after certain assignments of their rights have been in effect for twenty years?

It is clear that each aspect of copyright must necessarily be integrated with others, and be examined in the light of its place in the whole proposed structure, as well as of its dependency upon or its effect on other individual provisions.²

B. *Formalities.*

We shall be concerned, of course, in this discussion with the concepts long recognized as "formalities" in our system, such as publication with notice of copyright, registration of the claim to copyright, the deposit of copies for the Library of Congress which ordinarily accompanies a registration, and the domestic manufacturing and *ad interim* requirements for works of foreign origin in the English language. Such publication with notice, as well as registration of certain specified classes of work³ while still unpublished, are the formal acts which create and initiate the term of statutory copyright protection. Continued placement of the notice on copies thereafter published by authority of the copyright owner is a formality conditioning the continuing validity of the copyright.⁴ On the other hand, registration (and its accompanying deposit of copies) of the claim to a copyright already secured

2. Some views of this panelist on the interdependence of basic copyright concepts are indicated in the printed Report of Committee No. 15, Program for Revision of the Copyright Law, drafted by the writer, as then Chairman, for the Section's 1957 Annual Meeting in New York City. *1957 Committee Reports of the Section of Patent, Trademark and Copyright Law, American Bar Association*, 51 at 57-68.

3. Dramatic, musical, dramatico-musical, motion picture, photographic works and works of art. Title 17 U.S.C. sec. 12.

4. Title 17 U.S.C. sec. 10.

in a work by its prior publication with notice, is a formality which is only a condition precedent to suit for infringement.⁵ Absence of such registration will not condition the validity of the copyright, unless such absence follows written demand by the Register to deposit copies.⁶

Contrasted with these formalities basic to the U.S. system for initiating and preserving statutory copyright, are the non-formality systems of most of the major countries of the world, particularly those of the Berne Union, as well as of our so-called common law in the various States law for works while still unpublished, where protection is automatic from creation without any formality.

The Register has now proposed a radical expansion of the U.S. formality for initiating copyright. This will bring into the federal statutory orbit virtually all copyrightable materials that have not been kept strictly private. This is to be accomplished by a new concept, that of first "public dissemination," which would invest a work with statutory copyright, while simultaneously divesting it of its common law rights. Such dissemination may be accomplished in various ways, such as: (1) a first authorized public performance or rendition; (2) a permissive registration of any theretofore unpublished work of any class whatever; (3) the public distribution of sound recordings; or (4) first publication in tangible copies with statutory notice of copyright thereon (as under present law).

At the Section's 1960 Copyright Symposium in Washington on "Proposals to Revise the Copyright Law" this panelist submitted a paper for "An Exclusive Federal Statutory System for Literary and Artistic Works," pointing out the confusions in the diversity of our present state and federal systems.⁷ The Register appreciated the desirability of national uniformity, through federal law in this field, and was agreeable to extending it to all

5. Title 17 U.S.C. sec. 13. *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30 (1939), rehearing denied 306 U.S. 668.

6. Title 17 U.S.C. sec. 14.

7. This panel paper by the writer was published in 8 BULL. CR. SOC. page No. 6-20, No. 1 (Oct. 1960). Pointing out (p. 8) that the manuscript of the same play or piece of music, whether "*unpublished*" and deposited in the owner's desk at home, or registered in the Copyright Office, or "*published*" with copyright notice, can be simultaneously disseminated by performance to millions for commercial purposes, via radio or television networks in many States, or be repeated via tape, film, disc, or wire recordings thousands of times in as many different places, and with Echo satellites in the future to bounce its signals in even wider circles, this panelist posed the question: "Do not fifty State boundaries, with their possibly varying internal interpretations and statutes, as distinguished from a single Federal system, become an anomaly, when judicial protection and redress may be sought for an infringing use of literary or musical property which has its damage impact in each of the States?"

works publicly disseminated, but felt that there were overbalancing reasons for preserving common law or State protection for undissemminated works until the author or his successor chooses to disclose them.⁸ The Register's proposals substantially achieve the result then proposed by this panelist, retaining for State law only those works of a private nature such as diaries, family photographs, letters, etc. which the author has chosen not to disseminate publicly. This is a reasonable limitation with which this panelist then said he would be willing to concur, although prepared to go further.

C. *Ownership.*

Concerning "ownership" we must necessarily treat with "authorship" from which it obviously stems. Then we must consider joint authorship and joint ownership, which may have differing legal consequences. A discussion of ownership also necessarily involves the matter of transfers of ownership, particularly of the many partial or divisible rights thereunder, as well as how such transfers are to be executed, and recorded for public information and guidance in a central repository. The Register has further proposed, in lieu of the present renewal system for authors and their families (which he suggests abandoning), a recapture right for authors after lump sum assignments of their rights have been in effect for at least twenty years, and continue on a non-royalty basis.

Part I.

FORMALITIES

A. *The Register's Proposals as to Public Dissemination.*

1. *First "Public Dissemination".*

The Register has felt that federal statutory copyright should continue to be initiated by a formal act, from which its specified term of years can be computed. Automatic copyright protection from creation, as under our common law and in Berne Union countries, with protection enduring until a fixed number of years after death, as in Berne, did not appeal.

However, the Register was willing to bring virtually all works into the exclusive federal domain, except those only which the author or other owner preferred to keep strictly private.

Accordingly, the Register has proposed that a first public dissemination of the work dedicate its common law rights, and invest it with federal

8. Report, 41.

statutory copyright.⁹ Such a "public dissemination" would be accomplished in various ways, as follows:

(a) *Voluntary registration of unpublished works.* Claim to copyright in any class of copyrightable work could be registered voluntarily in the Copyright Office. Heretofore, this privilege was available only to dramatic, musical, dramatico-musical, motion picture, photographic and art works.¹⁰

No statutory notice of copyright would need to be affixed to such works, until such later time as they would be publicly sold or distributed in tangible copies.

(b) *First public performance or rendition of unpublished works.* Under the Register's proposal, a public performance or rendition would initiate statutory copyright and divest common law rights, if the work has been fixed in some tangible form so as not to be deemed an oral work. Under present law this has not been the case, and owners of unpublished works capable of performance or exhibition could publicly exploit them in that manner in theatres, over the radio and television, and otherwise, under common law protection, so long as they did not publicly sell or distribute them in tangible copies.¹¹

(c) *First public distribution of sound recordings of unpublished compositions.* The Register would also apply the statute to the public distribution of sound recordings as a form of public dissemination.¹² Presumably, this would dedicate the common law rights in the *composition* so performed and recorded, and invest it with statutory copyright. This is not to say that the recording itself, in so far as the *rendition* on the sound track is concerned, is to be invested with copyright, or that the formalities of notice, registration and deposit are to be applied thereto as a copyrighted sound recording. The Register is not yet prepared to make recommendations in such regard, feeling that these are unresolved questions requiring further study.¹³

However, in so far as the song or play recorded is concerned, as distinguished from the rendition and recording, public distribution of the recording would invest statutory copyright, in similar manner as a first public performance would, and presumably no notice of copyright would be required until the work is publicly sold or distributed in tangible visual copies.

9. Report, 40-41.

10. Title 17 U.S.C. sec. 12.

11. See Strauss, Protection of Unpublished Works, Copyright Office Revision Study No. 29.

12. Report, 41.

13. Report, 17-18.

(d) *Mandatory copyright notice for published copies.* Where the first public dissemination of a work is by the public offering of tangible copies for sale or distribution, our so-called typical "publication," the Register proposes the retention of the mandatory requirement of statutory notice of copyright to be affixed on every copy then and thereafter published by or under the authority of the copyright owner.

Similarly, if statutory copyright is initiated by other forms of public dissemination, such as registration, performance, or distribution of sound recordings of works, otherwise unpublished in tangible copies, and requiring no copyright notice while in such state, the Register proposes that the notice must be mandatorily affixed when any such work is later published in tangible copies.¹⁴

2. *Why the Copyright Office Supports a Mandatory Copyright Notice.*

The Register indicates his appreciation of the fact that authors, publishers and other owners have long been critical of our notice system, particularly because of its effect in throwing many works unintentionally into the public domain through errors, omissions, carelessness or lack of knowledge as to the appropriate fixing of a proper form of notice. At the same time, the Register feels that many users of copyright have liked the notice system, because it gives them a quick lead of some sort toward identification of the person with whom they may have to deal for rights, and the date in the notice will help to indicate the date of copyright expiration.¹⁵

3. *Proposals as to Requirements of the Notice.*¹⁶

(a) *Content and position.* The Copyright Office proposes a notice similar to that provided by the Universal Copyright Convention. This will mean the use in every instance of either the word "copyright" or the symbol ©, accompanied by the name of the copyright owner, and the year date of first publication. These are not now all required for all classes of work.¹⁷ As to

14. Report, 63-64; Revision Study No. 7 of November, 1957, on "Notice of Copyright" by Vincent A. Doyle, George D. Cary, Marjorie McCannon and Barbara A. Ringer. See also, Revision Study No. 8 on "Commercial Use of the Copyright Notice," by W. M. Blaisdell; Revision Study No. 9 on "Use of the Copyright Notice by Libraries," by Joseph W. Rogers.

15. Report, 62-64.

16. Report, 64-67.

17. Works presently registered in classifications (f) to (k), for example, need only the symbol © accompanied by the initials, monogram, mark, or symbol of the copyright owner, without the year date, provided the owner's name appears on some accessible portion of the margin, back, permanent base or the substance on

its position, it may be "placed in such manner and location as to give reasonable notice of claim to copyright," rather than in the arbitrary positions provided by present law.¹⁸

(b) *Collective works.* As to collective works, a single notice is to suffice for the work as a whole, as well as for its individual component parts, even if the component parts were previously copyrighted (but without extending the copyright term for such previously copyrighted component works). In dealing with the public, the person named in the notice would act as Trustee for others having rights in the component works.

(c) *Year date.* The year date would now be required for all classes of published works. Such year date would be that of first publication in tangible copies, *even though copyright may already have been secured in an earlier year* for the same work while it was in its unpublished stage, by voluntary registration, or by public dissemination, or distribution of sound recordings.

The Register feels that this year date requirement, giving the year of first publication in copies, rather than first inception (as under present law), would be useful in connection with the proposed new terms of copyright in those cases where statutory copyright is secured for an unpublished work, by either public performance or voluntary registration. The term is twenty-eight years from either of the latter events, subject to the securing of an additional term of forty-eight years by the then copyright owner, or owner of the right, filing a renewal application during the last five years of the first term. If the work is later published in copies during the original term, but is not renewed, copyright will terminate twenty-eight years from the date of such first publication in copies. To that extent, utilizing the date of publication in the copyright notice will serve to indicate the possible termination date of the term of such copyright, provided the copyright was not renewed.¹⁹

4. *Proposals for Relaxation of Penalties for Errors and Omissions.*

If notice is omitted inadvertently from a few copies, but other copies bear the notice, the Register feels there should be no invalidation of copyright.

If omitted inadvertently from a substantial number or an entire edition, he proposes that the copyright is not to be invalidated if a copyright claim is

which mounted. The year date must be included for printed literary, dramatic or musical works. Title 17 U.S.C. sec. 19. For U.C.C. protection, the symbol © must be used instead of the word "copyright."

18. As to present requirements for position, see Title 17 U.S.C. sec. 20.

19. Report, 66. As to the Register's proposals concerning "Duration" and "Renewal," see Report, 45-58.

registered before, or within one year, after publication of the copies without notice; and a statement of the circumstances of omission is filed within the one-year period.

In any event, an innocent infringer misled by the omission of notice, is not to be liable for an infringement begun before actual information that a claim has been registered, and is not to be enjoined from completion unless fully reimbursed for his outlay.

5. Proposals Concerning Erroneous Name or Date.

Such will not invalidate the copyright, according to the Register, but any person not actually informed otherwise should be entitled to act on the assumption that the name and date in the notice are correct; further, where the year date is more than one year later than the date of first publication, the claimant should be required to record in the Copyright Office, within one year following the publication of copies bearing the later date, a statement showing the correct year date and the circumstances in which the later date was given.

6. Proposals Concerning Notices with Separated Name or Date.

If there is a copyright notice or symbol, with one or more names or dates in the copies but separated from the notice or symbol so as not to be clearly identified as a part of it, the copyright is not to be invalidated, but certain presumptions should be established as to the name or date to be considered part of the notice.

B. Commentary on the Register's Proposals as to Public Dissemination.

1. First Public Dissemination.

This panelist is heartily in accord with the Register's efforts to eliminate the duality of our present federal and state systems, to the extent of bringing into one federal orbit at least all copyrightable works which are publicly disseminated.

As to a first public dissemination being the formal act which will initiate federal statutory copyright, and divest common law rights, the Register weighed the possibility of a term of copyright determinable by a fixed number of years after an author's death, when all of his works would fall into the public domain simultaneously, as in most other countries. The Register, however, felt that it might be more difficult for the public to ascertain an author's death date, than to ascertain the date on which he first publicly disseminated each or any of his works. There may be considerable differences of opinion in such re-

gard.²⁰ Furthermore, the Register points out that death date reckonings would not be available for the very substantial body of important works created by employees for corporate owners, or created by anonymous authors, so that a fixed period of years from a date of inception would nevertheless be needed for these works so created. The Register felt that in the interest of uniformity of term for all, there should be one method of computing term, namely a fixed period of years after the first public dissemination, with the period sufficiently lengthened to be substantially equivalent in effect to the term in foreign countries.

Accordingly, the date of first public dissemination has been made the proposed criterion as the date of inception from which to compute the copyright term.

2. The Value of Mandatory Notice May Have Been Overrated.

While the presence of a copyright notice may be of some assistance at times to potential users in so far as it may give a lead or starting point in tracing the present owner of the particular right of use in a "published work" for which the user would require an appropriate license, it is by no means the final or effective answer. It merely shows that at one time there was an apparent claim of copyright in the work by some one. The name in the notice need not necessarily be that of the present owner of the copyright, nor need it be that of the exclusive licensee of the particular right sought. Under the new principle of "divisible ownership" elsewhere proposed in the Report, the person named in the notice may be that of a partial owner of the total copyright, or an exclusive territorial licensee concerned with rights other than those in which the prospective user is interested.

Mandatory "notice of copyright" was workable to reasonable extent with our present system of so-called "indivisible" copyright. Will it work as satisfactorily under the proposed "divisible" copyright? Will the errors or omissions, as to notice, of the original paramount owner, or of a sub-owner of a divisible portion, affect the divisible owner or owners of other rights, whether derivative, partial or collateral?

Coupled with this is the fact that correctible errors or ambiguities in name and date in the notice, or the accidental omission of notice from some copies, will not serve to prejudice the copyright, and that where notices are wholly

20. It would seem infinitely easier to ascertain from family, friends, or township authorities at his last residence the date of death of a song composer, for example, than to ascertain the fact and date of the first performance of each of his hundreds of compositions at a long defunct night club, cabaret or radio station over some forty to fifty years of his composing career. For the proposals as to Duration and Renewal, see Report, 45-58.

omitted or grossly in error, because of the faulty attempt in performance by a licensee to respect his licensor's strict and proper instructions, the user still has to obtain appropriate clearance from the source actually controlling the exclusive right to his particular prospective use.

It is when the work has been "*published*" in copies, and then only, that the presence of the mandatory notice of copyright is called for, and would seem to offer some slight advantage to the public. Such would only be a tentative and often uncertain lead for the further necessary search for the recorded or unrecorded owner of the particular right sought to be cleared.

Prospective users who intend to make investments in the work or a right thereunder have long been accustomed to make their necessary searches, while the work was under common law, or protected by the present statute through registration as an unpublished work, to ascertain the proper person from whom the necessary clearance must come, despite the absence of copyright notice. Potential users of rights under copyright are not necessarily pleased to see that copyright notice errors may have invalidated a copyright, so as to make it freely available. Users who will make substantial investments in a particular right, often will do so only if an "exclusive" right can be obtained, and thus desire to find a valid copyright in their search.

It would appear to this panelist that the Copyright Office perhaps overrates the value of a mandatory "notice of copyright," under a divisible copyright system, in so far as it makes the clearance task of the prospective user substantially easier. Despite the proposed relaxation in the provisions with respect to inadvertent omissions of notice, and errors and ambiguities as to date and name in the notice, this mandatory formality can seriously affect the copyright status over the long 76-year term. Certain errors must be corrected within a year by appropriate statement to the Copyright Office. Often the user will have to deal with persons named in the notice who are merely technical "trustees" of unknown other rights for unknown other persons under the same copyright, when the divisible system goes into effect.

It would seem that the primary basis for the Copyright Office's proposal is its feeling that there be no uncertainty as to the public domain status of a large bulk of "published" materials, for which copyright is neither desired nor claimed, and as to which the Copyright Office admits there would ordinarily be no commercial or exploitation value. These are such materials as circulars, corporation and society reports, manuals, pamphlets, newspapers, scholarly and scientific informational matter. Failure to affix notice would generally indicate such public domain status, according to the Copyright Office, although some search would still be necessary.

Most foreign countries have found the concept of "notice" unnecessary, and have apparently experienced no major difficulties over the generations in the assumption that every work is protected from creation without formality,

whether published or unpublished. Their authors do not expressly have to lay claim to any such work. If it be valueless or unexploitable, the occasions ordinarily do not arise for infringement action. *Reliance on registration and recordation would probably be much more effective than upon copyright notice.*

This panelist would not have found difficulty in accepting this foreign view, as to its needlessness, and has also indicated on prior occasions that "notice of copyright," if desired, could be made "permissive" to the extent of the statute affording more attractive remedies as an inducement to its utilization.²¹ Might not a denial of the availability of statutory damages, for example, to those who omit proper copyright notice on their published copies, serve, under a permissive system, to encourage the use of notice in the case of the small rights, where users apparently find some usefulness in it, and where such damages would usually be the basic claim. This might serve to avoid loss of copyright in its entirety, through errors or omissions incapable of timely correction.

C. *The Register's Proposals as to Registration.*²²

1. *The Purpose of Registration.*

The Copyright Office proposals retain the basic concepts of our present registration system, substantially expanded, coupled with very powerful inducements to an early voluntary registration.

As pointed out by the Register, a central public registry, as distinguished from the registry systems of private groups utilized in many foreign countries, has many values, not only to authors and owners, but as well to users, and to potential transferees. It provides an official record of copyright claims, proof of existence of the work at a particular time, and *prima facie* evidence of the relevant facts through the certificate of registration. It provides accessible official records from which users can obtain information as to the existence, basis and extent of a claim under copyright, its duration and initial ownership, as well as a chain of title. It provides a means for automatic deposit of copies for the Library of Congress, and an administrative review of the nature and scope of the claim, to weed out the wholly worthless or unfounded.

21. See 1957 Report of Committee No. 15, *op. cit.*, footnote 2, at 60-63. See, also, commentary by this panelist to Copyright Revision Study No. 7, "Notice of Copyright," *op. cit.* footnote 14, at 54.

22. Report, 69-77. See, also, Copyright Revision Study No. 17, "The Registration of Copyright," by Professor Benjamin Kaplan; Copyright Revision Study No. 18, "Authority of the Register of Copyrights to Reject Applications for Registration," by Caruthers Berger.

2. *The Present Registration System.*

While our statute calls for "prompt" registration and deposit of copies for the Library, after a work is published with copyright notice, as well as "prompt" deposit of copies after publication if the work was previously registered as an unpublished work, such deposit and registry requirement, under the *Washingtonian* case,²³ was deemed not to affect copyright validity, or to avoid prior infringements, but to act only as a condition precedent to suit for infringement. It was only if there was not a timely compliance with a written demand by the Register for deposit of a published work, that the copyright would be voided, and the copyright owner would be subject to fine.²⁴

The certificate of copyright registration was utilizable, regardless of the time of registration, as *prima facie* evidence of the facts therein stated.²⁵

3. *The Proposed Registration System.*

This is still to be permissive rather than mandatory, with powerful inducement, however, to early registration.

In so far as deposit of copies for the Library of Congress is concerned, registration will ordinarily produce the desired deposit, but since registration is voluntary, the Copyright Office feels that a deposit *must* be made mandatory. This will be later discussed.

Registration will of course preserve the inherent value of the registration record to the owner, as well as provide the *prima facie* proof afforded by the registration certificate. The Report indicates this is not enough.

a. *Inducements to Registration.*

(1) *Non-timely registration.* If not registered within three months after first public dissemination (six months if abroad), it is proposed that the owner may recover only the actual damages suffered by him and neither statutory damages nor profits of the infringer. It is further proposed that there be merely discretion in the court as to whether it will enjoin future infringements, or the completion of an infringing undertaking commenced before registration, or order the impounding and destruction of infringing articles (but only on condition that the infringer's outlay be fully reimbursed).

(2) *Infringement after late registration.* It should be noted that registration at any time will be sufficient, so as to afford full remedies, as to any infringement commenced after the registration, but if registration is within

23. *Supra*, footnote 5.

24. Title 17 U.S.C. sec. 14.

25. Title 17 U.S.C. sec. 209.

the stated statutory three-month period, it is immaterial when the infringement commenced.

(3) *Attorneys' fees, costs and criminal penalties to be available.* The Register would provide for the continuance of attorneys' fees and costs to the prevailing party; also, criminal penalties for wilful infringement for profit, despite the absence of registration.

b. *U.C.C. Exemption.*

To comport with the spirit of the Universal Copyright Convention, it would be preferable, according to the Register, to continue the provisions of §9(c) of our present statute exempting U.C.C. works from any consequences of failure to register, except only as to require it as condition precedent to suit. Thus U.C.C. works would have full statutory remedies, despite non-registration prior to infringement.

c. *Testing a Registration Refusal.*

In the event that registration is refused, the Register recommends departure from the doctrine of the *Vacheron* case,²⁶ which requires the U.S. District Court to reject an infringement action until the registration refusal is settled by a mandamus suit against the Register. The Register proposes to permit the question of the Register's refusal to be raised in an infringement action to which the Register could be given the opportunity to participate.

d. *The Copyright Certificate.*

The Register proposes to continue the provision that the certificate may be admitted in any court as *prima facie* evidence of the facts therein stated. However, he proposes to change present law by permitting such *prima facie* probative effect only if the work be registered *within one year* after the first public dissemination; otherwise, for later registrations, its probative effect is to be left to the discretion of the court. This indeed would be a powerful inducement to early registration.

e. *Authority of the Register to Reject.*

The Register seeks specific authority in the statute for what is now unsaid, but which he believes is clearly implied, namely: (1) the Register shall be required to make registration if the claim appears to be valid, and procedural formalities have been complied with; and (2) he is authorized to refuse registration, subject to appropriate judicial review, for any claim found invalid.

26. *Vacheron & Constantin Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F. 2d 637 (2d Cir. 1958).

D. *Commentary on the Register's Registration Proposals.*

It is likely there will be substantial general approval to the Register's general approach to registration, although there may be differences of opinion as to the degree of particular recommendations.

1. *Probative Value of the Registration Certificate.*

The probative value of the certificate, at least as *prima facie* evidence, is a very vital consideration. It is even more so in a formality system such as proposed, where copyright may be initiated, for example, by a public performance or rendition, or a first publication of tangible copies with the statutory copyright notice. The occurrence and date of such acts are vital. Further, the notice must continue to be affixed to copies published by or under the authority of the owner, throughout the life of copyright.

When the life of the copyright, under the new proposals, may be 76 years, and probative testimony or other evidence in all likelihood will be unavailable in the late years to establish these facts, among others necessary, the restriction of the only available presumption (and that a *prima facie* one as to the facts stated in the registration certificate), to a certificate of a registration made within the first years, might seem unduly severe. There is no such restriction under present law.

Other countries are much more liberal in their presumptions. In Canada, if the existence of the copyright is put in issue in an infringement action, the work is "presumed" to be one in which copyright subsists, unless the contrary be proven.²⁷ If the work be registered, the certificate of registration is *prima facie* evidence that copyright subsists in the work, and that the person registered is the owner of such copyright.²⁸ In the United Kingdom, there are even more liberal "presumptions" to be drawn in an infringement action, as to the subsistence of copyright, of authorship, of ownership, of the time and country of first publication, etc., unless the contrary be shown by the defendant.²⁹ There should be more liberality in our presumptions.

2. *Penalties for Untimely Registration.*

Since a registration must be made, at least prior to suit, some questions necessarily arise as to the proposed effect of a late registration, that is, one not made within three months after first public dissemination, or if later, at least prior to the commencement of infringement.

27. Canadian Copyright Act, Rev. Statutes Canada, 1952, ch. 55, sec. 20[3][a].

28. *Ibid.*, sec. 36[2].

29. United Kingdom Copyright Act 1957, 4 & 5 Eliz. 2, ch. 74, sec. 20.

(a) *Limiting the availability of remedies.* The Register would allow the recovery only of actual damages. He would put *at the discretion of the court* injunctive relief against continuance of the infringement, or against threatened new infringement, or seizure, impounding and destruction of the infringing articles or devices. The present statute makes no such provision as to discretion, if a suitable case is made for injunctive relief, seizure and destruction. Statutory damages, or the infringer's profits would not be allowed.

Except for statutory damages, these are all remedies which a common law owner, particularly of an unpublished work capable of commercial performing exploitations, such as a drama or dramatico-musical work has today. He can obtain his actual damage. He can obtain injunctive relief, and incident thereto an accounting of profits, seizure, impounding and destruction. This he can obtain without any formality of registration, and perpetually so long as he does not publish in tangible copies. Unless there are overriding advantages elsewhere in the proposed law, such owners might be reluctant to a change whereby the first public performance dedicates their common law rights, by throwing them into a statutory federal system requiring a timely registration as the price of preserving the equivalent of their common law remedies.

(b) *Try-out or preview public performances.* Furthermore complications might well arise out of this three-month registration requirement. A song writer tries out his first draft at a public performance at a night club, or a playwright has a pre-New York try-out performance in summer stock or on the road, or a motion picture is given public sneak previews to test audience reaction. Changes are made from week to week, and tested by public disseminations, before a so-called final version is released, or registered, or published with notice. Ordinarily, the last version would be considered the final work, to be protected by copyright (the prior versions having been fully protected heretofore under common law without the formality of registration or notice). Possibly, the basic creative work of authorship is in the first draft or print publicly disseminated, the later versions containing primarily refinements, embellishments or small modifications.

Under this new system, every version, from the preliminary and intermediate try-out drafts to the finally released work, is dedicated, in so far as future common law protection is concerned, and is protected exclusively by federal statutory copyright. Should every version then be registered within three months after its dissemination, or at least prior to any infringement, to insure that the full statutory remedies, including those previously available at common law, will be available against an infringer in the later years of copyright who might prove that his access was to a public performance of an unregistered version?

It would seem, under the proposed system, that the owner who heretofore sought statutory copyright, if at all, by registration or publication with notice, of his final tested version, would be prudent in making a timely registration at least of his first version, probably containing the basic elements of his creation, within the three month period after its first public dissemination, and possibly to make timely registration of each publicly disseminated new version thereafter. Indeed, he need not wait for the disseminations, but might register them prior thereto.

E. *The Register's Proposals as to Deposit of Copies.*

1. *Deposits under Voluntary Registration.*

The Register recommends that the deposit of two copies of the best edition of a published work be continued where registration is sought.

However, the Register asks statutory authority to make administrative regulations, subject to approval by the Librarian of Congress, to make exceptions with respect to undesired copies, such as those which are bulky, unwieldy, fragile or hazardous, as well as to accept substituted identifying materials.

The Register also recommends the retention of the provisions permitting foreigners to deposit two copies, in lieu of payment of the fee, on registration, which has proven very useful in obtaining foreign deposits. He would eliminate the present requirement in such cases for a catalog card which is useless.

2. *Deposit to Be Mandatory, if Unregistered.*

Where registration is not sought, the Copyright Office wants a *mandatory* deposit, within three months after publication in the United States, rather than the present provision for "prompt" deposit. It is understood that registration, however, is not to be made mandatory. It is proposed that failure to deposit within three months after written demand by the Register shall subject the copyright owner to a fine of \$200 (presently \$100), plus the retail price of two copies.

The Register is not prepared, however, to request at this time, continuation of the present copyright forfeiture provision under sec. 14 of Title 17, for failure to comply with the Register's written deposit demand. He points out that such forfeiture would be inapplicable in any event to a claimant here under the Universal Copyright Convention. In many foreign countries, penalties are imposed for failure to deposit copies for governmental libraries or registries, but forfeiture of copyright is not one of them, since such a requirement would affect their concept of copyright as an automatic system not subject to formalities conditioning the right.

3. *Mailing Requirements and Disposition of Deposits.*

The Register suggests the elimination of present requirements for a postmaster's receipt on mailing, and for free mailing of copyright deposits. He advocates retention of the present provision for the disposition of deposits not transferred to the Library of Congress, except for the deletion of a requirement that notice be printed in the catalog of Copyright Entries before destroying deposits of published works.

F. *Commentary on the Register's Proposals as to Deposit.*

It is the view of this panelist that the Register's proposals are well taken and should meet with general approval. It is further felt that there should be no forfeiture of copyright for failure to make the requested deposit, such conditioning of copyright being a concept to which this panelist is opposed in principle.

G. *Elimination of the Domestic Manufacture Requirement.*³⁰

The Register would entirely eliminate the present requirement of the manufacture of books and periodicals in the United States as a condition of copyright, and the related provisions dealing with affidavits of such manufacture, *ad interim* copyright, and importation prohibition. These provisions, incidentally, have not been applicable to any Universal Copyright Convention claimant from a foreign country seeking protection in this country since 1955, when the Universal Copyright Convention became effective as to the United States.³¹ The Register would continue in substance all present exemptions enjoyed by foreign works that qualify under the Universal Copyright Convention.

Under our present statute, books and periodicals of *foreign origin, in the English language*, must be manufactured in the United States, as well as lithographs and photo-engravings. Their importation is prohibited if manufactured abroad, except that up to 1500 copies may be imported during an

30. See Revision Study No. 32, "Protection of Works of Foreign Origin," by Arpad Bogisch. The recommendations of the Register are in the Report, 113-124. The provisions of our present statute concerning domestic manufacture, *ad interim* copyright, prohibition of importation of such copies, are in Title 17 U.S.C. secs. 16, 17, 18, 22, 23, 107.

31. For a detailed analysis, see the articles by this panelist: "UCC Protection in the United States: The Coming Into Effect of the Universal Copyright Convention," 33 N.Y. Univ. Law Rev. 811-856 (1958); "The Coming Into Effect in 1955 of the Universal Copyright Convention: A National Report for the U.S.A.," submitted to the International Academy of Comparative Law for its Fifth International Congress (Brussels, 1958), and printed in 5 BULL. CR. SOC. 177 (1958).

ad interim period of five years, by a registration in the Copyright Office within six months after first publication abroad. Such *ad interim* copyright may be extended to a full term if an edition is manufactured in the United States within the five year period. However, by an oversight, this *ad interim* provision was not made applicable to United States citizens to permit such importations of their non-English language books if printed abroad, when our statute was amended in 1955 to permit such importation for their English language books.

If protection of the United States printing industry is necessary, the Register feels it should be under laws other than copyright, and would eliminate all domestic manufacture requirements. It is believed that the Register will find general support in this view except perhaps from some phases of the printing industry.

PART II

OWNERSHIP

The Register's proposals³² in respect of the authorship, ownership, joint authorship, co-ownership, transfer and recordation of rights under copyright (divisibility) as well as for recapture rights by authors who have transferred their rights, involve new and far-reaching concepts.

Generally speaking, these matters fall into and will be taken up in five categories, as follows:

- A. Initial ownership, stemming from authorship, with the problems of "works made for hire," and composite or collective works.
- B. Co-ownership of the work as a whole stemming from joint authorship as defined by the Register, as contrasted with co-ownership of the whole or various of its divisible parts stemming from inheritance or inter-vivos transfers to two or more persons; and the problem of licensing by one co-owner.
- C. The transfer of ownership, or particular "divisible" rights thereunder, and the protection of authors against unremunerative transfers on a non-royalty basis by recapture rights after twenty years.
- D. The execution of transfers.
- E. The recordation in the Copyright Office of transfers to divisible rights as constructive notice, and provisions as to the names of transferees in the notice of copyright.

32. Report, 85-97.

A. *Initial Ownership.*

1. *Authorship.*

All rights of ownership stem, of course, from creation of the work by the author. From the moment of creation and until publication, he has common law literary property rights in his work.

The author, of course, would first be entitled to secure statutory copyright. Any other claimant seeking to secure copyright, must acquire the undedicated common law right from the author, either by inheritance or inter vivos transfer, and will then be eligible to secure copyright.

There have been two important provisions, however, in the present law, which must specially be considered: (1) the employer, in the case of "works for hire," has been deemed the author;³³ and (2) in the case of a composite or collective work such as an encyclopedia or periodical, the publisher has the right to secure copyright.

a. *Works made for hire.*³⁴

The concept of an employer for hire being the author, in our statute since 1909, has been a significant feature of our system, particularly for works such as motion pictures, dictionaries, etc., which are the composite or collective product of many employees.

The Register points out that at common law, as well as under the statute, ownership of works produced by employees in the course of their employment, are vested in the employer, since the work is produced on the employer's behalf and under the employer's direction, the employee is paid for the work, and the employer pays all costs and bears all risks.

(1) *The Register's proposal as to works made for hire.*³⁵

The Register has accordingly proposed to preserve the principle that the employer shall be the first entitled to secure statutory copyright, but suggests that the employer no longer be characterized as the "author."

(a) *As to limiting the employer's right.* In reply to the suggestion that the employer secure the exclusive right only for the particular medium for which the work was prepared by the employees, leaving other media of exploitation to the employees, the Register sees many practical difficulties in any proposal to divide the rights by a statutory formula. Controversial issues, he points out, could frequently arise as to the scope of the employer's business,

33. Title 17 U.S.C. sec. 26.

34. See Revision Report No. 13, "Works Made for Hire and on Commission" by Borge Varmer.

35. Report, 85-87.

and as to the degree of competition between his business and particular uses of the work. It would be unworkable in the common situation where the work is the composite product of many employees, and it would be difficult for potential users to know with whom to deal.

Motion pictures, for example, are often produced by corporations, through a host of employees of diverse creative talents involving script and screen play writers, directors and producers and their assistants, editors, cutters, set and costume designers, directors of photography and special photography, creators of special visual and acoustic effects, color artists, actors, musicians, etc. etc. The motion picture producing corporation is often also engaged or interested in allied fields, such as recordings, radio and television presentations, stage play productions, publication of books based on the motion picture production.

The Register reasonably points out that where employees are in a position to bargain, they can do so for a share of the revenue from subsidiary uses, and where they are not, would gain little or nothing from having rights which their employers could require them to assign.

(b) *Clarifying "works made for hire."* So that it will be clear, as the courts have indicated, that the present statutory words, "works made for hire" are not intended to cover works made on special commission, and that an employee owns the right in any work created on his own time and initiative outside the scope of his employment, the Register proposes that works in which the employer is to have the right to copyright should be defined as "works created by an employee within the regular scope of his employment."

This appears a reasonable suggestion.

(c) *Eliminating the characterization of employers as authors.* In proposing, as above indicated, to continue the concept that "the right to secure copyright vests in the employer" while suggesting discontinuance of the present statutory characterization of such employer for hire as an author, the Register presumably proposes to continue to consider such employer as if the employer were the original author, in so far as the securing and retention of all other authors' or owners' rights under the statute are concerned.

What might be the consequences of such a proposal? An author there must be, under the requirements of Art. 1, Sec. 8 of the U.S. Constitution. If the employer for hire is no longer the author, then presumably authorship must be in that host of employees whose creative talents in the course of their employment contributed, for example, to the motion picture copyright. Their contract of employment is presumably the instrument of transfer to the employer, as owner, of any rights stemming from their individual contributions of authorship.

If the renewal system of the present law were retained, there would obviously be immediate difficulty. The renewal right would vest in the

individual authors, or their widows and children, etc., rather than in the employer for hire as at present. However, the Register proposes to change the renewal system so as to vest the right to renewal during the last five years of the first twenty-eight year term in the *then owner of the copyright or of any right thereunder*. This would permit the employer for hire, if he still owns the copyright, to renew.

But the Register has also proposed that transfers of rights by an "author" shall not be effective for more than twenty years from the date of execution, unless the transfer agreement provides for the continuing payment of royalties based on the uses made of the work or the revenue derived from it.

It would seem that no such recapture or re-negotiation privileges are intended for employees in the case of works made for hire; otherwise the confusion would be compounded.³⁶ The situation should be clarified.

Since apparently no consequences are in contemplation for employers for hire, in so far as future copyrights are concerned, which would be inconsistent with the employer being deemed an author, with all rights under the statute of an author, it would seem preferable to retain the present characterization of an employer for hire as the author, and thereby avoid unintended effects and consequences of leaving the authorship status *in limbo*. The definition, of course, might well be refined as above suggested by the Register, so as to limit the works to those created within the regular scope of employment.

2. *Periodicals, Encyclopedias and Similar Composite Works.* The publisher or employer would be entitled to copyright in the contribution of editing or arranging a collection of contributions by different authors, as well as to copyright in the individual contribution if made by an employee in the course of his employment.

However, if the individual contribution in the collective work was created by an individual author prior to or outside of any employment, the publisher can only own the same by assignment from the prior owner.

a. *The Register's proposal.*³⁷

The Register proposes that the copyright secured in the composite work by the publisher shall protect all such component individual contributions, without the necessity to separately copyright the latter, but that the publisher

36. It would be startling indeed for the producers of such motion pictures as "Gone With the Wind," "Around the World in Eighty Days," "Ten Commandments," "Ben Hur," "Spartacus," in which millions were invested, and which will have periodic recurring releases over decades, to find that they could be stopped in a release twenty years later by any one of the many contributing employees, regardless of the amount of his contribution, in order to negotiate a future royalty arrangement for such employee.

37. Report, 87-88.

shall be deemed to hold in trust for such individual author all rights in his contribution, except a right to publish it in a similar composite work and except for any other right which the author has expressly assigned.

B. *Co-ownership*.³⁸

As the Register points out, co-ownership means that two or more persons own a copyright, or any right or rights therein, acquired either by joint creation, transfer inter-vivos, or by devolution from a decedent owner, or by being members of a class entitled to a renewal copyright.

It differs from "divisibility" which concerns the ownership by different persons of different rights in a work.

1. *Rights of Co-owners*.

The present statute says nothing about the rights of co-owners among themselves. The Register feels that American courts have adjudicated such rights as permitting any co-owner to use the work, or license its non-exclusive use to third parties, without consulting other co-owners, subject only to accounting to the other owners.³⁹

However, since no assignee or licensee of less than all the owners would acquire "exclusive" rights, the Register feels that it is in the public interest not to disturb the rules established by our Courts, and sees no need to re-state them in the statute.

Pointing out that the rule is otherwise in the United Kingdom and other foreign countries, where the consent of all co-owners must be obtained to any use or license, the Register feels that the American rule encourages the dissemination of copyrighted works and is in the public interest.

The proposals of the Register appear reasonable.

2. *Joint Authorship*.⁴⁰

The Register believes that the question of what constitutes "joint authorship" should be clarified in a new statute, particularly because of the uncertainties and inappropriate results created by the "Melancholy Baby"⁴¹ and "Twelfth Street Rag"⁴² music cases.

38. See Revision Report No. 12, "Joint Ownership of Copyrights," by George D. Cary. The Register's proposals are in Report, 88-91.

39. See cases, footnotes 41, 42, and 43, *infra*.

40. The Register's proposals are in Report, 89-90.

41. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F. 2d 406 (2d Cir. 1946), *cert. den.* 331 U.S. 820.

42. *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 223 F. 2d 252 (2d Cir. 1955).

In earlier cases,⁴³ the courts had indicated the test was whether the individual authors had contributed their portions *with the object of having their contributions combined into a single integrated work*, even though they could be used separately, and they did not work together. The Register points to the case of a composer of music and writer of lyrics, which could each be used independently, intending to integrate their contributions as a song, for which separate copyright could be obtained in the name of both as a work of joint authorship. Under the new theory which emerged in the above mentioned cases, intention by the individual authors to merge their contributions into a new single work was unnecessary. In the "Twelfth Street Rag" case, the composer of an instrumental piece of music assigned his copyright to a publisher. The latter commissioned a lyricist to write words for the music. The two authors separately assigned their renewal rights in the song to different publishers. There was no collaboration, and the composer did not consent to the addition of words to his music. The Court held, nevertheless, that the song constituted a single work of joint authorship, and the assignees of each author became co-owners of the renewal right in the song.

Among the consequences of this doctrine, according to the Register, is that the author who may never have been aware of the new contribution to his original work which might no longer be in his control, becomes an owner of the new so-called joint work, with power to use or license its use, and share in its profits—and would so continue even after the copyright in his original work expired.

a. *The Register's proposal.*

The Register recommends, and the proposal appears reasonable, that a "work of joint authorship" should be defined in the statute as a work created initially by two or more authors with the object of integrating their contributions into a single work.

C. *Transfer of Rights (Divisibility).*⁴⁴

1. *By Inheritance.*

Except for the author's right of renewal under present law in the twenty-eighth year, which passes to his widow and children, or his executors, or his next of kin, in that order, if he then be deceased, regardless of the author's wishes or his testamentary dispositions to the contrary, copyright and rights

43. *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F. 2d 266 (2d Cir. 1944).

44. See Revision Study No. 11, "Divisibility of Copyright," by Abraham L. Kaminstein, with supplements by Lorna G. Margolis and Arpad Bogsch.

thereunder of the owner pass to his legatees or distributees under state law, as any other form of personal property.

a. *The Register's proposal.*⁴⁵

The Register does not propose to change such descent and distribution, except that he proposes to provide an option to renew the copyright in the last five years of the first term of twenty-eight years *to the then owner of the copyright or of a partial right therein*, for an additional term of forty-eight years. Such renewal right would pass like any right under copyright or personal property to the owner's legatees or distributees under state law, and the present statutory succession of the author's widow and children, executors, next of kin, etc. to the renewal right, would be eliminated.

The Register's proposal for elimination of the present renewal system for the author, or his family, will be discussed by another panelist under Duration.

2. *By Inter-vivos Transfers.*

a. *Difficulties under the present indivisible copyright.*⁴⁶

The present law, predicated upon the indivisibility of copyright, with its confusions and uncertainties as to the distinction between assignments and licenses, requires clarification.

Provisions as to transfers of ownership and their recordation refer only to "assignments," and it is uncertain whether they apply to exclusive licenses or partial transfers. It is uncertain whether the copyright secured by a publisher in a periodical covers the individual contributions unless all rights in the contributions have previously been assigned to the publisher. Taxation of the proceeds of a transfer as ordinary income or capital gains may be involved in the distinction, although recent tax rulings, in reversal of earlier ones, have tended to regard partial transfers as assignments. Furthermore, a partial transferee cannot sue for infringement of his right without joining the copyright proprietor as a voluntary or involuntary party, although the latter may have no interest in the outcome, unless the validity of his copyright is challenged. He is often out of the jurisdiction, even the country, and the requirement of his presence presents a serious obstacle.

45. Report, 90-94. As to duration and renewal under present law, see Revision Study No. 31, "Renewal of Copyright," by Barbara A. Ringer; Revision Study No. 30, "Duration of Copyright," by James L. Guinan.

46. See Revision Study No. 11, "Divisibility of Copyright," by Abraham L. Kaminstein, with supplements by Lorna G. Margolis and Arpad Bogsch.

b. *The Register's proposals for divisibility.*⁴⁷

Recognizing these disabilities of the present system, the Register proposes to bring the copyright statute into line with commercial practices generally, by providing in the new law that: (1) any of the rights comprised in copyright may be assigned separately; (2) statutory provisions governing "assignments" extend to exclusive licenses and other exclusive transfers of any right; and (3) the assignee of any particular right may sue in his own name for infringement of that right, but the court, in its discretion, may direct or permit joinder or intervention of any person who appears to have an interest in the suit.

These proposals raise two questions which the Register feels must be answered: (1) the matter of whose name shall appear in the copyright notice under a system of divisible copyright; and (2) shall authors be given statutory protection against unremunerative transfers, since they or their families may no longer have the renewal right of the present system?

c. *Name of owner in copyright notice.*

The Register proposes that the name of any partial owner in the copyright notice should suffice to protect the copyright, and points out that two or more partial owners could be named in the notice, with an indication of the rights held by each, if they wished. Other owners could establish their rights by recording a transfer from the owner named in the notice, and third persons could deal with him in the absence of a recorded transfer from him. He would act as trustee for any owner.

With the divisibility arising from the transfer of partial rights and exclusive licenses, considerable complications as to the notice could arise. The owners of partial exclusive rights for limited times and areas, could be multitudinous.

In above discussing the formality of notice of copyright, we expressed some skepticism as to the desirability of the notice requirement being mandatory, particularly with its problems compounded by insertion into the notice of the name or names of owners of partial rights or of exclusive licensees under the divisible copyright.

d. *Protection of authors against unremunerative transfers.*

(1) *The Register's views.*⁴⁸

The Register recognized that statutory specifications of the terms of a transfer, or the prohibition of certain transfers, in the interest of protecting

47. Report, 91-92.

48. Report, 92-94.

improvident authors, may hamper authors as well as users in arranging for the exploitation of copyright works; that terms unfair in some cases may be fair in others, and that lump sum transfers in some situations may be the only practical way of remunerating authors. Nevertheless, the Register felt that compensation of authors on a royalty basis should be encouraged without forbidding lump sum transfers.

The Register therefore proposes to put a statutory time limit on transfers by an author or his heirs or representatives, so that they will not be effective for more than twenty years from date of execution, unless it provides for continuing payment of royalties based on the uses made of the work or the revenue derived from it.

How would one evaluate such recapture rights, for example, in the case of a motion picture produced at a cost of many millions, where the producer utilized by assignment (and not from employees for hire) scores of copyrighted musical compositions as incidental background, for which the owners were happy to get the going market rate of a few hundred dollars for recording rights when the picture was produced.

There may be serious questions raised as to the general desirability of any such recapture provision, and it remains to be seen how it will be worked out in statutory language.

D. *Execution of Transfers.*

1. *The Register's Proposals.*⁴⁹

a. *Continue present provisions.* The provision of present law that copyright may be assigned, granted or mortgaged by an instrument in writing signed by the copyright owner, is proposed to be continued.

b. *Extension to exclusive transfers.* However, the Register asks that "assignments" be extended expressly so as also to cover *exclusive* licenses and all other transfers of any *exclusive* right under a copyright, but the same must be in writing signed by the transferor.

c. *Non-extension to non-exclusive transfers.* This requirement of a writing would not be extended to non-exclusive licenses, which he says do not transfer any form of ownership, but merely give permission to use a work.

d. *Acknowledgements.* Acknowledgement of the execution, whether in the United States or abroad, should not be required, according to the Register, but when made should be *prima facie* evidence of its execution. The Register proposes to incorporate broader provisions, similar to those in the patent law, which permit acknowledgment in a foreign country to be made either before an

49. Report, 94-95.

authorized diplomatic or consular officer of the United States, or before an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the U.S.

E. *Recordation of Transfers and Other Instruments.*⁵⁰

1. *The present law.*

The existing copyright statute merely refers to "assignments." Section 28 of Title 17 U.S.C. says that copyrights may be assigned, granted or mortgaged, by an instrument in writing, signed by the proprietor of the copyright.

a. *The grace period for recordation.*

Section 30 further provides for the voluntary recordation in the Copyright Office within three months (six months if from abroad), of every assignment. If recorded within this grace period, the assignment will be effective against any subsequent transfer even if the latter has a prior recording. It will also be effective against a prior unrecorded assignment, unless the latter's grace period had not yet expired and its recordation is made within such grace period. In other words, as between two conflicting assignments, the one first executed will prevail, if recorded within its grace period, regardless of priority of recordation of the other. Otherwise, a subsequent transfer, taken in good faith for value, will prevail if it is the first to be recorded.

b. *Recordation after the grace period.*

The Register points out that Section 30 leaves unanswered the question of which prevails, when the first executed is recorded after the grace period, but before the recordation of the later assignment.

c. *Right of non-exclusive licensees to rely on recordation records.*

The Register further points out that also left in doubt by Section 30 is whether a *non-exclusive* licensee in good faith can rely on the recordations of ownership, and prevail against a prior unrecorded assignment.

2. *Problems to Be Considered:*

- a. With the creation of a "divisible" copyright system, it is important that there be a central repository in the Copyright Office of the record of transfers of partial as well as the entire rights.

50. See Revision Study No. 19, "The Recordation of Copyright Assignments and Licenses," by Alan Latman, assisted by Lorna G. Margolis and Marcia Kaplan. The Register's discussion appears in Report, 95-98.

This is particularly so in view of the intangible nature of the property rights involved, which are not capable of physical possession, to enable third persons to know with whom they must deal as the owner, as well as to enable a transferee to give constructive notice to all third persons as to his ownership. Under our present system, with its ambiguities as between "*exclusive licenses*" and "*assignments*" as well as with statutory execution and recordation provisions which refer only to "*assignments*", what kind of instruments shall be embraced in a recordation system?

- b. What should be the form of recordable instruments of transfer, particularly as to writing and signature?
- c. What should be the effect of so-called constructive notice, and the extent to which it relates to the content of the recorded instrument?
- d. What shall be the effect of failure to record, and shall there be a grace period?
- e. What about the name of the transferee in the mandatory copyright notice?

3. *The Register's Proposals.*

a. *Broadening the concept of "assignment".*

The Register would extend the concept of "*assignments*" to cover "*exclusive licenses*," mortgages and all other transfers of any *exclusive* right under a copyright.

While not requiring instruments other than transfers of *exclusive* rights to be recorded, in order to be effective as constructive notice of ownership, he would nevertheless encourage the recording of any other instruments pertaining to a copyright with the effect of giving constructive notice of the information therein disclosed. Instruments such as these, among many others, might be powers of attorney, court decrees, publication contracts, employment agreements, changes in name or title, etc. By "*requiring*" an instrument conveying *exclusive* right to be recorded, the Register does not intend this as a mandatory formality conditioning the validity of the unrecorded transfer. Recordation would still be permissive, but the consequences of a failure to make a timely recording would be the loss of the recordation record as constructive notice to subsequent innocent transferees of any rights for value, and possible loss of such rights to the later transferee. By not requiring an instrument to be recorded, such as the Register proposes for example for *non-exclusive* licenses (as hereinafter discussed), there would be no such conse-

quence as loss of constructive notice by failure to record, and a *prior unrecorded non-exclusive license* would nevertheless prevail against an innocent subsequent exclusive transferee.

b. *Written signed assignments only.*

The Register would retain the present requirement that assignments be in writing, signed by the assignor. He would have either the original precise document with original signature of the assignment, or a sworn or officially certified true copy of the original.

c. *Constructive notice limited to identified copyrights and recorded facts.*

As to constructive notice, the Register, however, would confine the effect of such notice on third parties to only the copyrights specifically identified in the recorded instrument, and this, he indicates, is to preclude constructive notice of blanket assignments by an owner of all the copyrights he owns, without identifying the same particularly.

Similarly, he would not have the recorded instrument serve as constructive notice concerning anything other than the facts therein stated. Accordingly, reference in the recorded instrument to other instruments, presumably not recorded, should not serve as notice, according to the Register, as to the content of the unrecorded documents.

d. *Reduce the grace period.*

The Register feels that the arguments concerning the desirability of a three to six months grace period in which to record a transfer, are about evenly divided. He proposes to retain the principle, but to reduce the same to one month (three months from abroad).

e. *Effect of recordation.*

(1) *Which of conflictive transfers to prevail.* The Register would answer the unresolved questions under present Section 30 of the copyright statute by adopting the patent statute principle that the first in execution of two assignments will prevail if recorded within the grace period, regardless of a prior recordation of the second assignment. Further, it will also prevail, if recorded *after the grace period*, but at least *prior to the date* of the second transfer, with the addition of the requirement (from said Sec. 30), that the later assignment *must itself be recorded* in order to prevail against a prior executed assignment not recorded.

(2) *Subsequent innocent non-exclusive licensee prevails against unrecorded prior exclusive transferee.* The Register would have an express statutory provision clear the present doubt, by providing that a *non-exclusive licensee*

in good faith can rely on the absence of recordation of a prior transfer of exclusive rights (since such recordation is in the "required" category), and will prevail against such prior *unrecorded* transfer.

(3) *Subsequent innocent exclusive transferee will not prevail against prior unrecorded non-exclusive licensee.* However, as to the reverse situation, namely, where a *prior unrecorded non-exclusive* license exists, such non-exclusive license will prevail against a subsequent recorded assignee in good faith who must nevertheless take subject to it. The exclusive transferee will have to rely on warranties of his transferor concerning the absence of prior non-exclusive licenses. The Register feels that the enormous volume of non-exclusive licenses make it wholly impractical administratively to *require* their recordation in order that the same may serve as constructive notice.

f. Name of assignee in copyright notice.

Pointing out the unfortunate effect of present Section 32 of Title 17, whereby a copyright may be lost through a fatally defective notice if the assignee inserts his name therein before recording his assignment, the Register proposes to eliminate such effect. He would preserve the copyright in any case where the name of a genuine assignee is in the notice, regardless of recordation. Such assignee would hold the rights under the copyright in trust for those partial or other owners respectively concerned.

F. Commentary on Proposals Concerning Execution and Recordation of Transfers.

A clarification of the ambiguities in our present law, as well as the necessity to meet the requirements of a divisible system, call for broad advance in our old system of executing and recording transfers of rights under copyright. It would also seem desirable to have a central repository under government auspices for the recordation of copyright transactions.

The Register's proposals have in great part generally recognized and met these needs, and in the view of this panelist, will find substantial acceptance.

While the Register's proposals are necessarily quite general at this stage, it may be useful to discuss some pertinent matters of detail not treated by the Register at this time.⁵¹

51. Discussion by this panelist of the various proposals treated in the subsequent text above, including the treatment given to "grants" and "recordation" in the 1940 Shotwell bill, appear in the printed comment by this panelist to Revision Study No. 19, "The Recordation of Copyright Assignments and Licenses," *op. cit.* footnote 50.

1. *A broader coverage for transfers?*

The so-called Professor Shotwell Committee bill, introduced by Senator Thomas in 1940,⁵² and similarly providing for divisibility, did go into considerable detail as to the execution and recordation of transfers. A review of some of its provisions may be useful.

The Shotwell bill referred to transfers broadly as "grants." These were defined to include any right or rights secured to the author or other copyright owner under Title 17, as well as any chose in action for infringement thereof, to the extent of the interest of such author or owner obtained by way of assignment, conveyance, transfer, license, mortgage, pledge, or other alienation or disposition either wholly or partially. It also provided that any such grant may be general, restricted, assignable, non-assignable, exclusive, non-exclusive, limited in time, or for a specified place or territory, or for one or more works. Provision was also made for any instrument by which any right or rights, or chose in action for infringement thereof, to the extent of the interest of the author or other owner, devolved or was to be administered upon the death or incompetence of the owner, or was the property of a debtor in reorganization, receivership, insolvency, or of a bankrupt.

2. *A "statute of fraud" test for "written" grants?*

The Register proposes that the instrument of transfer, if it covers exclusive rights, be in writing, which is the provision of present law as to "assignments." He feels this is necessary because of the importance of the transactions, and the provisions for recordation.

Might not the typical statute of frauds provision of state law meet this need, without being as rigid? The Shotwell bill provided that no grant, or agreement to grant, shall be valid unless it or a note or memorandum thereof was in writing signed by the author or other owner of the right in question, or by a duly authorized agent of such author or owner.

52. S. 3043, 76th Cong., 3d Sess. This general revision bill was introduced by request of the Committee for the Study of Copyright, a subcommittee of the National Committee of the U.S.A. on International Intellectual Cooperation, after almost two years of intensive informal panel studies and meetings of the so-called Conference on Copyright Legislation under the chairmanship of Prof. James T. Shotwell. Various interested industries, groups, learned societies, and individuals, including this panelist, participated. Discussions of this project, and the basic proposals developed in the above Thomas bill, S. 3043 (often referred to as the Shotwell Committee bill), appear in the annual Reports submitted to the A.B.A. Section of Patent, Trademark and Copyright Law, by its then Committee on Copyright (the forerunner of its present Copyright Division) under the chairmanship of this panelist, at the annual meetings in 1939. (San Francisco) and 1940. (Philadelphia). See the Section's Printed Committee Reports for such years.

3. *Shall there be an option to record "short form transfers"?*

Many instruments of transfer in the copyright field are exceedingly long and complex. They often involve, in so far as their financial arrangements and other provisions are concerned, matter which is of a highly confidential nature with respect to competitors and others.

The Register's proposals do not mention or clearly indicate the possibility of utilizing acceptable signed instruments that fully satisfy recordation purposes, but which are specially prepared short form transfers, prepared at the time for recordation in lieu of the main instrument. The Register merely indicates that the original signed instrument or a certified copy of such instrument must be the one submitted for recordation.

The Shotwell bill provided⁵³ that upon receipt of the fee the Register shall record any written grant of copyright, or of any right or rights therein, "and any other written instrument signed by the grantor, or by the duly authorized agent of the grantor * * * ." It is further provided that the grant "*or other instrument*" was to contain the names of the author, grantor, and grantee, a statement whether it included any rights in works thereafter to be created or owned by the author or grantor, the nature of the grant, and when the grant itself specifically enumerated individual works, a description of the work or works covered in the grant, such as the title or titles and the nature thereof.

The Shotwell bill further provided⁵⁴ that, for the purposes of the Act, a recordation was deemed to put all persons on notice of the grant "*or other written instrument*" so recorded to the extent of the statements therein contained. However, this was to be so, provided that such grant or other written instrument contained sufficient statement therein for the purposes of indexing, so that if fully indexed by the Register of Copyright, the recordation of such grant or other instrument would be revealed upon reasonable search of the indexes and records of the Copyright Office.

4. *Should there be a grace period for effective recordation?*

The Shotwell bill provided no grace period. If a grantee, for a valuable consideration, recorded his grant in good faith without notice of any prior executed grants, his grant prevailed over any earlier grants not recorded.

This would not be the effect, of course, under a grace period, if the prior grantee were still to make a timely recording within such period, despite a previous recording by an innocent subsequent grantee.

Real estate transfers generally do not provide for grace periods in respect of recordation. Assuming such real estate transferees all act in good faith

53. S. 3043, 76th Cong., 3d Sess., sec. 16(1) and (2).

54. Ibid., sec. 16(4).

without notice, priority in recordation will usually prevail. However, real estate instruments are usually recordable in the very county where the transaction takes place. The grace periods under long established patent and copyright legislation may possibly be due to the recognition of the time lag in earlier days in sending recordable instruments from various parts of the world to Washington, D.C. Modern communications are of course much more rapid, but copyright transfers are world-wide, so there well may be reasonableness in the Register's proposal to preserve the principle but substantially reduce the grace period.

5. Shall recordation be conditioned upon a prior or simultaneous registration?

The Register does not discuss this question. It would of course be desirable to have a chain of title, where transfers are recorded, showing the original nature of the copyright, as indicated by its registration, with which the instruments of transfer are concerned. Since registration of the claim to copyright is not mandatory, shall a transferee, desiring to record his transfer, be first obligated to procure a registration, if registration has not yet been made? It may be quite a burden on an exclusive transferee of small rights, for example, who desires to record his grant, to see that the copyright under which he claims is first registered.

Without a registration, however, to identify the work, the author and first owner, the date of commencement of its term and other information, it may often be impossible to determine the work, its term and the chain of title to the transferee's claim of ownership. Strong incentives are desired to encourage registration, and some of these have been proposed, as elsewhere indicated in this paper, by way of limiting remedies in the absence of registration prior to infringement. A requirement to register, as a condition precedent to or simultaneous with recordation, may be a strong incentive to registration from the economic pressure imposed by potential transferees of rights under the copyright desiring a Copyright Office record of their claim to ownership, if they could not record their transfers until they procured the owner to register or authorize registration of the copyright.

6. Shall recordation of common law transfers be a prerequisite to registration by an owner other than the author?

If the author does not himself register his claim to copyright, but sells or assigns his common law rights, while the work is still unpublished, undisseminated publicly, and unregistered, it would be a useful record, of course, if the documents under which the owner acquired the common law rights from the author, be recorded prior to or simultaneous with his attempted registration of the copyright.

However, a long history has recognized the validity of parol assignments at common law, and our statute has not heretofore required any such recordation by the copyright registrant. It would seem that while the work is still in the undisseminated pre-statutory copyright stage, the appropriate state law should be controlling as to the validity or proof of transfers of ownership while the work is protectible only as personal property under common law. If state law permits such parol transfers, without a written agreement or memorandum signed by the transferor, there may be no written instruments to record in the Copyright Office. Written common law transfers could, of course, be recorded if desired. Possibly, authority might be given the Register to provide by administrative regulation, in applications for registration by an owner other than the author, an appropriate description of the transfers and their nature by which the owner acquired his common law rights.

CONCLUSION

The Register's recent tentative proposals to the Congress as to how our federal copyright system should be generally revised to fit our electronic era, are a far-reaching and careful distillation of the series of exceedingly able general revision studies.

It must be recognized that in various situations affecting copyright, there are sharply conflicting views of different interests, such as those of the author and his publisher, producer, distributor or assignee, on the one hand, and the consuming user on the other, as well as differences of the author *vis-a-vis* his publisher, producer, distributor or assignee.

The Register has attempted to reconcile these conflicting interests by what he feels are practical working arrangements, although ideally other solutions may possibly have fitted more symmetrically into the design. He has sought to evaluate the *pros* and *cons* of each situation realistically, appreciating that advantages and disadvantages exist in many instances on each side of the conflicting issue. He has tried to project the overriding balance of convenience in the light of the general public interest, with a workable compromise if such would be an effective solution.

On the whole, this panelist feels that the Register, in the light of this realistic approach to general revision, has made a very effective general presentation of his proposals as to "formalities" and "ownership," although this panelist may not necessarily agree with some of the detail as indicated in the above discussion.

It must be appreciated that some give and take by the groups and interests concerned with copyright will be essential, if we are ever to have a general revision.

5. THE COPYRIGHTEE'S RIGHTS AND REMEDIES: AS THEY ARE AND AS THE COPYRIGHT OFFICE RECOMMENDS THEY SHOULD BE

By ALFRED H. WASSERSTROM

Under Existing Law

Under Copyright Office Proposals

COPYRIGHTABILITY

Constitutional basis for Congressional enactment. Exclusive right to authors for limited times to their writings. (Art. I, Sec. 8, Cl. 8).

Section 4 of Act expressly provides that all *writings* of the author are within the reach of copyright. Hence, to be copyrightable the work must be a writing resulting from authorship. What is a writing and what is authorship have had to be decisionally construed. Both have been so construed very broadly. Works expressed in tangible form intelligible to the eye, that is, capable of being seen, and not merely read, held to be writings. Only a very modest degree of authorship needed. Thus, the originality inherent in such authorship will be found even though the work lacks artistic quality or merit and novelty is no factor. Requisite originality means only that the work is the author's own and distinguishable as such, and not merely copied from another or too trivial for the law to recognize. (*Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239; *Fisher Inc. v. Dillingham*, 298 F. 145; *Bell & Co. v. Catalda Fine Arts*, 191 F. 2d 99; *National Comics Publications v. Fawcett Publications*, 191 F. 2d 594.)

Eliminate Section 4 and substitute therefor a broadly inclusive but specific classification, as hereinafter indicated.

Revised Act should *expressly* provide that copyrightable works "must be fixed in some tangible form and must represent the product of original *creative* authorship". (Emphasis added.)

Under Existing Law

Section 5 classifies copyrightable works, but this classification is not substantively definitive and is designed for administrative (registration) purposes.

A work of art does not lose its copyright status by being embodied in a useful article, even though such use may have been intended for the work from its inception (*Mazer v. Stein*, 347 U.S. 201). Hence, pictorial, graphic and plastic works of art remain such, and continue to be copyrightable as such, despite their employment as ornamental or decorative designs of utilitarian objects. This posture of the law has opened the door to dubious copyright claims for useful articles embodying "works of art" as designs thereof, albeit such "works of art" were intended to be, and were in the first instance, embodied or wrought into such articles.

Architectural drawings are copyrightable as technical drawings, and copyright thereto prevents the making and distributing copies of the drawings. Copyrighted models or designs of

Under Copyright Office Proposals

A broad, substantively definitive classification of copyrightable works containing more than the 13 classes now found in the Act. This would replace Section 4. A separate flexible classification for administrative use.

Sui generis protection—under a separate Design Protection Act—should be afforded to ornamental and industrial designs of useful articles as such. But there should be no necessary impairment of copyright status of a pictorial, graphic or sculptural work of art even though such work is utilized as the ornamental design of a useful article. In such case, the copyright owner of the work of art should have the choice of bringing the design as embodied in the useful article under the Design Protection Act or not, and only if so brought would that Act, as distinguished from the Copyright Act, apply. The Copyright Act should clearly state that works of art encompassing pictorial, graphic and plastic works, are registrable thereunder, notwithstanding their portrayal or use in useful articles, but the useful articles are not to be deposited. The Act should reflect the distinction decisionally made that copyright protection covering a pictorial, graphic or sculptural work depicting a useful article as such does not extend to the making of the article itself.

Protection should be continued for architectural drawings, for non-functional architectural structures that are works of art and for drawings for such non-functional structures.

Under Existing Law

works of art may not be used to make or execute the work of art. However, copyrighted drawings of functional objects not works of art may be used in the making of the objects.

Choreographic works, i.e., "dance works created for presentation to an audience" are copyrightable as dramatic compositions in that they result from requisite authorship and it is now feasible to capture them in tangible form by means of a distinctive system of dance notations or in motion pictures.

The literary, dramatic or musical work of an author embodied in a sound recording is given statutory protection. However, performer's rendition of such works and the recording itself are not so protected.

Section 7 makes independently copyrightable "compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works * , or works republished with new matter". Hence, inferentially, such derivative works including such other versions, in order to qualify as new copyrighted works, must result from said authorship expressed in said written form.

Under Copyright Office Proposals

As a specific class, choreographic works, i.e., dance works prepared for presentation to audiences, should be copyrightable whether they are in the nature of dramatic compositions or not; thus "abstract" dances would be protected.

The unauthorized duplication of sound recordings should be prevented and copyright principles should be applied to that end. However, the detailed implementation of this recommendation needs further study.

A clear provision to the effect that new versions of preexisting works, in order to be copyrightable, must be expressed in tangible form and be the result of original creative authorship.

RIGHTS

There is accorded to the copyright proprietor a plurality of exclusive rights, the most basic of which is the right to make copies, i.e., to manifold the work itself. (*Arnstein v. Marks*

Under Existing Law

Music Corp., 82 F. 2d 275.) This crucial protection against plagiarism carries with it the exclusive right to publish and to sell such copies. Thus, the exclusive rights which spread protectingly over all kinds of copyrightable works are the rights to make, to publish and to vend copies of the copyrighted work.

To spell out infringement (a) the whole of a work need not be copied and (b) the copy need not be identical with its copyrighted source. " * * for infringement it is not necessary to reproduce the work in *ipsissimis verbis*; it is enough to take the substance of its 'expression' as distinct from its 'ideas' ". (DeAcosta v. Brown, 146 F. 2d 408, 413, cert. den. 325 U.S. 862; see also Nikanov v. Simon & Schuster, 246 F. 2d 501.) But the "copying" of less than the whole of a copyrighted work is not necessarily infringement; for that there must be "copying" of at least a copyrightable, material part of the protected work. (Dellar v. Goldwyn Inc., 104 F. 2d 661; Arnstein v. Porter, 154 F. 2d 464; Nikanov v. Simon & Schuster, *supra*.)

Moreover, all copyrighted works are subject to fair use, that is, to the use by way of the reproduction of so much of protected material as is considered *reasonable* within the factual context of the particular case. Criteria of fair use will be (a) the purpose of the use (b) the nature of the copyrighted work (c) the quantum and value of the material reproduced and (d) the

Under Copyright Office Proposals.

Subject to the statutory recognition of the fair use doctrine and permissible photocopying by libraries, as herein-after more particularly indicated, the existing exclusive rights of copyright proprietors to exploit their works by the control over the making, publishing and selling of copies should be retained. These rights, however, should be more simply and more clearly set forth.

The fair (i.e., non-infringing) use doctrine should be statutorily recognized and the scope of that principle should be indicated.

Public libraries should be permitted to supply photocopies of copyrighted works under the following limitations: single copies of an article in a

Under Existing Law

economic effect of the use on the protected work. A concise statement of these pertinent considerations is offered in No. 14 of the Copyright Law Revision Studies on the subject of fair use wherein it is said at page 15: "In fact, the tests may perhaps be summarized by: importance of the material copied or performed from the point of view of the reasonable copyright owner. In other words, would the reasonable copyright owner have consented to the use? At times, custom or public policy defines what is reasonable." (See also comments and cases cited in my article "Magazine, Newspaper and Syndication Problems" in CCH "1953 Copyright Problems Analyzed" 159, 175 et seq.)

As noted, the foregoing rights attach to all categories of works. In addition certain particular genres of works are accorded further protection:

(1) Literary, dramatic and musical works against any other versions, including translations of literary works, dramatizations of non-dramatic works, novelizations of dramatic works and arrangements and adaptations of musical works; and

(2) models and designs of works of art against execution of the work of art; and

(3) non-dramatic literary (including sermons, lectures and similar "for profit" public delivery, public works) and musical works against the presentation or public performance (but performance of a musical work

Under Copyright Office Proposals

periodical or of a reasonable part of another publication may be supplied for research; single photocopies of an entire publication may be supplied upon a showing in writing that the publication in question is not available from the publisher.

This right to make other versions should be retained but should be stated with greater clarity.

This right to execute works of art should be retained.

This right limited as it is to public deliveries, presentations and performances "for profit" should be retained. However, the coin-operated machine exemption, at least as to the operators of such machines, should be elimi-

Under Existing Law

on a coin-operated machine is not such public performance for profit, absent an admission charge to the place where performance occurs); and

(4) Dramatic works, including dramatico-musical works, against any public performance or public exhibition; and

(5) Literary, dramatic and musical works against reproduction in any transcription or record. (This right as to musical compositions is subject to a compulsory licensing provision which provides in substance that if copyright owner permits the mechanical reproduction of the composition then all others may similarly reproduce it without any license therefor provided they pay the owner the statutory "royalty of 2¢ on each part manufactured".)

Only works published under Section 10 and works registered under Section

Under Copyright Office Proposals

nated, and a reasonable license fee imposed to cover the public performance for profit of musical compositions on such machines.

This right proscribing the public performance or public exhibition of dramatic works, whether "for profit" or not, should be enlarged to include all motion pictures, whether photoplays or not, as well as choreographic works and, as so enlarged, should be retained but more clearly set forth.

This right to control the making of transcriptions and records should be retained. However, the compulsory licensing provisions should be eliminated after one year from the enactment of the revised Act.

There should be no liability for a public performance on the ground of the reception as distinguished from the retransmission of broadcasts unless the receiver charges the public for such reception. This statutory exemption would overcome the effect of *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191, wherein a hotel was held liable when, without license, it retransmitted for the benefit of its guests broadcasts of copyrighted music which it had received.

The revised Act should be made applicable to all copyrightable works

Under Existing Law

12 qualify for statutory copyright; only works which come within one of the particular classes expressly set forth in Section 12 are registrable thereunder.

Under Copyright Office Proposals

upon public dissemination thereof and such dissemination may be by way of the publication of copies, registration, public performance or public distribution of sound recordings. Section 12 should be enlarged to accommodate all classes of copyrightable works.

REMEDIES

The remedies of a copyright proprietor for infringement are cumulatively set forth in Section 101 (Sheldon v. Mordall Realty Corp., 95 F. 2d 48.)

- (1) injunction (permanent and temporary), and
- (2) actual damages suffered by the proprietor from the infringement, and
- (3) profits made by the infringer from the infringement (on this phase plaintiff need only prove sales and defendant must prove deductible costs), or
- (4) in lieu of said damages and profits, such damages (at least \$250.00 but not more than \$5,000.00 per infringement) as, in its judicial discretion (but within said range), the trial court deems just.

Injunctive relief both provisionally and finally should continue to be available.

Damages and profits should not be cumulatively recoverable. The Act should provide for the recovery of damages *or* profits, whichever is the larger.

The more inclusive term "gross revenue" should replace the term "sales" in this context.

These damages as alternative relief should continue to be recoverable. However, the maximum should be increased from \$5,000.00 to \$10,000.00 for all infringements for which the defendant is then liable.

Incident to assessing the so-called "in lieu" or statutory damages, there is a permissive schedule (as, for example, \$1.00 per infringing copy) which the court may apply within said per infringement money range.

This schedule should be eliminated.

Under Existing Law

Except for infringements taking place after actual notice, statutory damages may not exceed the \$5,000.00 per infringement maximum.

Absent adequate proof of both actual damages *and* profits, statutory damages will, perforce, apply so that in such case at least \$250 for each infringement will have to be awarded. Of course, one cannot recover actual damages *or* profits *and* statutory damages. However, proof of actual damages or of profits will not necessarily preclude an award of statutory damages, and statutory damages may, nevertheless, be recovered, despite such proof and in lieu thereof, if the trial court's sense of justice so dictates or the vindication of the policy of the Copyright Act so requires. (*Woolworth v. Contemporary Arts*, 344 U.S. 228.)

As the court said in *Woolworth*, page 233, "Lack of adequate proof on either element", i.e., actual damages or profits, "would warrant resort to the statute in the discretion of the court, subject always to the statutory limitations".

While the innocence of the infringer is no defence and the intent to infringe not needed to spell out infringement (*Woolworth Co. v. Contemporary Arts*, 344 U.S. 228; *Buck v. Jewell-La Salle Realty Co.*, 283 U.S. 191; *Peter Pan Fabrics v. Acadia*, 173 F.Supp. 292, *aff'd*, *Peter Pan Fabrics*

Under Copyright Office Proposals

Instead of this notice provision, one pertaining to the wilfulness of the infringer should appear so that such wilfulness may be taken into account as a punitive measure up to the statutory maximum.

The revised Act should provide that if actual damages or profits fall below \$250, then statutory damages covering all infringements and in lieu of such damages or profits shall be recovered, and that the amount of such statutory damages shall be recovered, and that the amount of such statutory damages shall range from \$250 to no more than \$10,000, as, in the discretion of the trial court, the justice of the case requires. But even in this situation an award of the statutory minimum need not be made if a defendant establishes his innocence, in which case the court may award less than that minimum or nothing at all. Moreover, if actual damages or profits exceed \$250 but, nevertheless, fall below an amount which the court, depending upon the exigencies of the entire case, considers just, then it may, in its discretion, award statutory damages instead of such damages or profits in any amount up to and including \$10,000.

As indicated above, the innocence of the infringer should be relevant to the assessment of statutory damages even to the extent of empowering the court, in its discretion, to award

Under Existing Law

v. Martin Weiner Corp., 274 F. 2d 487), nevertheless, a defendant's innocence "may be relevant to the question of damages to be assessed against the infringer" (Peter Pan Fabrics v. Dixon Textile Corp., 188 F. Supp. 235, 237, rev'd on other grounds, 280 F. 2d 800; see also dissenting opinion by L. Hand J. in *De Acosta v. Brown*, 146 F. 2d 408, 412, et seq.) However, if statutory damages are properly applicable, the per infringement minimum of \$250 is mandatory, notwithstanding the innocence of the defendant, except for (a) an infringing reproduction in a newspaper of a copyrighted photograph, in which case the damages may range from \$50 to \$200; and (b) the innocent infringement of an undramatized or nondramatic work by means of motion pictures, in which case the damages may not exceed \$100; and (c) the innocent infringement by broadcast of any nondramatic literary work, in which case the damages may not exceed \$100.

Recoverable profits are those made by the infringer "from such infringement" (Section 101), so as to prevent an infringer from becoming unjustly enriched. Hence, an infringer's over-all, i.e., commingled, profits are subject to apportionment and only such profits as are attributable (but with doubts resolved against the infringer) to the infringement may be recovered. (*Sheldon v. Metro-Goldwyn Corp.*, 106 F. 2d 45, aff'd 309 U.S. 390.)

Under Copyright Office Proposals

less than the statutory minimum of \$250 against the innocent infringer, but such infringer should bear the burden of proving his innocence.

In view of the proposed elimination of a mandatory minimum against an innocent infringer, these three exceptions might well be eliminated.

The Act should clearly provide for the apportionment of profits to reflect prevailing decisional law.

Under Existing Law

Also available are the provisional remedy of impounding of allegedly infringing articles and the final remedy of destruction of infringing copies and devices or other means used in the making of such copies.

A prevailing party in an infringement action is also entitled to an allowance of full costs including a discretionary award of a reasonable attorney's fee (Section 116). Where there is a genuine and not unreasonable issue on the question of infringement, the court has frequently been reluctant to award a counsel fee to the prevailing party, whether plaintiff or defendant. An example of this approach is found in *Morse v. Fields et al.*, 127 F. Supp. 63, 69.

Once copyright has been secured by publication with notice, registration of the claim to that copyright is to be made (Sec. 13). However, the absence of registration (even for an inordinately long period following initiation of copyright) does not adversely affect substantive rights or remedies for infringement, except that no infringement action or suit can be maintained until registration has been effected (*Washingtonian Publishing Co., Inc. v. Pearson et al.*, 306 U.S. 30; *Vacheron etc. Watches, Inc. v. Benrus Watch Co., Inc.*, 260 F. 2d 637.) Hence, there may be recovery for infringements antedating registration.

Under Copyright Office Proposals

These provisions should be retained in substantially their present form.

An allowance of costs should be discretionary. The discretionary allowance of a reasonable attorney's fee should be retained.

Consonant with present law, registration should not precondition copyright, but should remain as a prerequisite to the maintenance of action. However, the revised Act should expressly provide that the Register is required to register all claims to copyright "appearing to be valid under the statute, upon compliance with the procedural requirements for registration", and that the Register may refuse registration, subject to judicial review, of all claims which he concludes are invalid. However, the Register's refusal to effect registration of an apparently valid claim, duly applied for, should not prevent the bringing of an infringement action; in such action the validity of a disputed claim is to be determined—but the Register should be notified of

Under Existing Law

No matter when registration takes place, the Copyright Office's certificate thereof is to be admitted as prima facie evidence of the facts therein stated (Sec. 209).

Under Copyright Office Proposals

such action with an opportunity to be heard therein.

Furthermore, unless registration is made (or registration of an apparently valid claim is duly applied for) within three (3) months after initial public dissemination (including but not limited to first publication) of the work in the United States (or within six (6) months after such dissemination elsewhere) plenary remedies should not be available against an antecedent infringer. Except for foreign works protected under Universal Copyright Convention, in the case of tardy registration only the following civil remedies should be available for an infringement commenced prior to such registration: (a) actual damages sustained by the copyrightee; (b) discretionary injunction against future infringements; and (c) discretionary injunction against completion of infringing undertaking commenced before registration and against impounding and destruction of infringing items, provided the infringer is fully reimbursed.

This same probative effect of the certificate of registration should be retained *provided* registration is made within one (1) year after first public dissemination; otherwise the effect of the certificate should be committed to the court's discretion.

6. INTERNATIONAL CONVENTION FOR THE PROTECTION OF PERFORMERS, PRODUCERS OF PHONOGRAMS AND BROADCASTING ORGANIZATIONS—*The Diplomatic Conference on Neighboring Rights.*

Rome (October 10-26, 1961)

From October 10 to 26, 1961, a diplomatic conference was held in Rome, Italy, for the adoption of a multilateral treaty on the protection of performing artists, producers of phonograph records, and broadcasting organizations. The conference was sponsored by the Italian government and three intergovernmental organizations: United Nations Educational, Scientific and Cultural Organization (UNESCO), International Labor Organization (ILO), and the Berne Copyright Union. More than forty countries participated, among them the United States, whose delegation was headed by Abraham L. Kaminstein, United States Register of Copyrights.

Preparations for the Rome Diplomatic Conference had proceeded over a long period. The rights protected were discussed by the International Union for the Protection of Literary and Artistic Works at its Diplomatic Conference in Rome in 1928. The International Labor Organization studied the problems in connection with displacement of musicians in the 1930s and has maintained a continuing interest in the subject. There were meetings at Samaden, Switzerland (1939), *vœux* were passed by the Brussels revision conference of the Berne Copyright Union (1948), and, in 1951, a committee of experts, which also met in Rome, produced the Rome Draft of a convention. In 1956 another draft was produced under the sponsorship of the International Labor Office and, in 1957, the Monaco Draft was prepared under the sponsorship of UNESCO and the Berne Copyright Union. Another committee of experts, jointly called by the three intergovernmental organizations, met at The Hague in 1960, under the chairmanship of Professor G. H. C. Bodenhausen, and produced the Hague Draft, which was the basis of the deliberations in Rome.

On the last day at Rome, the treaty was signed by eighteen of the participating countries, namely, Germany, Argentina, Austria, Belgium, Brazil, Cambodia, Chile, Denmark, Spain, France, India, Iceland, Italy, Mexico, United Kingdom, Vatican City, Sweden and Yugoslavia. The United States did not sign the instrument in Rome, but the convention will remain open for signature until the end of June of next year.

The main feature of the treaty consists of the obligation of each Contracting State to grant the same protection to performances, phonogram disks and tapes, and broadcasts of foreign origin as it grants to those of domestic origin. In addition to this so-called national treatment, or assimilation of foreigners to nationals, the treaty provides for some minimum protection. For

example, it provides that each Contracting State has to take measures which make the copying of disks, whether directly or off the air, illegal.

One of the most controversial points in the treaty was whether the principle of payments for the use of phonograph records in broadcasting should be written into the convention. After much debate, the principle was written into the convention; but under the terms of the convention itself each country is allowed to exclude the application of this principle, which is not recognized in a great number of countries.

There has not yet been time to reach any decision on whether the United States Government should recommend the signing and ratification of the new treaty. In any case, ratification could only be considered after the necessary changes in our domestic law were made.

The U. S. Delegation comprised the following:

Representatives:

Abraham L. Kaminstein (Chairman), Register of Copyrights, Copyright Office.
Richard B. Bilder, Office of Assistant Legal Adviser for Economic Affairs,
Department of State.

Dr. Arpad Bogsch, Attorney Adviser, Copyright Office.

Leonard R. Linsenmayer, Director, Office of International Organization Affairs,
Department of Labor.

Vincent D. Travaglini, Foreign Business Practices Division, Office of International Programs, Department of Commerce.

Harvey J. Winter, Assistant Chief, Office of International Business Practices,
Department of State.

Congressional Advisers:

Hon. Roland Libonati, House of Representatives, United States Congress.

Cyril F. Brickfield, Counsel, House Judiciary Committee, United States Congress.

Advisers:

Mortimer I. Becker, General Counsel to American Federation of Television and Radio Artists and American Guild of Musical Artists, New York.

Donald F. Conaway, National Executive Secretary, Associated Actors and Artists of America and American Federation of Television and Radio Artists, New York.

Sidney A. Diamond, General Counsel for London Records, New York.

Robert V. Evans, Assistant General Attorney, Columbia Broadcasting System, Inc., New York.

Herman Finkelstein, General Attorney, American Society of Composers, Authors, and Publishers, New York.

Henry Kaiser, Attorney for American Federation of Musicians, Washington.

Sydney M. Kaye, Chairman of Broadcast Music, Inc., New York.

Herman D. Kenin, President, American Federation of Musicians, New York.

Ernest S. Meyers, General Counsel, Record Industry Association of America, Inc., New York.

Thomas J. Robinson, Attorney, Metro-Goldwyn-Mayer, and Chairman of Motion Picture Association of America Copyright Committee, New York.

Sidney A. Schreiber, Secretary and General Counsel, Motion Picture Association of America, Inc., New York.

THE CONVENTION

The Contracting States, moved by the desire to protect the rights of performers, producers of phonograms, and broadcasting organisations,

Have agreed as follows:

Article 1

Protection granted under this Convention shall leave intact and shall in no way affect the protection of copyright in literary and artistic works. Consequently, no provision of this Convention may be interpreted as prejudicing such protection.

Article 2

1. For the purposes of this Convention, national treatment shall mean the treatment accorded by the domestic law of the Contracting State in which protection is claimed:

(a) to performers who are its nationals, as regards performances taking place, broadcast, or first fixed, on its territory;

(b) to producers of phonograms who are its nationals, as regards phonograms first fixed or first published on its territory;

(c) to broadcasting organisations which have their headquarters on its territory, as regards broadcasts transmitted from transmitters situated on its territory.

2. National treatment shall be subject to the protection specifically guaranteed, and the limitations specifically provided for, in this Convention.

Article 3

For the purposes of this Convention:

(a) "Performers" means actors, singers, musicians, dancers, and other persons who act, sing, deliver, declaim, play in, or otherwise perform literary or artistic works;

(b) "Phonogram" means any exclusively aural fixation of sounds of a performance or of other sounds;

(c) "Producer of phonograms" means the person who, or the legal entity which, first fixes the sounds of a performance or other sounds;

(*d*) "Publication" means the offering of copies of a phonogram to the public in reasonable quantity;

(*e*) "Reproduction" means the making of a copy or copies of a fixation;

(*f*) "Broadcasting" means the transmission by wireless means for public reception of sounds or of images and sounds;

(*g*) "Rebroadcasting" means the simultaneous broadcasting by one broadcasting organisation of the broadcast of another broadcasting organisation.

Article 4

Each Contracting State shall grant national treatment to performers if any of the following conditions is met:

(*a*) the performance takes place in another Contracting State;

(*b*) the performance is incorporated in a phonogram which is protected under Article 5 of this Convention;

(*c*) the performance, not being fixed on a phonogram, is carried by a broadcast which is protected by Article 6 of this Convention.

Article 5

1. Each Contracting State shall grant national treatment to producers of phonograms if any of the following conditions is met:

(*a*) the producer of the phonogram is a national of another Contracting State (criterion of nationality);

(*b*) the first fixation of the sound was made in another Contracting State (criterion of fixation);

(*c*) the phonogram was first published in another Contracting State (criterion of publication).

2. If a phonogram was first published in a non-contracting State but if it was also published, within thirty days of its first publication, in a Contracting State (simultaneous publication), it shall be considered as first published in the Contracting State.

3. By means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will not apply the criterion of publication or, alternatively, the criterion of fixation. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

Article 6

1. Each Contracting State shall grant national treatment to broadcasting organisations if either of the following conditions is met:

(a) the headquarters of the broadcasting organisation is situated in another Contracting State;

(b) the broadcast was transmitted from a transmitter situated in another Contracting State.

2. By means of a notification deposited with the Secretary-General of the United Nations, any Contracting State may declare that it will protect broadcasts only if the headquarters of the broadcasting organisation is situated in another Contracting State and the broadcast was transmitted from a transmitter situated in the same Contracting State. Such notification may be deposited at the time of ratification, acceptance or accession, or at any time thereafter; in the last case, it shall become effective six months after it has been deposited.

Article 7

1. The protection provided for performers by this Convention shall include the possibility of preventing:

(a) the broadcasting and the communication to the public, without their consent, of their performance, except where the performance used in the broadcasting or the public communication is itself already a broadcast performance or is made from a fixation;

(b) the fixation, without their consent, of their unfixed performance;

(c) the reproduction, without their consent, of a fixation of their performance:

(i) if the original fixation itself was made without their consent;

(ii) if the reproduction is made for purposes different from those for which the performers gave their consent;

(iii) if the original fixation was made in accordance with the provisions of Article 15, and the reproduction is made for purposes different from those referred to in those provisions.

2. (1) If broadcasting was consented to by the performers, it shall be a matter for the domestic law of the Contracting State where protection is claimed to regulate the protection against rebroadcasting, fixation for broadcasting purposes, and the reproduction of such fixation for broadcasting purposes.

(2) The terms and conditions governing the use by broadcasting organisations of fixations made for broadcasting purposes shall be determined in accordance with the domestic law of the Contracting State where protection is claimed.

(3) However, the domestic law referred to in sub-paragraphs (1) and (2) of this paragraph shall not operate to deprive performers of the ability to control, by contract, their relations with broadcasting organisations.

Article 8

Any Contracting State may, by its domestic laws and regulations, specify the manner in which performers will be represented in connexion with the exercise of their rights if several of them participate in the same performance.

Article 9

Any Contracting State may, by its domestic laws and regulations, extend the protection provided for in this Convention to artistes who do not perform literary or artistic works.

Article 10

Producers of phonograms shall enjoy the right to authorise or prohibit the direct or indirect reproduction of their phonograms.

Article 11

If, as a condition of protecting the rights of producers of phonograms, or of performers, or both, in relation to phonograms, a Contracting State, under its domestic law, requires compliance with formalities, these shall be considered as fulfilled if all the copies in commerce of the published phonogram or their containers bear a notice consisting of the symbol (P), accompanied by the year date of the first publication, placed in such a manner as to give reasonable notice of claim of protection; and if the copies or their containers do not identify the producer or the licensee of the producer (by carrying his name, trade mark or other appropriate designation), the notice shall also include the name of the owner of the rights of the producer; and, furthermore, if the copies or their containers do not identify the principal performers, the notice shall also include the name of the person who, in the country in which the fixation was effected, owns the rights of such performers.

Article 12

If a phonogram published for commercial purposes, or a reproduction of such phonogram, is used directly for broadcasting or for any communication

to the public, a single equitable remuneration shall be paid by the user to the performers, or to the producers of the phonograms, or to both. Domestic law may, in the absence of agreement between these parties, lay down the conditions as to the sharing of this remuneration.

Article 13

Broadcasting organisations shall enjoy the right to authorise or prohibit:

- (a) the rebroadcasting of their broadcasts;
- (b) the fixation of their broadcasts;
- (c) the reproduction:
 - (i) of fixations, made without their consent, of their broadcasts;
 - (ii) of fixations, made in accordance with the provisions of Article 15, of their broadcasts, if the reproduction is made for purposes different from those referred to in those provisions;
- (d) the communication to the public of their television broadcasts if such communication is made in places accessible to the public against payment of an entrance fee; it shall be a matter for the domestic law of the State where protection of this right is claimed to determine the conditions under which it may be exercised.

Article 14

The term of protection to be granted under this Convention shall last at least until the end of a period of twenty years computed from the end of the year in which:

- (a) the fixation was made—for phonograms and for performances incorporated therein;
- (b) the performance took place—for performances not incorporated in phonograms;
- (c) the broadcast took place—for broadcasts.

Article 15

1. Any Contracting State may, in its domestic laws and regulations, provide for exceptions to the protection guaranteed by this Convention as regards:

- (a) private use;
- (b) use of short excerpts in connexion with the reporting of current events;

(c) ephemeral fixation by a broadcasting organisation by means of its own facilities and for its own broadcasts;

(d) use solely for the purposes of teaching or scientific research.

2. Irrespective of paragraph 1 of this Article, any Contracting State may, in its domestic laws and regulations, provide for the same kinds of limitations with regard to the protection of performers, producers of phonograms and broadcasting organisations, as it provides for, in its domestic laws and regulations, in connexion with the protection of copyright in literary and artistic works. However, compulsory licences may be provided for only to the extent to which they are compatible with this Convention.

Article 16

1. Any State, upon becoming party to this Convention, shall be bound by all the obligations and shall enjoy all the benefits thereof. However, a State may at any time, in a notification deposited with the Secretary-General of the United Nations, declare that:

(a) as regards Article 12:

(i) it will not apply the provisions of that Article;

(ii) it will not apply the provisions of that Article in respect of certain uses;

(iii) as regards phonograms the producer of which is not a national of another Contracting State, it will not apply that Article;

(iv) as regards phonograms the producer of which is a national of another Contracting State, it will limit the protection provided for by that Article to the extent to which, and to the term for which, the latter State grants protection to phonograms first fixed by a national of the State making the declaration; however, the fact that the Contracting State of which the producer is a national does not grant the protection to the same beneficiary or beneficiaries as the State making the declaration shall not be considered as a difference in the extent of the protection;

(b) as regards Article 13, it will not apply item (d) of that Article; if a Contracting State makes such a declaration, the other Contracting States shall not be obliged to grant the right referred to in Article 13, item (d), to broadcasting organisations whose headquarters are in that State.

2. If the notification referred to in paragraph 1 of this Article is made after the date of the deposit of the instrument of ratification, acceptance or accession, the declaration will become effective six months after it has been deposited.

Article 17

Any State which, on October 26, 1961, grants protection to producers of phonograms solely on the basis of the criterion of fixation may, by a notification deposited with the Secretary-General of the United Nations at the time of ratification, acceptance or accession, declare that it will apply, for the purposes of Article 5, the criterion of fixation alone and, for the purposes of paragraph 1 (a) (iii) and (iv) of Article 16, the criterion of fixation instead of the criterion of nationality.

Article 18

Any State which has deposited a notification under paragraph 3 of Article 5, paragraph 2 of Article 6, paragraph 1 of Article 16 or Article 17, may, by a further notification deposited with the Secretary-General of the United Nations, reduce its scope or withdraw it.

Article 19

Notwithstanding anything in this Convention, once a performer has consented to the incorporation of his performance in a visual or audio-visual fixation, Article 7 shall have no further application.

Article 20

1. This Convention shall not prejudice rights acquired in any Contracting State before the date of coming into force of this Convention for that State.
2. No Contracting State shall be bound to apply the provisions of this Convention to performances or broadcasts which took place, or to phonograms which were fixed, before the date of coming into force of this Convention for that State.

Article 21

The protection provided for in this Convention shall not prejudice any protection otherwise secured to performers, producers of phonograms and broadcasting organizations.

Article 22

Contracting States reserve the right to enter into special agreements among themselves in so far as such agreements grant to performers, producers of phonograms or broadcasting organisations more extensive rights than those granted by this Convention or contain other provisions not contrary to this Convention.

Article 23

This Convention shall be deposited with the Secretary-General of the United Nations. It shall be open until June 30, 1962 for signature by any State invited to the Diplomatic Conference on the International Protection of Performers, Producers of Phonograms and Broadcasting Organisations which is a party to the Universal Copyright Convention or a member of the International Union for the Protection of Literary and Artistic Works.

Article 24

1. This Convention shall be subject to ratification or acceptance by the signatory States.

2. This Convention shall be open for accession by any State invited to the Conference referred to in Article 23, and by any State Member of the United Nations, provided that in either case such State is a party to the Universal Copyright Convention or a member of the International Union for the Protection of Literary and Artistic Works.

3. Ratification, acceptance or accession shall be effected by the deposit of an instrument to that effect with the Secretary-General of the United Nations.

Article 25

1. This Convention shall come into force three months after the date of deposit of the sixth instrument of ratification, acceptance or accession.

2. Subsequently, this Convention shall come into force in respect of each State three months after the date of deposit of its instrument of ratification, acceptance or accession.

Article 26

1. Each Contracting State undertakes to adopt, in accordance with its Constitution, the measures necessary to ensure the application of this Convention.

2. At the time of deposit of its instrument of ratification, acceptance or accession, each State must be in a position under its domestic law to give effect to the terms of this Convention.

Article 27

1. Any State may, at the time of ratification, acceptance or accession, or at any time thereafter, declare by notification addressed to the Secretary-General of the United Nations that this Convention shall extend to all or any of the territories for whose international relations it is responsible, provided that the

Universal Copyright Convention or the International Convention for the Protection of Literary and Artistic Works applies to the territory or territories concerned. This notification shall take effect three months after the date of its receipt.

2. The notifications referred to in paragraph 3 of Article 5, paragraph 2 of Article 6, paragraph 2 of Article 16 and Articles 17 and 18, may be extended to cover all or any of the territories referred to in paragraph 1 of this Article.

Article 28

1. Any Contracting State may denounce this Convention, on its own behalf, or on behalf of all or any of the territories referred to in Article 27.

2. The denunciation shall be effected by a notification addressed to the Secretary-General of the United Nations and shall take effect twelve months after the date of receipt of the notification.

3. The right of denunciation shall not be exercised by a Contracting State before the expiry of a period of five years from the date on which the Convention came into force with respect to that State.

4. A Contracting State shall cease to be a party to this Convention from that time when it is neither a party to the Universal Copyright Convention nor a member of the International Union for the Protection of Literary and Artistic Works.

5. This Convention shall cease to apply to any territory referred to in Article 27 from that time when neither the Universal Copyright Convention nor the International Convention for the Protection of Literary and Artistic Works applies to that territory.

Article 29

1. After this Convention has been in force for five years, any Contracting State may, by notification addressed to the Secretary-General of the United Nations, request that a conference be convened for the purpose of revising the Convention. The Secretary-General shall notify all Contracting States of this request. If, within a period of six months following the date of notification by the Secretary-General of the United Nations, not less than one half of the Contracting States notify him of their concurrence with the request, the Secretary-General shall inform the Director-General of the International Labour Office, the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the Bureau of the International Union for the Protection of Literary and Artistic Works, who shall convene a revision

conference in co-operation with the Intergovernmental Committee provided for in Article 32.

2. The adoption of any revision of this Convention shall require an affirmative vote by two-thirds of the States attending the revision conference, provided that this majority includes two-thirds of the States which, at the time of the revision conference, are parties to the Convention.

3. In the event of adoption of a Convention revising this Convention in whole or in part, and unless the revising Convention provides otherwise:

(a) this Convention shall cease to be open to ratification, acceptance or accession as from the date of entry into force of the revising Convention;

(b) this Convention shall remain in force as regards relations between or with Contracting States which have not become parties to the revising Convention.

Article 30

Any dispute which may arise between two or more Contracting States concerning the interpretation or application of this Convention and which is not settled by negotiation shall, at the request of any one of the parties to the dispute, be referred to the International Court of Justice for decision, unless they agree to another mode of settlement.

Article 31

Without prejudice to the provisions of paragraph 3 of Article 5, paragraph 2 of Article 6, paragraph 1 of Article 16 and Article 17, no reservation may be made to this Convention.

Article 32

1. An Intergovernmental Committee is hereby established with the following duties:

(a) to study questions concerning the application and operation of this Convention; and

(b) to collect proposals and to prepare documentation for possible revision of this Convention.

2. The Committee shall consist of representatives of the Contracting States, chosen with due regard to equitable geographical distribution. The number of members shall be six if there are twelve Contracting States or less, nine if there are thirteen to eighteen Contracting States and twelve if there are more than eighteen Contracting States.

3. The Committee shall be constituted twelve months after the Convention comes into force by an election organised among the Contracting States, each of which shall have one vote, by the Director-General of the International Labour Office, the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the Bureau of the International Union for the Protection of Literary and Artistic Works, in accordance with rules previously approved by a majority of all Contracting States.

4. The Committee shall elect its Chairman and officers. It shall establish its own rules of procedure. These rules shall in particular provide for the future operation of the Committee and for a method of selecting its members for the future in such a way as to ensure rotation among the various Contracting States.

5. Officials of the International Labour Office, the United Nations Educational, Scientific and Cultural Organization and the Bureau of the International Union for the Protection of Literary and Artistic Works, designated by the Directors-General and the Director thereof, shall constitute the Secretariat of the Committee.

6. Meetings of the Committee, which shall be convened whenever a majority of its members deems it necessary, shall be held successively at the headquarters of the International Labour Office, the United Nations Educational, Scientific and Cultural Organization and the Bureau of the International Union for the Protection of Literary and Artistic Works.

7. Expenses of members of the Committee shall be borne by their respective Governments.

Article 33

1. The present Convention is drawn up in English, French and Spanish, the three texts being equally authentic.

2. In addition, official texts of the present Convention shall be drawn up in German, Italian and Portuguese.

Article 34

1. The Secretary-General of the United Nations shall notify the States invited to the Conference referred to in Article 23 and every State Member of the United Nations, as well as the Director-General of the International Labour Office, the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the Bureau of the International Union for the Protection of Literary and Artistic Works:

(a) of the deposit of each instrument of ratification, acceptance or accession;

(b) of the date of entry into force of the Convention;

(c) of all notifications, declarations or communications provided for in this Convention;

(d) if any of the situations referred to in paragraphs 4 and 5 of Article 28 arise.

2. The Secretary-General of the United Nations shall also notify the Director-General of the International Labour Office, the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the Bureau of the International Union for the Protection of Literary and Artistic Works of the requests communicated to him in accordance with Article 29, as well as of any communication received from the Contracting States concerning the revision of the Convention.

IN FAITH WHEREOF, the undersigned, being duly authorised thereto, have signed this Convention.

DONE at Rome, this twenty-sixth day of October 1961, in a single copy in the English, French and Spanish languages. Certified true copies shall be delivered by the Secretary-General of the United Nations to all the States invited to the Conference referred to in Article 23 and to every State Member of the United Nations, as well as to the Director-General of the International Labour Office, the Director-General of the United Nations Educational, Scientific and Cultural Organization and the Director of the Bureau of the International Union for the Protection of Literary and Artistic Works.

7. "REPORT ON SINGLE COPIES"—JOINT LIBRARIES COMMITTEE ON FAIR USE IN PHOTOCOPYING

Editor's Note: We are indebted for the following report to Edward G. Freehafer, Director, The New York Public Library, and Chairman of the Committee.

Introduction

The Joint Libraries Committee on Fair Use in Photocopying was organized after the Association of Research Libraries had resolved in January, 1957 to lay on the table a proposed polity statement prepared by its Committee on Photocopying of Copyright Material (the "David Committee"). This committee had recommended that the question of Library duplication be referred to the Joint Committee, which consists of one representative from each of the following: the Association of Research Libraries (A.R.L.), the Special Libraries Association (S.L.A.), the American Library Association (A.L.A.) and the American Association of Law Libraries (A.A.L.L.). Representatives of the Council on Library Resources, Inc. and of the Library of Congress (Copyright Office) serve as consultants.

The present members of the Committee are Edward G. Freehafer, Chairman, representing A.R.L.; Richard E. Chapin, representing A.L.A.; Chester M. Lewis, representing S.L.A.; and Julius Marke, representing A.A.L.L. Verner W. Clapp, President, Council on Library Resources, Inc., and Abe A. Goldman, Chief of Research, Copyright Office, have participated as consultants. The late Arthur Fisher, Register of Copyrights, served as a consultant until his death in November, 1960.

The Committee has studied past attempts to define the position of libraries faced with a demand for reproduction of material in their collection, including:

1. The "Gentlemen's Agreement" of 1935 reproduced in The Journal of Documentary Reproduction, Vol. 2, No. 29 (1939) and the negotiations leading up to it.
2. The "Reproduction of Materials Code" prepared by Keyes D. Metcalf and adopted by the A.R.L. and adopted by the A.L.A. Council in 1940.
3. The David Committee proposals.

Several helpful articles have been studied; e.g., Study No. 10 in the General Revision of the Copyright Law, "Fair Use of Copyrighted Works" by Alan Latman, and Study No. 19, "Photoduplication of Copyrighted Material by Libraries" by Borge Varmer.

With a view to the question of Fair Use, the Committee conducted studies in two general areas—one of library practices, the other of demand. Counsel for the Committee has reviewed the legal issues and participated in the factual studies. On the basis of its findings and the opinion of counsel, the Committee is now in a position to recommend a Statement of Policy. A summary of the results of the Committee's studies is given in Appendix B.

Library practices were surveyed at three government libraries, three public libraries and four university libraries. Of these ten, five were studied in March 1959 and five in December 1959. Each reported, for a period of from one day to three months, orders for copies by subject matter and type of work copied, source of order, place and date of publication, and copyright status.

The first study of library practices indicated that The New York Public Library duplicating service offered the optimum in volume and diversity of demand, and NYPL was therefore selected as the principal location for intensive study. The services of NYPL employees were made available; a contract was entered into with Service Bureau Corporation (an IBM subsidiary); and a detailed punch card study of NYPL duplicating demand was conducted under the supervision of counsel in the spring of 1960 covering orders received in December 1959. At the same time, the December 1959 extension of the library practices study was conducted at five libraries. From this group, Princeton (Firestone Memorial Library) and from the first group, the University of Chicago (Harper Memorial Library), were selected for more detailed study to check the representative nature of NYPL demand and to determine whether any significant variations from the NYPL study existed at libraries with collections less heavily concentrated in technical fields. Orders received at each library during the last three months of 1960 and, in addition, those received at Chicago during December 1959, were studied.

Conclusions Drawn From the Studies

The studies establish that in meeting research demand the participating libraries do not adjust, and indeed are incapable of adjusting, their duplicating services to the complexities of copyright law and status and that each attempts to satisfy what it considers legitimate research demand. It is clear from the Committee's studies that the various codes and agreements heretofore proposed or adopted do not affect or reflect actual practice. Demand for copies is shown by the studies to be widely dispersed. The demand cannot be correlated with copyright status or with the advertising policies of publishers. Any economic damage to publishers or copyright owners through library duplication appears to be theoretical in view of the number of pages, dates of publication and variety of demand, revealed by the studies. The heavy corporate and institutional demand, which the studies show to be widely dis-

persed, negates any likelihood that demand for research photocopies is affected by costs.

Findings of the Committee

1. The making of a single copy by a library is a direct and natural extension of traditional library service.
2. Such service, employing modern copying methods, has become essential.
3. The present demand can be satisfied without inflicting measurable damage on publishers and copyright owners.
4. Improved copying processes will not materially affect the demand for single copy library duplication for research purposes.

Recommended Policy

The Committee recommends that it be library policy to fill an order for a single photocopy of any published work or any part thereof.

March 17, 1961

SUMMARY OF COMMITTEE STUDIES

(Condensed)

I. Library Practices

The Committee studied the copying done at five libraries in March, 1959 and at five different libraries in December, 1959. The March surveys were conducted at the Harper Memorial Library of the University of Chicago, the United States Department of Agriculture Library, the Library of Congress, the National Library of Medicine, and The New York Public Library, Astor, Lenox and Tilden Foundations. The December surveys were conducted at the Free Library of Philadelphia, the Firestone Memorial Library at Princeton University, the Los Angeles Public Library, the Library of the University of California at Berkeley, and the Libraries of the Massachusetts Institute of Technology. Of these, only the Library of Congress was able to give reliable information as to how much of the material affected by requests for copies was copyrighted.

A majority of the orders filled at each library surveyed, with the exception of the Harper Library at Chicago and the Firestone Library at Princeton, were requests for copies of works in the scientific and technical fields. A majority of the works copied at government libraries were reported to be foreign publications, and a majority of works copied at university and public libraries were reported to be domestic publications.

Although certain libraries reported that a majority of requests were received from individuals, a heavy majority of all copying reported by the libraries participating in the surveys was done on the request of corporate and other institutional users. A notable exception to the composite result was reported at Princeton where approximately three-fifths of the requests received during the survey period were from individuals.

Each library surveyed reported substantially more copying from periodicals than from books, and with the exception of the Library of Congress, the Harper Memorial Library

at Chicago and the Firestone Memorial Library at Princeton, each reported more copying from periodicals than from all other works combined. Orders were filled at each library surveyed without regard to the date of publication, and a composite majority of the works copied had been published within 10 years of the date on which the copy was made.

II. Demand for Copies

On the basis of the information obtained in the studies of library practices, the Committee, working with representatives of Service Bureau Corporation (an IBM subsidiary), prepared the data contents sheet for a detailed punch card study at The New York Public Library.

After completing study and analysis of the IBM punch card study at The New York Public Library, the Committee resolved to conduct surveys in depth at the University of Chicago and at Princeton University for the purpose of determining whether the punch card results were sufficiently representative of library practice to be considered definitive. The earlier survey of the library practices had shown that the majority of the copying done at Chicago and Princeton involved publications other than those in the scientific and technical fields, whereas the material copied at The New York Public Library was preponderately in scientific and technical fields. There follows a comparison of the results of The New York Public Library (punch card study) with the results of the studies in depth at Princeton and Chicago together with specific information obtained from each study:

1. Publication Date of Material Copied.

	<i>NYPL</i>	<i>Princeton</i>	<i>Chicago</i>
Percentage published in 20th Century	91.0%	83.7%	95.1%
Percentage published within ten years	57.9%	47.4%	37.0%
Percentage published within one year	13.3%	2.5%	6.0%

2. Number of Pages per Request.

	<i>NYPL</i>	<i>Princeton</i>	<i>Chicago*</i>
Percentage less than 20 pages	90.5%	86.9%	67.5%
Percentage less than ten pages	73.0%	69.7%	44.5%
Percentage less than five pages	45.0%	no data	21.5%
(*excluding theses)			

3. Kind of Material Copied.

	<i>NYPL</i>	<i>Princeton</i>	<i>Chicago</i>
Books	5.4%	25.8%	17.0%
Periodicals	92.1%	49.8%	71.9%
Maps	0.2%	5.1%	—
Music Text	0.05%	—	—
Music Notation	0.3%	—	—
Manuscripts	0.3%	14.2%	—
Prints, Pictures and Illustrations	0.55%	5.1%	—
Theses	—	—	11.1%

4. Origin of Work Copied.

	<i>NYPL</i>	<i>Princeton</i>	<i>Chicago</i>
Domestic	54%	60.8%	60.3%
Foreign	46%	39.2%	39.7%

5. Advertising.

Less than 10% of the material copied from at Princeton and Chicago carried important advertising. At The New York Public Library publications with important advertising of one kind or another accounted for 46% of all requests, but over 80% of such publications were at least one year old when the copies were requested, more than 70% were at least two years old and more than 63% were at least three years old. Over half (52.42%) of the publications copied from which carry important advertising and which were published within one year were of foreign origin. Accordingly, only 4.26% of total copying was done from recent domestic publications with important advertising.

6. At The New York Public Library.

A selected sample of approximately 25% of the punch cards, properly weighted to compensate for the fact that a longer period of time was used for credit account orders than for cash orders and quick copy orders, indicates that nearly 75% of the orders are received from large corporations. The corporate orders in this sample were dispersed over a total of 58 different three-place Dewey classifications. These classifications ranged from No. 020 to No. 745. This range excludes certain orders from publishing corporations and certain corporate specialties (e.g., Corning Museum) which involved material in the upper ranges of the Dewey classifications.

7. At Princeton.

(a) Thirty-five of the 122 instances of copying from books involved the copying of ten or more pages, and in 30 of those cases the number of pages copied was 20 or more. However, 21 of the books from which 20 or more pages were copied were not copyrighted (primarily because of expiration of copyright).

(b) Seventy-one of the 228 of the instances of copying from periodicals involved the copying of ten or more pages, including 16 instances of copying 20 or more pages.

(c) None of the instances of copying ten or more pages involved a periodical carrying more than incidental advertising. Only 15 of all the 228 instances of copying from periodicals involved periodicals carrying advertising.

(d) Thirty-five (about half) of the instances of copying ten or more pages from a periodical involved periodicals published within the past ten years. Only five of the instances of copying 20 or more pages from a periodical involved periodicals published within the last ten years.

8. At Chicago.

(a) Over 55% of all instances of copying 20 pages or more involved foreign publications.

(b) Over 70% of all instances of copying 20 pages or more involved publications more than ten years old at the time the copy was made, and 17% of all such instances involved publications over 60 years old.

(c) Only 10% of all instances of copying 20 pages or more involved domestic works published within ten years of the time the copy was made, and there were no instances of such copying within one year of the time the copy was made.

(d) Less than 10% of requests were from individuals. Libraries and other educational institutions accounted for 74.6% of all requests, corporations for 13.6%, and government agencies 1.9%.

General Comment.

C. In terms of potential damage to copyright owners the significant difference between the demand at NYPL (with its emphasis on scientific and technical works) and at Princeton and Chicago appears in the tendency, particularly apparent at Chicago, for the user to request a substantial number of pages of the work being copied. This tendency is counterbalanced both in the general percentage figures and the more detailed Princeton and Chicago analyses by the fact that a substantially higher percentage of copying at Princeton and Chicago, again particularly marked at Chicago, involved material more than ten years old and that relatively few instances of copying of 20 or more pages in fact involved recent publications.

Other differences in demand at the two classes of library collections are the somewhat larger percentage of domestic publications copied from at Princeton and Chicago and the substantially higher incidence of important advertising in the works copied from at NYPL (see Item B. 5 above).

D. *Representative Results.* Detailed punch card studies have been made of the three domestic publishing houses whose publications were most frequently copied.

These three publishers are the only domestic publishers accounting for as much as 1% of the material duplicated.

1. The most frequently copied publisher is a learned society. None of its publications are copyrighted although some of them do carry sections of advertising that are apparently important.

2. The second most frequently copied publisher is also a learned society, all of the publications of which are copyrighted. Nearly all carry substantial advertising. A total of nine different publications were copied from. Half of the publications copied from were over 12 years old. Less than 10% had been published within the year preceding the duplication by the Library.

3. The third most frequently copied publisher is a commercial publisher, all of whose publications are copyrighted. All carry advertising that is apparently important. A total of 22 different publications were copied from. Half of the orders involved publications published within six years of the date on which the copies were made. About 14% involved publications published within one year of the date on which the copies were made.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. UNITED STATES OF AMERICA AND TERRITORIES.

8. U. S. CONGRESS. HOUSE.

H.R. 9045. A bill to amend the Trading With the Enemy Act, as amended. Introduced by Mr. Harris, Sept. 5, 1961, and referred to the Committee on Interstate and Foreign Commerce. 8 p. (87th Cong., 1st sess.)

This bill would divest all vested enemy copyrights as a matter of grace, and provide the Attorney-General with the power to give the Library of Congress title to all vested or captured prints of films, some of which are already in the Library's possession.

9. U. S. CONGRESS. HOUSE.

H.R. 9198. A bill requiring announcement of the fact that music broadcast in connection with certain programs was recorded or otherwise reproduced in a foreign country. Introduced by Mr. Celler, Sept. 13, 1961, and referred to the Committee on Interstate and Foreign Commerce. 2 p. (87th Cong., 1st sess.)

This bill, which has the support of the American Federation of Musicians, is aimed at curbing the practice of using foreign reproduced music for television sound tracks in the United States.

10. U. S. CONGRESS. SENATE.

S. 2341. A bill to provide (1) criminal penalties for the counterfeiting of phonograph records and (2) civil remedies for infringement of mechanical rights in copyrighted music. Introduced by Mr. Fulbright, July 31, 1961, and referred to the Committee on the Judiciary. 2 p. (87th Cong., 1st sess.)

A companion bill to H.R. 6354 introduced by Mr. Celler, April 17, 1961. See 8 BULL. CR. SOC. 302, Item 274 (1961).

11. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Amending the Trading With the Enemy Act, as amended. Report to accompany S. 495, submitted by Mr. Eastland (for Mr. Johnston), Sept. 15, 1961. 21 p. (87th Cong., 1st sess., S. Rept. No. 1062.)

The report recommends "immediate and favorable consideration by the Senate" of S. 495 as amended by the committee. The bill, as amended, provides in part for "the divestment as a matter of grace and return to the persons entitled thereto of (1) copyrights; (2) rights or interests arising from prevesting contracts relating to copyrights; (3) trademarks; or (4) rights or interests arising from prevesting contracts relating to trademarks vested under the Trading With the Enemy Act after Dec. 17, 1941. Also, the Attorney General is directed to transfer vested prints of motion pictures to the Library of Congress.

2. FOREIGN NATIONS

12. CANADA. PARLIAMENT. *House of Commons.*

Bill C-112. An Act to provide for copyright in Canada and to implement the Universal Copyright Convention. First reading, June 19, 1961. [Introduced by] Miss LaMarsh. Ottawa, R. Duhamel, Queen's Printer and Controller of Stationery, 1961. 39 p. (4th sess., 24th Parliament, 9-10 Elizabeth II, 1960-61.)

A private member's bill to provide for a revision of the Copyright Act and for Canada's adherence to the U. C. C. The bill died with the adjournment of the Canadian Parliament.

13. DENMARK. *Laws, statutes, etc.*

Lov om ophavsretten til litterære og kunstneriske værker. [København, 1961] 8 p. "Lov nr. 158 af 31. maj 1961."

The text of the new Danish Law on Copyright in Literary and Artistic Works which became effective on Oct. 1, 1961.

14. DENMARK. *Laws, statutes, etc.*

Lov om retten til fotografiske billeder. [København, 1961.] 3 p. "Lov nr. 157 af 31. maj. 1961."

The text of the new Danish Law on Rights in Photographic Pictures which became effective on Oct. 1, 1961.

15. FINLAND. *Laws, statutes, etc.*

N:o 404: Lag om upphovsrärliga verk, given i Helsingfors den 8 juli 1961. *Finlands Förfatningssamling*, 1961, nos. 404-408, pp. 799-807.

The text of the new Finnish Law on Copyright in Literary and Artistic Works which became effective on Sept. 1, 1961.

16. FINLAND. *Laws, statutes, etc.*

N:o 405: Lag om rätt till fotografisk bild, given i Helsingfors den 8 juli 1961. *Finlands Författningssamling*, vol. 1961, nos. 404-408, pp. 808-810.

The text of the new Finnish Law on Rights in Photographic Pictures which became effective on September 1, 1961.

17. GREAT BRITAIN. *Privy Council.*

The Copyright (Foreign Television Broadcasts) Order, 1961. Made 26th May, 1961; laid before Parliament 1st June, 1961; coming into operation 1st July, 1961. [London, H. M. Stationery Off., 1961.] 2 p. (Statutory instruments, 1961, no. 993: copyright.)

"This order confers on television broadcasts made in France or Sweden by organisations constituted in or under the laws of the country in which the broadcasts are made, the same protection as is now enjoyed by television broadcasts made in the United Kingdom by the B.B.C. or the I.T.A. under the provisions of the Copyright Act 1956.

"The countries mentioned are, along with the United Kingdom, parties to the European Agreement on the Protection of Television Broadcasts concluded at Strasbourg on the 22nd June, 1960."

18. NORWAY. *Laws, statutes, etc.*

Loi no. 2 du 12 mai 1961 sur le droit d'auteur. *Interauteurs*, no. 143 (2d quarter 1961), 145-154.

An official translation of the new Norwegian copyright law.

19. NORWAY. *Laws, statutes, etc.*

Lov om opphavsrett til åndsverk m. v. *Norsk Lovtidend*, 1961, no. 18 (May 31, 1961), 377-391.

The text of the new Norwegian Law on Copyright in Literary and Artistic Works which became effective on July 1, 1961.

PART IV.

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

20. *Moger v. WHDH, Inc.*, 194 F. Supp. 605, 130 U.S.P.Q. 441 (D. Mass. May 1, 1961) (Sweeney, C.J.)

Action for copyright infringement. Defendant moved for summary judgment on the ground that plaintiff's copyright notices were defective.

Held: Motion Granted.

Plaintiff's cartoons, which were published in newspapers, carried a copyright notice consisting only of the symbol © and the year. The court found plaintiff's failure to comply with the requirement in 17 U.S.C. 19 that the notice include "the name of the copyright proprietor" to be a fatal defect. *Buck v. Liederkrantz*, 34 F. Supp. 1006 (E.D. Pa. 1937); *Goes Lithographing Co. v. Apt Lithographic Co.*, 14 F. Supp. 620 (S.D.N.Y. 1936). Nor did the fact that plaintiff's name was prominently displayed in the title ("About Faces by Art Moger") cure the defect, especially since another name, "Ned Jones," appeared in the art work.

There were copyright notices covering some of the newspaper issues in which the cartoons appeared, but this also failed to afford plaintiff copyright protection, *Mifflin v. R. H. White Co.*, 190 U.S. 260 (1903), since the publisher was not the "copyright proprietor" of the cartoons.

Plaintiff argued that the book in which these drawings were also published contained a "full and complete copyright notice". The court held, however, that since the notice was on the inside of the back page instead of on the "title page or the page immediately following," it was invalid. The court noted that "the decisions are uniform" that a misplaced notice is ineffective. *J. A. Richards, Inc. v. N. Y. Post*, 23 F. Supp. 619; *United Thrift Plan v. National Thrift Plan*, 34 F. 2d 579 (E.D.N.Y. 1929); *Krafft v. Cohen*, 117 F. 2d 579 (3d Cir. 1941); *Siewek Tool Co. v. Morton*, 128 F. Supp. 71 (E.D. Mich. 1934).

2. State Court Decisions

21. *Cascade Pools Corp. v. Consolidated Pools & Equip. Corp.*, 172 A. 2d 246, 130 U.S.P.Q. 282 (N.J. Superior Ct., Ch. Div., Union Co., June 21, 1961) (Herbert, J.)

Motion for interlocutory injunction in an action to enjoin defendant's misappropriation and use of certain magazine articles as unfair competition, and to enjoin defendant's use of a copyrighted drawing. Both plaintiff and defendant manufacture "do-it-yourself" swimming pool kits. Plaintiff had procured the publication in *Readers Digest*, *The Sunday News Coloroto* Section, and *The Family Handyman* of articles which depicted and described these pools and extolled their virtues, and defendant distributed reprints of the articles in promoting its own product. Some of the reprints contained added material which the plaintiff alleged, and the court held, amounted in effect to a false representation that defendant's product had been singled out for national publicity by the publications in question.

Held: Interlocutory injunction denied.

The Court said that "In exercising its ingenuity and spending its money to get these articles prepared, written and published the plaintiff was necessarily promoting public interest in all pools to which the published material would apply." Such material could be freely used by anyone without interference from plaintiff. Because neither the plaintiff nor its product were identified in the articles "in any way which is recognizable by the public," there was no palming off of defendant's product as plaintiff's. The court reasoned that since there is no general right to enjoin the false advertising of a competitor, *Handler, False and Misleading Advertising*, 39 Yale L.J. 22, 34-42 (1929); 1 Callmann, *Unfair Competition and Trademarks*, 2d Ed. 297-307; 4 *Rest. Torts* 761; Prosser, *Torts*, 2d Ed. 753-754, the use of the reprints could not be enjoined in the absence of palming off, and indicated that it would have reached the same result if the material reprinted from the three magazines had been "advertisements for the plaintiff and its products" instead of the planted publicity articles. Quoting from 52 *Am. Jur.* 116, p. 595, the Court said that without the element of palming off, "The general rule is that the appropriation of another's advertising matter or methods is not of itself unfair competition. . . ."

The plaintiff also alleged that the defendant had reproduced and used a drawing contained in plaintiff's copyrighted installation manual without the permission of the copyright proprietor (Spiegel, Inc.; not a party to this suit) or of plaintiff. The court found that defendant had

in fact copied the drawing, but held that this was not unfair competition because the drawing did not "identify in any way with the plaintiff the partly-finished pool which is depicted" and, therefore, that there was no palming off. The court stated: "Whatever the morals of the situation, material of this sort may be appropriated by others without giving the original user any cause of action." *Strubl, Inc. v. Relaxor Cushion Corporation*, 161 F. Supp. 826, 118 U.S.P.Q. 276 (S.D.N.Y. 1958). It refused to consider whether the copyright in the drawing appropriated by defendant was valid or infringed, since this is a question exclusively for the federal courts.

The rights of the publishers with respect to the reprints were not involved in the controversy.

22. *Franco v. National Telefilm Associates, Inc.*, N.Y.L.J. June 9, 1961, p. 15, col. 2. (N.Y. Sup. Ct., N.Y. Co. 1961.)

Action for fraud relating to sale of the exclusive right to distribute the film *Cyrano de Bergerac* in Italy and Trieste. Motion for summary judgment by defendant.

Defendant acquired the second run rights after the first run rights had expired, but did not obtain all the prints. After defendant sold an exclusive territorial license to plaintiff, it was discovered that the film was being distributed by others and shown in theaters in plaintiff's assigned territory. Defendant claimed that it was well known in the trade that unrecovered prints would be in existence after an extensive first run, and that it had not warranted that no one else could or would distribute the film.

Held: Motion denied.

The Court ruled that there were issues of fact and law which should be determined upon trial. It considered that the crucial question was whether "defendant was culpably at fault in selling the exclusive distribution rights."

Also of Interest:

23. *Holbrook v. United States*, 194 F. Supp. 252, 130 U.S.P.Q. 461 (D. Ore. Apr. 12, 1961) (Kilkenny, J.)

Action to recover overpayment of income tax.

Held: Judgment for defendant.

Rejecting plaintiff's contention that advances against future royalties on a book were loans to be repaid when the publisher deducted them from earned royalties, the court held that such advances were income when

received. On this basis, Holbrook had not earned 80% of his royalties from *The Age of the Moguls* in a single year and therefore was not entitled to the "spread-back" provisions of 26 U.S.C. 1302.

24. *Labr v. Adell Chemical Co.*, 195 F. Supp. 702 (D. Mass., June 29, 1961) (Caffrey, D.J.)

Action to recover for alleged imitation of plaintiff's voice and comedy style by a cartoon duck in a filmed commercial.

Held: Complaint dismissed.

The Court ruled that plaintiff had not made a showing of any applicable law under which this "label-less, anonymous tort" constituted an actionable wrong.

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

25. AMERICAN BAR ASSOCIATION. *Section of Patent, Trademark and Copyright Law*. 1961 committee reports to be presented at the Annual Meeting to be held August 4 to 10, 1961, St. Louis, Mo. Chicago, American Bar Center, 1961. 149 p.

Among the reports are included those of the Copyright Division committees dealing with the following subjects: copyright law revision, international copyright relations and conventions, Copyright Office affairs, program for revision of the copyright law, program for protection of industrial designs, related rights, and authors. (See Items 2 to 6, inclusive, *supra*.)

26. NATIONAL COUNCIL OF AMERICAN IMPORTERS, INC. How trademark and copyright laws affect imports; taken from transcript of luncheon meeting held under the auspices of the National Council of American Importers, Inc., New York, New York, Thursday, June 8, 1961. Speaker: Edward L. Gilmore. New York [1961.] 28 p.

An address by Mr. Gilmore, attorney, Penalties Section, Division of Entry, Value and Penalties, Bureau of Customs, followed by questions from the floor and the answers by Mr. Gilmore. The appendices contain the texts of the pertinent provisions of the Tariff, Trademark, and Copyright Acts, and the customs regulations on trademarks and copyrights.

2. Foreign Publications

1. In German

27. MESTMACKER, ERNST JOACHIM. Sind urheberrechtliche Verwertungsgesellschaften Kartelle? Berlin, F. Vahlen. ©1960. 40 p. (Internationale Gesellschaft für Urheberrecht. Schriftenreihe, Bd. 20.)

A legal opinion, written at the request of the West German performing right society, GEMA, on the following questions:

(1) How is the organization of GEMA, as regulated by its by-laws of April 9, 1955, to be judged under the [West German] antitrust law?

(2) From the point of view of comparative law, what is the position of ASCAP under the U. S. antitrust laws?

B. LAW REVIEW ARTICLES

1. United States

28. BIRCH, ROBERT L. Copyright and patent: promotion team for "useful arts." (43 *Journal of the Patent Office Society* 514-516, no. 7, July 1961.)

A brief note on the "manner in which the copyright system complements patents in promoting the progress of 'useful arts.'"

29. BLAISDELL, WILLIAM M. Facts concerning ornamental industrial designs. (5 *The Patent, Trademark, and Copyright Journal of Research and Education* 159-181, no. 2, Summer 1961.)

This paper, by an economist formerly on the staff of the Copyright Office, "is a previously unpublished study and is based upon the returns from a questionnaire sent in 1960 to a sampling of industrial companies interested in protection for ornamental designs." The questionnaire was prepared to secure information about (1) the general attitude of business men toward this problem; (2) the knowledge of business men concerning specific legislative design proposals; (3) the type of products involving ornamental industrial design; (4) the methods of design creation and the cost of ornamental industrial designs; and (5) the extent and frequency of copying of ornamental industrial designs.

30. CHOKA, ALLEN D. The television order letter; a primer and checklist. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 49-60, no. 1, June 1961.)

A discussion, through the format of an actual order letter that was executed between a major network and a major advertiser, of the television order letter which the writer defines as a "synopsis or short form of . . . contract" between sponsor and network and is "the initial document which permits the show to get started."

31. DERENBERG, WALTER J. Territorial scope and situs of trademarks and good will. (47 *Virginia Law Review* 733-750, no. 5, June 1961.)

A discussion of problems involved in the application of the principle of territoriality in international trademark law, with reference to the

"extent to which a trademark owner may exercise his alleged territorial dominion over the mark and the limitations which should be imposed upon him either for reasons of public policy or in objective consideration of actual 'public understanding' in other countries."

32. EHRLICH, THOMAS. Copyright of textile designs—clarity and confusion in the Second Circuit. (59 *Michigan Law Review* 1043-1052, no. 7, May 1961.)

A former law clerk of the late Judge Learned Hand comments favorably on the majority opinion delivered by Judge Hand in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F. 2d 487, 7 BULL. CR. SOC. 182, Item 243 (2d Cir. 1960), but is critical of the later decision in *H. M. Kolbe Co. v. Armigus Textile Co.*, 279 F. 2d 555, 7 BULL. CR. SOC. 292, Item 389 (2d Cir. 1960), with particular reference to the problem of the notice requirement for repetitive designs.

33. [GEEN, WILLIAM J.] "Copyright" protection for uncopyrightables: the common-law doctrines [by William J. Geen and Harry K. Schwartz]. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 61-109, no. 1, June 1961.)

Reprinted from 108 *University of Pennsylvania Law Review* 699-734, no. 5, Mar. 1960.

See 7 BULL. CR. SOC. 251, Item 339 (1960).

34. HASSON, JOHN V. Copyrights—rights of the Federal Government and its employees. (6 *Villanova Law Review* 531-549, no. 4, Summer 1961.)

The purpose of this comment, which has been entered in the Nathan Burkan Memorial Competition, is to "investigate the interrelation of the United States Government, its employees, and the general public in the field of copyright law, with emphasis on Section 8 of the copyright statute itself."

35. INABNIT, LINZA B. The unwarranted tax discrimination against creators of copyrighted works and literary, musical, or artistic compositions or similar properties. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 110-130, no. 1, June 1960.)

Reprinted from 47 *Kentucky Law Journal* 529-545, no. 4, Summer 1959.

See 7 BULL. CR. SOC. 110, Item 137 (1959).

36. LANDSBERG, BRIAN K. Copyrights: notice of copyright on textiles. (49 *California Law Review* 558-561, no. 3, Aug. 1961.)

A case note on the appellate decision in *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F. 2d 487, 7 BULL. CR. SOC. 182, Item 243 (2d Cir. 1960).

37. MCCANNON, MARJORIE G. Report on copyright law revision. *American Patent Law Association Bulletin* (July-Aug. 1961), 336-341.

A summary highlighting some of the principal recommendations of the *Report of the Register of Copyrights on the General Revision of the U. S. Copyright Laws*.

38. MCPETERS, THOMAS H. Taxation of literary property income. (12 *Mercer Law Review* 370-383, no. 2, Spring 1961.)

This paper, which was entered in the 1961 Nathan Burkan Memorial competition, analyzes the current status of literary property income in relation to the capital gains tax.

39. MAYER, MICHAEL F. Trouble about titles. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 1-7, no. 1, June 1961.)

A discussion of the legal rights and remedies in cases of conflicts between identical or highly similar titles in the entertainment industries.

40. Parody and the law of copyright. (29 *Fordham Law Review* 570-577, no. 3, Feb. 1961.)

An exploration of the case history, in the field of parody and burlesque, of the problem of how to distinguish between usage that is fair and that which infringes, "with the intention of evolving therefrom a workable and practical rule of law."

2. FOREIGN

(a) French

41. BLUM, ARNO A. La législation d'Israël sur le droit d'auteur et ses problèmes particuliers. *Interauteurs*, no. 143 (2d quarter 1961), 110-117.

A discussion of particular problems in connection with the present copyright law in Israel preceded by an explanation of the reasons the absence of a copyright law of Israeli origin and the fact that Israel ap-

plies, with some modifications, the U. K. Act of 1911 which is no longer in effect in Great Britain.

42. HESSER, TORWALD. La nouvelle legislation suedoise sur le droit d'auteur. (74 *Le Droit d'Auteur* 191-202, no. 7, July 1961.)

A commentary on the new Swedish copyright laws promulgated on December 30, 1960, effective July 1, 1961. The article includes the following footnote [translated]:

Since this article was written, revisions of copyright laws have also been accomplished in the other three North European countries. A new law was promulgated in Denmark on May 31, 1961, effective October 1, 1961. In Finland, the laws have been approved by the Parliament although not yet promulgated. In Norway, the law concerning copyright protection of photographic works was promulgated on June 17, 1960, and the copyright law was promulgated on May 12, 1961, effective July 1, 1961.

43. HESSER, TORWALD. Quelques questions concernant la future revision de la Convention de Berne. (74 *Le Droit d'Auteur* 238-243, no. 9, Sept. 1961.)

A discussion, from the Swedish point of view, of a number of problems concerning the forthcoming Stockholm Conference in 1965 for revision of the Berne Convention.

44. SANCTIS, VITTORIO M. DE. La revision de la loi sur le copyright aux Etats-Unis d'Amerique. *Interauteurs*, no. 143 (2d quarter 1961), 95-109.

A French translation of the author's article which appeared under the title "La revisione della legge sul copyright negli Stati Uniti d'America" in 32 *Il Diritto di Autore* 76 (1961). See Item 54, *infra*.

45. SANCTIS, VALERIO DE. Lettre d'Italie. (74 *Le Droit d'Auteur* 221-228, no. 8, Aug. 1961.)

A survey of recent Italian legislative and judicial developments in the field of copyright and related areas. A section on international copyright relations includes a brief discussion of certain problems arising out of the application of article 3—concerning the term of foreign works protected in Italy by virtue of the Universal Copyright Convention—of the Italian law implementing the Convention (Law no. 923 of July 19, 1956).

(b) French and English

46. BLUM, ARNO A. Lettre d'Israel. Letter of Israel. (74 *Le Droit d'Auteur* 244-253, no. 9, Sept. 1961.)

French and English in parallel columns. The French text of this article appeared under the title "La legislation d'Israel sur le droit d'auteur et ses problemes particuliers" in *Interauteurs*, no. 143 (2d quarter 1961), pp. 110-117. See Item 41, *supra*.

47. COLBY, RICHARD. Protection des oeuvres cinematographiques en vertu de la Convention universelle sur le droit d'auteur. (74 *Le Droit d'Auteur* 203-211, no. 7, July 1961.)

A discussion, in French and English in parallel columns, of copyright protection for cinematographic works under the Universal Copyright Convention, with emphasis on notice requirements. Includes appendices listing the member states of the Universal Copyright Convention as of July 1, 1961, and the respective dates on which the Convention became effective, and the relevant provisions of the French and Italian copyright laws.

(c) German

48. KASPERS, HEINRICH. Das Pflichtexemplarrecht. (17 *Börsenblatt für den Deutschen Buchhandel* Frankfurter Ausg. 373-379, no. 22, Mar. 17, 1961.)

An inquiry into the concept and history of legal provisions requiring publishers and printers to make deposits of books and other printed materials at selected libraries. The article, which is an excerpt from a forthcoming book by the same author, is concerned primarily with West and East German law, and includes a brief survey of legal deposit requirements in other countries.

49. MÜNZER, GEORG. Die Leistungsschutzrechte nach dem zweiten Entwurf des Gesetzes über das Urheberrecht. (9 *Erfindungs—und Vorschlagswesen*, Ausg. C. 236-237, no. 12, Dec. 1960.)

A critical comment on some of the provisions dealing with neighboring rights contained in the second draft of the East German copyright law.

50. PÜSCHEL, HEINZ. Das Urheberrecht als Teil des Zivilrechts. (10 *Erfindungs—und Vorschlagswesen*, Ausg. B. 85-92, no. 5, May 1961.)

Using as a basis the Soviet concept of copyright, a case is made for the integration of copyright law in East Germany with its civil law.

51. SCHÖNHERR, HANS JOACHIM. Zu einigen Fragen des Urheberrechtes auf dem Gebiete des Hoch—und Fachschulwesens. (9 *Erfindungs—und Vorschlagswesen*, Ausg. C. 237-241, no. 12, Dec. 1960.)

A discussion of some East German copyright problems in the field of higher and technical education, with reference to theses, inaugural dissertations, correspondence courses, research work, etc.

52. THIEME, FRANZ. Urheberrechtliche Bedeutung des Vermerkes "Als Manuskript gedruckt." (9 *Erfindungs—und Vorschlagswesen*, Ausg. C. 241-244, no. 12, Dec. 1960.)

Manuscripts. A discussion of the problem of determining whether or not a work bearing the phrase "Printed as manuscript" should be considered as published, in which a case is made for clarification of the significance of the phrase from the copyright point of view, in East Germany.

(d) Italian

53. SANCTIS, VALERIO DE. Sulla natura giuridica del diritto di autore. (32 *Il Diritto di Autore* 1-34, no. 1, Jan-Mar. 1961.)

A commentary on the legal nature of copyright and related matters within the framework of Italian law, but, according to the author, equally applicable to laws of other countries with analogous legal systems.

54. SANCTIS, VITTORIO M. DE. La revisione della legge sul copyright negli Stati Uniti d'America. (32 *Il Diritto di Autore* 76-100, no. 1, Jan.-Mar. 1961.)

Comments on those Copyright Office general revision studies "which deal with the most important problems, calling attention to the interests and currents of thought which are in conflict and the direction which probably will be followed in the future revision of the American copyright law." The comments are preceded by a sketch of the historic evolution of the revision of the Copyright Act.

55. VAUGHAN, DENIS. La pubblicazione per le stampe dell'opera musicale; opera originale e edizione critica. (32 *Il Diritto di Autore* 3-15, no. 1, Jan.-Mar. 1961.)

An expanded Italian version of the author's "The problem of moral rights in the preservation and availability of original musical scores," published in 8 BULL. CR. SOC. 81, Item 71 (1960).

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

56. GOTSHAL, SYLVAN. Why retailers should support laws to protect fashion designs. *Stores* (June 1961), 14-16.

An article on the problem of the retailer in facing the issue of design piracy. After an examination of existing legal protection, a case is made for a corrective legislation protecting creative designers and manufacturers of original designs, with special reference to the pending design bills, H.R. 6776 and S. 1884.

2. England

57. A New look at copyright; radical changes proposed in U. S. Report to Congress. *The Bookseller*, no. 2905 (Aug. 26, 1961), 1190-1196.

A summary of the recommendations of the *Report of the Register of Copyrights on the General Revision of the U. S. Copyright Laws*.

58. Young publishers hear librarians on public lending right. *Bookseller*, no. 2901 (July 29, 1961), 884-888.

A report of the July 1961 meeting of the Society of Young Publishers at which the new proposed Public Lending Right Bill in Great Britain was discussed by three speakers representing librarians.

59. NEW ADHERENCES TO THE UNIVERSAL COPYRIGHT CONVENTION.

Canada. According to *The New York Times* of Oct. 26, 1961, Noel Dorion, Secretary of State, Ottawa, has announced that Canada, which signed the Universal Convention in 1952, will ratify it at the next session of Parliament.

Ruanda-Urundi. UNESCO has advised the United States Department of State that Ruanda-Urundi has ratified the Universal Convention and Protocols 1, 2, and 3, effective from April 24, 1961. Deposit of the instrument of ratification was made by the Belgian Government, in accordance with Article XIII of the Convention, on behalf of the Trust Territory of Ruanda-Urundi, for which it has been the United Nations Trustee since 1946.

60. COPYRIGHT DECISIONS, 1959-60, BULLETIN 32, PUBLISHED.

The latest volume of *Decisions of the United States Courts Involving Copyright*, compiled and edited by Benjamin W. Rudd, Librarian of the Copyright Office, is now available. The volume contains all Federal and State copyright cases reported during the years 1959 and 1960, as well as cases involving related subjects in the field of intellectual property. This is the 16th volume in a series which covers substantially all U.S. cases on copyright and related subjects decided since 1909. Price of the volume is \$3.00.

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PARTICIPANTS IN THE AMERICAN BAR ASSOCIATION SYMPOSIUM ON REVISION OF THE COPYRIGHT LAW,
NEW YORK UNIVERSITY LAW SCHOOL, DECEMBER 1-2, 1961

Seated, l. to r.: Joseph Gray Jackson, Samuel W. Tannenbaum, Harriet F. Pilpel, The Hon. A. L. Kaminstein, *Register*,
Standing, l. to r.: Theodore R. Jackson, John R. Peterson, Sydney M. Kaye, Harry R. Olsson, Jr., The Hon. Robert J. Burton, Richard Colby, George D. Cary, John Schulman, Joseph A. McDonald, Walter J. Derenberg, Sidney A. Diamond, Theodore R. Kupterman, Horace S. Manges, and Joseph S. Dubin.

61. A.B.A. SYMPOSIUM ON COPYRIGHT LAW REVISION

A two-day symposium on Copyright Law Revision and the "Report to Congress of the Register of Copyrights on the General Revision of the U.S. Copyright Law" was held at New York University Law School on Dec. 1 and 2, 1961.

The program was divided into four panel discussions, each of which was opened by The Hon. A. L. Kaminstein, Register of Copyrights, or one of his associates, who were Barbara A. Ringer, Chief, Examining Division; Abe A. Goldman, General Counsel; and George D. Cary, Deputy Register. The subjects discussed included "Copyrightability and Formalities", "Rights and Remedies of Copyright Owners", and "Duration and Renewal"; the final session was devoted to the Report as a whole. At the close of each meeting, a member of the national panel of experts summarized the topic discussed and the questions raised. Summaries were made by Professors Walter J. Derenberg, of New York University Law School; Harry G. Henn, Cornell Law School; and Benjamin Kaplan, Harvard School of Law, and by Joseph A. McDonald, of the District of Columbia Bar.

The meeting was presided over by Samuel W. Tannenbaum, Chairman of the A.B.A. Copyright Division. John R. Peterson and Joseph S. Dubin, co-Chairmen of the Copyright Law Revision Committee, cooperated with Mr. Tannenbaum in planning the program, and Theodore R. Kupferman and Theodore R. Jackson served as a Committee on Arrangements.

Among the speakers were Dean Russell D. Niles, of New York University Law School, who opened the meeting; Joseph Gray Jackson, Chairman of the American Bar Association Section on Patent, Trademark and Copyright Law; the following were panel participants: Richard Colby, Sidney A. Diamond, Harriet F. Pilpel, Horace S. Manges, Harry R. Olsson, Jr., Herman Finkelstein, Judge Robert J. Burton, Irwin Karp, John R. Peterson, Sydney M. Kaye, John Schulman and Joseph S. Dubin.

This was the first major professional meeting devoted exclusively to a discussion of the recently published Report of the Register. The co-sponsors included The Copyright Society of the U.S.A., the Copyright Luncheon Circle, and these Bar Associations: American Patent Law, Bar of the City of New York, Federal Bar of New York, New Jersey and Connecticut, Federal Bar (Empire State Chapter), New York County Lawyers, New York Patent Law and the Women Lawyers of the State of New York.

PART I.

ARTICLES

62. THE GHOST OF *DONALDSON* v. *BECKETT*: AN INQUIRY INTO THE CONSTITUTIONAL DISTRIBUTION OF POWERS OVER THE LAW OF LITERARY PROPERTY IN THE UNITED STATES—PART I *

By JOHN F. WHICHER**

Do the dry bones of *Donaldson* v. *Beckett*¹ live again? Certain it is that the unlaidd ghost of a question that was asked nearly two centuries ago, when that "great cause concerning literary property" was up on appeal before the British House of Lords, still walks abroad. Today it haunts the constitutional

* © 1962 by John F. Whicher. This is the first part of a two-part article.

** Member, New York Bar. A.B., 1941, Amherst; LL.B., 1947, Columbia.

1. 7 Bro. P.C. (1st ed.) 88, or (as it is customarily cited, referring to the second edition) 2 Bro. P.C. 129; 1 Eng. Rep. 837 (H.L. 1774); also, *sub nom.* *Donaldsons* v. *Becket*, as an appendix to *Millar* v. *Taylor*, 4 Burr. 2303 at 2408, 98 Eng. Rep. 201 at 257 (K.B. 1769). Two very full accounts of the *Donaldson* case, each by an anonymous reporter, appeared in London in 1774. One of these is a 39-page pamphlet, bearing the title: "The pleadings of the counsel before the House of Lords in the great cause concerning literary property; together with the opinions of the learned judges on the common law copyright of authors and booksellers, to which are added the speeches of the noble lords who spoke for and against reversing the decree of the Court of Chancery." This report (hereinafter cited as *Anon., Plead.*) is available in the New York Public Library, where it is catalogued under the name of Alexander *Donaldson*. The second anonymous report of the case is a 68-page pamphlet entitled, "The cases of the appellants and respondents in the cause of literary property before the House of Lords; wherein the decree of Lord Chancellor Apsley was reversed, 26 Feb. 1774. With the genuine arguments of the council [*sic*], the opinions of the judges, and the speeches of the lords, who distinguished themselves on that occasion. With notes, observations and references. By a Gentleman of the Inner Temple." The writer gratefully acknowledges the kindness of the Librarian of the Harvard Law School in furnishing a microfilm of this document (hereinafter cited as *Gentleman, Cases*). An obvious (though unacknowledged) paraphrase of the last-cited pamphlet report appears in 17 Cobbett's *Parl. Hist. of England*, 953 *et seq.* (1813). That paraphrase was embellished with summary statements of the answers of each of the judges to the questions posed by the House of Lords. These added summaries may have been derived from 4 Burr. at 2408, *supra*; but see text accompanying notes 87 through 90, *infra*. The brief description of *Donaldson* v. *Beckett* which appears in footnote (d) to the report of *Tonson* v. *Collins*, 1 W. Bl. 321, 345, 96 Eng. Rep. 180, 191, did not appear in the original edition of Blackstone's Reports (1781), but was added thereto by the editors of the second edition, first published in 1828.

foundations of American copyright law, seeking the requiescat of a final answer. The question is this: does a statute which secures to authors² an exclusive property right in their published works for an expressly limited period of time necessarily replace and cut short, by implied preemption,³ a common law right of similar character but of longer (perhaps perpetual) duration? To use the exact language of the House of Lords, does such a statute "impeach or take away" such a common law right?

By the *Donaldson* decision, England is thought to have answered this question, at least temporarily, with a qualified affirmative.⁴ A minority of American judges have also adopted that position; and they have done so in even more positive terms than did their counterparts in England. Among our

2. Unless otherwise stated, or otherwise clearly indicated by the context, the term "author", as used throughout this article, refers to the creator of *any* kind of original literary, musical, or artistic work which has achieved a recorded form susceptible of communication in manifold copies, whether such form be visually or acoustically recorded. The term thus includes, *inter alia*, writers, painters, sculptors, composers, film producers, photographers, architects, and even performing artists whose original interpretative renditions of plays, songs, or other works are captured and manifolded on film, disc, or (perhaps) tape.
3. "Preemption" refers to the supplanting of an existing body of law by a second, later-created law or group of laws dealing with the same subject matter, when the later rule has been promulgated by a law-making authority superior to that which originated the supplanted rule or rules. The term has recently come into legal usage, in this sense, in connection with the displacement of state common law rules or statutes by federal enactments. See, e.g., *Weber v. Anheuser-Busch, Inc.*, 348 U.S. 468, 473, 480 (1955); *Algoma P. & V. Co. v. Wisconsin Emp. Rel. Bd.*, 336 U.S. 301, 306 (1949). This usage is here broadened to include within the meaning of the term the supplanting of merely judge-made rules of law ("common law") by *any* legislative enactment, whether state or federal. Preemption is "implied" when (a) the legislature has passed a statute which trenches upon the field covered by an earlier rule of inferior provenance; (b) the legislature has not explicitly declared that its enactment shall (or shall not) preempt such earlier rule; and (c) the courts infer, from such hints as the statute and its history may afford, that the enactment was either *meant* to be preemptive, or that the public policy which the statute seeks to express can best (or can only?) be effected by treating it as preemptive. See Note, *The Supreme Court, 1959 Term*, 74 *Harv. L. Rev.* 81, 132-35 (1960).
4. The answer was "qualified": see *Beckford v. Hood*, 7 *Term. Rep.* 620, 101 *Eng. Rep.* 1164 (K.B. 1798) (granting actual damages—a common law remedy not conferred by the statute). The answer was "temporary": see the opinions of Lords Brougham and St. Leonards in *Jefferys v. Boosey*, 4 *H.L.C.* 815, 960-68, 976-80, 10 *Eng. Rep.* 681, 738-41, 744-45 (H.L. 1854), taking the view that the common law copyright of an author's work terminated at publication of its own force, without regard to the statute. For the doubtful character of the traditional rendering of the answer given to the last one of the three decisive questions in *Donaldson v. Beckett*, *supra* note 1, see text accompanying notes 73-96 *infra*.

jurists of this school, the late Judge Learned Hand was undoubtedly the ablest and most respected. In at least four opinions written for the Court of Appeals for the Second Circuit, he declared that the public policy of our copyright statute cuts off all common law property rights in published literary or artistic creations.⁵ In a fifth and more recent case, however, he found himself for the first time expounding that position as a dissenter.⁶ He was then compelled to acknowledge that in two, at least, of his four earlier decisions, the issues had not truly warranted raising the problem of preemption.⁷ Since the same observation can demonstrably be made concerning the two remaining cases in Judge Hand's early quartet, his admission relegated to the category of dicta *all* his prior declarations on the subject.⁸ Indeed, it did more. It cast a

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5. *G. Ricordi & Co. v. Haendler*, 194 F.2d 914, 915 (2d Cir. 1952); *National Comics Publications v. Fawcett Publications*, 191 F.2d 594, 598 (2d Cir. 1951); *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86, 88-90 (2d Cir.), cert. denied, 311 U.S. 712 (1940); *Fashion Originators Guild v. F.T.C.*, 114 F.2d 80, 83 (2d Cir. 1940), aff'd, 312 U.S. 457 (1941).
 6. *Capitol Records v. Mercury Records Corp.*, 221 F.2d 657, 664 (2d Cir. 1955).
 7. In the *RCA* and *Fashion Originators* cases, *supra* note 5, Judge Hand applied "federal law" to reach his holding that the public sale of artistic works which were not covered by the copyright act would divest their creators of all exclusive rights of ownership therein. In affirming the *Fashion Originators* case, the Supreme Court indicated its disapproval of Judge Hand's unqualified application of federal law to this problem by declaring that the question whether or not the piracy of such published works was wrongful at common law ("tortious") was, at least in the first instance, one to be resolved by reference to state law, 312 U.S. at 468. Accordingly, in the *Capitol Records* case, *supra* note 6, the majority of the court followed the state common law in protecting a phonograph record company against piracy of its publicly sold discs. Judge Hand, dissenting, argued that the Constitution itself required the states to accede to a doctrine of at least ultimately divestitive publication. 221 F.2d at 664 *et seq.* In doing so, however, he declared (221 F.2d at 666): "We did not indeed have to say what law governed that question in either *Fashion Originators Guild v. Federal Trade Commission*, *supra*, or *RCA Mfg. Co. v. Whiteman*, *supra*, for we had no reason to anticipate that the [common] law of New York would take a different view . . ."
 8. In *National Comics Publications v. Fawcett*, *ubi supra* note 5, Judge Hand went visibly out of his way to suggest that a federal doctrine of "forfeiture," impliedly imposed by the copyright statute, should be substituted for the rather illogical common law doctrine of "dedicatory publication." See *infra*, text accompanying notes 14-15. The suggestion was not necessary for the decision of that case, however, since the result reached would have been the same whichever doctrine was applied. In *G. Ricordi & Co. v. Haendler*, *ubi supra* note 5, Judge Hand again exercised his preference for referring to federal rather than state law to determine the extent to which authors' rights are lost at publication; but since he acknowledged that it was "doubtful" that the New York courts, applying their own law, would have reached a different result on the facts of that case, the necessity for deciding the choice of law point was again lacking. Cf. *Desclee & Cie. v. Nemmers*, 190 F. Supp.

similar doubt upon the authoritative force of every pronouncement favorable to federal copyright preemption which the courts of this country have uttered down the years; for in no such case did the facts call for a determination of that issue. This is true, for example, of the well-known decision in which the highest court of the State of New York made the following magisterial observation:⁹

"No proposition is better settled than that a statutory copyright operates to divest a party of the common law right."¹⁰

The blunt fact is that there is probably no proposition in American law that is *less* well settled than this. With the possible exception of one obscure opinion by an inferior New York tribunal,¹¹ which achieved a glory not altogether its due on the pages of Bowker's distinguished treatise on copyright,¹² no American court has ever actually *held* that our copyright statute

381 (E.D. Wis. 1961), reaching the same result on the merits, in a case presenting a similar state of facts, but applying state law (in a jurisdiction which has yet to develop an independent jurisprudence of its own on this subject).

9. *Jewelers' Mercantile Agency v. Jewelers' Weekly Pub. Co.*, 155 N.Y. 241, 247, 49 N.E. 872, 873 (1898).
10. Plaintiff had claimed that it was rightfully suing in the state court for infringement of its common law copyright, despite the fact that it had distributed printed copies of its work with statutory notice of copyright thereon. It contended that its method of distribution (leasing) did not constitute an investitive "publication" of its work under the federal Copyright Act of the time. The court observed that if the plaintiff's distribution *were* a "publication" within the meaning of the federal Act, the plaintiff *would* have secured a federal copyright thereby; and it concluded these plainly hypothetical observations with the statement quoted in the text. It then declared (*ubi supra*, note 9): "But publication operates to destroy the common law right whether a [statutory] copyright be secured or no." The opinion then went off on the common law question of *divestitive* publication; the problem of *investitive* publication under the federal statute was never decided and did not have to be. The statement quoted in the text, in short, was pure dictum. Its repetition, fifty years later, in *Tams-Witmark Mus. Library v. New Opera Co.*, 298 N.Y. 163, 172, 81 N.E. 2d 70, 73 (1948), was equally unnecessary to the point of decision in that case.
11. *Washington Irving's Heirs and G. P. Putnam & Sons v. Pollard & Moss*, 18 Daily Reg. 705, col. 1 (N.Y. Sup. Ct., Oct. 13, 1880). The following sentence constitutes all that the court said on the subject: "I consider it well settled by authoritative adjudications that an author has no common law right of property in literary works after publication *id est* by printing and sale, and *even had it existed the right was taken away by the Act of Congress relating to copyright.*" (Emphasis added.) It might well be argued that the italicized statement was mere hypothetical dictum, rather than an alternative holding.
12. Bowker, *Copyright, Its History and Its Law*, 40-41 (1912), where the Irving case, *supra* note 11, is discussed *sub nom.* *Putnam v. Pollard*. Bowker not only attaches more importance to the observations of an inferior state court, untested by appeal,

forbids the protection of published works at common law.¹³ Instead we have insisted that it was the author himself who cut short his common law right to dispose of his own creations as he might see fit.¹⁴ We have reached this remarkable conclusion by means of a legal fiction: the common law doctrine of "dedicatory publication."

According to that doctrine, our common law conclusively presumed that an author, simply by publishing his work, made a present of his right of ownership therein to his "*hypocrite lecteur*," the general public. From this premise there flowed, as a natural corollary, the view that the function of our copyright enactments was to give back to the author the proprietary right in his own creation which he had, in legal supposition, so thriftlessly given away to us all at just that moment when its continued exercise might conceivably have begun to be economically rewarding to him. But the author lost by this exchange; for our statutory present to him was a good deal less generous than his presumptive common law gift to us. It was not his old right of absolute ownership that we returned to him, but a "new" right, "created" by our statute, subject to prescribed conditions, and (above all) enjoyable only for a limited period of time. When that time expired, so did

on a point of federal law, than such pronouncements have normally been thought to deserve, but he also finds greater significance in an unreported (oral?) argument of counsel in that obscure case than was accorded to it by the court which heard it; for no mention of the argument is made in the decision.

13. We have already mentioned most of the familiar dicta. We may here notice one more. In *Holmes v. Hurst*, 174 U.S. 82, 85 (1899), the Supreme Court said, in passing, that "while a right [in published works] did exist at common law, it has been superseded by statute." This dictum rested, however, upon a clearly erroneous reading of *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), which did *not* hold that the federal statute preempted ("superseded") the common law right, but held only that the common law right ended of its own force at publication, so that the statutory right simply *succeeded* it. The blunder has not been repeated in any of the Supreme Court's later dicta on the subject. See, e.g., *Mazer v. Stein*, 347 U.S. 201, 214-15 (1954); *Fox Film Co. v. Doyal*, 286 U.S. 123, 127-28 (1932).

Two other well-known cases favorable to federal preemption of the law of literary property (both of which concern unpublished works) are discussed in note 33, *infra*.

14. "It is not by virtue of any statute that it has been decided the publication of a book . . . is a surrender by the author of his common law rights and a dedication to the public unless protected by copyright under statute. The basis of such decisions is, that by causing the book to be printed without the protection of the [statutory] copyright the author is deemed to have relinquished all rights, both common law and statutory, and to have dedicated his protection to the public . . ." *Frohman v. Ferris*, 238 Ill. 430, 440, 87 N.E. 327, 329 (1909), *aff'd*, *Ferris v. Frohman*, 223 U.S. 424 (1912). See, also, *Wheaton v. Peters*, *supra* note 13; *Palmer v. DeWitt*, 47 N.Y. 532, 536 (1872); *Banker v. Caldwell*, 3 Minn. 94 (1859) (*dictum*).

our gift; thenceforth (thanks to the earlier operation of the common law fiction of "dedicatory publication"), the author's right "reverted to the public domain" (i.e., we took our present back again), this time for good.¹⁵

As a result of our professed belief in this mythical exchange, it became part of our accepted legal orthodoxy that the common law protected an author's rights only before publication; thereafter all his proprietary interest in his own work was exclusively derived from the statute. The two forms of copyright (common law and statutory) were thus thought to be entirely discrete; and since, upon this analysis, it was self-evident that they would not conflict, it seemed equally clear that the problem of preemption could never arise. Consequently, the great majority of the American courts have felt no need to ask, much less to answer, the troublesome question posed by their Lordships of England in the *Donaldson* case. The common law doctrine of dedicatory publication sufficed to serve us as the good fence that made good neighbors of common law and statutory copyrights.¹⁶ Thus, the Court of Appeals for the Ninth Circuit recently observed:¹⁷

"By the common law, the author of a writing possesses the sole and exclusive right to publish it, but upon and after the first publication the writing may be published by anyone including the author, since the writing has gone into the public domain . . . The copyright statute extends the author's sole and exclusive right in accordance with its terms and provisions . . . In other words, it reserves the writing from the public domain for the effective period of the copyright. What we have just said is what is meant by courts when they say: 'When the copyright comes in, the common law right goes out.'" (Emphasis added.)

But the peace achieved by this arbitrary division of authority, though it lasted for a surprisingly long time, could not last forever. "Something there is that doesn't love a wall"¹⁸—in the realm of rights as in the world of nature. Since 1918, new substantive rules, evolved by that rapidly expanding body of common law doctrines called "unfair competition," have seriously undermined and upset the "good fence" of dedicatory publication. In the second installment of this article, we shall consider these developments

15. *Mazer v. Stein*, *ubi supra* note 13; *Fox Film Corp. v. Doyal*, *ubi supra* note 13; and see *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 439-40 note 5, 194 A. 631, 634 note 5 (1937) (dictum).

16. Weil, *American Copyright Law*, 101-04 (1917); Rothenberg, *Legal Protection of Literature, Art and Music*, 5-6 (1960).

17. *Warner Bros. Pictures v. Columbia Broadcasting System*, 216 F.2d 945, 948 (9th Cir. 1954) (dictum).

18. Frost, "Mending Wall," *Complete Poems*, 47 (Holt, Rinehart and Winston, Inc. 1949).

in more detail. For present purposes, however, it is enough to note: (1) that these new common law rules recognize and protect authors' rights to their own works as property rights, both before and after publication;¹⁹ (2) that these new common law rights are not lost when the author takes out a statutory copyright;²⁰ and (3) that the "unfair competition" rights of authors *may* even survive the term of statutory copyright protection.²¹ Accordingly, the traditional theory by which the boundary line between statutory and common law rights in literary and artistic properties was once defined has now lost a substantial part of its once self-evident validity. Under the circumstances, we can no longer rely on the doctrine of dedicatory publication to sweep the *Donaldson* question tidily under the rug.

Upon inspection, that question turns out to be one of unexpected magnitude. For, when the ghost of *Donaldson v. Beckett* goes west to America, it takes on alarming constitutional dimensions. To oversimplify: our copyright statutes are federal enactments; our common law is of state creation.²²

19. *International News Service v. Associated Press*, 248 U.S. 215 (1918); *Capitol Records v. Mercury Records Corp.*, *supra* note 6; *Haeger Potteries v. Gilner Potteries*, 123 F. Supp. 261 (S.D. Cal. 1954); *Hesse v. Grossman*, 152 Cal. App. 2d 536, 313 P.2d 625 (1957); *McCord v. Plotnick*, 108 Cal. App. 2d 392, 239 P.2d 32 (1951); *Dior v. Milton*, 9 Misc. 2d 425, 155 N.Y.S. 2d 443, *aff'd*, 2 App. Div. 2d 878, 156 N.Y.S. 2d 996 (1956); *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S. 2d 483 (1950), *aff'd*, 279 App. Div. 632, 107 N.Y.S. 2d 795 (1951).
20. This seems a fair implication from the terms of 28 U.S.C. §1338(b), conferring a pendent jurisdiction over unfair competition cases when substantially related to claims of copyright, patent, or trademark infringement. See: *Hurn v. Oursler*, 289 U.S. 238 (1933); *Hygienic Specialties Co. v. H. G. Salzman, Inc.*, 189 F. Supp. 790 (S.D.N.Y. 1960); *Robertson v. Batten, Barton, Durstine & Osborne, Inc.*, 146 F. Supp. 795 (S.D. Cal. 1956).
21. Cf. *Ronson Art Metal Works v. Gibson Lighter Mfg. Co.*, 205 Misc. 155, 127 N.Y.S. 2d 786 (1953), modified, 283 App. Div. 937, 130 N.Y.S. 2d 814 (1954), protecting inventions, even after the expiration of the patents thereon, on grounds of unfair competition (but the holding of the lower court on this point was seriously weakened by the modification which the appellate court effected in its decree). See, also, *S. J. Charia & Co. v. U.S.*, 135 F. Supp. 727, 735-39 (Customs Ct. 1954), *aff'd* on other grounds, 248 F.2d 124 (Cust. & Pat. App. 1956) (decision based on federal statute). The point is still somewhat uncertain, and is subject to much future development. See, e.g., *American Safety Table Co. v. Schreiber*, 269 F.2d 255 (2d Cir.), cert. denied, 361 U.S. 915 (1959), decree modified, 287 F.2d 417 (2d Cir. 1961). A good general discussion of the problem appears in 1 Callmann, *The Law of Unfair Competition and Trade Marks*, §16.2(d), especially at p. 202, and §17.2(a), especially at p. 221 note 93 (1945).
22. State copyright statutes are collected and summarized in Rothenberg, *Copyright Law, Basic and Related Materials*, 618-42 (1956). The existence of a "federal common law" has been much debated ever since *Erie R. Co. v. Tompkins*, 304 U.S. 64

Accordingly, when we ask whether a federal copyright statute impliedly supplants concurrent state common law protections for authors' works, we find ourselves at once embroiled in the always delicate and difficult task of adjusting state and federal powers.

Proponents of federal preemption in this field have developed three distinct but loosely interrelated theories to support their contentions. The first of these is that the patent-copyright clause in the Constitution²³ forbids, by necessary implication, and of its own force, the exercise of state power to protect any form of published intellectual property without at least some recognition of, and obedience to, a federally created time limit. We may call this the theory of *constitutional preemption*. It is, at present, chiefly supported by Judge Hand's dissent in the *Capitol Records* case,²⁴ and by a brief passage in Professor Crosskey's over-tendentious treatise on the Constitution.²⁵ With the latter we need not be seriously concerned;²⁶ but Judge Hand's opinions will always justly command respectful attention, even when uttered in dissent. As we shall have occasion to see, however, there are good reasons why his views on this matter did not carry persuasion with them.

The second theory declares that the federal statute "occupies the field" of legal protection for authors' published works and thus, under the supremacy clause, excludes any exercise by the states of the power to protect published "Writings" (in the constitutional sense of the quoted term²⁷).

(1938), perhaps somewhat too sweepingly, announced its demise. Compare 1 Moore, Federal Practice (2d Ed.) §§0.318-0.327 (1959), with Hill, The Erie Doctrine and the Constitution (I), 53 Nw. L. Rev. 427, 437-47 (1958).

23. U.S. Constitution, Art. I, §8, cl. 8, quoted *infra* in text accompanying note 36.

24. *Capitol Records v. Mercury Records Corp.*, *ubi supra* note 6.

25. I Crosskey, Politics and the Constitution in the History of the United States, 477-86 (1953). Cf. Sutherland, Book Review, 39 Cornell L.Q. 160 (1953).

26. See, *inter numeros alia*, Hart, Professor Crosskey and Judicial Review, 67 Harv. L. Rev. 1456 (1954); Goebel, Ex parte Clio, 54 Colum. L. Rev. 450 (1954); Sutherland, *supra* note 25. For specific criticisms of Professor Crosskey's analysis of the patent-copyright clause, see *infra* notes 125 and 138.

27. There has been no definitive adjudication by the Supreme Court of the meaning of the term "Writings" in the patent-copyright clause; but the consistent trend of legislative action (and of judicial constructions thereof), throughout the whole history of American copyright law, has been *toward* treating as "Writings" every humanly-created expression of thought or sentiment, embodied in any physically recorded, communicable form, which exhibits the least degree of originality. Note, The Meaning of "Writings" in the Copyright Clause of the Constitution, 31 N.Y.U. L. Rev. 1263 (1956). A physically recorded form of expression need not be *visually* communicable in order to fall within the category of "Writings", thus defined; purely *acoustical* recordings are also within the potential reach of Congressional action under the clause, though they have not yet been brought directly under the shelter of our copyright statute and are expressly excluded from the coverage of

This theory, which we may call one of *statutory preemption*, has been brilliantly expounded in a recent law review article.²⁸ Unhappily (for purposes of our present inquiry), the authors of that article were more concerned to show how their theory would work out in practice than they were to grapple with two basic questions: (1) Does a constitutional clause that speaks, in terms, only of "securing" authors' rights, and declares that the power it grants may only be exercised "for limited Times", confer on Congress any authority *permanently* to *take away* any state-created rights of authors? (2) Assuming, *arguendo*, that it does so, what is there in the language or legislative history of our present copyright statute to justify the conclusion that Congress has, in fact, intentionally exercised such a preemptive authority?²⁹

the only major international copyright convention to which this country is a party. *Capitol Records v. Mercury Records Corp.*, *supra* note 6, 221 F.2d at 660 and (dissenting opinion) 664; Sargoy, UCC Protection in the United States: The Coming into Effect of the Universal Copyright Convention, 33 N.Y.U. L. Rev. 811, 830-42 (1958); Kaplan, Performer's Right and Copyright: The Capitol Records Case, 69 Harv. L. Rev. 409 (1956).

28. Kalodner & Vance, The Relation Between Federal and State Protection of Literary and Artistic Property, 72 Harv. L. Rev. 1079 (1959). See, also, Comment, 70 Harv. L. Rev. 1117, 1120 (1957); Kaplan, *supra* note 27.

It should, perhaps, be stressed at this point that the writer of this article does not propose herein to choose between the alternative views of public policy which would either foster or forbid the development of state common law protections for published literary or artistic works. The problem confronted in these pages relates to the limits which the Constitution may impose upon the freedom of Congress, and of the states, respectively, to make such a choice, wisely or otherwise. We are concerned, in other words, with the scope and effect of a particular constitutional *power*, rather than with the conflicting social values that would be expressed or inhibited by any particular mode of *exercising* that power. Justice Holmes's famous dictum that the constitution "does not enact Mr. Herbert Spencer's Social Statics" stands as a constant reminder of the importance of keeping these two questions distinct. *Lochner v. N.Y.*, 198 U.S. 45, 75 (1905) (dissent).

29. Kalodner & Vance, *supra* note 28. The cited article is not wholly silent on the second question; for the authors do offer some ingenious constructions of the language of our present copyright statute (17 U.S.C. §1 *et seq.*) to undergird their suggestion that the Act is preemptive of common law rights. See, e.g., 72 Harv. L. Rev. at 1091, 1092 and 1095. It is submitted with deference, however, that their interpretations are too far-fetched; it seems almost wildly improbable that Congress could ever have meant the statute to bear so heavy a weight of *implied* significance on so important a point. The main difficulty stems from the fact that the common law of the several states did not really begin to protect authors' property rights in published works until the Supreme Court gave a green light to such a development in 1918—nearly ten years after the Act was passed. *International News Service v. Associated Press*, *supra* note 19. The statute, therefore, antedates the beginning of any real need to consider the question of preemption. Messrs. Kalodner & Vance

The third theory modifies the doctrine of statutory preemption by introducing an element of individual choice, and may therefore be called the theory of *elective preemption*. According to this view, common law and statutory copyrights co-exist, but only as alternatives; once an author has chosen to exploit his work under one mode of protection, he loses his right to the other. The theory has thus far chiefly found support in cases dealing with unpublished copyrightable works which may be marketed commercially in ways which the common law does not recognize as "dedicatory" publications.³⁰ A few cases apply the theory to published works as well, but their authority is doubtful.³¹ Moreover, the great majority of decisions supporting this theory prove, on analysis, to represent nothing more than a normal application of the doctrine of election of *remedies*: an author who successfully sues an infringer under the federal act is thereby barred from suing the same infringer for the same wrong under the state common law. Such a rule is necessary to avoid the injustice of granting two cumulative monetary recoveries for the same injury. But such cases do not hold that the author is precluded by his choice from suing under either system of law, at a later date, to recover damages for other infringements, whether committed by the same or by other infringers.³² So complete a preclusion as that would be could only result from an election of *rights*. Under such an election, an author, simply by securing a federal copyright for his work, would be deemed automatically to have renounced forever any protection for that work under state common law. The only case to *hold*, clearly and directly, that an election of this order flows from an author's registration of his work for federal copyright is not well reasoned; for it flies in the face of an important section of the Copy-

are to be commended, however, for their almost unique appreciation of the fact that federal preemption is not an automatic consequence of the mere exercise of Congressional power: there must be some basis in the clearly ascertainable legislative purpose, if not in the actual language of the statute itself, to justify the conclusion that the Copyright Act is, in fact, preemptive. Cf. Note, The Supreme Court, 1959 Term, *supra* note 3, at 132-33.

30. Swanson Mfg. Co. v. Feinberg-Henry Mfg. Co., 147 F.2d 500, 503-04 (2d Cir. 1945); Press Pub. Co. v. Monroe, 73 Fed. 196, 199 (2d Cir.), app. dism. for lack of substantial federal question involved, 164 U.S. 105 (1896); Loew's Inc. v. Superior Court, 18 Cal. 2d 419, 115 P.2d 983 (1941); Palmer v. DeWitt, *supra* note 14; Woolsey v. Judd, 4 Duer 379, 11 How. Pr. 49 (N.Y. Super. 1855).
31. G. Ricordi & Co. v. Haendler, *supra* note 5; but cf. notes 6-8 inclusive, *supra*, and accompanying text. See also G. Ricordi & Co. v. Paramount Pictures, 189 F.2d 469, 471 (2d Cir.), cert. denied, 342 U.S. 849 (1951) (dictum).
32. E.g., Swanson Mfg. Co. v. Feinberg-Henry Mfg. Co., *supra* note 30. See, generally, Note, Problems of Parallel State and Federal Remedies, 71 Harv. L. Rev. 513, 523-25 (1958).

right Statute.³³ At all events, none of the cases which expound the theory of elective preemption (including the one last mentioned) have confronted the two fundamental questions we have previously raised concerning the doctrine of statutory preemption: they neither identify the constitutional source of the supposed power of Congress to compel an author to choose between the two systems of protection, nor do they point to any language in the statute which convincingly shows a Congressional intent to exercise such a power (if it exists).

The fascinating but secondary problems of Congressional intent and legislative construction raised by the two theories of statutory and elective preemption are beyond the scope of this article. Our concern is with the begged question whether the constitutional presuppositions underlying all *three* preemptive theories are valid or not. The lack of decisive authority on this subject is not hard to understand. Our courts don't like to determine constitutional problems unless absolutely necessary. Although there is much wisdom in this cautious policy, it has occasionally been carried to excess; at times, indeed, almost any rational method of ducking a constitutional issue has

33. *Loew's Inc. v. Superior Court*, *supra* note 30. This decision is, in submission, clearly wrong because it flouts the express mandate of §2 of the Copyright Act (17 U.S.C. §2). The court relies, for its conclusion, on a number of doubtful dicta, all of which are fairly represented by the cases cited and discussed in notes 5 and 7 to 13, *supra*, and accompanying text. Perhaps the strongest such case not previously discussed herein was *Photo-Drama M.P. Co. v. Social Uplift Co.*, 220 Fed. 448, 450 (2d Cir. 1915), where the court declared: "We do not concur in Judge Hand's holding [213 Fed. 374 (S.D.N.Y. 1914)] that one who has obtained statutory copyright of a book or play has left in him any common-law right in literary property by virtue of section 2 of the act. We think that section is intended only to indicate that the statute does not displace the common-law right. Whoever elects to avail himself of the statute, however, must be held to have abandoned his common-law right." The difficulty here is that the doctrine announced in the last quoted sentence would necessarily mean that the statute does displace the common law right, at least pro tanto. Moreover, a careful and repeated reading of Judge Hand's opinion in the District Court (which was not, it must be confessed, a model of clarity) fails to disclose any statement whatever corresponding to the "holding" which the appellate court, in the first quoted sentence, purported to criticize. Under these circumstances, it is submitted that the above-quoted remarks of the Second Circuit in the *Photo-Drama* case are too uncertain in their intended application to have meaningful force as precedent.

Cases decided under the Patent Law (35 U.S.C. §1 *et seq.*), concerning an inventor's duty to elect between his common law right in a commercially exploitable but undisclosed discovery, and his statutory right to obtain a federal patent therefor, are not applicable to this problem by analogy, because the Patent Law has no provision corresponding to §2 of the Copyright Act, *supra*. See, e.g., *Macbeth-Evans Glass Co. v. General Electric Co.*, 246 Fed. 695 (6th Cir. 1917), cert. denied, 246 U.S. 659 (1918).

seemed to be regarded by the American judiciary as something in the nature of a providential deliverance.³⁴ Thus, as we have seen, the doctrine of dedicatory publication may be said to have held a compelling fascination for our courts precisely because it provided just such an apparently happy reprieve from the need to resolve the constitutional question we have here set out to explore. But, because of the challenge now offered to that doctrine by the developing common law of "unfair competition", we are beginning to realize that judicial resort to this convenient escape hatch has led our copyright law into unsuspected briar patches instead of green pastures.³⁵ It is time we faced up to the basic constitutional issues.

I.

"FOR LIMITED TIMES": CONCURRENT PROTECTIVE POWERS AND THE INTENT OF THE FRAMERS OF THE CONSTITUTION

The patent-copyright clause³⁶ confers upon 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."

Advocates of the theory of constitutional preemption read a limitation on state as well as on federal power into the phrase "for limited Times." For them these three words stand out from the rest of the constitutional clause and are its very heart and soul. In their view, almost the whole point of conferring a power to protect intellectual property on the federal government was to assure that every such protection would be limited in time. They bolster their contentions by reference to a supposed need for uniformity in the laws that protect this species of property. Their arguments were con-

34. The writer has previously had occasion to comment on one notable recent instance of such excessive reluctance to decide a constitutional question. Whicher, *The Erie Doctrine and the Seventh Amendment: A Suggested Resolution of Their Conflict*, 37 Texas L. Rev. 549, 558 (1959).

35. The briar patches are, perhaps, sufficiently indicated by the vigor and complexity of the scholarly reaction to the observation, advanced in *American Visuals Corp. v. Holland*, 239 F.2d 740 (2d Cir. 1956), that the term "publication," even when used within the frame of reference of the law of authors' rights, is a term of multiple connotations, depending for its precise meaning on the legal context in which it appears. See, e.g., Kalodner & Vance, *supra* note 28; Nimmer, *Copyright Publication*, 56 Colum. L. Rev. 185 (1956); Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. of Pa. L. Rev. 469 (1955).

36. *Supra* note 23.

cisely stated in Judge Learned Hand's dissenting opinion in *Capitol Records v. Mercury Records Corp.*:³⁷

"I . . . recognize the plausibility of the possible argument that . . . the courts of New York should be deemed free, sub nomine 'unfair competition', to determine what conduct shall constitute a 'publication' of a 'work' not covered by the Copyright Act. It would then follow that they could grant to an author a perpetual monopoly, although he exploited the 'work' with all the freedom he would have enjoyed, had it been copyrighted. I cannot believe that the failure of Congress to include within the Act all that the [patent-copyright] Clause covers should give the states so wide a power. To do so would pro tanto defeat the overriding purpose of the Clause, which was to grant only for 'limited Times' the untrammelled exploitation of an author's 'Writings.' Either he must be content with such circumscribed exploitation as does not constitute 'publication,' or he must eventually dedicate his 'work' to the public. The situation is no different from that of patents, where such bilateral character of the grant is a commonplace. I would hold that the clause has that much effect *ex proprio vigore*; and that the states are not free to follow their own notions as to when an author's right shall be unlimited both in user and in duration. Such power of course they have as to 'works' that are not 'Writings'; but I submit that, once it is settled that a 'work' is in that class, the Clause enforces upon the author the choice I have just mentioned . . .

"Moreover, there is another reason for this conclusion. Uniformity was one of the principal interests to be gained by devolving upon the Nation the regulation of this subject."

But *was* it the "overriding purpose of the Clause . . . to grant only for 'limited Times' the untrammelled exploitation of an author's 'Writings' "? *Was* it the framers' intention to confer upon Congress not only a power to secure to authors and inventors a protection for their intellectual creations which would be national in extent (though limited in duration), but also a power to enact uniform patent and copyright laws to the total exclusion of state action in the field?

The available materials on the proceedings of the Philadelphia Convention of 1787 shed little light on the purpose of the framers in these respects.³⁸

37. *Supra* note 6, 221 F.2d at 666-67.

38. Taubman, *Copyright and Antitrust*, 11-12 (1960); *The Meaning of "Writings" (etc.)*, *supra* note 27, 31 N.Y.U. L. Rev. at 1266; Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 *Georgetown L.J.* 109 (1929).

It does appear, however, that James Madison was intimately associated with the authorship of the patent-copyright clause.³⁹ Peculiar importance, therefore, attaches to Madison's observations about that clause in the forty-third number of *The Federalist*.⁴⁰

"The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provision for either of these cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress."

This comment teaches us: (1) that the architects of the patent-copyright clause regarded the "Right" therein mentioned of "Authors . . . to their Writings" as closely akin to an existing "right of common law" known as "copyright"; and (2) that they believed that a similar "Right" of "Inventors . . . to their . . . Discoveries" should have equal recognition.⁴¹ Our first task, therefore, is to determine the nature of Madison's conception, in 1787, of this "right of common law", as "adjudged, in Great Britain."⁴² We turn, accordingly, to a page of England's legal and literary history which, though perhaps an oft-told tale, has yet to be as fully understood as its relationship to the constitutional foundations of American copyright law requires.

39. 3 Brant, James Madison, 132 (1950); cf. Fenning, *supra* note 38.

40. The Federalist, No. 43 (Mod. Lib. ed.), 279 (1941).

41. Cf. *Tonson v. Collins*, *supra* note 1, 1 W. Bl. at 344, 96 Eng. Rep. at 189. The property right of an inventor to his unpatented, undisclosed, but commercially marketed discoveries had been recognized by English law at least as early as 1744. See *Giblett v. Read*, 9 Mod. 459, 88 Eng. Rep. 573 (Ch. 1744) (nostrums).

42. Madison, of course, was not stressing the "foreign" character of the common law right by his allusion to a British adjudication. The common law of England was regarded as a precious American heritage, although some principles of selectivity were imposed upon its post-Revolutionary reception here, either by statute or by judicial decisions. These restrictive principles were originally evolved, partly in order to preserve established colonial variations from accepted English practice, and partly in order to reconcile the common law to its new domicile in a republican rather than a monarchical polity. See, generally, Goebel, *Cases and Materials on the Development of Legal Institutions*, 298-300 (1946); Goebel & Naughton, *Law Enforcement in Colonial New York*, Introduction, xvii-xxxix (1944).

A. THE "GREAT QUESTION CONCERNING LITERARY PROPERTY" IN
ENGLAND: 1766-1775

During the latter half of the eighteenth century, England's leading lawyers and authors⁴³ participated on both sides of a great public debate over the question whether or not an author had a "perpetual" right of property in his literary works at common law. One of the champions of the common law right in this debate was Sir William Blackstone, who expounded his views on the subject in the second volume of his *Commentaries*, first published in 1766.⁴⁴ Blackstone began with the "natural right" view of literary property: a man is entitled, by the "law of nature," to reap the fruits of his own labors; therefore, an author should have the profits to be made from the commercial exploitation of his own literary creations. The argument continued:⁴⁵

"When a man by the exertion of his rational powers has produced an original work, he has clearly a right to dispose of that identical work as he pleases, and any attempt to take it from him, or vary the disposition he has made of it, is an invasion of his right of property. Now the identity of a literary composition consists entirely in the *sentiment* and the *language*; the same conceptions, clothed in the same words, must necessarily be the same composition: and whatever method be taken of conveying that composition to the ear or the eye of another, by recital, by writing, or by printing, in any number of copies, or at any period of time, it is always the identical work of the author which is so conveyed: and no other man can have a right to convey or transfer it without his consent, either tacitly or expressly given. This consent may perhaps be tacitly given, when an author permits his work to be published, without any reserve of right, and without stamping on it any marks of ownership: it is then a present to the public, like the building of a church, or the laying out a new highway: but, in case of a bargain

43. In this section IA of the text, and in section IB immediately following, the term "author", unless otherwise clearly indicated, refers only to the creator of a literary work.

44. 2 Blackstone, *Commentaries on the Laws of England* (1st ed. 1766), 405-07. Important bibliographic information concerning the various editions of Blackstone's treatise will be found conveniently assembled in Eller, *The William Blackstone Collection in the Yale Law Library*, Yale Law Lib. Pub. No. 6 (1938).

45. Blackstone, *supra* note 44, at 405-06. In the seventh and later editions of the *Commentaries*, published after the rendition of the House of Lords' decision in *Donaldson v. Beckett*, *supra* note 1, Blackstone recast the last two of the three sentences in this passage to put them in much more hypothetical form; and he added, as an alternative (but not preferable) hypothesis, the suggestion that the right became, after publication, too ephemeral for continued legal recognition.

for a single impression, or a sale or gift of the copyright, the reversion is plainly continued in the original proprietor, or the whole property transferred to another."

While there were no decisions by the English common law courts (in 1766) explicitly recognizing authors' rights in their creations, the old Licensing Acts and a number of equity decisions were clearly based, in Blackstone's view, on the assumption that such rights did exist at common law. This was evident, too, he suggested, from the existing copyright statute, enacted in 1709, commonly called the Statute of Anne. That enactment, as Blackstone read it, simply created remedies *additional* to those available at common law for trespasses upon such rights. This construction of the statute was important; for it necessarily implied that the time limits fixed by the act (fourteen years, with a renewal term for another fourteen years) were imposed only as restrictions on the additional *remedies* granted by the enactment, and not as limits cutting short the basic common law right.⁴⁶

With the possible exception of the idea that publication might "perhaps", and under certain circumstances, dedicate an author's work to public use,⁴⁷ Blackstone's doctrines were by no means novel. English "booksellers" (whom we would call, in this context, publishers) and their legal conveyancers had been treating copyrights as property rights by willing them and selling them long before 1700.⁴⁸ The essential heads of the legal argument supporting this practice were probably developed by William Murray (later Lord Mansfield) during his career at the bar in the 1740s and 50s.⁴⁹ Moreover, there

46. *Id.* at 407: "But, exclusive of such copyright as may subsist by the rules of the common law, the statute 8 Ann. c. 19, hath protected by additional penalties the property of authors and their assigns for the term of fourteen years . . ." In the seventh and later editions (see *supra* note 45) this sentence was recast thus: "But whatever inherent copyright might have been supposed to subsist by the common law, the statute 8 Ann. c. 19 . . . hath now declared that the author and his assigns shall have the sole liberty of printing and reprinting his works for the term of fourteen years, and no longer . . ." Cf. *infra* note 72.

47. Quoted *supra* in text accompanying note 45. Even as applied to lands, the doctrine of "dedication" was a comparatively recent development in English law when Blackstone thus blithely suggested its extension to the law of literary property. *Lade v. Sheperd*, 2 Strange 1004, 93 Eng. Rep. 997 (K.B. 1735); *Queen v. Inhabitants of Hornsey*, 10 Mod. 150, 88 Eng. Rep. 670 (Q.B. 1713).

48. Trade usages of this sort were apparently enough to convert their inchoate and incorporeal subject matters into legally recognizable property rights, at least for some purposes. Cf. *Giblett v. Read*, *supra* note 41.

49. See his argument, as solicitor-general, in *Tonson v. Walker*, 3 Swanst. 672, 36 Eng. Rep. 1017 (Ch. 1752), and his brief autobiographical statement in *Millar v. Taylor*, *supra* note 1, 4 Burr. at 2407, 98 Eng. Rep. at 257. Mansfield may well have

had been a considerable flurry of pamphlets on the pros and cons of the question for some time before Blackstone took up his pen to write the *Commentaries*.⁵⁰ Indeed, since the booksellers' commercial traffic in copyrights had begun long before 1700, and had never been in the least clandestine or secret, it may seem somewhat surprising that debate on the subject should have been so long deferred. Englishmen generally were probably vaguely aware that "copy" (as copyright was then called)⁵¹ was being treated as property in some sense; but, as usual in English commercial law, legal theory followed long after settled trade practice.

Blackstone, by stressing the theoretical analogy between copyright and the more familiar right of land ownership, inadvertently did the cause of authors' rights a disservice. For the analogy focussed public attention on the two least attractive elements in the whole idea of common law copyright: (1) the right of the owner to put out a "no trespassing" sign, and (2) the "perpetual" character of that right. No one really begrudged an author the right to reap as perpetual a profit from any book as it was capable of earning; but to make this a right of absolute property meant that the "owner", however remote in time and sympathy he might be from the author, had the right to take what had come to be "his" work out of public circulation and

acquired his early interest in the subject of authors' rights from his close friendship with Alexander Pope. Fifoot, *Lord Mansfield*, 31-32 (1936). Indeed, his entry into London's literary circles while still a young man won him a memorable encomium from Samuel Johnson: "... not a mere lawyer: he drank champagne with the wits." *Id.* at 30; cf. 2 Boswell, *Life of Johnson* (Hill and Powell ed.), 158 (1934).

50. Collins, *Authorship in the Days of Johnson* (1927), has the fullest account of this controversy. Unhappily, that author's manifest bias against the London booksellers in the age of which he treats prevents him from doing full justice to their position. They were not an admirable crew. Their championship of the cause of "authors' rights" was all too obviously a mere stalking horse, behind which they relentlessly pursued their collective mercenary self-interest. Even so, that cause was better than its bookseller champions. Its legal advocates, men like Mansfield, Wedderburn, and Blackstone, were certainly sincere in their advocacy and should not lightly be tarred with the same brush as their clients. Drone's rhetorical eloquence on this theme may seem, to modern readers, overblown, but it is certainly not wholly unjustified. Drone, *A Treatise on the Law of Property in Intellectual Productions*, 40-42 (1879).
51. Blackstone is commonly credited with the first published use of the word "copyright." Mackinnon, *Notes on the History of English Copyright*, Oxf. Comp. to Eng. Lit. 877, 880 note 3 (1944). The earlier use of the word "copy" to express the same concept is reflected by Milton's oft-cited reference, in *Areopagitica* (1644), to "the just retaining of every man his several copy, which God forbid should be gainsaid." 2 Milton, *Complete Prose Works*, 486, 570 (Yale Univ. Press, 1959).

keep it out. Then as now, the view that the great classics of English literature, once established as such, could be kept from the public at the whim of their "owners" was simply unpalatable to educated minds.⁵²

Blackstone's idea of dedicatory publication was no answer to this difficulty, for it depended upon the author's publishing his work "without any reserve of right, and without stamping upon it any marks of ownership." The avarice of booksellers (if not of authors themselves) could be counted on not to overlook such formalities. Less often noticed, however, was another limitation on the duration of the common law right which was implied, though not expressed, by Blackstone's treatise. Blackstone had included common law copyrights in a class of property rights acquired by "occupancy" (i.e. user), such as easements of light, air, and water. Such incorporeal rights, so acquired, were subject to a doctrine of abandonment by non-user.⁵³ The author who created and published his work, therefore, retained his exclusive right to multiply copies (that was his "right of copy", or "copy right") *only for so long* as he exercised it; but if he let his work go out of print, then sooner or later the right would be deemed abandoned, and anyone thereafter could publish copies of the work. Relatively few literary works

52. Samuel Johnson, for example, was sometimes critical of the notion of perpetual copyright on this ground. 2 Boswell, *supra* note 49, at 259 and 272-73 (1934). But at other times he was equally critical of those who sought to restrict the duration of the right. 1 *id.*, at 437-38 (1934); 5 *id.*, at 50-51 and 72 (1950). Boswell concludes that his friend was, at heart, opposed to a "perpetual" right. 2 *id.*, *ubi supra*. But Boswell may have been unconsciously influenced in drawing this conclusion by his own predilections, acquired as a successful (though junior) advocate for those opposed to the common law right in *Hinton v. Donaldson*, 1 Hailes's Dec. 535 (Scot. Ct. of Sess. 1773) (see also Boswell's pamphlet report: *The Decision of the Court of Session upon the Question of Literary Property [etc.]* [Edinburgh, 1774]). Johnson, on all the evidence, seems not to have been always of one mind on this subject. Perhaps he simply enjoyed playing the Socratic role of challenging easy answers on either side of the question.

Educated minds still find the existence of a perpetual right (even when limited, as it is today, to unpublished works) unpalatable. Their attitude is abundantly justified by such irresponsible misuses of the right as were involved in the garbled or belated publications of Emily Dickinson's poetry during the first sixty years after her death. (The story is very briefly and dispassionately summarized in T. H. Johnson's preface to his scholarly and definitive edition of the poems. *I Poems of Emily Dickinson*, xxxix-xlviii [Belknap Press, 1955].) Whether the cure for such evils lies in destroying the right entirely, or in part, or in encouraging our federal and state legislatures to employ their powers of eminent domain in the premises with greater frequency, is a question wholly beyond the scope of this article.

53. See 3 Kent, *Commentaries on the American Law*, *448 note (o) (any edition), and English authorities there cited.

were or are capable of supporting a perpetual commercial market.⁵⁴ Consequently, despite all the clamor on the subject, the right was not *literally* perpetual: its duration depended on the commercial life of the particular works to which it applied.⁵⁵ A few keen legal minds of Blackstone's time understood this point and tried to elucidate it.⁵⁶ But, in the event, the point proved to be too subtle for the laymen of that era to understand; and, under the judicial structure of that time, it was for laymen, in the House of Lords, to speak the last word.⁵⁷

But before the Lords could so speak, the regular courts had first to be heard. The friends of common law copyright were initially much encouraged, therefore, when their theories were vindicated, in 1769, by the famous decision of the Court of King's Bench in *Millar v. Taylor*.⁵⁸ The facts of that case were these: A London bookseller named Millar had become the owner by assignment of the common law copyright in James Thomson's poem, *The Seasons*. This work had been first published in four successive instalments during the years 1726-1730.⁵⁹ By 1758, therefore, Millar's right (as Thomson's assignee) to obtain the remedies afforded by the Statute of Anne had completely expired, under the time limits fixed by that act. A rival bookseller named Taylor published his own edition of the poem, without Millar's permission, in 1766. Millar brought an action against Taylor, claiming infringement of the common law copyright. In one of the few split decisions ever handed down during Lord Mansfield's tenure as Lord Chief Justice, the Court of King's Bench upheld Millar's claim by the opinions of three judges to one.⁶⁰ The court expressly held: (1) that Millar (by assignment from Thomson) owned the common law copyright in *The Seasons*; (2) that his

54. See Birrell, *Seven Lectures on the Law and History of Copyright in Books*, 23-26 (1899).

55. The modern importance of this distinction between "perpetuity" and "commercial life" was recently underlined by the case of *Warner-Lambert Pharmaceutical Co., Inc. v. John J. Reynolds, Inc.*, 178 F.Supp. 655, 661-67 (S.D.N.Y. 1959), *aff'd* on the District Court's opinion, 280 F.2d 197 (2d Cir. 1960).

56. E.g., Mr. Justice Aston, in *Millar v. Taylor*, *supra* note 1, 4 Burr. at 2345-46, 98 Eng. Rep. at 224; Mr. Justice Gould in *Donaldson v. Beckett*, *supra* note 1, 17 Cobbett's Parl. Hist. of England, at 984-85.

57. The day had not yet come when appeals to the House of Lords were heard only by the "Law Lords." In the 1760s and 70s, it was still the rule that, in deciding such appeals, every one of the peers could and *should* participate in the decision. Compare *Donaldson v. Beckett*, *supra* note 1, with *Jefferys v. Boosey*, *supra* note 4.

58. *Supra* note 1.

59. Oxf. Comp. to Eng. Lit., 703 ("Seasons, The"), 778 ("Thomson, James") (1944).

60. The majority: Lord Chief Justice Mansfield and Justices Aston and Willes. The dissenter: Justice Yates.

right was not lost by publication; and (3) that the Statute of Anne was not intended to, and did not, curtail the duration of that right.⁶¹

The lone dissenting voice was that of Mr. Justice Yates.⁶² He exerted the full force of the reasoning of his opinion to support the proposition that there was no common law right in *published* works. (In doing so he probably recognized that, if ever the existence of such a common law right were conceded, the majority's construction of the Statute of Anne, as not intended to curtail that right, was technically correct.⁶³) Let us put Justice

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61. Mr. Justice Willes was particularly instructive on the point of statutory construction (4 Burr. at 2333, 98 Eng. Rep. at 217-18): "It [the Statute of Anne] certainly went to the committee, as a bill to secure the undoubted property of copies forever. It is plain, that objections arose in the committee, to the generality of the proposition; which ended in securing the property of copies for a term; *without prejudice* to either side of the question upon the general proposition as to the right. *By the law and usage of Parliament a new bill cannot be made in a committee: a bill to secure the property of authors could not be turned into a bill to take it away.*" (Emphasis added.) Mr. Justice Aston supplies us with the motives which impelled those most nearly concerned in the matter to seek a statute in aid of their common law rights (4 Burr. at 2350, 98 Eng. Rep. at 227): "This Act was brought in at the solicitation of authors, booksellers and printers, but principally of the two latter; not from any doubt or distrust of a just and legal property in the works or copy-right (as appears by the petition itself, pa. 240, vol. 16, of the Journals of the House of Commons;) but upon the common-law remedy being inadequate, and the proofs difficult, to ascertain the damage really suffered by the injurious multiplication of the copies of those books which they had bought and published."
 62. 4 Burr. at 2354, 98 Eng. Rep. at 229.
 63. The arguments against that construction centered on two points: (1) the title of the Statute of Anne spoke of "vesting" the right in authors (i.e., granting it to, or conferring it upon, them); and (2) the body of the statute declared that authors should have the sole right to print, reprint, etc., for the term of fourteen years "and no longer." *Donaldson v. Beckett*, *supra* note 1, Anon., Plead. at 17, 22; 17 Cobbett's Parl. Hist. of England, at 975, 983 and 986. The first point was not of much importance, for the title was not an efficient part of the Act. In the body of the statute, the term used was "securing", which meant "protecting." The term implied that the right to be "secured" was already in existence. *Millar v. Taylor*, *supra* note 1, 4 Burr. at 2334, 98 Eng. Rep. at 218. The second point, drawn from the words "and no longer," has generally been regarded as the ultimately decisive argument. *Wheaton v. Peters*, *supra* note 13, 33 U.S. (8 Pet.) at 677-78, 696-97 (dissenting opinion). The troubling element in that argument was that the words "and no longer" were at best equivocal: did they cut short only the statutory right to recover forfeitures from infringers, or did they cut short the common law right as well? The course of judicial prudence was to treat them as not intended to affect the common law right, leaving Parliament free to clarify its purpose by further legislation if it considered such a course advisable. See Lord Mansfield's statement of this position: 4 Burr. at 2406, 98 Eng. Rep. at 256. Justice Willes' argument in favor of an undisturbed common law right, drawn from a point of settled Parliamentary procedure (*supra* note 61), was never answered.

Yates's argument in simple terms. I may call an idea "mine" (he reasoned) only while I keep it to myself. But when I communicate that idea to you, it becomes "our" idea; for I cannot thereafter prevent you from thinking it, or using it at your pleasure. Indeed, my very act of communicating the idea to you negatives the existence of any intention on my part to withhold it from you. When an author publishes his work, he communicates his ideas to the world at large. He thus makes a present of his ideas to the public. Thereupon those ideas become the common property of all. (Here, rather than in Blackstone, we find the true origin of the common law fiction of dedicatory publication as we know it today.) No one, of course, had even suggested that the English language could be anything *but* common public property. Justice Yates, therefore, did not find it necessary even to consider whether or not an author might have a property in "his" words. Since neither the ideas, once published, nor the words, whether published or not, could be said to belong exclusively to the author, that left nothing, in Justice Yates's view, which an author could justly claim to own in his published works. Accordingly, whatever Parliament may have thought it was doing when it passed the Statute of Anne, it seemed clear to Yates that it had, in fact, created a right where none had existed before, and that the right so created must necessarily end with the statutory time limits.

The countering arguments of the other three justices may be thus summarized: It is only in *one sense* that my ideas, once communicated to you, can be said to become "our" ideas, and that is in relation to the internal operations of your mind and mine. But when I communicate my ideas to the public by externalizing them in a commercially valuable product like a book, the economic value of that externalization is the result of my labor and no one else's. In this aspect, my book is "mine" forever; you cannot justly wring your living from the sweat of my wits by taking the cash from the sale of my book and letting me have nothing but the credit of its authorship, if that. To recognize my right thus to market the product of my labor is not to deny that, when I publish my work, I have given my ideas to the public, and that everyone may thereafter use those ideas freely, in any way *other than by marketing identical copies of my work*. The scope of the short-lived eighteenth-century common law right in published works was, from this regard, a very narrow one indeed. Justice Aston put this point very clearly:⁶⁴

"... I am of opinion that the publication of a composition does not give away the property in the work; but the right of the copy still remains in the author; and that no more passes to the public, from the free will and consent of the author, than an unlimited use of every

64. 4 Burr. at 2348, 98 Eng. Rep. at 226.

advantage that the purchaser can reap from the doctrine and sentiments which the work contains. *He may improve upon it, imitate it, translate it, oppose its sentiments: but he buys no right to publish the identical work.*" (Emphasis added.)

Justice Willes also had a revealing word to say on the subject:⁶⁵

"Certainly *bonâ fide* imitations, translations, and abridgements are different [from copies]; and, in respect of the property, may be considered as new works: but colourable and fraudulent variations will not do."

Here lay the crux of the problem. What was the difference between "*bonâ fide* imitations" on the one hand, and "colourable and fraudulent variations" on the other? It was well enough to say that the right to multiply identical copies of an author's work was distinct from the right freely to use the ideas which the work conveyed; but if once it was admitted that the author owned something more than the exclusive right to multiply and market *identical* copies of his work, then it could not be said that a property in ideas had been wholly banished from the purlieus of copyright law. Conversely, however, if mere paraphrases were allowed as *bona fide* imitations, the copyright would hardly be an adequate protection of the author's legitimate commercial interest in the profitable dissemination of his creation.

The resulting problem of distinguishing between "ideas", which are not protected, and "expressions", which are, has remained, from that day to this, one of the hardest problems to solve in the law of copyright, whether at common law or under statute. Lord Mansfield may, perhaps, be thought to have suggested an initial answer to this problem when he declared that copyright "is a property in notion."⁶⁶ The distinction between "notion" and "simple idea" had been popularized, eighty years before Mansfield wrote, by John Locke's *Essay on Human Understanding*.⁶⁷

"The mind often exercises an active power in making these several combinations [of simple ideas]: for it being once furnished with simple ideas, it can *put them together in several compositions*, and so make a variety of complex ideas, without examining whether they exist so in nature. And hence I think it is that these ideas are called notions . . ." (Emphasis added.)

By his choice of the word "notion", Mansfield may, perhaps, have meant to suggest that copyright was a property in the particular way in which an

65. 4 Burr. at 2310, 98 Eng. Rep. at 205.

66. 4 Burr. at 2396, 98 Eng. Rep. at 251.

67. Book II, ch. 22, §2.

author combined, arranged, and presented his ideas, rather than in the ideas themselves. If so, the suggestion was too broad; for the right to make bona fide imitations of an author's work included, at that time, the rights to translate and to abridge;⁶⁸ and this necessarily meant that the same ideas, in the same arrangement, sequence and combination, could (in certain cases) be presented in different *words* without infringing the author's common law copyright. It is not surprising, therefore, to find that, eighty-five years later, Mr. Justice Erle, rendering an advisory opinion to the House of Lords in favor of the existence of a common law copyright in published works, reverted to the idea of copyright as a property in the identical form of expression:⁶⁹

"The subject of property is the *order of words* in the author's composition; not the words themselves, they being analogous to the elements of matter, which are not appropriated unless combined, nor the ideas expressed by those words, they existing in the mind alone, which is not capable of appropriation." (Emphasis added.)

Yet somehow the broader concept which we have attributed to Lord Mansfield just will not die. As recently as 1957 an opinion came down from the United States Court of Appeals for the Seventh Circuit, declaring:⁷⁰

"The association, arrangement and combination of ideas and thoughts and their form of expression may make a particular literary composition which is entitled to protection."

When our modern courts deal with this problem, a good deal seems to depend (a) on the degree of originality displayed by the first author's work and (b) on the creative qualities of the imitative use thereof. The more

68. See Justice Willes' opinion in *Millar v. Taylor*, *ubi supra* note 65. The right to abridge had been recognized in *Dodsley v. Kimmersley*, Amb. 403, 405, 27 Eng. Rep. 270, 271 (Ch. 1761); see, also, "Newberry's case," Lofft 775, 98 Eng. Rep. 913 (Ch., undated—1774?). The rule that copyright does not protect against translations or abridgements carried over into American copyright law for as long as our statutes defined copyright simply as the right to print, reprint, publish and vend. See *Stowe v. Thomas*, 23 Fed. Cas. 201, No. 13,514 (C.C.E.D. Pa. 1853) (translation of *Uncle Tom's Cabin*); cf. *Folsom v. Marsh*, 9 Fed. Cas. 342, 345, 347-49, No. 4,901 (C.C. Mass. 1841) (defendant's published selections from Washington's correspondence *held*, with much hesitation, not to be justifiable as an abridgement of Jared Spark's earlier [authorized] publication thereof in his *Life and Writings of George Washington* [12 vols. 1834-37]).

69. *Jefferys v. Boosey*, *supra* note 4, 4 H.L.C. at 867, 10 Eng. Rep. at 702.

70. *Eisenschiml v. Fawcett Publications*, 246 F.2d 598, 603 (7th Cir.), cert. denied, 355 U.S. 907 (1957).

originality an author's work displays, the more inclined our courts will be to protect the "notional" content thereof; conversely, the less original it is, the less will our courts be inclined to protect it against anything but identical copying. Again, the more the alleged infringer's use of a work can be shown to have claims of its own to creative originality, the less likely will our courts be to forbid it as an intrusion on the first author's "notions"; on the other hand, the more nearly the alleged infringement approaches to an unoriginal, imitative use of the first work, the more inclined our courts will be to condemn it, even though it may not be an identical copy or mere paraphrase. Of course, there is a point of abstraction beyond which no author's "notions" can be protected: were Christopher Marlowe alive today, and had he just published *The Tragicall Historie of Doctor Faustus*, his copyright in that first poetic dramatization of the familiar legends of the great magician could not preclude a modern Goethe from writing *Faust*. But within the limits of protectibility thus suggested, the line between actually protected "expression" and unprotected "idea" remains, necessarily, a fluid one, drawn in the light of the facts of each case, and decided upon a just balancing of the considerations above noted.⁷¹

But we are getting ahead of our story. In *Millar v. Taylor*, the three judges who composed the majority had just begun to grasp these subtle and elusive conceptions. It is not surprising, therefore, that they were unable to persuade Justice Yates to their views, nor he to argue them into his. The majority carried the day, but the war had only begun. Like summer's lease, the initial triumph of common law copyright had all too short a date. That triumph lasted long enough, however, for Blackstone to publish three successive editions of the *Commentaries* in which he inserted a footnote citing

71. Compare for example, the broad protection given to the author of a highly original book of cartoons, in *King Features Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924), with the narrow protection given to the author of a miniature reproduction of Rodin's sculpture, "The Hand of God," in *Alva Studios v. Winniger*, 177 F.Supp. 265 (S.D.N.Y. 1959). Cases discussing and applying the distinction between "idea" and "expression" are legion; the following are representative of a much longer list: *Continental Casualty Co. v. Beardsley*, 253 F.2d 702, 704-06 (2d Cir.), cert. denied, 358 U.S. 816 (1958); *Eisenschiml v. Fawcett Publications*, *supra* note 70; *G. Ricordi & Co. v. Paramount Pictures, Inc.*, *supra* note 31; *Desny v. Wilder*, 46 Cal.2d 715, 741-43, 299 P.2d 257, 271-72 (1956). Our modern understanding of the distinction owes much to two of Judge Learned Hand's finest opinions: *Sheldon v. Metro-Goldwyn-Mayer Pictures Corp.*, 81 F.2d 49 (2d Cir.), cert. denied, 298 U.S. 669 (1936); *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), cert. denied, 282 U.S. 902 (1931). There is also an excellent treatment of the subject in Chafee, *Reflections on the Law of Copyright* (Part I), 45 Colum. L. Rev. 503, 511-14 (1945).

Millar v. Taylor as authority for his teachings on the subject.⁷² But then the roof fell.

The Samson who brought down the roof was a cut-rate Scotch publisher named Alexander Donaldson.⁷³ He printed and sold still another pirated edition of that improbable best seller, *The Seasons*. Millar had died just as his case against Taylor was decided. His executors sold his interest in Thomson's poem to one Beckett, who thereupon sued Donaldson in Chancery, seeking an injunction to suppress the Scotchman's arrant piracy. Lord Chancellor Apsley⁷⁴ granted the injunction on the authority of the *Millar* case. Donaldson, however, being a pertinacious Scot, appealed from that decree to the House of Lords. There, in 1774, in the famous case of *Donaldson v. Beckett*, the Lord Chancellor's decree was reversed and the doctrine of *Millar v. Taylor* was overruled.

But when we ask what doctrine, precisely, the Lords preferred to that which they thus cast aside, Clio (that coy muse) simply shrugs. Let us see, so far as the historical sources permit, what actually happened. When the *Donaldson* case came up on appeal, the House of Lords, following a customary practice,⁷⁵ issued writs of assistance directing the twelve judges of the three common law courts of the realm (King's Bench, Common Pleas, and Exchequer) to attend and advise their Lordships on the legal aspects of the question of literary property at common law. Three questions, in essence, were put to the judges,⁷⁶ which we may paraphrase as follows: (1) Was there a common law right of literary property at all? (2) If so, did it

72. The fourth, fifth and sixth authorized editions, published in 1770, 1773 and 1774, respectively. The footnote appears at pp. *406-07 of each of these editions as footnote *b*. With minor variations not here material, it reads (in each such edition) as follows: "In the case of *Miller v. Taylor* in B.R. Pasch, 9 Geo. III, it was determined (upon solemn argument and great consideration) by the opinion of three judges against one, that an exclusive copyright in authors subsists by the common law . . ." In the seventh edition, published in 1775, and in all later editions of the Commentaries, the following sentence was added: "But afterwards, in the case of *Donaldson v. Becket* [sic], before the house of lords, which was finally determined 22 Febr. 1774, it was held that no copyright subsists in authors, after the expiration of the several terms created by the statute of queen Anne."

73. 1 Boswell, *supra* note 49, at 437-38.

74. Who succeeded to the earldom of Bathurst on his father's death in 1775. Some commentators on the case refer to him, therefore, as Lord Bathurst.

75. X Holdsworth, *History of English Law*, 610-11 (1938).

76. Actually there were five questions asked; but the fourth and fifth were simply Lord Camden's loaded rephrasings of the second and third, designed to provoke answers unfavorable to the common law right. Lord Camden was a bitter political foe of Lord Mansfield, and sought to discredit him by persuading the House of Lords to repudiate the doctrine of *Millar v. Taylor*, *supra* note 1. Curtis, *A Treatise on the Law of Copyright*, 60-61 note 2 (1847); and see Fifoot, *supra* note 49, at 45-46.

survive publication into perpetuity? (3) If so, did the Statute of Anne supplant or cut short the perpetual common law right? Unfortunately, the judges were not of one accord in their answers to these questions. Even had they been unanimous in their views, however, their opinions were at best advisory, and were not controlling on the Lords' decision.⁷⁷ Moreover, there is a disturbing conflict among the various reports of the case concerning the answers which two of the eleven⁷⁸ judges gave to the last of these three questions.

There are five such reports: two anonymous pamphlet accounts of the case, which were issued in 1774;⁷⁹ Sir James Burrow's report, first published in 1776;⁸⁰ Josiah Brown's report, which came out in 1783;⁸¹ and the narrative found in the seventeenth volume of *Cobbett's Parliamentary History of England*, which appeared in 1813.⁸² The anonymity of the first two reports is probably attributable to the existence of a standing rule of the House of Lords by which any publication of its proceedings in cases on appeal could be punished as a contempt.⁸³ It was not long before 1774 that an effort had been made (fortunately without success) to enforce that rule.⁸⁴ Small wonder, then, that some minimal caution, at least, was observed in flouting it. Once the anonymous reports had appeared, however, others could follow suit with some assurance of safety; for they could always claim, if ques-

77. 3 Boswell, *supra* note 49, at 345-46; X Holdsworth, *ubi supra* note 75; I *id.* at 376-77 (1922).

78. Lord Mansfield did not participate, "out of motives of delicacy," averring that it was unusual for a peer to support his own judgment on an appeal to the House of Lords. 4 Burr. at 2417, 98 Eng. Rep. at 262. If so, it must have been even more unusual for a peer to speak *against* his own judgment, as Lord Chancellor Apsley did in this very case. Anon., Plead., *supra* note 1, at 35; Gentleman, Cases, *supra* note 1, at 55; 17 Cobbett's Parl. Hist. of England, *supra* note 1, at 1001-02. Lord Mansfield's distaste for Parliamentary debate concerning his own conduct on the bench was well known, and Lord Camden liked nothing better than to play on it. See authorities cited *supra* note 76. Mansfield's contemporaries, in fact, despised this "delicacy" as a weakness. Thus, Horace Walpole observed: "... Lord Mansfield's finesse, as you call it, was christened by its true names, pitiful and paltry..." Letter to Rev. William Mason, March 23, 1774, 28 Walpole, Correspondence (Yale ed.), 142 (1955). And see Curtis, *supra* note 76, at 59-60 n. 2.

79. Anon., Plead. and Gentleman, Cases, *supra* note 1.

80. 4 Burr. 2408, *supra* note 1.

81. 7 Bro. P.C. (1st ed.) 88, *supra* note 1.

82. *Supra* note 1.

83. 1 Burr., Preface, vii (1765).

84. VI Holdsworth, *supra* note 75, at 573 (1924).

tioned, that they had published their reports only to protect the House of Lords from "errors" (real or imagined) in the earlier accounts.

Four of the five reporters—Burrow, Cobbett, and the two anonymous pioneers—set out the answers which each of the judges gave to each of the three questions posed by the House. Three of those four reporters—the anonymous pair and Cobbett—also give us, in digest form, the opinions which each judge rendered in support of his answers. The fifth report (Brown's) simply summarizes the final outcome by the all-inclusive statement that five judges favored the perpetual common law right while six were opposed to it. This negative formulation of the majority's position is not very helpful; for it leaves us in the dark as to whether the six judges took the position they did (a) because they rejected the view that there was any common law copyright at all, (b) because they believed that the right existed but was lost by publication, or (c) because they believed the statute cut short the common law right.

Turning to the remaining four reports, we find that they all agree (though with some initial confusion on the part of Burrow) that the judges divided eight to three on the first question, the majority favoring the existence of the common law right.⁸⁵ The four reporters are in perfect agreement that, on the second question, seven judges favored the perpetuity of the common law right, and four held that it must at least come to an end with publication.⁸⁶ On the third question, however, the reporters are hopelessly in conflict. Burrow says that six judges favored statutory preemption of the common law right and five opposed it.⁸⁷ Cobbett, on the contrary, shows a six-to-five division in which the majority opposed the idea that the statute took away the common law right.⁸⁸ Both of the two anonymous

85. On this first question, the majority was composed of Justices Nares, Ashurst, Blackstone, Willes, Aston, and Gould, Lord Chief Baron Smythe, and Lord Chief Justice DeGrey. The minority was formed by the three puisne Barons of Exchequer: Eyre, Perrott, and Adams. Burrow at first records Barons Perrott and Adams with the majority. 4 Burr. at 2413, 2415, 98 Eng. Rep. at 260, 261. But the resulting ten-to-one division is clearly wrong, as appears from Burrow's own summary (4 Burr. at 2417, 98 Eng. Rep. at 262): "... there were eight to three upon the first question ..."

86. The seven: Justices Nares, Ashurst, Blackstone, Willes, Aston, and Gould, and Lord Chief Baron Smythe. The four: Barons Eyre, Perrott, and Adams, and Lord Chief Justice DeGrey.

87. The six: Justices Nares and Gould, Barons Eyre, Perrott, and Adams, and Lord Chief Justice DeGrey. The five: Justices Ashurst, Blackstone, Willes, and Aston, and Lord Chief Baron Smythe.

88. The six: Justices Ashurst, Blackstone, Willes, and Aston, Baron Adams and Lord Chief Baron Smythe. The five: Justices Nares and Gould, Barons Eyre and Perrott, and Lord Chief Justice DeGrey.

reporters present us with still another picture, in which only four judges favored statutory preemption while seven maintained that the statute had no effect on the continued existence of the common law right.⁸⁹

The differences focus on the answers of Baron Adams and Justice Nares. All four reports agree that, of the remaining nine judges, five (Justices Ashurst, Blackstone, Willes, and Aston, and Lord Chief Baron Smythe) favored the survival of the common law right; and four (Justice Gould, Barons Perrott and Eyre, and Lord Chief Justice DeGrey) believed that the statute supplanted it.

Examination of Baron Adams's opinion, as given by both of the anonymous reporters and Cobbett, discloses at once the cause for confusion as to his answer. Adams had held, in reply to the first and second questions, that there was no common law copyright, certainly none after publication. Asked (at least by fair implication) to assume the contrary of both of these positions and to say whether, on that assumption, the statute preempted the perpetual common law right, the worthy baron simply balked. He held that the statute was not preemptive, because there—just—*wasn't*—any common law copyright for the statute to preempt!⁹⁰ Cobbett and the anonymous reporters, therefore, are literally correct in recording Adams as voting against preemption, in his answer to the third question; but Burrow is clearly more discerning of the spirit that prompted that answer when he records him as voting the other way. Perhaps Brown's negative formulation of the final result was, after all, the most tactful way of dealing with this peculiar situation.

But the difficulty surrounding Justice Nares's views is quite a different story. Burrow shows him giving an answer favorable to statutory preemption, in response to the Lords' third question. This is consistent with Brown's report, where Nares is listed among the judges opposed, in the final analysis, to the perpetual common law right. On the other hand, the two anonymous reporters bear common witness that Justice Nares vigorously *supported* the common law right and *opposed* the idea of statutory preemption, both in his opinion and in his answer.⁹¹ Cobbett paraphrases one of the two anonymous reports in rendering Nares's opinion; but for some unknown reason he switches from that model to adopt Burrow's version of Justice Nares's answer to the third question.⁹² We thus have a most extraordinary picture, in Cobbett's report, of a judge deciding in favor of preemption while reasoning against

89. The seven: Justices Nares, Ashurst, Blackstone, Willes, and Aston, Baron Adams, and Lord Chief Baron Smythe. The four: Justice Gould, Barons Eyre and Perrott, and Lord Chief Justice DeGrey.

90. Anon., Plead. at 24, Gentleman, Cases at 43, 17 Cobbett's Parl. Hist. of England at 986.

91. Anon., Plead. at 17-18, Gentleman, Cases at 35.

92. 17 Cobbett's Parl. Hist. of England at 975-76.

it. A decent respect for Nares's sanity, and a normal historian's preference for the sources which are at once the fullest and the most contemporaneous with the event, might lead us to accept the anonymous reporters' version as the more likely to be correct; but if Burrow and Brown were both wrong, it is difficult to understand how they were each led astray, and why no one, then or later, ever ventured to correct them.

In short, we are left in perplexity whether (accepting Burrow's rendering of Baron Adams's answer) the judges' division on the third question was actually six to five in *favor* of statutory "impeachment" of the common law right, or six to five *against* it.

We need not be too deeply troubled by this riddle; for as we have already seen, the judges' views were not controlling on the ultimate result in any case. Three other factors were undoubtedly more decisive in their influence on the final outcome than any tally of judicial wigs pro and con: (1) the curious reticence of Lord Mansfield;⁹³ (2) the Lord Chancellor's remarkable intellectual somersault in speaking against his own decree;⁹⁴ and (3) the powerfully eloquent, though specious and politically motivated, speech of Lord Camden moving for reversal.⁹⁵ But when all's said and done, we can never be certain how the twenty-two Noble Lords who voted "Aye" on that motion (to eleven "Nays" favoring affirmance) decided among the three several grounds for their decision which the three questions posed to the judges had suggested.

The influence of Burrow's and Brown's reports of the case, however, has been decisive in persuading later ages to conclude that the decision was based on the theory that the statute *did* "impeach or take away" the common law right in published works. It is in this sense, therefore, that we shall speak hereafter of the "rule" or "doctrine" of *Donaldson v. Beckett*. It was in this sense, too, that Blackstone, independently of the reporters, construed the decision when he altered the text of the *Commentaries* to accord with it, in the seventh edition of that work, published in 1775.⁹⁶

93. *Supra* note 78.

94. *Id.*

95. Anon., Plead. at 29-34, Gentleman, Cases at 48-55, 17 Cobbett's Parl. Hist. of England at 992-1001. And see *supra* notes 76 and 78.

96. For the significant alterations in Blackstone's text, see notes 45, 46 and 72, *supra*. Blackstone was unable to be present in the House of Lords when the case of *Donaldson v. Beckett* was before that body, "being confined to his room with the gout." 4 Burr. at 2411, 98 Eng. Rep. at 259. His answers to the Lords' questions and his reasons therefor were read for him by Justice Ashurst. *Id.*

The influence of Burrow's and Brown's reports of *Donaldson v. Beckett* was chiefly felt in America, where the case has been treated as much more clearly authoritative than it ever was in England. Compare, for example, the American decisions cited *supra* note 5 with the English authorities cited *supra* note 4. The

1775, as we all know, was the year in whose April "the shot heard round the world" was fired at Concord Bridge. Copyright problems were far from the minds and hearts of Americans then, and for many hard and anxious years thereafter. It is, indeed, a matter for real national pride that the infant American states had scarcely won their independence when they set about enacting legislation to give interstate protections to authors' rights, beginning with the Connecticut copyright law of January, 1783, and continuing thereafter with similar statutes in all the original thirteen states save one.⁹⁷ When the Constitution was written in 1787, the patent-copyright clause of that instrument conferred a limited power upon the national government to give the protection of such rights nationwide scope. That power was promptly exercised in 1790.⁹⁸ The relationship between these American developments and the English controversy whose history we have just traced is the next subject of our inquiry.

B. COMMON LAW COPYRIGHT IN AMERICA AND THE CONSTITUTIONAL CLAUSE

The publishing business was not, by any means, a late arrival on the American economic scene. In Massachusetts, Hezekiah Usher had established himself as a "bookseller" at least as early as 1644; by 1686 there were some fourteen practitioners of the trade in the city of Boston.⁹⁹ William Bradford began printing and selling books in Philadelphia in 1685; he removed his business to New York in 1693.¹⁰⁰ As time passed, these pioneers of the American publishing industry were joined by many more. John Usher, who grew up in his father Hezekiah's business in Boston, and succeeded to it on the latter's death in 1676, was a heavy importer of English books and was in constant communication with the London booksellers.¹⁰¹ There

subsequent history of statutory and common law copyright in Great Britain is briefly treated in Copinger & James, *Law of Copyright*, 10-17 (9th ed. 1958). Our concern here, however, is with the reception and development of the problem in America, where the constitutional issues involved give the whole question a very different aspect from that which it presented in England.

97. Solberg, *Copyright Enactments of the United States, 1783-1906* (U.S. Copyright Off. Bull. No. 3), 11-31 (1906). Delaware was the only state not to enact such a law. *Id.* at 31. Its legislature had resolved, late in 1785 or early in 1786, that it would do so; but the adoption of the Constitution, conferring on the federal Congress the power to create a national scheme of copyright legislation, relieved it of the necessity for carrying out its declared intentions. Scudder, Noah Webster, 56 (1882).

98. Act of May 31, 1790, 1 Stat. 124 *et seq.*

99. Littlefield, *Early Boston Booksellers*, 65-111, 120-137 (Club of Odd Volumes, 1900).

100. Ford, *The Boston Book Market*, 61 (Club of Odd Volumes, 1917).

101. Ford, *supra* note 100, at 5-25; Littlefield, *supra* note 99, at 78-82.

is no reason to suppose that his case was unique. It would be strange indeed if these early American publishers did not know and share their English brethren's concept of the basic property right on which that branch of their business relating to the production and marketing of new books was based. That they did, in point of fact, accept the idea of copyright as a right of property admits of no doubt; for in 1672 John Usher persuaded the Massachusetts General Court (the legislature of the Colony) to enact a statute protecting, by quasi-penal remedies, the right of the "owner" of the "coppie" (i.e., copyright) of a printed book to forbid unauthorized reprintings thereof.¹⁰² Yankee ingenuity thus framed a primitive copyright act more than a quarter of a century before the English Statute of Anne was passed.

It is, in submission, highly significant that the Massachusetts legislature did not purport to *create* the right of ownership which it protected by this enactment. It evidently presupposed the existence of legally recognizable owners of copyrights in the Colony, despite the three thousand miles which separated any such owners from the Stationers' Register in London (where English booksellers, according to a custom fathered by the English Licensing Acts, had been wont to record their copyrights). We can only conclude, therefore, that in 1672 the ownership of copyright was recognized in Massachusetts as a right antecedent to this early colonial statute and independent of the Licensing Acts of the Mother country—in short, that it was regarded as a right at common law. It may be further noted that the statute put no

102. IV Records Gov. and Co. of Mass. Bay, Part 2 (Shurtleff, ed.), 527 (1854); Solberg, *supra* note 97, at 113: "In ans^r to the petition of John Vsher, the Court judgeth it meete to order, & be it by this Court ordered and enacted, that no printer shall print any more coppies then are agreed & paid for by the owner of the said coppie or coppies, nor shall he nor any other reprint or make sale of any of the same, without the said owners consent, vpon the forfeiture and poenalty of treble the whole charges of printing, & paper, &c, of the whole quantity paid for by the owner of the coppie, to the said owner or his assignes." (Emphasis added.) For the background of this statute see Littlefield, *supra* note 99, at 79. It is to be observed that the act does not explicitly identify the "owner of the coppie" with the author of the work. The English booksellers, however, had recognized at least as early as 1660 that their "copies" did not originate with their entries of the same on the Stationers' Register, but were derived from and dependent on the authors' assignments of their manuscripts. Bald, *Early Copyright Litigation and Its Bibliographical Interest*, 36 Papers Bibliog. Soc. of America 81, 84-85 (1942); cf. Kirschbaum, *Author's Copyright in England before 1640*, 40 Papers Bibliog. Soc. of America 43 (1946). It is unlikely, therefore, that the phrase "the owner of the coppie" in the Massachusetts act was understood to mean anyone other than the author or his assignees. This may well account for the fact that Usher later felt obliged to procure a special enactment protecting his "coppie" in the printed laws of the colony (of which, needless to say, he was not the author)—a protection which, unlike the unrestricted coverage of the quoted statute, was limited by the General Court to a duration of seven years. Littlefield, *ubi supra*.

time limit upon the protection given to the owner's right. Clearly, the idea of a "perpetual" common law copyright had found a firm foothold of acceptance on this side of the Atlantic well before the end of the seventeenth century.¹⁰³

One hundred-odd years later, Madison's reference to common law copyright in the *Federalist*¹⁰⁴ made clear the fact that American approval of the booksellers' doctrines was not confined to Massachusetts and had survived (if, indeed, Americans were then even aware of) the English debate on the subject. Doubtless the wide circulation throughout the American colonies of the reprint of the fourth edition of Blackstone's *Commentaries*, published by Robert Bell of Philadelphia in 1770-71, and reissued by him in 1774,¹⁰⁵ did much to orient American legal thinking toward acceptance of the "natural right" theory of common law copyright as therein expounded. The fact is worth stressing that it was the *fourth* edition of Blackstone's treatise, originally published *after* the case of *Millar v. Taylor* had been decided but *before* that decision had been overruled by *Donaldson v. Beckett*, which was thus sown broadcast in pre-Revolutionary America; for that fact materially assists us to resolve an apparent conflict of opinion concerning Madison's attitude toward the common law right. The opposing sides of this conflict are represented, on the one hand, by Madison's biographer, Irving Brant, and, on the other, by Joseph Taubman, author of a profound and illuminating study of the copyright clause.¹⁰⁶

Brant maintains¹⁰⁷ that Madison was a life-long opponent of perpetual rights in intellectual property. He bases this thesis in part upon Madison's sponsorship of bills in the Virginia legislature in the 1780s giving short-term protections (a) to authors' copyrights and (b) to both Rumsey's and Fitch's claims of invention of steamboats. This evidence, however, is equivocal at best. The Rumsey-Fitch "patent" bills were, in essence, mere legislative promises to protect the two would-be inventors in their future rights to exploit discoveries which neither one of them had yet reduced to practice. To impose a time limit on such a promise, in regard to so inchoate a future

103. The Supreme Court was, of course, ignorant of these facts when it suggested, in *Wheaton v. Peters*, *supra* note 13, 33 U.S. (8 Pet.) at 659-60, that the common law right was not "suited" to the "condition" of the early settlers of America.

104. *Ubi supra* note 40.

105. Eller, *supra* note 44, at 37; Hamlin, *Legal Education in Colonial New York*, 64-65, 69-70 (1939). Bell's reprints of the *Commentaries* were the only editions thereof published in America until 1790, when Isaiah Thomas of Worcester, Mass. brought out a reprint of the tenth English edition, as the "first Worcester edition." Eller, *supra*, at 37-40.

106. Taubman, *supra* note 38, at 1-41.

107. 2 Brant, *James Madison*, 370-71 (1948).

expectancy of inventive accomplishment, is hardly evidence of antipathy to perpetual protection of inventors' property rights in their *achieved* discoveries. As to the Virginia copyright law, it is probable (as we shall show hereafter) that the time limits fixed by that act were intended to apply only to the quasi-penal *remedies* of forfeiture, which served as sanctions in the statute against infringements, and were not conceived as limitations on the basic *rights* of authors. Brant is, in submission, too much influenced in his interpretation of the evidence by an essay on monopolies which Madison wrote in 1832 but never published in his lifetime (the document was not, in fact, discovered and printed until 1914).¹⁰⁸ In that essay, Madison classified both copyrights and patents as monopolies, and maintained that they ought, as a matter of principle, to be limited in duration. Brant reads this Madisonian attitude of 1832 back into Madison's activities in the Virginia legislature in the 1780s and into his authorship, in 1787, of the "limited Times" phrase in the Constitution.

Taubman contends, on the contrary, that Madison was hostile to the idea of curtailing authors' and inventors' rights when the Constitution was framed and adopted.¹⁰⁹ He reaches this conclusion by the following argument: (1) In the 1780s the "natural right" theory was peculiarly congenial to American thinking. (2) Madison voiced no contrary doctrine in the *Federalist*. (3) In fact, he indicated in that work his approval of the recognition given to authors' rights in *Millar v. Taylor*, and suggested that the protection so given thereto by the common law ought to be extended to inventors. (4) Further-

108. Madison (Hunt, ed.), *Aspects of Monopoly One Hundred Years Ago*, 128 *Harper's Magazine* 489, 490 (March, 1914): "The Constitution of the United States has limited them [monopolies] to two cases—the authors of Books, and of useful inventions, in both which they are considered as a compensation for a benefit actually gained to the community as a purchase of property which the owner might otherwise withhold from public use. There can be no just objection to a temporary monopoly in these cases; but it ought to be temporary because under that limitation a sufficient recompense and encouragement may be given. The limitation is particularly proper in the case of inventions, because they grow so much out of preceding ones that there is the less merit in the authors; and because, for the same reason, the discovery might be expected in a short time from other hands." It is submitted that the most striking feature of this passage lies in what it does *not* say: Madison does *not* claim that authors' and inventors' "monopolies" are *required* to be "temporary" by the Constitution; he argues only that time limits upon such "monopolies" are desirable as a matter of public policy. Doubtless this is because he recognized that, however the federal power might be limited by the Constitution, the concurrent power of the states was unrestrained. See Turnbull, John Stevens, 256 (1928).

109. Taubman, *supra* note 38, at 13-14.

more, he flatly declared that the public interest "fully coincides with the claims of individuals" to such protection.¹¹⁰

Taubman, however, embellishes this argument with one other, less valid point. He notes (correctly) that no mention was made of *Donaldson v. Beckett* in Madison's passage on copyright in the *Federalist*, though *Millar v. Taylor* was clearly referred to and approved therein. It is, says Taubman, "incredible" that Madison should have known of the *Millar* case without also being aware of the *Donaldson* decision. If so, Madison's failure to mention *Donaldson* was clearly indicative of his antipathy to the doctrine thereby expounded; for, if Madison had been aware of *Donaldson* and in favor of its holding curtailing authors' rights, he would hardly have cited the *Millar* case without qualifying its authority by reference to the decision which had overruled it on just this point. On the other hand, we may interpose the observation that, if Madison had been hostile to the *Donaldson* doctrine (as Taubman contends), he was hardly so incautious an advocate as to refer to *Millar* without even a disparaging reference to the Lordly authority that had set that case aside. The fallacy underlying this point in Taubman's argument is its basic premise: that Madison must have known about the *Donaldson* decision in 1787. If Burrow's combined report of *Millar* and *Donaldson*¹¹¹ had been the only source from which Madison could have derived his knowledge of the earlier of those two cases, the premise might stand; but, as we have seen, Bell's reprint of the *Commentaries* was readily at hand as a source from which Madison could have learned of the *Millar* decision without finding out that it had been overruled.¹¹² The stress laid on the solemnity with which the *Millar* case had been adjudicated, both in Blackstone's footnote citing that decision and in Madison's reference to the case in the *Fed-*

110. *Supra* note 40. American acceptance of the "natural right" theory of literary property, in the 1780s, is amply supported by the terms of the preambles to many of the state copyright acts of 1783-86. See Solberg, *supra* note 97, at 11, 14, 18, 19, 25, and 27.

111. *Supra* note 1, 4 Burr. 2303-2418.

112. Madison was not among the subscribers to Bell's reprint (listed in the opening, unnumbered pages of Volume IV thereof). The first subscriber so listed, however, was Lord Dunmore, the last colonial governor of Virginia; when he was driven from the colony by the patriot forces, his library was sold at public auction, and Madison bought in a very substantial portion of it. 2 Brant, *supra* note 107, at 308. It is not unlikely, therefore, that Madison acquired a copy of Bell's reprint from this source. Alternatively, Madison may have read the copy of the English fourth edition of the *Commentaries* which was in the library of his good friend, Thomas Jefferson, at Monticello. 2 Catalogue of the Library of Thomas Jefferson, 228 (1953); cf. Letter of Madison to Jefferson, December 10, 1783, 2 Madison, *Writings* (Hunt ed.), 28 (1901).

eralist,¹¹³ points to Blackstone as the source of Madison's information on the subject. There is, on the other hand, nothing in the language of Madison's comment to suggest that he was acquainted with Burrow's account, or knew anything more about common law copyright than a reading of the *Commentaries* would have taught him.

In short, the evidence indicates three things about Madison's thinking on this subject in 1787: (1) He had learned of *Millar v. Taylor* from a reading of Blackstone's *Commentaries*. (2) He was then ignorant of the fact that *Donaldson v. Beckett* had overruled the *Millar* decision. (3) He then accepted Blackstone's "natural right" theory of copyright and saw no conflict between legal enforcement of that theory on the one hand, and the public interest on the other. Later in life his attitude changed; ultimately he came around to the views expressed by his essay on monopolies in 1832.¹¹⁴ But it must be emphasized that the observations concerning the advisability of limiting the duration of authors' and inventors' rights, which he made in that essay, were composed nearly a half-century after the Constitution and the *Federalist* had been written. It is significant, too, that Madison never claimed, even in 1832, that the Constitution *compelled* the imposition of time limits on authors' and inventors' common law rights. The transformation in his views, from support of the "natural right" theory in 1787 to his reprobation of patents and copyrights as monopolies in 1832, represented a complete reversal of his concepts of what the public interest required in the premises; but he was never guilty of the arrogance of reading his own, altered views of public policy into the Constitution. This metamorphosis in Madison's thinking, as we shall see, exactly reflected a similar change in the general climate of legal opinion on the subject in America, which took place between 1800 and 1824.

At this point, however, we need only note that all America, in 1787, apparently shared Madison's ignorance of *Donaldson v. Beckett* and his then uncritical acceptance of Blackstone's "natural right" theory of literary property. There is no indication that anyone disputed the justice and accuracy of Madison's brief comment, in the *Federalist*, on the patent-copyright clause at any time during the searching debates which preceded ratification of the Constitution in each of the thirteen states. Nor is it as strange as it may at first blush appear that a whole continent of English-speaking people,

113. The *Federalist*, *ubi supra* note 40: "The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law . . ." 2 Blackstone, *ubi supra* note 72: "In the case of *Miller v. Taylor* . . . it was determined (upon solemn argument and great consideration) . . . that an exclusive copyright in authors subsists by the common law."

114. *Supra* note 108.

many of them able lawyers, were unaware of the House of Lords' decision in *Donaldson v. Beckett* nearly fifteen years after it had been rendered. Other more important matters had, after all, been occupying their attention in that interval: a long and arduous war of independence, the establishment of new forms of government, and the severe post-war economic trials which had led, in New England, to actual armed insurrection. Surely, with all these difficulties and dangers on their minds, Americans of that era may well be pardoned their provincial ignorance of Grub Street's *cause célèbre*.

With the exception of the two anonymous reports of the *Donaldson* case, all the accounts of that decision were published after the Revolution had broken out. The two pamphlet reports were not likely to have attracted much interest on this side of the Atlantic when they first appeared in London in 1774; in any case, the little interest they might otherwise have inspired here was probably altogether checked by the colonial non-importation agreements of that year, making it difficult if not impossible to bring copies of those pamphlets into American hands. No full-scale report of *Donaldson v. Beckett* could have reached these shores, therefore, until the War of Independence was over—or nearly over.¹¹⁵ By that time, the two pamphlet reports had almost certainly been supplanted in England by Burrow's fourth and Brown's seventh volumes, containing their two reports of the decision. Other cases from Burrow's volume, first published in 1776, were cited here as early as 1781.¹¹⁶ Brown's volume, which saw the light in 1783, had probably arrived on this side of the Atlantic by 1785.¹¹⁷

115. We are reminded of the dangers of asserting that improbable events are impossible by the fact that Burrow's fourth volume was cited on this side of the Atlantic as early as 1781, two years before the Treaty of Paris was signed: *Nathan v. Virginia*, 1 Dall. (Pa.) 77, 78 (1781). Probably some Tory lawyer left the book behind when British evacuated Philadelphia in 1778.

116. The citations (in chronological order) appear in: *Nathan v. Virginia*, *ubi supra* note 115; *Respublica v. Doan*, 1 Dall. (Pa.) 86, 90, 91 (1784); *Purviance v. Angus*, 1 Dall. (Pa.) 180, 184 (and see *id.*, Appendix, 489, 494) (1786); *Farr v. McDowell*, 1 Bay (S.C.) 29, 30 (1786). We may also note that decisions reported in 5 Burr. were cited in two reported American opinions during this period: *Helms's Lessee v. Howard*, 2 Harr. & McH. (Md.) 57, 59 (1784); *Izzard v. Middleton*, 1 Dessaus. (S.C.) 116, 121 (1785).

117. 7 Bro. P.C. (1st ed.), *supra* note 1. Although the earliest American citations of this particular volume are believed to appear in *LeGuen v. Gouverneur & Kemble*, 1 Johns. Cas. (N.Y.) 436, 507 and 522 (1800), other volumes of Brown's work, published at the same time as volume 7, were cited in this country very shortly after their first appearance in England. Thus the reference, "6 Bro. 45," in *Izzard v. Middleton*, *ubi supra* note 116, appears, from the context, to be a citation of *Whaley v. Bagnel*, 6 Bro. P.C. (1st ed.) 45, 1 Bro. P.C. (2d ed.) 345, 1 Eng. Rep.

But it is one thing to acknowledge that these two volumes were available to American readers for a few years before 1787, and quite another thing to conclude that the reports of *Donaldson v. Beckett* contained therein were read here at that time. After all, unlike the first three volumes of Burrow's magnum opus, both his fourth volume and Brown's seventh were published too late to form a part of the corpus of reports from which the English common law, as received in America prior to the Revolution, had been established.¹¹⁸ Consequently, the decisions therein contained were not, *prima facie*, evidence of *American* common law. It is probably for that reason that they were cited infrequently by American lawyers and judges during the early years of our independence; on the few occasions when the decisions therein reported were so cited, it was only under a protective screen of other, older cases, from more familiar sources, supporting the points for which they were offered.¹¹⁹ In short, an American lawyer in the 1780s who had access to Burrow's or Brown's volumes made, in all likelihood, no more than a purely ad hoc use of them. In preparing a brief, he might, after completing his research into the older, accepted authorities, glance through these two volumes to see whether any decisions therein contained could usefully be flourished in his (or his adversary's) argument; but he was hardly likely to find his interest detained by decisions that had no manifest relationship to the particular problem he had in hand. It is, therefore, significant that the earliest reference in any reported American case to *Donaldson v. Beckett* appears in 1808, some thirty-

611 (H.L. 1765). Cf. the citation of that case *sub nom.* Whaley v. Bagel in *Pym v. Blackburn*, 3 Ves. Jr. 34, 38 note 1, at 39, 30 Eng. Rep. 878, 881 note 1, at 882 (Ch. 1796).

118. Cf. *Waters & Co. v. Gerard*, 189 N.Y. 302, 314 (1907): "Where recognized printed reports of the English courts prior to 1775 show that the common law on any particular subject was by such case established and determined . . . such reports are the best and highest evidence of such common law." (Emphasis added.) The court was applying a provision of the New York Constitution of 1777 by which the common law as it existed prior to April 19, 1775, was received as the law of New York State. But *caveat*: there is great variety in the terms of the reception statutes of the thirteen original states. See Goebel, *ubi supra* note 42.

119. See the cases cited *supra* note 116. It is believed (after diligent search) that these are *all* the citations of either of Burrow's last two volumes in the printed reports of all the American states covering decisions rendered prior to 1787. It is true that, in *Helms's Lessee v. Howard*, *ubi supra* note 116, counsel cited a case in 5 Burr. *without* older supporting authority; but he did so only for the purpose of refuting, by older authority, the point for which he supposed his adversary might be tempted to cite the case in question. So, too, in *Purviance v. Angus*, *supra* note 116, 1 Dall., Appendix, at 494, a case from 4 Burr. is cited without any other authority in point; but the citation appears in a *dissenting* opinion.

five years after that decision had been rendered—and more than twenty years after the Constitution had been written.¹²⁰

The conclusion that Americans were not acquainted with the *Donaldson* case in 1787 is further strengthened when we consider the terms of the state copyright laws of 1783-86, and the history behind their enactment. All of these statutes were closely modeled upon the English Statute of Anne.¹²¹ Like that enactment, all the statutes provided for the protection of authors' rights in published works by the quasi-penal sanctions of monetary forfeitures, available only for a limited period of time.¹²² Lawyers and legislatures familiar with the original analysis in Blackstone's *Commentaries* of the effect of the English statute on the common law rights of authors would almost certainly have recognized that the function of the statutory time limitations was to curtail the availability of those stringent remedies, not to cut short the very rights the statutes purported to protect. The omission, from all of the state enactments (save only that of South Carolina), of the negative words "and no longer," whose appearance in the Statute of Anne, following the time limitations thereof, had cast doubt on the Blackstonian construction of that English act, gives strong ground of support to this conclusion.¹²³ Furthermore, the only three state statutes which, in addition to forfeiture, granted an action for actual damages as a remedy for copyright infringement, did so only for unpublished works, and imposed no time limits on that particular remedy.

120. *Nichols v. Ruggles*, 3 Day (Conn.) 145, 152-53 (1808).

121. There were three other English copyright enactments in existence at that time: the statutes of 8 Geo. II c. 13 (1734), 7 Geo. III c. 39 (1767), and 17 Geo. III c. 57 (1777). All of these, however, dealt solely with the copyrighting of pictorial works. This was a topic not covered by the early American copyright laws.

122. Monetary forfeitures were the only remedies which *all* the state statutes afforded for infringements of published works. A few provided for forfeiture of infringing copies as well. Forfeitures of either kind were regarded as quasi-penal in character. See *Bolles v. Outing Co.*, 175 U.S. 262, 264-65 (1899).

123. *Supra* note 63. It did not (in submission) require acquaintance with the arguments of the judges in *Millar v. Taylor* and *Donaldson v. Beckett* to raise, in the minds of lawyers trained in eighteenth-century common law traditions of statutory construction, a question whether or not the common law right *might* be affected by the negative words "and no longer" in the Statute of Anne. The omission of those words from eleven of the twelve state statutes, therefore, particularly in the light of the general acceptance of the "natural right" theory of literary property (*supra* note 110), is significant of the American legislatures' intent to preserve the common law right. Conversely, however, the inclusion of those three words in the South Carolina enactment (Solberg, *supra* note 97, 21-22) does not necessarily bespeak a contrary intent; Blackstone's original analysis of the non-preemptive effect of the Statute of Anne, *supra* note 46, might well have persuaded the South Carolina legislators that the words did not operate to curtail the common law right.

Moreover, it is no mere coincidence that these same three statutes were also the only ones to provide:¹²⁴

"That nothing in this act shall extend to affect, prejudice or confirm the rights which any person may have to the printing or publishing of any book, pamphlet, map or chart, at common law in cases not mentioned in this act . . ."

In short, the only three statutes which undertook, to any extent, to duplicate the common law *remedy* were also the only three to declare explicitly that they did not intend to affect, favorably or adversely, the operation of the common law *right*.¹²⁵ The remaining nine state statutes, since they did not trench upon the common law remedy at all, had no need to make any similar reservation; every one of the state acts (with one equivocal exception) had made clear their purpose to leave untouched the common law right by carefully omitting the negative words, "and no longer," which had appeared in the English statute they all used as a model.

Each of these state enactments owed its existence to the industrious activities of one man: Noah Webster. His travels up and down the land, successfully petitioning for the enactment of the state copyright statutes of 1783-86, have justly earned him the title of "the father of copyright legislation in America."¹²⁶ Webster was not an active legal practitioner; but he had been trained to the bar in Litchfield, Connecticut, in 1780-81, when his friend and (perhaps) mentor, Judge Tapping Reeve, was beginning to make that pleasant community a Mecca for law students from all over the nation.¹²⁷ With a professional training of this quality behind him, Webster can hardly have been unaware of the theory of common law copyright in published works. We shall, in a moment, discuss the reasons that led him, none the less, to

124. Solberg, *supra* note 97, at 13, 28 and 31 (Connecticut, Georgia and New York). The New York statute, however, did not include the quoted reference to "map or chart;" it protected only books and pamphlets.

125. Professor Crosskey (*op. cit. supra* note 25, at 483-86) argues, with creditable hesitation, that the omission of this saving clause from the remaining nine state statutes evidences a widespread American hostility to the "perpetual" common-law right. If so, it is at least surprising to find no evidence of debate on the subject in America at the time any of these three statutes were adopted. Moreover, it is submitted that his argument fails adequately to appreciate: (1) the natural desire of all the state legislatures to curtail the quasi-penal remedies granted by the statutes (*supra* note 122); (2) their acceptance of the "natural right" theory of common law copyright (*supra* note 110); and (3) the significance of the omission of the negative words "and no longer" from all the state statutes save one (*supra* note 123).

126. Warfel, Noah Webster, Schoolmaster to America, 58 (1936).

127. *Id.*, at 39. And see Kilbourn, The Bench and Bar of Litchfield County, Connecticut, 26-27 (1909).

seek statutory protections for his writings. But we must first note that the earliest reference to *Donaldson v. Beckett* in his published correspondence appeared in 1803;¹²⁸ and that, from that time on, his campaign against American acceptance of the doctrine of that case was both vigorous and persistent.¹²⁹ Had there been any intention to implement the *Donaldson* doctrine by the time limitations of the early state statutes, or to make it the supreme law of the land by the "limited Times" phrase in the Constitution, it is simply inconceivable that Webster would have taken fifteen to twenty years to discover that fact and to raise his voice in protest.¹³⁰ His silence on the point until 1803, and his vigorous objections thereafter, bear eloquent witness to the fact that no such intention was in the minds of the framers of these enactments.

Why, then, if it was generally supposed that authors' rights in their works were recognized and protected by the common law both before and after publication, did Webster and the legislatures which responded to his petitions seek to protect these rights by statute as well? Three reasons, at least, may be at once suggested: (1) The common law remedy was almost wholly inadequate to prevent piracy. (2) The common law right in published works was, in important respects, vague and uncertain. (3) The common law right was restricted geographically; it could be protected only in those states in which the author or his assigns actively exercised the right by publishing the author's work. Each of these points will bear some elaboration.

The sole remedy for infringement of authors' rights afforded by the common law was the right to sue the infringer for actual damages. Then

128. Letter of Webster to Simeon Baldwin, December, 1803, Webster, *Letters* (Warfel, ed.), 253 at 254 (1953). Cf. Letter of Webster to Rufus King, August 22, 1800, *id.*, 218-19 where Webster declares his familiarity with "many cases adjudged upon the English statute"—but without identifying any of the cases.

129. Letter of Webster to Simeon Baldwin, December, 1803, Webster, *ubi supra* note 128; Letter of Webster to John Pickering, December 1816, *id.*, 341 at 383-86; Letter of Webster to Daniel Webster, September 30, 1826, *id.*, 417 at 418-20. In February, 1828, Martin Van Buren "presented [to Congress] the petition of Noah Webster and others, praying that the existing laws respecting copyrights may be so amended as to give to authors and their heirs the *exclusive* and *perpetual* property in their works . . ." Solberg, Copyright in Congress, 1789-1904, *A Bibliography and Chronological Record*, 136 (1905) (italics in original). The petition met with considerable sympathy on Capitol Hill. See the report of the House Judiciary Committee of 1830, quoted in the dissenting opinion of Thompson, J., in *Wheaton v. Peters*, *supra* note 13, 33 U.S. (8 Pet.) at 690-91. No one seems to have suggested a constitutional barrier to this proposal until 1839. On Literary Property, 4 *New York Review* 273, 276 (April, 1839).

130. Webster was present in Philadelphia during the deliberations of the constitutional convention, and was one of the first and ablest champions of the resulting scheme of government. Warfel, *supra* note 126, at 165-70.

as now, however, such damages were hard to prove.¹³¹ There was, in consequence, a very real need for a statute fixing a determinate monetary penalty for literary piracy. Hence the quasi-penal remedies of forfeiture in all the early state statutes, which we have previously noticed.

Secondly, Blackstone's ill-starred speculations on the subject of dedicatory publication created grave doubts as to the proper manner of preserving the common law right in published works. Blackstone had indicated (subject to an unhelpful "perhaps") that publication *might* be dedicatory unless accompanied by a "reserve of right" or the stamping of "marks of ownership" on the published work.¹³² But he was above discussing such matters as the proper *form* for a "reserve of right," and the exact *style* of "marks of ownership." The lack of answers to these practical problems left poor Webster in a quandary: he urgently needed a clear and certain protection for a specific work—his "American Spelling Book"—which he was about to publish.¹³³ He could not afford to guess at the answers to Blackstone's speculations, nor to await "the law's delays" in resolving them. It was, in all probability, this immediate need, confronted with such vexing doubts, that prompted Webster's impatiently exaggerated explanation of the difficulty he wanted legislative help to overcome, in his petition to the New York legislature in 1783 for a copyright statute:¹³⁴

" . . . to secure to your petitioner the benefits of his own labors to which he considers himself solely entitled *but which are not protected by the laws that protect every other species of property . . .*" (Emphasis added.)

Even if the common law right had not been saddled with the uncertainties created by Blackstone's adventure into the theory of dedication, Webster's sweeping observation would not have been entirely inaccurate. The "laws that protect every other species of property" would make the thief who stole a watch liable in damages to the true owner wherever the thief might flee. But it was by no means certain, in 1783, that the common law would protect an author against literary piracy in any state in which he did not exercise

131. See Justice Aston's remarks in *Millar v. Taylor*, quoted *supra* note 61. It might be observed that Millar recovered only nominal damages of one shilling in that case. 4 Burr. at 2309, 98 Eng. Rep. at 205. For modern difficulties, see *F. W. Woolworth Co. v. Contemporary Arts*, 344 U.S. 228 (1952).

132. *Supra*, text accompanying note 45.

133. Warfel, *supra* note 126, at 53-61.

134. Webster, *supra* note 128, 5 at 7.

his right to multiply copies of his work.¹³⁵ Not until nearly a century later was it settled in America that an alien author could seek protection of his common law rights in a jurisdiction where he was not actively exercising them; and the point was then so decided in despite of English dicta to the contrary.¹³⁶ In the 1790s, however, the accepted theory seems to have been that an author's right to reap the fruits of his published labors was coterminous with the boundaries of the jurisdiction in which he exercised that right. Thus one of Webster's biographers informs us:¹³⁷

"... an author [in the 1780s], in making his arrangements [for publication], was *accustomed* to sell the right to print and publish to various printers in various parts of the country,—a custom which continued through the first quarter of the [nineteenth] century." (Emphasis added.)

The common practice of Scotch, Irish, and American publishers of that time was to bring out unauthorized editions of the writings of English authors. This bears further witness to the prevalence, in the English-speaking world of the eighteenth century, of the concept of geographic limitations on authors' rights.¹³⁸ Under this concept, an American author who wished to reap the full profits of his own work under the protection of the common law would have been obliged to contract to publish with printers in every state of the (then) Confederation; for, if he failed to do so, he would be exposed to the dangers of competition from pirated copies of his work printed in any or every state in which he had not made such arrangements. It was because of this situation that Madison declared in the *Federalist* that the "States cannot *separately* make effectual provision" to protect authors' rights (emphasis added).¹³⁹ Only some form of nationwide protection could relieve American authors of this burden. As Madison further observed, the states had "anticipated the decision [by the Constitutional Convention] of this point [of making copyright protection nationwide in extent], by laws passed at the

135. See *Wheaton v. Peters*, *supra* note 13, 33 U.S. (8 Pet.) at 658; cf. *Capitol Records v. Mercury Records Corp.*, *supra* note 6, 221 F.2d at 662.

136. *Palmer v. DeWitt*, *supra* note 14, 47 N.Y. at 540, distinguishing *Jefferys v. Boosey*, *supra* note 4 (cf. 47 N.Y. at 534, argument of counsel). And see *Guichard v. Mori*, 2 Coop. T. Cott. 216, 47 Eng. Rep. 1134 (Ch. 1831).

137. Scudder, *supra* note 97, at 69-70.

138. To argue from this practice that the common law right was not recognized in America, as Professor Crosskey does (I Crosskey, *supra* note 25, at 482), is going much too far. We might as well argue from the bibulous habits of many Americans during the 1920s that the Eighteenth Amendment was never adopted.

139. *Ubi supra* note 40.

instance of Congress."¹⁴⁰ Each of the state laws not only protected the rights of the citizen-authors of the enacting state, but also extended protection to authors who were citizens of *any* of the United States.

The Constitution, for reasons of manifest convenience, simply shifted the power to provide such nationwide protection to the new federal government. But the need thus met for the protection of authors' rights on the national level should not be confused with a felt need for uniformity in the law of literary property. As others have pointed out,¹⁴¹ the framers of the Constitution knew how to make a need for uniformity explicit when they truly felt it. They did so, for example, in the constitutional clause creating federal legislative power over the subjects of naturalization and bankruptcy.¹⁴² Significantly, they did not do so in the patent-copyright clause.

The copyright statutes which Congress was authorized to enact under that clause were necessarily envisaged as occupying a different relationship to the common law right than their predecessor state enactments. The latter, as we have seen, contained limitations of time primarily because of the quasi-penal character of the remedies they afforded for infringement. But the Constitution said not a word to restrict the federal power to the provision of such extraordinary remedies. Consequently, we must look elsewhere for the motives that impelled the authors of the clause to provide that "the exclusive Right" should be protected "for limited Times."

We may begin by noting the important fact that the Constitution did not define "the exclusive Right." It did not, to speak more particularly, expressly identify that "Right" with the common law right—as the Seventh Amendment (for example), adopted just a few years later, was explicit to "preserve" the "right" to jury trial which had previously existed in "suits at common law."¹⁴³ The framers wisely chose to leave Congress free to *define* "the exclusive Right" of "Authors and Inventors" as well as to *secure* it; they did not chain the future to the narrow concepts of statutory or common law copyright prevalent in the eighteenth century.¹⁴⁴ Accordingly, the "Right" which Congress was thus left to define was one that was free to grow beyond the limits of the common law right. Indeed, simply by extending across state boundaries, it exceeded the limits of common law copyright at its very

140. *Id.*

141. Kalodner & Vance, *supra* note 28, 72 Harv. L. Rev. at 1084; Kaplan, *supra* note 27, 69 Harv. L. Rev. at 421-22.

142. U.S. Constitution, Art. I, §8, cl. 4. But cf. *Collet v. Collet*, 2 Dall. 294 (C.C. Pa. 1792), as explained in *U.S. v. Viaropoulos*, 221 Fed. 485, 488-89 (W.D. Pa. 1915).

143. U.S. Constitution, Amendment VII.

144. See *Dable Grain Shovel Co. v. Flint*, 137 U.S. 41, 43 (1890).

birth. It is in this sense that the federal statutes may justly be said to create a "new" right instead of merely protecting an old one.¹⁴⁵

On the other hand, there is nothing in the language of the constitutional clause, read against its historical background, to suggest that the existing power of the states to protect their own authors and publishers, within their own borders, by the common law, was meant to be curtailed by the federal statutes, or was surrendered to the nation by the Constitution.¹⁴⁶

Such a purpose, as we have seen, was alien to the thoughts of the framers. We are compelled, therefore, to conclude that they envisaged the two constitutional sovereignties, state and federal, as creating and protecting two independent rights in the same subject matter, which would operate concurrently. Obviously, the danger of conflict could not be discounted. To minimize that danger, the *federal* power was restricted: it could act only "for limited Times". The state power to enforce the common law right was retained; it was subject only (and at most) to a temporary interference by the federal power. It would seem that the demand for interstate protection of authors' rights was thought to resemble the demand for statutory forfeitures in this one respect: it expressed a need for relief of an extraordinary character. It was only natural, then, to impose a similar time restriction on the fulfillment of that extraordinary need.

The suggestion just made, that the authors of the patent-copyright clause envisaged—if only "for limited Times"—the concurrent operation of state and federal powers to protect intellectual property, will doubtless come as a shock to those who still approach the problems of our constitutional federalism in the spirit of Ancient Pistol's demand, "Under which king, Bezonian? speak, or die."¹⁴⁷ Underlying any such approach is the supposition that the national government must forever be regarded as the jealous rival for power of the governments of the several states. But such a concept simply will not do as a basis for construction of the constitutional instrument. True enough, a principle of federal supremacy was there enshrined in order to resolve conflicts that could be settled in no other way.¹⁴⁸ But it is, to say the least, unrealistic to imagine that the very practical politicians who wrote the Constitution entirely discounted the probability that both powers—state and federal—would ultimately come, like husband and wife, to recognize and accept (however reluctantly) their mutual need to act cooperatively.¹⁴⁹ Both powers,

145. Curtis, *supra* note 76, at 80-82.

146. See *Livingston v. Van Ingen*, 9 Johns. (N.Y.) 507, 581-82 (1812).

147. Shakespeare, II Henry IV, Act V, sc. 3.

148. U.S. Constitution, Art. VI, cl. 2.

149. See Corwin (ed.), *The Constitution of the United States of America*, Introduction, xiii-xiv (U.S. Gov't Print'g Off., 1953).

after all, were deemed to have a common source in, and responsibility to, "the People." Indeed, as we trace the subsequent history of common law and federal copyrights, we shall find that such unforced cooperation has generally been the rule, even when both powers were dealing with the same subject matter at the same time. Let us consider, for example, the concurrent protections which both powers have extended to unpublished works.

C. CONCURRENT POWERS IN PRACTICE: UNPUBLISHED WORKS

Every general copyright statute passed by Congress, from the first Act of 1790 down to (but not including) the present Act of 1909, accorded to the creator of a literary work an unconditional remedy, by way of an action for actual damages, for unauthorized printings of his unpublished manuscripts.¹⁵⁰ This was exactly the same remedy as that accorded by the common law of literary property for exactly the same injury. Yet even though the statutory remedy was readily enforced by the federal courts,¹⁵¹ it was always held that the federal act did not supplant the power of the states concurrently to enforce an author's common law copyright in his manuscript.¹⁵² It is no small tribute to the vigor and effectiveness of the state courts that authors ultimately came to look to the common law, rather than to the federal

150. Act of May 31, 1790, §6, 1 Stat. 125-26; Act of February 3, 1831, §9, 4 Stat. 438; Act of July 8, 1870, §102, 16 Stat. 215; Rev. Stat. 1873-74, Tit. 60, c. 3, §4967; Act of March 3, 1891, §9, 26 Stat. 1109. All of these enactments are collected in Solberg, *supra* note 97, at 32-64. The present statute (17 U.S.C. §1 *et seq.*) is, with minor amendments, the Act of March 4, 1909, 35 Stat. 1076 *et seq.* The original provision in section 6 of the Act of May 31, 1790, *supra*, read: "That any person or persons who shall print or publish any manuscript, without the consent and approbation of the author or proprietor thereof, first had and obtained as aforesaid, (if such author or proprietor be a citizen of or resident in these United States) shall be liable to suffer and pay to the said author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof." Section 9 of the Act of February 3, 1831, *supra*, added a provision for equitable relief. This added provision was not included in section 102 of the Act of July 8, 1870, *supra* (it was removed to another section). That act also eliminated from the section the words "as aforesaid" and the last two phrases (beginning with the words "to be recovered") of the original enactment. By section 9 of the Act of March 3, 1891, *supra*, the requirement that the author be a citizen or resident was removed. For the repeal of this provision by the Act of Mar. 4, 1909, *supra*, see *infra* note 153.

151. E.g., *Boucicault v. Hart*, 3 Fed. Cas. 983, 987-88, No. 1,692 (C.C.S.D.N.Y. 1875); *Bartlett v. Crittenden*, 2 Fed. Cas. 967, No. 1,076 (C.C. Ohio 1849); *id.* (*sub nom.* *Bartlette v. Crittenden*), 2 Fed. Cas. 981, No. 1,082 (C.C. Ohio 1847).

152. *Press Pub. Co. v. Monroe*, *supra* note 30; *Palmer v. DeWitt*, *supra* note 14; *Woolsey v. Judd*, *supra* note 30; and see *Cardinal Film Co. v. Beck*, 248 Fed. 368 (S.D.N.Y. 1918).

statute, as the normal source of protection for their unpublished manuscripts. By 1909, this had become so universally the case that Congress, by the Copyright Act of that year, gracefully retired from the field, and left the protection of unpublished works entirely to the states' common law.¹⁵³

That, at any rate, seems to be what the Congress of 1909 *thought* it was doing; for the Copyright Law it enacted not only expressly disclaimed any intention of interfering with authors' common law rights in their unpublished works,¹⁵⁴ but also provided (in what is now section 24 of the statute)¹⁵⁵ that every work copyrighted under the Act was to be protected for a renewable term of twenty-eight years running from "the date of first publication." An apparently unforeseen difficulty was encountered, however, in applying this provision to works registered for federal copyright under what is now section 12 of the statute.¹⁵⁶ That section extended the coverage of the Act to certain kinds of works (lectures, dramas, plastic art, photographs, music, and—later—motion pictures) which were "not reproduced in copies for sale." Statutory protection for such works was conditioned upon registration and deposit of one complete copy of the work in the Copyright Office (except as to motion pictures, for which it was necessary to deposit only a partial copy). All such works had two characteristics in common: (1) They could be publicly exploited, by performance or exhibition, without being "reproduced in copies for sale." (2) Such modes of public exploitation were not regarded as dedicatory publications at common law.¹⁵⁷ Manifestly, therefore, the statute made, or seemed to make, protection available to such works while they were still, in the common law sense, *unpublished*. How, then, could section 24 apply to such works?

Congress, apparently, had relied on a familiar common law doctrine which regarded the deposit of any copyrightable work in a place of public access (such as a library or museum) as a dedicatory publication.¹⁵⁸ It was

153. Act of March 4, 1909, §§2 and 63, 35 Stat. 1076, 1088. And see *Capitol Records v. Mercury Records Corp.*, *supra* note 6, 221 F.2d at 666 (dissenting opinion; point not discussed by majority opinion). But cf. *Weil*, *supra* note 16, at 584, expressing doubt as to the efficacy of section 63 to repeal the prior statutory provisions protecting unpublished manuscripts. The doubt so expressed is, in submission, one of excessive nicety.

154. Act of March 4, 1909, §2, *supra* note 153 (17 U.S.C. §2).

155. 17 U.S.C. §24; Act of March 4, 1909, §23, 35 Stat. 1080.

156. 17 U.S.C. §12; Act of March 4, 1909, §11, 35 Stat. 1078, as amended by Act of August 24, 1912, 37 Stat. 488.

157. See *Ferris v. Frohman*, *supra* note 14; *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Palmer v. DeWitt*, *supra* note 14.

158. *Brown v. Select Theatres*, 56 F. Supp. 438, 441 (D. Mass. 1944); *Rees v. Peltzer*, 75 Ill. 475 (1874); *Tams-Witmark Mus. Library v. New Opera Co.*, *supra* note 10,

thought that, under this doctrine, the statutory requirement that a copy of the work be deposited in the Copyright Office in the Library of Congress amounted to a direction that the work be "published" in this manner.¹⁵⁹ The difficulty with this theory, however, was that it disregarded a further common law rule, which held that the doctrine of deposit publication was not applicable if any restrictions, express or implied, were imposed on the freedom of the general public to copy the work in the place where it was deposited.¹⁶⁰ Members of the general public were *not* free to copy section 12 works in the Copyright Office; for, if they did, they would be infringing the very copyright which that section purported to grant.¹⁶¹ It followed, therefore, that the doctrine of deposit-publication could not apply to such works until the expiration of the period of statutory protection. But that period did not *start* to run until the "date of first publication."¹⁶² The argument thus came full circle.

The problem came to a head in 1938, when two of the Marx brothers played an unsuccessful one-night stand as appellants before the United States Court of Appeals for the Ninth Circuit.¹⁶³ Groucho and Chico had been convicted in a federal district court of willfully infringing the copyright, under section 12, of a radio script which—apart from its deposit in the Copyright Office—had never been published. On appeal from that conviction, the two comedians contended: (1) that section 12 protected unpublished works; (2) that section 24 imposed a time limit only on the statutory

298 N.Y. at 171-72, 81 N.E. 2d at 73 (1948); *Jewelers' Mercantile Agency v. Jewelers' Weekly Pub. Co.*, *supra* note 9, 155 N.Y. at 251, 49 N.E. at 875 (and see concurring opinion, 155 N.Y. at 254, 49 N.E. at 876); *Wright v. Eisle*, 86 App. Div. 356, 83 N.Y.S. 887 (1903); *Tumey v. Little*, 18 Misc. 2d 462, 186 N.Y.S. 2d 94 (1959). In recent years, however, the whole concept of deposit-publication has come under strong critical fire. Price, *Photocopying by Libraries of Copyrighted Material*, 5 BULL. CR. SOC. 345 (1958); Nimmer, *supra* note 35, 56 Colum. L. Rev. at 200; Howell, *The Copyright Law*, 57-59 (1942). Consequently, we are beginning to witness a judicial repudiation of the doctrine. *Fader v. Twentieth Century-Fox Film Corp.*, 169 F. Supp. 880 (S.D.N.Y. 1959); *Smith v. Paul*, 174 Cal. App. 2d 744, 345 P.2d 546 (1959). And see *Heim v. Universal Pictures Co.*, 154 F.2d 480, 486 (2d Cir. 1946) (dictum). We may note, however, that the *Fader* case, *supra*, could and probably should have been decided on other grounds, *viz.*: that a mere error in classifying a copyrighted work (in Class A instead of Class D) is not a valid ground for annulling a statutory copyright therein. 17 U.S.C. §5.

159. *Weil*, *supra* note 16, 289-304. And see 17 U.S.C. §212.

160. See *American Tobacco Co. v. Werckmeister*, *supra* note 157, 207 U.S. at 300.

161. Cf. Copyright Office Rules and Regulations §201.2(d)(2), 37 C.F.R. c. II, Part 201, restricting copying of such works.

162. *Supra* note 155.

163. *Marx v. U.S.*, 96 F.2d 204 (9th Cir. 1938).

protection of published works; (3) that section 12 works, unless subsequently published, were thus protected in perpetuity; and (4) that such perpetual protection was invalid because it would violate the "limited Times" requirement of the Constitution.

The Court of Appeals accepted, without discussion (perhaps only *arguendo*), the brothers' first point: that section 12 protected unpublished works. But the Court held, after a full review of the statute and its legislative history, that Congress had intended section 24 to apply to works copyrighted under section 12, and that, *for this purpose*, "the date of first publication" in section 24 should be construed to mean the date of registration and deposit of a section 12 work in the Copyright Office.¹⁶⁴ It is important to note that the Court did not "force" this construction in order to avoid reaching the constitutional question. On the contrary, it made a careful and workmanlike job of construing the statute in such a way as to accord with the evident intent of Congress in the premises.¹⁶⁵ Since the Marx brothers' argument was thus refuted at its second step, the Court never had occasion to decide whether the statute would otherwise have been deemed to be unconstitutional. The question, therefore, is still an open one; may Congress constitutionally protect unpublished works perpetually (in effect), by extending coverage to such works from the moment of their creation while running the limited time of such statutory protection from the date of their first publication? It is submitted, for reasons now to be advanced, that Congress not only *may* do so, but that it has, in fact, repeatedly done so in the past. This is not to say that it was wise to do so; that question is not before us. We are discussing the constitutional scope of Congress's powers, not the soundness of its views of public policy.

The section of the Copyright Act of 1790 relating to unpublished manuscripts, previously discussed,¹⁶⁶ imposed no time limits on the protection thereby granted to such works. Nor did any of the later re-enactments of that provision do so.¹⁶⁷ For over a century after the adoption of the Constitution, in short, Congress acted again and again on the evident supposition that the "limited Times" phrase was fully complied with by a statute which, read as a whole, protected literary property from the moment of its creation until the end of a fixed period *after publication*. The possibility that publication might never occur, and that, accordingly, the statutes might

164. See *Shilkret v. Musicraft Records*, 131 F.2d 929, 932 (2d Cir. 1942), cert. denied, 319 U.S. 742 (1943).

165. Weil, *supra* note 16, 289-304. And see *Shilkret v. Musicraft Records*, *supra* note 164.

166. *Supra* note 150.

167. *Id.*

protect unpublished manuscripts in perpetuity, did not, it seems, disturb the constitutional conscience of these legislators.

And after all why should it? A familiar doctrine of English law might well have suggested to the various Congresses concerned that a limit of time does not cease to be a limit of time merely because it is made to depend on an event that, quite possibly, may never occur. That suggestive doctrine was the rule that statutes of limitation, in cases of fraud, should be construed to run from the date when the victim discovered the wrong, rather than from the date on which the wrong was committed.¹⁶⁸ Under the limitation statutes so construed, an action for fraud was never barred if the deception was never discovered; yet the statutes were none the less deemed to impose a true time limit on the right to bring such an action. Just so, a system of federal copyright law applicable from the creation of a protected work until a fixed period after its publication might reasonably be said, as a matter of law, to be subject to a limit of time, even though publication might never occur.¹⁶⁹

In short, the legislative construction of the "limited Times" phrase evidenced by the enactments under discussion was an entirely reasonable one. It has behind it the considerable persuasive force of its apparent adoption by the first Congress of the United States, in the Copyright Act of 1790.¹⁷⁰ Many of the members of that Congress had been delegates to the Constitutional Convention; they can hardly be supposed to have flouted the very

168. The pertinent English authorities, both at law and in equity, are conveniently collected and discussed in *Bailey v. Glover*, 88 U.S. (21 Wall.) 342, 348 (1875). Most modern statutes of limitations make this construction explicit. A further refinement is often added, either expressly or by way of judicial construction: that the limitation runs from a date when "reasonable diligence" should have discovered the fraud. The courts thus discourage the temptation to reap a golden harvest from willful blindness or unconvincing stupidity. The test is not, however, an easy one to apply; for it depends on a nice determination of what diligence would have been "reasonable" under circumstances that will almost inevitably have become somewhat obscure by the time any court is required to judge of the matter. See, e.g., *Universal Film Exchanges, Inc. v. Swanson*, 165 F. Supp. 95, 97-99 (D. Minn. 1958). In any event, it is clearly conceivable that the discovery of a skillful fraud might elude even "reasonable diligence" forever.

169. This construction of the "limited Times" phrase has been criticized *ex hypothesi* on the ground that it substitutes a "limit on use" for the constitutionally prescribed "limit on time." Kalodner & Vance, *supra* note 28, 72 Harv. L. Rev. at 1083. This novel categorization of "limits" seems to have originated with the authors of the cited article; they do not, however, undertake to demonstrate their apparent (though tacit) assumption that these two categories are mutually exclusive. In short, logic is lacking to support their conclusion that a "limit on time" will automatically lose its character as such merely because it may also be aptly described as a "limit on use."

170. *Supra* note 150.

instrument they had thus helped to frame.¹⁷¹ It is clear, therefore, that the federal government, by protecting "Writings" from the time of their creation until a fixed term after the date of their publication, (a) may constitutionally afford coverage to unpublished works in perpetuity, (b) has done so, and (c) has not been deemed thereby to have preempted the concurrent power of the states to supply their own common law remedies for infringement of such works.

This raises an obvious question. If both federal and state powers may concurrently protect unpublished works (as we have seen that they may), what strange magic resides in the act of publication that will prevent both powers from protecting published works concurrently as well, at least for as long as Congress chooses to make federal protection last? Certainly our review of the historical background of the patent-copyright clause has made it clear that the framers of that provision neither intended nor created thereby any direct hindrance to the exercise of concurrent powers over published "Writings." The "limited Times" phrase was written only as a restraint on the federal power; it was never intended to curtail common law rights in literary property in the several states.

The difficulty here is not, in fact, a constitutional one. It stems, instead, from a view of public policy which the courts have so consistently read into the federal statutes that it has achieved an almost constitutional force of its own. According to that view, the public interest imperatively requires that authors shall not possess their published works in perpetuity; and it follows logically from this premise that, even though the Constitution does not directly express that policy, Congress may (some courts seem almost to say that it must) "promote the Progress of Science and useful Arts" by providing, in the federal copyright statutes, for the divestment of authors' "perpetual" common law rights in their published works. Our next task, therefore, is to answer three questions: (1) How did this theory come into being? (2) Does the constitutional clause, in fact, confer any such divestitive power upon Congress? (3) If it does, what are the constitutional limits, if any, upon that power?

[Part II of this article will be published in our February, 1962 issue]

171. See *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 57 (1884).

63. MEETING OF THE INTERNATIONAL LITERARY AND ARTISTIC ASSOCIATION (A.L.A.I.)

(Florence, September 11-16, 1961)

By THOMAS L. FINKELSTEIN

At the invitation of the Perpetual Secretary, over 100 members of the International Literary and Artistic Society from twelve countries* participated in the 49th Congress of the Association held in Florence from September 11 to 16, 1961, under the sponsorship of the Italian Group of the A.L.A.I. and the Italian Authors' and Publishers' Society (S.I.A.E.). Marcel Boutet, President of A.L.A.I., presided at the Congress. Resolutions dealing with the subjects covered in Sections 1 to 6 below were adopted at the closing session of the Congress. These resolutions are set out in Section 7 below. Brief additional comment on several subjects of discussion is included in Sections 1 to 5 below.

1. *Neighboring Rights*

The major topic of discussion at the conference was the draft treaty on "neighboring rights" promulgated at The Hague Conference held under the auspices of the Government of the Netherlands, on May 9-20, 1960. (See 8 BULL. CR. SOC. 31, Item 15 (1960); and 8 BULL. CR. SOC. 71, 72-73 (1960).)

Following Prof. Henri Desbois' status report and analysis of the draft treaty, a number of the participants in the Congress debated the many controversial features of the treaty, notably those sections dealing with the rights of interpreters.

Several participants in the discussion felt that it was difficult as a matter of logic to refuse to interpreters the rights granted to creators. The majority of the participants expressing views seemed to feel, however, that there was a major difference between the contribution of the creator and that of the interpreter.

Several speakers also felt that, as stated in Article 2 of the draft treaty, the treaty would in no way injure authors' rights. There was sharp disagreement again on this issue, the majority of the participants taking the view that as a matter of economics, what was given to the interpreters would in large measure be taken from the creators.

* Belgium, Finland, France, Germany, Greece, Italy, Netherlands, Norway, Sweden, Switzerland, U.A.R. (Egypt) and U.S.A. Representatives of various international organizations including UNESCO, the Berne Bureau, and C.I.S.A.C. also participated in the Congress.

It was also pointed out that in many instances the interpreter's right would be greater than that of the creator. It was pointed out that a notable example is the United States, where the author of a musical composition is subject to the compulsory license provision of Section 1(e) of the Copyright Act, while the interpreter would have an absolute right to prohibit reproduction without permission.

There was also vigorous debate on whether signatories of the treaty should be required to assure a minimum amount of protection to performers, manufacturers, and broadcasters, or, alternatively, whether it should be sufficient for signatory nations to undertake not to discriminate against non-nationals in whatever laws might be in effect in a signatory nation.

The debate on "neighboring rights" has by now been removed to the Diplomatic Conference in Rome.

2. Duration of Copyright

Substantial discussion was given over to the report of Dr. Antonio Ciampi on the question of increasing the minimum duration of copyright pursuant to Article 20 of the Berne Convention from 50 to 80 years after the death of the author. The matter, which was previously studied by the Council of Europe and the Berne Union Bureau, has been examined by a Committee of Experts formed under the auspices of the Berne Union, who drafted, in January, 1961, a project of arrangement on this subject (see 8 BULL. CR. SOC. 255, item 195, April 1961). Substantial support for this increase exists in Europe, notably on the part of the Italian Government, but substantial opposition also exists, notably on the part of the governments of the Scandinavian countries.

3. Copyright and Film Rights

Mme. Lucy Willemetz presented a report on the various current problems relating to copyright in cinematographic works. The most vigorous portion of the discussion related to the extent to which authors should cede (or be presumed to cede) their rights to film producers when their works are used in films. The sharp difference between American and European law on this point was discussed at some length.

4. New Scandinavian Copyright Legislation

A report was presented by Prof. Seve Ljungman on the new Scandinavian Copyright Legislation.* In the case of each country, the new legislation is

* *Denmark*, Law of May 31, 1961; *Finland*, Law of July 8, 1961; *Norway*, Laws of June 17, 1960, and May 12, 1961; and *Sweden*, Law of December 30, 1960.

in the form of a complete and unified copyright law revision. Perhaps the most novel provision in any of these laws is Article 22 of the Swedish law, which provides in part:

"A Swedish radio or television organization, as defined by the King in Council, which has an agreement with an organization representing a large number of Swedish authors in the field, under which it may broadcast literary and musical works, may also broadcast published works of authors who are not represented by the organization; such authors shall be entitled to compensation for the broadcast. The rule stated shall not apply to the dramatic works, nor to works for which the author has prohibited broadcast or in other cases where there is a particular reason to assume that the author will oppose the broadcast."

It was stated that the only complaint that has arisen so far out of this provision was a complaint against unauthorized use lodged by Sir Winston Churchill.

5. *United States Copyright Law Revision Project*

A communication from Dr. Arpad Bogsch on the current Copyright Office Studies and the Report of the Register was summarized for the conference by Mr. Victor Melas.

In connection with the discussion of the Copyright Office Studies, the Congress formally expressed its indebtedness to the late Register, Mr. Arthur Fisher, for his life-long devotion to the cause of authors' rights, and for his many contributions to previous international meetings, including the A.L.A.I. Congress in 1959 in Athens.

6. *Other Topics*

Reports were also given on the following subjects at the conference:

- a) Report on the Protection of Designs and Models, by Dr. Alois Troller
- b) Report on the Loan and Rental of Records and Books, by Prof. Torben Lund
- c) Report on the German Copyright Law Revision Projects, by Dr. Heinz Kleine.

7. *Resolutions*

Nine resolutions were passed at the closing session of the conference, the texts of which are set out below.

1. RESOLUTION RELATIVE TO NEIGHBORING RIGHTS

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Having heard the report of Professor Desbois on the draft of the Committee of Experts adopted at The Hague in 1960, relating to the international protection of interpreting and performing artists, record manufacturers and broadcasters; and on the state of the question as it appears on the eve of the Diplomatic Conference called for next month in Rome,

Recalling the principles affirmed on this subject during the course of preceding Congresses,

Believes, above all, that because of the insufficiency or divergencies of national legislation on the subject, an international convention does not seem opportune or useful, and that it is at the very least premature, the lack of unity of views being manifested, for example, by the fact that The Hague draft contains on several essential points of both substantive and procedural law a renvoi to national laws,

In any case, is of the opinion that the new international instrument which is envisaged should only be open to ratification or adhesion to member states of the Berne Union or parties to the Universal Copyright Convention, and that it should only be effective between states bound by the same Convention, whether it be those of the Berne Union or the Universal Copyright Convention,

Considers that, in regard to the tenor of the essential articles conferring the rights sought by the treaty being drawn up, the declaration contained in Article 2 of The Hague draft does not constitute an effective safeguard of authors' rights on the work performed, recorded, or broadcast,

Believes that the protection of performing or interpreting artists, record manufacturers, and broadcasters does not require the international recognizance of a private right of an exclusive character, such as that secured to authors, but is or can be perfectly secured by other juridical means,

Reaffirms and maintains notably its reservations regarding treaty protection being accorded to secondary utilizations, and

Believes finally, in regard to the formal provisions, that the coming into force of such a convention should be suspended pending the ratification of at least ten states and that any modification, at the time of an eventual revision should require the unanimous consent of the contracting States.

II. RESOLUTION RELATIVE TO PROLONGING THE DURATION OF AUTHOR'S RIGHTS

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Recalling the resolution adopted by its 48th Congress at Athens regarding the proposition of the Italian Government presented to the Council of

Europe and looking toward prolonging the duration of the Author's right in the international domaine,

Expresses its satisfaction that following the initiative of the Council of Europe and the diligence of the International Bureau of the Berne Union, a Committee of Experts meeting in Geneva in January, 1961 has drafted a preliminary plan of arrangement within the framework of Article Twenty of the Berne Union Convention, aiming at the adoption among interested countries of a minimum period of protection longer than the period of 50 years stipulated in the Brussels text,

Having heard the general report on the question presented to the Congress by Mr. Antonio Ciampi:

Holds the opinion that the drawing-up of the preliminary plan of arrangement constitutes an important step toward the solution desired in the legitimate interest of the creators of works of the mind, and

Puts trust in the Director of the International Bureau to collect the opinion of the Permanent Committee on the suitable procedure, with a view of attaining the desired goal as quickly as possible.

III. RESOLUTION RELATIVE TO THE QUESTION OF THE INTERNATIONAL PROTECTION OF CINEMATOGRAFIC WORKS

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Having heard the report of Mme. Lucy Willemetz on the question of the international protection of Cinematographic works as well as the report made by Association observers at the meeting of the Studies' group held at Geneva in June, 1961,

Holds that this protection should remain regulated within the Treaty bounds of the Berne Union in order to preserve the unity and homogeneity of the international protection of literary and artistic works,

Is of the opinion that, while the project undertaken has allowed the principal problems to be brought to light and certain modifications of the treaty arrangements to be envisaged, it still remains to pursue thorough studies in order to derive some practical solutions judged necessary, notably in respect to duration, moral right and country of origin, and

Judges it useful to emphasize that the insertion in the Convention of a presumption that the rights of exploitation of a cinematographic work have been assigned to the producer is likely to bear grave consequences demanding serious examination; and in effect, thinks that the safeguarding of producers' interests, and the guarantee of Authors' rights can be pursued by other means, notably by contractual channels.

IV. RESOLUTION RELATIVE TO THE NEW SCANDINAVIAN COPYRIGHT LAWS

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Having heard the report of Professor Ljungman on the new Scandinavian legislation, and having received the communication of Mr. Doehlin on the new Norwegian legislation,

Takes note of the provisions contained in these laws, and

Welcomes the adherence of Sweden to the Brussels text of the Berne Convention and the Universal Copyright Convention.

V. RESOLUTION ON THE PRELIMINARY REPORT RELATING TO THE REVISION OF THE COPYRIGHT LAW IN THE UNITED STATES

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Takes note of the contents of the communication of Dr. Arpad Bogsch on the report of the Register of Copyrights relating to the revision of the copyright law in the United States, and

States that it is disposed to proceed, henceforth, to a general study of the report with the view of expressing its observations to the Copyright Office.

VI. RESOLUTION RELATIVE TO THE APPLIED ARTS

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Having heard the report of the Professor Troller on the protection of designs and models,

States with satisfaction that the dispositions of the draft treaty on the international copyright of designs and models, reviewed at The Hague in November 1960, does not affect in any way the protection granted on the plane of the Author's right to artistic works and to works of applied art by national legislation or by bilateral treaties or by international conventions,

In view of the review at Stockholm of the Brussels text of the Berne Union Convention, decides to go on to a careful study of line 5, article 2 of said Convention before trying to work out a draft which cannot be interpreted in a restrictive sense of the rights of creators.

VII. RESOLUTION RELATIVE TO THE LOAN AND RENTAL OF BOOKS AND RECORDS

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Having become acquainted with the report of Professor Torben Lund on the legal arrangements governing the "loan and rental of books and records" in Scandinavian Countries, and the further explanations furnished on the situation in other countries, as well as projects for rules in the process of elaboration,

Recognizing the interest which this question presents, within the frame of reference of the protection of the author's right, for authors and composers as well as for producers of records and publishers;

Noting the constant development of the practice of lending and renting records and books in different countries,

Believing that the Author must always participate in profits of any nature able to result from the utilization and diffusion of his works,

Expresses the wish that the Governments of the Countries where such needs and similar practices exist, examine the legal and economic aspects of the problem they pose, in order to arrive at effective and just legislative solutions, and

Desires that, following the inclusion of such measures in several national laws on the author's right, the protection of authors can be realized on the international plane, by any suitable dispositions at the time of future revisions of existing multilateral Conventions.

VIII. RESOLUTION ON THE PRELIMINARY PLAN OF REFORM OF THE GERMAN LAW ON AUTHOR'S RIGHT

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Having heard the report of Dr. Kleine on "Certain Aspects of the Draft of Reform of the German Law on Author's Right" and the fuller observations presented in the name of the Association of German writers,

Expresses its satisfaction in seeing in this draft new dispositions introducing the *Droit de Suite* and the *Domaine Public Payant* whose principle is already established in certain national laws and which, as for the former, is written into the Berne Convention, or as for the latter, has been the object of a favorable resolution of the Conference of Revision at Brussels.

IX. RESOLUTION RELATIVE TO THE PROTECTION OF AUTHORS' RIGHTS IN THE NEWLY INDEPENDENT STATES

The A.L.A.I. meeting in Florence, September 11-16, 1961,

Expresses the hope that relations will be established with the newly independent States, which will guarantee the protection of authors' rights, national as well as foreign, both by national legislation and adherence to existing international conventions,

Welcomes the initiative taken by the intergovernmental organizations in this matter, and

Declares itself ready to participate in work undertaken in this regard and put this question down on the agenda of its next deliberations.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. UNITED STATES OF AMERICA AND TERRITORIES

64. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Design Protection. Hearings before the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, Eighty-Seventh Congress, first session, pursuant to S. Res. 55 on S. 1884, August 15, 16, and 17, 1961. Printed for the use of the Committee on the Judiciary. Washington, U.S. Govt. Print. Off., 1961. 220 pp.

See Latman, "The New Design Protection Proposals Before Congress," 8 BULL. CR. SOC. 356 (1961), and Waldheim, "The 'Anti-Maim' Rule—New Design Bill Shares Majority View Among Nations," 8 BULL. CR. SOC. 359 (1961).

65. U. S. COPYRIGHT OFFICE.

Publications of the Copyright Office. Washington, Sept. 1961. fold. sheet. (Circular 75.)

A revised circular listing the Copyright Office publications and providing information as to price, if any, and how they may be obtained.

2. FOREIGN NATIONS

66. DENMARK. *Laws, statutes, etc.*

Loi relative au droit d'auteur sur les oeuvres littéraires et artistiques, no. 158, du 31 mai 1961. (74 *Le Droit d'Auteur* 295-301, no. 11, Nov. 1961.)

The official French translation of the new Danish Law on Copyright in Literary and Artistic Works which became effective on October 1, 1961.

67. DENMARK. *Laws, statutes, etc.*

Loi sur le droit d'images photographiques, no. 157, du 31 mai 1961. (74 *Le Droit d'Auteur* 293-295, no. 11, Nov. 1961.)

An official French translation of the new Danish Law on Rights in Photographic Pictures which became effective on October 1, 1961.

68. PERU. *Laws, statutes, etc.*

Ley de derechos de autor. Ley no. 13714. (*El Peruano* 2-4, no. 6159, Nov. 3, 1961.)

Law No. 13714, a new basic law for the protection of copyrights, was passed by the Peruvian Congress on September 1, 1961, and promulgated by President Prado on October 31, 1961.

According to a dispatch from the American Embassy, Lima, all works in the literary, artistic and scientific field are protected, whatever the form or mode of expression used; foreign authors domiciled in Peru are accorded the same protection as Peruvian authors, and foreign authors not domiciled in Peru are covered by bilateral or international conventions to which Peru is a party (Peru is a member of the Buenos Aires Convention), or by reciprocal treatment under the new law if no conventions exist. Duration is for the author's lifetime; and for his heirs or legatees, 50 years more, except for certain classes of works such as motion pictures and photographs for which shorter terms are provided.

Provision is made for a National Copyright Registry. Failure to register does not deprive the author of his rights except as reserved by the law. This represents a substantial change from the previous law and regulations which made copyright contingent on registration.

69. SWEDEN. *Laws, statutes, etc.*

Loi du 30 décembre 1960 relative au droit sur les images photographiques. (*Revue Internationale du Droit d'Auteur* 144-148, no. 32, July 1961.)

An official French translation of the Swedish Law on Rights in Photographic Pictures which became effective on July 1, 1961.

70. SWEDEN. *Laws, statutes, etc.*

Loi suédoise sur le droit d'auteur. Swedish Copyright Act, 1960. [Stockholm] Svenska föreningen för upphovsrätt [1961]. 37, 37 p.

Opposite pages numbered in duplicate.

A booklet, issued by the Swedish Copyright Society, containing the Swedish text, with the official French and English translations in parallel columns, of the new Swedish legislation on copyright and on rights in photographic pictures, which became effective on July 1, 1961.

71. SWEDEN. *Laws, statutes, etc.*

Loi du 30 décembre 1960 relative au droit d'auteur sur les oeuvres littéraires et artistiques. (*Revue Internationale du Droit d'Auteur* 130-143, no. 32, July 1961.)

An official French translation of the Swedish Law on Copyright in Literary and Artistic Works which became effective on July 1, 1961.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS72. Diplomatic Conference on Neighboring Rights, *Rome, 1961.*

International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organisations. [Rome, Oct. 26, 1961.] 13 p.

The English text of the new convention on neighboring rights adopted by the Conference held in Rome from October 10 to 26, 1961. See also 9 BULL. CR. SOC. 65, item 6 (October 1961).

73. International Copyright Union. *Permanent Committee. 10th Session, Madrid, 1961.*

[Actes de la] Dixième session du Comité permanent de l'Union internationale pour la protection des oeuvres littéraires et artistiques (Union de Berne) et Sixième session du Comité intergouvernemental du droit d'auteur (Unesco), Madrid, 25-30 septembre 1961. (74 *Le Droit d'Auteur* 318-339, no. 11, Nov. 1961.)

Records of the 10th session of the Permanent Committee of the Berne Copyright Union and the 6th session of the Intergovernmental Copyright Committee at Madrid, September 25-30, 1961, including the reports and resolutions in French and English. A report of this joint session will appear in our February 1962 issue.

PART IV.

JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY

A. DECISIONS OF U.S. COURTS

1. Federal Court Decisions

74. *Famous Music Corporation v. Seeco Records, Inc.*, Civ. 137-54 (S.D. N.Y. Nov. 22, 1961) (Levet, J.) (*not yet reported*).

Action for accounting and damages for use of plaintiffs' copyrighted songs on phonograph records manufactured by defendant in the United States and on master tapes sent by defendant to record manufacturers abroad. Defendant was using plaintiffs' songs pursuant to the compulsory license provisions of the copyright law. It made monthly reports to plaintiffs pursuant to demand, and tendered royalty payments on the number of records actually *sold* in the month prior to each report rather than on the number of records *manufactured*. Defendant further contended that it was not liable for royalties on records manufactured by others outside the United States from its master tapes.¹

Held: for plaintiffs.

1. Plaintiffs were entitled to an accounting from defendant of all records *manufactured* and to payment of a royalty of two cents for each of said records, and in addition three times the amount thereof, the amount of royalties to be determined in the final decree after a special master's report.

2. The defendant is also liable as a joint tort-feasor for royalties derived from his sending of tapes abroad for the purpose of being manufactured into records there, the amount of royalties to be determined by a special master.

3. Plaintiffs were also entitled to costs and counsel fees to be determined by the master.

In his opinion, Judge Levet made these important observations with regard to the two principal points involved. Regarding liability for *manufactured* rather than *sold* records, the Court said: "In regard to the records which were the subject of periodic royalty reports, the number of records manufactured is the royalty criterion." With regard to defendant's liability

1. Defendant also raised the defense of accord and satisfaction, which was rejected by the Court. That portion of the Court's decision is not digested here.

for producing tapes to be used in the manufacturing of records in foreign countries, it was said:

"The preparation of the tapes (which are sent to persons abroad to be used by said persons to manufacture phonograph records), which contain renditions of plaintiffs' compositions, is a violation of Section 101(e).

"The act of the defendant in producing the tapes of plaintiffs' compositions in the United States clearly involves defendant as a joint tort-feasor in 'manufacture.' *Reeve Music Co. v. Crest Records, Inc.*, D.C. E.D. N.Y., 1959, 190 F. Supp. 272, *aff'd* 2 Cir., 1960, 285 F. 2d 546. As Judge Abruzzo stated in the district court decision in *Reeve*:

'The Court of Appeals for the Second Circuit has held on numerous occasions that the infringement of a copyright is a tort and all persons concerned therein are jointly and severally liable. See *Cross v. Van Dyk Gravure Co.*, 230 F. 412; *American Code Co. v. Bensinger*, 282 F. 829; and *Ted Browne Music Co. v. Fowler*, 290 F. 751.

'The Court of Appeals for the First Circuit in *Sammons v. Colonial Press*, 126 F. 2d 341, citing *Gross v. Van Dyk Gravure Co.*, *supra*, with approval, also holds that on familiar principles of tort liability all persons who unite in the infringement of a copyright are jointly and severally liable for the damages resulting therefrom.

'None of these four cases last cited involved the mechanical recording of a song, but the legal principle expounded is applicable to the case at bar in that they all involve copyright infringements. (p. 276).'

"It is plain that the act of defendant here was a part of the manufacture. In the *Reeve* case, *supra*, in the court below, Judge Abruzzo pointed out:

'A leading case on copyright infringement is *Belford, Clarke & Co. v. Scribner*, 144 U.S. 488, 12 S.Ct. 734, 36 L. Ed. 514. Although this case involves the printing of books and not the manufacturing of phonograph records, it holds (at page 507, 12 S.Ct. 734) that both the printer and publisher of the books are liable to the owner of a copyright for an infringement in that the printers were sharers in the profits realized from the sale of the books and were *participes criminis* with the publisher in the infringement. (p. 276).'

"When the *Reeve* case, *supra*, came to the appeals court, Judge Swan, after referring to *G. Ricordi & Co. v. Columbia Gramophone Co.*, D.C. S.D. N.Y., 1920, 270 Fed. 822, 826, wrote:

* * * This is not a holding, as the defendants seem to believe, that all the first eight steps must be taken to constitute a defendant a manufacturer. * * *

"Under § 101(e), on the other hand, "manufacture" is an act of infringement, and "courts have long recognized that infringement of a copyright is a tort, and all persons concerned therein are jointly and severally liable as such joint tort-feasors." *Ted Browne Music Co. v. Fowler*, 2 Cir., 290 F. 751, 754. We think it plain that here, whether or not the separate act performed by each defendant constitutes "manufacture," the two defendants, acting in concert, "manufactured" the infringing discs. (p. 548)."

"A holding in *Capitol Records v. Mercury Records Corporation*, 2 Cir., 1955, 221 F. 2d 657, that a copyright has no extra-territorial effect, does not solve this problem of manufacture since plaintiffs seek to hold defendant for what it did *here* rather than what it did abroad.

"Accordingly, this court holds that the act of defendant in preparing the tape was a part of the manufacture and, consequently, an infringement for which it should respond under Section 101(e)."

Concerning the award of treble damages, the Court said:

"In regard to the records which were the subject of periodic royalty reports, or should have been included in such reports, the damages to be awarded pursuant to Section 1(e) shall be three times the amount found to be due as a royalty. In awarding such damages, the court has considered the intent and acts of the defendant in failing to make payment and its wilful disregard of the Copyright Act. *Leo Feist, Inc. v. American Music Roll Co.*, D.C. E.D. Pa., 253 Fed. 860; *Edward B. Marks Music Corporation v. Foulton*, 2 Cir., 1949, 171 F. 2d 905; *ABC Music Corp. v. Janov*, D.C. S.D. Cal., 1960, 186 F. Supp. 443; Title 17 USC § 1(e)."

75. *Doran v. Sunset House Distributing Corp.*, 197 F. Supp. 940, 131 U.S.P.Q. 94 (S.D. Cal., Sept. 20, 1961) (Byrne, J.).

Action for copyright infringement and unfair competition. Plaintiffs had registered a claim to copyright in a Santa Claus composed of several plastic bags designed to be stuffed with crumpled newspaper and assembled, thus forming a life-size three-dimensional figure. Defendants manufactured and distributed a similar figure concededly "inspired" by plaintiff's product. They were charged with also using advertising similar to plaintiffs' and with infringing plaintiffs' trademark and trade name in a printed instruction sheet enclosed with defendants' Santa Claus.

Held: for plaintiffs; defendants being guilty of copyright infringement and unfair competition, plaintiffs entitled to injunction and statutory damages and counsel fees.

I. 1. With regard to copyright infringement, the defendants contended that plaintiffs' copyright was invalid for three reasons: 1. It was argued that since Santa Claus was in the public domain, this legendary figure could not be the subject of a valid copyright. In ruling against defendants on this point, the court pointed out that, unlike the subject matter of a patent, copyrighted material need not be new but only original, *Stein v. Mazer*, 204 F.2d 472, 97 U.S.P.Q. 310 (4th Cir. 1953), *aff'd* 347 U.S. 201, 100 U.S.P.Q. 325 (1954), and that originality in the realm of copyright refers to the form of the expression and not to the novelty of the subject matter, *Chamberlin v. Uris Sales Corp.*, 150 F.2d 512, 65 U.S.P.Q. 544 (2d Cir. 1945), and that copyright protects only the expression of the idea, not the idea itself, *Mazer v. Stein*, 347 U.S. 201, 100 U.S.P.Q. 325 (1954); *Kalem Co. v. Harper Bros.*, 222 U.S. 55 (1911). It was held that there was sufficient originality in plaintiffs' "form of expression", the three-dimensional plastic figure, to support copyright although an "idea" in the public domain was therein embodied. Citing *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 90 U.S.P.Q. 153 (2d Cir. 1951), the Court said:

"(T)he requirements for the 'originality' necessary to support a copyright are modest. The author must have created the work by his own skill, labor and judgment, contributing something 'recognizably his own' to prior treatments of the same subject. However, neither great novelty nor superior artistic quality is required."

2. Defendants further argued that the copyright was invalid because the life-size plastic bags could be worn and thus constituted a garment, and that the utilitarian aspects of this item precluded copyrightability. This argument was rejected on the facts, plaintiffs' figure being found to be intended and advertised as a lawn ornament, an artistic figure or item of decoration. The Court went on to say, however, that even if the product could be worn, such utilitarian feature would not necessarily invalidate the copyright since *Mazer v. Stein*, 347 U.S. 201, had put to rest all previous doubts on the subject by holding that "the intended use or use in industry of an article eligible for copyright" does not bar or invalidate registration.

3. Another attack on the validity of plaintiffs' copyright was premised on the fact that plaintiffs changed their trademark and trade name from "Plastic Personalities" to "Plasti-Personalities" after the claim to copyright

was registered. Defendants alleged current publication of copies of plaintiffs' Santa Claus with the old trade name in the notice, alleging that this was a failure to comply with the requirements of Section 19 that the name of the copyright proprietor be stated. However, after noting that a trademark or a trade name may be, under certain conditions, a sufficient designation of the proprietor in a copyright notice, *Scarves by Vera, Inc. v. United Merchants*, 173 F. Supp. 625, 121 U.S.P.Q. 578 (S.D. N.Y. 1959) (trademark); *Werckmeister v. Springer Lithographing Co.*, 63 F. 808 (S.D. N.Y. 1894) (trade name), the court held that even if it were true that plaintiffs' old trademark/trade name were being used in the notice, "such designation would still be sufficient notice of plaintiffs' copyright." Said the Court:

"The purpose of the notice requirement in Section 19 is to advise the public of the copyright proprietor's claim and to prevent innocent persons, unaware of the claim, from incurring infringement penalties."

The Court called the dropping of a "c" and the addition of a hyphen "at most insubstantial variations which would not mislead innocent persons." Quoting *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276, 23 U.S.P.Q. 295 (2d Cir. 1934), the Court further said:

"(T)he name of the copyright proprietor is sufficient in form, if it gives notice of copyright to one who is looking for the truth and desires to avoid infringement."

4. Finally, the defendants argued that plaintiffs' copyright notice was ineffective because it was placed on the hood of the figure only and not on the other two components. Distinguishing from the instant case such cases as *Scarves by Vera, Inc. v. United Merchants*, 173 F.Supp. 625, and *Trifari, Krussman & Fishel, Inc. v. B. Steinberg-Kaslo, Inc.*, 144 F. Supp. 577 (S.D. N.Y. 1956), the Court said:

"No other conclusion was possible in these cases because hangtags, not being part of the article, may be easily removed or lost, and 17 U.S.C.A. Sec. 19 requires that the copyright notice appear on some portion of the article itself."

The Court held that plaintiffs had literally complied with the statute by placing the notice on an "accessible portion" of their figure, and that placing the notice on one component was sufficient, since all three parts "are sold as a unit and indeed cannot be used separately . . .".

II. In considering the claim of unfair competition, of which the Court assumed pendent jurisdiction under 28 U.S.C. 1338-b, Judge Byrne

applied the California Civil Code, Section 3365, which defines unfair competition as "any unfair or fraudulent business practice." Defendants were held clearly guilty of unfair competition as well as copyright infringement, not only in deliberately copying plaintiffs' Santa Claus, but in copying their advertising and infringing their trademark and trade name. Moreover, there was ample justification in the Court's opinion for the exercise of the Court's discretion to award reasonable attorneys' fees to plaintiffs, in addition to statutory damages of \$1.00 per infringing copy (as a work of art not a painting, sculpture or statue). Defendants were not only enjoined from continuing the infringement but required to surrender for destruction all infringing copies remaining in their possession together with the means of "making the same".

76. *Industrial Sewing Machine & Supply Corp. v. Hoffman*, 131 U.S.P.Q. 162 (N.D. Ga. Oct. 3, 1961) (Morgan, J.).

Action for copyright infringement; motion by plaintiff to join as party defendant the printer which had printed the infringing catalog.

Held: motion granted.

Plaintiff contended that since the printer prepared the copyrighted catalog which was alleged to have been infringed, it was subject to liability as a tort-feasor. The defendant's argument that it should be excused because it was "an innocent printer" was summarily rejected by the Court on the ground that the cases would not support defendant's contention, citing *Sammons v. Larkin*, 38 F. Supp. 649, 49 U.S.P.Q. 350.

77. *Morris v. Wilson, et al.*, 189 F. Supp. 565, 128 U.S.P.Q. 419 (S.D. N.Y. 1960), affirmed *per curiam*, 131 U.S.P.Q. 130 (2d Cir. 1961). See 8 BULL. CR. SOC. 265, item 217 (April 1961), for brief mention.

2. State Court Decisions

78. *Miller v. Universal Pictures Company*, 132 U.S.P.Q. 77 (N.Y. Ct. App. Dec. 5, 1961), affirming 11 App. Div. 2d 47, 201 N.Y.S.2d 632 (1st Dept. 1960), 7 BULL. CR. SOC. 294, item 395 (1960).

Our readers will recall that in this interesting and much discussed litigation, the trial court had held that the widow of the late Glenn Miller, who had granted RCA the exclusive right to use Miller's name and likeness in producing and selling phonograph records, could enjoin Universal Pictures Company and its parent, Decca Records, from issuing an album of the sound track of "The Glenn Miller Story" and from advertising such records as "exact duplications of some of the most famous Glenn

Miller hits," etc. The trial judge's decision was based not so much on concepts of a property right in the Glenn Miller sound, but on the basis of violation of an implied negative contractual covenant with regard to Universal not to exercise its motion picture production rights so as to impair the earlier recording contract between Mrs. Miller and RCA, of which both Universal and Decca had knowledge. *Miller v. Universal Pictures Co., Inc.*, 121 U.S.P.Q. 475 (S.Ct. N.Y., 1959); see also 6 BULL. CR. SOC. 305, item 349 (1959). On appeal, the Appellate Division, in a *per curiam* decision, cited above, reversed and ordered a new trial on the ground that there had been no "misappropriation" on the part of Universal-Decca since they had actually made their own recordings, that Mrs. Miller had no "property interest" in the Glenn Miller sound, and that no implied negative covenant could be found.

On further appeal, here reported, the Court of Appeals affirmed the Appellate Division in a four-to-three decision without majority opinion. However, Judge Burke, speaking for Judges Fuld and Froessel as well, wrote a thoroughly considered dissenting opinion, raising fundamental issues and problems of unfair competition of such importance that our Editorial Board deems it to be in the interest of our members to publish it here in entirety:

BURKE, J. (dissenting):

The majority would affirm a decision of the Appellate Division reversing Special Term and dismissing a complaint on the ground that where a licensor does not have "property" rights in an intellectual product, so far as the Copyright Act and the general rules of common law are concerned, he must show that the licensee expressly covenanted that it would not use the granted rights in media other than that in which rights are granted. In other words, from now on the scope of a grant in a license contract depends not on the parties' intention which is reflected by the bargain they made, but only on status.

No other reported decision reaching such a result can be found. The decision represents an abrupt departure from the established concepts governing the existence and nature of literary and artistic rights. In New York and California, which are centers of the American artistic world, ideas, even though common or open to public knowledge, are protected if there is a contract between the parties prior to disclosure of the idea, 23 A. L. R. 2d § 24, and cases cited therein.

Heretofore once an idea became the subject-matter of a contract, the contract forever precluded licensees from the right enjoyed by all others to the use of the idea, wherever obtained, whether from the public domain

or independent creation, without complying with the obligations of the contract (*High v. Trade Union Courier Pub. Co.*, 69 N.Y.S. 526, *affd.* 275 App. Div. 803; *Gellert v. Dick*, 277 N.Y. 123; *Chandler v. Roach*, 156 Cal. App. 2nd 435).

The duty of a licensee not to exceed the express limits of its grant is no less a part of the consideration flowing to the licensor than its duty to pay the stipulated royalties. The obligation not to exceed the scope of the grant cannot be avoided any more readily than the obligation to pay royalties. The enforcement of both obligations is based on contract, not property. "By entering into the contract and accepting and retaining the consideration therefor, the respondents assumed a fiduciary relationship which had its origin in contract, and which imposed upon them the duty of utmost good faith. *Kirke LaShelle Co. v. Armstrong Co.*, 263 N.Y. 78, 95.

The question, therefore, is not whether plaintiff had a legally recognized property right or particular "status" but whether a breach of fiduciary duty has occurred which has its origin in contract for which the licensee must be held. We think there was such a breach of contract.

The action arises from the release and sale by Decca Records, under a grant from Universal Pictures, which *Decca controls*, of phonograph records embodying most of the musical portion of the sound track of Universal's motion picture, "The Glenn Miller Story". Decca Records *paid nothing to Universal Pictures or plaintiff for this right, sold the records in competition with records on which plaintiff was receiving royalties, and has received substantial profits from the recordings.*

In Decca's publicity attending the exploitation of the records, the Miller name and reputation, and the unique quality of the Miller music were emphasized. Thus, on the reverse side of the cover of the "sleeve" captioned "The Glenn Miller Story", in which the Decca record was sold, we find: "Although few bands achieve it, every band wants to have a sound all its own. Glenn Miller got the organization, trained the men, scored the arrangements, and finally made a band that had a sound like no other, a rich, golden sound, a sound like . . . Glenn Miller." "These recordings preserve the Glenn Miller character. Those who were old enough to remember it will cherish this re-animation; those who have never heard that amazing leader will thrill to a great and exciting sound,—sound which no band has ever surpassed".

It is plaintiff's contention that defendant's sale of records made from the sound track is a breach of the contract which she had with Universal

authorizing the making of the sound picture "The Glenn Miller Story", based on the life and musical success of her husband.

Plaintiff is, as defendants knew, the recipient of royalties from the sale of R.C.A. records of Glenn Miller, and claims her royalties have been reduced by the competing sale of records made from the sound track from "The Glenn Miller Story".

Defendants assert "that Universal could have made the musical sound track and used it to make records *without any contract with or leave from plaintiff*" and "as Universal was free to make the musical portion of the sound track and any recordings therefrom without any license from plaintiff, it could be placed under restraint in the use of its musical sound track only by a contractual undertaking, clearly expressed, that it would not make some particular use of the sound track".

The contention is based on a faulty analogy with cases such as *Chaplin v. Amador*, 93 Cal. App. 358; and *Supreme Records v. Decca Records*, 90 F. Supp. 904, where the litigants were not parties to a contract which covered the subject matter of the lawsuit.

These cases establish what no one disputes but they do not hold that a licensee who has bargained for the use of arrangements, compositions and orchestrations in connection with music to be made part of a sound track in the preparation and production of a sound picture, and used them, can breach its agreement in subsequent dealings with the sound track. The holding of the Appellate Division that the sole consideration is whether plaintiff had any legally recognized "property interest" in the Miller material and performances resulted, it seems to us, from a failure to differentiate this case concerning a musical sound track made pursuant to a contract authorizing the making of a sound picture, and the cases which have held that *strangers* are privileged to make imitations where the copyists have used independent performances rather than "dubbing" or mechanical devices (*Supreme Records, Inc. v. Decca Records*, 90 F. Supp. 904; *Chaplin v. Amador*, 93 Cal. App. 358).

Since sound tracks are an integral part of "photoplays" (*Jerome v. Twentieth Century Fox Film*, 67 F. Supp. 735, 741), defendants, in order to sustain their theory that Universal's right to use the musical sound track was not dependent on any grant from plaintiff, but rather an exercise of the rights of independent imitators, were required to show either that the musical portion of the sound was made before the agreement was entered into, or that Universal did not contract at all in respect to such musical portion of the sound track. They have failed. The musical portion of the sound track was made after Universal signed the agreement, made expressly for the picture and would never have been made had there been

no picture. The agreement, as well as the declarations of Universal, prove that Universal contracted not only generally for authorization to make a sound track for "The Glenn Miller Story", but in particular the musical portion of the sound track.

In not one of the cases relied on by the Appellate Division and respondents was there an agreement in writing dealing with specific obligations. Absent an agreement, anyone could independently create a musical sound track and use it free of any claims of plaintiff. But the defendants may not do so. Universal gave up that right by the contract.

The fundamental law is that where there is an agreement in writing the parties to the contract must remain faithful to its terms whether or not the disclosure is novel or original. *Chandler v. Roach*, 156 Cal. App. Div. 2d 435 is expositive of the rationale upon which this proposition rests:

"Even though the idea disclosed may be 'widely known and generally understood' * * *, it may be protected by an express contract providing that it will be paid for, regardless of its lack of originality.

"We believe that if a producer obligates himself to pay for the disclosures of an idea, whether it is for protectible or unprotectible material, in return for a disclosure thereof, he should be compelled to hold to his promise. There is nothing unreasonable in the assumption that a producer would obligate himself to pay for the disclosure of an idea which he *otherwise would be legally free to use, but which in fact he would be unable to use but for the disclosure.* * * *

"The test for a property right, applied in common-law copyright cases, is that the work be new, novel and concrete in form. * * *

"Not only is this property right test not a part of any traditional contract action, but there is no reason for applying such a test in this particular type of contract action. The *reason* for the requirement in common law copyright was that to have a remedy good against the world, a property right must be shown. *This reason for the test is missing in an action on contract.*" (Emphasis added.)

In this matter Universal obligated itself to pay for the disclosure of the Miller ideas of "composition", "arrangement" or "adaptation" of the scores which were to be played as part of the sound track and which it might otherwise be legally free to try to imitate, but which *in fact* it would be unable to use in this motion picture but for the agreement. Under the agreement, Universal could not make the sound track or any portion of it, a part of the picture without consent of plaintiff, as the picture could be made only from a scenario approved in writing by the plaintiff.

It is clear that Universal sought: "All of Glenn Miller's compositions, arrangements and orchestrations now owned by you as well as the

right to use or simulate the style manner and manner of playing of Glenn Miller and/or his orchestra". In this clause, the parties expressly and specifically agreed upon the media in which Universal was given permission to exercise said "right", i.e. "for use in the preparation and production of said photoplay or photoplays and productions." The very contracting for the right to make such use establishes the intent at the time the contract was drawn as to the purpose of the grant sought and the permissible use of the sound track.

The claim, moreover, that Universal did in fact, as it had agreed to, make use of the arrangements and orchestrations furnished by the plaintiff in simulating the style and manner of playing Glenn Miller music in the preparation and production of the sound picture, is supported by substantial evidence. Thus, in the "Property Promotion Exploitation Kit", which it widely distributed, Universal announced: "Because the musical sequences of the Glenn Miller Story are being recorded in the new stereophonic sound technique, Producer Aaron Rosenberg and Director Anthony Mann found it necessary to discard the actual use of original Miller performances available on Victor (R.C.A.) recordings, Chesterfield radio programs and tapings of Miller's shows during military service both in the [United States] and abroad. Indeed, Universal-International *has managed to acquire all of the original manuscripts in Miller's library*, and copyists have even traced, note for note, the ad lib solos in these tunes which are being re-recorded verbatim for the film sound track" and Universal also advertised that Gershenson recorded the Miller numbers "using verbatim the original arrangements written by Miller" (emphasis added). Universal's announcements show that the use of "stereophonic sound technique"—a discovery which outmoded prior recordings—made it necessary to "discard" Glenn Miller's original recordings for R. C. A., and that Universal used the material it had "managed to acquire" from plaintiff, instead, in making the sound-track.

Universal says it has not bargained in regard to the musical portion of the sound track, but the contract and its other conduct shows that it has. The contracting for the delivery of "all of Glenn Miller's compositions, arrangements and orchestrations now owned by you . . ." as well as the right to use or simulate the style manner and manner of playing of Glenn Miller and/or his orchestra, is persuasive in plaintiff's favor on that question. The importance of the evidence of intent to bargain in connection with the musical part of the sound track, which lies in the declaration made by Universal that "Gershenson recorded the Miller numbers using verbatim the original arrangements written by Miller", cannot be disputed. Moreover, Universal acknowledged its obligations

and the existence of conditions when in 1953 it sought to justify the license to Decca under its "advertising rights".

If Universal did not need the name, arrangements or "right to use or simulate the style . . . of Glenn Miller" to make the musical portions of the sound track, it should have refrained from insisting on their delivery. Defendants are now in no position to challenge the need for the grant or repudiate the dependent conditions and obligations assumed (*International News v. Associated Press*, 248 U. S. 215, 240; *Outcault v. Bonheur*, 120 App. Div. 168).

Since contracts can create rights not otherwise recognized, the resolution of the rights of the parties to this contract, as we have said, did not depend upon property, but upon contract and the relationship of trust and confidence created thereby. Here the authorization to make the sound track was created by contract. Therefore, the right to use the musical portion of the sound track, or any part thereof, is necessarily dependent upon the scope of the contract and the manifest intent of the parties.

Once the contract with Universal is properly construed, the manner of imitation and the medium of copying are distinctions without difference. The use of a copying orchestra rather than electronic dubbing cannot save the defendants because the contract with Universal encompassed the use of a copying orchestra in the making of the musical portion of the sound track. Otherwise, Universal would not have sought to acquire the "compositions, arrangements and orchestrations" owned by plaintiff and "the right to use or simulate the style . . . of Glenn Miller." The plaintiff's right to prevent unauthorized use of the subject matter of her limited grant is totally unaffected by the particular method by which the musical portion of the sound-track was created.

The distinction that the duplications of the Miller performance were achieved by a "studio orchestra" contemplated by the contract and employed by defendants creates a privilege based on imitating, must be rejected when part of the means employed by defendant was original, unpublished matter which Universal sought and secured by virtue of the contract by which plaintiff licensed the defendant to make the motion picture.

The lengthy, carefully prepared contract, being most specific in detailing permissible media—photoplay, radio, television, newspapers, fan magazines, trade periodicals, novelizations, serializations, booklets, programs, posters, lobby displays and "all other media of advertising and publicity, including, but not limited to, commercial tie-ups" the grant is, by its terms, limited to specific media. It was only by accepting these limitations that Universal was able to obtain the valuable license to make

the sound picture. By accepting the contract as written, Universal accepted the obligations imposed by equity on a licensee not to exceed its grants and to refrain from using any of the contract rights in competition with the licensor. *Manners v. Morosco*, 252 U. S. 317, 325-326; *Harper Bros. v. Klaw*, 232 Fed. 609, 612; *Klein v. Beach*, 239 F. 109; *Ettore v. Philco Tel. Broadcasting Co.*, 229 F. 2d 481, 487, cert. den. 351 U. S. 926; *Herne v. Leibler*, 73 App. Div. 194, 200.

In all these cases the question decided was whether the words of the contracts embraced the additional media. None of them turned on the status of the licensor.

As this Court held in *Kirke La Shelle Corp. v. Armstrong Co.*, 263 N.Y. 79, 87, in following the *Manners* and *Harper Bros.* decisions, *supra*, "Respondents seek to distinguish those cases on the ground that the courts were not construing a contract, but dealing with a question of whether one without authority could appropriate an essential part of copyright. Those cases were decided not on copyright law but on the law of contracts". The principles applied in the *Manners* and *Harper Bros.* decisions, *supra*, were held by this Court to be in the last analysis, an application "of the principle that in every contract there is an implied covenant that neither party shall do anything which will have the effect of destroying or injuring the right of the other party to receive the fruits of the contract, which means that in every contract there exists an implied covenant of good faith and fair dealing."

It was manifest to all at the time of the contract that the plaintiff would be substantially benefited by reason of the contract in the way of increased income from royalties on the increased sale of the Miller R.C.A. records which would follow the release of "The Glenn Miller Story" and the renewal of interest in the Glenn Miller style of music which would be engendered by its exhibition. While the limitation of the grant was respected, that expectation was being fully fulfilled until interrupted by defendants' poaching. One can hardly imagine a more palpable intermeddling with the fruits of a contract.

Defendants admit, and it is apparent, that "Decca's primary interest in releasing the records . . . was to make a profit". Such a use by defendants exceeded the limits of the grant which restricted the use of the sound track to the photoplay, the television, radio, and the promotion of the motion picture. *The enforcement of the obligation not to exceed the scope of the grant is based on contract because the use of the sound track from the picture by defendants diverted profits which defendant knew would accrue and were accruing to plaintiff's interests in the phonograph record business and constituted a breach of Universal's obligation as a party to the contract to conduct itself faithfully.* (See *Margolis v.*

National Bella Hess Co. Inc., 138 Misc. 738, affd. 235 App. Div. 839; *Montegut v. Hickson, Inc.*, 178 App. Div. 94.)

In this case, relief does not depend necessarily upon the implication by the Court of a "negative covenant" on the part of the licensee. As respondent notes, "the specificity of the licensed use is the limit of permissible uses and implies prohibition of non-licensed uses." The *Manners* case holds that where the grant is by its terms limited to specific media equity will grant relief as against the licensee who exceeds the limits of the grant. The omission of an express negative covenant from the contract cannot be interpreted as an implied recognition of Universal's right to use the sound track for phonograph recordings. It was unnecessary to express such a prohibition since the contract shows that the only uses of the sound track contemplated were motion pictures, radio and television; and both parties knew of plaintiff's exclusive contract with R.C.A. for the licensing of records.

It is plain that plaintiff, as the exclusive licensor of the original Glenn Miller Orchestra recordings, has sufficient interest to halt the use of the sound track for recordings by Universal and its parent, Decca, where such use constitutes a breach of contractual duty owed to the plaintiff. An unauthorized interference with the licensor's exclusive right to profit from a licensing agreement to make recordings is actionable apart from the rights of the licensee (*Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 780, affd. 279 App. Div. 632; *Capital Records v. Mercury Records Corp.*, 221 F. 2d 657 (2 Cir.)).

The respondents' contention that plaintiff has no right to sue because R. C. A. has the exclusive license to make phonograph recordings of performances of Glenn Miller and his orchestra is untenable. The holding in the *Metropolitan Opera* case, *supra*, that Metropolitan, which had sold the broadcasting rights and the right to make and sell phonograph records, had, apart from legally recognized property rights, or contract rights, standing to sue is applicable here. (See also *Giesecking v. Urania Records*, 155 N.Y.S. 2d 171; *Pittsburgh Athletic Co. v. KQV Broadcasting Co.*, 24 F. Supp. 490.)

As the decisions make plain, the plaintiff's standing to sue and recover is not to be determined by an inquiry as to whether plaintiff possessed a legally recognized property right, but whether plaintiff had rights which defendants interfered with by a scheme which violated the contract defendant Universal made with plaintiff.

The fact that the resulting unauthorized competition effectively diverted profits away from the plaintiff which should have gone to the plaintiff is enough. Protection of the Miller recordings as between plaintiff and Universal is not limited to protection against reproduction by purely

mechanical means. The courts obviously do not intervene only on the ground of mechanical reproduction. Mechanical reproduction may not be involved at all (e.g. *Fisher v. Star Co.*, 231 N.Y. 414; *Dior v. Milton*, 9 Misc. 2d 425).

Since the unauthorized use of the musical part of the sound track tends to saturate the market in which plaintiff has a substantial pecuniary interest, and thus diminishes and possibly destroys the value of plaintiff's stake in the record field by means of a violation of the contract Universal agreed to, the plaintiff is entitled to a perpetual injunction and an accounting.

Accordingly the judgment of Special Term should be reinstated.

79. *Festival Films, Inc. v. Robert Youngson Productions, Inc. and Twentieth Century-Fox Film Corporation*, New York Law Journal, Nov. 24, 1961, p. 11, col. 1 (Sup. Ct., N.Y. Co.) (Markowitz, J.).

Motion for temporary injunction pending trial to restrain defendants, inter alia, from reproducing prints of two Charles Chaplin silent movies, "The Cure" and "The Adventurer", and from dealing with, advertising or exhibiting allegedly "duped" prints. The films were produced between 1910 and 1920 and copyright, not having been renewed, had expired. Plaintiffs alleged that the defendants, Youngson, had produced a film entitled "Days of Thrills and Laughter", in which portions of "The Cure" and "The Adventurer" were incorporated; that they licensed defendant, Twentieth Century-Fox, to distribute and exhibit the said film, and that the latter was presently exhibiting the film. Plaintiffs based their claim to relief on physical ownership of the legitimate prints and alleged that defendants could not have obtained the prints they were using except by "purloining or surreptitiously obtaining" prints belonging to plaintiff or its predecessors in title and duplicating them. According to the complaint, "no authentic negatives and positive prints of said Chaplin comics have been lawfully in any ownership or possession other than that of plaintiff and its predecessors in title."

Held: motion denied.

Referring to the fact that plaintiff did not claim knowledge "as to what occurred between the original production of the two films and 1941 when . . . it acquired the rights on which it bases this action", the Court said: ". . . for aught it (plaintiff) knows, the negatives and/or positives of the films may have been sold or otherwise disposed of by one or more of the successive owners thereof in the period of more than twenty years prior to 1941." Consequently, "It is unnecessary to decide whether, regardless of the expiration of the copyrights, plaintiff may enjoin the

use by defendants of a film obtained illegally or improperly through copying plaintiff's negatives or positives which plaintiff claims it had stored away for future use (see *Montegut v. Nickson*, 178 App. Div. 94, but see *G. Ricordi & Co. v. Haendler*, 194 F. 2d 914). *This is so because a serious factual question is presented as to whether the Chaplin portions of the film produced and exhibited by defendants were, in fact, obtained through copying negatives or positives belonging to plaintiff or a predecessor in plaintiff's title. Plaintiff does not claim knowledge as to what occurred between the original production of the two films and 1941 when its parent and it acquired the rights upon which it bases this action. For aught that it knows, the negatives and/or positives of the films may have been sold or otherwise disposed of by one or more of the successive owners thereof in the period of more than twenty years prior to 1941.*"

"Since plaintiff has failed to establish by evidence, as distinguished from naked assertions and conclusions, that the film produced and exhibited by defendants was the result, as to the scenes from the two Chaplin films, of copying negatives or positives owned by plaintiff, it is clear that plaintiff is not entitled to the drastic remedy of an injunction prior to trial. *It is not without significance, as bearing on plaintiff's right to preliminary relief, that although it threatened to sue for an injunction as early as April 20, 1961, it waited until the middle of October, six months later, to apply for that relief and subsequently obtained an adjournment for an additional period.* Plaintiff is in no position, in the light of the foregoing, to urge successfully that it will suffer irreparable damage if it must await the trial to obtain injunctive relief.

It is well to mention, in connection with plaintiff's claim of unfair competition, that the names of the two films are not mentioned in the advertising and promotional material put out by defendant, Twentieth Century."

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

80. BURTON, ROBERT J. Copyright and the creative arts. (Lang, Paul Henry, ed. *One hundred years of music in America*. New York, Schirmer, 1961. 282-301 pp.)

The objective of this article "will be to sketch briefly the historical background of the development of the law protecting intellectual property and to focus some attention on the sad fact that in the sixth decade of the 20th-century composers of music are still living under a system of law which, with but a few exceptions, is identical with that which existed almost 150 years ago and which has undergone almost no revision at all since 1909."

81. PUBLISHERS ON PUBLISHING. Selected and edited with commentary and introduction by Gerald Gross. Preface by Frederic G. Melcher. R. R. Bowker Company and Grosset & Dunlap, New York 1961. 490 pp.

This recent book certainly deserves mention in our BULLETIN although it does not directly deal with problems of copyright. The volume is prefaced by the Dean of the Publishing field, a former Vice President of The Copyright Society, Mr. Frederic G. Melcher, who is also included among the publishers whose comments and ideas on book publishing were selected for inclusion by the editor of this attractive book. The chapter on J. Henry Harper includes some fascinating reminiscences concerning his friendship with Mark Twain, who is quoted, *inter alia*, as having said that he made "a grave mistake in not originally taking two noms de plume, one for his humorous writings and one for his serious works". Of particular interest to lawyers are the various chapters on censorship, particularly the experiences of Donald Friede in connection with the publication of Dreiser's "An American Tragedy" and Hall's "The Well of Loneliness". It seems hard to believe today that a Massachusetts court over 20 years ago should have held parts of Dreiser's now famous book "corrupting to the morals of youth". The book also offers chapters on some of the best known British publishers including the success story revealed by Sir Stanley Unwin of his publication of Heyerdahl's "Kon-Tiki" and some rather charming extracts from Fredric Warburg's autobiography,

"An Occupation for a Gentleman". The book is warmly recommended to all those interested in the book publishing business.

2. Foreign Publications

1. In French

82. STREULI, ADOLF. Examen du "Projet de Convention internationale concernant la protection des artistes interprètes ou exécutants, des producteurs de phonogrammes et des organismes de radio-diffusion" (adopté par le Comité d'Experts réuni à La Haye du 9 au 20 mai 1960) et du "Projet de clauses formelles" (soumis conjointement par le B.I.T., le Secrétariat de l'UNESCO et les BIRPI) Brougg, Suisse, Effingerhof, 1961. 83 p.

An article-by-article critique, from the point of view of the Swiss Society of Authors and Publishers (Suisa) and the Association of Swiss Musicians (A.M.S.), of the Draft International Convention on Neighboring Rights, adopted by the Committee of Experts at the Hague, in May 1960 and the Draft Final Clauses submitted jointly by the I.L.O., the UNESCO Secretariat and the International Bureau for the Protection of Industrial Property (BIRPI), with suggestions for a number of textual changes. A revised draft, incorporating the proposed changes, is given in the appendix.

B. LAW REVIEW ARTICLES

1. United States

83. AMERICAN PATENT LAW ASSOCIATION. *Special Committee on Design Legislation*. Report. *American Patent Law Association Bulletin* (Sept. 1961), pp. 450-458.

The report includes the statement of the Association on the design bill, S. 1884 (87th Congress, 1st sess.) which was submitted to the Senate Committee on the Judiciary by authority of the Association's Board of Managers. The Association, in its statement, approved "the purpose and, in general, the principles which underlie the provisions of S. 1884."

84. CARY, GEORGE D. Copyright and advertising. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 131-145, no. 2, Sept. 1961.)

After a brief examination of some of the "myths" that have grown up concerning the nature of copyright, the author traces the evolutionary processes which ultimately resulted in the acceptance of advertising as proper subject of copyright, and analyzes some selected types of copy-

righted advertising matter that have been involved in litigation in order "to illustrate some of the purposes and advantages of copyright protection, and also to point out some pitfalls that should be avoided."

85. DWORKIN, JONATHAN S. Copyright—the doctrine of limited publication. (12 *Western Reserve Law Review* 797-800, no. 4, Sept. 1961.)

A note on the appellate decision in the Rickover case, 284 F.2d 262, 8 BULL. CR. SOC. 47, Item 22 (D.C. Cir. 1960).

86. EGGE, GEORGE V., JR. Unfair competition: the action of community antenna television system in using television signals for their own profit without obtaining permission of originating stations does not constitute unfair competition. (50 *Georgetown Law Journal* 171-176, no. 1, Fall 1961.)

A case note on *Intermountain Broadcasting & Television Corp. v. Idaho Microwave, Inc.*, 196 F.Supp. 315, 8 BULL. CR. SOC. 373, Item 368 (S. D. Idaho 1961).

87. GOLD, DAVID R. Protection of the artist and sculptor under the law of copyrights. (22 *University of Pittsburgh Law Review* 709-727, no. 4, June 1961.)

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88. PLATTNER, JOHN L. Who may secure copyright. (37 *North Dakota Law Review* 362-367, no. 3, July 1961.)

This article was entered in the Nathan Burkan Memorial Competition.

89. Problems in co-ownership of copyrights. (8 *U.C.L.A. Law Review* 1035-1049, no. 4, July 1961.)

"It shall be the purpose of this comment to examine briefly the methods by which co-ownership arises and the rights of co-owners, with the main emphasis devoted to the development of the duty of accounting for profits and the possibility of other remedial protection for the interests of co-owners."

90. SCHULMAN, JOHN. Elements of copyright law. (34 *Wisconsin Bar Bulletin* 53-63, no. 5, Aug. 1961.)

A brief statement of the basic principles and nature of the copyright law.

91. WALLAHAN, FRANKLIN J. Immorality, obscenity and the law of copyright. (6 *South Dakota Law Review* 109-129, no. 1, Spring 1961.)

This paper, which was awarded first prize in the 1961 Nathan Burkan Memorial Competition at the University of South Dakota School of Law, examines the status of an immoral or obscene work in the law of copyright.

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(a) English

- 91a. BERGSTRÖM, SVANTE. The new Swedish copyright legislation. *EBU Review*, no. 68B, July 1961, 18-25; no. 69B, Sept. 1961, 64-72.

An analysis of the new Swedish copyright legislation, dealing first with copyright proper, then with the law on photographic pictures, and lastly, with neighboring rights.

(b) English and French

92. BOGSCH, ARPAD. Vers une revision de la législation des États-Unis d'Amérique en matière de droit d'auteur. Toward the general revision of the copyright law of the United States of America. (74 *Le Droit d'Auteur* 268-287, no. 10, Oct. 1961.)

An analytical summary, in French and English in parallel columns, of the Register's *Report on the General Revision of the Copyright Law*. All the recommendations contained in the *Report* are not mentioned, but "an effort has been made to take up most of the questions which may be of particular interest to readers outside the United States."

(c) English, French and Spanish

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94. CASTELAIN, RAOUL. Vers un registre européen de la cinématographie, par Raoul Castelain [et] Michel Gorline. *Revue Internationale du Droit d'Auteur*, no. 32, July 1961, 2-27.

A comparative analysis, in French, Spanish and English, of the French and Italian motion picture registry systems—the latter in the formative stage by virtue of a recently drawn up draft law—"in what they may have of reciprocal usefulness and what they place at the disposal of all countries interested in the creation of a public register."

95. MERCIER, JACQUES. De la protection aux États-Unis des artistes français et étrangers bénéficiaires de la Convention Universelle sur le droit d'auteur. *Revue Internationale du Droit d'Auteur*, no. 32, July 1961, 74-113.

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"This working paper [in English, French and Spanish] lists and analyses the problems arising in connexion with rights in cinematographic works, whether in the field of copyright proper or in that of certain other related rights:

- (a) describing, for each of these problems, the solutions provided by the existing international conventions and national laws, as well as the solutions envisaged by certain draft laws now under consideration, and
- (b) summing up, also for each of these problems, the observations and suggestions made by the international non-governmental organizations consulted by the United International Bureaux with respect to a report drawn up by Professor G. Lyon-Caen, following the seventh session of the Permanent Committee of the International Union for the Protection of Literary and Artistic Works (Geneva, August 1958)."

The working paper was turned over, as a basis for deliberations and a report thereon, to a small study group which had been set up by the chairman of the Intergovernmental Copyright Committee and

the Permanent Committee of the Berne Union in agreement with the Director of the Bureau of the Berne Union and the Director-General of UNESCO.

(d) French

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- 97a. BÉGUIN, GEORGES. L'organisation des Bureaux internationaux réunis pour la protection de la propriété industrielle, littéraire et artistique. (77 *La Propriété Industrielle* 203-213, no. 9, Sept. 1961.)

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101. VAUGHAN, DENIS. La publication pour les imprimés de l'oeuvre musicale. (74 *Le Droit d'Auteur* 265-268, no. 10, Oct. 1961.)

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(e) German

102. ADAM, KLAUS. Die Urhebernachfolgevergütung; zur Verfassungsmässigkeit des Entwurfs einer Urheberrechtsform. (34 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 257-263, nos. 5/6, Aug. 1, 1961.)

A critical examination, from the point of view of the West German Constitution, of those provisions of the Federal Ministry of Justice Draft Copyright Law which are concerned with the "domaine public payant." The competence of the Federal Government to levy a "cultural tax" is questioned and a suggestion is made that the Länder enter into an agreement to enact the necessary laws in order to provide a proper legal basis for its collection.

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104. BLOTEKAMP, W. Die kartellrechtliche Stellung der GEMA und sonstiger Verwertungsgesellschaften. (34 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 17-25, nos. 1/2, May 1, 1961.)

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105. Börsenverein des Deutschen Buchhandels. Stellungnahme des Börsenvereins zu den Ministerialentwürfen zur Urheberrechtsreform. (17 *Börsenblatt für den Deutschen Buchhandel*, Frankfurter Ausg. 573-588, no. 30, Apr. 14, 1961.)

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106. GENTZ, GÜNTHER. Elektronische Musik als Rechtsproblem. (34 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 9-17, nos. 1/2, May 1, 1961.)

An examination of some legal problems arising in connection with electronic music in West Germany.

107. GLUCKSMANN, ANSELM. Zu einigen Grundfragen des Urheberrechts. (10 *Erfindungs- und Vorschlagswesen*, Ausg. B., 142-143, no. 8, Aug. 1961; 156-160, no. 9, Sept. 1961.)

A criticism of the views expressed by H. Püschel in his article "Das Urheberrecht als Teil des Zivilrechts," published in 10 *Erfindungs- und Vorschlagswesen*, Ausg. B., 85-92, no. 5 (See 9 BULL. CR. SOC. Item 50 (1961), on the question of the position of the copyright law within the framework of the civil law. While Püschel's thesis that copyright law is a part of civil law is accepted in essence, it is argued that the question whether the copyright law should be incorporated in the forthcoming East German civil code or whether there should be a special copyright law can be answered only after a thorough scrutiny of the contents and purposes of both laws. The author's conclusion is that a separate copyright law in the German Democratic Republic is necessary.

108. HENSSLER, EBERHARD. Der Schutz der angewandten Kunst nach geltendem Recht und nach dem Ministerialentwurf 1959 zum Urheberrechtsgesetz. (63 *Gewerblicher Rechtsschutz und Urheberrecht* 397-403, no. 8, Aug. 1961.)

The protection of works of applied art in West Germany viewed as a "problem of coexistence between a copyright law based on the [Federal] Ministry [of Justice] Draft Copyright Law [of 1959] and the existing Law concerning the Protection of Designs."

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110. KLEINE, HEINZ. Der Leistungsschutz der ausübenden Künstler, der Tonträgerhersteller und der Sendeunternehmen. (16 *Juristenzeitung* 354-360, no. 11/12, June 16, 1961.)

The problem of the protection of the rights of performing artists in West Germany is examined in the light of the Federal Ministry of Justice Draft Copyright Law and four decisions handed down by the Federal Supreme Court on May 31, 1960. A brief comment on the protection of the rights of record manufacturers and broadcasters is included.

111. KNAP, KAREL. Die Stellung der Tschechoslowakei im internationalen Urheberrecht. (34 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 129-140, nos. 3/4, July 1, 1961.)

An examination of Czechoslovakia's position in international copyright within the framework of her copyright law and the Berne and Universal Copyright Conventions to which she adheres. The author points out, *inter alia*, that the positive attitude of the Czechoslovak government toward international regulation of the protection of neighboring rights indicates that there is every reason to hope that Czechoslovakia will adhere to an international convention for such regulation.

112. MÜNZER, GEORG. Arbeitsgesetzbuch und Urheberrecht. (10 *Erfindungs- und Vorschlagswesen*, Ausg. B., 92-96, no. 5, May 1961.)

A discussion of copyright problems arising out of employ for hire and on commission situations, which is the first of a two-part study on the relationship between the East German Labor Code and the copyright law. See Item 113, *infra*.

113. MÜNZER, GEORG. Die praktische Durchführung betrieblicher kultureller Veranstaltungen nach den Grundsätzen des AGB. (10 *Erfindungs- und Vorschlagswesen*, Ausg. B., 143-144, no. 8, Aug. 1961.)

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out of cultural performances given in industrial establishments with particular reference to royalties. See Item 112, *supra*.

114. PETER, WILHELM. Die Aufnahme von Werken in eine Gesamtausgabe. (17 B. *Börsenblatt für den Deutschen Buchhandel*, Frankfurter Ausg., 736-738, no. 40, May 19, 1961.)

A brief comparative survey of copyright and related legal provisions applicable to publications of complete works of an author.

115. PETER, WILHELM. Copyright-Schutz deutscher Verlagswerke österreichischer Urheber. (17 B. *Börsenblatt für den Deutschen Buchhandel*, Frankfurter Ausg., 735-736, no. 40, May 19, 1961.)

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116. SCHRAMM, CARL. Verlegerhaftung für Autorenplagiat; zum Umfang der Nachprüfungspflicht. (34 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 26-30, nos. 1/2, May 1, 1961.)

An examination of the question of the publisher's liability for wrongful actions of others, *e.g.*, authors, editors, etc., in West German law, with special emphasis on plagiarism.

(f) Italian

117. FABIANI, MARIO. Concorrenza e libere utilizzazioni nella disciplina del diritto d'autore. (32 *Il Diritto di Autore* 210-214, no. 2, Apr.-June 1961.)

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A translation, with slight modifications, of the author's "Der Künstler und die Technik" which was the first of three studies on neighboring rights issued under the collective title "Leistungsschutz" as no. 5 of a series by the International Copyright Society. See 5 BULL. CR. SOC. 314, Item 404 (1958).

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

120. THE BMI CONVENTION: Copyright and the manufacturing clause. (74 *Book Production* 64, no. 5, Nov. 1961.)

A summary of discussions, at a convention held recently by the Book Manufacturer's Institute, on the proposed elimination of the manufacturing clause and of tariff duties on printed books [Florence Agreement]. See also Item 121, *infra*.

121. BMI: convention views management problems and international programs. (180 *Publishers' Weekly* 52-72, no. 20, Nov. 13, 1961.)

A summary of the proceedings at the 29th annual convention of the Book Manufacturer's Institute, Boca Raton, Florida, October 25-28, at which the featured topics included discussions of copyright and tariff matters affecting the book industry with particular reference to the Copyright Office recommendation for repeal of the manufacturing clause, and the Florence Agreement.

The result of the discussions was the adoption of the following resolution:

"RESOLVED: That the board of directors of the Book Manufacturer's Institute study any proposed legislation affecting tariff and copyright and take such action and expend such funds as it deems necessary in the best interests of the industry and the nation."

122. BROWN, ALBERTA L. Summary of copyright positions. (52 *Special Libraries* 499-505, no. 9, Nov. 1961.)

A paper presented at a panel discussion on "Copyright Law" at the Special Libraries Association Joint Chapter Regional Meeting held in

Columbus, Ohio, April 14, 1961. The first part of the paper is a definition and brief history of copyright, and the second part a summary of the Copyright Office General Revision Studies 1-20.

123. BUDINGTON, WILLIAM S. Using copyrighted material. (52 *Special Libraries* 510-513, no. 9, Nov. 1961.)

A paper presented at a panel discussion of "Copyright Law" at the Special Libraries Association Joint Chapter Regional Meeting held in Columbus, Ohio, April 14, 1961. The paper discusses photocopying and other uses of copyrighted materials by libraries.

124. DONOVAN, JOHN. The new proposals for the revision of the copyright law. (180 *Publishers' Weekly* 24-27, no. 15, Oct. 9, 1961.)

A summary of the recommendations of interest to the book trade contained in the *Report of the Register of Copyrights on the General Revision of the Copyright Law*.

125. DORWARD, DONALD. A publisher looks at copyright. (52 *Special Libraries* 505-510, no. 9, Nov. 1961.)

A paper, by the associate editor of *Chemical Abstracts*, presented at a panel discussion of "Copyright Law" at the Special Libraries Association Regional Meeting held in Columbus, Ohio, April 14, 1961. The paper discusses the operation of the American Chemical Society and its publication of *Chemical Abstracts* with reference to the Society's attitude toward fair use.

126. Editorial [on photographic books and the manufacturing clause]. (10 *Infinity* 19, no. 8, Oct. 1961.)

A brief editorial comment on the recommendation for repeal of the manufacturing clause which appeared in the Register's *Report on the General Revision of the Copyright Law*.

127. Editorial [on the Copyright Office general revision studies]. (10 *Infinity* 19, 21, no. 6, June 1961.)

A brief editorial comment on some of the points in the studies that affect photography.

128. GOULD, MORTON. A band composer's lament. *Music Journal* 1961 *Annual*, 10, 106.

A plea to school and college bands to endorse "the concept of an ASCAP performing rights blanket license" in their schools.

129. G[RANNIS], C[HANDLER] B. Tariffs, the Common Market, the Florence Agreement. (180 *Publishers' Weekly* 28, no. 22, Nov. 27, 1961.)

An editorial on the book industry's place in the Common Market area with particular reference to expected U. S. legislative proposals for implementation of the Florence Agreement. The statement is made that "here . . . is a topic that calls for consultation among all branches of the book industry."

130. KUBILIUS, WALTER. The copyright law—a warning. (74 *Book Production* 53, no. 4, Oct. 1961.)

A brief editorial comment, by the editor of *Book Production*, on the proposal for repeal of the manufacturing clause, which appeared in the *Report of the Register of Copyrights on the General Revision of the Copyright Law*.

131. LATMAN, ALAN. Copyright Office recommendations for a new copyright law. (52 *Special Libraries* 514-529, no. 9, Nov. 1961.)

A critical analysis of the recommendations with respect to provisions dealing with notice, registration and unpublished works, "selected because of their pivotal nature, as well as their interest to librarians."

132. LIBRARIES AND COPYRIGHT. (36 *Wilson Library Bulletin* 88, 90, no. 2, Oct. 1961.)

A brief digest of the recommendations in the Register's *Report on the General Revision of the Copyright law* which are of special interest to librarians.

NEWS BRIEFS

133. SENATE SUBCOMMITTEE HEARINGS ON DESIGN BILL.

Hearings on S. 1884 (*A bill to encourage the creation of original designs of useful articles by protecting the authors of such designs for a limited time against unauthorized copying*, introduced May 16, 1961, 87th Cong., 1st Sess., and referred to the Committee on the Judiciary) were held in Washington before a Senate subcommittee on August 15-17, 1961.

Among the speakers favoring enactment of the bill was Governor Ellis Arnall, who stated that the present bill reconciled the differences between the two previous design bills, the Talmadge and O'Mahoney bills, introduced in 1959 and 1960. Philip T. Dalsimer, of the New York Bar, demonstrated with artificial flowers and molds how easy and quick

copying in the design field is now and emphasized the need for protective legislation. Judge Giles E. Rich, of the U.S. Court of Customs and Patent Appeals, testified that the bill would promote the public interest and was, in his opinion, not subject to attack on constitutional grounds. Open discussion of the legislation included George E. Frost, of the Chicago Bar, who represented the plaintiff in the case of *Mazer v. Stein*; Horace B. Fay, Jr., Assistant Commissioner, and P. J. Federico, Examiner-in-Chief, of the U.S. Patent Office; the U.S. Register of Copyrights, Hon. A. L. Kaminstein and George D. Cary, Deputy Register; Congressman Gerald R. Ford; and George Lucas, Jr., Chairman of the National Committee for Effective Design Legislation. Senator Phillip A. Hart of Michigan, who presided, reiterated his interest in the field of more effective design protection and commented that no statements opposing the measure had been received by the subcommittee. The hearings are now available in printed form.

134. NEW ADHERENCES TO THE UNIVERSAL COPYRIGHT CONVENTION.

Denmark. UNESCO has advised the United States Department of State that Denmark has ratified the Universal Convention and Protocols 1, 2, and 3 thereof, as of November 9, 1961. The Convention will come into force with respect to Denmark on February 9, 1962.

Nigeria. UNESCO has also advised that on November 14, 1961, Nigeria deposited its instrument of accession to the Universal Copyright Convention, which will come into force with respect to that country on February 14, 1962. Nigeria is the 39th country to adhere to the Convention.

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Photograph by The Library of Congress

Dr. Louis Charles Smith

SENIOR ATTORNEY, UNITED STATES COPYRIGHT OFFICE

135. DR. SMITH'S RETIREMENT FROM THE COPYRIGHT OFFICE.

A member of the first Board of Trustees of The Copyright Society of the U.S.A. and a widely known career staff member of the U.S. Copyright Office, Dr. Louis Charles Smith retired as Senior Attorney on December 31, 1961. He served in the Office for 39 years and is the only attorney to have worked under all six Registers of Copyright. Dr. Smith began as an indexer, became a cataloger, was put in charge of copyright searches and public information, and was Chairman of the former Revisory Board which passed on rejection of copyright claims, before becoming Senior Attorney. During World War II he served for a time in the Ordnance Department of the Army. He was graduated *magna cum laude* from Georgetown University, and holds M.A., J.D., M.P.L., and S.J.D. degrees from National University, as well as a certificate of studies from the University of Hamburg.

Dr. Smith has written various monographs on copyright law, including, in 1947, a paper on "Copyright in the Editing of Music" which was influential in causing the Office to change its policy and begin to register copyright claims based on the editing of musical compositions. He is also the author of "Copying of Literary Property in Library Collections".

He is a member of the District of Columbia Bar and has practiced before the United States Court of Claims, the Court of Customs and Patent Appeals, and the Supreme Court. He has served on the American Bar Association's Copyright Committee and is a well known member of various professional groups, including Delta Phi Epsilon and Phi Beta Gamma. At a luncheon held in Dr. Smith's honor late in January, he was presented with a bound volume of all his writings. He plans to continue to write and teach, and in his leisure to enjoy his hobby of gardening.

I

ARTICLES

136. THE GHOST OF *DONALDSON V. BECKETT*: AN INQUIRY INTO THE CONSTITUTIONAL DISTRIBUTION OF POWERS OVER THE LAW OF LITERARY PROPERTY IN THE UNITED STATES—PART II*

By JOHN F. WHICHER**

II

"TO PROMOTE THE PROGRESS OF SCIENCE AND USEFUL ARTS":
THE CONSTITUTIONAL SOURCE AND THE LIMITING PRINCIPLE
OF THE FEDERAL DIVESTITIVE POWER

We have already seen that the framers of the Constitution did not anticipate that any conflict whatever would arise between the public interest, on the one hand, and the private interests of "Authors and Inventors" in securing an "exclusive Right to their respective Writings and Discoveries," on the other. As Madison wrote in *The Federalist*:¹

"The public good fully coincides in both cases [authors' and inventors'] with the claims of individuals."

The ink was hardly dry on Madison's overconfident observation, however, before a controversy broke out which was to expose his assurance as unfounded. This was the great steamboat patent war, which began in 1788 as a quarrel between John Fitch and James Rumsey over their rival claims of priority in the discovery of the principles of steam navigation. On this simple issue of pure fact, Rumsey (who never built a commercially workable steamboat until the very end of his life) had nothing to support his pretensions save his own presumption and a good deal of patronage in high places. He himself, however, did not press his claims for very long. He departed from this country almost as soon as the argument was fairly begun. But he left behind him a well-organized coterie of "true believers" to fight his battles for him; and they never permitted "poor John Fitch", the real inventor, to reap the fruits of his great discovery in peace.² With Fitch's tragic death by suicide

* © 1962 by John F. Whicher. This is the second part of a two-part article.

** Member, New York Bar. A.B., 1941, Amherst; LL.B., 1947, Columbia.

1. *The Federalist*, No. 43 (Mod. Lib. ed.), 279 (1941).

2. Boyd, *Poor John Fitch*, 188 *et seq.*, especially at 193-94 (1935); Turnbull, John Stevens, 100 *et seq.* (1928). The controversy began in the year following the writing of the Constitution, when the two rivals fired off argumentative pamphlets at one another's heads. Rumsey, *A Short Treatise on the Application of Steam* (1788); Fitch, *The Original Steamboat Supported* (1788).

in 1798, the battle for inventors' rights in steamboats became general. Out of this later struggle certain ideas emerged which contributed significantly to American legal thinking on the subject of our study.

A. PATENTS AS MONOPOLIES: THE GREAT STEAMBOAT PATENT WAR AND THE CONSTITUTIONAL SOURCE OF FEDERAL DIVESTITIVE POWER

Fitch was hardly in his grave when Robert Livingston persuaded the New York Legislature to cancel the fourteen-year "patent" which it had previously bestowed on Fitch, and to grant a twenty-year "patent" in steamboat operations to Livingston instead.³ It should be here recalled and re-emphasized that the so-called state "patents" which we are now discussing were not rewards for achieved discoveries; each was merely a promise of such a reward if the patentee should thereafter develop an invention conforming to the very general specifications laid down by the State Legislature. Thus the "patent" which had been granted to Fitch by New York in 1787 was granted on condition that he build and operate a steam vessel in New York waters which would be capable of making a certain minimum speed against the current of the Hudson River. This condition Fitch had never met; the only steamboat he ever built was operated on the lower reaches of the Delaware River, in waters "alien" to, and far to the south of, the State of New York. Consequently, Livingston had no difficulty in persuading the New York Legislature to cancel Fitch's "patent" as unperformed and to transfer the franchise to him instead. The grant so made to Livingston, however, was also given in the form of a conditional promise: in order to reap its benefits, he was required to build an operative steamboat within the space of one year. Although the time to fulfill this condition was repeatedly extended by subsequent enactments, Livingston continued to confront failure in his "inventive" efforts until he entered into a partnership with Robert Fulton in 1802. These two, after securing a further extension of time from the Legislature, at length achieved success with Fulton's vessel, the *Clermont*, which made its maiden voyage on the Hudson in 1807. Thereupon the earlier, promissory "patents" were again confirmed to the partners by the New York Legislature's enactment of a *real* patent, by which

3. The description given here of the patent war in New York is largely based on the account in I Dorfman, *The Economic Mind in American Civilization*, 478-84 (1946), and the statement of facts in *Livingston v. Van Ingen*, 9 Johns. (N.Y.) 507 at 507-14. To call it a "great war" is, perhaps, an ironic hyperbole; the development of steam-driven craft in America appears to have been attended with a surprising lack of public interest. Turnbull, *supra* note 2, at 234-35. But the controversy certainly became public when Cadwallader D. Colden and W. A. Duer debated the matter in print during the years 1817-19. Colden, *Life of Robert Fulton* (1817); Duer, *A Letter Addressed to Cadwallader D. Colden, Esq.* (1817); Colden, *A Vindication* (etc.) (1818); Duer, *A Reply* (etc.) (1819).

they were granted the exclusive right to operate steamboats in New York waters for a period of time that was to be extended for every vessel subsequently built and operated by them.

Meanwhile, however, other inventors had busied themselves in the premises. It was not long after 1807 that several rival pioneers in the field had succeeded in creating operative steam-driven craft. These late comers contended (with some justice) that they had invented *better* steamboats than Fulton's, and that the people of New York were unjustly denied the benefits of the improvements they had so discovered and perfected in the art of steam navigation. Upon these grounds, they challenged the wisdom of the State Legislature's "favoritism" in granting a "monopoly" to their successful rivals. This charge of "monopoly" was important: it was as a result of that charge that patents became firmly identified as monopolies in American legal thinking.⁴

By reason of that identification, American lawyers and judges quickly came to accept the idea that the primary function of the federal patent laws was to limit the duration of inventors' "monopolies" in their discoveries. This change in outlook from the "natural rights" approach, familiar to the framers of the Constitution, was made easier by the fact that, when the steamboat patent war was fully joined, the persuasive voices which had led the Founding Fathers to adopt their more idealistic approach to the subject had noticeably weakened. The reprints of the tenth and eleventh English editions of Blackstone's *Commentaries*, which Isaiah Thomas of Worcester, Massachusetts, brought out in 1790 and 1799, respectively, and St. George Tucker's annotated reprint of the ninth English edition, which he published in 1803,⁵ had at long last acquainted American students of the law with the short-lived character of the authority of *Millar v. Taylor*,⁶ and disclosed the extent to

4. American legal thinking on the subject of intellectual property has suffered, *ab initio*, from the lazy man's impulse to treat patents and copyrights alike, without a careful consideration of the vital differences between them. Thus, as Madison's comment in *The Federalist* shows (*ubi supra* note 1), we began by focusing our attention on authors' rights; inventors' rights simply rode in on the coattails of Blackstone's "natural rights" analysis of common law copyright. After the steamboat patent war had trained a generation of American lawyers to think of patents as dangerous monopolies that ought to be restricted for the public good, copyrights (as we shall see) fell under a like suspicion upon a highly unconvincing theory that can only be characterized as one of guilt by constitutional association. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), as discussed *infra* in text accompanying notes 27-68. It is only in recent years that the importance of the essential distinction between these two types of intellectual property has been at all adequately appreciated. See, e.g., *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 100-04 (2d Cir. 1951).

5. Eller, *The William Blackstone Collection in the Yale Law Library*, Yale Law Lib. Pub. No. 6, 40-43 (1938).

6. 4 Burr. 2303, 98 Eng. Rep. 201 (K.B. 1769).

which Blackstone had been compelled to retreat from the "natural rights" approach by the decision of the House of Lords in *Donaldson v. Beckett*.⁷

When the steamboat controversy reached the courts, however, it was not fought out in terms of monopoly against free enterprise, but as a struggle between state and federal powers. The forces of "free competition" contended that the New York grant to Livingston and Fulton was unconstitutional on two grounds: it conflicted with federal statutes enacted under the commerce power; and it conflicted with the federal patent laws. In *Livingston v. Van Ingen*,⁸ the first of the two important cases arising out of this controversy, Chief Justice Kent of New York and his brethren, in 1812, rejected both grounds of attack as erroneous. It was not until twelve years later, in 1824, that the United States Supreme Court, speaking by its great Chief Justice, John Marshall, struck down the New York grant as unconstitutional in the landmark case of *Gibbons v. Ogden*.⁹ Marshall's opinion, however, rested entirely on the ground that the New York "patent" conflicted with federal legislation regulating the navigation, through New York waters, of federally licensed vessels engaged in interstate commerce. He expressly declined to pass on the question of conflict between the state franchise and the federal patent laws.¹⁰ *Livingston v. Van Ingen*, therefore, remained the last judicial word on that aspect of the matter.¹¹ The gist of Chief Justice Kent's exposition of this subject in that earlier-decided case may be gathered from the following passage:¹²

"That power [granted by the patent-copyright clause] only secures, for a limited time, to authors and inventors the exclusive privilege to their writings and discoveries; and as it is not granted, by exclusive words, to the *United States*, nor prohibited to the individual states, it is a concurrent power which may be exercised by the states, in a variety of cases, without any infringement of the congressional power. A state cannot take away from an individual his patent right, and render it common to all the citizens. This would contravene the act of congress, and would be, therefore, unlawful. But if an author or inventor, instead of resorting to the act of congress, should apply to the legislature of this

7. 2 Bro. P.C. 129, 1 Eng. Rep. 837; 4 Burr. 2408, 98 Eng. Rep. 257 (H.L. 1774). For Blackstone's alterations in the Commentaries, see Part I of this article, notes 45, 46, and 72.

8. *Supra* note 3.

9. 22 U.S. (9 Wheat.) 1 (1824).

10. *Id.* at 221.

11. See *Patterson v. Kentucky*, 97 U.S. 501, at 508-09 (1879).

12. *Supra* note 3, 9 Johns. (N.Y.) at 581-82.

state for an exclusive right to his production, I see nothing to hinder the state from granting it, and the operation of that grant would, of course, be confined to the limits of this state. Within our own jurisdiction, it would be complete and perfect. So a patentee under the act of congress may have the time of his monopoly extended by the legislature of any state, beyond the term of fourteen or twenty-eight years allowed by that law. Congress may secure, for a limited time, an exclusive right throughout the union; but there is nothing in the constitution to take away from the states the power to enlarge the privilege within their respective jurisdictions. The states are not entirely divested [*sic*] of their original sovereignty over the subject matter; and whatever power has not been clearly granted to the union, remains with them."

These views would, no doubt, have been accepted by the framers of the Constitution as an accurate exegesis of the document they wrote, save, perhaps, for the characterization of the inventor's natural, "exclusive Right" as, first, a "privilege", and then as a "monopoly".¹³ Later ages, in fact, have not allowed the application of these invidious words to patents to go unquestioned. As recently as 1933 the Supreme Court observed:¹⁴

"Though often so characterized, a patent is not, accurately speaking, a monopoly, for it is not created by the executive authority at the expense of and to the prejudice of all the community except the grantee of the patent . . . The term monopoly connotes the giving of an exclusive privilege for buying, selling, working or using *a thing which the public freely enjoyed prior to the grant. Thus a monopoly takes something from the people.* An inventor deprives the public of nothing which it enjoyed before his discovery, but gives something of value to the community by adding to the sum of human knowledge . . . He may keep his invention secret and reap its fruits indefinitely. In consideration of its disclosure and the consequent benefit to the community, the patent is granted." (Emphasis added.)

Now surely it is immaterial, in defining a monopoly, to look to its source; a monopoly created by the legislature, or by the unaided acquisitive genius of the monopolist, is just as truly a monopoly as one "created by the executive authority." Nor is the power to exclude others from the use of a thing the hallmark of monopoly; for, if it were, your right and mine to refuse the contents of our purses to any beggar cheeky enough to demand

13. For Madison's views see Turnbull, *supra* note 2, at 256.

14. U.S. v. Dubilier Condenser Corp., 289 U.S. 178, 186 (1933), recently quoted and followed in Application of Tenney, 254 F.2d 619, 622-23 (C.C.P.A. 1958).

them would make "monopolists" of us all. Exclusivity (thus allegorically defined as the right to say "no" to a panhandler) is simply a necessary element of any concept of mere *property*: by the very force of definition, "meum" *excludes* "tuum". While patents have been widely regarded as monopolies, they have never been so characterized merely because they are granted by an executive officer of the federal government, nor yet because a patent is, as the Constitution requires it to be, an "exclusive right." It is the peculiar and characteristic evil of a monopoly that it deprives the public of some benefit which the public rightfully enjoyed before the monopoly came into being. It is precisely in this sense (despite the last-quoted observation by our highest court) that patents are rightly characterized as monopolies.

The same circumstances which made the monopolistic character of patents evident to Americans at the beginning of the last century will serve to illustrate the point here. In *Livingston v. Van Ingen*, neither plaintiffs nor defendants were the actual inventors of the steamboat. But the plaintiffs stood (however unjustly) in the shoes of the original inventor, John Fitch. The defendants, meanwhile, honestly complained that they were inventors too: they had also invented steamboats; and their intellectual labors were just as arduous, and just as deserving of public reward, as those which had led Fitch to his original discovery. Indeed, at this distance in time, it is easy to see that the steamboat, in a sense, invented itself; if Fitch had not achieved his discovery, someone else would certainly have done so. To grant an exclusive patent in the art of steam navigation to anyone, therefore, necessarily meant that all the later "inventors" of that art were denied the right to practice discoveries which each of them had achieved in exactly the same manner as the first inventor: by the independent exercise of intellectual labor. Patents thus stood revealed as true monopolies because they deprived the public of the benefits which had previously flowed from allowing others besides the *first* inventor to exercise the "natural" right to profit from an *independent* discovery of any given invention. That right had been recognized by the common law, which protected the first inventor's right to practice his discovery only from unfair or fraudulent devices to wrest his secret from him.¹⁵ If others, by independent efforts, achieved identical inventions, the common law allowed them, too, to exploit their discoveries equally with the first inventor. Unlike a patent, in short, the common law right of inventors was not a monopoly; for it did not deprive the public of the benefits of the exercise, by *later* inventors, of their rights of independent rediscovery. Under the common law, ideas remained free. But the patent law conferred upon the inventor a monopoly in his idea, and thus destroyed that freedom, *pro tanto*.

15. See, e.g., *Giblett v. Read*, 9 Mod. 459, 88 Eng. Rep. 573 (Ch. 1744).

Because the public deprived itself of the potential benefits of independent rediscoveries by granting patents solely to *first* inventors, it was only just to accord to the public a quid pro quo for its sacrifice. Our patent statutes have always required, as a condition precedent to the grant, that a prospective patentee describe his invention fully to the executive officer charged with the duty of issuing patents. Such a requirement is manifestly necessary to inform the government of what, precisely, it has undertaken to protect, so that it will not vitiate one patent by granting to another claimant a second patent for the same discovery. But, as the battles of the great steamboat war began to expose the monopolistic character of patents to public view, a further purpose came to be read into these statutory requirements for disclosure: beginning in 1809, they were construed as directions to the inventor to disclose his invention *openly to the public* (not confidentially to the executive officer), thus "dedicating" the invention to public use when the patent grant was terminated.¹⁶ The courts held that the power of Congress to compel such a "dedication" of the inventor's common law right had its source in the opening phrase of the patent-copyright clause of the Constitution: "To promote the Progress of Science and useful Arts."¹⁷ This phrase was and is the only true source of Congress's power to divest inventors of their proprietary rights in their own creations.

In the eighteenth century, "Science" meant knowledge in general, and was not restricted to that one particular branch of knowledge to which we now confine the term (and which our forefathers would have called "natural philosophy").¹⁸ To compel an inventor to disclose his invention to the general public manifestly promoted the progress of "Science" in this older, larger sense, because it compelled the inventor to add to the sum of shared human knowledge by his disclosure. By parity of reasoning, the same enforced disclosure also promoted the "Progress of . . . useful Arts" by adding to the sum of shared skills which all men thereafter might practice and improve. Upon this analysis, the federal courts, at an early date, construed the over-all scheme of the patent laws as one by which an inventor, in exchange for public disclosure and dedication of his invention, received from the federal government the grant of a temporary monopoly in the commercial exploitation of his in-

16. *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822); *Whittemore v. Cutter*, 29 Fed. Cas. 1120, 1122, No. 17,600 (C.C. Mass. 1813). Patentees' specifications were not opened to public inspection until 1809, when the Patent Office obtained a ruling from the Attorney General authorizing disclosure of Fulton's steamboat patent specifications to his rival, John Stevens of New Jersey. *Turnbull*, *supra* note 2, at 272-73, 282.

17. *Grant v. Raymond*, 31 U.S. (6 Pet.) 218, 241-42 (1832); *Pennock v. Dialogue*, 27 U.S. (2 Pet.) 1 (1829).

18. *Taubman*, *Copyright and Antitrust*, 14 (1960).

vention, which he could exercise only for the term limited by the statute. Thereafter, everyone was free to practice the invention, since the public disclosure compelled by the statute had made the inventor's discovery a matter of public knowledge. To keep the bargain fair to the public, moreover, the courts have also held that the inventor may not exercise his common law right to reap the commercial rewards of the practice of his invention while it remains secret, and then, at a later date (when at last he begins to feel the hot breath of independent rediscoveries by others on his neck) take out a federal patent to fend off his pursuers. He must choose between the two modes of protection at the moment when his invention becomes commercially exploitable. He may then do one of two things: either (1) he may accept the bargain the federal government offers, abandon his common law right, and receive in exchange a protection which, though limited in time, will be effective against legitimate rediscoverers of his invention; or (2) he may keep his secret, and forfeit all claim to preclude others from the immediate exercise of their rights of independent rediscovery.¹⁹

The important thing to notice about this "bargain" doctrine is that it was the patent statutes, *not* the provisions of the Constitution, which were thought to compel an inventor to make such a choice as we have just described.²⁰ The constitutional phrase, "To promote the Progress of Science and useful Arts," while it was held to *authorize* Congress to enact such a dedicatory condition precedent to the grant of a federal patent, has never been deemed to *command* Congress to adopt such a course.²¹ Nor should it be; for such a construction of the phrase would distort the intent of the framers. As we have seen, the authors of the patent-copyright clause did not anticipate that any conflict would arise between the private rights of patentees and the public interest. It was only after the Constitution was adopted that such a conflict did, in fact, occur in this country. Only then was the monopolistic character of patents realized. Only then was the need felt for curtailing inventors' exclusive rights in their ideas. Only then was it conveniently discovered that Congress had a power to meet that need by virtue of the phrase, "To promote the Progress of Science and useful Arts."

19. *Pennock v. Dialogue*, *supra* note 17; *Macbeth-Evans Glass Co. v. General Electric Co.*, 246 Fed. 695 (6th Cir. 1917), cert. denied, 246 U.S. 659 (1918).

20. *Pennock v. Dialogue*, *supra* note 17; *Evans v. Eaton*, *supra* note 16; *Metallizing Eng. Co. v. Kenyon Bearing & A. P. Co.*, 153 F.2d 516, 520 (2d Cir.), cert. denied, 328 U.S. 840 (1946); *Macbeth-Evans Glass Co. v. General Electric Co.*, *supra* note 19.

21. Thus, as we have already seen, Congress granted *unconditional* protection to unpublished manuscripts by copyright statutes enacted under the same constitutional clause for well over a hundred years after the Constitution was written. Part I of this article, note 150.

What the framers probably intended by that purposive phrase was to authorize Congress to establish procedures by which it could determine whether a particular "Writing" or "Discovery" held such inherent promise of promoting "the Progress of Science and useful Arts" as to *deserve* federal protection.²² The high standards of "novelty" which an invention still has to meet in order to qualify for a patent²³ represent a very important surviving realization of that original purpose. As to copyrights, however, both Congress and the courts seem to have recognized from the first that almost any "Writing" will promote the progress of knowledge to some extent, so long as it meets a minimal standard of originality.²⁴ Traces of a stricter view survive in occasional judicial holdings that copyrights in obscene works are void because any federal protection of such works would not subserve the constitutional purpose.²⁵ Even here, however, it is the constitutional purpose *as effectuated by the copyright statutes*, not the Constitution alone, which compels denial of federal protection to "Writings" of this kind.²⁶ The purposive phrase, in short, is not self-executing.

It is not inconsistent with the framers' intent, however, to read the purposive phrase more broadly, as an authority for Congress to decide *how* it will give effect to the declared purpose of the patent-copyright clause whenever it enacts a patent or copyright law. We may fairly conclude that the purposive phrase, thus broadly construed, leaves it up to Congress to

22. Consider, in this connection, the great stress which Noah Webster thought it necessary to lay, in his petitions to the various state legislatures for statutes protecting his American Spelling Book, on the public service which his book would render. Webster, Letters (Warfel, ed.), 1 and 5 (1953). It is not, in submission, unreasonable to suppose that, when the American author most conspicuous in the battle for statutory copyrights was thus prepared to submit his works to such a test, his contemporaries may well have thought that all authors might properly be required to do the same. Under such a system, if any author failed to pass such a test, he would simply have been remitted to his common law rights; he would have been denied nothing save the extraordinary federal protection granted to his more "distinguished" confreres.

23. E.g., *Cuno Eng. Corp. v. Automatic D. Corp.*, 314 U.S. 84, 90-92 (1941).

24. See The Meaning of "Writings" in the Copyright Clause of the Constitution, 31 N.Y.U. L. Rev. 1263, 1282-94 (1956). Maps seem to constitute a judicially-created exception to this rule. See *Amsterdam v. Triangle Pub., Inc.*, 93 F. Supp. 79 (E.D. Pa. 1950), *aff'd*, 189 F.2d 104 (3d Cir. 1951).

25. *Bullard v. Esper*, 72 F. Supp. 548 (N.D. Tex. 1947); *Barnes v. Miner*, 122 Fed. 480 (S.D.N.Y. 1903); *Martinetti v. Maguire*, 16 Fed. Cas. 920, No. 9,173 (C.C. Cal. 1867).

26. Thus in *Barnes v. Miner*, *supra* note 25, the court construed the meaning of "dramatic composition" in the statute so as to exclude from its coverage the script of a supposedly indecent pantomime. Cf. 41 Op. Atty. Gen., No. 73 (December 18, 1958).

decide, within rational limits, whether or not to give effect to an intention of its own to curtail inventors' rights in their ideas; and this is true despite the fact that the framers of the Constitution did not anticipate that any need to curtail those rights would ever arise. Just so does Congress undoubtedly exercise the commerce power today in ways undreamed of in the eighteenth century. There is, in short, no real inconsistency between the criticisms above made of the theory of "constitutional preemption" and the position now taken that the purposive phrase confers upon Congress a permissive (not a mandatory) preemptive power to divest an inventor of his common law right to keep secret the ideas represented by his discovery, as a condition of investing him with a federal patent monopoly. Our next inquiry must be whether authors' copyrights are, like patents, monopolies of ideas, so that a like divestitive power may, by similar reasoning, be deduced from the same constitutional source with respect to them. That problem was first raised in America by the famous case of *Wheaton v. Peters*,²⁷ to which we now turn.

B. COPYRIGHTS AS MONOPOLIES: WHEATON V. PETERS AND THE DOCTRINE OF GUILT BY CONSTITUTIONAL ASSOCIATION

Wheaton v. Peters is one of those "leading" decisions which everyone cites but nobody really reads. It deserves the better if less exalted fate of fresh and critical study. The parties to that action are still familiar to modern American lawyers as the editors of two successive series of the official reports of the United States Supreme Court. Wheaton edited a dozen volumes in all, containing the Court's decisions for the years 1816-1827; Peters's sixteen tomes cover the period 1828-1842.²⁸ The two reporters got into litigation over Peters's extracurricular publication of a series of "Condensed Reports" of all the Supreme Court decisions that had been handed down prior to his tenure as the Court's official reporter. Wheaton protested that these volumes infringed both his statutory and his common law copyrights in the official reports which he had published. When Peters turned a deaf ear to this complaint and insisted that he had a perfect "right" thus freely to earn his living at the expense of a brother lawyer's labors, Wheaton had no recourse but to sue for an injunction to put a stop to such conduct. The action was brought in the Federal Circuit Court in Pennsylvania. That court threw out Wheaton's bill of complaint; and thereby hangs our tale.

In regard to his claim of infringement of his statutory copyrights in his volumes, Wheaton very nearly became one of the first sacrifices to be offered up on the altar of our federal bureaucracy's capacity for injurious inertia.

27. *Supra* note 4.

28. Two volumes of Peters' series (3 and 4) were required to cover the decisions rendered in 1830.

Under the law governing his rights and duties as reporter, Wheaton had been required to deliver eighty copies of each annual volume of his reports to the Secretary of State; under the Copyright Law of that time he had been required, as a condition of obtaining a valid statutory copyright in each volume, to deposit one copy with the same official. As any cynic might have predicted, the State Department—which had kept (as required by statute) a very careful record of the yearly delivery of the eighty copies demanded by the reporter's act—had (in the absence of any further explicit directions) utterly failed to keep any record at all of the annual deposit of the eighty-first copy upon which Wheaton's federal copyright depended. Wheaton's publisher testified at the hearing that it was the usual custom of his firm to mail to the State Department one copy of every book his firm brought out, in order to secure the copyright; but he was too honest a man not to acknowledge, on cross-examination, that some slip-ups might have occurred in this practice. That admission was all the Circuit Court needed to hold that such "doubtful" testimony was insufficient to establish compliance with the deposit requirements of the Copyright Law, which it held to be *strictissimi juris*. Wheaton's claim was dismissed on the ground that his statutory copyright was not proved.

His plea of common law right was also denied by the trial court, but with less finality. Reviewing the relevant English authorities, that court found that they raised grave doubt whether the common law had ever extended copyright protection to published works.²⁹ In the complete absence of any American authorities on the subject, the court held that it was powerless, *as a court of equity*, to decide the question.³⁰ It therefore dismissed Wheaton's bill, but with leave to him to bring a new action *on the law side* of the court to settle the point.³¹

Wheaton, however, was unwilling to accept the Circuit Court's denial of his statutory copyright. He therefore appealed, and in doing so attacked the entire decision thus rendered. He contended, first, that no doubt should have been entertained by the trial court concerning the existence of his common law right to his published writings; and secondly, that his proof of compliance with the deposit requirements of the copyright statute had been sufficient,

29. *Donaldson v. Beckett*, *supra* note 7, was simply treated as raising such a doubt.

30. 33 U.S. (8 Pet.) App. at 741: "But I have found, the counsel have found, no common law such as is now set up in the colonies, in the States, or in the United States, and if I am now to recognize it, I must first make it . . . Holding the opinion that the complainants . . . have no right at common law *which this court can recognize and protect*, it is not necessary for me to give any opinion on the remaining question argued . . ." (Emphasis added.)

31. 33 U.S. (8 Pet.) App. at 741: "Let the complainants go to the law side of the court, and if they shall establish their right there, they may return and claim the aid of this court to protect that right."

at the very least, to entitle him to a full trial of that issue. The Supreme Court accepted and adopted this second contention. It thereupon reversed the order of the Circuit Court and remanded the case with instructions to submit the issue of Wheaton's compliance with the Copyright Statute to a jury for determination.³² The Supreme Court refused, however, to modify in any manner the disposition of the common law copyright issue as decided by the trial court. The vigor with which the Court rejected Wheaton's claims on this aspect of the case has tended to obscure the fact that the decision in no way holds that the trial court had erred in remitting Wheaton to an action at law to establish his common law right. Strictly speaking, the case stands, on this point, solely for the purely jurisdictional proposition that the existence of the common law right in published works was too doubtful, in 1834, to permit a court of equity to enforce it unless and until that right had been acknowledged by a court of common law.³³ Whatever language in the Supreme Court's opinion may be thought to go beyond this narrow point must, in the context of the case, be regarded as dictum.

As the result of his appeal, in fine, Wheaton was left free to relitigate his statutory claim in the Circuit Court; by reason of the undisturbed ruling of the trial court permitting him to begin a new action at law in order to establish his common law right, he was free to relitigate that issue as well. He declined, however, to adopt either course, partly because the expenses of the action had already exhausted his little patrimony,³⁴ but chiefly because the Supreme Court had gone somewhat out of its way, in its decision, to observe that Wheaton could have no valid copyright, in any event, in the opinions of the Justices printed in his *Reports*.³⁵ This meant that he could hold only an emasculated copyright in his books, confined to the headnotes, indexes, digests of counsel's arguments, and the like, which they contained. Because of this ruling, Wheaton's opportunities for further litigation lost whatever charm they might otherwise have held for him. He left the audience chamber

32. It would seem that the Court's insistence upon a jury trial of this fact-issue in an equity case was prompted by distrust of the Circuit Court's capacity for impartiality on remand; no other explanation suggests itself.

33. Indeed, since Peters had not appealed from the trial court's direction on this point, the Supreme Court had no power, upon Wheaton's appeal, to do anything more than reject the latter's contention that the trial court should have taken equitable jurisdiction of the question.

34. Baker, Henry Wheaton, 129-131 (1937).

35. 33 U.S. (8 Pet.) at 668. Of course the observation was perfectly sound as a matter of law: Wheaton was not the author of the Court's opinions and had therefore no standing to exercise an author's rights therein.

of the Court he had served so long the embittered winner of a Pyrrhic victory.³⁶

The court's rejection of Wheaton's plea of common law right, however, was so strongly worded that the case has ever since been cited for the proposition that common law copyrights end at publication. The vigor of the opinion on this topic seems to have been the product of a largely intramural passion. Only four of the six Justices who heard the case³⁷ concurred in the decision rendered by the Court. The remaining two, Justices Thompson and Baldwin, filed dissenting opinions in which they strongly protested that Wheaton should have been granted an injunction on the strength of his common law right alone.³⁸ Time has served only to underline the cogency of their criticisms of the majority opinion, which was written by Mr. Justice McLean.

That politically ambitious, but hardly brilliant, jurist began his discussion of the point in question by reviewing some of the relevant English decisions.³⁹ Dealing first with the case of *Millar v. Taylor*, he noted that it had been decided by a divided court, and proceedly grandly to declare, without supporting demonstrative argument, that Justice Yates's dissenting opinion in that case was, in force of reasoning, the equal (if not the superior) of the opinions of Justices Willes, Aston, and Lord Mansfield. Next, he carefully traced the answers of the eleven common law judges to the questions posed by the House of Lords in *Donaldson v. Beckett* (using Burrow as his source). He deduced that the case had turned upon the effect of the Statute of Anne upon the common law right.⁴⁰ This brought him to a difficulty; for the Statute of Anne had never extended to the American colonies, and therefore could

36. Baker, *supra* note 34, at 130-31. It seems that Wheaton had some real cause for his bitterness, quite apart from his natural disappointment at the outcome. The Circuit Judge, Hopkinson, was a "weak" judge who had felt the need of some reassurance as to the correctness of his decision. Before he rendered his opinion, therefore, he consulted Mr. Justice Story about it, and the latter very foolishly gave him the benefit of some advice. Wheaton somehow got wind of these backstage conferences and, of course, put the worst possible construction upon them after the debacle of his case. He believed that the outcome of his appeal had been pre-arranged by Story in response to Hopkinson's importunities. The result was a severance of Wheaton's earlier friendship for Story. Baker, *supra*, at 127 and 129.

37. Mr. Justice Johnson was absent from the Court throughout the term, and therefore did not participate. 8 Pet. vi note a.

38. Peters printed Justice Thompson's dissent (33 U.S. [8 Pet.] at 668), but blandly omitted Justice Baldwin's. See Kaplan & Brown, Cases on Copyright, Unfair Competition, and Other Topics Bearing on the Protection of Literary, Musical, and Artistic Works, 22 note a (1960).

39. 33 U.S. (8 Pet.) at 654-57.

40. 33 U.S. (8 Pet.) at 656: "It would appear from the points decided that a majority of the judges were in favor of the common law right of authors, but that the same had been taken away by the statute."

not have cut short the common law right here as it had in England.⁴¹ McLean neatly avoided this difficulty by ignoring it. He passed quickly on to quote some highly equivocal dicta from two later English cases,⁴² in order to give a thin color of support to his conclusion that the English courts had always treated the existence of a common law right in published works as doubtful.

The quality of judicial craftsmanship exhibited by this performance was, to put it mildly, something less than masterful. McLean seems to have thought so too, for he abandoned his argument from authority at this point in order to venture into the field of analogical reasoning. He observed, in effect, that copyrights involved a property in ideas,⁴³ and likened them in this respect to patents. No one, he pointed out, had ever suggested that inventors held a common law right to exclude others from practicing their discoveries after the secrets thereof had been disclosed. It would therefore, he argued, be anomalous to the point of injustice to grant such a right to authors in their published (i.e., disclosed) creations.⁴⁴

But, as we have seen, the common law *did* recognize authors' rights after publication. And the anomaly involved in the contrast with inventors' rights was more apparent than real. After all, inventions and writings are different things. An inventor discovers a new way of *doing* something; an author originates a new way of *expressing* something. You can change the form of an invention, and still be using the inventor's discovery: a steamboat (we may suppose) will work just as well whether it is painted yellow, white, or purple,

41. McLean did not state the difficulty; but Mr. Justice Thompson's dissent vigorously supplied the omission: 33 U.S. (8 Pet.) at 687-90.

42. *Beckford v. Hood*, 7 Term Rep. 620, 627, 101 Eng. Rep. 1164, 1167 (K.B. 1798); *University of Cambridge v. Bryer*, 16 East 317, 320, 104 Eng. Rep. 1109, 1111 (K.B. 1812).

43. 33 U.S. (8 Pet.) at 657: "A book is valuable on account of the matter it contains, the ideas it communicates, the instruction or entertainment it affords. Does the author hold a perpetual property in these?" Justice McLean's fondness for stating his conclusions in the form of loaded rhetorical questions like this is perfectly infuriating. How and for what purpose are we invited, here, to evaluate a book? Justice McLean seems to imply that a book is to be valued solely on the basis of what a reader *gets out* of it. But this begs the question. To value a book from the reader's standpoint is to treat the author as the creator of the ideas and sentiments which the book communicates to the reader. The inevitable result is to treat copyright as a property right in the author's *ideas*. But surely, in the context of a discussion of the author's property rights in his creation, a book is to be valued in terms of the labor, craft and skill which the author has *put into* his work. When an author's work is so valued, we treat him (as did the common law) as the creator of a unique *expression* of ideas. The approach dictates the conclusion; but McLean seems totally unconscious of the fact that it is his choice of a starting point that requires justification.

44. 33 U.S. (8 Pet.) at 657-658.

and whether the deck railings are made of wood or of rope. But you cannot change the form of a writing without changing the author's product. A discovery is an *idea*; a writing is an *expression* of an idea. A writing embodies an author's whole personality, and is therefore forever unique; an invention embodies its discoverer's ingenuity, which (though superior to his contemporaries') may be anyone's. We would have steamboats today even if John Fitch had never been born; but without Thoreau we could never have had *Walden*. The common law, therefore, rightly denied to Fitch the exclusive right to build steamboats; for anyone else with the skill and means to conceive and build one had as much right as he to practice the art. But the common law gave (or would have given, if left alone) to Thoreau the exclusive right to market copies of *Walden*, because no one but Thoreau could ever have created that work. Justice McLean's failure to appreciate these distinctions has done our law a grave disservice; the necessary correction is only now beginning to be made.⁴⁵

Justice McLean next turned, in his opinion, to examine the state of the law in America on the question of common law copyright. As if to emphasize the dubious character of his own prior analysis of the English authorities, he began by making the explicit assumption that a common law right in published works *had* existed in the mother country. In America, he observed, the United States, as such, had no common law.⁴⁶ If any common law copyright existed here, therefore, it could only be by virtue of the common law of some particular state. Since Wheaton had brought his action in Pennsylvania, and had first published his work there, it was to the common law of that state that McLean directed his inquiry. No decision, custom, or practice could be found in Pennsylvania to support the existence of the disputed right. Nor could it, in McLean's judgment, be maintained that such a right had come into Pennsylvania as a part of the common law brought into that region by its English settlers; for Penn's colonists brought with them only so much of the common law as was applicable to their new situation. Could it be said (McLean demanded) that the common law copyright, so vigorously disputed in England, was "brought into the wilds of Pennsylvania by its first adventurers? Was it suited to their condition?"⁴⁷

Justice McLean evidently supposed that echo would answer "no" to these rhetorical questions. Yet, as we have seen, the London booksellers had exer-

45. *Mazer v. Stein*, 347 U.S. 201, 217-18 (1954); *Wihtol v. Wells*, 231 F.2d 550, 553 (7th Cir. 1956); *Arnstein v. Edward B. Marks Music Corp.*, 82 F.2d 275 (2d Cir. 1936). The fullest and best discussion of the point is in Alfred Bell & Co. v. Catalda Fine Arts, *ubi supra* note 4.

46. 33 U.S. (8 Pet.) at 658. The point was not a new one. See, e.g., *U.S. v. Worrall*, 2 U.S. (2 Dall.) 384, 394 (C.C. Pa. 1798).

47. 33 U.S. (8 Pet.) at 660.

cised the common law right in England for over a century before any doubts were suggested as to its existence. *Millar v. Taylor* did not create the right; it simply recognized, and gave the force of law to, a long-settled custom of the bookselling trade.⁴⁸ The booksellers' doctrines had preceded William Penn to America by many decades, and had been recognized by statute in Massachusetts ten years before Penn's settlement in the "wilds of Pennsylvania".⁴⁹ Since the right was, at that time, evidently "suited to the condition" of the English settlers of Massachusetts, it is difficult to see why it was not equally "suited to the condition" of the late-arriving English settlers in Pennsylvania. Justice McLean's conclusion, in short, rested upon an imperfect understanding of the historical evidence.⁵⁰

But his reasoning is open to an even more fundamental objection. The basic statement that the first English settlers of America brought with them only so much of the common law as was "suited to their condition", though often repeated by many courts, has long been exposed as a highly euphemistic label for what was, in fact, an entirely arbitrary exercise of judicial taste; under cover of this doctrine, American judges simply "shopped" the English common law, appropriating what they liked and rejecting what displeased them.⁵¹ But the doctrine itself was always, in the last analysis, meaningless as a standard of selection; the key term "suited to the condition of the settlers," had, in this context, no determinable objective significance in judicial usage. The problem, therefore, which arises in any case where the courts have resorted to this expedient formula, is to get behind the language of decision to the real canons that guided the judges' tastes. So far as the *Wheaton* case is concerned, this is a job we shall tackle very shortly; but for the present it suffices to note that the argument from "suitability at the time of settlement" concealed rather than disclosed the Court's real *ratio decidendi*.

The truth of this observation is strengthened when we remind ourselves that the Supreme Court of the United States is not the final arbiter of the scope and content of the common law of any state, save only in those particular areas where that law may come in conflict with federal statutes or treaties, or with the Constitution itself.⁵² The Court's exegesis of Pennsylvania law,

48. Part I of this article, text accompanying notes 43-71.

49. *Id.*, text accompanying notes 99-103.

50. In fairness to McLean, it should be noted that the historical evidence on this point, which we have reviewed, was not as accessible then as it is now.

51. Goebel, *Cases and Materials on the Development of Legal Institutions*, 314 (1946): ". . . the judges . . . proceeded like housewives shopping for dinner to select what seemed tempting in the shelves of the common law market."

52. E.g., *Mynard v. Syracuse R.R. Co.*, 71 N.Y. 180, 185-86 (1877). And see, generally, 21 C.J.S., *Courts*, §205, at 360-64.

therefore, was "final" only for the case in hand; as a precedent, it simply expressed the emphatic belief that, when the Pennsylvania courts came to decide the question, they would share the Supreme Court's evident distaste for the rule of *Millar v. Taylor*.⁵³ The grounds of that distaste, however, remained implicit rather than explicit in the language of Justice McLean's opinion.

Not much additional light is thrown on the problem by McLean's remaining arguments. Wheaton's counsel had strongly pressed the point that the Constitution spoke of "securing" authors' and inventors' rights, rather than of "vesting" them; the lawyers contended that this choice of language indicated a constitutional recognition of the existence of an antecedent right to be "secured".⁵⁴ McLean purported to rebut this argument by reverting to the patent-copyright analogy. The common law (he reasoned) had never recognized an inventor's right of ownership in his publicly disclosed inventions. Therefore, there was no antecedent right in published inventions to be "secured". Consequently, the word "securing" in the constitutional clause did *not* imply the existence of an antecedent right in published intellectual creations of any kind. This conclusion was, McLean contended, buttressed by the language of the first section of the Copyright Law of 1790, which was significantly phrased in the future tense: "... the author . . . *shall have* the sole right and liberty of printing, reprinting, publishing and vending . . ." (Emphasis added.) These facts, he argued, indicated that, at the time the Constitution was adopted and the first federal Copyright Act was passed, no one had supposed that the common law already recognized authors' property rights in their published works.⁵⁵ It should be noted that McLean was not contending that either the Constitution or the statute cut short the common law right. He cited those two sources of law solely as evidence to support his conclusion that there was no common law copyright in published "Writings" for the federal law to supersede.

What this argument overlooked, however, was a point previously made by the decision itself: there is no *federal* common law. Any federal statute on the subject, therefore, would of necessity create a "new" right; for whatever common law right antedated the statute could not be one of federal provenance. This fully accounts for the use of the phrase "shall have" in the Copyright Law of 1790.⁵⁶ As to the use of "securing" in the Constitution, we have seen that the framers of that instrument presupposed the recognized existence of a right of authors to their writings, both published and unpublished,

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

54. 33 U.S. (8 Pet.) at 600-03.

55. 33 U.S. (8 Pet.) at 660-61.

56. Curtis, *A Treatise on the Law of Copyright*, 80-82 (1847).

under the received common law of the several states. They were hopeful that a similar "natural" right of inventors to their discoveries would achieve equal recognition.⁵⁷ Madison's explanation of the patent-copyright clause in the *Federalist* makes this point crystal clear.⁵⁸ Justice McLean cannot have been ignorant of Madison's observation; for the dissenting opinion of Mr. Justice Thompson quoted it in full and stressed its significance upon this very point.⁵⁹ McLean's deliberate disregard of so important a piece of relevant historical evidence indicates the lengths to which he and his brethren of the majority were prepared to go in order to resist recognition of any common law right in published works. But the decision furnishes no valid ground in reason for that resistance.

The constant recurrence of the patent-copyright analogy in the majority opinion suggests, however, that the real basis for the Court's evident antipathy to common law copyrights in published works was founded on the classic misapprehension that copyrights, like patents, are property rights in *ideas*. The then recent steamboat patent war had disclosed the danger of monopoly inherent in the recognition of property rights of that order. This confusion between patents and copyrights was further encouraged by their "marriage" in the Constitution. Copyrights, it would seem, were attained of "monopoly" largely by virtue of their constitutional association with patents.

The dissenting opinion of Justice Thompson suggested an interesting way out of this difficulty. The patent-copyright clause, said he, should be read distributively, as creating two powers rather than one.⁶⁰ So construed, the clause would read: (a) "To promote the Progress of Science . . . , by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings," and (b) "To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries." It then would follow that the laws enacted under these twin powers might well move in different ways to achieve their objectives; certainly the problems created by inventors' discoveries would not have to be confused with, or by, the problems created by authors' writings. Although modern legal scholarship tends to support such a reading of the clause as a correct expression of the framers' purpose,⁶¹ it must be admitted that this point has yet to receive the imprimatur of authoritative judicial recognition.

As we have seen, a patent confers upon the inventor a monopoly in the use of his idea. A copyright, however, does no such thing. It confers upon

57. Part I of this article, text accompanying notes 99-149.

58. *Id.*, text accompanying note 40.

59. 33 U.S. (8 Pet.) at 681 and 685.

60. 33 U.S. (8 Pet.) at 684-85.

61. Taubman, *supra* note 18, at 14-17; Stocking & Watkins, Monopoly and Free Enterprise, 447 note 1 (1951).

the author only the right to prevent copying.⁶² If two authors should independently create an identical work (a situation not altogether impossible in the case of the simpler forms of musical composition, or in the case of such minimally original copyrightable works as directories, street lists, etc.), both authors may copyright their respective works, and neither would have any remedy against the other under the Copyright Law.⁶³ In other words, while a patent deprives the public of the right of independent rediscovery, a copyright does not similarly deprive the public of the right of independent re-origination. Consequently, the justification for treating patents as monopolies does not exist in the case of copyrights. As Judge Learned Hand pointed out in *Arnstein v. Edward B. Marks Music Corp.*:⁶⁴

"Although we once held otherwise in *Hein v. Harris* (1910) 183 F. 107, independent reproduction of a copyrighted . . . work is not infringement; nothing short of plagiarism will serve . . . Our reasoning in *Hein v. Harris* . . . can be defended only in case copyrights, like patents, are monopolies of the contents of the work, as well as of the right to manifold the work itself. That is contrary to the very foundation of copyright law, and was plainly an inadvertence which we now take this occasion to correct."

While Judge Hand thus acknowledged that copyrights are not, like patents, monopolies of *ideas*, his admirable analysis was coupled with a troubling suggestion that "the right to manifold the work" might be regarded as a "monopoly" in itself. According to our definition of "monopoly", this suggestion would be true only if the public had some sort of vested pre-existing right to manifold copies of a work, once it was published. But this is not so. The concept of "the public domain" in the law of intellectual property is not one of vested public right (though the fiction of "dedicatory publication" may give the unwary a contrary impression). It is only a convenient label for the absence of any legally recognized private proprietary right in a given intellectual creation. That absence of private right is a legal vacuum which the law may fill at any time by restoring an old, or creating a new, private

62. 17 U.S.C. §1 indicates what Congress has, by now, come to regard as a "copying." Copying in the statutory sense is to be distinguished from copying in the old common law sense, which is now generally described as "Chinese" copying (i.e., identical reproduction).

63. See, e.g., *Mazer v. Stein*, *supra* note 45, 347 U.S. at 217-18: "Unlike a patent, a copyright gives no exclusive right to the art disclosed; protection is given only to the expression of the idea—not the idea itself . . . The copyright protects originality rather than novelty or invention . . . conferring only the 'sole right of multiplying copies.' Absent copying, there can be no infringement of copyright."

64. *Supra* note 45, 82 F.2d at 275.

right, without thereby working any legal injury to the public.⁶⁵ It can hardly make any difference, in this connection, whether the private right be restored or created by a federal statute, or by the slow growth of a developing doctrine of common law. In neither case does the public lose anything to which it ever had an affirmative legal right.

It might, perhaps, be argued that, when an author makes an unrestricted sale or gift of even one copy of his work, the buyer or donee would acquire (but for the "privilege" conferred on the author by his statutory copyright), the right to make any use of that copy he pleases—including the right to make and sell further copies thereof. The sacrifice of this "right" by the "public" (conceived as a congeries of prospective purchasers or donees of copies of the author's work) would then justify applying the epithet, "monopoly," to copyrights. But such a proposition, it is submitted, simply begs the question. Ownership of a thing does not imply unlimited freedom to use it: by buying a stick I do not acquire the right to hit you over the head with it. Just so, ownership of a copy of a book implies no right to manifold copies thereof, if the exercise of such a claimed "right" would injure a legally recognized right in the author to his original work. The law, in this connection, has long distinguished between the rights attending ownership of a physical copy of a work and those related to the author's property in his intangible copyright in the work itself. The distinction is drawn both by the common law⁶⁶ and by statute.⁶⁷

A humble agricultural analogy, first advanced by Noah Webster,⁶⁸ will serve to drive home the point we are making. The purchaser of a package of seed corn undoubtedly acquires the right to "manifold copies" of his purchase by planting his newly obtained package of seed and harvesting the resulting corn crop. Thereupon he is free to compete with the original vendor in the market for that kind of corn. But he may enjoy that right only by planting, tending and harvesting the seed *in his own field*. He does not, by buying a package of seed, acquire the right to sow it in the vendor's ground and reap his harvest there. Applying the analogy, we may say that an author "grows" his "Writings" in the "field" of his own creative mental powers. His copyright is his exclusive right to market the "crop" of physical copies of the work there "grown." To be sure, the purchaser of a copy of the

65. See, e.g., *Evans v. Jordan*, 13 U.S. (9 Cranch) 199 (1815); *Graham v. Johnston*, 21 Fed. 40, 43 (D. Md. 1884); *Evans v. Eaton*, 8 Fed. Cas. 846, 848-49, No. 4,559 (C.C. Pa. 1876), rev'd on other grounds, 16 U.S. (3 Wheat.) 454 (1818).

66. E.g., *Chamberlain v. Feldman*, 300 N.Y. 135, 89 N.E. 2d 863 (1949).

67. E.g., *Stephens v. Cady*, 55 U.S. (14 How.) 528, 530-32 (1852). The statute, indeed, expressly enforces the distinction: 17 U.S.C. §27.

68. Webster, Letter to John Pickering, December, 1816, Webster, *supra* note 22, at 383-86.

author's work may "grow his own crop" from the "seed" so purchased. That is to say, he may take the ideas communicated by the first author's work and use them in writing his own book (or composing his own sonata, or painting his own picture). But, like the first author, he must grow his own crop in his own field: he should write his own book in his own words, *using his own powers of original expression*. Neither the exclusive right of the farmer to his field nor that of the author to his copyright can justly be called a monopoly; for neither right deprives the purchaser—whether of seed from the farmer's crop, or of a copy of the author's "Writing"—of any right which that purchaser had any just cause to expect to acquire by his purchase.

Thus we see that the fatally attractive analogy between patents and copyrights as monopolies in ideas, which underlay the decision in *Wheaton v. Peters*, does not withstand critical analysis. But that analogy had sufficient plausible force to persuade the several states, for a long period of time, to deny the existence of any common law right to an author's published "Writings". As long as this was true, and as long as the states enforced the resulting common law doctrine of dedicatory publication, the constitutional issue remained quiescent. Today, however, the "dedication" doctrine has been seriously challenged by the rise of a common law theory of "unfair competition", which, in the form of a prohibition against "misappropriation" of the commercially exploited creations of another, is rapidly taking on the exact dimensions of the common law copyright in published works formulated and described by the majority opinions in *Millar v. Taylor*. It behooves us, therefore, to examine this development in some detail.

C. UNFAIR COMPETITION AND THE RENASCENCE OF AUTHORS' COMMON LAW RIGHTS IN PUBLISHED WORKS: THE CONSTITUTIONAL LIMITS OF FEDERAL DIVESTITIVE POWER

The doctrine of dedicatory publication was never absolute; some common law rights of authors were always recognized as continuing after publication.⁶⁹ This was true, for example, of an author's right to credit for the authorship of his work, which could only be lost by contractual waiver.⁷⁰ So, too, an author retained, after publication, the right to prevent distorted versions of his

69. See *Warner Bros. Pictures v. Columbia Broadcasting System*, 102 F. Supp. 141, at 146-47 (S.D. Cal. 1951), *aff'd in part and rev'd in part* (on other grounds), 216 F.2d 945 (9th Cir. 1945).

70. *Jones v. Am. Law Book Co.*, 125 App. Div. 519, 109 N.Y.S. 706 (1908); *Hackett v. Walter*, 80 Misc. 340, 142 N.Y.S. 209 (1913); *Clemens v. Press Pub. Co.*, 67 Misc. 183, 122 N.Y.S. 206 (1910). And see *Granz v. Harris*, 198 F.2d 585 (2d Cir. 1952); *Vargas v. Esquire*, 164 F.2d 522 (7th Cir. 1947).

work from appearing under his name.⁷¹ Many interesting theories have been elaborated to reconcile these legal phenomena with the rationale of the doctrine of dedicatory publication. Thus, for example, it has been suggested that such post-publication rights of authors are "moral rights", incident to authors' personalities, rather than rights of property in their works.⁷² A recent formulation advances the somewhat indigestible proposition that the common law protects, after publication, only "non-writing elements" in what are (in the constitutional sense) "Writings."⁷³

The rock upon which all such theories founder is the decision of the United States Supreme Court in the famous case of *International News Service v. Associated Press*.⁷⁴ The facts of that case may be briefly restated. The parties to the action (to whom we shall refer as "INS" and "AP", respectively) operated rival news-gathering services. INS had been "taking a free ride" on AP's work by pirating AP's news stories, which it got hold of in three different ways: (1) by bribing disloyal AP employees; (2) by encouraging newspapers that were clients of both services to give the stories to INS (which was a violation of such newspapers' contractual obligations to AP); and (3) by taking the stories from published bulletins, or from early editions, printed by AP's Eastern newspaper-members. INS telegraphed the stories so obtained to its own Western clients, either verbatim or in manifest paraphrase. Because of time differentials, INS's Western clients were often able to publish AP's stories before AP's own Western members did so. AP sued to enjoin INS from misappropriating its stories by all three of the methods above described. So far as the first two methods of acquiring the stories were concerned, AP encountered no difficulty in securing judicial vindication of its rights. The District Court was prompt to enjoin INS from suborning disloyal employees and clients of AP in order to get improper access to AP's stories.⁷⁵

But AP had a much harder row to hoe when it came to enjoining the third method by which INS had been "lifting" the news stories in question.

71. *Granz v. Harris*, *supra* note 70; *Drummond v. Altemus*, 60 Fed. 338 (E.D. Pa. 1894). And see *Ettore v. Philco Television Broadcasting Corp.*, 229 F.2d 481 (3d Cir.), cert. denied, 351 U.S. 926 (1956).

72. Cf. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 Harv. L. Rev. 554 (1940). But see *Crimi v. Rutgers Presbyterian Church*, 194 Misc. 570, 573, 89 N.Y.S. 2d 813, 816 (1949), where the "moral right" of an artist to prevent distortion of his work is described as a "proprietary interest" in one breath, and as a right related to his "personality" in the next.

73. *Kalodner & Vance, The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 Harv. L. Rev. 1079, *passim*, but especially at 1085-91 (1959).

74. 248 U.S. 215 (1918).

75. 240 Fed. 983 (S.D.N.Y. 1917).

The difficulty on this point stemmed from the fact that AP's Eastern members had published those stories without the statutory notice of copyright. INS, therefore, claimed that it was simply exercising its "right" to reprint "Writings" that had been dedicatorily published and had thus fallen into the public domain. The District Court found this claim to be just and declined, accordingly, to enjoin INS from continuing the practice in question.⁷⁶ AP appealed from this refusal, contending that INS's copying of its published stories should have been enjoined, like the rest of its conduct, as "unfair competition". The Circuit Court of Appeals sustained this contention, and directed the District Court to modify and broaden its injunction accordingly.⁷⁷ INS appealed from this decision to the Supreme Court, but in vain; the Court of Appeals' ruling was there affirmed, Justice Brandeis alone dissenting.⁷⁸

Justice Pitney wrote the majority opinion. Taking the traditional equity view that any legal right which has *commercial value* is a "property" right, he held that AP had, as against INS, a "quasi-property" in its news stories, even after publication, which endured for as long as those stories had commercial value as news. That right, he maintained, could be protected from unauthorized misappropriation by INS for competitive purposes during the commercially valuable (newsworthy) life of the stories.⁷⁹ This reasoning is instructively to be contrasted with that of the concurring opinion of Justice Holmes (in which Justice McKenna joined).⁸⁰ Holmes took the traditional common law position that it is the owner's *right to exclude* all others from enjoyment of a thing which constitutes the essence of any legal right of "property".⁸¹ From this point of view he agreed with INS that AP had lost its "property" in its news stories by publication. But it had not, he maintained, thereby lost its right to credit for its authorship of those stories. Since INS was transmitting AP's stories to its clients without accreditation to AP, it was perpetrating a fraud on the public and a personal injury to AP which equity could enjoin. Holmes would have limited affirmance of the Circuit Court's decision to this narrow ground. The majority of the Court, however, by placing its decision on a broader basis, clearly rejected Holmes' restrictive solution.

76. *Id.*

77. 245 Fed. 244 (2d Cir. 1917).

78. Justice Clarke did not participate.

79. 248 U.S. at 236-46.

80. 248 U.S. at 234-46, esp. at 236.

81. See also Holmes' concurring opinion in *White-Smith Mus. Pub. Co. v. Apollo Co.*, 209 U.S. 1, 18 (1908); and Holmes, *The Common Law*, 219-220 (1881).

It is this circumstance which makes it impossible to accept as meaningful the distinctions between authors' "personal" rights and their "property" rights, or between "Writings" and "non-writing elements," which have been offered as explanations for the survival after publication of certain kinds of authors' rights at common law. It was AP's *stories*, not some esoteric "non-writing" abstractions from them, which INS was held to have wrongfully appropriated. It was AP's *property* right in those stories which INS was held to have infringed, not just a personal right to accreditation. The Court's description of the right in question as a mere "quasi-property" was evidently coined in the vain hope of appeasing Holmes' objections to the Court's reasoning. He was not—and we should not be—deceived by so artless a label. The right which the court enforced was clearly regarded as a property right in AP's stories.⁸² That right, moreover, was not derived from the copyright statute. It was a right created by judge-made law; hence, it was a common law property right.

In 1918, when the Supreme Court decided the *INS* case, the doctrine of *Swift v. Tyson*⁸³ was still in force. Under that doctrine, the Supreme Court had power to evolve new principles of common law without too much concern for state court precedents. Twenty years later, in 1938, *Erie Railroad v. Tompkins*⁸⁴ reversed the doctrine of the *Tyson* case, and restored to the states exclusive powers of ultimate control over the evolution of the major part of the common law in America. During that interval, the Supreme Court had occasion to speak twice more on the subject of "unfair competition" by "misappropriation" of others' intellectually-created properties. In *A.L.A. Schechter Poultry Co. v. U.S.*,⁸⁵ it acknowledged, by way of dictum, that it had, indeed, intentionally expanded the prior limits of the law of unfair competition in the *INS* case. And in *Hurn v. Oursler*⁸⁶ it extended the doctrine of "pendent jurisdiction" in order to enable a federal court to adjudicate "unfair competition" claims arising out of the same facts as a pleaded claim of infringement of statutory copyright. The Court recognized, in so ruling, that the two claims it thus held to be concurrently justiciable constituted, essentially, a single cause of action. Apparently the only difference between an author's "unfair competition" right and his statutory copyright, as the Court

82. See *Norwich Pharmacal Co. v. Sterling Drugs, Inc.*, 271 F.2d 569, 571 (2d Cir. 1959), cert. denied, 362 U.S. 919 (1960); but cf. *Speedy Products, Inc. v. Dri Mark Products, Inc.*, 271 F.2d 646, 649 (2d Cir. 1959).

83. 41 U.S. (16 Pet.) 1 (1842).

84. 304 U.S. 64 (1938).

85. 295 U.S. 495, 531-32 (1935).

86. 289 U.S. 238 (1933).

envisaged both in the *Hurn* case, was that the former arose under the common law, while the latter was the creature of the federal statute.⁸⁷

The *Hurn* doctrine was reaffirmed (though not in a copyright case) shortly after *Erie* was decided.⁸⁸ Ten years later, Congress enacted the doctrine as statutory law, in a section of the Judiciary Code.⁸⁹ By that time it had long been settled that "unfair competition" was the creature of state common law.⁹⁰

87. The potential likeness of such a form of "unfair competition" to statutory copyright protection had been noted even before the *INS* case was decided. *West Pub. Co. v. Edward Thompson Co.*, 169 Fed. 833, 853 (E.D.N.Y. 1909), modified on other grounds, 176 Fed. 833 (2d Cir. 1910). Today the factual identity of such "unfair competition" claims with both common law and statutory copyright claims, respectively, has been held to preclude pleading the "unfair competition" claim separately from a claim of infringement of either form of copyright. *Harms, Inc. v. Tops Music Enterprises*, 160 F. Supp. 77, 81-82 (S.D. Cal. 1958); *Fabrics by Bus Davies, Inc. v. Kay Windsor Frocks, Inc.*, 25 Misc. 2d 48, 202 N.Y.S. 2d 467 (1960). This does not mean, however, that a plaintiff may not plead his grievance as a claim of "unfair competition" when he might have pleaded the same facts as a claim for copyright infringement but chose not to do so. *Swanson Mfg. Co. v. Feinberg-Henry Mfg. Co.*, 147 F.2d 500, 503-04 (2d Cir. 1945). Nor does it mean that a claim for "misappropriation" by "unfair competition" may not be pleaded separately from a claim for copyright infringement where the underlying facts are not identical, even though they may be closely related. Cf. *Nikanov v. Simon & Schuster*, 144 F. Supp. 375 (S.D.N.Y. 1956), aff'd (but only as a copyright infringement action), 246 F.2d 501 (2d Cir. 1957). The significance of the *Harms, Inc.* and *Bus Davies* cases, *supra*, is simply that the courts will be alert to see to it that the existence of two concurrent remedies for the same wrong will not be made a pretext for awarding double recoveries to the injured author.

88. *Armstrong P. & V. Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938).

89. 28 U.S.C. §1338(b).

90. *Pecheur Lozengé Co. v. National Candy Co.*, 315 U.S. 666 (1942); *Fashion Originators Guild v. F.T.C.*, 312 U.S. 457, 468 (1941). There is a body of largely academic opinion favoring the proposition that §44 of the Lanham Trademark Act of 1946 (15 U.S.C. §1126) would support judicial development of a general "federal common law" of unfair competition. 1 Moore, *Federal Practice* (2d ed.) §0.326 (1959); Oppenheim, *Unfair Trade Practices*, 86-91 (1950). The courts today do not favor this suggestion. *Reachi v. Edmond*, 277 F.2d 850, 854 (9th Cir. 1960); *Royal Lace Paper Works v. Pest-Guard Products*, 240 F.2d 814 (5th Cir. 1957); *Maternally Yours v. Your Maternity Shop*, 234 F.2d 538, 540-41 note 1 (2d Cir. 1956); *L'Aiglon Apparel v. Lana Lobell, Inc.*, 214 F.2d 649, 651-54 (3d Cir. 1954); *American Auto Assoc. v. Spiegel*, 205 F.2d 771 (2d Cir.), cert. denied, 346 U.S. 887 (1953). The fatal weakness of the suggestion lies in the implausibility of its basic assumption: that Congress ever intended to accomplish so far-reaching a result by the statutory provisions in question. Kaplan & Brown, *supra* note 38, at 493; Note, *Developments in the Law of Trade Marks and Unfair Competition*, 68 Harv. L. Rev. 814, 881 (1955). For a kindred theory which, though based on a different federal statute, suffers from the same essential flaw, see Bunn, *The National Law of Unfair Competition*, 62 Harv. L. Rev. 987 (1949); but cf. *National*

Between them, therefore, Congress and the Supreme Court have recognized (though indirectly) the power of the states to protect authors' common law property rights in published literary and artistic works concurrently with the similar protections given to such works by the federal copyright statute.

The lower federal courts, however, have been visibly reluctant to explore the trail thus blazed by the Supreme Court.⁹¹ Conversely, the state courts (particularly in New York) have been far from averse to doing so. Thus, for example, Judge Hand's early attempt to confine the rule of the *INS* case to news reports alone⁹² has been completely rejected in New York; it is clear that, in that state at least, the *INS* doctrine extends to all forms of commercially marketed literary and artistic property.⁹³ A closer look at the "misappropriation" doctrine, as developed in New York, may serve to bring our main problem into clearer focus.

The most striking feature of this relatively new form of "unfair competition"⁹⁴ is the virtual identity of the right it enforces with the old, eighteenth-century conception of a common law copyright in published works which Blackstone had set out in the *Commentaries* and Justices Willes, Aston,

Fruit Product Co. v. Dwinell-Wright Co., 47 F. Supp. 499, 504 (D. Mass. 1942), aff'd (on an appeal confined to other grounds), 140 F.2d 618 (1st Cir. 1944). Of course it is not to be doubted that Congress has *power*, under the commerce clause, to enact a federal law of unfair competition that will be preemptive as to all transactions affecting interstate commerce. The point here made is simply that it has not yet done so.

91. See, for example: *Harms, Inc. v. Tops Music Enterprises*, *supra* note 87; *Continental Casualty Co. v. Beardsley*, 151 F. Supp. 28, 32-35 (S.D.N.Y. 1957), aff'd, 253 F.2d 702 (2d Cir.), cert. denied, 358 U.S. 816 (1958); *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952); *R. C. A. Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir.), cert. denied, 311 U.S. 712 (1940); *Cheney Bros. v. Doris Silk Corp.*, 35 F.2d 279 (2d Cir. 1929), cert. denied, 281 U.S. 728 (1930).

92. See last three cases cited *supra* note 91.

93. E.g.: *Dior v. Milton*, 9 Misc. 2d 425, 155 N.Y.S. 2d 443, aff'd, 2 App. Div. 2d 878, 156 N.Y.S. 2d 996 (1956); *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S. 2d 483 (1950), aff'd, 279 App. Div. 632, 107 N.Y.S. 2d 795 (1951).

94. "Misappropriation" of rights springing *directly* from the authorship of literary or artistic property is one of many interrelated forms of "unfair competition." Other relevant forms include: (1) wrongful interference with rights created by *contracts* which have literary or artistic property as their subject-matter (e.g., *Manners v. Morosco*, 252 U.S. 317 [1920]; *Underhill v. Schenck*, 238 N.Y. 7, 143 N.E. 773 [1924]; *Fisher v. Star Co.*, 231 N.Y. 414, 132 N.E. 133 [1921]); and (2) cases in which the wrong-doer not only appropriates the author's work, but also attempts to palm it off as his own (e.g., *Flint v. Oleet Jewelry Mfg. Co.*, 133 F. Supp. 459 [S.D.N.Y. 1955]; *Chaplin v. Amador*, 93 Cal. App. 358, 269 P. 544 [1928]).

and Lord Mansfield had defended with such vigor and brilliance in *Millar v. Taylor*.⁹⁵ Thus, in the first place, the modern common law right, like its ancient and ill-starred counterpart, is rooted in authorship. No interests in artistic property other than those derived from the author are protected.⁹⁶ Secondly, like the old common law right, the new "misappropriation" doctrine is keyed to originality; works lacking this quality are beyond the protective scope of the doctrine.⁹⁷ Thirdly, as we have already seen, the author's modern right, like the old one, is a right of *property*.⁹⁸ Fourth, again like the old right, the new one protects the author and his successors only for as long as they actively market the work commercially: although the owner will be protected against copying even by those who do not directly compete with him in his chosen market,⁹⁹ the protection endures only for the commercially exploited life of his work.¹⁰⁰ Judge Hand to the contrary notwithstanding,¹⁰¹ this is a very different thing from perpetual protection.¹⁰² Because of this limitation, the new common law right does not include (as the statutory right does) the power to withhold a work, once published, from the market. Finally, the modern right is severely restricted to the protection of the author's expressions as opposed to his mere ideas.¹⁰³ We have previously had occasion to note that the old common law copyright in published works was strictly limited in this respect, so as to amount to little more than a right against identical

95. Part I of this article, text accompanying notes 43-71.

96. *Hebrew Pub. Co. v. Scharfstein*, 288 N.Y. 374, 43 N.E. 2d 449 (1942).

97. *Mavco, Inc. v. Hampden Sales Assoc.*, 273 App. Div. 297, 77 N.Y.S. 2d 510 (1948) (protection denied to woman's compact shaped like a jewel, for lack of originality); *American Merri-Lei Corp. v. Jet Party Favors*, 123 N.Y.S. 2d 136 (1953) (like ruling as to paper Hallowe'en witch's hat).

98. Text accompanying notes 74-82 *supra*.

99. *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, *supra* note 93, 199 Misc. at 795-96, 101 N.Y.S. 2d at 491-93.

100. *Gantz v. Hercules Pub. Corp.*, 15 Misc. 2d 1061, 1062-63, 182 N.Y.S. 2d 450, 452 (1959); cf. *International News Service v. Associated Press*, *supra* note 74 (protection given only during newsworthy life of plaintiff's news stories). The rule is a heritage from the origins of "unfair competition" in the common law of trade marks. *Golenpaul v. Rosett*, 174 Misc. 114, 18 N.Y.S. 2d 889 (1940). As to the old common law right, see Part I of this article, text accompanying notes 52-57.

101. *Cheney Bros. v. Doris Silk Co.*, *supra* note 91, 35 F.2d at 279-80.

102. Cf. *Warner-Lambert Pharmaceutical Co., Inc. v. John J. Reynolds, Inc.*, 178 F. Supp. 655, 661-67 (S.D.N.Y. 1959), *aff'd*, 280 F.2d 197 (2d Cir. 1960).

103. *Pocket Books v. Meyers*, 292 N.Y. 58, 54 N.E. 2d 6 (1944); *Germanow v. Standard U. W. Watch Crystals*, 283 N.Y. 1, 27 N.E. 2d 212 (1941); *Archie Comic Pub., Inc. v. Am. News Co.*, 204 Misc. 1060, 125 N.Y.S. 2d 919 (1953), *aff'd*, 283 App. Div. 868, 129 N.Y.S. 2d 915 (1954).

copying.¹⁰⁴ That the same observation is true of the modern doctrine appears from the recently decided case of *Miller v. Universal Pictures Co., Inc.*¹⁰⁵

In that case, the plaintiff was the widow and executrix of the late band leader, Glenn Miller. She had licensed the defendant, Universal Pictures Co., to make a movie based on Miller's life: "The Glenn Miller Story." Universal had devoted considerable pains to the creation of an "authentic" sound track for the film; it had hired skilled instrumentalists to play hit tunes that were associated with Miller's name in the public mind; it had used Miller's arrangements of those tunes; and it had spent a great deal of time, effort and money to make the resulting musical sound as close an approximation of the sound of Miller's performances as possible. In all of this, Universal acted with the knowledge, permission and authority of Mrs. Miller. But it also granted, without such authority, a gratuitous license to its parent company, Decca Records, to make and sell commercial phonograph records made from the sound track so created. Miller had, during his lifetime, granted to RCA the exclusive right to make and sell recordings of his performances. Mrs. Miller had several times renewed this license, and RCA's records of Miller's renditions were still very much in demand in record stores all over the country. Mrs. Miller brought suit against Universal and Decca, claiming that the Decca records of Universal's sound track constituted such a "misappropriation" of Miller's performances as to render these two defendants liable for unfair competition.

It should be emphasized that no question was raised as to Universal's and Decca's rights to record the *music* used in these performances. Instead, the charge of "misappropriation" centered upon the performing *style*—the manner in which the recorded music was played. The "work" involved was not the music played, but the "Miller sound" achieved by the players. The trial court accepted Mrs. Miller's contentions: (1) that Miller was the "author" of the "Miller sound;" (2) that that "work" was original; (3) that Universal had not been licensed to copy the "work" on commercial phonograph records; and (4) that, by doing so, it had "misappropriated" the "work" and was guilty of "unfair competition". The appellate court, however, reversed this decision. It rejected the theory that Decca's records of Universal's independent re-creations of the "Miller sound" constituted a misappropriation of Miller's performances. Had Universal used Miller's own recordings on its sound track, it would clearly have been using his actual artistic work—his "expression"

104. Part I of this article, text accompanying notes 64-69.

105. 11 App. Div. 2d 47, 201 N.Y.S. 2d 632 (1960) (rev'g 18 Misc. 2d 626, 188 N.Y.S. 2d 386 [1959]), modified, 13 App. Div. 2d 473, 214 N.Y.S. 2d 645, aff'd, 10 N.Y. 2d 972 (N.Y. Ct. of Appeals 1961).

of his performing artist's "idea." The appellate court made it clear that, in such a case, Universal and Decca would have committed an actionable misappropriation of Miller's work. But it would seem that by creating its *own* renditions of the sound of Miller's performances, Universal had taken only the "idea" of Miller's work; the resulting "expression" was Universal's. In other words, the "Miller sound", divorced from Miller's own recordings, was an artistic effect, which resided in the realm of "idea" rather than "expression". Consequently, Universal was legally without fault in giving Decca the recording rights in the resulting performances of *Universal's* "expression" of that "idea." Since the Decca records were marketed as what they were—sound track recordings of imitations of Miller's performances—there was no element of deliberately created customer-confusion, or "palming off," justifying a charge of unfair competition of another kind than "misappropriation."¹⁰⁶ Consequently, the case was dismissed by the appellate courts.¹⁰⁷

These, then, are the elements of "misappropriation" under the New York law of "unfair competition": (1) *authorship* by the plaintiff or his predecessor in title of (2) an *original* work, (3) which has been *appropriated* by another to his own use, (4) during the *time* the plaintiff was himself marketing the work commercially, provided (5) that the appropriator took the author's actual *expression*, not the mere *idea* which his work expressed.

The lower federal courts, however, have exhibited a continued reluctance to accept and develop the *INS* doctrine as the New York courts have done. The federal judges' present battle line is drawn on the position that "something more" than the above-stated elements of "mere" misappropriation must be involved in order to justify granting any relief to an author for piracy, under this new common law theory. The requisite "something more" may take any number of forms. Frequently mentioned in this connection are such added elements as "passing off," wrongful appropriation of the author's *reputation* (as well as his work), or unjustified interference with contract rights relating to the author's work.¹⁰⁸ This position is plausibly (though negatively) supported by the circumstance that no New York court (with one

106. Had such an element been present, liability would certainly have been imposed. *Flint v. Oleet Jewelry Mfg. Co.*, *supra* note 94; *Chaplin v. Amador*, *supra* note 94.

107. The Appellate Division offered to remand the case for a determination whether Universal should be required, under its contract with Mrs. Miller, to pay her a royalty for the records of the sound track so made; but she declined the offer, and the court thereupon dismissed her suit. 13 App. Div. 2d 473, 214 N.Y.S. 2d 645 (1961). The Court of Appeals affirmed upon the Appellate Division's opinion, but only by a 4-3 vote. 132 U.S.P.Q. 77, *supra* note 105.

108. E.g., *Harms, Inc. v. Tops Music Enterprises*, *supra* note 87; *Continental Casualty Co. v. Beardsley*, *supra* note 91, 151 F. Supp. at 44.

obscure exception)¹⁰⁹ has awarded recovery, in any case yet decided, where the facts indisputably present a picture of "mere" misappropriation unadulterated by the presence of one or more such other elements.¹¹⁰ The language of numerous decisions, however, leaves little room to doubt the probability that the New York courts will, today, grant recovery in a "pure" case of misappropriation, if and when one comes before them.¹¹¹ The incautious assertion made by one federal judge, that those courts have, on the contrary, refused recovery for "mere" misappropriation,¹¹² must be marked with an emphatic *dubitation*.¹¹³

The reluctance of the lower federal courts to go along with the clear trend of New York decisions on this matter seems to stem from their unwillingness to recognize a potentially vital common law competitor in a field which the federal copyright statutes have heretofore (by historical accident)

109. *Frank M. Shaw, Inc. v. C. H. Cleworth & Associates, Inc.*, 110 U.S.P.Q. 394 (N.Y. Sup. Ct. 1956). The doctrine of recovery for "misappropriation" alone, without more, was recently asserted in the clearest terms. *Karr v. Leeds Mus. Corp.*, 126 U.S.P.Q. 27 (N.Y. Sup. Ct. 1960). Unfortunately, since the facts of that case were not described in the court's opinion, we cannot be sure that the doctrine was indisputably so applied.

110. *Continental Casualty Co. v. Beardsley*, *ubi supra* note 91.

111. E.g., *Electrolux v. Val-Worth, Inc.*, 6 N.Y. 2d 556, 567, 161 N.E. 2d 197, 203 (1959): "The principle that one may not misappropriate the results of the skill, expenditures and labor of a competitor has . . . often been implemented in our courts." See also: *Dior v. Milton*, *supra* note 93, 9 Misc. 2d at 431-35, 155 N.Y.S. 2d at 452-55; *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, *supra* note 93, 199 Misc. at 792-802, 101 N.Y.S. 2d at 488-98; *Karr v. Leeds Mus. Corp.*, *supra* note 109.

112. District Judge Palmieri in *Continental Casualty Co. v. Beardsley*, *ubi supra* note 108.

113. See note 111, *supra*. With one exception, every single New York decision cited by Judge Palmieri in the *Continental Casualty Co.* case (*ubi supra* note 108), to support the proposition that the New York courts refuse recovery for "mere" misappropriation (151 F. Supp. at 44 note 6), is susceptible of another construction. The cases so cited (other than the exception) are those mentioned *supra* in notes 96, 97 and 103. Cf. the text accompanying those notes for the rules of law upon which recovery was, in fact, denied in those cases. The solitary exception is *United Merchants & Manufacturers v. Bromley Fabrics*, 3 Misc. 2d 179, 148 N.Y.S. 2d 22 (1955). Judge Palmieri's reference to that decision in the *Continental Casualty* case is the first and only time it has been honored by citation since it was decided. Our equity jurisprudence, in submission, was not well served by a decision which permitted what was concededly a "sharp practice" (using plaintiff's fabrics as samples from which defendant sold its own copies of plaintiff's designs). Other courts have been more astute to forbid such conduct. Cf. *L'Aiglon Apparel v. Lana Lobell, Inc.*, *supra* note 90; *Electrolux v. Val-Worth, Inc.*, *supra* note 111. Under the circumstances, it is respectfully submitted that Judge Palmieri's authorities do not convincingly support his conclusion.

been left to occupy exclusively. If we may venture onto the thin ice of "reading between the lines" of their opinions, we may hazard a guess that this unwillingness stems, at least in part, from a sense of constitutional unease about the result. Our problem, then, is to determine whether the divestitive powers of Congress under the constitutional clause may validly be deemed to authorize federal preemption of the "misappropriation" doctrine as presently limited and defined.

We have heretofore shown that the Constitution itself was not intended directly to forbid concurrent state and federal protections for the "Writings" of "authors". The power of Congress, under the patent-copyright clause, to cut short or preempt state common law protections for intellectual properties, is permissive rather than mandatory (i.e., Congress may, not must, exercise it). It stems by implication from the purposive phrase, "To promote the Progress of Science and useful Arts." Under the power so derived, it has been settled that the "Discoveries" of "Inventors" may be dedicated to ultimate public use by federal statutes. This is so because inventions are *ideas*, and are legally protected *as such* by our patent laws. The proposition that the dedication of ideas to public use will promote the progress of knowledge in general ("Science") is too self-evident to be open to doubt. But "Writings", although they *express* ideas, are not protected *as ideas* by our copyright laws; and the "misappropriation" doctrine does not, as we have seen, threaten so to protect them. All that is involved in the "misappropriation" cases is an author's right to protect his original *expressions* from unauthorized exact reduplication during the time he or his successors in interest are commercially marketing the work. Does this distinction make a difference in the constitutional applicability of the federal dedicatory power? It is submitted that it does.

All sides agree that, when an "Author" publishes a "Writing", he dedicates his ideas to public use, subject only to such limitations upon the public use of those ideas as Congress may, "for limited Times," impose for his benefit by the copyright statutes. Thus the public would be free, but for the statute, to make new versions of an author's published "Writings": it could, in other words, at and from the moment of publication, translate, abridge, dramatize, or otherwise change the form of the "Writings", for in doing so it would be creating a "new" work.¹¹⁴ No case of "misappropriation" has been found which would alter this state of things; all that the doctrine protects is the exclusive right of an author to multiply *identical* copies (or blatant paraphrases) of his work.¹¹⁵ In other words, all that is involved in the "misappropriation"

114. Cf. 17 U.S.C. §7.

115. Compare, e.g., *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, *supra* note 93 (involving "Chinese copies" of plaintiff's broadcast performances), with *Miller v. Universal Pictures Co. Inc.*, *supra* note 105.

cases is the right to reiterate the author's original expression itself. To justify federal dedication of a right so limited would require a determination that the "Progress of Science" would be served thereby. But just here is the difficulty. Such a dedication might, broadly speaking, "promote Science." But that is not the constitutional test. It must "promote the *Progress of Science*." The author's ideas being dedicated to public use, can we say that mere parrot-like reiterations of the identical forms of expression in which those ideas were originally published, will *advance* our knowledge ("Science") to any degree? Surely not: they leave our knowledge just where it was. Consequently, it is submitted, a federal statute investing the public not only with the right freely to use an author's ideas, but also with the ultimate right to reiterate exactly an author's once-published expressions could not, in the latter aspect, be said to "promote the Progress of Science."

It might, perhaps, be argued on the contrary that published reiterations of old expressions serve to give currency to the ideas therein expressed; that they bring those ideas to the attention of a wider circle of minds until, at last, they reach a mind capable of improving upon them in a new work; and that, in consequence, they *indirectly* promote the advancement of knowledge. We would thus be invited to include not only knowledge, but its commercial dissemination as well, within the constitutional concept of the "Progress of Science." But here we reach another difficulty. Congress has other constitutional sources of power to regulate the dissemination of knowledge: for example, the commerce power, the post-office power, and the power to lay taxes for the "general welfare" (whence comes federal aid to education).¹¹⁶ The power "to promote the Progress of Science," however, is limited to a specific means of Congressional expression: "by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries." The necessity for subjecting Congressional power over the dissemination of knowledge to this limitation is not readily apparent. Indeed, the Supreme Court has flatly declared that the patent-copyright clause ". . . confers no power on Congress to regulate commerce . . ." ¹¹⁷ If that is so, the commercial dissemination of published expressions is plainly beyond the scope of application of the dedicatory powers conferred by that clause. These circumstances, it is submitted, indicate the advisability of confining the meaning of the term "Progress of Science" to the creation of *new* items of intellectual property. The temptation speciously to expand that term to include the repetitious dissemination of old expressions is one that we had better, in logic and discretion, resist.

The distinction between "idea" and "expression," however, is never an easy one to draw, and is particularly difficult to apply in this context. Thus,

116. U.S. Constitution, Art. I, §8, Clauses 1, 3, and 7.

117. *Brown v. Duchesne*, 60 U.S. (19 How.) 183, 195 (1857).

for example, an inventor's discovery is, as we have seen, an "idea;" but, when realized in tangible form, it may also be said to be an "expression." Perhaps we may draw the distinction, in this area, in terms of the developing dichotomy between the "functional" features of the invention, which the federal power may dedicate, as opposed to its "non-functional features," which the common law of unfair competition is increasingly coming to protect, both concurrently with, and after, federal patent protection.¹¹⁸ "Functional features," as is well known, are the operative elements of an invention—the things that make it "tick." Like business forms or maps, they are "expressions" in which their creators' "ideas" are almost inextricably bound up.¹¹⁹ Conversely, "non-functional features" are what is left of the inventor's realized invention when all the "functional" features are stripped away—items of mere trade dress, or of extraneous decoration, which are clearly inessential to the operation of the invention. They are, perhaps, "expressions" of *non-inventive* ideas, which, if original, may be protected at common law against "misappropriation."

A similar distinction, it is submitted, may be drawn in the copyright area in terms of an expanded doctrine of "fair use", as opposed to the kind of uncreative, literal imitation forbidden by the "misappropriation" doctrine. Some authorities, it is true, seem to equate "fair use" with the right to appropriate an author's "ideas," as opposed to his "expressions."¹²⁰ But fair use goes further when it permits fair quotation: here the expression itself, as well as the idea, is licitly appropriated to some extent. The permissible character of the appropriation seems to depend on a number of variable factors such as the quantity of material involved in the appropriation, the significant importance and relative originality of the passage appropriated, the manner in which the appropriated expression is used, the effect of the appropriation on the commercial market of the original author's work, the appropriator's intent, and the like.¹²¹ In broad terms, however, the "use" may be said to be "fair" if the appropriation is reasonably necessary for the creation of a genuinely

118. E.g., *American Safety Table Co. v. Schreiber*, 269 F.2d 255 (2d Cir.), cert. denied, 361 U.S. 915 (1959), decree modified, 287 F.2d 417 (2d Cir. 1961).

119. *Continental Casualty Co. v. Beardsley*, *supra* note 91, 253 F.2d at 706; *Amsterdam v. Triangle Pub., Inc.*, *supra* note 24, 93 F. Supp. at 82, 189 F.2d at 106 (but cf. 17 U.S.C. §7).

120. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir.), cert. denied, 298 U.S. 669 (1936).

121. Kaplan & Brown, *supra* note 38, at 309-10; Latman, *Fair Use of Copyrighted Works*, Copyright Law Revision Studies Prepared for the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary, Study No. 14, at pp. 5-7 (U.S. Gov't Print'g Off. 1960).

"new" work. The copyright statute, however, expressly prohibits certain such reasonably necessary appropriations by including within the author's exclusive statutory rights the power to control new "versions" of his copyrighted works.¹²² If, as has been suggested,¹²³ the root justification for the doctrine of "fair use" is that it serves to effectuate the constitutional purpose "to promote the Progress of Science and useful Arts," then surely new "versions" of a published work would, to the extent that they appropriate from the "expression" of the original, be regarded as "fair uses" but for the statute.¹²⁴ After all, an "expression", when placed in a new setting, often achieves a new meaning in its new context. It embodies, then, a new "idea". The "Progress of Science", therefore, may well be deemed to be subserved by requiring authors ultimately to dedicate their works to "fair use" in this enlarged sense.¹²⁵

But the developing state common law of "unfair competition", as its very name implies, simply affords protection to authors' and inventors' works against uses that are *not* fair. It forbids essentially uncreative appropriations of authors' expressions, and purely imitative appropriations of the non-functional features of inventors' discoveries. In both such cases, it operates in fields which, it is submitted, are beyond the scope of the dedicatory powers of Congress under the patent-copyright clause, limited as those powers are to the realization of the objectives stated in the opening, purposive phrase of that clause.¹²⁶

122. 17 U.S.C. §1(b). Cf. 17 U.S.C. §7.

123. *Mathews Conveyor Co. v. Palmer-Bee Co.*, 133 F.2d 73, 85 (6th Cir. 1943).

124. By new "versions," of course, we do not mean mere paraphrases, but works which, though based (perhaps substantially) upon the first author's work, contain recognizably original efforts by the second author, e.g.: dramatizations, translations, abridgments, etc. Cf. *Folsom v. Marsh*, 9 Fed. Cas. 342, No. 4,901 (C.C. Mass. 1841).

125. Cf. Chafee, *Reflections on the Law of Copyright (Part I)*, 45 Colum. L. Rev. 503, 511-14 (1945).

126. This is not to say that Congress lacks power to preempt and "federalize" the entire law of literary property. It is only to say that such a power cannot be distilled from the patent-copyright clause *alone*. A preemptive federal law of "unfair competition" by or in any transaction concerning literary or artistic property, which in any way affects interstate commerce, would, when coupled with as preemptive a copyright statute as Congress could enact, certainly clear the decks of state action in the field. Theoretically, to be sure, the states would remain free to develop the application of their law of "unfair competition" to artistic works in any case where the transaction involved was so purely intrastate in character as not to *affect* interstate commerce; but this theoretical loophole can hardly be deemed to be of much practical importance. As we have already stated (in Part I of this article, note 28), the wisdom of enacting such a preemptive statute is beyond the province of this article; our concern here is solely to explore the scope and meaning of the patent-copyright clause.

CONCLUSION

In the analysis we have here made of the patent-copyright power, it has seemed convenient to treat separately (and in reverse order) the two phrases of which the constitutional clause is composed: (1) the purposive phrase, "To promote the Progress of Science and useful Arts," and (2) the substantive phrase, "by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The substantive phrase, on its face, confers on Congress the affirmative power to protect "Writings" and "Discoveries"; but the power so granted is not plenary in character, for it can only be exercised "for limited Times." We have attempted to show that: (1) this limited *protective* power was intended to operate concurrently with that of the states in the premises; (2) in consequence, federal protection of unpublished "Writings" has never been regarded as preemptive of state protection of the same subject-matter; (3) as to published works, the states (misled by the specious but attractive analogy between patents and copyrights) have not attempted to exercise their concurrent powers in the premises until very recently; but (4) in the absence of clearly preemptive regulation by Congress, there can be no question of the existence of such reserved and concurrent state powers. It follows logically, from this contention, that a preemptive exercise of Congress's protective powers under the substantive phrase could only preclude state action "for limited Times." Once the limited period of federal protection for a given work expired, the states (whose reserved powers are not similarly restricted) would be free to reenter the field of protective regulation of that work.

Considering the purposive phrase, however, we have found: (1) that it gives rise to an implied power in Congress perpetually to divest authors and inventors, who seek federal protection for their works, of any claim they may have to concurrent or residual state protection of the "ideas" involved in their respective creations; but (2) that this *divestitive* power, being limited to the accomplishment of the constitutional purpose, does not extend to authorize federal divestiture of state protections for mere "expressions" *as such*—it cannot, in other words, deny to the creators of intellectual works the continued ownership of their "expressions," so far as the same can, as a practical matter, be efficiently divorced from the "ideas" they convey to the public. We have argued that such a divorce can practically be made: (1) in the case of inventions, along the lines of cleavage drawn by the familiar distinction between "functional" and "non-functional" features; and (2) in the case of "Writings", along the line of demarcation between "fair use" (untrammelled by statutory limitations) and the kind of "unfair use" prohibited by the developing law of "unfair competition" relating to uncreative "misappropriations" of such works. We have concluded that the federal divestitive power cannot preempt

the reserved powers of the states (1) to protect inventors against unauthorized appropriations of the strictly non-functional features of their inventions, and (2) to protect authors against merely uncreative "Chinese copying" of the particular "expressions" created by them.

A final word of caution remains to be said. When two such giants of American law as James Kent and Learned Hand differ so radically across the centuries,¹²⁷ and when even mighty Marshall has discreetly held his peace,¹²⁸ it would be a bolder man than the present writer who would undertake to declare himself the discoverer of all the answers to the thorny problems of construction of the patent-copyright clause herein reviewed. A final solution to these difficult issues can only be reached by widespread and enlightened discussion of all the relevant factors, pro and con. It is believed, however, that the conclusions above stated will be found to have shed some light, at least, on the way toward such solution; even more, it is hoped that they will challenge serious reexamination of the many familiar but untested propositions of law and historical fact in this area which we have all, for too long, simply taken for granted.

There is compelling cause for thus seeking immediate and full debate upon these questions. We stand today on the verge of enacting a new revision of our federal copyright statute, which has gone without a major overhauling for over fifty years. As we have seen, many of the unspoken preconceptions upon which the Act of 1909 was written have been radically challenged by modern doctrines of "unfair competition". The need for a fundamental reappraisal of the constitutional distribution of state and federal powers over the law of literary and artistic property is, therefore, both urgent and manifest. It is time we laid to its final rest the two-centuries-old ghost of *Donaldson v. Beckett*.

127. Compare Kent's exposition of the clause, quoted *supra*, in the text accompanying note 12, with Hand's exegesis, quoted in Part I of this article, in the text accompanying note 37.

128. *Gibbons v. Ogden*, *supra* note 9, 22 U.S. (9 Wheat.) at 221.

137. FOURTH JOINT MEETING OF UNESCO INTERGOVERNMENTAL
COPYRIGHT COMMITTEE AND BERNE PERMANENT COM-
MITTEE*

(Madrid, Sept. 25-30, 1961)

The Intergovernmental Copyright Committee and the Permanent Committee of the International (Berne) Union for the Protection of Literary and Artistic Works held their sixth and tenth sessions, respectively, and the fourth joint meeting, from September 25 to 30, 1961, in Madrid, Spain. (For reports of prior meetings see 6 BULL. CR. SOC. 26, Item 2 (1959), and 8 BULL. CR. SOC. 71, Item 70 (1960).

The twelve Member States of the Intergovernmental Copyright Committee (Argentina, Brazil, Federal Republic of Germany, France, India, Italy, Japan, Mexico, Spain, Switzerland, United Kingdom, United States of America) and the twelve Member States of the Permanent Committee (Belgium, Brazil, Denmark, Federal Republic of Germany, France, India, Italy, Portugal, Rumania, Spain, Switzerland, United Kingdom) were represented at the session. The representatives of seven States which do not belong to either of the Committees attended the session as observers. These included Austria, Chili, Cuba, the R.A.U., Sweden, Tunisia, and Turkey. In addition, two intergovernmental and eleven non-governmental organizations were represented at the session.

Representing the United States were the Hon. Abraham L. Kaminstein, Register of Copyrights, Dr. Arpad Bogsch, Legal Advisor, Copyright Office; and Mr. Harvey J. Winter, Assistant Chief, International Business Practices Division, Department of State.

The members of the two Committees first attended an official ceremony in the National Library on 25 September 1961. On their behalf Mr. *Gordon Grant* (United Kingdom), Chairman of the Intergovernmental Committee and the Permanent Committee from 1960 to 1961, paid a tribute to the memory of Dag Hammarskjöld, Secretary-General of the United Nations, whose tragic death had been sadly lamented throughout the world. He likewise paid a tribute to the memory of Arthur Fisher, Register of Copyrights of the United States of America, who had devoted a great part of his life to the development of copyright. After welcoming Mr. Fisher's successor, Mr. Kaminstein, Mr.

* This report of the proceedings at Madrid is taken from the official report printed in *Le Droit d'Auteur*, November 1961.

Grant recalled the most important events that had taken place during the past year in the field of copyright, such as the Diplomatic Conference on the international protection of industrial designs and models, the session of the Study Group on the international protection of cinematographic works, and the Diplomatic Conference on the international protection of neighbouring rights, convened at Rome on the generous invitation of the Italian Government. Finally, he expressed the hope that the two Committees would continue to hold joint meetings to examine questions of common interest. Other speakers included Mr. Jesus Rubio, Minister of National Education (Spain); Prof. Jacques Secretan, Director of the Berne Bureau, and Mr. Rene Maheu, Acting Director General of UNESCO.

The two Committees held their first meeting the same afternoon. Messrs. José Antonio García-Noblejas (Spain) and A. M. D'Rozario (India) were unanimously elected Chairman and Vice-Chairman, respectively, of the two Committees. In addition, Messrs. Juan O. Díaz Lewis and Thomas Ilosvay assumed the functions of Secretary and Associate Secretary of the Intergovernmental Committee, and Messrs. Claude Masouyé and G. R. Wipf were appointed to the same posts on the Permanent Committee.

A drafting Committee headed by Mr. Henry Puget (France) and composed of Messrs. Dumitrescu (Rumania), Gaxiola (Mexico), Kaminstein (United States), Perales García (Spain), Ulmer (Federal Republic of Germany) and Wallace (United Kingdom) prepared draft resolutions for the two Committees.

The following questions were examined during the joint meetings of the two Committees:

1. Criminal proceedings and other forms of assistance by governments in cases of infringement of copyright;
2. International protection for works of applied art and designs and models;
3. International protection for cinematographic works and report on the session of the Study Group;
4. Preparation of the Convention on international protection of performers, producers of phonograms and broadcasting organizations;
5. Co-operation between UNESCO Secretariat and the United International Bureaux regarding publications;
6. Conformity of musical scores with the original compositions;

7. Participation of UNESCO and the International Bureaux in the activities of Member States in the field of copyright;
8. Photographic reproduction of copyrighted works by or for libraries, documentation centres and scientific institutions.

1. Criminal proceedings and other forms of assistance on behalf of Governments in cases of copyright infringement

The reports submitted by the Secretariats contained replies from thirty States to an enquiry on the use of penal sanctions in cases of copyright infringement. This enquiry was made to implement the resolutions adopted by the two Committees at London.

Commenting on the results of the enquiry, Mr. *D'Rozario* (India) hoped that the use of such sanctions would be facilitated on the administrative and diplomatic levels. To the same end, Mr. *Puget* (France) expressed the wish that access to the competent jurisdictions should be facilitated and that, in the case of this sort of action, the presence of the complainant should not be insisted upon. Mr. *Galhardo* (Portugal) proposed that in cases of this kind the administration should verify whether the author had in fact granted users the necessary authorizations.

The Committees finally took note of the announcement made by their Secretariats that the results of the enquiry were to be published in order to give the widest possible diffusion to the information obtained from it.

2. International protection for works of applied art and designs and models

The reports prepared by the Secretariats gave on the one hand an account of the measures taken following the recommendations made on this subject by the two Committees during their joint session at London, and on the other hand of the progress of the work of the Diplomatic Conference at The Hague in November 1960, and also of the main provisions of the new Arrangement adopted by the Conference concerning the international deposit of industrial designs or models.

The two Committees took note of the contents of the Secretariats' reports.

3. International protection for cinematographic works and report on the session of the Study Group

The reports presented by the Secretariats gave an account of the implementation of the recommendations made by the two Committees at their joint session in London; namely, the meeting at Geneva in June 1961 of a Study Group convened by the Director of the United International Bureaux and the Director-General of UNESCO. Six of the nine Governments invited to appoint an expert each had been represented at Geneva (Federal Republic of Germany,

France, Italy, Mexico, Sweden and the United Kingdom), while the representatives of the three other countries (Czechoslovakia, India and the United States) had been absent; the Study Group, thus composed, had adopted the report submitted by its Rapporteur, Professor Desbois (France).

The Study Group had agreed on the recommendation of its Chairman to give this report a preliminary character in the hope that all the countries invited to appoint an expert would be able to participate in subsequent work. The Group had met again in Madrid with the participation of the experts from the six countries represented at Geneva, together with those from the United States and India.

The Chairman of the Group expressed his regret that the state of health of the Rapporteur, Professor Desbois, had prevented him from taking part in their work, and the Group agreed to send him a telegram of good wishes. Mr. *Düby* (International Federation of Film Producers' Associations) then explained the position of film producers, distributors and proprietors of cinemas. For these, the Anglo-American copyright systems would be preferable to any other; however, it was hardly possible to give up the traditional system of the Berne Convention according to which the person who participates in intellectual creation is regarded as an author; they therefore hoped that the new regulations would allow producers to make films in collaboration with other authors and to exploit them freely. In this respect, Mr. *Düby* expressed the wish that the regulations contemplated should be based on the following three principles: (1) they ought to contain the presumption *jure conventionis* that the producer acquires property rights in the cinematographic work from the authors, to the exclusion of moral rights, such a presumption being, in Mr. *Düby's* opinion, necessary for the exploitation of the film; (2) the exercise of moral rights of authors should make due allowance, from the intellectual, artistic and economic standpoints, for the interests of the producer responsible for the film; and (3) the producers, film distributors and cinema owners should be protected from the tendency of certain authors to share in cinema box office receipts; several authors sharing in these receipts could, indeed, endanger the economic exploitation of the film.

For his part, Mr. *Devaux* described the position of the International Literary and Artistic Association as this appears in the resolution adopted by the Association at its Congress held at Florence in September 1961. That organization considered that the protection of cinematographic works should continue to be governed within the traditional framework of the Berne Union, that careful studies should be made to find the practical solutions deemed necessary, particularly regarding the term of protection, the moral right and the country of origin, and finally that inserting in the Convention a presumption of assignment of exploitation rights in the cinematographic work to the producer would

be liable to lead to grave consequences calling for serious examination. Producers' interests and authors' rights could be made compatible by other, notably contractual, means.

Finally, Mr. *Malaplate* recalled the position of the International Confederation of Authors' and Composers' Societies for whom the presumed assignment could involve serious consequences for the authors, since their economic situation could not allow them to insist on the insertion of the contrary stipulation in their contracts so that the presumption of cession would end by having the same effects as an assignment by operation of law.

Animated debate took place on the form to be given to the results of the works of the Madrid Study Group and on the proposals to be put forward.

Regarding the form, the Study Group decided to appoint a drafting committee to revise, if possible, the Preliminary report or, failing that, to supplement it by an additional report. The Committee comprised Mr. Puget (France) as Chairman, and Messrs. Hesser (Sweden), Kaminstein and Bogisch (U.S.A.), Ulmer (Federal Republic of Germany) and Wallace (U.K.). It decided to revise and complete the preliminary report, the modifications put forward being, as Mr. Ulmer pointed out, of a minor order, affecting neither the structure nor the substance of the earlier report. The new version of the report was unanimously approved by the drafting committee, on the understanding that Professor Desbois would be asked for his assent to the alterations contained therein so that it could be published under his name.

As to the substance, Mr. *Kaminstein* (U.S.A.) emphasized that, from the copyright point of view, it was impossible to create a difference between documentary films and newsreels, on the one hand, and the remainder of cinematographic works on the other, but that any distinction between protected cinematographic works and motion pictures not subject to protection should be based on the notion of intellectual creation. This opinion, which was shared by all the experts, was emphasized in the revised report.

Likewise, it was specified that the Convention should contain rules concerning the exploitation of economic rights, in the sense of a presumption of transfer of such rights by the author to the producer, it being clearly understood that the parties may avoid the effects of this presumption by means of contractual stipulations having such an effect.

With reference to this subject, Mr. *Kaminstein* (U.S.A.) expressed the opinion that the presumption would affect only countries in which the national laws did not vest copyright in the film producer. Mr. *Ulmer* (Federal Republic of Germany), on the other hand, expressed his view that although in such countries the presumption would not apply with respect to the direct contributions of the intellectual creators of the cinematographic work, it should still apply in respect of the pre-existing works, adapted or reproduced in the

cinematographic work. Finally the Committee agreed that countries (such as the United Kingdom) which grant a copyright in cinematographic works to producers, or which allow assignment by operation of law of economic rights in favour of producers (such as Austria and Italy), should not be obliged to change their systems.

Furthermore, as a result of the observations of Mr. *Straschnov* (European Broadcasting Union), note was taken of the fact that certain experts were of the opinion that it was not desirable to make distinctions between works on the basis of the original purpose for which they were made (projection in a cinema or television broadcast).

With respect to the term of protection, certain experts expressed the opinion that the Convention should fix a minimum term of protection, which could either comprise the lifetime of the last surviving author and a certain number of years after his death, or be counted from the date of the first public showing of the cinematographic work.

The President of the Study Group, Professor *Ulmer* (Federal Republic of Germany) told the members of the two Committees that, in the opinion of the Group, the report adopted was only a first step. He considered that it would be desirable later to ask the interested Governments and organizations to state their views, and then convene another Study Group to draw up new conventional rules.

Regarding this point, Mr. *Puget* (France) proposed that the two Committees should note, with satisfaction, the results obtained, without pronouncing on the conclusions of the Report, and invite the Secretariats to continue their studies and send copies of the Study Group report to all interested Governments and groups and ask them for their views¹).

At the conclusion of their discussions, the two Committees adopted Resolution No. 5 or 44 (VI).

4. Preparation of the Convention on international protection of performers, producers of phonograms and broadcasting organizations

The Secretariats provided information on the activities of the three inter-governmental organizations interested in this subject, in agreement with the Italian Government, the Diplomatic Conference would be convened at Rome on 10 October 1961; the working documents — viz. the draft Convention drawn up by the experts at The Hague in May 1960, the draft formal clauses jointly elaborated by the three Secretariats and the States' observations together with a detailed analysis of the said observations — have been sent to all the

1. This report is being published separately for transmission to Governments and interested organizations.

Governments invited, that is to say to all the Governments of Member countries of the Berne Union, UNESCO or the International Labour Organisation. So far, twenty-five States had already officially indicated the composition of their delegations to the Conference.

5. Co-operation with regard to publications between UNESCO Secretariat and the United International Bureaux Secretariat

The reports submitted by the Secretariats stated that the completed manuscript of the French version of "Copyright Laws and Treaties of the World" had been sent to the publishers and that the English and Spanish versions were regularly brought up to date, that the first instalment of "Design Laws and Treaties of the World" had already appeared, and a second instalment would be published in the near future; and, generally speaking, coordination of publications produced by the United International Bureaux and the UNESCO Secretariat was being constantly strengthened.

The report of the Permanent Committee's Secretariat also put forward certain proposals regarding the review *Le Droit d'Auteur*, particularly about the possible separate publication of English texts in the review.

Having heard the remarks of Mr. *Grant* (United Kingdom) and Mr. *Kaminstein* (United States) and several other delegates, the Committees expressed their satisfaction at the increased collaboration between the United International Bureaux and the UNESCO Secretariat, and the members of the Permanent Committee expressed the wish that as many articles and texts as possible in languages other than French should be given space in the review *Le Droit d'Auteur*, the principle of its publication in the French language being maintained. The recommendations adopted by the Committees on this question are contained in Resolution No. 1 or 40 (VI).

6. Protection of Musical Works

a) Musical scores:

The reports submitted by the Secretariats recalled that during their London Sessions, the two Committees had asked the Secretariats to translate, reproduce and distribute the text of the statement made by Mr. Denis Vaughan regarding the conformity of musical scores with the original compositions.

Mr. *Hesser* (Sweden) said that most laws provided for the presumption that a publishing contract meant publication without alteration and that the question did not give rise to a need for modifying Article 6^{bis} of the Berne Convention. The Committees subscribed to the proposals made by Mr. *Puget* (France) to the effect that it was for the Secretariats to carry out further studies, and conduct inquiries among the Governments, in order to get to know the

state of legislation, jurisprudence and administrative practice in this matter in the various countries.

These conclusions were the subject of Resolution No. 2 or 41 (VI).

b) Term of protection of musical scores:

The Committees discussed the question of the duration of copyright protection in musical works. It was remarked that some music publishers tried to delay the falling into the public domain of musical compositions by introducing small changes in the musical scores, in the expectation that the term of protection in the changed version would be computed from its publication or from the death of the author of the changes. Whereas, of course, certain changes, such as most adaptations or arrangements, deserve copyright protection, changes made merely for the sake of trying to create a basis for the continued collection of royalties would seem to be in contradiction with one of the basic characteristics of copyright protection in most countries, namely with its limited duration.

The Committees, before formulating any views on this matter, wanted to have more facts before them and adopted Resolution No. 3 or 42 (VI) in which they invited their Secretariats to undertake a study of the problem.

It was understood that this resolution did not call for an enquiry to be addressed to Governments at the present time. What the Secretariats would be expected to do in order to assemble the necessary factual information for preparing their report was to make enquiries from half a dozen or so of the foremost (*a*) authors' societies, (*b*) music publishers, (*c*) opera houses, (*d*) symphonic orchestras. These should be asked to state the present practices as to payment of copyright royalties in connection with works, at least one version of which has already fallen into the public domain because of the expiration of the applicable term of protection.

**7. Participation of UNESCO and the United International Bureaux
in the activities of Member States in the field of copyright**

This question appearing only on the agenda of the Intergovernmental Committee was examined first by the members of that Committee. The Secretary, Mr. *Díaz Lewis*, gave a detailed report of the preparation of the documents to be submitted to the African regional meeting on copyright, the role of consultants before and during the meeting, and the plans for a meeting in Latin-America and future grants of fellowships.

Mr. *D'Rozario* (India) hoped that these fellowships would be numerous enough and that the fellows would pass a large part of their time as students at the UNESCO Headquarters. In order to ensure satisfactory preparation of the meetings in question, Mr. *Winter* (U. S. A.) expressed the wish that

the Intergovernmental Committee should approach the Director-General of UNESCO with a view to the nomination of consultants.

The Permanent Committee having manifested its interest in this question, the discussion was continued in joint session. A draft resolution formulated by Mr. *Kaminstein* (U. S. A.) was put before the Committees; it took note with satisfaction of the initiatives taken in this field, and invited (1) the Chairman to appoint two or three consultants to help the Secretariats in preparing the documentation for the said meeting, and (2) the Director-General of UNESCO and the Director of the United International Bureaux to choose experts from countries outside the regions in question, in agreement with the Chairman. The two Committees approved the draft, the text of which appears as Resolution No. 6 or 45 (VI).

After the adoption of the Resolution, the Chairman informed the two Committees that he had designated Mr. *Hesser* (Sweden) and Mr. *Kaminstein* (U. S. A.) to assist the Secretariats in preparing documentation for the regional meeting on Africa.

8. Photoduplication of copyrighted material by or for libraries, documentation centres and scientific institutions

This question appeared first on the agenda of the Intergovernmental Committee and only one report was submitted for discussion by the two Committees. Mr. *Ilosvay*, Assistant Secretary of the Intergovernmental Committee, recalled that the study of this question had been suggested by the Director-General of UNESCO. He then stressed the prominent place occupied by photoduplication processes in the case of libraries and similar institutions and indicated certain copyright problems raised by these processes. In the succeeding debate, the representatives of several States warmly approved the initiative of the Director-General of UNESCO.

Mr. *Kaminstein* (U.S.A.) emphasized the importance of these processes in his country and hoped an exhaustive study would be made, in collaboration with copyright experts and library specialists, in order to discover all aspects, juridical and practical, of the question. With a view to obtaining the fullest possible information, the two Secretariats ought to conduct an inquiry among Governments. He offered the closest cooperation of the United States Copyright Office and Library of Congress of which the Copyright Office is a department.

The Chairman, Mr. *García-Noblejas*, and Mr. *Jimenez Quesada* (Spain) stressed practical aspects of the question which called for clarification with the help of librarians. Mr. *Tiscornia* (Argentina) hoped that all the problems would be clearly defined and all points of view could be expressed. The difficulties were more numerous and had special features in the less developed

countries in the view of Mr. *D'Rozario* (India), who expressed the wish that these countries, especially those in Asia, should be represented on the proposed committee of experts.

Messrs. *Gaxiola* (Mexico), *Hesser* (Sweden) and *Wallace* (U.K.) described the legislation in their respective countries in this field.

Mr. *Ulmer* (Federal Republic of Germany) made a distinction between on the one hand, the general problem of the influence of modern techniques on copyright, and on the other hand the special problem of the part played by photoduplication processes in the case of libraries. He suggested a legal study by the Secretariats on national legislation, bills and case law. After this study, a committee of experts should be convened.

Mr. *Puget* (France) proposed that the Secretariats should prepare their documentation with the help of consultants, and submit it to the next joint session of the Committees, after which a committee of experts should be convened.

The Secretary of the Intergovernmental Committee finally stated that the proposed studies would be carried out in close collaboration by the United International Bureaux and the UNESCO Secretariat. However, as far as the latter was concerned, the project came within the competence of both the Copyright Division and the Libraries Division. The last named had moreover already brought the question before the International Consultative Committee on Bibliography, Documentation and Terminology, at the present time holding its first session in Paris.

The recommendations of the two Committees are set out in Resolution No. 4 or 43 (VI), concerning the photoduplication of copyrighted works, by or for libraries, documentation centres and scientific institutions.

B. Questions examined by the Intergovernmental Committee only

1. Report of the Secretariat on the Universal Copyright Convention

The Secretary of the Intergovernmental Committee, Mr. *Días Lewis*, reported on the progress made in various countries (Colombia, Cyprus, Denmark, Ghana, Greece, Panama and Venezuela) tending towards ratification of or accession to the Convention.

Mr. *Puget* (France) recalled the situation of the French-speaking African States, whose territory had also been covered by France's ratification of the Berne Convention. This was, therefore, a question of the right of succession of States. Furthermore, it was desirable to take into account the effects of what was known as the "safeguarding clause" in Article XVII of the Universal Convention. The Secretary then stated that all initiatives in this field would be concerted jointly by UNESCO and the Berne Bureau.

2. Preliminary studies to be undertaken with a view to a possible limited revision of the Universal Copyright Convention

A report on this matter with an explanatory note was submitted to the Intergovernmental Committee by Messrs. *Bogsch* (U.S.A.) and *Ulmer* (Federal Republic of Germany), who at the London session of the Committee had kindly consented to act as consultants to the Secretariat.

Mr. *Kaminstein* (U.S.A.) recalled that it was a question on the one hand of a Convention signed barely nine years ago, and that, on the other hand, the first aim was to get new accessions. He proposed that while keeping the question on the Committee's agenda, no circular letter concerning the desirability and aim of a possible revision should for the time being be sent out to the States. Mr. *Puget* (France) also expressed the wish that the issue of a circular letter of this kind should be postponed, although the question ought to remain on the agenda of the Committee.

Messrs. *D'Rozario* (India), *Morf* (Switzerland) and *Seno* (Japan) were of the same opinion as the representatives of the United States and France.

The Committee then agreed that the circular letter should not be sent out at present and that the question should appear on the agenda of the next session of the Committee.

3. Periodicity of the sessions of the Intergovernmental Copyright Committee and modification of its Rules of Procedure

In view of a wish formulated during the London Session (October-November 1960), the Secretariat in its report proposed to modify the rule relating to holding the ordinary Sessions of the Committee on a yearly basis (Rule 9 of the Rules of Procedure), and substitute for it a measure similar to Rule 6 of the Permanent Committee's *modus vivendi* which provides that "the Committee shall meet in ordinary session at least once every two years".

Messrs. *Puget* (France), *Ulmer* (Federal Republic of Germany) and *Wallace* (U.K.) approved the principle of Article 6 of the *modus vivendi*, since the Chairman might always convene the Committee more frequently if he felt the need.

In approving the Secretariat's suggestion, the Committee constituted a working group, headed by Mr. *Puget* (France), and comprising Messrs. *Bogsch* (U.S.A.) and *Morf* (Switzerland) to propose the necessary modifications. These modifications were approved unanimously by the Committee.

C. Questions examined by the Permanent Committee only

The points which were on the agenda of the Permanent Committee but not on that of the Intergovernmental Committee were as follows:

- (1) Composition of the Permanent Committee;
- (2) Extension of the period of protection;
- (3) Preparation of the Stockholm Conference for revision of the Berne Convention and the measures to be taken forthwith to make such preparation possible.

1. Composition of the Permanent Committee

Resolution No. 2 adopted at the eighth session held at Munich in October 1959 provided that "the draft rules . . . will be used as a *modus vivendi* until the (Stockholm) Conference takes place, as far as the practical working methods of the Committee are concerned, in its present composition".

The Committee recorded the fact that no resignation had been presented.

2. Extension of the protection period

As a result of the enquiries conducted by the International Bureau, five countries (Brazil, the Holy See, Italy, Lebanon, Spain) replied favourably to the proposal for extending the protection period, and seven (Belgium, Finland, France, Greece, Israel, Luxemburg, Tunisia) did not reject the possibility of an extension while twenty-two replied in the negative. Furthermore, two countries (Greece and Tunisia) considered that fresh rules on the protection period ought to be embodied in the Convention, and three (Denmark, Japan, New Zealand) were in favour of a private Union or a restricted arrangement, whereas ten (Belgium, Ceylon, France, Italy, Lebanon, Liechtenstein, Luxemburg, Netherlands, Spain, Thailand) indicated their preference for an additional protocol to the Berne Convention, and nineteen countries expressed no opinion on the subject.

Lastly, the Permanent Committee was informed by its Secretary of the contents of a report made by the Committee of Experts which met at Geneva in January 1961 and the draft private arrangement drawn up by that Committee.

Mr. *Devaux* (ALAI) having recalled that the International Literary and Artistic Association at its Florence congress in September 1961 was in favour of a rapid conclusion of the work undertaken with a view to extending the period of copyright, different opinions were formed in the Permanent Committee.

As regards the end sought, Mr. *Perales García* (Spain) advocated a protection period of eighty years from the author's death, whereas Mr. *Petrén* (Sweden) stressed that the body of opinion in favour of a prolongation was not very great, and some countries even found it hard to accept the period of fifty years after death specified in the Brussels text of the Berne Con-

vention. Mr. *de San* (Belgium) thought that a majority might emerge in favour of a unification of the various wartime prolongations, and suggested that the International Bureau should set up a broader working group in order to go deeper into the question and find a compromise solution which numerous countries could accept. This suggestion was supported by Mr. *Puget* (France) who emphasized that it ought to be possible to unify the various national prolongations for instance a ten-year extension of the protection period.

Summing up the discussion, Mr. *Puget* (France) stated that the members of the Committee were all agreed on the need for a resumption of studies by an enlarged group for the purpose of achieving the adoption of a uniform protection period. After Mr. *Talamo Atenolfi* (Italy) and Mr. *de San* (Belgium) had pointed out that it would be as well to place no restrictions whatever on the task of the new study group, the Permanent Committee instructed its Drafting Committee to prepare a draft resolution expressing the *voeu* that the studies should be conducted within the framework of the Berne Union to determine what international instrument would permit a unification of the different national protection periods among the countries interested in this question.

After discussion of this resolution, the text of which is given hereunder, it was decided, on the proposal of Mr. *Talamo Atenolfi* (Italy), that the International Bureau should take note of its opportunity to assemble, as quickly as possible, a committee of experts appointed on a broader basis.

The Committee then adopted Resolution No. 7 by eight votes in favour, none against, and four abstentions (Federal Republic of Germany, Portugal, Switzerland and United Kingdom).

3. Preparation of the Stockholm diplomatic Conference and means to be used to make this preparation possible

As for the proposals expressed, either at the Brussels Conference or during the work of the various professional groups and international organizations interested in copyright, the Secretary emphasized that the objectives of certain *voeux* had already been attained or were about to be, for example the Brussels *voeux* relating to the Universal Copyright Convention and the international protection of performers, producers of phonograms and broadcasting organizations. On the other hand, further questions arising out of the evolution of copyright would have to be examined at Stockholm, such as determinations of the country of origin of the work, recognition *jure conventionis* of the exclusive right of reproduction, protection of news items, limitations on the author's exclusive right in matters of sound and visual broadcasting, problems relating to cinematography, the question of penal sanc-

tions in cases of infringement of copyright, and reform of the Union's administrative structure.

Finally, the Secretary stressed that the report submitted to the Committee contained certain proposals intended to ensure the financing of the preparatory work for the Stockholm Conference.

Mr. *Puget* (France) indicated that the inscription on the agenda of the Stockholm Conference of the matter of wider adoption of the "*droit de suite*" was desired by the French Government.

Mr. *Petrén* (Sweden) then informed the members of the Permanent Committee of his Government's position with regard to the Diplomatic Conference which would convene at Stockholm in 1965. Against the background of the problems to be discussed the points listed in the Bureau's report corresponded to what was in general envisaged by the Swedish Government, it being understood that the latter might however hesitate to include on the agenda certain questions such as, for example, double taxation, "*droit de suite*", or extension of the protection period.

Resolution No. 8, which is given hereunder, was adopted unanimously.

D. Date and place of the next joint session of the Committees

Recalling the invitation given to the two Committees during the previous year, the Indian representative, Mr. *D'Rozario*, expressed anew the desire of his Government that the two groups should hold their next joint session in India. The Committees warmly accepted the invitation; the fixing of the exact date of the session—which would probably take place at the beginning of 1963—being left to an agreement between the Indian Government and the Chairman of the Committees in consultation with the Director-General of UNESCO and the Director of the Bureau of the Berne Union.

RESOLUTIONS

RESOLUTION No. 1 or 40 (VI)

regarding publications in the field of copyright

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee,

Noting the present state of publications on the subject of copyright, particularly the English, Spanish and French versions of "Copyright Laws and Treaties of the World" and the compilation "Design Laws and Treaties of the World",

Express their satisfaction at the results already obtained and hope that the necessary measures will be taken in order to keep these publications up to date,

Recommend that as regards the publication *Le Droit d'Auteur*, while maintaining the principle of publication in French, the largest possible number of articles and texts in other languages should be included therein.

RESOLUTION No. 2 or 41 (VI)

regarding the conformity of musical scores with the original compositions

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee,

Having taken note of the studies carried out by the Secretariats following the joint session in London (1960),

Invite the Secretariats to secure information from Governments as to the legal means for protecting the original form of the author's work in succeeding editions.

RESOLUTION No. 3 or 42 (VI)

regarding musical scores and term of copyright in musical scores

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee,

In view of the possibility that some publishers may make minor changes in musical works solely for the purpose of extending the term of protection or otherwise acquiring rights,

Invite the Secretariats to undertake a study of this matter.

RESOLUTION No. 4 or 43 (VI)

regarding the photographic reproduction of copyright works, by or for libraries, documentation centres and scientific institutions

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee,

Considering the increasing importance of photographic reproduction of copyrighted works, by or for libraries, documentation centres and scientific institutions,

Welcome the initiative of the Director-General of UNESCO in suggesting a study of the questions arising in this field,

Request the Director-General of UNESCO and the Director of the Bureau of the Berne Union, after consulting the Chairman of the two Committees, to appoint three or four specialists in copyright and libraries, as consultants, to assist the Secretariats in preparing a report for the next joint session of the Committees and for the committee of experts mentioned below, on the statutes, revision proposals and bills, case law, facts and practices in this matter,

Recommend that the Secretariats request the various governments to supply any useful information on this subject,

Recommend that on completion of these preliminary tasks the Director-General of UNESCO and the Director of the Bureau of the Berne Union jointly convene a committee of experts to examine the problem, to formulate recommendations with a view to possible solutions, and to submit their conclusions to one of the forthcoming joint sessions of the two Committees.

RESOLUTION No. 5 or 44 (VI)

regarding the international protection of cinematographic works

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee,

Having noted with appreciation and interest the important results of the work of the Study Group on the international protection of cinematographic works,

Considering the importance of the question and also its possible inclusion, after agreement with the Swedish Government, in the agenda of the coming Conference of revision of the Berne Convention,

Invite the Secretariats to submit the report of the Study Group to Governments and interested international organizations for comments and report on these comments at the next joint session of the two Committees.

RESOLUTION No. 6 or 45 (VI)

concerning participation in the activities of countries in the field of copyright

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works and the Intergovernmental Copyright Committee,

Note with satisfaction the plans for (a) holding regional copyright seminars, (b) placing experts at the disposal of countries, especially the newly independent states, which wish to adopt new copyright laws, to modify their existing copyright laws, or to study the possibilities of their adherence to the Universal Copyright Convention or the Berne Convention, and (c) granting fellowships to nationals of such countries,

Invite the Chairman of the two Committees to designate two or three consultants to assist the Secretariats in the preparation of the more important working papers for such seminars,

Invite the Director-General of UNESCO and the Director of the International Bureau of the Berne Union to designate, after consultation with the Chairman of the two Com-

mittees, specialists from countries outside the regions concerned to participate in the regional seminars or to serve as experts on the request of the interested countries.

RESOLUTION No. 7

regarding the extension of the term of protection after the death of the author

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works,

Having taken note of the results of the work of the Committee of Experts which met at Geneva in January 1961 and the report of the International Bureau on this question,

Having noted that in the opinion of some delegations:

- (1) the term of protection at present provided by the Berne Convention is inadequate, and
- (2) that, taking into account, the diversity of national legislations as regards this term, and further the inequality of the various wartime prolongations of the normal period, the existing prolongations be unified,

Expresses the hope that studies will be pursued to obtain a solution acceptable to the greatest possible number of the countries interested in this matter and to determine what international instrument would permit unification among the said countries.

RESOLUTION No. 8

regarding the preparation of the Stockholm Conference for the revision of the Berne Convention

The Permanent Committee of the International Union for the Protection of Literary and Artistic Works,

Being convinced of the importance of a thorough preparation for the Stockholm revision Conference,

Considers that the program of this Conference, in its general lines and with the consent of the Swedish Government, ought to take into account the suggestions made by the Secretariat of the International Bureau,

Is of opinion that the Conference ought to be preceded, with the consent of the Swedish Government, by meetings of a study group, subsequently assisted by a committee of experts appointed by the governments and of observers from the non-governmental international organizations concerned,

Considering that this preparation, with the necessary personnel, will involve certain expenses, at charge of the International Bureau,

Expresses the "*voeu*" that the Government of the Swiss Confederation, after examining the final report it is preparing on the administrative and financial organizations of the United International Bureaux, will consider to what extent the States of the Union could be asked to make a contribution for this Conference.

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. UNITED STATES OF AMERICA AND TERRITORIES

138. U. S. CONGRESS. HOUSE.

H.R. 9524. A bill relating to the tax treatment of transfers of rights to copyrights and literary, musical, and artistic compositions. Introduced by Mr. Lindsay, January 10, 1962, and referred to the Committee on Ways and Means. 4 p. (87th Cong., 2d sess.)

This bill would grant to authors of literary, musical, or artistic works similar benefits of capital gains tax treatment in the event of transfers of rights as those accorded to patent owners.

139. U. S. CONGRESS. HOUSE.

H.R. 9906. A bill to provide for the establishment of a National Arts Agency in the United States Office of Education to aid in the creation and understanding of, and education in, the fine arts. Introduced by Mr. McDowell, January 25, 1962, and referred to the Committee on Education and Labor. 3 p. (87th Cong., 2d sess.)

This bill provides for the creation, in the United States, of a *domaine public payant*. Under it "all writings, including music, now or hereafter in the public domain" would be the property of the United States "as copyright owner," and royalties would be collected through the proposed National Arts Agency.

140. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Design protection. Hearings before the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate, Eighty-seventh Congress, first session, pursuant to S. Res. 55 on S. 1884. August 15, 16, and 17, 1961. Printed for the use of the Committee on the Judiciary. Washington, U. S. Govt. Print. Off., 1961. 220 p.

141. U. S. CONGRESS. HOUSE.

Lindsay, John B. Capital gains tax. *Congressional Record*, vol. 108, no. 2 (daily ed. Jan. 11, 1962), pp. 60-61.

Remarks of Congressman Lindsay with respect to his introduction of H.R. 9524. Mr. Lindsay indicated that he had introduced the bill "in the hopes that it will become part of a series of legislative steps that must be taken to stimulate the growth and development of the arts in the United States." See Item 138, *supra*.

142. U. S. COPYRIGHT OFFICE.

Games. Washington, U. S. Govt. Print. Off., Dec. 1961. 1 p. Cir. 17.

An extensively revised circular which explains what may or may not be copyrighted in respect to games and materials published in connection therewith.

143. U. S. COPYRIGHT OFFICE.

Oeuvres dramatico-musicales. *Interauteurs*, no. 144 (3d quarter 1961), p. 240. "Circulaire 8."

A French translation of Copyright Office Circular no. 8, Dramatico-musical works. See 8 BULL. CR. SOC. 369, Item 357 (1961).

144. U. S. COPYRIGHT OFFICE.

Protection du copyright dans les pays étrangers en faveur des citoyens des États-Unis. *Interauteurs*, no. 144 (3d quarter 1961), pp. 240-242. "Circulaire 37."

A French translation of Copyright Office Circular no. 37, Copyright protection in foreign countries for United States citizens. See 8 BULL. CR. SOC. 304, Item 281 (1961).

145. U. S. COPYRIGHT OFFICE.

Copyright sur les périodiques. *Interauteurs*, no. 144 (3d quarter 1961), pp. 242-243. "Circulaire 42."

A French translation of Copyright Office Circular no. 42, Copyright for periodicals. See 8 BULL. CR. SOC. 368, Item 354 (1961).

146. U. S. COPYRIGHT OFFICE.

Dessins d'actualité et bandes dessinés. *Interauteurs*, no. 144 (3d quarter 1961), pp. 244-245. "Circulaire 55."

A French translation of Copyright Office Circular no. 55, Cartoons and comic strips. See 8 BULL. CR. SOC. 368, Item 353 (1961).

2. FOREIGN NATIONS

147. GERMANY (FEDERAL REPUBLIC, 1949-) *Laws, statutes, etc. (Proposed)*.

Regierungsentwürfe zur Urheberrechtsreform. [Bonn, 1961.] 175, 22, 27, 11 p.

A recently issued publication of the official copyright reform drafts of the West German Government, consisting of the Draft Law on Copyright and Neighboring Rights; Draft Law concerning the Performing Rights Societies; Draft Law concerning the adherence of the Federal Republic of Germany to the Brussels Revision of the Berne Convention; and the Draft Law concerning the adherence of the Federal Republic of Germany to the European Agreement on the Protection of Television Broadcasts of June 22, 1960. Each of the draft laws is accompanied by explanatory statements of motives, and the Draft Law on Copyright and Neighboring Rights also includes a tabular comparison of its provisions with those of the existing copyright law.

148. GHANA (REPUBLIC OF). *Law, Statutes, etc.*

Copyright Act, 1961. Act 85 of Nov. 8, 1961. An act to make provision for copyright in literary, musical and artistic works, cinematograph films, gramophone records and broadcasts. 12 p.

Ghana's new Copyright Act has been enacted with provisions specially referring to the Universal Copyright Convention. However, no word has yet been received concerning Ghana's proposed adherence to the Convention, nor is it known when the new copyright act will become effective.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS149. DIPLOMATIC CONFERENCE ON NEIGHBORING RIGHTS, *Rome, 1961.*

Conférence diplomatique sur la protection internationale des artistes interprètes ou exécutants, des producteurs de phonogrammes et des organismes de radiodiffusion, Rome, 10-26 octobre 1961. 74 *Le Droit d'Auteur* 346-360, no. 12, Dec. 1961.

A brief statement about the conference followed by the full text of the new convention in English, French and Spanish in parallel columns.

PART IV.

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

150. *Arc Music Corp. v. Lee*, 296 F. 2d 186, 131 U.S.P.Q. 338 (2d Cir., Nov. 27, 1961) (Clark, J.).

Appeal from judgment for defendant in action for copyright infringement. Defendant's song "Love Is Strange" allegedly was copied from Plaintiff's song, "Billy's Blues."

Held, affirmed.

Plaintiff argued that there was an "inverse ratio" rule which should be applied in determining the existence of plagiarism in a given case. The effect of this rule was stated to be that the stronger the evidence to access, the less proof of similarity should be required.

According to the court there was "no such principle in the federal law of copyright." The court noted that the case cited by defendant as authority for the claimed principle (*Golding v. R.K.O. Pictures, Inc.*, 208 P. 2d 1, 82 U.S.P.Q. 136, 35 Cal. 2d 690, 221 P. 2d 95, 86 U.S.P.Q. 537) does state that when there is strong evidence of access "less proof of similarity may suffice," but that if such evidence is uncertain, "strong proof of similarity should be shown before the inference of copying may be indulged." This, however, was not equivalent to saying that the stronger the evidence of one of the essential elements of plagiarism, the less evidence was needed of the other. The court indicated that the weakness of plaintiff's claimed principle was demonstrated by its "logical outcome . . . that proof of actual access will render a showing of similarities entirely unnecessary."

Holding that plaintiff's position was not supported by authority, the court said:

"Of course, access shown either directly or indirectly is an element of plaintiff's case. And it is not an unnatural step in inference of fact for ease of access to suggest a deduction of copying when similarity is found. But access will not supply its lack, and undue stress upon that one feature can only confuse and even conceal this basic requirement."

In the face of a finding that the two melodies were not substantially similar, proof of access alone was held insufficient to establish copyright infringement.

151. *Consumers Union of United States, Inc. v. Hobart Mfg. Co.*, 199 F. Supp. 860, 131 U.S.P.Q. 438 (S.D.N.Y., Dec. 4, 1961) (Murphy, J.). For decision on preliminary injunction, see 189 F. Supp. 275, 125 U.S.P.Q. 296, 7 BULL. CR. SOC. 24, Item 310 (1960).

Action for copyright infringement and unfair competition. Defendant circulated among its dealers and distributors a sales bulletin challenging plaintiff's rating of defendant's washing machine (in "Consumers Reports") as second best. Plaintiff alleged and defendant admitted that the sales bulletin contained material copied from plaintiff's publication. Defendant was charged with unfair competition in that the sales bulletin allegedly contained misstatements and out-of-context excerpts which would injure plaintiff's reputation. Defendant moved for summary judgment.

Held, motion granted as to claim for copyright infringement, denied as to claim for unfair competition.

I. With regard to copyright infringement, it was held, as defendant contended, that the material copied from plaintiff's "Consumers Reports" was not copyrightable. Quoting from Judge Dimock's opinion on the motion for preliminary injunction, the court said:

"In no instance did material which was copied into the Bulletin have any original literary form which would entitle it to copyright protection. Each item was a bald statement of fact which could hardly have been stated in any different fashion. I am faced with an attempt to clothe with copyright protection a compilation of facts. It cannot be gainsaid that this is one of the functions of the copyright system. A man who has tramped the streets and compiled a directory can, by copyrighting the product, obtain protection against a competitor who merely copies his work. He could not, however, obtain protection against someone who published an article upon the distribution of residents in relation to national origin and who used a compilation from the directory for locating the concentrations of persons bearing names characteristic of the various national origins. The directory cases are exceptions to the rule that facts are not a proper subject of copyright. That exception does not go so far, however, as to prohibit non-competitive use of facts set forth in a copyrighted collection. See *Kane v. Pennsylvania Broadcasting Co.*, D.C.D. Pa., 73 F. Supp. 307."

II. With regard to unfair competition, the court expressed "some misgivings as to whether or not there is any 'competition' between the parties." It was held, however, that there were issues of fact on this claim, however minimal, which must be resolved at trial.

152. *United Artists Associated, Inc. v. NWL Corp.*, 198 F. Supp. 953, 132 U.S.P.Q. 248 (S.D.N.Y., May 24, 1961) (Herlands, J.).

Action for copyright infringement. Defendant operates a community antenna system serving approximately 13,000 television subscribers in West Virginia to whom it rebroadcasts motion pictures licensed by plaintiff to others for television broadcasting. Defendant moved to transfer the action from the Southern District of New York to the Northern District of West Virginia; plaintiff moved to strike from defendant's answer the defense of "misuse of copyright."

Held, both motions denied.

I. With respect to the motion for transfer, it was held that although defendant had alleged that trial in New York would cause undue expense, disruption of defendants' business because of the necessity of moving records from West Virginia, and inconvenience to witnesses, it had not sustained its burden of showing that convenience of parties and interests of justice would be better served by trial in another district. The court stated that choice of forum should not be disturbed unless balance of convenience and justice was strongly in favor of defendant.

II. With respect to the defense of misuse of copyright, defendant charged that plaintiff's copyrights were being used in violation of the antitrust laws and argued that this should bar copyright protection. The issue, according to the court was:

"Does misuse of copyright bar an infringement action whether or not the misuse also violates the antitrust laws; and is the privilege to raise that defense grounded not upon injury to defendant, but on the misused monopoly's unenforceability against anyone?"

Holding that the alleged insufficiency of the misuse defense was not "clearly apparent," the court referred to *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U.S. 488 (1942), in which a complaint for patent infringement had been dismissed on the ground that the plaintiff had used the patent to restrain competition with the patentee's sale of an unpatented product. The court then stated:

"While a court of equity will withhold relief against even a stranger to the misuse, where the patentee is using the *patent*

privilege contrary to the public interest . . . , it is a substantial question whether a like rule, invokable in the same manner, is applicable to an action for infringement of *copyright*."

Having noted that "as a general rule, it is not a defense to a copyright infringement action to allege that plaintiff is violating the antitrust statutes by a combination in restraint of trade," the court went on to point out that while copyright protection has been withheld because the "granting thereof would tend to serve the plaintiffs in their plan and scheme . . . to extend their copyrights in a monopolistic control beyond their proper scope" *M. Witmark & Sons v. Jensen*, 177 F. 2d 515 (8th Cir. 1949), relief was granted to the copyright proprietor in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 74 F. Supp. 973 (S.D.N.Y. 1947), affirmed 191 F. 2d 99 (2d Cir. 1951), despite a finding that the copyrights were being used in restraint of trade. It was stated by the Second Circuit in the latter case that a conflict of policies between preventing piracy of copyrighted matter and enforcing the antitrust laws requires a balancing "taking into account the comparative innocence or guilt of the parties, the moral character of their respective acts, the extent of the harm to the public interest, the penalty inflicted on the plaintiff if we deny it relief." (191 F. 2d 106) (Frank, J.)

Because the question of the sufficiency of the misuse defense presents a substantial question of law, and "a determination of the effect of plaintiff's alleged misuse of copyright on its action for infringement requires a delicate balancing of competing public policies in an area of the law that is yet evolving" it was held that a definitive adjudication should be made only after a plenary hearing.

153. *Prestige Floral v. California Artificial Flower Co.*, 132 U.S.P.Q. 350 (S.D.N.Y., Jan. 5, 1962) (Feinberg, J.).

Action for copyright infringement. Plaintiff is a French corporation which designs, manufactures and exports molded polyethylene flowers. It seeks to enjoin defendants from bringing into the United States plastic flowers manufactured in Hong Kong which are alleged to be piratical copies of plaintiff's copyrighted lilac, plaintiff's flower having been registered in the United States Copyright Office as a work of art.

Held, preliminary injunction granted.

1. Defendants argued that there was not sufficient artistry in the creation of artificial flowers to justify copyright protection. The court held, however, that "though a flower . . . is a creation of nature, a

likeness of it may be copyrighted. This conclusion seems particularly justified when the creation involves . . . numerous and detailed decisions as to 'proportion, form, contour, configuration and conformation.' " *F. W. Woolworth Co. v. Contemporary Arts, Inc.*, 193 F. 2d 162 (1st Cir. 1951), *aff'd* 344 U.S. 228 (1952). See *Peter Pan Fabrics, Inc. v. Candy Frocks, Inc.*, 187 F. Supp. 334 (S.D.N.Y. 1960) which involved a floral design for a dress fabric.

Quoting from Copyright Revision Study No. 3, *The Meaning of "Writings" in the Copyright Clause of the Constitution*, 100-101, 31 N.Y.U.L. Rev. 1263, 1303 (1956), the court said:

"The courts in recent years, particularly since *Mazer v. Stein*, are beginning to realize the validity of the copyright approach and are gradually overcoming their hesitation to hold, expressly or impliedly, that a three-dimensional object is a 'writing' . . . In August, 1956, the Copyright Office issued regulations which . . . explicitly describe what can be registered. These regulations do not talk in terms of 'writings' but do require that any object offered for registration meet at least minimal standards of originality and creativity . . ."

Having found that plaintiff's lilac "reflects originality and a substantial degree of skill and independent judgment," the court held it to be a proper subject of copyright. *Mazer v. Stein*, 347 U.S. 201 (1954); *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F. 2d 99 (2d Cir. 1951).

2. Defendants also contended that plaintiff's copyright notices were defective in two respects. First, they urged that the notices (one molded on the stem of the flower, the other on the underside of a leaf) were insufficient because they could not be seen by the naked eye. The court found, however, that the notice on the stem was clearly visible, the one on the leaf "considerably more difficult to make out." The court said:

"That . . . (the notice) is on the underside of a leaf would not of itself seem objectionable. *Coventry Ware, Inc. v. Reliance Picture Frame Co.*, 288 F. 2d 193 (2d Cir.), *cert. denied* — U.S. — (1961); *Scarves by Vera, Inc. v. United Merchants*, 173 F. Supp. 625 (S.D.N.Y. 1959). The notice can be seen by the naked eye although 'close examination is required to locate it.' *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, 134 F. Supp. 551 (S.D.N.Y. 1955). . . ."

Having found further that plaintiff had established, *prima facie*, defendants' actual notice, the court held that difficulty in discerning the notice

on the leaf should not of itself prevent the granting of a preliminary injunction.

Secondly, defendants urged that plaintiff's copyright may have been invalidated by a post-dated notice on the 1961 version of the flower, which was first published in 1959. In addition to "c Prestige Floral" one of the notices said "Mod. Depose 1961" while the other added instead, "Mod. Depose 1959." The court held that although "apparently no date was necessary on plaintiff's flower, *Fleischer Studios v. Ralph A. Freundlich, Inc.*, 73 F. 2d 276, 278 (2d Cir. 1934)," and defendants did not claim that the notice on the leaf was inaccurate, the difference in date between the two notices might be confusing. However, the court did not "believe that plaintiff's copyright notice is thereby rendered so affirmatively misleading as to justify invalidating the copyright." Moreover, it was held that the defendants were not in fact misled.

3. It was held that, in addition to establishing valid statutory copyright, the plaintiff had made out a prima facie case of infringement, as required for the granting of a preliminary injunction. Access was shown, as was similarity. With respect to the latter, the court quoted from *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 173 F. Supp. 292 (S.D.N.Y. 1959) (L. Hand, J.):

"The test for infringement of a copyright is necessarily vague . . . In the case of designs . . . one cannot say how far an imitator must depart from an undeviating reproduction to escape infringement. In deciding that question one should consider the uses for which the design is intended, especially the scrutiny that observers will give to it as used . . ."

Applying Judge Hand's test, and basing his conclusions on his own comparison of the flowers as well as on the affidavits and other evidence, the court found that the "allegedly infringing lilacs are copies of plaintiff's lilac and that the claimed variations between them do not sufficiently differentiate them."

154. *Norwood Imports v. United States*, 132 U.S.P.Q. 216 (Cust. Ct., 2d Div., Dec. 27, 1961) (Lawrence, J.).

Protest against refusal of collector of customs at Chicago to permit entry of artificial geraniums imported from Hong Kong.

Held, protest overruled.

1. A letter to the collector of customs "expressing dissatisfaction" with the exclusion of the plaintiff's geraniums, although not a formal

protest, was held to satisfy the requirement of Section 514 of the Tariff Act (19 U.S.C. Sec. 1514) that a protest be filed within sixty days.

2. Plaintiff contended that its flowers were not "piratical copies" of a copyrighted work. It offered no oral testimony, resting the argument on the exhibits submitted. Holding that "plaintiff failed completely in its effort to prove that said geraniums were illegally excluded from entry," the court said:

"It is observed that the definition of the words 'piratical copies' includes not only 'actual copies' but as well 'substantial reproductions' of copyrighted works. [Cf. Customs Regulations, Sec. 1120-a.]

"If we were required to determine at this point whether or not plaintiff had made a prima facie case, we would have to exercise our judicial knowledge and by ocular inspection and comparison of exhibit 2 [specimen of plaintiff's geraniums] with exhibits 3-A and 5 [photographs of artificial geranium copyrighted by one A. E. Decamp], declare that exhibit 2 is not a piratical copy of the copyrighted article. However, we are of the considered opinion that the refinements of a comparison between a physical exhibit of an artificial geranium with a photograph is quite beyond the realm of judicial notice.

"A government official acting in the discharge of his duties over which jurisdiction is given him is presumed to have acted rightly. Therefore, it must be presumed that the collector of customs properly discharged his duties in excluding the geraniums in controversy, and the burden rests upon plaintiff of proving in fact and law that error has been committed. *United States v. Frank & Lambert*, 2 Ct. Cust. Appls. 239, T.D. 31973; *United States v. Glendinning, McLeish & Co., Inc.*, 12 Ct. Cust. Appls. 222, T.D. 40229; *E. I. du Pont de Nemours & Co. v. United States*, 27 CCPA 146, C.A.D. 75. . . .

"In any event, the evidence introduced on behalf of the defendant establishes beyond question that if not 'actual copies,' the imported geraniums are in any event 'substantial reproductions' of legally copyrighted works produced and imported in contravention of the rights of the copyright proprietor and, therefore, are 'piratical copies' within the meaning of the Copyright Act."

155. *Klasmer v. Baltimore Football, Inc.*, 200 F. Supp. 255, 132 U.S.P.Q. 36 (D. Md., Dec. 15, 1961) (Thomsen, C. J.).

Action for copyright infringement. Plaintiffs wrote "The Baltimore Colts' Official Theme Song" and were the owners of the copyright when

it was registered as an unpublished work. It was subsequently published by the Colts, a professional football team, and is played at the games, on radio and television and elsewhere. Plaintiffs now seek compensation for the use of the song.

Held, judgment for defendants.

The court held that three separate publications without proper notice had led to the forfeiture of plaintiffs' copyright in their song.

a) With full authority from plaintiffs, the Colts published the song with a copyright notice reading, "Copyright 1947 by The Baltimore Colts, Jo Lombardi and Benjamin Klasmer." This notice was defective because the authors, Lombardi and Klasmer, had not then assigned any interest in the copyright to the Colts. With respect to this defective notice, the court rejected plaintiff's contention that the notice was adequate in that it sufficiently stated that a claim to copyright was made and would enable persons seeing it to identify the copyright proprietors upon inquiry. It was held that because the right is purely statutory, the copyright claimant must follow the statute, at least substantially. *Mifflin v. R. H. White Co.*, 190 U.S. 260.

b) Band arrangements of the song with no notice of copyright whatever were distributed to local high school bands, volunteer bands and others. The court found this to be a public distribution without limitation as to use, and therefore a general publication.

c) For a number of years, the words of the song, without any copyright notice, were printed in the programs of the Colts' home games. This publication, like the others, was found to be authorized by the plaintiffs.

The court stated:

"(The law requires) . . . that notice of copyright be affixed to each copy of the work published or offered for sale in the United States by authority of the copyright proprietor, 17 U.S.C.A. 10, *Dejonge v. Brucker*, 235 U.S. 33. 'The provisions of the statute must be complied with in making and selling a copyrighted article, or otherwise there is a dedication to the public and copyright protection is lost.' *Fleischer Studios v. Ralph A. Freundlich, Inc.*, 2 Cir., 73 F. 2d 276, 277, 23 U.S.P.Q. 295, 296, cert. den. 294 U.S. 717. Even '(p)artial publication of a copyrighted work without the required notice has been repeatedly held to make the material published the property of the public.' *Deward & Rich v. Bristol Savings & Loan Corp.*, 4 Cir. 120 F. 2d 537, 540, 50 USPQ 1, 4. In *National Comics Publications v. Fawcett Publications*, 2 Cir. 191

F. 2d 594, at 598, 90 USPQ 274, 277, Judge Learned Hand noted that strictly speaking the terms 'dedication' and 'abandonment' should be applied to instances of intentional surrender, whereas an author whose work is 'forfeited' need have no such purpose and ordinarily does not; the forfeiture is imposed upon him because of his failure to comply with prescribed formalities."

There was also a failure to reregister the song after publication and a written assignment of all rights to the song made by plaintiffs to one of the several successive corporations which owned the Colts. The court held the assignment, although informal and unrecorded, to be valid as between the parties, and therefore sufficient to divest the plaintiffs of their rights, if any.

Defendants' contention that plaintiffs were estopped to assert their claim was not reached by the court "in view of the decision on the issues of dedication, forfeiture and assignment."

156. *Gelles-Widmer Co. v. Milton Bradley Co.*, 132 U.S.P.Q. 30 (N.D. Ill., Nov. 21 and Dec. 8, 1961) (Wham, J.).

Action for copyright infringement and unfair competition. Plaintiff was the author of several "educational works" consisting of flash card sets designed for use by children in the home to aid in their learning the alphabet and basic arithmetical skills. Each set included explanations, instructions and "progress testing sheets" in addition to the cards. All of these were copied by a photographic process and the copies published and distributed by the defendants. Defendants were also charged with unfair competition in that they allegedly used their dominant position in the children's game and educational materials industry to induce customers to purchase defendants' flash cards in preference to plaintiff's product.

Held, judgment for plaintiff on copyright infringement; judgment for defendants with regard to unfair competition.

I. With respect to copyright infringement, it was held that the plaintiff's flash card sets were copyrightable, the court having found as a fact that:

"These flash card sets, including the explanations, instructions and progress testing sheets, contain material wholly original with plaintiff in expression, style, arrangement, sequence and plan of compilation . . ."

That defendants' card sets were copied from plaintiff's was conceded. The plagiarism having been found to be wilful and deliberate, plaintiff was awarded counsel fees in addition to an injunction against further infringement, damages, and an accounting of profits. The decree also provided that defendants were to deliver up for destruction all remaining infringing copies in their possession, together with all molds and matrices.

II. No confusion, likelihood of confusion or misrepresentation as to source having been found, it was held that defendants were not guilty of unfair competition. The court found, as plaintiff had alleged, that defendants had used their "dominant position" to secure sales. The court concluded, however, that:

"The wrong committed by the defendant was the copying and infringement of the plaintiff's copyrighted products and the use of its own good will founded on a long history of dependable service to its customers, also business associates, and friendships built up over the years, constituting it a powerful competitor, to induce the wholesalers in particular to accept its new infringing products . . . This was not unfair competition . . ."

2. State Court Decisions

157. *Denker v. Twentieth Century-Fox Film Corp.*, 132 U.S.P.Q. 82 (N.Y. Ct. App., Nov. 30, 1961) (Fuld, J.).

Action to rescind for breach of contract an exclusive license granted by plaintiff and the Ourslers, joined as defendants, to film "The Greatest Story Ever Told," and for damages. The trial court denied defendant's motion for judgment on the pleadings and to dismiss the cause of action for rescission as insufficient in law, 210 N.Y.S. 2d 241, 8 BULL. CR. SOC. 268, Item 224 (1961). The Appellate Division modified the trial court's order and granted defendant's motion to dismiss the first cause of action, 13 A.D. 2d 627, 213 N.Y.S. 2d 214, 8 BULL. CR. SOC. 318, Item 295 (1961). Plaintiff appeals this modification.

Held, on appeal, affirmed.

1. The court held that since it required the joint action of Denker and the Ourslers to effect a grant of the exclusive motion picture rights, it would require similar joint action to undo what was done and obtain rescission of the contract. The court said:

"There is no doubt that the plaintiff and the Oursler Estates are co-owners of copyrighted material and, as such they are to be

considered tenants in common. . . . Either Denker or one of the Ourslers had the power, acting alone, to grant nonexclusive motion picture rights to third persons (see *Nillson v. Lawrence*, 148 App. Div. 678; *Klein v. Beach*, 232 F. 240, *aff'd* 239 F. 108 [2nd Cir.]) . . . but it is clear that exclusive rights to a copyright may be effected only by a grant in which all of the co-owners join."

Noting that in the instant case all three of the co-owners had joined in granting exclusive rights to Fox, the court went on:

"Even assuming, therefore, that (Fox) . . . had breached its obligation, the plaintiff alone would not be able to procure a rescission of the contract."

Where several parties are joint contractors, joint purchasers or joint vendors, the court said, the rule is that one of them alone cannot repudiate or terminate the contract, or obtain its rescission, without the consent or against the objections of the others.

2. The plaintiff contended that if he was not entitled to rescission of the entire contract, he should have rescission as to his interest alone. Rejecting this argument, the court pointed out that if the plaintiff were to have a partial rescission, he would reacquire the right to grant a non-exclusive license to produce the picture. This would convert the exclusive grant to Fox to a non-exclusive license, which would materially alter its value. The court stated:

"Since 'The Greatest Story Ever Told' is based on the Bible, its factual content is in the public domain and the primary commercial value of the picture lies in the title of the copyrighted work. It is safe to venture that no motion picture producer would purchase a non-exclusive license to produce a picture based on the property, and neither Fox nor any other party would make the substantial investment necessary to produce and promote such a picture if another producer could lawfully release a picture dealing with the same subject and bearing an identical title."

3. It was held that the mere fact that the Oursler Estates had refused to join as plaintiffs in this action was not sufficient to support plaintiff's contention that such refusal was in bad faith and therefore justified plaintiff in proceeding alone, although the presence of fraud or bad faith "may well enlarge the right" of one of several coparties to a contract to act alone and procure a rescission, if proved.

158. *Speelman v. Pascal*, 178 N.E. 2d 723, 10 N.Y. 2d 313, 222 N.Y.S. 2d 324, 131 U.S.P.Q. 489 (Nov. 16, 1961) (Desmond, C.J.).

Appeal from a decision of the Appellate Division, 10 A.D. 2d 619, 197 N.Y.S. 2d 424 (Feb. 16, 1960) (memorandum decision) affirming 15 Misc. 2d 767, 182 N.Y.S. 2d 927 (Mar. 2, 1959) (Hofstadter, J.) in which plaintiff was granted summary judgment in action to establish right to participate in profits from "My Fair Lady." Gabriel Pascal was the principal stockholder of Gabriel Pascal Enterprises, Ltd., which corporation owned exclusive world rights to prepare and produce a musical play based on George Bernard Shaw's "Pygmalion" and a motion picture version of the musical play. Before the musical was written or produced, Pascal delivered to the plaintiff a letter in which he said, "I give you from my shares of profits of the Pygmalion Musical stage version . . . (and) from the film version" certain stated percentages. After Pascal's death, "My Fair Lady" was produced, based upon "Pygmalion". Plaintiff sues Pascal's estate to enforce payments to her pursuant to the alleged gift.

Held, judgment for plaintiff affirmed.

1. In holding that future royalties may be assigned, the court said:

"It is true that at the time of the delivery of the letter there was no musical stage or film play in existence but Pascal, who owned and was conducting negotiations to realize on the stage and film rights, could grant to another a share of the moneys to accrue from the use of those rights by others. There are many instances of courts enforcing assignments of rights to sums which were expected thereafter to become due to the assignor. *Field v. Mayor of City of New York*, 6 N.Y. 179; *Central Trust Co. of New York v. West India Improvement Co.*, 169 N.Y. 314."

2. It was further held that the gift was valid and completed upon the delivery of the letter, since the language thereof showed a clear intent to make a valid present gift and no additional act was required to effect a transfer.

159. *Michael Todd Company v. County of Los Angeles*, 16 Cal. Rep. 921 (Dist. Ct. App., 2d Dist., Nov. 17, 1961) (Herndon, J.).

Action to recover personal property taxes paid under protest. In 1957, Los Angeles County taxed negatives of "Around the World in Eighty Days" as tangible personal property valued at \$1,529,900. It was stipulated that the assessor considered the right of reproduction of

the negative "which the owner would not have but for his copyright." From judgment for defendant in the trial court plaintiff appeals.

Held, on appeal, affirmed.

Plaintiff had contended that it was improper to consider the value of the copyright in assessing the tax on the ground that copyrights are intangible property not subject to the personal property tax under California law, and that including the value of the copyright in assessing motion picture negatives is equivalent to a direct assessment of the copyright itself.

Holding that intangible values that cannot be separately taxed as property "may be reflected in the valuation of taxable property" the court said:

"Unquestionably, a copyright, considered alone, is an intangible. But there is nothing in federal law or in constitutional principles that renders it immune from state taxation, *Fox Film Corp. v. Doyal*, 286 U.S. 123, *Stone v. Stapling Machines Co.*, 221 Miss. 555, 73 So. 2d 123. . . . There is no inhibition in the state constitution or in the statutes upon inclusion of the value of any and all intangible rights and privileges owned by a taxpayer in the assessment of a tangible to which the pertinent intangibles lend a peculiar value." *Roehm v. County of Orange*, 32 Cal. 2d 280, 196 P. 2d 550; *Stein v. Mayor of City of Mobile*, 17 Ala. 234.

". . . It seems to us that the instant case does not actually turn upon the question of whether a copyright is per se an intangible or whether the right to make copies of the film is essentially intangible. Basically, ownership of anything is a bundle of intangible rights with respect to use, disposition, sale or other exercise of dominion over it. . . . That bundle of rights, each an intangible in itself, takes on the status of the property to which it relates, whether it be realty or personalty, and supplies the elements of value upon which the tax must be predicated. . . . If it be a literary property, such as a motion picture film, its value to its owner is affected by his possession or lack of the exclusive right to copy or sell or lease. There seems to be no reasonable or practical basis for dissecting it into the tangible and intangible elements that make up the whole of its value and assessing only that which separately can be designated as tangible . . ."

The court concluded that the value of the copyright had not been "included" in the assessment, but rather had been quite properly "con-

sidered" in arriving at the value of the tangible personal property, the negative films.

Also of interest:

160. *United States v. Loew's, Inc.*, 189 F. Supp. 373, 131 U.S.P.Q. 348 (S.D.N.Y., Dec. 2, 1960) (Dawson, J.), appeal filed Nov. 17, 1961, 131 U.S.P.Q. II.

In actions under Sections 1 and 3 of the Sherman Act, block booking of copyrighted motion picture films for television was held to be illegal where there was "conditioning of the license of one or more films upon whether or not other feature films were also licensed . . ."

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

161. FINKELSTEIN, HERMAN. Public performance rights in music and performance right societies. Rev. ed. New York, 1961. 28 p.

A revised edition of a lecture first published in 7 *Copyright Problems Analyzed* (Commerce Clearing House, c1952).

162. HOWELL'S COPYRIGHT LAW. Rev. ed. by ALAN LATMAN. Washington, 1962. 358 p.

Mr. Latman has thoroughly revised this standard text on copyright law and procedure written and last revised in 1952 by Herbert A. Howell, former Assistant Register of Copyrights. Added are analyses of recent trends in copyright as well as chapters on taxation, corporate techniques and depreciation of copyright. Appendices include the Copyright Law of 1909, Copyright Office regulations, U.S. Supreme Court Rules, Customs Regulations, and the texts of the Berne and Universal Conventions.

163. HURST, WALTER E. AND HALE, WILLIAM S. THE RECORD INDUSTRY BOOK. Hollywood, California, 1961.

A comprehensive study of the recording industry addressed to the layman and containing information on contracts, laws affecting the recording industry, and domestic and foreign rights.

2. Foreign Publications

1. In German

164. Quellen des Urheberrechts; Gesetztexte aller Länder und Tabellen über internationale Verträge, mit systematischen Einführungen, Herausgeber: Philipp Möhring, Erich Schulze, Eugen Ulmer und Konrad Zweigert. 1. Lfg. Frankfurt am Main, A. Metzner, 1961. 1 v. (loose-leaf.)

The first number of an important loose-leaf publication which will contain, for each country in the world, the following copyright source information: a systematic introduction to the existing copyright law, the

text of the copyright law in the original language and German translation, in parallel columns, multilateral and bilateral treaties to which the country adheres, in tabular form, and a list of the country's performing rights and author societies.

The first number covers the following countries: Belgium, France, Great Britain, Luxembourg, Netherlands, Austria, Switzerland, Turkey, and the United States. In the case of Turkey, a French translation of the copyright law is given instead of the original Turkish text. The work will be kept up to date by supplementary material.

B. LAW REVIEW ARTICLES

1. United States

165. BOXER, LESTER. Dramatic performing rights in dramatico-musical compositions: scope of protection. (34 *Southern California Law Review* 447-467, no. 4, Summer 1961.)

"This comment [awarded first prize, Nathan Burkan Competition, 1961, University of Southern California] concerns itself mainly with dramatico-musical compositions, although the question of the scope of protection afforded musical compositions will be raised and discussed as a means of comparison. It deals with the following issues: 1) What is a dramatico-musical composition; 2) What constitutes its infringement; and 3) What varying degrees of protection are granted to the author or composer of a dramatico-musical work in the major fields of the entertainment industry."

166. COLBY, RICHARD. Copyright protection for cinematographic works under the Universal Copyright Convention. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 271-287, no. 3, Dec. 1961.)

An expansion, by the author, of an article which appeared in French and English in the July 1961 issue of *Le Droit d'Auteur*. See 9 BULL. CR. SOC. 97, Item 47 (1961).

167. LAVIN, FREDERICK M. Copyrights—Common law protection of letters. (7 *Villanova Law Review* 105-116, no. 1, Fall 1961.)

"It is the purpose of this comment [entered in the Nathan Burkan Memorial Competition] to analyze in detail the common law copyright interest in letters, based on established precedents in the United States, England and several other countries, so as to provide a basis with which to answer . . . questions . . . which might arise in this field."

168. SILVERMAN, ARNOLD B. The copyright halo: a comparison of judicial standards for copyrights and patents. (23 *University of Pittsburgh Law Review* 137-155, no. 1, Oct. 1961.)

This paper, which was entered in the Nathan Burkan Memorial Competition, attempts to discover the reasons why, "in the courts . . . a very large percentage of patents are found to be invalid, whereas copyrights are, for the most part upheld." The author states that "in the light of such information, it would then be possible to determine the advisability of changing the present copyright and patent laws in order to best effectuate the constitutional policy [of fostering the growth of culture and knowledge]".

169. Standing to sue in copyright. (29 *University of Chicago Law Review* 200-213, no. 1, Autumn 1961.)

A comment, submitted for the Nathan Burkan Memorial Competition at the University of Chicago Law School, which examines the following two broad categories of cases involving standing to sue in infringement suits: (1) where the copyright owner has licensed one or several methods of exploitation, and (2) where the copyright has been transferred and only a royalty interest retained.

170. Television station held not to have property right in its broadcast. (61 *Columbia Law Review* 1523-1529, no. 8, Dec. 1961.)

A case note on *Intermountain Broadcasting & Television Corp. v. Idaho Microwave, Inc.*, 196 F. Supp. 315, 8 BULL. CR. SOC. 373, Item 368 (S.D. Idaho 1961).

2. Foreign

(a) English

171. COLBY, RICHARD. United States copyright renewals and french [sic] authors. (*Revue Internationale du Droit d'Auteur* 58-83, no. 33, Oct. 1961.)

"A current introduction [in English, French and Spanish in parallel columns] to a somewhat complicated aspect of the United States copyright law—the renewal or second twenty-eight year term of American copyright," written by the author for the purpose of being used "in connection with international sales of motion picture, television, stage and similar rights by French and other European authors."

172. GRASSI, ALESSANDRO. Notes on the subject of electronic music. (*EBU Review* 66-73, no. 70B, Nov. 1961.)

Contents.—Electronic works considered as intellectual works.—Electronic works considered as musical works.—Existing rights in electronic works and the relations between their proprietors.—The relations between publishers of conventional music and composers of electronic works.—The status of the 'technician.'

An examination of problems to which electronic music may give rise from the legal point of view in Italy.

(b) French

173. Association Littéraire et Artistique Internationale. *Congrès de Florence, Sept. 1961*. Actes du 49^e Congrès, Florence, 11-16 septembre 1961. (*Interauteurs* 283-291, no. 145, 4th quarter 1961.)

An account of the activities of the 49th Congress of A.L.A.I. held at Florence, Italy, Sept. 11-16, 1961. See also 9 BULL. CR. SOC. 152, Item 63 (December 1961).

174. HIRSCH-BALLIN, ERNST D. Le droit d'auteur à la croisée des chemins. (*Interauteurs* 263-267, no. 145, 4th quarter 1961.)

A French translation of an address delivered at the Fourth International Congress of Religious Music held at Cologne, June 22-30, 1961, which is a strong defense of the natural rights of an author as well as a criticism of the tendency to put record manufacturers, broadcasting organizations, and performers on an equal or better footing than authors.

175. LEVITSKY, SERGE L. La protection des droits d'auteur dans la législation soviétique. (*Interauteurs* 171-189, no. 144, 3d quarter 1961.)

"Article paru en langue allemande dans la revue Osteuropa (février-mars 1960, Stuttgart.)"

A discussion of the legal nature and practical application of Soviet copyright legislation, with special reference to the restrictions placed upon the "exclusive right" of the author.

176. LUND, TORBEN. Lettre du Danemark. (74 *Le Droit d'Auteur* 341-345, no. 12, Dec. 1961.)

The purpose of this article is, on one hand, "to state in more detail the fundamental principles and the new provisions [of the Danish Copyright Law of May 16, 1961], on the other, to stress those points in which the finally adopted text differs from the 1959 draft."

177. RONGA, GIULIO. La règle de l'unanimité pour la révision des Conventions de Paris et de Berne. (*Revue Internationale du Droit d'Auteur* 2-19, no. 33, Oct. 1961.)

A comparative analysis, in French, English and Spanish in parallel columns, of the application of the rule of unanimity governing the amendment procedure of the Berne and Paris Conventions.

178. SCHULZE, ERICH. Musique sacrée et droit d'auteur. (*Interauteurs* 268-272, no. 145, 4th quarter 1961.)

A French translation of an address delivered at the Fourth International Congress of Religious Music held at Cologne, June 22-30, 1961, in which a case is made for legislation which will provide for adequate compensation to composers of religious music, with special reference to the pertinent provisions of the West German draft copyright laws.

179. TOURNIER, ALPHONSE. Quelques considérations nouvelles sur l'usage radiophoniques des disques du commerce. (*Revue Internationale du Droit d'Auteur* 84-107, no. 33, Oct. 1961.)

A restatement, in French, English and Spanish in parallel columns, of the thesis that the author "has the right to authorize the radiophonic use of records reproducing his work when he has authorized the use of these records for private use only."

180. TOURNIER, JEAN LOUP. Le droit exclusif du compositeur de musique: réalité ou fiction? (*Revue Internationale du Droit d'Auteur* 20-57, no. 33, Oct. 1961.)

An examination, in French, English and Spanish in parallel columns, of the limitations, generally justified under the "public interest" concept, which are imposed on the exclusive right of the music composer, particularly with reference to legal hindrances on the operations of author or performing right societies. The author concludes that the intervention of the state, if necessary, must not break "the existing equilibrium between the creation and the exploitation."

181. WILLEMETZ, ALBERT. René Jougllet. (*Interauteurs* 190-191, no. 144, 3d quarter, 1961.)

A eulogy of the late Honorary Secretary General of the International Confederation of the Authors' and Composers' Societies (C.I.S.A.C.).

(c) German

182. HEIN, GERHARD. Vereinbarkeit des "Rahmenabkommens über die Herstellung von Fotokopien" mit § 1 GWB. (11 *Wirtschaft und Wettbewerb* 18-25, no. 1, Jan. 1961.)

An examination of the question whether the agreement between the German Book Trade Association and the German Industrial Association, both of West Germany, concerning the making of photocopies by commercial enterprises for internal use, is compatible with Section 1 of the West German antitrust law (GWB). See 6 BULL. CR. SOC. 274, Item 305 (1959).

183. LORENZ, THOMAS. Das revidierte Haager Musterabkommen. (10 *Österreichische Blätter für Gewerblichen Rechtsschutz und Urheberrecht* 81-85, no. 5, Sept.-Oct. 1961.)

A brief analysis of the Hague revision of the Agreement concerning the International Deposit of Industrial Designs.

184. MÜNZER, GEORG. Zur Diskussion über das Wesen des Urheberrechts. (10 *Erfindungs- und Vorschlagswesen*, Ausg. B. 173-176, no. 10, Oct. 1961; Ausg. C. 192, no. 11, Nov. 1961.)

A comment on, and elaboration of the thesis of Heinz Püschel's article which appeared in 10 *Erfindungs- und Vorschlagswesen*, Ausg. B. 85-92, no. 5, May 1961, under the title "Das Urheberrecht als Teil des Zivilrechts." See 9 BULL. CR. SOC. 97, Item 50 (1961).

185. UCHTENHAGEN, ULRICH. Urheberrechts-Fragen des Buch- und Schallplattenverleihs. (*Schweizerische Mitteilungen über Gewerblichen Rechtsschutz und Urheberrecht* 121-133, no. 2, pt. 2, 1961.)

An examination, from the point of view of the Swiss copyright law, of the question of lending rights to books and phonograph records, with a brief comparative survey of the pertinent provisions of the French, West German and Italian copyright laws as well as a short note on the Scandinavian law.

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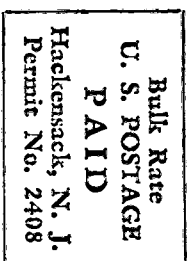
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PART I.

ARTICLES

186. TERRITORIALITY OF COPYRIGHT: AN ANALYSIS OF ASSIGNABILITY UNDER THE UNIVERSAL COPYRIGHT CONVENTION*

By ROGER M. MILGRIM

I

INTRODUCTION

The Copyright Act of 1909 is in many respects antiquated. In defiance of leaders of industry and the copyright bar, it endures in a form remarkably like the one in which it was originally fashioned. One significant change, however, is section 9(c), which enables the United States to fulfill the obligations of the Universal Copyright Convention, and thereby reap its benefits.

This multilateral compact provides for protection and permits freer flow of copyrightable matter among the contracting states. Inevitably, such an international venture presents some discomfort to industries that are built on national and linguistic lines. This paper is concerned with economic and cultural problems arising from the Convention, and presents a legal view which would permit proprietors in the various contracting states to deal efficiently with their property. Since proprietors often find it expeditious to assign copyright in one of the contracting states to an assignee whose contacts in that state allow fullest exploitation, the law should provide a means of effectuating such a transfer while still protecting the rights of assignor and assignee. A legal view permitting such transfers is in keeping not only with the terms, but also the spirit of the international compact, because copyrightable works would be distributed most profitably, and, therefore, most widely.

* This essay, which was awarded the National First Prize in the Nathan Burkan Memorial Competition in January 1962, was the prize-winning entry from New York University School of Law. It will be published in 12 ASCAP Copyright Law Symposium, and is printed here through the courtesy of the sponsor of the competition, The American Society of Composers, Authors and Publishers.

II

UCC: NEW DIMENSIONS AND PROBLEMS

The Universal Copyright Convention,¹ which granted extensive protection² to United States copyright proprietors,³ also exacted certain sacrifices. The parochial, protectionary manufacturing requirement⁴ had to be relaxed.⁵ This allowed unrestricted importation of foreign printed books and periodicals in

1. Aug. 5, 1955, 6 U.S.T. 2731, T.I.A.S. No. 3324 (effective Sept. 16, 1955), herein-after cited as UCC. Member states presently number thirty-four. Derenberg, Copyright Law, 36 N.Y.U.L. Rev. 585, in 1960 Ann. Survey Am. L. 210 (1961). (*Ed.*: Since this article was written, the UCC has been ratified and extended to 7 more countries: Denmark, Sweden, Nicaragua, Nigeria, Canada, Paraguay and Ruanda-Urundi (by Belgium).)
2. UCC art. II(1). UCC protection is not precisely international, but rather more the equivalent of "equal privileges and immunities" within each contracting state. See Tannenbaum, The Principle of "National Treatment" and Works Protected: Articles I and II, in *Universal Copyright Convention Analyzed* 13 (Kupferman & Foner ed. 1955).
3. UCC art. I speaks of "effective protection of the rights of authors and other copyright proprietors." (Emphasis added.) This language, read with the notice provision of art. III(1), requiring the © symbol "accompanied by the name of the copyright proprietor," indicates that UCC protection is intended for authors and proprietors, *i.e.*, assignees, alike. But see art. IV(2) which sets the term of protection in relation to life of author, and art. V(1) which makes the translation right the exclusive right of the author.

Additionally, it is persuasive that all nations granting copyright protection provide for transfer of copyright to some extent. 2 UNESCO Copyright Bull. 104-11 (1949). See Appendix to this paper.

4. Copyright Act of 1909, hereinafter cited as Copyright Act, 17 U.S.C. § 16 (1958). Section 16 applies to the manufacture of books and periodicals. Protest to UCC membership at the expense of relaxing the manufacturing requirement was registered by some book manufacturers. Hearings before Subcommittee No. 3 of the Committee on the Judiciary on H.R. 4059, 82d Cong., 2d Sess., Ser. 13, at 35 (1952), and some printer's trade unions. *Id.* at 56, 69, 76 and 80.
5. UCC art. X(1) requires parties to the convention to adopt necessary measures to ensure application of the various articles of the convention. Article III(1) prohibits, among other things, the manufacturing formality "with respect to all works protected . . . first published outside its [a contracting state's] territory and the author of which is not one of its nationals." Article II(3) permits a contracting state to assimilate as its own nationals persons domiciled within that state.

Public Law 743 (Act of Aug. 31, 1954, Pub. L. 83-743, 68 Stat. 1030) amended our Copyright Act to comply with UCC art. III(1). See Cary, The United States and Universal Copyright: An Analysis of Public Law 743, in *Universal Copyright Convention Analyzed* 83 (Kupferman & Foner ed. 1955). Works with proper UCC notice were exempted from the obligatory deposit requirement, the manufacturing requirements, and the import prohibitions of § 107 of the Copyright Act insofar as they related to the manufacturing provisions. Copyright Act, 17 U.S.C. § 9(c) (1958). The amendment, however, does not extend to the works of a United States

the English language for the first time since 1891.⁶ Furthermore, works first published abroad which formerly would have fallen into the United States public domain⁷ are now protected.

UCC protection expressly⁸ applies to the majority of classifications of works eligible for United States copyright.⁹ Works of art¹⁰ appear to be

citizen or domiciliary, regardless of place of first publication, or to any work first published in the United States. *Ibid.* This limitation, which is expressly permissible under UCC art. III(2), places a United States citizen or domiciliary at a distinct disadvantage. See generally, Younger, *Citizens Who Publish Abroad: A Study in the Pathology of American Copyright Law*, 44 *Cornell L.Q.* 215 (1959). Similarly, works first published in the United States are subject to all manufacturing and deposit requirements, thereby removing "backdoor" advantages of first or simultaneous publication here. See Derenberg, *The Status of United States Authors and Works First Published in the United States Under the Universal Copyright Convention*, 5 *BULL. CR. SOC.* 206 (1958). An interesting and ironical contrast is widespread United States use of Canada as a "backdoor" into Berne Union protection. See generally Fisher, *The 1948 Revision of the Berne Convention*, 10 *Fed. Com. B.J.* 53 (1949); Schulman, *International Copyright in the United States: A Critical Analysis*, 19 *Law & Contemp. Prob.* 141 (1954); Solberg, *The International Copyright Union*, 36 *Yale L.J.* 68 (1926).

6. See *The Chace Act*, § 3, 26 Stat. 1106 (1891). The first copyright enactment which extended protection to all works by an American author, regardless of language or place of publication, was *Act of May 31, 1790*, 1 Stat. 124 (1790).

See generally Appleman, *Compromise in Copyright*, 19 *B.U.L. Rev.* 619, 627-32 (1939); Toulmin, *Printing in the United States Under the Copyright Law*, 10 *Va. L. Rev.* 427 (1924); Comment, *The Compulsory Manufacturing Provision—An Anachronism in the Copyright Act*, 49 *Mich. L. Rev.* 417 (1951).

7. *American Code Co. v. Bensinger*, 282 Fed. 829, 833 (2d Cir. 1922) (work first published in Great Britain is in public domain in the United States); *Basevi v. The Edward O'Toole Co.*, 26 F. Supp. 41 (S.D.N.Y. 1939); *Universal Film Mfg. Co. v. Copperman*, 212 Fed. 301 (S.D.N.Y. 1914) (distribution of photoplay in Europe without United States copyright notice precluded United States copyright). *Contra*, *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946) (Frank, J., held that treaty protection extended to books published abroad with insufficient notice if defect cured in subsequent United States publication); *Italian Book Co. v. Cardilli*, 273 Fed. 619 (S.D.N.Y. 1918), probably overruled by *American Code Co. v. Bensinger*, *supra*.
8. UCC art. I. The enumerated categories are not intended to be all-embracing but only indicative. It is arguable, however, and moreover probable, that all classifications of Copyright Act § 5(a)-(m) are includable under art. I. See note 9, *infra*. If, for example, § 5(h) items were covered, textile designs would also be protected by UCC. For recent application of § 5(h) to textiles, see Derenberg, *Copyright Law*, 36 *N.Y.U.L. Rev.* 585, 589-92, in 1960 *Ann. Survey Am. L.* 214-17 (1961). It is of interest to observe that Berne Union protection applies, in many cases, to works which the original domestic copyright laws of member nations did not cover. 1 *Ladas, The International Protection of Literary and Artistic Property* 33, 53-55 (1938).
9. Copyright Act, 17 U.S.C. § 5 (1958). Classes of work not expressly enumerated in UCC art. I are: (c) Lectures, sermons, addresses (prepared for oral delivery);

expressly covered,¹¹ which indicates that items analogous to those held copyrightable in *Mazer v. Stein*¹² are entitled to UCC protection in the United States. *Mazer* held that statuette lamp bases were eligible for copyright although such items also qualified for design patent¹³ protection.¹⁴ And while *Mazer* failed to examine a basic constitutional question,¹⁵ it opened the door to copyright to many items which previously were not considered proper subjects.¹⁶ For example, costume jewelry, including earrings¹⁷ and "junk jewelry"

(f) Maps; (h) Reproductions of a work of art; (j) Photographs; and (k) Prints and pictorial illustrations including prints or labels used for articles of merchandise.

UCC art. II(1) which affords "equal privileges" protection for published works does not state whether "works" is to be defined with reference to UCC art. I's indicative listing, or by each contracting state's own copyright laws. If the latter, unquestionably any work falling within § 5 would be protectible in the United States if at the time it was published abroad in a contracting state or by a national of a contracting state the proper notice was affixed.

The prevailing view of the copyright bar is that publication abroad without the UCC notice cannot be cured by affixing sufficient notice to meet the requirements of a contracting state where publication is subsequently made. Statement of Professor Walter Derenberg, N.Y.U. School of Law, Nov. 30, 1960, indicating that the notice standards of UCC art. III(1) supersede *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946).

10. Copyright Act, 17 U.S.C. § 5(g) (1958).
11. UCC art. I uses the terminology "artistic works."
12. 347 U.S. 201 (1954). See Note, 31 N.Y.U.L. Rev. 1263 (1956); Comment, 68 Harv. L. Rev. 517 (1955).
13. 35 U.S.C. §§ 1.151-155 (1958) as amended, 35 U.S.C. §§ 1.151-155 (Supp. II, 1959-1960).
14. *Mazer v. Stein*, 347 U.S. 201, 217 (1954). The Court refused to follow the arbitrary English rule of denying copyright protection to designs used or intended to be used to industrially process more than fifty single articles. *Id.* at 217, n. 36.
15. See 347 U.S. at 221 (Douglas and Black, JJ., dissenting). The challenge to a scholarly inquiry into the meaning of the constitutional term "Writings," U.S. Const. art. 1, § 8, cl. 8, was skillfully met in note, 31 N.Y.U.L. Rev. 1263 (1956). The conclusion reached is that judicial interpretation of "Writings" allows Congress to extend copyright protection to new forms of art or methods of reproduction without any constitutional problem.
16. Prior to the *Stein* decision the Copyright Office had registered, under § 5(g), such items as an auto radiator emblem, owl head book ends, bear ash tray, belt buckle design and a metal figurine bottle opener. Amicus Curiae brief of Register of Copyrights, cited in 68 Harv. L. Rev. at 526 (1955). It would appear, however, that such registration was not an established practice.
17. *Boucher v. Du Boyes, Inc.*, 253 F.2d 948, 949 (2d Cir.), cert. denied, 357 U.S. 936 (1958) (notice appearing on one earring only is not faulty, as earrings are always sold in pairs). It should be observed that the form of notice permitted for § 5(f) to (k) works would not meet UCC requirements, lacking both the full name of the proprietor and the date. Copyright Act, 17 U.S.C. § 19 (1958).

necklaces,¹⁸ has since been protected,¹⁹ and apparently a wide variety of trinkets, ornaments and curios is presently being accepted for registration.²⁰ Justice Holmes' pragmatic warning that persons trained in the law are not the final arbiters of "work of art"²¹ has been carefully heeded by the courts.²²

The question of assignment of copyright on a territorial basis is directly related to the potential free flow into America of books and other copyrightable items under UCC. Books claiming UCC protection are not subject to the manufacturing or deposit²³ requirements, and all other copyrightable matter is similarly exempted from the deposit requirements. This raises a serious problem for potential American publishers since books as well as other copyrightable matter can be generally produced abroad at lower labor costs than those prevailing presently in the United States. Therefore a book publisher of a United States edition of a work first published in England, or a manufacturer or distributor of other matter first published abroad faces possible competition from the importation of the particular item in a less expensive "edition." The threat of such competition might discourage an American publication. This embarrassing problem could be averted, however, if the United States publisher, manufacturer or distributor could claim United States copyright, as he could then invoke the importation prohibitions available to the American copyright proprietor. Thus, in the case of a book:

During the existence of the *American copyright* in any book the importation into the United States of any piratical copies thereof or of any copies thereof (*although authorized by the author or propri-*

18. *Trifari, Krussman & Fishel, Inc. v. Charel Co.*, 134 F. Supp. 551 (S.D.N.Y. 1955).

19. But see *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, 260 F.2d 637 (2d Cir. 1958).

20. Remarks of Mr. George Cary, General Counsel, Copyright Office, as guest lecturer at N.Y.U. School of Law, February 2, 1961.

21. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251-52 (1903). See *Mazer v. Stein*, 347 U.S. 201, 214 (1954): "[I]ndividual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art." See also *Derenberg & Baum, Congress Rehabilitates Modern Art*, 34 N.Y.U.L. Rev. 1228 (1959).

22. Congress, however, has before it proposals for limitation of the duration of protection for ornamental designs under proposed copyright law amendments. S. 2075, 86th Cong., 1st Sess. (1959); S. 2852, H.R. 9870, 86th Cong., 2d Sess. (1960); see *Derenberg, Copyright Law*, 36 N.Y.U.L. Rev. 585, 587, in 1960 Ann. Survey Am. L. 212 (1961).

23. See note 5, *supra*.

etor) which have not been produced in accordance with the manufacturing provisions in section 16 of this title . . . is prohibited ²⁴

And as to any other copyrightable article:

The importation into the United States of any . . . piratical copies of any work copyrighted in the United States, is prohibited.²⁵

Piratical copies are defined as: "Actual copies or substantial reproductions of legally copyrighted works produced and imported in contravention of the rights of the copyright proprietor."²⁶

Under these provisions the American assignee-proprietor would argue that any copies produced abroad are piratical with reference to the United States. The theory behind such an argument is that upon assigning the United States copyright the original foreign proprietor loses his right to produce for the American market.

If, however, the American publisher, manufacturer or distributor²⁷ can be considered only an exclusive licensee of the original copyright proprietor,

24. Copyright Act, 17 U.S.C. § 107 (1958). (Emphasis added.) The remainder of the section, not quoted, consists of exceptions to the prohibition which have no application for the purposes of this study. But see Customs Regs., 19 C.F.R. § 11.21 (Supp. 1960):

(a) Copies of books or periodicals for which manufacture in the United States is required by 17 U.S.C. 16 may not be imported during the existence of the United States copyright, unless importation is permitted under 17 U.S.C. 107, or unless protection was secured under 17 U.S.C. 9(c) by virtue of the Universal Copyright Convention

This 1956 regulation appears to contradict the provisions of 17 U.S.C. § 107, which clearly state that even the authorization of the proprietor will not relax the prohibition on importation of books and periodicals which do not meet the manufacturing requirements. Therefore, the regulation could not be properly applied where there is an American proprietor, who is not excused by § 107 from the manufacturing requirement. Moreover, the regulation is not addressed to a situation of territoriality of copyright, i.e., a separate proprietorship of copyright for each contracting state. See text accompanying note 78 *infra*. In the author's opinion the above-quoted regulation would be neither conclusive nor persuasive if the principle of territoriality is recognized.

25. Copyright Act, 17 U.S.C. § 106 (1958).

26. Customs Regs., 19 C.F.R. § 11.20(a) (1953).

27. It should be noted that, whereas copyright importation protection is available to a copyright proprietor-distributor, such importation protection is not available to a design patent patentee-distributor. Such a patentee is protected "only when his patented product is manufactured in the United States." See Zelnick, Copyright and

he would have no remedies under the importation prohibition of the Copyright Act.²⁸ It is essential, then, that the American transferee be able to establish that he is the proprietor to secure importation protection.

III

DIVISIBILITY AND TERRITORIALITY OF COPYRIGHT: PROBLEMS AND DISTINCTIONS

Modern business and commercial practices connected with the various rights enumerated in Section 1 of the Copyright Act . . . , e.g. right to print, dramatize, record, etc., are inherently and essentially different. They can be exercised or purchased by different persons . . . and include a variety of industries such as the book publishing trade, the newspaper, magazine publishing industry, the legitimate stage, the motion picture industry, and the television industry . . . the copyright owner can dispose of such portion of his copyright as he desires.²⁹

That the above-quoted language is an accurate description of the commercial aspect of copyrights cannot be seriously disputed.³⁰ The law, however,

Design Patent Protection Against Importation of Piratical Merchandise, 5 BULL. CR. Soc. 261, 266-67 (1958).

From the point of view of the proprietor, the superiority of the almost automatic exclusionary features of the Copyright Act in conjunction with the Customs Regulations provide a much more desirable and commercially feasible means of controlling competition from imported merchandise than do design patents, *and they apply equally regardless of the place of manufacture of the work for which copyright protection is claimed.* Id. at 268. (Emphasis added.)

28. As to general remedies available to an exclusive licensee, see note 32 *infra*.

29. *Herwig v. United States*, 122 Ct. Cl. 493, 496, 105 F. Supp. 384, 388 (1952).

30. See generally, Bergstrom, *The Businessman Deals With Copyright: A Study of Assignments, Other Transfers, and General Contractual Relations*, 3 Copyright L. Symposium 248 (1940).

This writer has had the privilege of hearing many of the leaders of the copyright bar at Professor Walter Derenberg's Seminar on Artistic and Literary Property (N.Y.U. School of Law 1961), where it has been amply demonstrated that the various individual rights under copyright are handled and treated as totally distinct commercial properties for purposes of producing income from the incorporeal copyright of the proprietor. The history of copyright as an incorporeal right is summarized in *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U.S. 1, 19 (1908) (Holmes, J., concurring). The interesting development of statutory copyright is traced from 8 Ann. C. 19 (1710) through to our "modern" Copyright Act of 1909 in Henn, "Magazine Rights"—A Division of Indivisible Copyright, 40 Cornell L.Q. 411, 412-16 (1955).

is not yet at one with copyright reality. Many courts insist upon perpetuating the initially procedurally-based³¹ and now outmoded³² doctrine of indivisibility of the copyright "bundle of rights."³³ Other courts and authorities,³⁴ however, have recognized that "[t]here is nothing inherent in the nature of copyright which precludes the separate sale of the several parts which make up the whole."³⁵ In fact, partial assignment (even subject to territorial limitations) is expressly authorized under the English³⁶ and Canadian³⁷ copyright laws.

31. The rationale of these decisions was to protect the infringer against the harassment of a multiplicity of law suits. "In relation to the right to sue for an infringement, a copyright is an indivisible thing, and cannot be split up and partially assigned either as to time, place, or particular rights and privileges, less than the sum of all the rights comprehended in the copyright." *M. Witmark & Sons v. Pastime Amusement Co.*, 298 Fed. 470, 474 (E.D.S.C. 1924).
32. Fed. R. Civ. P. 19(a) allows an exclusive licensee to join a proprietor as co-plaintiff or involuntary party plaintiff. *Ilyin v. Avon Publications, Inc.*, 144 F. Supp. 368, 374-75 (S.D.N.Y. 1956). This procedure extends to copyright infringement cases the rule which originally was applied in the patent field in *Independent Wireless Telegraph Co. v. Radio Corp. of America*, 269 U.S. 459 (1926). As to necessity of joining the copyright proprietor, see *Stephens v. Howells Sales Co.*, 16 F.2d 805 (S.D.N.Y. 1926).
33. Cases characterizing the indivisibility approach are: *Goldwyn Pictures Corp. v. Howells Sales Co.*, 282 Fed. 9 (2d Cir. 1922), cert. denied, 262 U.S. 755 (1923); *Witwer v. Harold Lloyd Corp.*, 46 F.2d 792 (S.D. Cal. 1930), rev'd on other grounds, 65 F.2d 1 (9th Cir.), petition for writ of cert. dismissed per stipulation, 296 U.S. 669 (1933). See also Ball, *Law of Copyright and Literary Property* 532-33 (1944); Finkelstein, *The Copyright Law—A Reappraisal*, 104 U. Pa. L. Rev. 1025, 1060 (1956); Howell, *Copyright Law* 171-73 (3d ed. 1952).
34. *Manners v. Morosco*, 258 Fed. 557 (2d Cir. 1919), rev'd, 252 U.S. 317 (1920); *Photo-Drama Motion Picture Co. v. Social Uplift Film Corp.*, 213 Fed. 374 (S.D.N.Y. 1914) (Hand, L., J.), aff'd, 220 Fed. 448 (2d Cir. 1915), but not followed in *Goldwyn Pictures Corp. v. Howells Sales Co.*, supra note 33; *Field v. True Comics, Inc.*, 89 F. Supp. 611 (S.D.N.Y. 1950), aff'd, 189 F.2d 950 (2d Cir. 1951); *Public Ledger v. New York Times*, 275 Fed. 562 (S.D.N.Y. 1921), aff'd per curiam, 279 Fed. 747 (2d Cir.), cert. denied, 258 U.S. 627 (1922); Gitlin & Woodward, *Tax Aspects of Patents, Copyrights, and Trademarks* 13-15, 47 (rev. ed. 1954); Fulda, *Copyright Assignment and the Capital Gains Tax*, 58 Yale L.J. 245, 253 (1949); Gitlin, *Taxation of Copyright*, 27 Taxes 503, 505 (1949); Solberg, *The Present Copyright Situation*, 40 Yale L.J. 184, 190-91 (1930).
35. *Joseph A. Fields*, 14 T.C. 1202, 1211 (1950), aff'd, 189 F.2d 950 (2d Cir. 1951).
36. An Act to make new provisions in respect of copyright and related matters, 4 & 5 Eliz. 2, c. 74, § 36(2)(a)-(c), cited in *Copyright Laws and Treaties of the World* (Supp. 1958). The new act retains and elaborates the partial assignment portion of Copyright Act, 1911, 1 & 2 Geo. 5, c. 46, § 5(2), cited in *Copinger & Skone James, Law of Copyright* 392 (8th ed. 1948). See also *id.* at 111.

The new act also furnishes us with an "Infringements by Importation, Sale, and Other Dealings" scheme which we may compare with interest to our Customs Regs., 19 C.F.R. § 11.21 (Supp. 1960), quoted in part, note 24 supra:

Our Copyright Act, "section 1, makes no specific provision for an assignment of only part of the rights secured under the registration³⁸ of a copyright; the efficacy of partial assignments is left to the more uncertain rules of case law."³⁹

Professor Henn⁴⁰ describes case law favoring divisibility (where proprietor reserves some rights) as falling into two categories:

(1) if the grant is of at least all of the rights designated in one of the five statutory subdivisions⁴¹ of the enumeration of the rights embraced within the copyright, the grant constitutes an assignment, otherwise a license.⁴²

. . . (2) if the grant is of at least all of the rights necessary to produce a new version copyrightable under the statute as a new work, the grant constitutes an assignment; otherwise a license.⁴³

Also set forth as a test is the realistic, and less formal one which looks to the intention of the proprietor to transfer.⁴⁴

§ 5(2) The copyright . . . is infringed by any person who, without the license of the owner of the copyright, imports an article . . . into the United Kingdom, or into any other country to which this section extends, if to his knowledge the making of that article constituted an infringement of that copyright, *or would have constituted such an infringement if the article had been made in the place into which it is so imported.* (Emphasis added.)

The above-quoted provision demonstrates how a partial assignment may be protected.

37. The Copyright Act § 12(2), Can. Rev. Stat. C. 32 (1927), cited in Fox, *The Canadian Law of Copyright* 631 (1944). See also *id.* at 285.

The Royal Commission on Patents, Copyright, Trade Marks and Industrial Designs recommended in its Report on Copyright 114-15 (1957) that § 36(2)(a)-(c) of the new English act, note 36 *supra*, be enacted in Canada.

In the same report the Royal Commission urged Canada to ratify UCC in order to obtain its advantages of simplified formalities of art. III(1), especially with the United States requirements of registration and notice in mind. Report on Copyright 16 (1957). See also Kaminstein, ©: Key to Universal Copyright Protection (Article III: Formalities) in *Universal Copyright Convention Analyzed* 23 (Kupferman & Foner ed. 1955).

38. Rights are not secured by registration of a copyright, but rather by publication with proper notice. Attention is called to this conceptual error to demonstrate a major difficulty of case law in the area. Many decisions indicate less than a firm grasp of basic essentials of copyright law.
39. Joseph A. Fields, 14 T.C. 1202, 1209 (1950), *aff'd*, 189 F.2d 950 (2d Cir. 1951).
40. Henn, "Magazine Rights"—A Division of Indivisible Copyright, 40 Cornell L.Q. 411 (1955).
41. Copyright Act, 17 U.S.C. § 1(a)-(e) (1958).
42. Henn, *supra* note 40, at 432-33, and cases cited therein.
43. *Id.* at 432-33.
44. *Id.* at 433-34.

Not unexpectedly, the question of divisibility has been actively examined in the area of taxation.⁴⁵ Whether a transfer is a license or an assignment (sale) presumably is a significant factor in determining whether the revenue received is ordinary income or capital gains.⁴⁶ Yet the Supreme Court explicitly ignored the property concept of divisibility in a case determining the applicability of the capital gains provisions of the Revenue Act of 1938.⁴⁷ In *Commissioner v. Wodehouse*⁴⁸ respondent author, a British subject domiciled in France, assigned all rights, for a lump sum, in certain stories to an American magazine. After publication, the magazine reassigned all rights to the author, except serial rights which it reserved. The Court held that the Act of 1938 preserved the taxability of several kinds of income of nonresident aliens, including receipts "in the nature of royalties" for the use of copyrights in the United States. Approving two Second Circuit decisions⁴⁹ to the effect that lump sum payments are in the nature of royalties, the Court concluded that "Congress sought to tax . . . the income of a non-resident alien individual insofar as it was derived from payments for the use of or for the privilege of using copyrights in the United States."⁵⁰ In other words, the Court based its conclusion on congressional intent, manifested through long-standing legislative history and reflected in regulations which Congress left undisturbed by amendments to the revenue act, as opposed to deciding the case on the issue of divisibility of copyright.⁵¹ Moreover, viewing the holding strictly, it appears

45. E.g., *Commissioner v. Wodehouse*, 337 U.S. 369 (1949); *Rohmer v. Commissioner*, 153 F.2d 61 (2d Cir.), cert. denied, 328 U.S. 862 (1946); *Goldsmith v. Commissioner*, 143 F.2d 466 (2d Cir.), cert. denied, 323 U.S. 774 (1944); *Misbourne Pictures Ltd. v. Johnson*, 90 F. Supp. 978 (S.D.N.Y. 1950), aff'd, 189 F.2d 774 (2d Cir. 1951); *Herwig v. United States*, 122 Ct. Cl. 493, 105 F. Supp. 384 (1952).

46. See Fulda, *supra* note 34; Note, 54 Yale L.J. 879 (1945).

47. 52 Stat. 447 (1938).

48. 337 U.S. 369 (1949), reversing 166 F.2d 986 (4th Cir. 1948). The Court granted certiorari to resolve a conflict between the Fourth Circuit decision and that of the Second Circuit in *Rohmer v. Commissioner*, 153 F.2d 61 (2d Cir.), cert. denied, 328 U.S. 862 (1946).

49. *Rohmer v. Commissioner*, *supra* note 48, and *Sabatini v. Commissioner*, 98 F.2d 753 (2d Cir. 1938).

50. 337 U.S. at 384.

51. There was a strong dissent by Justice Frankfurter, with whom Justices Murphy and Jackson joined. *Id.* at 401. Student comments on the case also recognize that the Court looked to the income aspect rather than to the property aspect of the facts presented. See, e.g., 30 B.U.L. Rev. 128, 132 (1950); 35 Cornell L.Q. 893 (1950); 48 Mich. L. Rev. 132, 133 (1949); 34 Minn. L. Rev. 73 (1949); 23 So. Cal. L. Rev. 154, 156 (1949):

Thus it can be seen that the majority of the Court did not decide that there may not be a sale of partial rights under copyright, but merely that these items,

that *Wodehouse* is not even applicable to a like fact pattern if the author is a resident rather than an alien. *Herwig v. United States*⁵² recognizes that *Wodehouse* was decided on the interpretation of Section 211(a) of the Revenue Act of 1938⁵³ rather than the question of divisibility.⁵⁴ In *Herwig*, the Court of Claims, looking more to the dissent of *Wodehouse*⁵⁵ and the reversed Fourth Circuit decision,⁵⁶ held that conveyance of the exclusive motion picture rights constitutes a sale, not a license. Consequently, the court allowed capital gains treatment to the American proprietor-transferor.⁵⁷ In reaching the decision, the court placed stress on actual commercial practices⁵⁸ and modern procedural rules.⁵⁹ It is significant to note that the Government did not appeal *Herwig*, and that the decision has been cited approvingly⁶⁰ and followed recently.⁶¹ If *Herwig* is good law, it so narrows *Wodehouse* as to limit it to a case turning purely upon tax law, and of little persuasion with respect to the question of

being readily collectible, should not be eliminated as a source of income unless there is a clear expression from Congress to that effect Ibid.

But see Allan & Coggan, Aliens and the Federal Income Tax, 5 Tax L. Rev. 253, 267 (1950), which concludes that implicit in the decision is "a premise that the sums received by the taxpayer were 'for the use of a copyright in the United States' and hence were royalties," which is contrary to an assumption of divisibility.

52. 122 Ct. Cl. 493, 105 F. Supp. 384 (1952).

53. 52 Stat. 527 (1938).

54. 105 F. Supp. at 387.

55. 337 U.S. 369, 401 (1949) (dissenting opinion).

56. *Wodehouse v. Commissioner*, 166 F.2d 986, 989 (4th Cir. 1948).

57. See *Goldsmith v. Commissioner*, 143 F.2d 466 (2d Cir. 1944). There, the majority of the court, through L. Hand, J., treated the transfer of the exclusive motion picture rights as a "sale" of a "capital asset" but agreed that the proceeds could not receive capital gains treatment, as the asset was held for sale in the ordinary course of business. Judge Hand's language reveals a unique hybrid view on divisibility: "It does not unduly strain the meaning of 'sale' to make it include an exclusive license" Id. at 468. (Hand and Swan, JJ., concurring).

58. See text accompanying note 29, *supra*.

59. See note 32 *supra*.

60. *Merck & Co. v. Smith*, 261 F.2d 162, 165 (3d Cir. 1958) (patent assignment).

61. *Gershwin v. United States*, 139 Ct. Cl. 722, 153 F. Supp. 477 (1957). Transfer of songs listed by proprietor (by descent) and used by transferee motion picture producer held to be sale for purposes of capital gains treatment. The fact that the songs on list not chosen "reverted" to the grantor did not prevent the transaction from being an outright sale. "The reservation of certain rights in the grantor is not inconsistent with a sale of a property right to the producer." Id. at 726, 153 F. Supp. at 480. This result could be applied to an assignment which provided for reversion for failure to publish, manufacture or distribute a certain quantity, or within a stated period. Time reversion clauses are quite common in book publishing, theatrical and motion picture production assignments.

divisibility of copyright. Therefore a continued trend⁶² toward recognizing divisibility of the distinct rights embraced by copyright can be anticipated.

Now we must inquire into the permissibility of partition of copyright on a territorial basis. *Herwig* supplies some striking dictum:

While it has been suggested that the splitting up of the right on a geographical basis appears less feasible with respect to a copyright than with respect to patents or trademarks, even in the copyright field an agreement of this kind would be possible; e.g., a grant of the rights to dramatize productions limited to certain cities.⁶³

This language indicates that sub-territorial division would be permissible along the lines of a "true" economic market. New York City, for example, might be such a market for purposes of theatrical production. However, there is authority to the effect that any internal territorial limitation renders the transfer an exclusive license.⁶⁴

But what we must not ignore is that the very nature of statutory copyright,⁶⁵ being a monopoly granted upon publication in compliance with a statute, is perforce territorial. In the absence of international agreement, there is no copyright beyond the bounds of the enacting state.⁶⁶ Agreement that "statu-

62. To treat the transfer of any one of the various rights conferred by the Copyright Law as a sale would accord not only with analysis of their essential character and the scheme of the Copyright Law, but with the way these rights are treated by authors and purveyors of products of the mind for whose protection the Copyright Law was designed because of the belief that the interests of society would be furthered. The various exclusive rights have different attributes and therefore different significance. For that reason they may be sold separately and form the basis for a new copyright. *Commissioner v. Wodehouse*, 337 U.S. 369, 424 (1949) (dissenting opinion). See *Fulda*, *supra* note 34 at 253-54, and text accompanying note 43 *supra*.

63. *Herwig v. United States*, 122 Ct. Cl. 493, 496, 105 F. Supp. 384, 388 (Ct. Cl. 1952). See *Fulda*, *supra* note 34 at 264-65, n. 96 on the divisibility of trademark by territory, suggesting that such internal geographical division of copyright is less feasible but nonetheless possible.

64. *Ball*, *supra* note 33 at 535. The dissent in *Commissioner v. Wodehouse*, 337 U.S. 369, 424 (1949), assumes that a transfer granting a monopoly in all of the territory to which the copyright law extends is required for an assignment.

65. This paper is not concerned with the concepts of common law copyright, nor of statutory protection for unpublished works as found in Copyright Act, 17 U.S.C. § 12 (1958).

66. It is "settled law that a copyright has no extra-territorial effect." *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 662 (2d Cir. 1955). "[W]hatever right the author may have retained under the French law did not prevent the publication of his work in this country after it had been published in France. Publication unprotected by United States copyright releases a work for copying; it is then dedicated to the public and the author's common law rights no longer protect the work

tory rights of authors do not extend beyond the sovereignty of their origin,"⁶⁷ is tacit recognition of territoriality of copyright. Again, disregarding international treaty or agreement, it is proper to speak in terms of English copyright, Canadian copyright, French copyright, etc. Before UCC, an English proprietor could receive *ad interim* protection,⁶⁸ and, upon timely compliance with the manufacturing requirement, could secure an American copyright.⁶⁹ In theory, then, there was no reason why a proprietor of two national copyrights in the same work could not assign one of them and retain the other.⁷⁰

The crucial issue is whether a proprietor who is entitled to UCC protection throughout the contracting states can assign a copyright in any one of the states, and thereby transfer a distinct copyright to the transferee. Practically, in the case of books, we want to know if an English publisher⁷¹ can assign the American copyright while still retaining his British copyright and UCC protection elsewhere than in the United States. If that course is possible, the

against duplication." *Rolland v. Henry Holt & Co.*, 152 F. Supp. 167, 168 (S.D.N.Y. 1957). See also *American Code Co. v. Bensinger*, 282 Fed. 829, 833 (2d Cir. 1922); *Basevi v. The Edward O'Toole Co.*, 26 F. Supp. 41 (S.D.N.Y. 1939). *Contra*, *Italian Book Co. v. Cardilli*, 273 Fed. 619 (S.D.N.Y. 1918). But see *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946).

Note that common law copyright has no territorial bounds, but that statutory copyright does. Attention is called to recent attempts to obtain copyright protection for American works in the U.S.S.R. See Berman, *Rights of Foreign Authors Under Soviet Law*, 7 BULL. CR. SOC. 67, 246 (1959-1960); Iseman, *Governor Stevenson's Mission to Secure Payment to American Authors and Playwrights in the Soviet Union*, 7 BULL. CR. SOC. 155 (1960).

67. *Rolland v. Henry Holt & Co.*, *supra* note 66, at 169.

68. Copyright Act, 17 U.S.C. § 22 (1958).

69. Copyright Act, 17 U.S.C. § 23 (1958).

70. The writer has been unable to find any reported case which confirms or denies the validity of the above textual statement. Of great interest, though, is the following language:

Thus it would seem as a matter of legal doctrine that where a person transfers absolutely . . . a distinct right conferred by the Copyright Law granting the transferee a monopoly in all the territory to which the Copyright Law itself extends, legal doctrine should reflect business practice in recognizing . . . "the sale of personal property . . ." *Commissioner v. Wodehouse*, 337 U.S. 369, 424 (1949) (dissenting opinion).

Assuming that *Wodehouse* is properly a tax interpretation case, the reasoning of the dissent on the copyright issue of divisibility appears highly persuasive, and could be readily applied in a non-tax case. See text accompanying notes 50-54 *supra*.

71. Economically, it is the possible importation of books from England with which we are concerned. See note 85 *infra*.

result of the transfer of other copyrightable matter, such as that protectible under *Mazer v. Stein*,⁷² would follow.⁷³

UCC does not, itself, provide a standard of protection. There is no statutory UCC protection. Rather, the protection that the proprietor derives under UCC varies according to the laws of the several contracting states.⁷⁴ Conceptually, visualize thirty-four squares.⁷⁵ Each square represents a UCC nation and has different dimensions reflecting each particular state's copyright enactment. Thus, by publication with proper UCC notice in Great Britain, the publisher becomes entitled to separate protection in all⁷⁶ thirty-four squares. For all practical purposes, one entitled to protection can be considered the proprietor of the statutory copyright. (As amended, section 9(c) of the United States Copyright Act of 1909 expressly extends *copyright* to works entitled to UCC protection.) The proprietor does not have one copyright; in fact, he has thirty-four, each one bearing different rights and privileges, *i.e.*, different dimensions. If he chooses to transfer one or more of the individual blocks while retaining others, thereby excluding himself only from the area thus assigned, there appears to be no more objection to such an assignment than to the assignment of one of two copyrights in the pre-UCC *ad interim* situation.⁷⁷

Potentially differing durations of protection possible for a given work in the various states is further indication of the territorially distinct nature of copyright protection achieved by UCC in each contracting state. Under United States copyright law, the maximum protection a domestic or UCC work en-

72. 347 U.S. 201 (1954). See also text accompanying notes 10-22 *supra*.

73. There would be no issue of § 1 divisibility involved in works of art, therefore only the question of territorial severability would be involved.

74. UCC art. II(1). See note 2 *supra*.

75. UCC presently has thirty-four contracting states. See note 1 *supra*.

76. It would be possible for UCC protection to apply, yet protection in the place of first publication or place of domicile of the author to fail. This anomalous result is inherent in UCC art. III(1), which requires the notice to be placed "in such manner and location as to give reasonable notice of claim." "Reasonable" location would not satisfy the exact placement specifications, Copyright Act, 17 U.S.C. § 20 (1958), required of books or periodicals of American authors or authors domiciled here or books or periodicals first published here. "Reasonable" location, however, would satisfy Copyright Act, 17 U.S.C. § 9(c) (1958) (waiving § 20 compliance) as to non-American authors or first publications which qualified for UCC.

77. See text accompanying note 70 *supra*. It is of great significance to note the explicit permissibility of territorial (partial) assignment under English copyright law. See note 36 *supra*, and Appendix A of this work, under United Kingdom. As a matter of logic, as well as practicality, there appears no reason why an English copyright proprietor could not transfer his entire American copyright, or any divisible part thereof, and expect the assignment to be upheld by English courts.

joys is fifty-six years.⁷⁸ However, for a work first published in a Berne Union country, say France, the period of protection is the life of the author plus fifty years.⁷⁹ If a French author published a novel in France in 1960, he or his representatives could secure United States protection for fifty-six years, *i.e.*, until 2016. But the French-Berne Union countries' duration of protection is indeterminate while the author lives. If the author dies in 1963, his copyright will expire in France in 2013; if he dies in 1980, the term expires in 2030. It is evident that in fact the *nature and duration* of protection varies from state to state. It would appear more desirable to recognize this fact, and acknowledge the original copyright proprietor's thirty-four separate and distinct territorial copyrights.

The duration differences might be mitigated to some extent by UCC art. IV(4), which provides that "no contracting state shall be obliged to grant protection for a period longer than" that provided for the work in the country of first publication. The language is permissive, not mandatory. It does not prevent a contracting state from extending its full term, although the term has expired in the state of first publication. Thus, if our French author dies in 1963, but his representatives secure United States renewal, his term in the United States will exceed his term in France in the same work by three years.⁸⁰

*It may be fairly and logically said that under UCC the issue of divisibility of copyright is not raised by permitting assignment of copyrights along national lines. Actually no more than a question of territorial severability of an aggregate of copyrights is presented.*⁸¹ Complete assignment along national lines does not properly touch upon *divisibility within a state* of the nature supported by dictum in *Herwig*.⁸² In a national territorial assignment, the only question of divisibility that can arise is where less than all of the distinct rights granted by statute are transferred. But that resulting question of divisibility is no different than one which arises when an American proprietor assigns less than all of his rights to an American assignee.

Two examples will serve to point up the distinction drawn above.

78. Copyright Act, 17 U.S.C. §§ 24-26 (1958).

79. French Law No. 57-298 on Literary and Artistic Property art. 21, cited in Copyright Laws and Treaties of the World (Supp. 1958).

80. There is nothing in Copyright Act, 17 U.S.C. § 24 or § 9(c) (1958) to prevent this result.

81. Foreign assignment of United States copyright can be accomplished by acknowledgment of the assignor before a consular officer or legation secretary of the United States authorized to administer oaths or perform notarial acts. Copyright Act, 17 U.S.C. § 29 (1958). As protection against claim of a subsequent purchaser or mortgagee for value, such assignment should be recorded in the Copyright Office within six calendar months. Copyright Act, 17 U.S.C. § 30 (1958).

82. See text accompanying note 63 *supra*.

(1) *A*, a British author, publishes a book in England with proper UCC notice thereby securing UCC protection. *A* assigns the American copyright to *B*, an American publisher. This assignment may be characterized as severing one of *A*'s thirty-four copyrights. *B* receives the American copyright; *A* retains thirty-three others. *B* receives all the rights that *A* had in America, and this would allow *B* to license (or assign) to *C* the various distinct rights to create new works, themselves the subject of American and UCC copyright, such as dramatic productions or motion picture photoplays. In these new works, upon compliance with UCC notice, *C* is entitled to UCC protection just as *C* would have been if *A* had retained his American copyright and licensed (or assigned) the rights directly to *C*.

(2) *A* is again the original English and UCC proprietor of copyright in a book. *A* assigns to *B* only the American book publishing and serial rights. Under the *Herwig* holding of divisibility⁸³ the transaction would be properly characterized as the severance by sale of *A*'s American book publishing and serial rights from *A*'s UCC protection. *B* would become the American proprietor⁸⁴ of the rights transferred. In a court which does not recognize divisibility of copyright, *B* would receive a license only, because less than all of the rights embraced by American copyright were transferred to *B*. The finding of license would not be attributable to a denial of the principle of territoriality, but rather to a refusal to permit divisibility of the copyright within the territory.

IV

TERRITORIALITY: CONFORMITY WITH UCC SPIRIT AND LETTER

The contracting states of UCC are persuaded that the "universal copyright system will facilitate a wider dissemination of works of the human mind" ⁸⁵ Therefore, if the concept of territorial severability (or of divisibility) is to conform to the UCC precept it must promote more efficient dissemination of copyright works.

The territoriality view meets this test. With respect to books,⁸⁶ for example, it appears clear that if an English proprietor could himself distribute

83. See text accompanying notes 52-61 *supra*.

84. While it is not particularly persuasive, in the light of ease of registration and recordation, the Copyright Office records partial assignments. Copyright Act, 17 U.S.C. § 30 (1958); 2 Ladas, *The International Protection of Literary and Artistic Property* 802 (1938).

85. UCC preamble cl. 3.

86. Factual information regarding the book publishing trade has been supplied through the kindness of several prominent members of the publishing industry, among whom are Mr. Dan Lacy, Managing Director, American Book Publishers Council, Inc., 58

his books most efficiently in America, he would not assign his American publishing right. In the typical case of commercial books ("retail" fiction and non-fiction), however, American publishers are far better equipped to promote sales in this country than English publishers. Therefore, the original proprietor would receive greater benefits by assigning the American publishing rights than by attempting to market the books himself. And, in order that the American publisher may receive adequate importation protection, his status as an independent copyright proprietor must be recognized.⁸⁷ Contractual protection alone would be of limited value in the situation where the importer is a third party (e.g., an English book dealer-distributor) rather than a party to the contract. In any event, customs exclusion is generally more desirable to prevent the harm than litigation to remedy the wrong. To date, it may be noted, third party importation in the commercial field has been harassing rather than seriously competitive, but there is no assurance that future reliance can be placed entirely on gentlemen's agreements.⁸⁸

An area where even slight importation competition is a serious economic problem is that of scholarly books. The market for many of these works is

W. Fortieth Street, New York 18; and Mrs. Margaret Nicholson, The Macmillan Co., 60 Fifth Avenue, New York 11. All opinions and conclusions, however, are this writer's, and in no manner should be regarded as reflecting the views of any person interviewed.

87. See text accompanying notes 24-28 *supra*, where it is suggested that *after* assignment the original proprietor no longer has a right to publish or produce the assigned work for destination in the American market. Concerning works published or produced *before* assignment, the theory of "piratical with reference to . . ." is not as persuasive. The original proprietor, however, could be prevented from directly importing on two grounds: (1) he would be estopped to deny his assignee's American copyright, which grants customs protection; and (2) in jurisdictions which recognize the seller's implied negative covenant to refrain from preventing the purchaser from enjoying the fruits of the contract the assignor would be subject to injunctive relief. See *Uproar Co. v. National Broadcasting Co.*, 81 F.2d 373 (1st Cir. 1936).

Importers, other than the assignor, of those works antedating the assignment are not necessarily subject to the assignor's limitations. As a practical matter, the safest protection against third party importation is an indemnity clause in the contract of assignment. Such a clause provides economically feasible protection only where the assignor has assets in the United States.

88. Publishers have not expressed concern over foreign language books, as sales are negligible, and American publishers display little interest in the market. For this reason, this paper has constantly referred to English proprietors in examples. The reader, however, will find the significant statutory provisions relating to partial assignment for each of the thirty-four UCC states in the Appendix.

It is of interest to observe that re-sale price maintenance has come under the attention of the House of Commons. The Board of Trade has issued questionnaires to a "truly representative" group of retailers, wholesalers and manufacturers. The Bookseller, May 13, 1961, p. 1889.

primarily limited to college and university libraries, and a quantity of 3000 books is about all that can be expected to be sold. If an American publisher of this low profit item cannot be assured of production from importation of the scholarly works which he proposes to distribute, the handling of scholarly works obviously becomes unattractive to him. As a result, only the British publisher may be left to disseminate such matter through circulars and agents, and, in that case, it is likely that only one-sixth of the market will be effectively reached. The important market for scholarly works, therefore, by default would not be properly serviced. Territoriality could remedy this situation.

In the case of works of art,⁸⁹ where the major interest is in the reproduction and sale of an item, it is also apparent that a foreign copyright proprietor would profit from American distributorship, and, conversely, that the American distributor would need proprietor status to adequately protect himself. The work-of-art situation is somewhat analogous to aspects of patent law, in which field territorial assignability is recognized.⁹⁰

Territorial severability seems advantageous under UCC, as it would permit the original proprietor to distribute, or choose to assign to one better equipped on terms mutually advantageous.

V

CONCLUSION

The writer is aware that his proposal of territorial severability of copyright under UCC is based upon novel analysis. But without resorting to normative language describing the nature of the product of the mind which copyright is intended to protect, attention is called to the fact that today copyright exploitation is big business.⁹¹ As business it is entitled to law which reflects its everyday commercial practices and legitimate economic goals. Recog-

89. See text accompanying notes 10-22 *supra*.

90. Leading cases are *Gayler v. Wilder*, 51 U.S. (10 How.) 476 (1850); and *Moore v. Marsh*, 74 U.S. (7 Wall.) 515 (1868).

Trade marks are also assignable subject to territorial limitations. *Rainier Brewing Co.*, 7 T.C. 162 (1946), *aff'd per curiam*, 165 F.2d 217 (9th Cir. 1948); *Seattle Brewing & Malting Co.*, 6 T.C. 856 (1946), *aff'd per curiam*, 165 F.2d 216 (9th Cir. 1948). See *Derenberg*, *Current Trademark Problems In Foreign Travel And The Import Trade*, 49 *Trademark Rep.* 674 (1959).

Of course, requirements of invention and originality, in the case of patents, and originality and use in commerce in the case of trade marks, make both distinguishable from copyright.

91. The Copyright Office reported in 1960 that industries based on copyrighted matter accounted for more than six billion dollars of the total national income, exceeding thereby mining or banking or electric and gas utilities. *Variety*, Jan. 4, 1961, p. 3.

dition of territoriality of copyright under UCC would be a positive stride toward meeting the needs and demands of a modern industry.

APPENDIX

The economic impact of the relinquishment of the manufacturing requirement for UCC books and periodicals in English¹ is the basis for the foregoing emphasis on American-British agreements.² The importance of territoriality in the future, however, is by no means limited to the book trade nor England. With the broad "works of art" copyrightability available in the United States,³ manufacturers "publishing," with requisite notice,⁴ "works of art" in UCC states are entitled to United States copyright protection.⁵ Many of these foreign manufacturers will wish to exploit the American market by selling their American rights to manufacturers in the United States who have superior distribution facilities. The United States transferee, if he can be characterized as an assignee of the American copyright, will be entitled to the protection of customs regulation.⁶ Recognition of territoriality of copyright will thus afford adequate protection to American transferees under *presently existing statutory enactment*.

Assignment aspects of the law of each of the UCC contracting states are set forth below to acquaint the reader with the possibilities of whole or partial assignments possible under such laws.⁷

1. Copyright Act, 17 U.S.C. § 9(c) (1958).
2. See text accompanying notes 82-88 *supra*.
3. See text accompanying notes 10-20 *supra*.
4. UCC art. III(1).
5. "[T]his Convention, being an international statute, left it to each state to specify the works which are to be embraced within the general categories of literary, scientific and artistic works, as defined in Article I. . . . While copyrightability, thus, may vary from country to country, a single *standard* of protection is established." Tannenbaum, The Principle of "National Treatment" and Works Protected: Articles I and II, in *Universal Copyright Convention Analyzed* 13, 16-17 (Kupferman & Foner ed. 1955).
6. See text accompanying notes 25-26 *supra*.
7. A listing of current UCC members, together with dates of accession or ratification, is found in 13 *Unesco Copyright Bull.* 3 (1960). The Philippines is listed, but it appears that that country has withdrawn its ratification. See U.S. Dep't of State, *Treaties in Force* 206 (1960).

The copyright statutes of all UCC countries are reproduced in *Copyright Laws and Treaties of the World*, hereinafter cited CLTW. CLTW is a Unesco publication, and has been supplemented annually since its original appearance in 1956.

*Contracting
State**Statutory Source**Germane Provisions*

Andorra	No copyright statute. CLTW (Supp. 1960).	Relies on French and Spanish precedent.
Argentina	Law No. 11.723 on Copyright, cited in CLTW (Supp. 1958).	Art. 51: Allows partial or total alienation; but the assignee is not permitted to alter the title, form or contents of the work. Art. 53 requires registration of the assignment for validity.
Austria	Federal Act on Copyright in Works of Literature and Art and on Related Rights, cited in CLTW (Supp. 1957).	C. IV, § 26: Right to use (<i>i.e.</i> , assignment, see § 24) may be made subject to territorial and time limits as determined by contract. § 27(2): Subsequent transfer by assignee subject to reasonable approval of author.
Belgium	Law on Copyright, cited in CLTW (Supp. 1959).	§ I, art. 3: Copyright is deemed movable property, and is assignable in whole or in part.
Brazil	Civil Code, Book II, Title II, C. VI, cited in CLTW (Supp. 1960). Book III, Title V, C. IX, cited in CLTW (Supp. 1960).	Art. 659: Allows assignment, but not express or partial assignment. Art. 1349: "The author may not dispose of his work, <i>wholly or partially</i> , until such time as the editions which the publisher is entitled to publish have become exhausted." (Emphasis added.) Appears to imply partial assignment.
Cambodia	No copyright statute. CLTW (1956).	
Chile	Law No. 345 on Copyright, cited in CLTW (1956). Regulation No. 1063 regarding the Copyright Register, cited in CLTW (1956).	Art. 9: Allows separate transfer of the enumerated rights of Art. 1. Art. 10(2): Requires the Custodian to register "Public deeds concerning the partial or total transfer of the right . . ."

<i>Contracting State</i>	<i>Statutory Source</i>	<i>Germane Provisions</i>
Costa Rica	Law of Intellectual Property, cited in CLTW (1956).	C. I, art. 1: Intellectual property governed by same rules as movable property, which, per art. 4, is subject to transfer. Appears to implicitly allow partial transfer.
Cuba	Regulations for . . . the Law of . . . Intellectual Property, cited in CLTW (1956).	Art. 9: Provides for registration of every transfer, "irrespective of its importance." Indicates that less than a total transfer is recognized.
Czechoslovakia	Law on Copyright, cited in CLTW (Supp. 1958).	§ 26: An author may transfer some or all of his property rights. However, assignees cannot re-transfer without consent of author. § 33. § 28(1): By contract can transfer for any period.
Ecuador	Law of Intellectual Property, cited in CLTW (Supp. 1959).	Art. 23: "Copyright is capable of transfer, wholly or in part, upon any basis."
France	Law No. 57-296 on Literary and Artistic Property, cited in CLTW (Supp. 1958).	Art. 30: Recognizes partial transfer, subject to the moral right of the author, art. 32. Art. 31: Limitation may be as to rights, place, duration and purpose.
German Federal Republic	An Act concerning Copyright in Literary and Musical Works, cited in CLTW (1956).	§ 8: "Copyright may be transferred to others, with or without limitation; the transfer may also be made with a limitation to a particular territory." § 14(1, 2, 5): Absent express agreement, author retains certain enumerated rights in spite of transfer of copyright.
Haiti	Law on Literary and Artistic Property, cited in CLTW (1956).	Art. 5: Allows total or partial assignment.
Holy See	Copyright Law, cited in CLTW (Supp. 1960).	Art. 1: Observes copyright legislation of Italy, providing it does not conflict with Divine Law.

*Contracting
State**Statutory Source**Germane Provisions*

Iceland	Law No. 13 on Copyright and Printing Rights, cited in CLTW (1956).	§ 9: Allows transfer of work wholly or partially.
India ⁸	The Copyright Act, 1957, cited in CLTW (Supp. 1958).	C. IV, § 18(c): Allows whole or partial assignment, and § 18(2) expressly provides that the assignee becomes the owner of copyright of the rights assigned; the assignor remains the owner of copyright of rights not assigned.
Ireland	An Act . . . for . . . the Definition and Protection of Copyright, cited in CLTW (Supp. 1958).	Part VI, § 158(2): "The owner of the copyright in any work may assign the right, either wholly or partially, and either generally or subject to limitation as to place or otherwise and either for the whole term of copyright or for any part thereof"
Israel	United Kingdom Copyright Act, 1911, As Extended to Palestine . . . , Maintained in Force in Israel, cited in CLTW (Supp. 1958).	Adopts the English Copyright Act of 1911. See text accompanying note 36 supra.
Italy ⁹	Law No. 633 . . . for the Protection of Copyright, cited in CLTW (1956).	Art. 19: The exclusive rights enumerated in arts. 12-18 "are independent of one another." Art. 20: Recognizes author's moral rights after assignment. Art. 107: The rights of utilization may be "alienated or transferred under all methods and forms allowed by law."

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8. The importance of India as a potential volume market for English language films and paperback books, as well as its potential as a producer of low-priced "works of art," cannot be overlooked in a highly competitive world.
 9. For those interested in comparative aspects of copyright law, the Italian statute is remarkably detailed in its coverage of the various rights embraced by copyright, and exploitation thereof.

<i>Contracting State</i>	<i>Statutory Source</i>	<i>Germane Provisions</i>
Japan	Law, cited in CLTW (Supp. 1959).	Art. 2: "A copyright may be assigned in whole or in part."
Laos	Laws of France promulgated in Laos prior to May 11, 1947. CLTW (1956).	Refer to French copyright law enacted prior to May 11, 1947.
Lebanon	Decree Providing Regulation of Commercial and Industrial Property Rights in Syria and Lebanon, cited in CLTW (Supp. 1958).	Art. 146: "The assignment of copyright shall always be interpreted restrictively." Author who assigns right of reproduction retains right to bring action for infringement and to oppose modification of the work. This appears to be a unique blend of assignment and license.
Liberia	An Act Relating to Copyright, cited in CLTW (Supp. 1957).	Art. 1: Speaks of author's "exclusive right . . . to reproduce . . . and to sell or authorize such reproduction." No express statutory mention of assignment.
Liechtenstein	Law concerning Copyright in Literary and Artistic Works, cited in CLTW (Supp. 1960).	Art. 9: Provides for partial transfer; transfer of one right is not implied transfer of any other unless parties expressly contract otherwise.
Luxemburg	Law concerning Copyright, cited in CLTW (1956).	Art. 3: "Copyright is movable property, and is assignable and transmissible in whole or in part" Art. 8 protects author's moral right in assigned work.
Mexico	Federal Law on Copyright, cited in CLTW (Supp. 1957).	Art. 1: Author can "dispose of these [his several rights] rights on <i>any basis</i> , in whole or in part." (Emphasis added.) Would cover territoriality and divisibility.
Monaco	Law on the Protection of Literary and Artistic Works, cited in CLTW (1956).	Art. 14: "Copyright, in whole or in part, shall be assignable with or without consideration" Assignments are subject to the author's moral right. Arts. 19-20.
Pakistan	The Copyright Act, 1914, cited in CLTW (Supp. 1958).	C. I. § 2(1): Adopts the English Copyright Act of 1911. See text accompanying note 36 <i>supra</i> .

*Contracting
State**Statutory Source**Germane Provisions*

Portugal	Decree concerning Literary, Scientific and Artistic Copyright, cited in CLTW (1956).	Art. 15, § 1: Allows transmission of author's rights "gratuitously or for valuable consideration, as any other property rights." Appears to be deemed "movable property" in the civil law sense.
Spain	Law, cited in CLTW (1956).	Art. 2(3): "Copyright shall belong. "To any person who recasts, copies . . . or reproduces original works, insofar as the product of his efforts is concerned, provided that . . . the permission of the owner has been obtained." Implies divisibility, but see art. 6, which merely provides that "Copyright is also transferable by act <i>inter vivos</i> . . .," implying an indivisible copyright.
Switzerland	Federal Law concerning Copyright in Literary and Artistic Works, cited in CLTW (1956).	Art. 9: Provides for partial transfer; transfer of one right is not implied transfer of any other unless parties expressly contract otherwise.
United Kingdom	An Act to make new provision in respect of copyright and related matters, 4 & 5 Eliz. 2, c. 74, cited in CLTW (Supp. 1958).	§ 36(2) (a)-(c): Allows limitation of assignment of copyright in any or all of the following ways: "(a) as to any of class of acts which owner has exclusive right to do; "(b) so as to apply to any one or more . . . of the countries in relation to which the owner of the copyright has by virtue of this Act that exclusive right; "(c) so as to apply to part . . . of the period for which the copyright is to subsist"
United States	Copyright Act, 17 U.S.C. §§ 1-216 (1958).	§§ 28-32: Assignment provisions; not express on either territoriality or divisibility.

187.

THE NEW SOVIET COPYRIGHT LAW.

By SERGE L. LEVITSKY*

Part Four (Sections 96 to 106) of the *Principles of Civil Legislation of the Union of SSR and the Union Republics*, enacted by the U.S.S.R. Supreme Soviet on December 8, 1961,¹ deals with copyrights. Although copyright law has traditionally been regarded by Soviet legal doctrine as essentially a discipline of civil law,² until now only in Azerbaidjan has copyright legislation actually formed part of the Civil Code. In most other union republics, legislation pertaining to copyright was contained in separate copyright acts³ enacted in implementation of the federal *Principles of Copyright*, of May 16, 1928.⁴ In addition, there existed numerous *ad hoc* statutes, both republican and federal, dealing with such matters as author's contracts, schedules of royalties, administrative law, etc. Between 1946 and 1959 alone, more than twenty-five such statutes and orders were issued by the federal authorities and the authorities of the Russian Republic (R.S.F.S.R.). Those *ad hoc* statutes, which were still effective on the eve of the enactment of the new *Principles*, will for the most part continue to operate even after the entry into force of the *Principles* (May 1962).

The two questions which come readily to one's mind upon reading the new *Principles* are whether the Federal Copyright Act of 1928 was in need of revision, and how the new *Principles* differ from the legislation enacted in 1928, *i.e.*, in the closing years of the New Economic Policy. In Soviet literature, one could frequently detect criticism directed against the Federal Act of 1928, on grounds that it was obsolete, hindered progress, and required drastic changes.⁵ Evidence does not bear out such views. L. M. Azov was largely correct in pointing out that the charge of obsolescence could be levelled against some

* Docteur-en-Droit, Paris. Formerly Professor at Fordham University.

1. Vedomosti Verkhovnogo Soveta SSSR, December 15, 1961, No. 50 (1085), text 525, pp. 1299-1301; Izvestiya, Moscow, No. 291 (13837), December 10, 1961, pp. 3-7.
2. See, for instance, B. S. Antimonov and Y. A. Fleishits, *Avtorskoye Pravo*, Moscow, 1957, p. 8 *in fine*; and V. I. Serebrovsky, *Voprosy Sovetskogo Avtorskogo Prava*, Moscow, 1956, p. 13.
3. The Kazakh, Kirgiz and Tadzhik Republics did not enact their own copyright acts but applied the R.S.F.S.R. Copyright Act of October 8, 1928. The same practice was followed by Lithuania and Estonia following their incorporation in the U.S.S.R. The Moldavian Republic applied the Ukrainian Copyright Act of February 6, 1929.
4. English text in V. Gsovski, *Soviet Civil Law*, Ann Arbor, Mich., Vol. II, 1949, pp. 398-409.
5. See, for instance, the article by Yur. Chaplygin in *Pravda*, Moscow, October 15, 1954, translated in VI *The Current Digest of the Soviet Press*, No. 42, p. 28.

secondary provisions of the Federal Copyright Act of 1928, and certainly against many statutes and orders enacted on the basis and in implementation of that Act, not against its basic concepts and principles.⁶ It is not surprising, therefore, to discover that the *Principles* of 1961 do not introduce any significant new changes into the system of Soviet copyright as such. Reduced to essentials, Soviet copyright can still be defined as the author's right (1) to publish, reproduce and circulate his works; (2) to be compensated whenever the product of his intellectual labor is used by society; and (3) to claim protection for the integrity of his works. Unchanged are also the requirements that the author must seek the services of a "socialist organization" for the publication, presentation or circulation of his works, and that, as a rule, the amount of royalties which the author can claim is laid down in rigid schedules enacted by the Government.

This does not mean that the *Principles* of 1961 simply copied the provisions of the Federal Copyright Act of 1928 which they are called upon to replace. In comparison with its predecessor of 1928, the *Principles* of 1961 contain a number of improvements, but also many shortcomings. Some peculiarities and innovations are the result of amendments introduced during 1960 and 1961, in line with suggestions by Soviet specialists in copyright law, following the publication in the press of the draft of the *Principles*.⁷ Other changes reflect certain trends in Soviet copyright practices which could be observed over a number of years, particularly since 1957.

1. *Recent trends reflected.* The most spectacular, although in actual fact the least important, innovation introduced in the *Principles* of 1961 was the elimination of the "exclusive" nature of the author's rights. The Federal Copyright Act of 1928, reflecting the legal trends prevailing during the NEP period, had endowed the Soviet author with "exclusive" rights.⁸ With the complete socialization of the printing, publishing, book-selling and entertainment industries, this term lost all its meaning, although it remained on the statute books. In fact as in law, since the early 1930's the author's "exclusive" right to publish, reproduce, circulate and publicly perform his works was reduced to an obligation to secure the services of a "socialist organization" for the performance of these acts, while his "exclusive" right to derive material rights from the publication or public performance of his work, "in any lawful manner", was

6. L. M. Azov, "Neskol'ko zamechanii k razdelu ob avtorskom prave," in *Sovetskoye Gosudarstvo i Pravo*, No. 9, 1960, pp. 67-68.

7. *Sovetskaya Iustitsiya*, Supplement to No. 7, 1960, pp. 2-11; *Sotsialisticheskaya Zakonnost'*, No. 8, August 1960, pp. 4-20; English text in *Law in Eastern Europe*, Leyden, Vol. V, 1961, pp. 230-231.

8. Sections 7 and 8.

transformed into the author's right to receive compensation for his work in accordance with schedules established by the Government.

In Soviet legal doctrine, the reference to "exclusive" rights was systematically attacked as no longer corresponding to legal reality and, in fact, "un-Socialist." Consequently, it came as no surprise when it was dropped in the *Project* published in 1960, and subsequently in the *Principles* of 1961.⁹ The *Project* of 1960 expressed on the whole the true state of affairs when, in Section 82, it stated that

"In order to realize his rights, an author may conclude a contract with the appropriate organization, for the publication, production or filming of his work."

Nevertheless, this paragraph was dropped from the final text of the *Principles*. This was done in line with Professor Azov's objection that such a formulation would create the impression that the author possessed the *right* to impose upon the Socialist organizations (publishing houses, theatres, concert halls, etc.) the *duty* to perform such acts as are necessary for the reproduction and circulation of his works.¹⁰ The omission of this draft paragraph, of course did not abolish *the author's duty* to seek the services of government-sponsored publishing houses. Section 1 of the *Principles* (1961) lays down specifically that "The socialist system of economy and the socialist ownership of the tools and means of production is the basis of all property relationships in Soviet economy."¹¹

Of a considerably greater practical importance are the trends, partially reflected in the *Principles* of 1961, to narrow down the scope of the material advantages enjoyed by authors and their heirs.

(a) *Restriction of the author's property interests.* There appear to be at least four areas in which the author's rights have been cut down since 1957. Under the R.S.F.S.R. Decree of April 20, 1957 (supplemented by the *Instruction* of November 5, 1957), authors of dramatic, musical and musico-dramatic works received the full amount of royalties due for each public performance of their works, only up to 100,000 rubles. The take-home remuneration was progressively reduced for each subsequent 100,000 rubles, until it reached thirty per cent for the sixth and each subsequent 100,000. Royalties in excess of the

9. It is interesting to note that a number of senior Soviet scholars advocated the reintroduction of "exclusive" rights (see *Sovetskoye Gosudarstvo i Pravo*, No. 2, 1961, p. 102).

10. Azov, loc. cit., p. 71.

11. *Vedomosti*, loc. cit., p. 1274.

specific percentage authorized by the Decree were turned over, *ex-officio*, to the Government.¹²

A similar tendency could be observed in the provisions of the R.S.F.S.R. Decree of April 7, 1960 which established new tariffs for the remuneration of authors' *belles-lettres*.¹³ True, the earlier tariffs, established by a decree of July 15, 1947, had already introduced a sliding scale of royalties for new editions.¹⁴ However, the gradation was nowhere as steep as in the Decree of 1960 which progressively reduced the author's remuneration to twenty per cent of the original figure, for the eighth and each subsequent edition.¹⁵

An entirely new scale of remuneration was established for translations. The high incomes of translators had long been a sore point with many Soviet commentators.¹⁶ The R.S.F.S.R. Decree of July 15, 1947 had introduced lower tariffs of remuneration for authors of translations of *belles-lettres*,¹⁷ but translators of dramatic works continued to enjoy a privileged status until 1957 when the Decree of April 20 sharply reduced their share of the box-office receipts.¹⁸ The R.S.F.S.R. Decree of April 7, 1960, effected a new curtailment of the translators' "property interests" by introducing a sliding schedule of royalties for new editions, which gradually reduced the translators' remuneration to fifteen per cent of the original amount (for the sixth and subsequent editions).¹⁹ The Decree of April 7, 1960, of course, applied only to the works of *belles-lettres*.

This same Decree of April 7, 1960 excluded authors belonging to one of the smaller Soviet nationalities from receiving royalties if their works were translated into any other Soviet territorial language but Russian.²⁰ Under the Decree of July 15, 1947, they could claim payment in such cases.²¹

These trends, symptomatic though they may be, are not readily discernible from reading the text of the new *Principles* (1961). However, they must be

12. A detailed comment on the Decree of April 20, 1957 and the Instruction of November 5, 1957, appeared in a postscript to Antimonov and Fleishits, op. cit., pp. 274-276. See also V. I. Koretsky, *Avtorskiye Pravootnosheniya v S.S.S.R. Stalinabad, 1959*, pp. 117-122.

13. Summary of the Decree of April 7, 1960, appears in Azov, "Novoye v zakonodatel'stve ob avtorskom prave", *Sovetskaya Iustitsiya*, No. 8, July 1960, pp. 11-12.

14. Russian text of the Decree of July 15, 1947, appears in L. M. Azov and S. A. Shatsillo (eds.), *Avtorskoye Pravo na Literaturnye Proizvedeniya*, Moscow, 1953, pp. 85-88, and in several other works.

15. Azov, in *Sovetskaya Iustitsiya* (cit.), p. 11.

16. See, for instance, the Chaplygin article in *Pravda*, loc. cit., p. 28.

17. See above, note 14.

18. See above, note 12.

19. See above, note 13.

20. *Ibid.*

21. See above, note 14.

borne in mind in connection with the new Section 98 which lays down the author's rights to remuneration, and which entrusts to federal and republican legislations the task of establishing the appropriate schedules of remuneration.²²

(b) *Restriction of the rights of heirs.* The trend to restrict copyright protection *post mortem auctoris* has been even more pronounced, and its influence on the *Principles* of 1961 is readily discernible. It affected the whole circle of persons whose claims to copyright protection were recognized, after the death of the author, as well as the scope of the heirs' rights. The trend to restrict the circle of the author's successors-in-law had received an expression, for instance, in V. I. Serebrovsky's article written in 1955,²³ while the campaign for the restriction of the rights of heirs went beyond scholarly articles, and found an echo even in *Izvestiya*. In an article published in 1959,²⁴ *Izvestiya* bitterly attacked some heirs of successful writers whose income from the authors' estates permitted them to "loaf" while living on "unearned incomes."

The late Professor Vladimir V. Gsovski of the Library of Congress correctly pointed out that "a restriction of inheritances [was] in the air."²⁵ The truth is that the Soviet legislators had already set out to restrict the heirs' rights as early as 1957 and 1958. This trend shows a direct line of succession to Section 105 of the *Principles* of 1961. The 1961 Soviet textbook of *Civil Law* contains a very revealing paragraph in which it is stated that "During the past years, the [Government's] right to effect a forcible purchase [of copyright, in virtue of Section 20 of the Federal Copyright Act of 1928] was applied in order to eliminate the considerable incomes of the heirs of some popular writers based on unearned income."²⁶ Until recently, we had been assured that no such forcible expropriations had taken place in the Soviet Union since the early years of the Soviet regime.²⁷

A restriction in the circle of persons called upon to enjoy protection of their claims after the author's death appeared in Section 80 of the *Project* of 1960, and it was retained in Section 97 of the *Principles* of 1961. The point is that under the Federal Copyright Act of 1928 (Section 1), copyright protection was extended, after the author's death, not only to his heirs, but also

22. Vedomosti, loc. cit., p. 1299.

23. "Avtorskoye Pravo i Nasledovaniye," Sovetskoye Gosudarstvo i Pravo, No. 6, 1955, p. 44.

24. Izvestiya, Moscow, No. 186, August 7, 1959, p. 4. Article by V. E. Nemtsov.

25. See Dr. Gsovski's letters, dated Nov. 10 and 13, 1959, to the U.S. Attorney for the Southern District of California, Los Angeles, *In re* David Bogobashvele, Probate No. 56752.

26. Sovetskoye Grazhdanskoye Pravo, Moscow, Vol. II, 1961, p. 421.

27. See, for instance, Antimonov and Fleishits, op. cit., pp. 32 and 79; John N. Hazard, Law and Social Change in the U.S.S.R., Toronto, 1953, p. 191.

to his other successors-in-law.²⁸ However, successors-in-law other than heirs could not enjoy copyright protection on Soviet territory if the original work was first published abroad.²⁹ The terminology employed by the *Principles* of 1961³⁰ (and of the *Project* of 1960)³¹ seems to suggest that only the author's heirs will now enjoy copyright protection, in all cases, to the exclusion of the author's other successors-in-law.

More serious are the restrictions not contained in the *Project* of 1960 but spelled out in the *Principles* of 1961, concerning the period of protection after the author's death. For the first time since 1925, Soviet federal copyright law does not guarantee a specific period of protection (as a rule, the Federal Copyright Act of 1928 established a period of fifteen years), but leaves it up to the union republics (a) to establish the duration and the modalities of protection *post mortem auctoris*,³² and (b) to define those cases in which copyright protection expires even before the author's death. In the latter case, the heirs can claim protection for the unexpired portion of time.³³

Finally, Section 105 of the *Principles* (1961) empowers the union republics to establish the limits within which the author's heirs may benefit under the latter's copyright, particularly with regard to the amounts of remuneration which they can claim. Section 105 specifically stipulates that these amounts may not exceed fifty per cent of the sums due to the author. Such a drastic restriction of the scope of the heirs' property interests was not included in the *Project* of 1960, but we can easily see here the influence of trends inaugurated by the R.S.F.S.R. Decrees of April 20, 1957 (supplemented by the *Instruction* of November 5, 1957) and of July 26, 1958. The Decree of April 20, 1957 had reduced the share of the author's heirs in the accrued royalties for dramatic and musical works to fifty per cent of the compensation due to the author,³⁴ while the Decree of July 26, 1958 had extended this same restriction to the heirs of authors of prose and poetry.³⁵

28. Gsovski, II, p. 398.

29. Fundamentals of Soviet Law, Moscow 1961 (in English), p. 227; Antimonov and Fleishits, op. cit., p. 143.

30. Section 97.

31. Section 81.

32. With the elimination of a set period of protection, the reference in the *Principles* to the method of calculating protection *post mortem auctoris* did not become altogether pointless, but it was likewise omitted. Thus there is no need to speculate about the discrepancy between the methods used in the federal Copyright Act of 1928 and the *Project* of 1960.

33. Section 105. In the federal Copyright Act of 1928, cases of abridged protection were spelled out in Sections 11, 12, and 13.

34. See above, note 12.

35. Koretsky, op. cit., p. 122.

2. *Project of 1960 amended in the light of criticism.* Some peculiarities and innovations of the *Principles* of 1961 can only be explained in the light of the discussions that followed the publication of the *Project* in July 1960. This is true in at least five specific instances.

(a) The first case concerns the correlation between the author's right to receive royalties, and the existence of official schedules of such royalties. Let us take a concrete case. The U.S.S.R. Supreme Court, in a Ruling of its Plenum of November 20, 1933,³⁶ established as a principle that authors of musical compositions whose works have been recorded are entitled to claim royalties. However, years passed without a law being enacted which would specify the amount of remuneration due in such cases. The result was that, as A. I. Vaksberg pointed out in an article published in 1961,

" . . . courts of all instances are refusing to consider claims involving royalties for authors of recorded works. The refusal is motivated by the absence of schedules of remuneration applicable to this particular case . . . " ³⁷

Thus, while the Federal Copyright Act of 1928 expressly protected the author's "exclusive" right to publish, reproduce and circulate his work and derive profits therefrom (Section 7), and while the Federal Supreme Court has expressly admitted the authors of recorded works to the protection of this right, Soviet courts subordinated this protection to the existence of schedules of remuneration. It was this state of affairs which prompted A. I. Vaksberg to voice concern lest it receive an encouragement from the *Project* of 1960,³⁸ which, in Section 82, expressly recognized the author's right to "receive the compensation fixed by Union legislation and that of the Union Republics . . ." The implications were ominous since the Soviet legislator has failed—quite understandably so—to enact schedules of fees that would cover all categories of copyrightable works.

In line with Vaksberg's objections, the *Principles* of 1961 made the right to receive remuneration independent of the existence of any standard tariff.³⁹

(b) The difficulties with sound recordings are conceivably at the origin of another innovation in the *Principles* (1961), as compared with the text of

36. Sbornik deistvuyushchikh postanovlenii Plenuma Verkhovnogo Suda SSSR, 1924-1957, text No. 82, p. 153.

37. A. I. Vaksberg, "S tochki zreniya praktiki", Sovetskoye Gosudarstvo i Pravo, No. 3, 1961, p. 99.

38. Ibid., p. 99.

39. Section 98.

the *Project* of 1960. The Federal Copyright Act of 1928 in Section 4 contained a long list of the possible objects of copyright, and a blanket provision that copyright applied to *any* literary, scientific or artistic work, *regardless* of the manner and form of its reproduction, or the value and purpose of the work.⁴⁰ In the *Project* of 1960, this list was not reproduced⁴¹ although the blanket statement remained. Vaksberg welcomed this omission and argued that since a list of copyrightable materials was bound to be incomplete, an incomplete list served no practical purpose.⁴² In his opinion, the blanket statement of Section 80 of the new *Project* served its purpose very well. L. M. Azov took exception to this view and argued that while an incomplete list was certainly of little practical use, the absence of a list was just as bad. Either solution was powerless to prevent in the future the repetition of the notorious difficulties with sound recordings and other controversial objects of copyright. Azov therefore advocated the compilation of a complete list of copyrightable materials.⁴³

The final text of the *Principles* (1961) adopted a compromise solution. It left the blanket statement and in parentheses included, as examples, some obvious and some controversial objects including magnetic tape and mechanical recordings, followed by "etc." ⁴⁴

Speaking of the objects of copyright, a mention should be made of another change in terminology. Section 4 of the Federal Copyright Act of 1928 protected a work "regardless of the manner and form of its reproduction or the value and purpose of the work." ⁴⁵ In the *Project* of 1960, the reference to the "value" of the work was missing. This was an obvious attempt to exclude ideologically objectionable works from copyright protection.⁴⁶ Azov objected that to eliminate such works from protection of copyright would leave the field wide open to abuse on the part of those who would "expurgate" these works and then claim their own copyright to them.⁴⁷ Azov also pointed out the difficulties connected with evaluating the "value" of the work in each particular

40. Gsovski, II, p. 400.

41. Section 80.

42. A. I. Vaksberg, loc. cit., pp. 97-98.

43. L. M. Azov, in *Sovetskoye Gosudarstvo i Pravo* (cit.), pp. 70-71.

44. Section 96.

45. Gsovski, II, p. 400.

46. Soviet courts traditionally refuse to uphold the "property interests" (i.e., claims to royalties) of authors whose works are not "socially useful", although under the system of the federal Copyright Act of 1928 these authors retained the copyright title. Cf. T. A. Faddeyeva, "Pravo avtorstva po sovetskomu grazhdanskomu pravu," *Vestnik Leningradskogo Universiteta, Seria Ekonomiki, Filosofii i Prava*, Vypusk 4, No. 23, 1957, p. 116.

47. *Sovetskoye Gosudarstvo i Pravo*, No. 9, 1960, p. 70.

case.⁴⁸ In line with these views, the *Principles* of 1961 restored the reference to the "value" of the work.⁴⁹

(c) The third case concerns works created in the line of official duty. The *Project* of 1960, for the first time, clearly recognized that "the author of a work created in the line of duty in a scientific or other organization shall be entitled to the copyright to such a work."⁵⁰ Until then, Soviet statutes failed to cover the subject except in two isolated cases,⁵¹ and Soviet courts were often inclined to deny the authors of such works any protection. However, the improvement proposed by the *Project* of 1960 was only illusory since authors of such works were expressly denied the right to receive remuneration for their works.⁵² Such a categorical statement threatened to affect the interests of authors of textbooks created in the line of official duty, whose right to receive remuneration for such works was specifically laid down in a Letter of the Ministry of Higher Education, dated August 2, 1954.

As expected, Section 82 was subjected to serious criticism on the part of Soviet jurists.⁵³ As the result of this criticism, the *Principles* of 1961 authorized the union republics to enact legislation specifying those cases in which payment can be claimed.⁵⁴

(d) A few words must be said concerning translations. The new *Principles* (1961) still profess freedom of translation, and give the translator an original copyright to the translated work.⁵⁵ However, an initial effort was made in the *Project* (1960) to safeguard the author's moral rights to the translated work. Section 84 provided that translations shall not constitute an infringement of the author's copyright "provided the translation preserves the meaning and the integrity" of the work.⁵⁶ The *Principles* (1961) went a step further and in Section 102 required the translator to notify the author of the original work of the translation project, as well as to preserve the meaning and integrity of the work.⁵⁷ Section 102 also empowers the union republics to define those cases in which the author of the original work is entitled to royalties. This provision,

48. Ibid., p. 70.

49. Section 96.

50. Section 82. Law in Eastern Europe, V, pp. 290-291.

51. The copyright to a motion picture film belonged to the studio.

52. Section 82.

53. Vaksberg, loc. cit., p. 100. In the opinion of a group of Soviet scholars, Section 82 implied that the authors of such works were not paid at all, even under the contract of employment. Cf. Sovetskoye Gosudarstvo i Pravo, No. 2, 1961, p. 82.

54. Section 100.

55. Section 102.

56. Section 84.

57. Section 102.

missing from the *Project* (1960), was designed to safeguard the present rights of authors belonging to the various Soviet nationalities whose works have been translated into Russian.

(e) A final word concerns exceptions to the infringement of copyright. The *Project* of 1960 entirely omitted the long list of such exceptions which had formed part of the Federal Copyright Act of 1928. In line with the energetic protests of Soviet copyright specialists,⁵⁸ the *Principles* of 1961 re-introduced this list and, in two sections (103 and 104), enumerated all those cases in which (a) the work can be used without the author's consent and without payment of royalties; and (b) the work can be used without the author's consent, but with payment of royalties to the author.⁵⁹

3. *Shortcomings of the Principles of 1961.* Among the obvious shortcomings of the *Principles* of 1961, two deserve particular attention. The first has to do with conflicts of jurisdiction as between federal and union republican authorities. The Federal Copyright Act of 1928 contained rather detailed rules on this subject.⁶⁰ Nonetheless, these rules proved to have been rather inadequate. There were frequent instances of concurrent jurisdiction; of provisions which remained unimplemented;⁶¹ of infringements by federal authorities of their own jurisdiction;⁶² and of rules which were simply inexpedient. The *Project* of 1960 did not improve the situation. In two cases, it assigned jurisdiction specifically to the union republics (Sections 85 and 86), but in three other cases it referred to "Union and Republican legislation" (Sections 82 and 85) without further defining the limits of their respective jurisdiction. The same confusion is characteristic of the *Principles* of 1961. There are cases in which jurisdiction is specifically assigned to the union republics; at least four areas of concurrent jurisdiction, and one important area in which jurisdiction is not assigned at all (remedies for the infringements of copyright). The general rule seems to be that in matters involving the scope and modalities of the author's property interests, republican authorities have jurisdiction.

The second shortcoming is the absence of any reference in the *Principles* (1961) to the remedies for infringements of copyright.⁶³ In the post-war

58. See Sovetskoye Gosudarstvo i Pravo, No. 3, 1960, p. 71.

59. Vedomosti, loc. cit., pp. 1300-1301.

60. Sections 8, 9, 14, 17 and 19.

61. Koretsky, op. cit., p. 61, note 1.

62. A typical case is cited in Koretsky, p. 214.

63. An objection in this sense, made by a group of thirteen Soviet copyright specialists, seems to have been disregarded (Sovetskoye Gosudarstvo i Pravo, No. 2, 1961, p. 102). It is interesting to note that the sections on the Law of Inventions do include provisions concerning disputes.

years, Soviet courts were very reluctant to allocate cash payments in recovery of damages caused by infringements of copyright under Section 10 of the R.S.F.S.R. Copyright Act of 1928, *i.e.*, according to special rates, computed, as a rule, at 150 per cent of the established tariff.⁶⁴ We are told in a recent textbook on Soviet copyright law that claims under this Section "are not, in actual practice, granted by the courts."⁶⁵ A Soviet 1961 textbook on *Civil Law* distinguishes between claims involving infringements of "personal" rights, and claims involving infringements of "property" rights. In the first case, Soviet courts will readily uphold the author's right to claim "the performance of such acts as are necessary for the satisfaction of the legitimate interests of the author" (insertion of the author's name, elimination of unauthorized changes or additions, etc.), in accordance with Section 11 of the R.S.F.S.R. Copyright Act of 1928. However, the authors will not be admitted to claim cash compensations for such damages, since "Socialist society does not recognize [the principle of] monetary compensation for the sustenance of moral damages."⁶⁶

In case of damages involving property interests (*i.e.* in the first place, royalties), Soviet courts seem ready to allocate cash payments, but not in amounts exceeding the actual damage, *i.e.*, without the "fines" provided for by the *Regulation* of June 8, 1930. On the other hand, the 1961 textbook seems to take the position that

"... at the present time, the ... property rights of the author are more often and more effectively protected by measures of social constraint ... and by administrative procedure rather than through courts."⁶⁷

In the absence of any reference to the protection of authors' rights in the *Principles* of 1961, it may be assumed that the union republics will take it upon themselves to fill the gap in the federal law. In the meanwhile, the situation remains highly confused.

4. *Status quo maintained in some cases.* It is impossible, within the limits of this brief survey, to point out all those recent changes in Soviet copyright practice or copyright legislation which remained outside of the scope of the *Principles* of 1961. We may mention, as mere samples, the abolition of the last vestiges of copyright registration (except for photo-

64. S. Levitsky, "The Soviet Press and Copyright Legislation: Some Legal Concepts," 25 *Fordham Law Review*, Autumn 1956, p. 482.

65. Antimonov and Fleishits, *op. cit.*, p. 158.

66. *Sovetskoye Grazhdanskoye Pravo*, Vol. II (1961), p. 424.

67. *Ibid.*, p. 424.

graphs),⁶⁸ the repeal of the tri-partite evaluation of the "quality" of a work, or a work's value for Socialist society,⁶⁹ or the formulation of penal responsibility for the infringement of copyright.⁷⁰ Nor is it possible to give here a full list of those provisions of the *Principles* (1961) which remained unaltered since 1928. Only two of the most significant cases will be pointed out:

(a) Section 106 of the *Principles* (1961) continues to provide for cases where the author's right to the published or performed work can be forcibly purchased by the Government from the author or his heirs, in accordance with the procedure laid down in the legislation of the union republics.

(b) The position of foreign authors under the *Principles* of 1961 is substantially the same as it was under the Federal Copyright Act of 1928, with the following exceptions:

Foreign authors whose works were first published on Soviet territory continue to enjoy copyright protection on the same footing with Soviet citizens, but their successors-in-law, other than heirs, can no longer claim protection of their rights. Also, the entire range of innovations of the *Principles* (1961) is applicable to them, particularly the restrictions *post mortem auctoris*.

Foreign authors whose works were first published on Soviet territory are in a better position to control the integrity of their works, since under Section 102, translators must now notify them of the translation project and preserve the meaning and integrity of the work.

Foreign authors whose works were first published abroad continue to be excluded from copyright protection except on the basis and within the limits of international agreements. However, Section 129 of the *Principles* (1961)⁷¹ provides for the possibility that the rules laid down in international agreements differ from those established in the *Principles*, and specifies that in such a case the rules laid down in international agreements shall prevail.

Thus the Soviet government continues to hold out to the foreign author the prospects of a better protection of his rights in the future. It remains to be seen whether this provision is a matter of style or a promise of a new era in the international protection of copyright.

68. Vedomosti Verkhovnogo Soveta R.S.F.S.R., No. 13 (36), text 234 (1959).

69. See above, note 13.

70. Section 141 of the new R.S.F.S.R. Criminal Code (enacted in 1961, see Vedomosti Verkhovnogo Soveta R.S.F.S.R., No. 40 (111), text 591 (1960)).

71. Vedomosti, loc cit., p. 1306.

188. NORWEGIAN COPYRIGHT LAW REVISION

By *BIRGER STUEVOLD LASSEN*¹

The Norwegian Copyright Act of 1930, once considered a model act and a masterpiece of the fine art of legislation, has had to give way to a newcomer, The Copyright Act of May 12, 1961.²

The change was necessitated only partly by shortcomings in the old act. Although it was drafted in those happy days when no one dreamt of tape-recorders or television, it was still seaworthy. Yet, as early as 1938 the first steps were taken towards revision—and were met with vehement protests by authors, publishers, broadcasters and lawyers, some of whom are still grumbling. A rather peculiar situation, the key to which is found in the strong drive to establish in broad fields homogeneous legislation in the five Nordic countries, Denmark, Finland, Iceland, Norway and Sweden. In this case some of the other countries felt the need for revision. After more than twenty years of preparatory work—legislative co-operation across national borders is a very slow process, and in this case was made even slower by the German occupation of Denmark and Norway—new copyright acts came into force in four of the countries in 1961. Iceland had chosen to wait and see.

As might be expected, the four acts are not quite identical. National idiosyncrasy can be suppressed only to a point, even if the will to compromise is strong. It must be admitted that the Norwegian act is the most individualistic of the four, and that this is not in all respects caused by its being the best statute. More likely it is caused by our authors' dogged defence of all privileges—real and symbolic—granted to them in the 1930 act, or by the usual Norwegian attitude to compromise: It is no good if it is not exactly the way we want it. It must also be admitted that compared with the 1930 act, the new act seems clumsy and complicated. There is no reason to believe that it will ever be called a masterpiece of legislation. Nevertheless, it may well prove in practice to be worthy of its predecessor.

In one respect the new act upholds and underlines a maxim of the 1930 act which operates to the disfavor of the copyright owners, and establishes a slight, but none the less fundamental, difference between Norwegian law and the copyright law of most other western countries—the other Nordic countries included. Copyright acts are usually built on the principle that the author's right to his work is absolute, and that such rules as that of fair use, those excluding certain performances which are not for profit, and even the rules

1. Assistant Professor, University of Oslo.

2. In force from July 1, 1961. An authorized French translation of the act was published in *Le Droit d'Auteur* 1961, pp. 258-64.

limiting the duration of copyright, are necessary but most regrettable man-made limitations of this absolute right. Norwegian law, however, is built on the idea that the "right of the people" to a literary, musical or artistic work is founded on a basis just as sound and unquestionable as that on which rests the author's own right.

From the Norwegian legislators' point of view the problem is, therefore, not how many limitations can be imposed on the author's exclusive right, but rather, how should these two conflicting but equally well-founded rights be balanced. Whereas judges in other countries interpret the limitations restrictively, as exceptions from an otherwise unlimited monopoly, the Norwegian judge must bear in mind that his task is to carry out the careful balancing of interests intended by the legislators. Since the regulations of the Berne Convention have held back the legislators, the inroads on the author's right are seldom perceptibly more substantial in the Norwegian act than in those of the other Nordic countries. But the Convention's control of judicial attitude is less firm, and as the preparatory documents of our new act discourage restrictive interpretation in very clear words, it must be expected that some of the rules, however verbally identical in the four countries, will not stay identical in practice.

The new act has not brought any radical changes in regard to the author's pecuniary rights. According to section 2, copyright shall include—subject to the limitations stated in Chapters 2 and 4—the exclusive right to control a work "by producing copies thereof and by making it available to the public, be it in the original or a changed form, in translation or adaptation, in other literary or artistic form, or by other technical means". A work is made "available to the public" by performance outside "the private domain", and when copies of the work are placed on sale, lease or loan, or otherwise distributed or exhibited outside the private domain. The copyright owner is the person who has created the work (sec. 1), and his rights come into existence at the creation of the work; no formalities are required.

The act cannot, of course, live up to its own generous grant to the copyright owner of the exclusive right to all kinds of distribution of copies of the work. Section 21 recoups most of what section 2 gives in this respect, stating that "when a literary, scientific or musical work has been published, copies included in the publication may be further distributed and publicly exhibited; however, copies of musical works may not be leased to the public without the author's consent". And section 23 invades the exclusive right relating to works of art, decreeing that when such works have been published, or when the author has transferred copies of them, the copies thus transferred or included in the publication may be further distributed and publicly exhibited.

Nevertheless, there is a chance that a Norwegian painter might get some compensation for the resale of his paintings, and that the Norwegian writer

might eventually benefit from the lending or leasing of his books. Two special acts, the *Library Act* of 1947 and the *Lex Ulrik Hendriksen* of 1948, operate to that effect. But whereas the copyright act concentrates on the individual artist or writer and grants him the exclusive right to the profit of his work, these two acts are founded on fundamentally different ideas. The *Lex Ulrik Hendriksen* introduced a sort of substitute for a *droit de suite* system, levying a purchase tax of 3 per cent on public sales of works of art, be they Norwegian or foreign, protected or in the public domain. The money does not, however, go to the owners of the copyright, but is paid to a foundation for the benefit of young talented and old meritorious Norwegian artists.

The practical advantages of the system are obvious: distribution of the money to the individual copyright owners necessitates extremely complicated and therefore expensive administration and bookkeeping. The national advantages are just as evident: royalty is paid on the sales of the works of foreign as well as Norwegian artists, but only the latter benefit from the funds! It is an interesting trait, in many ways characteristic of Norway today, that during the painstaking preparation of a copyright act built on exclusive rights for the author, a sort of subsidiary copyright statute comes out and completely discards the principle of individual copyright. The demands for an extension of the artist's right to his work are met, not with the creation of new prerogatives for the individual, but with the introduction of a new tax, and redistribution of the tax money according to principles of social policy. The welfare state has entered the field of copyright law. The *Library Act* introduces a similar system for loans and leases of books from public libraries.³

The other limitations on the author's right stated in Chapter 2 of the copyright act are varied. Section 11 allows any person to produce single copies of a disseminated⁴ work for private use, on the condition that the reproduction is not made for profit and that the copies are not employed for other purposes than private ones. The provision does not include permission to engage others to reproduce articles of applied art, sculpture or woven Gobelins, nor to engage others to copy works of art by artistic reproduction. As for musical works,

3. For a somewhat broader discussion of these two acts, both of which were drafted in accordance with the wishes of the authors, see Birger Stuevold Lassen, *Lettre de Norvège*, in *Le Droit d'Auteur* 1961, p. 76 (at pp. 78-9).

4. "A work is considered disseminated when with the consent of the author it has been made available to the public. A work of art is considered disseminated also when the author has transferred a copy of the work to another person, and such copy has been made available to the public in accordance with the provisions of section 23.

"A work is considered published when a reasonable number of copies thereof with the consent of the author have been placed on sale or otherwise distributed to the public". (Section 8.)

other persons may be engaged to do the work when it is not done for consideration. Architectural works may not be copied by construction of buildings.

Sections 16 and 17 contain provisions permitting a rather limited amount of copying to be done by specified archives and libraries, and permitting sound recordings to be made for educational purposes and for the use of the blind and disabled. Musical works may not be recorded for the use of blind or disabled persons, but all kinds of works may be reproduced in Braille freely. When a work is recorded for the use of the blind or disabled, the author is entitled to be paid by the *State*.

The author's exclusive right to public performance suffers quite a substantial reduction by the provisions of section 18. A published work may be performed publicly in religious services, and, unless it is a cinematographic work created especially for such performance, in connection with education. Public performance of published works other than dramatic or cinematographic is permitted also if no attendance fees are charged and the performance is not arranged for profit, *or* if the performance takes place during a choral fête, musical festival, youth-meeting or other public fête not arranged for profit.

Compulsory licences are introduced in two cases. First, when five years have elapsed since the publication of literary, scientific or musical works, small parts of the works, or small works, may be included in composite works designed for use in religious services or in education, provided that the composite work consists of works or parts of works by a considerable number of authors. Second, works of art may be reproduced in connection with the text in such composite works when five years have elapsed since the dissemination of the work (section 15). Section 20 applies only to the Norwegian State Broadcasting Corporation. Provided the Corporation has an agreement with an organization representing the greater number of Norwegian authors under which it may broadcast their works, the Corporation is entitled to broadcast works of authors not represented by the organization. This provision does not apply to dramatic works, or to other works if the author *personally* has prohibited the broadcasting of them, or if there are particular reasons to assume that the author opposes broadcasting. Other copyright owners cannot prohibit broadcasting; this right is granted only to the author himself.

The right to quote a disseminated work "in accordance with proper usage, to the extent necessary for the purpose" is stated in section 13, which also applies the same rule to the reproduction of disseminated works of art in connection with the text of critical or learned treatises. Newspapers and periodicals may reproduce articles from other newspapers and periodicals on current religious, political or economic topics, unless such reproduction is expressly prohibited (sec. 14). A notice of copyright, valid under the Universal Copyright Convention, will be sufficient to prohibit this kind of reproduction. In connection with the reporting of a news event, newspapers and periodicals may

publish pictures of disseminated works of art, provided the works have not been created for the purpose of reproduction in such publications. Other provisions in favour of the news services are to be found in sections 19 and 23. The former states: "If the performance or exhibition of a work is part of a news event which is broadcasted or filmed, short excerpts of the work, or, if it is of minor size, the entire work, may be included in the broadcast or the film. In cases where the performance or exhibition of the work only form part of the background of the broadcast or film, or are otherwise of minor importance in relation to the main subject of the reportage, the entire work may be included". The latter paragraph is, *mutatis mutandis*, repeated in section 23 with regard to copies of works of art transferred by the author. Section 23 also deals with works of art permanently situated outdoors in public places, streets, etc. Such works may be reproduced in pictorial form, but if the work is clearly the main motive and the reproduction is made for profit, the author is entitled to a compensation, unless the reproduction appears only in newspapers, periodicals or in broadcasts.

There is no copyright in statutes, administrative regulations, court decisions or other public documents. Deliberations in Parliament, in municipal councils, in meetings of other elected public authorities, court proceedings, etc. are in principle subject to copyright, but may be reproduced freely without the author's consent. The author, therefore, retains only his moral rights (see below), and an exclusive right to publish compilations of his own statements (sections 9 and 22).

Chapter 4 contains provisions on the duration of copyright, which is 50 years *post mortem auctoris* or, in the case of anonymous works, 50 years after the first dissemination of the work. A special act of 1955, however, prolongs copyright in works by authors deceased before the end of the year 1955 for 6 years, provided that the work was not already in the public domain on December 2, 1955. The extra six years, allotted to make up for losses suffered during the war, 1939-45, are also granted to anonymous works published before the end of the year 1955.⁵

The act also contains a number of provisions regarding transfer of copyright, liability for infringement, etc., which are likely to be of less interest to foreign lawyers. The provisions on the author's *moral rights*, however, contain a few minor radical innovations.

The experts preparing the Copyright Bill had omitted some of the 1930 act's rules safeguarding moral rights. Although the proposed changes were not of major importance, they were severely criticized. The opinion of the critics was shared by the Parliamentary Committee, which stated clearly and without

5. A French translation of the prolongation act was published in *Le Droit d'Auteur* 1956, p. 118.

reservation: "The moral rights of the author should, in our opinion, on no point, in no way, be made weaker than they are according to the act now in force."⁶ This uncompromising pledge led the Parliamentary Committee to introduce several changes in the bill. But the Committee was not satisfied to play the role of a passive defender of moral rights already won by the authors. The main differences between the Norwegian act and those of Denmark, Finland and Sweden are to be found among the new rules brought in by the Parliamentary Committee in order to extend and strengthen the protection of moral rights.

The principal provisions are those of sections 3 and 48, the former dealing with works in which full copyright subsists, the latter safeguarding the author's moral interests after his death and after the expiration of all pecuniary rights. Section 48 even spreads its protective wings over all works of all authors, regardless of nationality, international conventions or bilateral treaties.

The first paragraph of section 3 decrees that whenever copies of a work are produced, and whenever the work is made available to the public, the author has a right to have his name stated in the manner "called for by proper usage". According to section 48, this provision also shall apply after the period of copyright has expired, and even if the work has never been subject to copyright in Norway. Section 24 repeats the rule once more, bearing on the reproductions and performances permitted by the limitation rules of Chapter 2.

Section 3 silently assumes that no one has a right to alter a work without the consent of the author, and states: "If another person has a right to alter a work or to make it available to the public, this must not be done in a manner or in a context which is prejudicial to the author's literary, scientific or artistic reputation or individuality, or prejudicial to the reputation of the work itself." Section 48 repeats this provision, for the benefit of works in the public domain, adding that alterations of a work are also illegal if they are made "in a manner which may be harmful to general cultural interests". As the author's heirs cannot always be relied upon as the best guards of his moral interests—they might be partial to money—the Ministry concerned is given a right to forbid violations of a work after the author's death, even if the copyright owners have consented. Similar bans can also be issued by the Ministry on the request of a living author if the work in question is not subject to copyright in Norway.

The rights granted by section 3 can be waived only in regard to clearly specified uses. And, even where a valid consent has been obtained, the author retains an inalienable right to demand, if the work is made available to the public in such prejudicial form as mentioned, that *either* his name shall not be

6. *Innstilling til Odelstinget XI, 1960-61*, p. 16.

stated *or* that satisfactory statements are made to the effect that the alterations do not derive from him.

Section 24 again safeguards the author's moral interests vis-à-vis the uses permitted according to the rules of Chapter 2.

Artists have, for a long time, demanded some protection against wilful destruction of their works. Section 49 contains a tentative step towards such protection, decreeing that "if circumstance necessitates the destruction of the original copy of a work, the author shall, if he is alive, be warned in reasonable time, if this can be done without great sacrifice or expenditure". The wording should be noted, as it implies an assumption by the legislators that decent people will not unnecessarily destroy works of art.

In the same tentative way, section 49 introduces a very limited *droit d'accès*. The owner of an original work can be compelled by order of court to give the author reasonable access thereto. The court shall, of course, consider all relevant circumstances before issuing such an order, and may make the order conditional on guarantees, or may lay down other conditions. The provision applies to the author's borrowing of the work for exhibitions, as well as for reproduction, but since only the author himself, and only with the consent of the Ministry, can apply for such a court order, the provision is obviously not of great practical importance.

A provision of greater practical importance is section 50, which deals with the married author's pecuniary and moral rights. Regardless of the property rights arrangement between husband and wife, the author always retains exclusive copyright in his works, and, if a joint estate is divided during the lifetime of the author-spouse, his copyright shall not be taken into account in the settlement. The latter rule applies to his copyright only, not to property rights in copies of the work.

Chapter 5 of the act deals with the rights of performing artists, producers of phonograph records and broadcasters. A performing artist's performance may not without his consent be recorded, filmed, broadcasted or otherwise made available by technical means to a greater audience than the one for which he gives the performance (section 42). Phonograph records and other sound recordings may not be copied without the consent of the producer before 25 years have elapsed since the making of the recordings (section 45). Most of the limitations of copyright proper are brought to bear on the rights of performers and phonograph record producers. Neither performers nor record producers have any individual rights with regard to secondary use: here the welfare state has again affected the law. The *Lex Gammleng* of 1956 regulates the payment for secondary use on the same lines as the *Lex Ulrik Hendriksen* and the *Library Act*. The broadcasters' rights, on the other hand, are not specified yet; the act only states that "the King may lay down the conditions on which a broadcast may be retransmitted or recorded".

Photographic pictures are not subject to copyright, but are protected according to the *Act on Rights in Photographic Pictures*, of 17th June 1960, in force from July 1, 1960.

The new Copyright Act has removed the few minor obstacles for Norway's accession to the Universal Copyright Convention and to the Brussels text of the Berne Convention. It is expected that such accession will take place in the very near future. Ratification of the new Rome Convention will necessitate a minor change in the act, and can only be effected with reservation as regards the payment for secondary use.

PART II.

LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS

1. UNITED STATES OF AMERICA AND TERRITORIES

189. U. S. CONGRESS. HOUSE.

H.R. 10038. A bill to provide civil remedies to persons damaged by unfair commercial activities in or affecting commerce. Introduced by Mr. Lindsay, February 1, 1962, and referred to the Committee on the Judiciary. 6 p. (87th Cong., 2d sess.)

A substitute bill for H.R. 4590 (87th Cong., 1st sess.) See 8 BULL. CR. SOC. 258, Item 196 (1961). See also Items 193 and 194, *infra*.

190. U. S. CONGRESS. HOUSE.

H.R. 10170. A bill relating to tax treatment of transfers of rights to copyrights and literary, musical, and artistic compositions. Introduced by Mr. Giaimo, February 8, 1962, and referred to the Committee on Ways and Means. 4 p. (87th Cong., 2d sess.)

Identical with H.R. 9524 (87th Cong., 2d sess.) See 9 BULL. CR. SOC. 247, Item 138 (1962).

191. U. S. CONGRESS. HOUSE.

McDowell, Harris B., Jr. To achieve excellence in education the fine arts must have equal status in our public schools and colleges with such credit courses as science and modern foreign languages, as well as with football, basketball, automobile mechanics, typing, bookkeeping, and shorthand; extension of remarks. *Congressional Record*, vol. 108, no. 15 (daily ed. Feb. 1, 1962), pp. A754-A755.

Extension, in the appendix of the *Record*, of Congressman McDowell's remarks, together with explanatory material, in reference to his introduction of H.R. 9906. See 9 BULL. CR. SOC. 247, Item 139 (1962).

192. U. S. CONGRESS. HOUSE.

H.J. Res. 627. Joint resolution extending the duration of copyright in certain cases. Introduced by Mr. Celler, February 15, 1962, and referred to the Committee on the Judiciary. 1 p. (87th Cong., 2d sess.)

This is a resolution to extend the life of the renewal term of copyright subsisting in any work on the date of approval of the resolution until December 31, 1967, if such term would expire before that date. It was introduced as a stopgap measure to keep valuable rights from expiring pending enactment of general revision legislation.

193. U. S. CONGRESS. SENATE.

S. 2784. A bill to provide civil remedies to persons damaged by unfair commercial activities in or affecting commerce. Introduced by Mr. Javits, February 2, 1962, and referred to the Committee on the Judiciary. 6 p. (87th Cong., 2d sess.)

A substitute bill for S. 1036 (87th Cong., 1st sess.) which was introduced by Mr. Javits on February 22, 1961, at the behest of the Association of the Bar of the City of New York (see 8 BULL. CR. SOC. 258, Item 197 (1961)). The present bill, which is identical with H.R. 10038, *supra* Item 189, contains certain revisions which the association considered appropriate for purposes of clarification and to meet some criticisms. See also Item 194, *infra*.

194. U. S. CONGRESS. SENATE.

Javits, Jacob G. Civil remedies to persons damaged by unfair commercial activities in or affecting commerce. *Congressional Record*, vol. 108, no. 16 (daily ed. Feb. 2, 1962), pp. 1257-1258.

Remarks of Mr. Javits on his introduction of S. 2784, accompanied by the text of the bill together with a brief memorandum showing the changes as compared with S. 1036 which Mr. Javits introduced during the first session of the 87th Congress. See Item 193, *supra*.

195. U. S. COPYRIGHT OFFICE.

Copyright for commercial prints and labels. Washington, U. S. Govt. Print. Off., Feb. 1962. 2 p. Cir. 46.

A completely revised circular. See 6 BULL. CR. SOC. 79, Item 76 (1958).

196. U. S. COPYRIGHT OFFICE.

Copyright for loose-leaf publications. Washington, U. S. Govt. Print. Off., Feb. 1962. 1 p. Cir. 16C.

Instructions as to the notice requirements and registration of loose-leaf materials published at intervals for insertion in a binder.

2. FOREIGN NATIONS197. GHANA. *Laws, statutes, etc.*

Copyright Act, 1961. Act 85. Date of assent: 8th November, 1961. Accra, Printed by Govt. Print. Dept., 1962. 11, 1 pp.

This new law, listed last month at 9 BULL. CR. SOC. 249, Item 148 (1962), became effective on March 1, 1962. As mentioned previously, the new law appears to be influenced by the Universal Copyright Convention. Under its terms literary, musical and artistic works, motion pictures, phonograph records and broadcasts are protected. Duration for unpublished works is for 25 years after the end of the year in which the author dies, and for published works, the end of the year in which the author dies or 25 years after the end of the year in which the work was first published, whichever is later, except that for certain classes of works shorter terms are provided. Foreign authors domiciled in Ghana, and nationals of member countries of the U.C.C. and of Guinea and Mali are accorded the same protection as Ghana authors.

PART III.

CONVENTIONS, TREATIES AND PROCLAMATIONS

198. DENMARK.

Accession to the Berne Convention for the Protection of Literary and Artistic Works revised last at Brussels on June 26th, 1948 (with effect as from February 19th, 1962). (75 *Le Droit d'Auteur* [English inset] 21, no. 2, Feb. 1962.)

Notification, by the Swiss Government to the Governments of the Berne Union countries, of Denmark's accession to the Brussels revision of the Berne Convention. The French text of a note of October 28, 1961 from the Royal Embassy of Denmark in Berne to the Swiss Federal Political Department, with respect to the accession, is appended.

199. Diplomatic Conference on Neighboring Rights, *Rome, 1961.*

International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations. (14 *UNESCO Copyright Bulletin* 171-183, 217-230, 263-276, no. 2, 1961.)

In English, French and Spanish.

200. Intergovernmental Copyright Committee. *6th session, Madrid, Sept. 25-30, 1961.*

Records. (14 *UNESCO Copyright Bulletin* 149-170, 195-216, 241-262, no. 2, 1961.)

Contents.—Report.—Resolutions.—List of participants.

The Records, in English, French and Spanish, of the sixth session of the I.G.C.C. held jointly with the tenth session of the Permanent Committee of the Berne Union. See also 9 BULL. CR. SOC. 230, Item 137 (1962).

201. International Copyright Union.

Statement as of January 1st, 1962. (75 *Le Droit d'Auteur* [English inset] 20-23, no. 2, Feb. 1962.)

The annual report of the Berne Bureau listing the member countries, and showing, in tabular form, the revisions of the Convention ratified by each, together with their reservations, as of January 1, 1962, reprinted below at Item 204.

202. International Copyright Union. *Permanent Committee. 10th Session, Madrid, 1961.*

Résolutions. Genève, Bureau international pour la protection des œuvres littéraires et artistiques, 1961. 9 p. (DACP/2/12)

The text, in French and English on opposite pages, of the resolutions adopted at the 10th session of the Permanent Committee of the Berne Union in Madrid, September 25-30, 1961. Most of the resolutions were also approved by the Intergovernmental Copyright Committee which held its sixth session jointly with the tenth session of the Permanent Committee. See also 9 BULL. CR. SOC. 230, Item 137 (1962).

203. Study Group on the International Protection of Cinematographic Works.

Report [of the Study Group, meeting at Geneva, 20-23 June 1961, and Madrid, 26-29 September 1961] by Henri Desbois, General Rapporteur. Genève, Bureau international pour la protection des œuvres littéraires et artistiques, 1961. 16 p.

At head of title: United Nations Educational, Scientific and Cultural Organization, Paris [and] International Union for the Protection of Literary and Artistic Works, Geneva.

The final report of the Study Group set up by the Permanent Committee of the Berne Union and the UNESCO Intergovernmental Copyright Committee to prepare a report on the manner in which provisions of the Berne and Universal Copyright Conventions dealing with the International protection of cinematographic works might be revised.

204. List of Contracting Berne Union Countries.

(As of January 1, 1962)*

Australia	Finland
Austria	France
Belgium	Germany
Brazil	Great Britain
Bulgaria	Greece
Canada	Holy See
Ceylon	Hungary
Czechoslovakia	Iceland
Dahomey	India
Denmark	Ireland

* Taken from *Le Droit d'Auteur*, official publication of the Berne Union, issue of January 1962.

Israel	Philippines
Italy	Poland
Ivory Coast	Portugal
Japan	Rumania
Lebanon	Siam (Thailand)
Liechtenstein	Spain
Luxembourg	Sweden
Monaco	Switzerland
Morocco	Syria
Netherlands	Tunisia
New Zealand	Turkey
Norway	Union of South Africa
Pakistan	Yugoslavia

The "Berne Union" is made up of countries adhering to one or more of the following: the original Berne Convention of 1886 and the successive revisions of Paris 1896, Berlin 1908, Rome 1928, and Brussels 1948. Since different countries have different relationships under one or more of these, persons interested in obtaining detailed information, including application of the various provisions to territorial areas, should consult the Bureau de l'Union internationale pour la protection des œuvres littéraires et artistiques, 32, chemin des Colombettes, Geneva, Switzerland.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U. S. COURTS

1. Federal Court Decisions

205. *Public Affairs Associates, Inc. v. Rickover*, 30 U.S.L. Week 4187, 132 U.S.P.Q. 535 (U.S., Mar. 5, 1962) (per curiam), reversing 284 F. 2d 262, 127 U.S.P.Q. 231, 8 BULL. CR. SOC. 47, Item 22 (D.C. Cir. 1960), which reversed 177 F. Supp. 601, 123 U.S.P.Q. 252, 7 BULL. CR. SOC. 102, Item 110 (D.D.C. 1959).

It will be recalled that in this important case both the District Court and the Circuit Court held that Admiral Rickover's speeches were not government publications, although some of the material had been typed with the use of government facilities and with the assistance of a government employee. With respect to the distribution of copies of some of the speeches to the press, the Circuit Court, one judge dissenting, reversed the District Court and held that such distribution constituted a publication without proper copyright notice whereby Admiral Rickover's copyright was forfeited.

The Supreme Court has now held that the record of the case, which was submitted in the form of an agreed statement of facts, was insufficient and too "sketchy" to enable the Court to decide the important questions involved. The Circuit Court decision was therefore reversed and the case remanded. Justice Douglas wrote a separate concurring opinion, while the Chief Justice wrote a dissenting opinion, concurred in by Justice Whittaker; Justice Harlan wrote a separate dissenting opinion. Because the case is of such importance, and because it has aroused so much interest, the Editorial Board deems it desirable to reprint these Supreme Court opinions here in full.

PER CURIAM.

These two cases arose under the Declaratory Judgment Act of June 14, 1934, 48 Stat. 955, as amended, now 28 U. S. C. (1958 ed.) §§ 2201 and 2202. The plaintiff, an educational publishing corporation, asked defendant, Vice Admiral Rickover, for leave to publish, to an undefined extent, uncopyrighted speeches he had theretofore delivered. He refused on the ground that what he claimed to be exclusive publishing rights

had been sold to another publisher, and he gave notice of copyright on speeches subsequent to the plaintiff's demand. Since the defendant threatened restraint of plaintiff's use of his speeches, the plaintiff sought this declaratory relief. The District Court dismissed the complaint on the merits, 177 F. Supp. 601. The Court of Appeals (one judge dissenting), agreeing with the District Court that the defendant had, as to his uncopyrighted speeches, the common-law rights of an author, held that he had forfeited his rights by reason of their "publication"; as to his copyrighted speeches, that court remanded the case to the District Court for determination of the extent to which "fair use" was open to the plaintiff. 284 F. 2d 262. By petition for certiorari and cross-petition both parties sought review and because serious public questions were in issue we brought the cases here. 365 U. S. 841.

The Declaratory Judgment Act was an authorization, not a command. It gave the federal courts competence to make a declaration of rights; it did not impose a duty to do so. *Brillhart v. Excess. Ins. Co.*, 316 U. S. 491, 494, 499; *Great Lakes Co. v. Huffman*, 319 U. S. 293, 299-300; *Federation of Labor v. McAdory*, 325 U. S. 450, 462; *Mechling Barge Lines v. United States*, 368 U. S. 324, 331. Of course a District Court cannot decline to entertain such an action as a matter of whim or personal disinclination. "A declaratory judgment, like other forms of equitable relief, should be granted only as a matter of judicial discretion, exercised in the public interest." *Eccles v. Peoples Bank*, 333 U. S. 426, 431. We have cautioned against declaratory judgments on issues of public moment, even falling short of constitutionality, in speculative situations. *Eccles v. Peoples Bank*, *supra*, at 432.

In these cases we are asked to determine matters of serious public concern. They relate to claims to intellectual property arising out of public employment. They thus raise questions touching the responsibilities and immunities of those engaged in the public service, particularly high officers, and the rightful demands of the Government and the public upon those serving it. These are delicate problems; their solution is bound to have far-reaching import. Adjudication of such problems, certainly by way of resort to a discretionary declaratory judgment, should rest on an adequate and full-bodied record. The record before us is woefully lacking in these requirements.

The decisions of the courts below rested on an Agreed Statement of Facts which sketchily summarized the circumstances of the preparation and of the delivery of the speeches in controversy in relation to the Vice Admiral's official duties. The nature and scope of his duties were not clearly defined and less than an adequate exposition of the use by him of Government facilities and Government personnel in the preparation

of these speeches was given. Administrative practice, insofar as it may relevantly shed light, was not explored. The Statement of Facts was in part phrased, modified and interpreted in the course of a running exchange between trial judge and counsel. The extent of the agreement of counsel to the Agreed Statement of Facts was in part explained in the course of oral argument in the District Court. None of the undetailed and loose, if not ambiguous, statements in the Agreed Statement of Facts was subject to the safeguards of critical probing through examination and cross-examination. This is all the more disturbing where vital public interests are implicated in a requested declaration and the Government asserted no claim (indeed obliquely may be deemed not to have disapproved of the defendant's claim) although the Government was invited to appear in the litigation as *amicus curiae* and chose not to do so. So fragile a record is an unsatisfactory basis on which to entertain this action for declaratory relief.

Accordingly, the judgment of the Court of Appeals is vacated, with direction to return the case to the District Court for disposition not inconsistent with this opinion.

It is so ordered.

MR. JUSTICE DOUGLAS, concurring.

It is conceded that the Declaratory Judgment Act is an authorization, not a command—a conclusion as well settled as is the proposition that the jurisdiction of federal courts is confined to “cases” or “controversies.” *Aetna Life Ins. Co. v. Haworth*, 300 U. S. 227. The requirements of a “case” or “controversy” and the propriety of the use of the declaratory judgment are at times closely enmeshed. In resolving those issues the Court has on the whole been niggardly in the exercise of its authority. Thus, in *Doremus v. Board of Education*, 342 U. S. 429, a taxpayer’s suit to declare that a public school system could not be used for religious instruction was dismissed because there was not “the requisite financial interest.” *Id.*, at 435. *Frothingham v. Mellon*, 262 U. S. 447—a decision with which I have great difficulty—was given new dimensions. That case held that a taxpayer of the United States had no standing to challenge a federal appropriation, since the question was essentially a matter of public, not private, concern.¹ *Id.*, at 487. This ruling was projected

1. “Back in 1923, the Court went further and held that the mere fact that a person could show he paid federal taxes made no difference in this respect and gave him no standing to challenge an act of Congress appropriating public funds. The Court recognized that an unconstitutional spending of public money might conceivably necessitate a rise in subsequent tax levies. Nevertheless it held that the causal connection between any specific expenditure and future tax rates would be too remote and uncertain to con-

into the state field by the *Doremus* case, barring relief to those legitimately concerned with the operation of the public school system.

At times the question of the "ripeness" of an issue for judicial review is brigaded with the appropriateness of declaratory relief. In *Public Service Comm'n v. Wycoff Co.*, 344 U. S. 237, 244, relief was denied though a carrier's certificate to do an interstate business was placed in jeopardy by threatened state action. That principle was extended in *Eccles v. Peoples Bank*, 333 U. S. 426, to deny relief in a situation comparable to a suit to remove a cloud from one's title. For a bank was being saddled with conditions by the Federal Reserve System that crippled its activities and restricted the market for its stock. On other occasions, "mootness" has been used as the rubric to deny relief through the route of a declaratory judgment, even though the litigant was still insecure and in peril as a result of administrative action. *Mechling Barge Lines v. United States*, 368 U. S. 324.

At other times the issue is said to be "abstract" because of the lack of immediacy in the threatened enforcement of a law. Thus, a person must risk going to jail or losing his job to get relief. That was true in *Poe v. Ullman*, 367 U. S. 497, a case involving Connecticut's birth control law, and in *United Public Workers v. Mitchell*, 330 U. S. 75, involving Civil Service Rules restricting the political rights of federal employees.

The list is not complete. But these cases illustrate the restrictive nature of the judge-made rules which have made the federal courts so inhospitable to litigation to vindicate private rights. At no time has the Court been wholly consistent; nor have I. Compare *Connecticut Ins. Co. v. Moore*, 333 U. S. 541, 556, with *Western Union Co. v. Pennsylvania*, 368 U. S. 71. But my maturing view is that courts do law and justice a disservice when they close their doors to people who, though not in jail nor yet penalized, live under a regime of peril and insecurity. What are courts for, if not for removing clouds on title, as well as adjudicating the rights of those against whom the law is aimed, though not immediately applied?

stitute an immediate personal injury to a taxpayer. Hence he would have no more to complain about than others.

"Rulings of this kind, designed to keep peace among the departments of government, are eminently sensible as over-all policies. Yet they also provide a way to immunize a bad law from attack in the courts: one need only frame the law in such a way as to violate the basic rights of nobody in particular but everybody in general, that is, of the *entire* American people. Then, since no one can point to an injury that is distinguishable from his neighbors', no one can come into court and challenge the legislation!" Edmond Cahn, *How to Destroy the Churches*, Harper's Magazine, Oct. 26, 1961, p. 36.

Evers v. Dwyer, 358 U. S. 202, is illustrative of what I deem to be the important role served by the declaratory judgment. A Negro who had not been arrested for riding a segregated bus brought a class action to have his rights and those of his class adjudicated. We held there was an "actual controversy," because it was clear that the local authorities were bent on enforcing the segregation law, though they had not enforced it against this plaintiff.²

The opinion of the Court in this case seems to set declaratory relief apart as suspect; it leaves the *innuendo* that if the case were here under a different complaint, the result might be different. I share none of these disparaging thoughts. I agree, however, that no matter what the cause of action might be, the present record leaves gaps which make an adjudication impossible. The lack of evidence as to the extent to which respondent's literary works were products of his office is fatal for me, though, of course, it would not be to one who considers those facts irrelevant to the legal issue. The approach we take today has often been used to abdicate the judicial function under resounding utterances concerning the importance of judicial self-denial. See, e.g., *United States v. Auto. Workers*, 352 U. S. 567, 590-592. It has also served to place undue emphasis upon the clarity and precision of the questions presented, as in *Rescue Army v. Municipal Court*, 331 U. S. 549, where the Court subjected the appellant "to the burden of undergoing a third trial" in order that the issues might be in a more "clean-cut and concrete form." *Id.*, at 584. But on the present record I have no other choice, for without additional facts I must withhold decision.

MR. CHIEF JUSTICE WARREN, with whom MR. JUSTICE WHITTAKER concurs, dissenting.

With respect to those of Admiral Rickover's speeches written and delivered prior to December 1, 1958, I would affirm. The record made below and filed here is, I believe, adequate to support the judgment of the Court of Appeals that the Admiral's practice of distributing numerous copies of his speeches, without limitations as to the persons who would receive them or the purposes to which they would be put by the

2. And see *Mitchell v. United States*, 313 U. S. 80, where we held that a Negro who filed a complaint with the Interstate Commerce Commission against an interstate carrier for discriminating against him had standing to complain, though it did not appear that he intended to make a similar railroad journey:

"He is an American citizen free to travel, and he is entitled to go by this particular route whenever he chooses to take it and in that event to have facilities for his journey without any discrimination against him which the Interstate Commerce Act forbids." *Id.*, at 93.

recipients, and without so much as a suggestion of a copyright claim, amounted to a dedication of those works to the public domain. At the same time, I recognize the inadequacy of the present record for determining now whether speeches on which a copyright notice had been placed were effectively protected by that notice from other than "fair use," and whether Public Affairs intended to make only "fair use" of those works. I would, therefore, also affirm the remand to the District Court ordered by the Court of Appeals as to such speeches.

In the light of these views, I find it unnecessary to pass now on the questions raised in No. 36, and would dismiss that case as premature.

MR. JUSTICE HARLAN, dissenting.

The basic issue which brought these cases here was whether Admiral Rickover's speeches were copyrightable in the light of the following provision of the Copyright Act: "No copyright shall subsist in . . . any publication of the United States Government." (17 U. S. C. § 8). As I see it, decision of that issue turns not merely on whether such speeches were made by the Admiral in the "line of duty," but also, and in my view more fundamentally, on whether such speeches were in any event "publication[s] of the United States Government." In my opinion the record is sufficient to require adjudication on both aspects of that issue, and on this phase of the controversy I agree with the result reached by the Court of Appeals. I also agree with its determination as to the adequacy of the copyright notice affixed to speeches delivered after December 1, 1958.

However, I consider the record inadequate to justify adjudication as to whether Admiral Rickover's right to copyright was lost with respect to speeches delivered before December 1, 1958 by reason of their alleged entry into "the public domain." * As to that issue I would vacate the judgment of the Court of Appeals and remand the case to the District Court for further proceedings. In all other respects I would affirm the judgment below.

* The stipulation states that with respect to 20 of the 22 speeches made before December 1, 1958, "Admiral Rickover mailed *some* to individuals who had requested copies or who Admiral Rickover believed would be interested in the subject. *Some* were sent by Admiral Rickover . . . to the sponsor of the speech to be made available to the press *and to others* at the place where the speech was to be delivered." (Emphasis added.) It appears from the stipulation that no further distribution other than for press use was ever made. Whether the foregoing publications were general enough to amount to a dedication to the public of all or any of these speeches depends on more precise information than is afforded by the stipulation.

206. *Caddy-Imler Creations, Inc. v. Caddy*, 299 F. 2d 79, 132 U.S.P.Q. 384 (9th Cir., Feb. 2, 1962) (Barnes, J.).

Action for copyright infringement, trademark infringement and unfair competition. Defendant, a stockholder and officer of plaintiff, had transferred to the corporation "his entire right, title and interest" in a set of books and records entitled, "The 390 Basic Arithmetic Facts" and "the idea behind them." He later published competing books and records, using the same title, which plaintiff alleged to be copied from the material sold to it by defendant. From a judgment (S.D. Calif.) (Westover, J.) holding, inter alia, that defendant was "not guilty of patent infringement" by reason of copying plaintiff's copyrighted book and that plaintiff had no protectible rights in the phrase, "The 390 Basic Arithmetic Facts," plaintiff appealed.

Held, affirmed.

I. The court agreed with the finding below that copying had not been proved. The only suggested parallels exactly alike in the two works were: "Many combinations are reversible and may be stated two ways." and "Take out a sheet of paper." Although there were other sentences that were "somewhat similar," the similarities were found not to be sufficient to prove plagiarism. The court said:

"We agree that the test for infringement of a copyright is of necessity vague. *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F. 2d 48, 124 USPQ 154 (2d Cir. 1960). That this is true is more a reason we cannot say the trial court erred, as a matter of law, in finding no infringement. '... A copyright is not infringed by an expression of the idea which is substantially similar where such similarity is necessary because the idea or system being described is the same'. *Baker v. Selden*, 101 U.S. 99 (1879). Nor can we term or classify such sentences so reproduced as 'important and vital parts of the two compositions,' as were the two lines from the copyrighted lyrics in *Whitney v. Ross Jungnickel, Inc.*, 179 F. Supp. 754, 124 USPQ 219; nor can we conclude the alleged infringing matter 'gets so close to the copyrighted matter that it is practically the same.' *Cash Dividend Check Corp. v. Davis*, 9 Cir. 1957, 247 F. 2d 458, 114 USPQ 32."

II. The court held that the title "The 390 Basic Arithmetic Facts" was a common working phrase known to teachers for many years in which the plaintiff had acquired no secondary meaning, and that defendant's use of the phrase, therefore, was not actionable.

207. *Duff v. The Kansas City Star Co.*, 132 U.S.P.Q. 483 (8th Cir., Feb. 16, 1962) (Vogel, J.).

Appeal from dismissal of complaint in treble damage action under Section 4 of the Clayton Act. Plaintiff, who had owned and operated the "Community Herald", a weekly newspaper, in Kansas City, Missouri from 1935 to 1942 alleged that defendants prevented him from going back into the newspaper business in Kansas City when he attempted to do so in 1951. Plaintiff contended that he had copyrighted the name "Community Herald" in 1942, and that defendants' interference injured him in his "property of owning copyright" inasmuch as he could neither use the name nor sell it in a market "free of defendants' restraints."

Held, affirmed.

Holding that the plaintiff had no property of any kind in the name "Community Herald", the court said:

"The name 'Community Herald' in and of itself is not a valid, copyrightable name. It is no more than the common name of a once-published newspaper. The name of a newspaper at best, if it qualifies as being unique and original, can be trademarked. . . . (N)o trademark registration was ever made. Thus the only protection available to the appellant here with reference to the name 'Community Herald' would be that protection given to trade names; that is, protection against wrongful use of the name 'Community Herald' by another party. However, there is no such issue involved here; hence, the only question left to determine is whether under the circumstances of this case there is a property right in the name 'Community Herald.' . . . The question narrows itself as to whether there is an established business (goodwill) to which the name 'Community Herald' attaches. If none exists, then there is no property right in the name. See *Lawyers Title Ins. Co. v. Lawyers Title Ins. Corp.*, D.C. Cir., 1939, 109 F. 2d 35, 43, 43 U.S.P.Q. 166, 172, cert. denied 309 U.S. 684, 45 U.S.P.Q. 713. . . . After eight years of non-publication plaintiff possessed neither business nor property, including goodwill, which could have been damaged by appellee's monopoly."

208. *Southern Music Publishing Co. v. Seeco Records, Inc.*, 200 F. Supp. 704, 132 U.S.P.Q. 682 (S.D.N.Y., May 12, 1960) (Murphy, J.).

Action for royalties under the compulsory license provision of Section 1(e). Plaintiff moved for partial summary judgment on the issue of liability.

Held, motion granted.

I. Defendant contended that a long-standing custom in the record industry entitled it to make its periodic reports and royalty payments to the proprietors of the copyrights in music it was using on the basis of the number of records sold in each month, rather than the number manufactured. The court held, however, that the statutory requirement that the payments be based on number of records manufactured is binding on the defendant, despite any custom to the contrary. The court said:

"We will assume that defendant could prove on trial that for 50 years every copyright holder acquiesced in receiving royalties based on records sold and never insisted on royalties for records manufactured. Yet such assumption raises only an issue of law, and that is, despite such custom and usage may a copyright holder now insist upon his express statutory right to the royalty on records manufactured?

"Congress in 1909 amended the copyright law and in clear, unequivocal language, stated, *inter alia*: '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 . . . ' 17 U.S.C. §1(e)

Nowhere in the same subdivision does Congress use the word 'sale,' but throughout uses the word 'manufacture.' There is no ambiguity here, but rather, clear unmistakeable intent. (See *Shapiro, Bernstein & Co. v. Remington Records, Inc.*, 265 F. 2d 263, 269, 121 USPQ 109, 114. . . . (W)hile heretofore copyright holders have previously waived some of their rights, such custom and usage cannot change the meaning of the language or add a gloss thereto so as to dilute the rights conferred. Cf. *Cudahy Packing Co. v. Narzisenfeld*, 3 F. 2d 567, 572."

II. Defendant also argued that plaintiff should be denied relief because plaintiff was prosecuting the action "for the sole purpose of coercing and harassing defendant in connection with other actions that are pending, and that its purpose is to destroy defendant's name and good will."

"The short answer to this defense," the court said, "is that if plaintiff has a valid cause of action, what its purpose is in pursuing it is of no moment in this proceeding."

209. *Edwin H. Morris & Co. v. Burton*, 201 F. Supp. 36, 132 U.S.P.Q. 680 (E.D. La., Dec. 21, 1961) (West, J.).

Action for infringement of plaintiffs' copyrights in the songs "Tenderly," "This Can't Be Love," and "How High the Moon." Plaintiffs' allegations that defendant, a nightclub proprietor, gave public performances for profit of these songs at "Joe Burton's Lounge" in New Orleans without the consent of the copyright proprietors and "threatened to continue such infringing performances unless restrained by this court" were deemed admitted because of defendant's failure to respond to plaintiffs' "Request for Admissions." * Plaintiffs moved for summary judgment.

Held, motion granted, judgment for plaintiffs.

I. It was held that plaintiffs were clearly entitled to summary judgment. The court said:

"Summary judgments to copyright owners in actions based on copyright infringements, as in this case, should be granted, where, on the basis of the pleadings, Admissions and Affidavits, there is no genuine issue of fact to be tried, *Houghton Mifflin Co. v. Stackpole Sons, Inc.*, 113 F. 2d 627, 46 USPQ 296; *Home Art v. Glensder Textile Corp.*, 81 F. Supp. 551, 79 USPQ 12; *Associated Music Publishers, Inc. v. Debs Memorial Radio Fund*, 141 F. 2d 852, 61 USPQ 161, cert. den. 324 U.S. 766, 63 USPQ 358. Here, the essential allegations necessary to the establishment of the cause of action being deemed to have been admitted, the plaintiffs are entitled to the relief sought."

II. The plaintiffs were awarded \$250.00 statutory damages for each infringement. The court stated:

"(W)here the plaintiffs have proved infringement on the part of the defendant, but have not submitted proof of the actual damages, award of \$250.00 as minimum damages in each cause of action is mandatory. *Jewell-LaSalle Realty Co. v. Buck*, 283 U.S. 202, 9 USPQ 22; *L. A. Westermann Co. v. Dispatch Printing Co.*, 249 U.S. 100; *F. W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228, 95 USPQ 396; *Interstate Hotel Co. of Nebraska v. Remick Music Corp.*, 157 F. 2d 744, 71 USPQ 138, cert. den. 329 U.S. 854; *Widinski v. Shapiro, Bernstein & Co.*, 147 F. 2d 909, 64 USPQ 448."

III. Counsel fees were also awarded. Noting that "award of a counsel fee to the prevailing party in a copyright infringement action is

* Under Rule 36 of the Federal Rules of Civil Procedure.

expressly authorized by 17 USC 116” the court fixed this award at \$400.00, which it considered to be reasonable in view of the amount of legal work done.

210. *Wibtol v. Crow*, 199 F. Supp. 682, 132 U.S.P.Q. 392 (S.D. Iowa, Nov. 22, 1961) (Stephenson, C.J.).

Action for copyright infringement. Defendant Crow, a choral instructor in the Clarinda, Iowa public schools, made a new arrangement of plaintiffs' copyrighted hymn, "My God and I." About 48 copies of the new arrangement were made on a duplicating machine at the local high school and it was performed once at the school and on one Sunday by a church choir. In response to Crow's letter to plaintiffs inquiring whether they would be interested in the new arrangement, he was threatened with suit for heavy damages for copyright infringement and with criminal prosecution. Plaintiffs then brought this action against Crow, the high school and the church.

Held, judgment for defendants; attorney's fees of \$500.00 awarded to each defendant.

1. Plaintiffs contended that defendant had copied matter both from the original version of the hymn, copyrighted in 1935, and from a solo arrangement copyrighted in 1944, and that there was, therefore, infringement of two separate copyrights. The court held, however, that the infringement, if any, involved the 1935 copyright only.

2. The court said that:

"The crucial issue, however, is whether the sum total of defendant Crow's actions in experimenting with the copyrighted song, drawing a new arrangement, and testing the same with his school and church choir constituted such unfair use of plaintiff's copyrighted work as to amount to an infringement."

Holding that defendant's activities had been fair use, the court went on to say:

"Fair use may be defined as a privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwithstanding the monopoly granted to the owner of the copyright . . . , *Toksvia v. Bruce Publishing Company*, 181 F. 2d 664 (7 Cir. 1950); *Loews Incorporated v. Columbia Broadcasting System*, 131 F. Supp. 165, 173-185 (S.D. California 1955).

"What is or is not fair use depends upon the circumstances of each particular case."

Noting that among the elements entering into determination of fair use are the extent and relative value of copyrighted material, the effect upon distribution of the original work, and the nature and object of the selections made, *Mathews Conveyor Co. v. Palmer-Bee Co.*, 135 F. 2d 73 (6th Cir. 1943), the court said that while "intent to infringe is not essential to render the infringer liable . . . innocent intention may have a bearing on fair use. *New York Tribune, Inc. v. Otis & Co.*, 39 F. Supp. 67 (S.D.N.Y. 1941); *Karll v. Curtis Publishing Co.*, 39 F. Supp. 836 (E.D. Wis. 1941)."

The court found that whether or not Crow had hoped for financial gain (by selling his arrangement to plaintiffs), he had "attempted no use of the new arrangement other than testing and experimentation with the school and church choir." Under all the circumstances, the court found this to have been fair use.

3. In view of the holding that Crow's use of the hymn did not constitute an infringement, the court found it "unnecessary to pass" on two additional defenses offered in behalf of the high school and the church. With respect to these, however, the court said: a) that under the doctrine of governmental immunity, the Clarinda Iowa School District could not be held liable for the alleged infringement, *Kraft Food Co. v. Walter Dairy Products*, 118 F. Supp. 1 (W.D. Wis. 1954); *Towle v. Ross*, 32 F. Supp. 125 (D.C. Ore. 1940); and b) that singing a hymn in church on Sunday morning was not a "public performance for profit" within the meaning of the copyright act.

4. Agreeing with defendants' contention that plaintiffs should also be denied relief because their threats to defendant Crow "smack of extortion", and that they came into court with unclean hands, *Gaye v. Gillis*, 167 F. Supp. 416 (D.C. Mass. 1958); *Seismograph Service Corp. v. Offshore Raydist*, 263 F. 2d 5 (5th Cir. 1958), the court considered plaintiff's conduct in this regard in relation to an award of attorneys' fees. The court said:

"The threats of possible criminal prosecution made by the plaintiff Company to defendant, Nelson Crow . . . , under the circumstances are scarcely defensible. Plaintiffs are familiar with copyright law, and well knew criminal sanctions required a willful infringement for profit. The Court has already found that there was no infringement. However, plaintiffs' conduct in this regard is a factor to be considered in weighing defendants' request that attorney fees

be assessed against the plaintiffs. . . . Under all the circumstances it appears to the Court that each of the defendants should be awarded an attorney fee of \$500.00. *Cloth v. Hyman*, 2 Cir., 146 F. Supp. 185."

211. *S. C. Johnson & Son, Inc. v. Drop Dead Co.*, 201 F. Supp. 442, 132 U.S.P.Q. 309 (S.D. Cal., Dec. 26, 1961) (Hall, C.J.).

Action for copyright infringement, unfair competition and trade mark infringement. Plaintiff had registered for copyright a label for its product, "Pledge." It distributed advertising placards to grocers on which a can of "Pledge," bearing the copyrighted label but without copyright notice, was pictured. Defendant moved for summary judgment, or in the alternative, judgment on the pleadings on all three causes of action.

Held, motion denied.

I. Defendant contended that the cause of action for copyright infringement must fail because the distribution of the placards was a publication of the label without notice and a dedication to the public which invalidated the copyright. It was held, however, that these placards did not constitute publication of the label. The court said:

"The facts here do not, in my judgment, fall within the ambit of either Advertising Exchange, Inc. (D.C. Mo.—1942), 50 F. Supp. 137, 56 USPQ 143 (matrices) or *Metro Associated Services v. Webster City Graphic* (D.C. Ia.—1953), 117 F. Supp. 224, 100 USPQ 88 (mats and other newspaper material) or *Bell v. Catalda Fine Arts* (D.C. N.Y.—1947), 74 F. Supp. 973, 75 USPQ 66, modified and affirmed, 191 F. 2d 99, 90 USPQ 153 (mezzotints), in that in each of these cases, it was the copyrighted material which was the product and which, itself, was sold, whereas here, the product sold is not the label, i.e. the copyrighted thing, but the contents of the can upon which the label 'Pledge' appears.

"Rather, this case comes more nearly within the reasoning of *Rushton v. Vitale* (C.A. 2d—1955), 218 F. 2d 434, 104 USPQ 158, where the doll 'Zippy' was copyrighted but an illustration of it was published in a Trade Journal, which illustration did not carry the copyright notice in the Trade Journal. The Court held that such illustrations were publications only for the limited purpose of drawing the product to the trade's attention, and did not constitute a dedication.

"From the facts as they stand now, I cannot say, as a matter of law, that the admitted distribution of the placard is sufficient dedication to the public to void the copyright."

II. The court further held that it had jurisdiction of the claim for unfair competition, since the plaintiff had a substantial claim under the copyright laws to which the claim for unfair competition was related.

III. Defendant's argument that because its activities were wholly intrastate, a federal cause of action for trademark infringement would not lie was rejected by the court, which stated that "it is a misconception that actual sales by an infringer must be made in interstate commerce before the Lanham Act applies. It is not the actual sales made in interstate commerce but the effect of them which is the norm to be applied."

212. *Carter v. Hawaii Transportation Co.*, 201 F. Supp. 301, 133 U.S.P.Q. 65 (D. Hawaii, Dec. 29, 1961) (Tavares, J.).

Action for copyright infringement. Defendant had engaged a public relations firm (third-party defendant A. D. Starr, Inc.) to arrange for printing a brochure advertising sight-seeing services on the island of Hawaii which it conducted under its trade name, "Gray Line-Hilo," the brochure to include a map of the island. The printer, without the knowledge or consent of the others, substituted for the map which had been specified a map "copied practically in its entirety" from plaintiff's map.

Held, judgment for defendants.

I. The court held that if plaintiff had a valid copyright it would have been infringed, and the defendants would be equally liable with the printer. With respect to the latter point, the court said:

"The Court's initial sentiment is one of sympathy with Carter, notwithstanding the lack of knowledge and intent on the part of Starr and Gray Line. Were Carter's map copyrightable and covered at the material times by a valid copyright, the Court would not hesitate to award such damages, if any, as might be found to have resulted from the infringement, or a satisfactory minimum award, because infringement does not depend upon intent; it depends upon the fact of copying copyrighted matter. *Towle v. Ross* (1940), D.C., Or., 32 F. Supp. 125, 127. However, in this connection, the Court must observe that both Gray Line and Starr were negligent and did not exercise due and ordinary business care by checking the brochure after it was printed to determine whether the original specifications had been complied with. Had this been done, both Gray Line and Starr would have discovered that a map other than the one specified had been included in the brochure and could have prevented its dissemination. Hence, their original lack of knowledge

and intent, if it had any ameliorating effect, is largely offset by their failure to check the brochure after printing."

II. It was held, however, that the copyright was not valid for two reasons:

a) *Copyrightability*: Plaintiff's map consisted of an outline of the island of Hawaii and "words within and without the outline indicating places, areas, names of cities and names of hotels and describing the activities and points of interest at various places on the island." With respect to these features, in holding that there was not sufficient originality to sustain copyright, the court said:

"The outline of the island of Hawaii is in the public domain and is not copyrightable. *Christianson v. West Pub. Co.* (1945), 9th Cir., 149 F. 2d 202, 203; *Sawyer v. Crowell Pub. Co.* (1942), D.C., N.Y., 46 F. Supp. 471, 474; 17 U.S.C. § 8. The names of areas, of cities and of hotels also are in the public domain and therefore are not copyrightable.

Maps are entitled to only limited copyright protection. *Axelbank v. Rony* (1960), 9th Cir., 277 F. 2d 314, 318."

Quoting from *Marken & Bielfield, Inc. v. Baughman Co.*, 162 F. Supp. 561, 562-563 (D.C. Va. 1957), the court went on:

"'While it is not required that the compilation be the sole product of the maker, it is clear that something more than the compilation of information procured by others is required to make a map copyrightable. There must be originality resulting from the independent effort of the maker in acquiring a reasonably substantial portion of the information.'"

The court found that substantially all the material in plaintiff's map was in the public domain except for some variations in designations, and as to these, the originality was termed "so slight that it could not possibly be the basis of a valid copyright." *Andrews v. Guenther Publishing Co.*, 60 F. 2d 555 (D.C., N.Y., 1932).

b) *Notice*: It was held that if plaintiff's copyright had originally been valid, subsequent publication with defective notice would have constituted dedication and abandonment. Plaintiff had first published his map in 1956, apparently with a copyright notice in his own name. Later, plaintiff published a guide pamphlet, bearing on its cover a copyright notice in the name of "Wikiwiki Publishers," in which substantially the same map was included. Noting that strict compliance with statutory

requirements is essential to valid copyright, and that one such requirement is that the notice of copyright shall contain, as proprietor, the name of the holder of record, the court said:

"If the owner of a copyright publishes the copyrighted material with a defective notice of copyright, he abandons his copyright and dedicates the material to the public. *Wildman v. New York Times Co.* (1941), D.C., N.Y., 42 F. Supp. 412, 414; *Sieff v. Continental Auto Supply, Inc.* (1941), D.C., Minn., 39 F. Supp. 683, 686; *Smith v. Bartlett* (1937), D.C., Maine, 18 F. Supp. 35, 37. By so publishing the latter map, Carter abandoned his copyright and dedicated the map to the public. There is no evidence that a valid, registered assignment of the allegedly infringed copyright was made by Carter to Wikiviki Publishers prior to the latter publication; therefore, the notice does not contain the name of the proprietor of record and it would not 'sufficiently aid in tracing . . . title if need be.' "

2. STATE COURT DECISIONS

213. *Roulette Records, Inc. v. Princess Production Corp.*, 224 N.Y.S. 2d 204 (App. Div., 1st Dept., Feb. 8, 1962) (McNally, J.).

Action to recover damages and to enjoin production and sale of Sarah Vaughan recordings of "The Awakening" and "Fan My Brow." In 1959, Miss Vaughan entered into an exclusive recording contract with plaintiff which is still in effect. On April 19, 1960, she contracted with defendants Princess Production Corp. and Burt Balaban to perform the two songs for the movie, "Murder, Inc." These defendants then licensed the manufacture and distribution of phonograph records taken from the movie sound track. A cause of action against Miss Vaughan was discontinued when she alleged that her contract with defendants had not given them the right to make the phonograph records from the sound track. Princess and Balaban appeal from judgment by the trial court (Sup. Ct., N.Y. Co., Dec. 20, 1960) (Levy, J.) awarding an injunction and damages to the plaintiff.

Held, reversed and new trial ordered.

I. Plaintiff contended that at all relevant times defendants had full knowledge of plaintiff's exclusive rights under its contract with Miss Vaughan. The trial court found that the agreement by which appellants licensed the manufacture and distribution of the two phonograph records in question from their sound track was made by the appellants in viola-

tion of plaintiff's rights under the aforesaid exclusive recording contract, "knowledge of which they could or should have had."

The Appellate Division, however, held that there could be no recovery without proof of actual knowledge. The court said:

"There is no evidence that the appellants were informed prior to August 8, 1960 by either defendant Sarah Vaughan or the plaintiff of the contract between plaintiff and defendant Sarah Vaughan dated July 24, 1959. On August 8, 1960 plaintiff wrote to the appellants and informed them of the said contract. . . . The phonograph records which are the subject of this action were manufactured and distributed prior to August, 1960.

"In support of plaintiff's allegation of knowledge on the part of the appellants of the contract between plaintiff and defendant Sarah Vaughan dated July 24, 1959, plaintiff relies solely upon the publicity thereof reflected in various trade publications. Appellants deny knowledge of said contract on April 19, 1960 and prior to the receipt of the letter of August 8, 1960

"On this record the sole basis for recovery against the appellants is the intentional interference with the contractual rights of the plaintiff under the agreement of July 24, 1959, without justification and with knowledge of the contract on the part of the appellants. Plaintiff was required to establish actual knowledge of the underlying agreement on the part of the appellants in order to support a recovery for intentional interference therewith. (*Associated Flour Haulers & Warehousemen, Inc. v. Hoffman*, 282 N.Y. 173, 181; *Reiner v. North American Newspaper Alliance*, 259 N.Y. 250; *Hornstein v. Podwitz*, 254 N. Y. 443 . . .)

The trial court did not find and on this record the evidence is insufficient to sustain a finding of actual knowledge on the part of the appellants of the plaintiff's contract with defendant Sarah Vaughan dated July 24, 1959 prior to receipt of the plaintiff's letter dated August 8, 1960. Although proof of actual knowledge may be predicated upon circumstantial evidence, this record does not demonstrate it."

II. The award of damages by the lower court was held to have been made on an improper basis, in that there was testimony tending to show that the small number of records involved (6,394 after deduction of quantity distributed for promotional purposes) would not have returned production costs, much less earned a profit, and no allowance had been made for a payment of \$4,800.00 to the musician's union for the privilege of reproducing the musical background from the sound track.

Dissenting opinion:

Justice Steuer, with whom Justice Stevens concurred, disagreed with the majority both as to the requirement of actual knowledge and as to proof of damages. He said:

"The trial court found that before making the record defendants knew, or ought to have known, of the contract between Miss Vaughan and plaintiff. It is claimed that nothing short of actual knowledge will suffice. This is not a precise statement of the law. Let us assume the accuracy of the text writers that there is no liability for negligent interference with contract (Harper and Jones, *The Law of Torts*, vol. 1, 509; Prosser, *Handbook of the Law of Torts*, 2d ed. p. 732, et seq.). There is quite a distinction between a negligent failure to know and a deliberate intent to stay in ignorance of what one suspects. It is granted that plaintiff did not prove that defendants actually knew of plaintiff's contract. But it was proved that news of the contract was published in two trade papers, attesting to the general interest of such an occurrence in the milieu in which these people operated. It was also established through the testimony of defendant's own expert that the practice was to inquire of the performer, before using him to make a record, whether the performer had existing contractual commitments. While it was not proved that defendants did so, it was certainly a reasonable conclusion for the trier of the fact to draw that the failure of the defendants to inquire was due to a desire not to be told. If this is not the equivalent of knowledge, it would seem to be an extremely technical exception in the law, as well as one without any basis in policy.

". . . That the plaintiff suffered monetary damage is clear, though it may not be possible to establish the extent with certainty. The award of the court was based on two items: the royalties received by the appellant and the profit made by the manufacturer of the record. These would appear to be unexceptionable items. Perhaps the only way—and certainly the accepted way—of establishing a monetary loss resulting from infringing on proprietary rights is to show what the wrongdoer profited from the venture. Actually defendants do not seriously dispute this. They do claim that only a part of the record was the recorded voice of the singer, the balance being instrumental music. But they cannot and do not dispute that the record was marketed as a song rendition by Sarah Vaughan. Also they claim that the royalties they received were not in fact royalties in that they had to pay some of them to other parties.

What they did with the royalties does not change the character of the receipts. . . . Damages were amply proved according to accepted standards."

214. *Brandon v. Arjay Enterprises, Inc.*, 133 U.S.P.Q. 165 (Sup. Ct., N.Y. Co.) (Lupiano, J.). *For decision on preliminary injunction see* 144 N.Y.L.J., Dec. 6, 1960, p. 15, col. 3, 8 BULL. CR. SOC. 268, Item 222 (1961).

Action for infringement of common law copyright in which injunction is sought against the exhibition of two German films, "Streets of Sorrow" and "Nosferatu," the rights to which had allegedly been vested in the Office of Alien Property in 1951 and later licensed to plaintiffs by the Attorney General. These films had been publicly exhibited for many years without copyright notice of any kind. Both parties moved for summary judgment.

Held, plaintiffs' motion granted; defendant's motion denied.

I. Defendant contended that plaintiffs' common law copyright (no statutory copyright was claimed) had been lost by publication without notice, stating that the issue was "whether the motion pictures, after more than 35 years of commercial public exhibition, can conceivably be deemed unpublished works . . ." the problem being "complicated by the fact that theatrical motion pictures are not usually sold or placed on sale but are distributed on a contractual basis." It was held, however, that no publication had occurred. The court said:

"The only case discovered on the subject, as defendant asserts, is *Blanc v. Lantz* (83 U.S.P.Q. 137 [California Supreme Court, 1949]), where the court held: ' * * * distribution and exhibition of these films in commercial theatres throughout the world constitutes so general a publication * * * as to result in the loss of the common law copyright.' That case involved . . . 'a peculiar California statute defining publication which has since been repealed.'

"Contrastingly, in the *De Mille Co. v. Casey* (121 Misc. 78), the court stated: 'Performance of an ordinary play has never been held to be a publication. The mere performance of a photoplay can have no different result; nor can the leasing of the latter or the furnishing of the film constitute a dedication under the circumstances here shown . . . I do not see that there ever was a publication or dedication to plaintiff where the public as a whole can claim a right to these plays. The plaintiff's control over them, and the use which it authorized others to make of them, caused no

cessation of its original rights. There was, in law, no circulation, exhibition, or distribution of the subject of copyright that, under the authorities, would constitute an abandonment.'

"The same rationalization and conclusion are appropriate to the case at bar."

II. The court refused to decide the validity of the original seizure of the films by the Alien Property Custodian, stating:

"(T)he correctness of the determination of the Alien Property Custodian of enemy ownership under the Trading With Enemy Act, 50 U.S.C.A. App., sections 5(b) and 7(c) and the validity of claims of any non-enemy against the vested property cannot be litigated and adjudicated here (*Commercial Trust Co. of New Jersey v. Miller*, 262 U.S. 51; *Central Union Trust Co. of New York v. Garvan*, 254 U.S. 554, 568)."

Also of interest:

215. *Miller v. Commissioner* (2d Cir., Feb. 6, 1962) (Kaufman, J.) (not yet reported).

The proceeds of the sale by the widow of the late Glenn Miller of the right to make the motion picture, "The Glenn Miller Story" were held to be ordinary income and not capital gains.

216. *Wheeler v. Dell Publishing Co. and Columbia Pictures Corp.* (7th Cir., March 12, 1962) (Kiley, J.) (not yet reported).

Appeal from judgment for defendants in libel action.

Held, affirmed.

The plaintiffs alleged that they had been libelled by the portrayal of two characters in the book and film "Anatomy of a Murder." The court held that these characters were fictional (although the book was based on an actual case) and were not identifiable with plaintiffs.

217. *McGraw-Hill Book Co. v. Random House, Inc.*, 225 N.Y. Supp. 2d 646, 132 U.S.P.Q. 530 (N.Y. Sup. Ct., N.Y. Co., Feb. 8, 1962) (Gellinof, J.).

Action for unfair competition.

Held, judgment for defendant.

Plaintiff's book title "PT 109: John F. Kennedy in World War II" was held to be "an expression residing in the public domain" to which plaintiff had no exclusive rights. Defendant's use of a somewhat similar title for a book on the same subject was not unfair competition.

Citations:

218. *Famous Music Corporation et al. v. Seeco Records, Inc.* (9 BULL. CR. SOC. 163, Item 73), now reported, 201 F. Supp. 560, 132 U.S.P.Q. 342 (S.D. N.Y., Nov. 22, 1961).
 219. *Prestige Floral v. California Artificial Flower Co.*, 132 U.S.P.Q. 350 (9 BULL. CR. SOC. 254, Item 153), now also reported, 201 F. Supp. 287 (S.D. N.Y., Jan. 5, 1962).
 220. *Labr v. Adell Chemical Co.*, 195 F. Supp. 702 (9 BULL. CR. SOC. 91, Item 24), now also reported, 132 U.S.P.Q. 662 (D. Mass. 1961).
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PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

221. ALTMAN, GEORGE T. The "Eisenhower amendment"; despoilment of the non-professional author under the income tax. Illus. by Dennis Renault. New York, Tilden Press, 1961. 40 p.

A critical analysis of the background of the special tax ruling which resulted in taxation, at the capital-gain rate, of the sum received by Mr. Eisenhower for all rights in his book, *Crusade in Europe*. The author concludes with a strong plea for repeal of the so-called "Eisenhower amendment," which closed the door to similar benefits for other amateur authors.

222. Copyright Law Symposium, No. 11. New York, Columbia University Press, 1962. (Nathan Burkan Memorial Competition, sponsored by the American Society of Composers, Authors and Publishers, 1959-60) 208 p.

The prize essays are analyzed separately *infra*. See also *News Briefs*, Item 240, *infra*.

2. Foreign Publications

223. ANDRE HUGUET. L'Ordre Public et les Contrats d'Exploitation du Droit d'Auteur, Paris, 1962, 231 p.

Mr. Huguet, a graduate of the Law School at the University of Poitiers (France) in his doctor's thesis produced a well-documented analysis of the French copyright law of March 11, 1957, in the light of the public interest. The work is divided into two parts, the first dealing with the moral right of the author, and the second dealing with the rules of law governing the author's interests under an assignment contract, both in the light of the public interest.

The first part presents few, if any, new ideas. It is largely limited to a recapitulation of old, sometimes rather worn, material. The second part analyzes the provisions of the law of 1957 concerning the rights of authors and users in the various types of contracts which may be concluded in regard to the use of intellectual works.

A discussion of the public interest in copyrighted works is welcome departure from the usual approach of French writers on copyright law, most of whom consider only the interest of the author. At least, Mr. Huguet admits that the public has an interest in intellectual works and explores the connection between copyright and the law of contracts, of wills, and of damages.

224. SCHULZE, ERICH. Kommentar zum Gesetz betreffend das Urheberrecht an Werken der Literatur und der Tonkunst, und zum Gesetz betreffend das Urheberrecht an Werken der bildenden Künste und der Photographie, mit internationalem Recht. Lfg. 1. Frankfurt am Main, A. Metzner [c1961] 1 v. (loose leaf)

An article-by-article commentary, in loose-leaf form, on the West German copyright laws, with a section on international copyright. The appendix includes texts of related German laws and of international agreements, and documents relating thereto, in German. A section is reserved for insertion of materials on the forthcoming revised copyright laws.

B. LAW REVIEW ARTICLES

1. United States

225. CLAPP, VERNER W. Library photocopying and copyright: recent developments. *Law Library Journal*, vol. 55, no. 1 (Feb. 1962), pp. 10-15.

After developing the thesis that "all use of books involves taking some kind of copy," the president of the Council on Library Resources outlines the efforts to develop a working definition of fair use for purposes of library photocopying beginning with the "Gentlemen's Agreement" of 1935.

226. COLSEY, WILLIAM B, III. The protection of advertising and the law of copyright. *Copyright Law Symposium*, no. 11 (1962), pp. 28-59.

This paper, which was awarded the National First Prize in the 1960 Competition, was first published in 5 Vill. L. Rev. 615 (1960) under the title: Copyrights—the protection of advertising. See 8 BULL. CR. SOC. 137, Item 96 (1960).

227. CROWLEY, RICHARD P. The Register of Copyrights as an art critic. *Copyright Law Symposium*, no. 11 (1962), pp. 155-169.

This paper, which was awarded National Honorable Mention in the 1960 Competition, purposes "to probe the actions of the Register

of Copyrights in regard to artistic merits of works of art. More particularly, the purpose is to examine the subsequent events and the subsequent actions of the Register of Copyrights, since the *Mazer v. Stein* decision, in regard to three-dimensional works of art having utilitarian characteristics."

228. DWORKIN, ALAN T. Originality in the law of copyright. *Copyright Law Symposium*, no. 11 (1962), pp. 60-81.

This paper, which was awarded Honorable Mention in the 1959 Competition, was first published in 39 B.U.L. Rev. 526 (1959). See 7 BULL. CR. SOC. 192, Item 258 (1960).

229. GARLAND, WILLIAM H. Our copyright law: growing pains in international society. *Copyright Law Symposium*, no. 11 (1962), pp. 82-95.

This paper, which was awarded Honorable Mention in the 1959 Competition, "analyzes some of the considerations shaping our copyright relations with other countries, and endorses the principle, embodied in the Universal Copyright Convention, of a unified approach to international copyright protection."

230. GOLDMAN, ABE A. Tentative recommendations of the Copyright Office on the revision of the Copyright Law: problems of interest to libraries. *Law Library Journal*, vol. 55, no. 1 (Feb. 1962), pp. 3-9.

An address, delivered at the annual meeting in Boston, June 1961, of the American Association of Law Libraries, on the subject of the tentative recommendations of interest to libraries, to be included in the then forthcoming report of the Register of Copyrights on general revision.

231. GUNNELS, DONALD L. Copyright protection for writers employed by the Federal Government. *Copyright Law Symposium*, no. 11 (1962), pp. 138-154.

This paper, winner of the National Third Prize in the 1960 Competition, was first published in 1960 Wash. U. L. Q. 182. See 7 BULL. CR. SOC. 303, Item 432 (1960).

232. HARRINGTON, JOHN E. Copyright duration. *Copyright Law Symposium*, no. 11 (1962), pp. 96-112.

This paper, which was awarded Honorable Mention in the 1959 Competition, "is a study of term of copyright and our present two-term system, in which the author concludes that a single term would be preferable for all concerned."

233. HAUSER, RITA E. The French droit de suite: the problem of protection for the underprivileged artist under the copyright law. *Copyright Law Symposium*, no. 11 (1962), pp. 1-27.

This paper, which won the National Award in the 1959 Competition, was first published in 6 BULL. CR. SOC. 94, Item 111 (1959).

234. KLEIN, HERBERT DAVID. Is unauthorized use of titles of artistic works in unrelated fields actionable piracy? *Brooklyn Law Review*, vol. 28, no. 1 (Dec. 1961), pp. 59-98.

The author answers the question forming the title of his contribution with a "qualified 'No' ", and concludes that the goal of adequate protection for titles "can only be obtained . . . by the passage of the Lindsay Bill, a revision of the Copyright Statute, or the creation of a new Act transforming titles into a protectible property right."

235. Rights of Federal Government personnel under the Copyright Act. *Indiana Law Journal*, vol. 37, no. 1 (Fall 1961), pp. 105-124.

A note on legal problems involved in the determination of what rights, if any, a Federal Government employee has in his literary products, with suggestions for possible solutions.

236. RITTENHOUSE, JOHN, JR. Section 24—renewal rights, survivors, and confusion: a case study. *Copyright Law Symposium*, no. 11 (1962), pp. 113-137.

This paper, which was awarded National Second Prize in the 1960 Competition, was first published in 37 Dicta 368 (1960). See 8 BULL. CR. SOC. 272, Item 238 (1961).

237. SCHRAMM, FREDERIC B. Bases for protection of intellectual property other than patents, trademarks and copyrights. *Journal of the Patent Office Society*, vol. 44, no. 2 (Feb. 1962), pp. 75-90.

A discussion of types of rights or bases for protection with respect to trade secrets, ideas disclosed under agreement to compensate or confidential relationship, and protection against unfair competition.

238. SEIDEL, ARTHUR H. Antitrust, patent and copyright law implications of computer technology. *Journal of the Patent Office Society*, vol. 44, no. 2 (Feb. 1962), pp. 116-125.

Includes a brief discussion of the question whether computer programs are copyrightable subject matter, with "a few words about the broadening of the services which may be rendered by the Register of Copyrights in the future by virtue of the advent of computer technology."

NEWS BRIEFS

239. NEW ADHERENCES TO THE UNIVERSAL COPYRIGHT CONVENTION.

Paraguay. UNESCO has advised the United States Department of State that Paraguay deposited its instrument of accession to the Universal Copyright Convention and to Protocols 1, 2, and 3 thereof, with the Director General. Under Article IX, paragraph 2, of the Convention, the latter will come into force in respect of Paraguay three months after the deposit of its instrument of ratification, i.e., on March 11, 1962. Paraguay is the 40th country to adhere to the Convention.

Canada. The Copyright Office has received a dispatch from the State Department to the effect that following earlier approval by the Senate, the Canadian House of Commons approved on Monday night, April 16, 1962, ratification by Canada of the Universal Copyright Convention, signed by Canada at Geneva in 1952, and Protocol 3 of the Convention.

The next step will be the deposit of the instrument of ratification; the Convention will come into force in respect of Canada three months after the deposit of this instrument with the Director General of UNESCO.

240. \$1750 ASCAP COPYRIGHT AWARDS FOR 1961.

Judge Sterry R. Waterman of the United States Court of Appeals for the Second Circuit, and Mr. Justice Walter V. Schaefer of the Supreme Court of Illinois, announced that Roger M. Milgrim, 33 Washington Square West, New York City, is the winner of the \$1000 National First Prize in the Nathan Burkan Memorial Competition for the best paper on copyright law submitted by law students throughout the United States. The paper also won First Prize at New York University Law School. It is printed herein, pages 271-294.

The Competition, sponsored annually by the American Society of Composers, Authors and Publishers (ASCAP) in tribute to the memory of the Society's first general counsel, is designed to promote better understanding of the development of copyright law.

The national winners were chosen from among 50 papers first selected by law school deans across the country as the best essays on copyright submitted by students in their own schools.

Mr. Milgrim's prize-winning paper is entitled "Territoriality of Copyright: An Analysis of Assignability Under the Universal Copyright Convention." A graduate of the University of Pennsylvania and New York University School of Law, Mr. Milgrim was Associate Editor of

the New York University Law Review. He is currently engaged in graduate study at New York University's Institute of Comparative Law under a two-year Ford Foundation Scholarship in Civil Law.

Mr. Justice Schaefer and Judge Waterman announced the award of the Second Prize of \$500 to Donald L. A. Kerson, 2400 Haste, Berkeley, California, a graduate of the University of California School of Law now serving as Research Clerk to Justice Raymond E. Peters of the California Supreme Court. The subject of Mr. Kerson's paper is "Sequel Rights in the Law of Literary Property."

The winner of the \$250 Third Prize is Don Metz, 230 West Locust Street, Shelbyville, Indiana. Mr. Metz is a third-year student at the Indiana University School of Law in Bloomington, Indiana. His paper is entitled "Rights of Federal Government Personnel Under the Copyright Act."

Honorable Mention was awarded to Anthony M. Thurber, 1136 East Second South, Salt Lake City, Utah, a graduate of the University of Utah College of Law. Mr. Thurber's paper is entitled "Fair Use: How Much?"

Herman Finkelstein, ASCAP General Attorney, announced that the four papers selected by the Judges will be published by Columbia University Press in Volume No. 12 of the ASCAP Copyright Law Symposium series.

241. AMERICAN BAR ASSOCIATION ANNUAL MEETING.

The Annual Meeting of the American Bar Association and its Patent, Trademark and Copyright Section will be held at the Sheraton-Palace Hotel in San Francisco from August 3 to August 9, 1962.

On the morning of August 3, at 7:45 a.m., The Copyright Society of the U.S.A. will hold a breakfast, preceding the Symposium on Copyright, which will begin at 9:30 a.m. Details of the planned meetings will be published in our June issue.

Copyright Society of the U.S.A.

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PART I.

ARTICLES

242. RESCINDING THE SUPREME COURT'S RULES FOR COPYRIGHT PROCEDURE UNDER SEC. 101, TITLE 17.*

Editor's Note: We are privileged to reproduce Mr. Edward A. Sargoy's reply to the Chairman of the Copyright Committee of the American Patent Law Association, Mr. John Schulman, in answer to his letter concerning rescinding the Supreme Court's Rules for Copyright Procedure. Mr. Sargoy is a Vice President of The Copyright Society of the U.S.A., former Chairman of the Copyright Division of the Patent, Trademark and Copyright Section of the American Bar Association, and a former Chairman of the Committee on Copyright of the Bar Association of the City of New York.

In our judgment, this is an unusually interesting letter commenting on certain proposals to rescind the Supreme Court Copyright Rules on the ground that they may have been replaced or covered by the existing Federal Civil Procedure Rules 64 and 65 (a-d) and by Title 17, Sec. 101 (a, c) and Sec. 112. The letter suggests that the long established, detailed and effective procedure concerning seizure and impounding of motion pictures, which, although little known even by copyright practitioners, was promulgated by the U.S. Supreme Court in 1909 and continued in 1939 when the Civil Procedure Rules became effective, should be retained.

April 30, 1962

John Schulman, Esq.
Chairman, Committee on Copyright
American Patent Law Association
New York 4, N. Y.

Re: Rescinding the Supreme Court's Rules for Copyright Procedure under Sec. 101, Title 17

Dear John:

I have your memorandum of April 25th to the members of our Committee on Copyright, advising that the proposal to rescind the "Supreme Court Copyright Rules" originated with the Advisory Committee of the Judicial Conference of the United States, concerned with the Civil Rules of Practice; that the Committee had suggested in respect thereof that the subject matter of these provisions may specifically be covered by Federal Rules 64, 65(a)-(d), and by Title 17 U.S. Code, section 101(a), (c), and Section 112.

I understand from you that the next meeting of the Civil Rules Advisory Committee is scheduled for May 28th.

I further understand from your memorandum of April 20th to our Committee that W. Brown Morton, Jr., of the Advisory Committee on Civil Rules, reported to you that: "It is my understanding that this proposal in its entirety meets with the approval of the Copyright Office."

* See Appendix.

In the light of an experience of over thirty years with the practical application and use of these Rules, I am quite disturbed by the proposal to drop the same. I have a feeling that the proposal to rescind these well thought out, detailed and complete Rules is a well meant academic suggestion, prompted perhaps by a desire for symmetry and terseness in the Federal Rules, by persons who have had no special experience with seizure and impounding provisions under the copyright statute. It further disturbs me in that the proposal would have a very plausible appeal to those who have had no actual experience, including many copyright practitioners, with the problems and practice of utilizing the vital seizure and impounding provisions of the copyright statute. I might well have been included in such group, but for the fact that over the years, I have time and again had occasion to observe these Rules most effectively utilized in practice.

I think it would be useful, therefore, to relate some of my own observations and experience, which has been primarily in the field of the infringement of motion picture copyrights. As you know, for upward of the past thirty years, my law firm has acted as special counsel nationally for virtually all of the major motion picture companies, in such distribution matters, among others, as concern infringing uses of their copyrighted films. I am sure that other attorneys who have had infringement problems in other fields of copyright must also have had occasion to observe the great effectiveness of the present Rules. Before indicating these experiences, I should like to indicate the situation as it now exists, and the effect of the proposal.

I. *The Copyright Statute Authorizes but does not Detail Seizure and Impounding.*

The Copyright statute itself provides no procedure whatever for administering seizure, impounding and destruction of articles alleged to infringe a copyright, including all the infringing copies or devices, as well as all plates, molds, matrices, or other means for making such infringing copies.

Subdivisions (c) and (d) of Section 101 of Title 17 U.S.C. merely provide the authorization under the statute for seizure, impounding and destruction, as follows:

"(c) *Impounding during action.*—To deliver up on oath, to be impounded during the pendency of the action, upon such terms and conditions as the court may prescribe, all articles alleged to infringe a copyright;

"(d) *Destruction of infringing copies and plates.*—To deliver up on oath for destruction all the infringing copies or devices, as well as all plates, molds, matrices, or other means for making such infringing copies as the court may order."

Subsection (a) of 101 creates the liability of an infringer "To an injunction restraining such infringement," and Section 112 of Title 17 provides for the granting, service, and enforcement of injunctions, according to the course and principles of courts of equity.

II. *Civil Procedure Rules 64 and 65 for Seizure and Injunctions.*

Quite obviously, Rule 65 of the Federal Rules of Civil Procedure is applicable to supply the detailed procedure necessary for the injunctive relief authorized by the copyright statute. Shortly after the Federal Rules of Civil Procedure were promulgated, the Supreme Court of the United States amended Rule 1 of its 1909 Rules for Copyright Procedure under Section 101 of Title 17 U.S.C. (then Section 25), so as to make the federal Rules of Civil Procedure applicable as well as to civil actions brought under Sec. 101, including proceedings relating to the perfecting of appeals, insofar as such Rules of Civil Procedure were not inconsistent with the Supreme Court's Rules of Copyright Procedure. This amendment became effective September 1, 1939.

There is no problem as to injunctive relief, since the Copyright Rules of Procedure are not concerned at all with injunctive relief. Civil Procedure Rule 65 serves to lay down the necessary procedure for injunctions.

A well thought out detailed procedure is a necessity for handling the vital statutory remedy for the seizure and impounding of infringing copies and devices. It is a procedure where it is important to have national uniformity, since the incorporeal statutory copyright knows no state boundaries. The acts of an infringer will usually carry across state borders. In the motion picture field, for example, the possessor of a pirated film print, that is, one illegally duped (duplicated) from an unauthorized negative or an authorized positive, as well as the possessor of a lost or stolen authentic copyrighted print made authorizedly from the original negative, holds an article which may not only be an infringing copy (if duped), but is at the same time capable of projecting infringing exhibitions as well as a device equivalent to a plate, mold, or matrix from which infringing copies in the form of duped prints or negatives can be made.

III. *The Supreme Court's Rules of Copyright Procedure.*

That a detailed procedure for the seizure and impounding authorized by the copyright statute is necessary, is revealed at once by examining the remarkably well thought out rules promulgated by the Supreme Court of the United States in 1909 upon the enactment of the present statute, and re-affirmed and continued in 1939 after the Rules for Civil Procedure were adopted. These Rules for seizure and impounding need only to be examined to support what I state. I have taken the liberty of attaching a copy of such Rules of

Copyright Procedure as they presently appear at the end of the annotation to Section 101 of Title 17, U.S.C.A.

Rule 1, amended as above indicated in 1939, made applicable the Rules of Civil Procedure, in so far as they were not inconsistent with the Rules of Copyright Procedure. Rule 2 provided for attaching to the petition, a copy of the alleged infringement of copyright, if actually made, as well as a copy of the work alleged to be infringed, or that its absence be explained, with certain exceptions where not feasible.

The remaining Rules 3 through 13 are concerned only with the seizure and impounding authorized by Sec. 101(c) and (d) of Title 17. They specify when, where, and by whom the application may be filed; the supporting affidavit concerning the number and location of the alleged infringing copies or devices, and the value of the same. They provide for the nature of the bond to be executed, its amount, its sureties, and approval by a court or commissioner; the detailed provisions for conditioning the bond as to prompt prosecution, the return of the articles if adjudged not to be infringement, or the action abates, or is discontinued; and for the payment to defendant of any damages awarded against the complainant. They give directions to the Clerk for the issuance of the writ to the Marshal of the district in which the infringing copies or devices are located, as well as generally to any Marshal of the United States, to seize and hold the same subject to the order of the Court issuing the writ, or of the Court or District in which the seizure is made. The Rules then provide as to how the Marshal shall make the seizure; the papers to be served by him, the persons upon whom service is to be made and their alternates; how return of the seizure is to be made to the Court; how the articles are to be tagged after seizure, as well as how to be stored. The Rules still further outline how the defendant may serve notice to except to the penalties of the bond or to the sureties, and what the Court may do with respect to ordering a new bond or the return of the property to the defendant; the procedure for the plaintiff justifying the sureties before the court. There are provisions as to how the defendant may make application to the Court for return of the articles seized, and the kind of affidavit to be filed in such regard; and the duties of the Marshal with respect to delivering the seized articles to the defendant.

Rule 64 of the Rules of Civil Procedure, which is concerned with "Seizure of Person or Property," does not in any adequate sense cover these seizure and impounding situations, particularly when we see what the Supreme Court has heretofore thought to be necessary seizure and impounding Rules. It simply provides that the Court apply the law of the State in which the district court is held, existing at the time the remedy is sought, subject to the qualification that any existing statute of the United States governs to the

extent to which it is applicable. The federal copyright statute is clearly applicable, with its provisions of Section 101(c) and (d) authorizing seizure and impounding of infringing copies or devices, but it provides no procedural details whatever. Obviously, no State statute has procedure provisions for seizing and impounding of infringing copies, or devices capable of making infringing copies, of an incorporeal federal statutory copyright. Statutory copyright is outside the domain of State law. Furthermore, in the case of most infringements of statutory copyright, where infringing copies or devices are concerned, the physical material on which the incorporeal copyright is embodied, or the device capable of producing infringing copies is ordinarily the physical property of the infringer and not of the owner of the incorporeal copyright. State law contemplates no such situation in its procedure. Of even more importance is the point above made that infringers operate nationally and across State lines. A unitary federal remedy is necessary, rather than the analogous application of fifty separate systems of procedure available in as many States, under laws which never contemplated any statutory copyright situations. I refer you to the philosophy of my panel paper at the 1960 Copyright Symposium of the A.B.A. in Washington, D. C., on "An Exclusive Federal Statutory System for Literary and Artistic Works: The Confusions in the Diversity of Our Present Federal and State Systems." It is published in 8 Bull. Cr. Soc. 6-20 (1960), and I believe you are in accord with the approach taken.

IV. *The Long and Favorable Experience of the Motion Picture Industry with the Copyright Rules.*

My personal experience over many years has given me a keen appreciation of how effectively these thoughtfully worked out Supreme Court Rules of Copyright Procedure have functioned in practice, particularly in the case of the illicit distribution of copyrighted motion picture films for infringing purposes. Indeed, the Rules for seizure and impounding, particularly by way of *ex parte* application to the Court so that the Marshal might serve the various seizure papers simultaneously with the summons and complaint, have from time to time in effect been the only practical remedy.

The motion picture industry has unfortunately been plagued in certain periods by thousands of the copyrighted prints of its motion pictures getting into unauthorized hands. A particularly difficult time were the years during and after World War II until the early 1950s. The motion picture industry, as its donation to the Armed Services, made available some 42,000 prints of feature pictures in 16mm. size, and almost as many copyrighted short subjects, immediately after the pictures were completed (in many instances a year or more before the pictures were released to theatres in the United

States). The purpose was to entertain the members of the Army, Navy and Air Force, gratis, outside the continental United States. Title to the prints remained in the copyright owners, but the Armed Services were to account for the same either by affidavit of destruction, or by return of the prints to the owners. Because of the exigencies of the war, thousands of these prints were unable to be accounted for at all. Brought back in the knapsacks of returning soldiers, they began to turn up in various parts of the United States for unauthorized infringing exhibitions in competition with the licensees of the copyright owners. The Government, through the F.B.I., succeeded in recovering prints of over 800 different motion picture feature subjects, for return to the copyright owners, over a period of years, but many could not be accounted for.

Recent investigations have again uncovered as serious a situation. These indicate that literally prints of thousands of different copyrighted motion pictures, some in 35mm. size, but mostly in 16mm., are in the hands of unauthorized distributors who have no right to possess the films, much less to vend and rent the same for exhibition. Some of these prints are illegally "duplicated," but most are lost or stolen authentic positive prints owned by the copyright owners. Unlike copyrighted books or sheet music, the motion picture copyright owners which I represent, those primarily producing entertainment films, never make their prints available for sale to the general public. Title to the physical prints remains with them at all times. The prints are only distributed on a bailment basis to authorized distribution or exhibition licensees for the limited period of the license, to enable the necessary projection of the licensed exhibitions, and are required to be returned to the owner at termination of the license.

The Army, Navy, Red Cross, Veterans Administration, may each take from 20 to 50 prints of a copyrighted film, in 16mm. size, on a license basis, from the copyright owner or the authorized national or world distributor, for use throughout the United States and perhaps the world. The prints must be accounted for, by way of affidavit of destruction or loss, or returned upon conclusion of the license. Certain authorized 16mm. distributors may also be given a substantial batch of prints of each feature and short subject for non-theatrical distribution and exhibition, which prints are to be accounted for and returned at the conclusion of the license period. Unfortunately, there have been many missing and stolen prints reported by these governmental institutions and 16mm. dealers. Substantial thefts took place, for example, several years ago from the Brooklyn Navy Yard, which acts as the distribution center for the Navy throughout the world. The defendants were convicted in a trial held some two years ago, at the conclusion of which about 40 features were surrendered by certain of the defendants of the hundreds which were reported to have been stolen. Only a few weeks ago an

indictment for mail fraud was handed down against a 16mm. dealer in a middle western city, the indictment alleging that the defendant had used some 32 aliases in renting prints from authorized 16mm. dealers in various parts of the United States for alleged church, school or other non-theatrical showings. At the time of the arrest 55 feature pictures were seized in defendant's home by the arresting authorities, with an additional 20 features since returned by the defendant's customers. The defendant concocted fictitious names of various churches, each with a spurious address which was his own home address, for the purpose of renting prints from dealers in Maine, Connecticut, New York, Ohio, and elsewhere, for one day showings at the fictitious churches.

The foregoing are just a few illustrations of how prints of copyrighted motion pictures, which by the very nature of the business must be in circulation throughout the country, get into illicit hands. When it is realized that millions may have been invested in the negative, the disturbing nature of the problem is apparent, at least to the motion picture industry.

Unfortunately, the typical film bootlegger, when discovered after difficult and expensive investigation, is usually irresponsible financially, and unable to respond in any way for damages. They conduct the business surreptitiously, and without available records when examined in any litigation. The same print may be sent one week to Maine, the next week to Florida, and the third week to Oklahoma, for a one-day booking, via the mails or by railway express. No one knows where they are going to be exhibited, since non-theatrical showings of 16mm. pictures by schools, churches, social organizations, camps, etc., are not generally advertised. The prints are easily disposed of or hidden. United States Attorneys are extremely reluctant to prosecute under Section 104 of Title 17, which makes willful infringement for profit a misdemeanor. This is quite understandable, when it is appreciated that they do not want to undertake the expense of a difficult investigation and trial, the bringing in of necessary witnesses from remote parts of the country, the considerable effort and tribulation of learning new law and preparing a prosecution in this highly specialized field of statutory copyright, for what is presently merely a misdemeanor. The apparent tendency is to consider this misdemeanor no more serious than expectorating on the sidewalk, or smoking in a prohibited area.

Replevin and conversion remedies in the State courts are virtually useless. In the first place, the plaintiff does not know whether the infringing prints are his own lost or stolen physical property, or whether the same are "dupes" or materials belonging to the infringer. If the latter, replevin or conversion would be inapplicable. Damages for conversion, if the prints belonged to plaintiff, furthermore, would be nominal, predicated as they are on the physical value of the chemicals and acetate comprising a used print (and

not on the incorporeal value of the copyright in which millions of dollars may have been invested in the negative alone). Furthermore, the defendant is likely to be unable to respond to any damages awarded.

There is, of course, the possibility of injunctive relief under the copyright statute. Unfortunately, such relief can be granted only as to the specifically identified copyrights as to which proof can be adduced that the defendant had already infringed the same, or that the defendant threatens to infringe and has the means of so doing. Since there are many thousands of copyrighted films in circulation, the defendant may perhaps respect the injunction, and devote his infringing activities to any of the many other copyrighted motion pictures not named in the injunction.

It has been our experience that if the defendant were to be aware that a copyright infringement action had been filed against him, as is likely through newspaper reports of new federal actions filed even before the defendant is served with summons and complaint, he will secrete or otherwise dispose of the infringing films. If the United States Marshal later serves him with seizure papers, or a temporary injunction or restraining order, the prints will have already disappeared to places unknown.

Under the present Copyright Rules, we simultaneously file an affidavit and a bond with our infringement complaints. We also present an order for signature by the Judge, which directs the Clerk to issue a writ of seizure to the Marshal of the District, as well as to any other Marshal in any District throughout the United States in which the location of the articles is described in the supporting affidavit (with appropriate bond approved by the Court). We then try to have the Marshal serve the summons, complaint, and all the seizure papers (affidavit, bond, Judge's order, Clerk's writ), simultaneously upon the defendant, on the same day, seize the infringing copies or devices, and impound the same for further order by the Court. The defendant under the Rules can make immediate appropriate application to the Court for their return, upon showing reasonable grounds and make an appropriate undertaking which will satisfy the Court.

This procedure has been most effective in recovering and taking out of circulation the prints illicitly held or utilized. As a practical matter it has been the only effective remedy in the circumstances above described. These defendants do not have or intend to assert serious defenses.

You will recall my matter involving the Chaplin prints not so long ago. We filed a copyright infringement action in Federal Court in Brooklyn involving unauthorized exhibitions of Chaplin's famous MODERN TIMES, and the Marshal seized and impounded the print on the same day. We were faced with the fact that the five individual defendants and seven of the eight exhibiting corporate defendants were non-residents of the State, and possibly not amenable to process. They had been trafficking in various States with

some eight important Chaplin copyrighted films belonging to plaintiff. Defendant counsel claimed that all defendants were unable to respond to any money judgment but were willing to appear in the action, even though out of the jurisdiction, and consent to a decree of injunction. The complaint was amended to include the additional copyrights, and under the seizure order signed by the Judge on the day the complaint was originally filed, the Clerk issued various seizure writs to U. S. Marshals in Washington, D. C., and Milwaukee, Wisconsin, which succeeded in impounding prints of the seven other Chaplin pictures. All of these prints, being unauthorized 16mm. versions, were subsequently destroyed pursuant to the final decree of the Court.

In another action brought by a client against a party in Kentucky who had unauthorizedly made a negative and some 15 or so positive prints of the famous silent picture *UNCLE TOM'S CABIN*, we used similar proceedings to seize and impound the negative and a number of positive prints found with the defendant. The Clerk of the United States District Court in Kentucky, pursuant to the order of the Judge thereof, issued writs of seizure to United States Marshals in Colorado, Minnesota and other States, where prints were located, and such prints were seized and impounded by such Marshals. A judgment of some \$40,000 was ultimately obtained against the defendant which has remained wholly unsatisfied. The remedy was in taking these prints out of the illicit market, through the seizure and impounding provisions, for the detailed procedure of which we have been thankful to the Supreme Court Rules of Copyright Procedure. These prints, being dupes, were destroyed by the Marshals, as directed in the judgment.

Some years ago on the West Coast, a similar proceeding, whereby the Judge directed the Clerk to issue seizure writs to the Marshal on the day the infringing action was filed, succeeded in recovering and impounding prints of over 40 copyrighted feature films of one of our clients, which prints were found in the possession of the infringer, and additional prints of some 30 more copyrighted feature films of the client were seized and impounded by the Marshal as the prints were returned by customers of the defendant. These were authentic prints belonging to the plaintiff copyright owner and in the final judgment, the Court directed their return.

A few months ago, we concluded a copyright infringement matter for nine of our motion picture distributing companies in the East, in which we obtained permanent injunctions against the administratrix of a decedent who had been alleged to have infringed over 170 copyrights in feature films by renting the same in 16mm. size for unauthorized exhibitions. The infringer died during the pendency of the action leaving no estate. We were not able to use the seizure provisions at the beginning, since the pictures involved were only identified by us after the litigation had commenced, through a customer of the defendant in the middle west who identified the same as

having been rented by him from the defendant. Pre-trial deposition of the defendant, prior to his death, revealed that like others of his kind, he kept no records. The prints in the infringer's possession were apparently disposed of prior to his death, so that there was no recovery of the films, although final decrees against his estate awarded permanent injunctive relief and directed the surrender of the prints. These prints are still outstanding with unknown unauthorized persons.

I mention the foregoing merely to give some illustrations of the practical value of the present Rules of Copyright Procedure for seizure and impounding in copyright infringement actions.

My very strong feeling is to leave the present Rules precisely as we find them. This involves a problem unique to statutory copyright, for which there are no genuinely analogous procedures in the laws of the respective States, to which Rule of Civil Procedure 64 would direct us.

If the necessary procedure were to be brought into the Rules of Civil Procedure, then I think that all of the Supreme Court's Copyright Procedure Rules should be transferred intact into Civil Procedure Rule 64 as an appropriate subdivision thereof. However, I do not see any necessity for so doing.

As to annexing a copy of the infringing article, as well as a copy of the infringed work, to each copy of the complaint, unless not feasible, I agree with you that this Copyright Procedure Rule 2 might well be relaxed. I can see how the making of many copies of a dramatic manuscript of some hundreds of pages, for attaching to each copy of the complaint when it is used for filing, service, motions, etc., could be a great burden. It is impractical, of course, to attach copies of our copyrighted motion pictures to the complaint. A print of BEN HUR in 70mm. size could well run about a quarter of a ton. What we do in our complaint is to offer to produce a copy of the infringed work, as well as a copy of the infringing work (if the infringement is an available print rather than an infringing exhibition), for appropriate inspection subject to order and direction of the Court. Perhaps a provision along such lines could better serve the needs of identification than attaching copies.

In my recent conversation with you concerning the proposal, we mutually felt that it ought to be called to the attention of committees and others concerned with copyright, and I understand it is agreeable with you that copies of this letter may be circulated. I am enclosing copies so that you might distribute the same to the members of our Committee on Copyright in the American Patent Law Association.

With all good wishes,

Sincerely,

EDWARD A. SARGOY

APPENDIX

Present Rules of Practice for Procedure
Under Sec. 101 of Title 17, U.S.C.,
As Promulgated By the Supreme
Court of the United States

(As printed in the Annotation to Sec. 101)

RULES OF PRACTICE AS AMENDED

The Rules of Practice set out hereunder were adopted by the Supreme Court of the United States to govern the procedure under section 25 of Act March 4, 1909, now incorporated in section 101 of this title.

1. Proceedings in actions brought under section 25 (now 101) of the Act of March 4, 1909, entitled "An Act to amend and consolidate the acts respecting copyright", including proceedings relating to the perfecting of appeals, shall be governed by the Rules of Civil Procedure, in so far as they are not inconsistent with these rules. Amended by Supreme Court June 5, 1939, eff. Sept. 1, 1939.

2. A copy of the alleged infringement of copyright, if actually made, and a copy of the work alleged to be infringed, should accompany the petition, or its absence be explained; except in cases of alleged infringement by the public performance of dramatic and dramatico-musical compositions, the delivery of lectures, sermons, addresses, and so forth, the infringement of copyright upon sculptures and other similar works and in any case where it is not feasible.

3. Upon the institution of any action, suit or proceeding, or at any time thereafter, and before the entry of final judgment or decree therein, the plaintiff or complainant, or his authorized agent or attorney, may file with the clerk of any court given jurisdiction under section 34 of the Act of March 4, 1909, (now covered in sec. 1338 of title 28, U.S.C.), an affidavit stating upon the best of his knowledge, information and belief, the number and location, as near as may be, of the alleged infringing copies, records, plates, molds, matrices, etc., or other means for making the copies alleged to infringe the copyright, and the value of the same, and with such affidavit shall file with the clerk a bond executed by at least two sureties and approved by the court or a commissioner thereof.

4. Such bond shall bind the sureties in a specified sum, to be fixed by the court, but not less than twice the reasonable value of such infringing copies, plates, records, molds, matrices, or other means for making such infringing copies, and be conditioned for the prompt prosecution of the action, suit or proceeding; for the return of said articles to the defendant, if they or any

of them are adjudged not to be infringements, or if the action abates, or is discontinued before they are returned to the defendant; and for the payment to the defendant of any damages which the court may award to him against the plaintiff or complainant. Upon the filing of said affidavit and bond, and the approval of said bond, the clerk shall issue a writ directed to the marshal of the district where the said infringing copies, plates, records, molds, matrices, etc., or other means of making such infringing copies shall be stated in said affidavit to be located, and generally to any marshal of the United States, directing the said marshal to forthwith seize and hold the same subject to the order of court issuing said writ, or of the court of the district in which the seizure shall be made.

5. The marshal shall thereupon seize said articles or any smaller or larger part thereof he may then or thereafter find, using such force as may be reasonably necessary in the premises, and serve on the defendant a copy of the affidavit, writ, and bond by delivering the same to him personally, if he can be found within the district or if he can not be found, to his agent, if any, or to the person from whose possession the articles are taken, or if the owner, agent, or such person can not be found within the district by leaving said copy at the usual place of abode of such owner or agent, with a person of suitable age and discretion, or at the place where said articles are found, and shall make immediate return of such seizure, or attempted seizure, to the court. He shall also attach to said articles a tag or label stating the fact of such seizure and warning all persons from in any manner interfering therewith.

6. A marshal who has seized alleged infringing articles, shall retain them in his possession, keeping them in a secure place, subject to the order of the court.

7. Within three days after the articles are seized, and a copy of the affidavit, writ and bond are served as hereinbefore provided, the defendant shall serve upon the clerk a notice that he excepts to the amount of the penalty of the bond, or to the sureties of the plaintiff or complainant, or both, otherwise he shall be deemed to have waived all objection to the amount of the penalty of the bond and the sufficiency of the sureties thereon. If the court sustain the exceptions it may order a new bond to be executed by the plaintiff or complainant, or in default thereof within a time to be named by the court, the property to be returned to the defendant.

8. Within ten days after service of such notice, the attorney of the plaintiff or complainant shall serve upon the defendant or his attorney a notice of the justification of the sureties, and said sureties shall justify before the court or a judge thereof at the time therein stated.

9. The defendant, if he does not except to the amount of the penalty of the bond or the sufficiency of the sureties of the plaintiff or complainant, may make application to the court for the return to him of the articles seized, upon filing an affidavit stating all material facts and circumstances tending to show that the articles seized are not infringing copies, records, plates, molds, matrices, or means for making the copies alleged to infringe the copyright.

10. Thereupon the court in its discretion, and after such hearing as it may direct, may order such return upon the filing by the defendant of a bond executed by at least two sureties, binding them in a specified sum to be fixed in the discretion of the court, and conditioned for the delivery of said specified articles to abide the order of the court. The plaintiff or complainant may require such sureties to justify within ten days of the filing of such bond.

11. Upon the granting of such application and the justification of the sureties on the bond, the marshal shall immediately deliver the articles seized to the defendant.

12. Any service required to be performed by any marshal may be performed by any deputy of such marshal.

13. For services in cases arising under this section the marshal shall be entitled to the same fees as are allowed for similar services in other cases.

243. INTERIM EXTENSION OF COPYRIGHT—*Subcommittee Hearing on House Joint Resolution 627*

By JOHN R. PETERSON*

Is Congress really interested in copyright legislation? Anyone anxious to know would have been well rewarded by attendance at the House Judiciary Subcommittee hearing in Washington on May 3 on House Joint Resolution 627.¹ Originally scheduled to run from 10 until 12, the hearing actually continued until almost 2:30 in the afternoon without even a break for lunch. Witness after witness thought he had finished and rose to retire, only to be held on the stand by the incisive and searching questions of the Congressmen.

Res. 627 was explained as intended to provide for the continuance until December 31, 1967 of copyrights which would otherwise expire during Congressional consideration of the general revision of the copyright law which has been proposed by Abraham L. Kaminstein, Register of Copyrights. The recommendations of the Copyright Office, the culmination of a five-year study authorized by Congress, include a recommendation for an extension of the term of copyright from the present maximum of fifty-six years to a possible total of seventy-six years. It is well accepted that it would take several years for a general revision of the copyright law to receive adequate consideration and debate for passage, and it was brought out in the hearing that it is the purpose of the pending resolution to preserve existing copyrights without disturbing present rights and interests so that any such revision would be effective with respect to such copyrights.

A companion measure, Senate Joint Resolution 182, introduced by Board Senator Estes Kefauver of Tennessee, is pending in the Senate, replacing

* Member of the Massachusetts Bar; Co-Chairman, Committee on Program for the Revision of the Copyright Law, Patent, Trademark and Copyright Section, American Bar Association. The Editorial Board is indebted to Mr. Peterson, who was present throughout the hearing, for the preparation of this report.

1. Res. 627 read as follows: "*Resolved by the Senate and House of Representatives of the United States of America in Congress assembled, That in any case in which the renewal term of copyright subsisting in any work on the date of approval of this resolution would expire prior to December 31, 1967, such term is hereby continued until December 31, 1967, or until the date of enactment into law of a general revision of the copyright laws of the United States, whichever shall first occur.*"

On May 2, 1962, S.J. Res. 182 was introduced by Senator Kefauver, which eliminated the subjunctive phrase, "*or until the date of enactment into law of a general revision of the copyright laws of the United States, whichever shall first occur.*"

Res. 178 which Senator Kefauver had previously introduced but which varied slightly from the language of the House Resolution.

Edwin E. Willis, Chairman of the Patents, Trademarks and Copyright Subcommittee of the Committee on the Judiciary of the House, presided over the hearing until he had to absent himself for an important vote on the floor in the early afternoon. The Chair was assumed during his absence by Roland V. Libonati. John V. Lindsay of New York took a particularly active part in the questioning of the witnesses, but all of the members of the Subcommittee explored and probed the evidence with questions which showed a considerable familiarity with the problems involved and appreciation of the issues which were presented.

The hearing was opened by the testimony of Hale Boggs of Louisiana, Democratic Whip of the House, who indicated his support for the resolution and his hope for its favorable consideration by the Subcommittee. Chairman Willis stated that a letter had been received from the Department of Justice opposing the resolution on the ground that copyrights were "forms of monopoly and should not be extended for periods longer than those now provided by law" and that "it would seem unwise to extend further the copyright monopoly". He stated that it appeared that the Department of Justice was taking a position contrary to that of the majority leadership of Congress and that if it were necessary for the Subcommittee to choose between the two they might well be inclined to follow the majority leadership. Chairman Willis and several members of the Subcommittee expressed disappointment and regret that the Department of Justice had not accepted the invitation to have a representative present to support the Department position and to be available for questioning by the Subcommittee.

Testimony supporting the resolution was given by John Schulman of New York, as Chairman of the Copyright Committee of the American Patent Law Association. After he had finished his prepared statement questions from the Committee members kept Mr. Schulman on the stand for a considerable time. During the course of his testimony Mr. Schulman reported the endorsement of the resolution by the American Patent Law Association.

The stand was then taken by Samuel Tannenbaum, of New York, as Chairman of the Copyright Division of the Patent, Trademark and Copyright Law Section of the American Bar Association. Mr. Tannenbaum testified that the American Bar Association had also placed itself on record in support of the resolution. His statement included the names of a number of well known authors and composers whose copyrights would expire before a general revision of the copyright law could be made effective unless the pending resolution were enacted into law.

Mrs. Helen Sousa Abert, daughter of John Philip Sousa, American composer of band music and marches, told the Subcommittee that although her

family still owned the home in which her father had written "The Stars and Stripes Forever", they had lost their rights in this music in the United States due to the expiration of its copyright. Royalties still come in from Europe, where her father's rights in this music are given greater recognition than in his own country. She told of several other of her father's compositions which will pass into the public domain within the next several years unless the resolution is passed.

The General Counsel for the Authors' League of America, Irwin Karp, submitted the statement of his organization, and was questioned by the Chairman as to whether the passing of works into the public domain generally increased their distribution and therefore availability to the public. He responded that the considerable investment of publishing and producing organizations in the dissemination of a work often requires the protection of copyright as a practical safeguard, and that for this reason mere free use for all did not of itself guarantee greater distribution to the public.

Julian Abeles testified as Counsel for Music Publishers' Protective Association Inc. and as General Counsel for Harry Fox, recording rights agent and trustee. He described briefly some of the hardships and inequities which he said would result if the resolution were not passed.

Robert J. Burton, Vice President of Broadcast Music, Inc., stated that he presented the support for the measure of the many young composers who are members of his group, and stated also that he felt in a position to testify that the public interest would be served by the pending resolution.

Testimony against the resolution was offered by Harry R. Olsson, Jr., Senior Attorney, National Broadcasting Corporation. Mr. Olsson testified that he was not against a longer term of copyright, and felt that this might well be justified because of the longer life span of authors and composers today. He was inclined to agree with the Register's proposal for a seventy-six year term of copyright, but he felt that any lengthening of the term should be accomplished only as part of the general revision of the copyright law. The proposed resolution would not, in his opinion, accomplish the constitutional purpose of encouraging the progress of science and the arts because it would affect only existing works already produced. Mr. Olsson also objected that the resolution failed to distinguish between authors who would benefit from the extension of copyrights by the resolution and those who had purchased such rights from authors.

Mr. Redd Evans then testified against the resolution, identifying himself as a small music publisher of New York City who had suffered from monopolistic practices. Mr. Evans charged that the bill benefited special interests and was intended to favor monopolies in the music publishing field by certain large organizations.

The Register of Copyrights, Mr. Kaminstein, testified at considerable length in response to interesting questions from the Committee members. He declared himself to be in favor of the principle of the proposed resolution, but felt that the benefits of any extension of copyright should be shared by the authors and composers rather than passing solely to whoever may have succeeded to their interests. The pending resolution, he felt, was not satisfactory because it did not accomplish this purpose. He stated that if the resolution would provide for some sharing of the benefits between the author and the proprietor and if the period of extension were shortened somewhat, his office would be able to support it, but that he recommended the improvement of the resolution rather than its defeat.

The Register's testimony included the statement that about 47,700 copyrighted works would be benefited by the pending resolution. This is the number which had been renewed and therefore would come within its provisions. Of these 70% are musical compositions, 15% books, 10% periodicals, and 5% miscellaneous. Representative Libonati raised the question as to whether Congress could deprive copyright proprietors of rights which were vested in them, and Mr. Kaminstein expressed his opinion that Congress had this power as long as the rights related to an additional term of copyright which was being granted. Congressman Lindsay indicated that he did not feel that Congress was prepared at this time to cope with the comprehensive question as to who should get the benefits in an extension of copyright, but suggested that the Register prepare a draft bill which he felt would accomplish his purpose and submit this for the consideration of the Subcommittee.

Mr. Burton Lane, President of American Guild of Authors and Composers (formerly called the Songwriters' Protective Association) and composer of the music for "Finian's Rainbow" and of a number of popular songs, testified in favor of the resolution, and presented the names of a number of well known authors and composers whose works were due to pass into the public domain within the period covered by the resolution. Congressman Lindsay invited Mr. Lane to comment on the Register's proposal that the resolution should be amended to provide for the payment of royalties to authors and composers in all cases. Mr. Lane replied that, of course, he was generally in favor of anything which would benefit authors and composers, but that in view of the urgent necessity for the passage of the present resolution at this time he felt that its prospects should not be jeopardized by complicating it with such efforts. He felt it more important that it pass in its present form than be defeated as the result of an effort to make it of possibly greater benefit to authors and composers.

The stand was then taken by Maurice R. Cheyette of Chamberlain and Willi, attorneys for the Trustees of Mark Twain's Estate. He urged a longer

term of copyright, and emphasized the fact that other forms of property received perpetual protection.

Testimony was then offered by Philip B. Wattenberg as General Counsel to the National Music Council and the Music Publishers' Association of the United States Inc. Mr. Wattenberg presented a statement on behalf of his organizations, and then reported to the Subcommittee that the proposed resolution was not without precedent, a similar bill having been passed in Japan just recently, extending the period of copyright in that country for three years pending a general revision of its copyright law. He then reported that the Executive Committee of the National Music Council had endorsed the resolution.

Herman Finkelstein, General Attorney for ASCAP, testified at some length, distinguishing between patents and copyrights. The members of the Subcommittee questioned him in detail as to his contention that the Department of Justice should not have referred to copyrights as monopolies. Mr. Finkelstein stated that both publisher and composer members of his organization were in favor of the Resolution.

At the conclusion of the testimony, Congressman Lindsay asked whether it would be possible for the Register of Copyrights to report to the Subcommittee as to the actual number of authors who would benefit from his proposed change in the resolution. Mr. Kaminstein said that he would endeavor to secure such information and report it to the Subcommittee. The record was left open for the submission of such additional information, and it was indicated that the Resolution would receive the active consideration of the Subcommittee.

In conclusion, it may be observed that the number and nature of the Subcommittee's questions to the various witnesses clearly indicated a real and active interest on the part of its members in copyright law revision.

244. THE LENDING AND RENTAL OF PHONOGRAPH RECORDS AND BOOKS*

By TORBEN LUND

Introduction

The following analysis deals particularly with the Scandinavian Copyright Law for two reasons. First, the author is Scandinavian, and has consequently specialized knowledge of theoretical points of view as well as practical applications in this field. Second, and more important, the Scandinavian countries are, I believe, the only ones having systems which assure authors, at least to a certain degree, remunerations in case their works are lent or rented. The establishment of such a right for authors may be conceptualized on various bases.

According to the leading rationale it might be reasoned that the authors' right is founded on the basis of *copyright* in its statutory sense: *i.e.*, the *exclusive right* of authors to oppose the lending or rental of the copies of their protected works, or to require compensation therefor. This may be considered within the ordinary scope of rights secured by copyright. Or, it could be argued that the right conferred on authors to oppose the lending or rental of their works, or to require compensation, is derived from considerations of property rights in general. In this view, it is considered a property right to the corporeal object, to wit, the copy, not an incorporeal property right in the intellectual work embodied in that copy.

Finally, it is possible that the desired result could be achieved by express legislation, which would regulate this question by law without reference to copyright or property concepts. Such a system could be established by a convention.

We may examine each of the three possibilities separately.

I.

Points of View Based on Copyright.

The substantive attributes of a copyright consist of the fact that they confer on the author the exclusive right to produce and reproduce the work which, expressed conversely, is the exclusive right to oppose the production of copies of the work which may be visually or aurally perceived by third

* A report presented by Professor Torben Lund of the University of Aarhus, President of the Danish group of the Association Litteraire et Artistique Internationale (ALAI) before its meeting in Florence, September 11-16, 1961.

parties. This right rests upon the more fundamental right of the author to refrain altogether from publication. It is the act of publication which permits the work to be perceived by third parties. The very definition of copyright implies that any action which permits copies to be perceived by third parties constitutes a "publication." It is generally admitted that to constitute a copyright infringement, it is sufficient for the infringer to place the work in a position which *permits* others to perceive it. Thus, if a musical composition is played during a concert, it is not necessary to establish that third parties *actually listened*. It is enough that it was *possible* for them to listen. In the case of the transmission of a book, copyright infringement arises from the fact that it becomes possible for a person who receives the book to read it. This analysis results in characterizing the communicator as the infringer, rather than the receiver of the work communicated. Thus, wrongful publication, not reception, is the essence of infringement.

In addition to, and prior to the exclusive right to produce copies, the author has the right to decide whether or not the work is to be published at all.

Publication may be made in two ways. One is transmission of copies of the work to third parties not in the presence of the transmitter. Selling a book is an example. Another method is public performance. A public concert of a symphony exemplifies this latter method of publication. (It may be noted that some consider broadcasting to be a special form of distribution which does not fit into either of the two types of publications described. A detailed analysis of this question is not germane to our subject.)

For support, I cite the new Scandinavian laws on copyright (the Swedish law of December 30, 1960, the Norwegian law of May 12, 1961, and the Danish law of May 31, 1961. It is expected that a corresponding Finnish law will soon be passed.) These laws contain a first chapter which establishes the general rules concerning copyright, and a second chapter entitled "Limitations on copyright."

In the first chapter, article 2 deals with our subject. It prescribes, in effect, that copyright includes, "within the limitations provided by this law, the exclusive right to dispose of the work by producing copies and making them accessible to the public. . . ."

With regard to the aspect of the right which allows the author to object to production of copies of his work, article 2 stipulates "that the fixation of the work in a concrete form capable of being reproduced [or communicated*] is also considered a production of copies."

Regarding the aspect of the right which permits the author to object to his work being made accessible to the public, it is provided "that this is

* From the Official French text. Tr.

accomplished when the work is performed in public or *when copies of the work are placed on sale, offered for rent or for loan, or diffused in any other way, or publicly performed.*"

If there were no other provisions in the new Scandinavian laws on copyright, these terms standing alone would be persuasive authority that lending and rental to the public, of both books and phonograph records, are included in copyright protection.

These laws also contain a Chapter 2 indicated above which provides certain limitations on copyright, notably article 23 (in the Norwegian law, article 21) which is phrased in almost identical terms in the laws of the three countries and reads (in the Danish version): "when a literary or musical work is published the copies of the edition may be diffused or publicly presented."

Obviously, a view of copyright protection applicable to the lending or rental of books and phonograph records is considerably weakened by such provision. The German theory, "Erschöpfungslehre," is manifested here in somewhat modified form. It contends that the author's right is considered *exhausted* after the publisher has disposed of the copy.

According to the new Scandinavian laws, however, the author's right is not completely exhausted when the copy has been disposed of. The fact that the right of distribution is fixed in principle by Chapter 1, and that the right of subsequent distribution is established as an exception in Chapter 2, is bound to influence interpretation. It is certain that the author retains his moral right, even with regard to subsequent distributions. And, article 23 of the Danish law expressly provides that its text implies no limitation on the right conferred on authors by other legal provisions to collect remuneration for the public lending of books by libraries. (Cf., III, *infra*.)

Finally, article 23 of the Danish law expressly provides that without the author's consent, copies of compositions on staff paper should not be distributed to the public by rental or lending. This rule applies, however, only to scores, not to phonograph recordings. Sweden has the same provision.

Thus in Danish and Swedish law the situation is that while lending or rental to the public of recordings and books are, in *principle*, under the protection of the copyright law, in fact, unrestricted lending or rental are made lawful by an exceptional special provision. And the moral right remains in force.

As to the particular question of the rental of recordings, they are also regulated under article 23, since the definition of the term "publication" in article 8 of the law includes any diffusion of copies of an intellectual work, and therefore includes recordings.

The reasoning behind the provision of the Danish law is that although rental of recordings is not at present extensive in Denmark it may be in

the foreseeable future. Then the problem of the protection of authors in this connection could be re-studied.

Article 21 of the Norwegian law, on the other hand, provides that copies of musical works cannot be rented to the public without the permission of the author. This also applies to recordings. This provision will become effective July 1, 1961, so that after that date, authors will enjoy a very extensive form of protection against this form of use of their works.

Ulmer gives an accurate summary of this phase of German law in *Urheber- und Verlagsrecht* (2d ed. 1960). From a theoretical point of view, lending and rental of works may come under the heading of copyright, but the German "Erschöpfung" seems to indicate limitations that are not favorable to authors. In fact, German law regulating copyright actually provides that "die ausschliessliche Befugnis des Urhebers erstreckt sich nicht auf das Verleihen." [The exclusive right of the author does not extend to lending of works.] Nevertheless, the "Ministerialentwurf" (Proposed New Act) published in 1959 would provide the payment to the author of a fee when copies of his work are offered for rent *for profit*.

An analogous solution has been recognized in the Austrian law. Max Rintelen, *Urheberrecht und Urhebervertragsrecht* 117-19 (Vienna 1958): "Das Verbreitungsrecht" [the circulation right] is ended in the case of each copy from the moment that the copy is disposed of with the consent of the author. Austrian *Urheberrechtsgesetz*, article 16 (1936). In a note at 119, Rintelen states the thesis that tends to prevail, according to which the right to distribute cannot always be considered ended when the copy is disposed of, an extension of rights being recommended in view of the growing number of lending and rental libraries.

II.

Points of View Based on the Common Law of Property.

A detailed study of the possibilities to establish protection, offered by the different types of law through application of certain rules of property right or chattel rights in general, against the lending or rental of copies of intellectual works for the benefit of their authors, would be outside the scope of this essay. It will be possible to trace only the broad lines, and to give a certain amount of succinct information on the provisions of the law in this respect in the Scandinavian countries.

In considering these matters, we must begin with the fact that the physical property which a copy of a work constitutes, such as a book or record, belongs to the person who has produced the physical copy or had it produced.

The question is whether the proprietor can compel persons who subsequently acquire a copy to pay a fee for the lending or rental of the copy, either to the proprietor or for the account of third persons, in particular, persons who have special interest in the distribution of the copy: the author of the book or record, and possibly the performing artist who contributed to the production of the record.

It must be noted that such a right, even if it could be established for the benefit of authors and others, may be enforced only by an action brought by the original proprietor, *i.e.*, the publisher or manufacturer.

It is evident that this right can be established by contract between the original proprietor and his vendee; the publisher may sell the book to a bookseller on the condition that the latter will not rent the book, or that he will not make a charge for lending it. However, it must be pointed out that such an agreement could not be binding were it in conflict with the public interest. It remains an open question whether article 23 of the new Danish law on copyright, discussed above, and analogous provisions which appear in the laws of many other countries, are to be considered regulations concerning the public interest which are in opposition to the conclusion of such contracts between the vendor of the copy and the purchaser. As a matter of fact, article 23 is an exception to the proprietor's absolute right of distribution (which encompasses control over loan and rental) granted in article 2, stating that "when a literary or musical work has been published, the published copies may be further distributed, or publicly performed." It is generally admitted that the exception provided by the chapter of the law dealing with "limitations on copyright" are to be considered as provisions for the benefit of the public. The limitations are aimed at assuring, in certain limited areas, public access and enjoyment of the benefits of civilization that these works represent. This implies that the authors are forbidden to impose restrictions by provisions ensuring private rights. This intention of the law could not, consequently, be contractually compromised by publishers, or manufacturers of copies of books.

On the other hand, in cases where the law has not provided or envisaged that no restrictions exist on the lending or rental of copies—as, for example in the former Danish law on literary and artistic property—a right to royalties may be established by an agreement between the vendor and his vendee.

However, in the great majority of cases, records and books are not purchased directly from the manufacturer or publisher, but through a middleman. Thus, the question is whether the original proprietor would be able to claim any right against the final purchaser of the copy, who intends to lend or rent it, that is to say, protection against third parties. It must at least be a prior condition for the purchaser to be aware, before the purchase

was made or at the moment it was concluded, that the original vendor claims such a right. This condition may be fulfilled either by placing a restricted-use notice on the record or by calling to the purchaser's attention through announcements, circulars, or by a combination of these methods, the right claimed by the producer.

However, it remains to be seen whether the procedures mentioned would be sufficient to permit the producer to restrict lending or rental, either for royalties for himself or other persons who collaborated in producing the record or book, or to exact a fee for this kind of use of the copies.

It should be stated at the outset that creation of such a right is subject to legislation deemed to be in the public interest. This consideration would be exactly as described above in the case of legal relations between contracting parties. What follows is therefore applicable only to cases where the question has not been decided by statute.

If the question is to be answered in the affirmative, it may be on the basis of any of three different points of view.

The first begins with the admission that the producer, the original vendor, is qualified to encumber the object of which he was the original proprietor with a clause, it might be termed a servitude, which must be respected by each successive person who acquires the object and who is aware of this servitude, whether the person who acquires it is a purchaser or acquires it in some other way. I call this point of view the *servitude point of view*. K. Illum, however, argues with force in his book on Danish real property that, under Danish law, chattels cannot be encumbered with servitudes. [K. Illum, II *Dansk Tingsret* 207-09 (1952).]

The second point of view admits that, while it is contrary to Danish law to encumber chattels with servitudes, the original vendor may make an agreement with the buyer (the middleman) that the latter must respect the restriction and take the responsibility for seeing that it is respected by subsequent purchasers. The subsequent purchaser who, knowing of the restriction, breaks the interdiction, commits an illicit action in violating the obligation, the legal relations existing between the manufacturer and the original purchaser.

In this case, the original proprietor has a right arising from international interference with contractual relations. We may call this the tort (*unprivileged interference*) *point of view*.

Finally, the legal relationship could be viewed as requiring the original buyer, the middleman, to be duty-bound to respect the manufacturer's restriction and to see that it is respected by the buyer who purchases the work from him. However, since this agreement is made for the benefit of the manufacturer, the right is transmitted from the middleman to the manufacturer, who may exercise the right directly against the last purchaser. This is what I call the *contractual responsibility point of view*.

Another point of view, based on the right of competition, could be argued in support of the right of the producer. This is the provision in article 15 of the Danish law on competition, the so-called "general clause." "Any act performed with a view to profit and contrary to fair commercial practices entails the duty of making reparation and may be legally enjoined." Danish case law is in keeping with the statutory scheme as a result of Supreme Court decisions handed down in 1930, 1935, 1943, and 1946. (*See infra.*)

It must be remembered that in Danish copyright law in force until the present, there are no rules formally regulating, either positively or negatively, the lending or rental of copies. This is explicitly stated in the Supreme Court decision of 1930.

The servitude point of view has been formally rejected by the Supreme Court in its decisions. Restrictions against renting printed material are not in themselves enough to protect the manufacturer against third parties, and this is so even if the person who acquires the copy (but who does not buy directly from the manufacturer) is aware of this prohibition. This rule has been applicable ever since the insertion in 1937 into the law on competition of the very effective "general clause" mentioned above.

If, on the other hand, the manufacturer (the publisher) establishes an effective system of contracts, and, in addition to these, places on every copy sold a printed notice, a purchaser buying one of these copies upon which a notice has been placed with the intention of committing an infraction of the agreement, would be duly liable to suit for violation of professional practices under Article 15 of the law on competition, the "general clause." It therefore is not always a matter of an obligation based on the point of view of contractual responsibility. The right created in favor of the manufacturer (editor) is founded on an obligation prescribed by a special law, the law on competition; we are in the presence of a responsibility deriving from commercial law. The purchaser is responsible, not because he violated purely contractual rights deriving from an agreement between the manufacturer and the middleman—nor is it strictly a case of tortious interference—but solely because the purchaser has committed an act which the law considers an act performed with a view to profit and contrary to fair commercial practices.

The decisions of the Supreme Court referred to above all concern notices printed on books or periodicals which prohibit rental without the consent of the producer. There are no Danish court decisions regarding notices on records dealing with their rental or loan, but there is little reason to think that the Danish courts would have a different solution for records than for books.

However, the Supreme Courts of Sweden and Norway handed down decisions in 1949, and in 1940 and in 1955 respectively, on notices appearing on records, but none of these judgments deal with a defense of rental or lending. They concern the restriction against performing the record in public, without the consent of the producer, by broadcasting, or at sports events, etc.

Whereas the Swedish Supreme Court considered that the producer was unable to obtain, by this procedure, a right which the Swedish law did not confer on him, the Norwegian Supreme Court decided (in the 1955 case, by a vote of three to two) that the acquirer who had bought the record from a middleman but who knew of the restriction imposed by the manufacturer, should respect this restriction in spite of the fact that the rather effective "neighboring right" given to the manufacturers of phonographs by the old Norwegian law was formally abrogated by the copyright law of 1930.

III.

Special Legislation

While, to my knowledge, no special legislation exists which gives authors any sort of protection against rental of records (see, on the other hand, what has been said at I *supra*, on the subject of the new Norwegian copyright law), laws and other regulations have been promulgated in the Scandinavian countries which confer on authors certain rights regarding the lending and rental to the public of their books.

Denmark

The first country to establish protection in this field was Denmark. This reform was introduced in 1943, at which date an agreement was made between the professional groups representing bookstores and the Danish authors' society concerning the rental of books by the reading clubs organized by the bookstores. An autonomous institution was created, the Fund for Danish Writers, the charter of which received the royal endorsement, so that the institution was of an official nature. The most recent statutes concerning this Fund date from 1957.

These statutes provide that the royalties to authors constitute a remuneration to offset the use made of the works of authors during the course of the activities of the reading clubs. This system tends in the direction of copyright exploitation. This is confirmed by the fact that the distribution of "royalties" to the different authors is in the form of individual compensation proportional to the use made of their works. Thus, every year, a count is made of the number of copies of each author which are used in the reading clubs belonging to the organization. It should be noted that these reading clubs constitute the only effective form of book rental existing in Denmark.

The necessary funds come from the fees which must be paid by each person belonging to a reading club; this fee was originally 1 crown (14.5 cents), in 1957 raised to two crowns. Out of the funds thus established the sums necessary for administrative expenses are deducted, and from the remainder small sums are reserved for a literary prize and for welfare purposes. The balance, which is the greatest part of the capital collected, is distributed to the authors in proportion to the number of copies of books by which they were represented in a given year in all the member clubs. The widows of deceased authors are admitted as beneficiaries, but not the widowers of deceased authoresses. It may be foreseen that soon the system will be revised also to admit the minor children of authors.

The right to royalties cannot be attached by the creditors of the author, nor can they be assigned to third parties by agreement.

These royalties produced in the last fiscal year the sum of 36,876 Danish crowns (about \$5,347). Distribution to authors according to the rules outlined above was 31,129 crowns, and a sum of 1000 crowns was allotted to a literary prize. The rest was absorbed by administrative expenses, notably the analysis and documentation necessary to make the proportionate distribution. The most widely read writers received sums ranging from about 1,500 crowns to 3,500 crowns (\$217 to \$507); 137 authors received royalties.

In 1946, the Danish Writers' Fund extended its activities to include as well the lending of books, which in Denmark is to a large extent done through the agency of state-supported Danish public libraries. This system, which is in accordance with the law of March 30, 1946 on libraries, is founded on the concept of copyright in its true sense. Individual royalties are collected by authors of books made available to the public, and the royalties are paid by the libraries, that is to say by the organizations which distribute the books. The royalties, which are part of the subsidy granted the libraries by the State, are held by the State for payment directly into the Danish Literary Fund. These sums, paid annually to writers, are designated by the law in the following terms: "compensation for the use made by libraries of the books of the writers in question." Those authorized to benefit by these royalties are Danish writers, and widows and minor children of deceased Danish writers.

Each library sends annually to the Fund a list of the number of books of each author concerned that the Library has on hand for lending purposes (for home use or for use in the reading room). It is therefore necessary, in order to prepare the annual lists, that the writers (or their widows or children) be registered with the Fund. Whatever sum is available, after the administrative expenses have been deducted, is distributed to the authors in proportion to the number of books by each in the collections of libraries during the past year. For the purpose of these calculations (performed by

modern computers), it is therefore not the number of lendings, but the number of books placed at the disposal of the public, which determines these royalties.

In making these calculations, a count is kept of all the books in different categories, belles-lettres or special subjects, which are the result of an original creative activity of the author, while the activities of a translator or adaptor are not included. It was also unfortunately necessary to exclude, for practical reasons, books with more than one author.

The right to royalties may not be sold, transferred or pledged in any other way; and similarly the royalties may not be attached nor included in bankruptcy proceeding.

In the last fiscal year a sum of 744,492 Danish crowns was available (about \$109,954) of which about 700,000 crowns were distributed to the authors, the rest being used to pay administrative expenses relating to the calculating of royalties.

In 1960-1961, royalties were paid to more than 1,100 writers or widows of writers. The largest share was about 18,000 Danish crowns (about \$2,610), and several writers with a highly valued literary output received sums between 6,000 and 10,000 crowns (\$870 to \$1,450). As authors of poetry receive only a small portion of the proportional distribution, a special annual poetry prize of 5,000 crowns (\$725) was established.

Norway

The law of December 10, 1947, on popular and educational libraries, provides for the creation of a maintenance fund for Norwegian writers maintained by royalties, partly from a portion of the subsidies paid by the State to these libraries, and partly by a royalty on the purchase of books for reading rooms. A royalty is also collected from the reading clubs according to an agreement between the Writers' Society and the bookstores.

While the funds available are therefore made up in the same way as in Denmark, the principles for distributing these funds are markedly different. No author is entitled (as in Denmark and Sweden) to a right to the royalty. Rather, the distribution is made in accordance with the estimation of a directing committee, in the form of scholarships and subsidies. Among the factors taken into consideration in making the distribution, however, is the extent of representation of each author in the library collections.

In the last fiscal year, the directing committee disposed of a total of about 125,000 crowns (\$16,500).

Sweden

The Swedish Parliament passed a resolution in 1955 regarding the payment of Swedish writers for the lending and utilization of their works by

the national libraries, the popular libraries subsidized by the State, and the educational libraries. [Royal decree of June 17, 1955, modified June 2, 1961.]

A Fund for Swedish writers was also created, into which is paid 3 öre (100 öre = one crown; one crown = \$.193) for each copy of an original lent by the libraries plus 12 öre for each work to be found each year in a reading room. In addition 1 öre was paid for the lending of each translation into Swedish, and 4 öre for each copy of a translation available in a reading room.

From these sums, authors receive, as an individual royalty, *and to which they have a positive right*, 2 öre for each loan and 8 öre for each copy in a reading room. The remainder of the receipts for royalties for original works, and the total royalties for translations are paid into the portion of the fund reserved for pensions and subsidies, scholarships for writers, translators, illustrators of merit, and contributions to special literary projects, especially to groups of authors. When this discretionary distribution is made, only authors and their survivors who would be eligible for individual distribution receive subsidies.

The royal decree provides formally that this system applies to original works and translations which enjoy protection under the copyright law, and the right to the royalty passes on the author's death to his successors by the application of the legal provisions on marriage and succession. The right to the royalty is not assignable or subject to attachment. As it is practically impossible to determine the total number of loans made by all the libraries under this system, samplings are verified each year in specially chosen libraries.

When there are more than three authors of a work, individual royalties are not paid out, and the entire amount for these works is credited to the funds for discretionary distribution.

In 1959, at which time the system did not yet include translators, about 400,000 Swedish crowns (\$77,200) were distributed in individual royalties, while the free distribution amounted to about 500,000 crowns (\$96,500). Administrative expenses were about 83,000 crowns, most of it for calculating the number of loans and the number of copies in reading rooms.

Finland

In Finland, a system along the lines of the Norwegian system is in preparation.

It might be remarked that the principles applied in the Scandinavian countries concerning royalties paid by the libraries, etc., are of a national character, available only to nationals of the country. A system of reciprocity between countries is under study, but it is encountering difficulties due to the differences between the systems used in various countries.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. UNITED STATES OF AMERICA AND TERRITORIES

245. LIBONATI, ROLAND V.

Report on the diplomatic conference for the adoption of an international convention concerning the protection of performers, producers of phonograms and broadcasting organizations in Rome, Italy, October 10-26, 1961. Printed for the use of the [House] Committee on the Judiciary. December 1961. Washington, U. S. Govt. Print. Off., 1962. 64 p. (Committee print).

Congressman Libonati, who attended the conference as a congressional adviser to the U. S. delegation, makes the following statement in the letter transmitting his report to the House Judiciary Committee:

"I herewith submit to the committee for its use my report of that conference. It contains a history of the steps leading to the meeting in Rome as well as my comments on the problems and issues which were considered by the delegates to the convention. It is hoped, in making this report, that it will be of aid in connection with enabling legislation which would be needed if the convention is formally ratified as a treaty."

An appendix includes the English text of the Convention, the list of participants, and the "Report [provisional] of the Rapporteur-General," Mr. Kaminstein.

246. U. S. CONGRESS. SENATE.

S.J. Res. 178. Joint resolution extending the duration of copyright protection in certain cases. Introduced by Mr. Kefauver (by request) on April 2, 1962, and referred to the Committee on the Judiciary. 1 p. (87th Cong., 2d sess.)

Identical with H.J. Res. 627 (87th Cong., 2d sess.) except for disjunctive phrase at end extending the renewal term until December

31, 1967, "or until the date of enactment into law of a general revision of the copyright laws of the United States, whichever shall first occur."

247. U. S. CONGRESS. SENATE.

S.J. Res. 182. Joint resolution extending the duration of copyright protection in certain cases. Introduced by Mr. Kefauver (by request), May 2, 1962, and referred to the Committee on the Judiciary. 1 p. (87th Cong., 2d sess.)

Identical with H.J. Res. 627 (87th Cong., 2d sess.). See 9 BULL. CR. SOC. 315, Item 192, and Items 243 and 246, *supra*.

248. U. S. CONGRESS. HOUSE.

H.R. 11793. A bill to provide criminal penalties for trafficking in phonograph records bearing forged or counterfeit labels. Introduced by Mr. Celler, May 17, 1962, and referred to the Committee on the Judiciary. 2 p. (87th Cong., 2d sess.)

This bill would make anyone who "knowingly and with fraudulent intent" transports, sells, or receives sound recordings bearing forged or counterfeit labels guilty of a felony and subject to a fine of not more than \$10,000 or imprisonment for not more than ten years, or both. Apparently it is a clean bill introduced in lieu of H.R. 6354 (87th Cong., 1st sess.) as a result of testimony at the recent hearings on that bill. See 8 BULL. CR. SOC. 302, Item 274 (1961). See also *infra*, p. 430, Item 349.

249. U. S. CONGRESS. HOUSE. *Committee on Education and Labor*.

Economic conditions in the performing arts. Hearings before the Select Subcommittee on Education of the Committee on Education and Labor, House of Representatives, Eighty-seventh Congress, first and second sessions. General investigation of conditions affecting the income and employment of performing artists. Hearings held in New York, N. Y., November 15, 16, and 17, 1961; San Francisco, Calif., December 7 and 8, 1961; and Washington, D. C., February 5 and 6, 1962. Washington, U. S. Govt. Print. Off., 1962. 635 p.

These hearings which were held pursuant to H.Res. 141, 87th Congress, introduced by Congressman Giaimo, include testimony bearing on the question of the perfection of the performing artist.

250. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Trading With the Enemy Act. Report of the Committee on the Judiciary, United States Senate, made by its Subcommittee to Examine and Review the Administration of the Trading With the Enemy Act of 1948 and the War Claims Act of 1948 pursuant to S.Res. 60, 87th Cong., 1st Sess., as extended, together with individual views. April 27, 1962. Washington, U. S. Govt. Print. Off., 1962. 8 p. (87th Cong., 2d sess., Senate Report No. 1363).

A presentation of the background of the assets question, an analysis of the current bills on the subject, the work of the Subcommittee on the Trading With the Enemy Act on the bills, the administration of the Trading With the Enemy and War Claims Acts, and conclusions.

In its conclusions, the committee urges early consideration of its recommendations with respect to the obligation of the Congress to provide reimbursement to American war damage claimants as reflected in its report on the claims bill during the first session, and that Congress "continue to seek a final solution to the perplexing problems involving vested assets and war damage claims." Individual views of Senator Keating appear at end, in which he urges favorable action on his proposed amendments to S. 2618 (87th Cong., 1st sess.).

251. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Patents, trademarks, and copyrights; report of the Committee on the Judiciary, United States Senate, made by its Subcommittee on Patents, Trademarks, and Copyrights, pursuant to S.Res. 55, Eighty-seventh Congress, first session, as extended. Washington, U. S. Govt. Print. Off., May 9, 1962. 20 p. (87th Cong., 2d sess. Senate. Report no. 1481).

The annual report on the activities of the Subcommittee covering the first session of the 87th Congress. The review of copyright matters includes summaries of the hearings on the design bill, S. 1884, and of the principal recommendations in the Register's report on general revision. In addition, there are brief statements on the Rome neighboring rights conference and on the appellate decision in the *Rickover* case.

In connection with general revision, a statement appears in the report to the effect that the chairman of the subcommittee has authorized the staff to conduct certain pertinent studies, a major area of which "will relate to an examination of the economic importance of the various aspects of copyright."

252. U. S. COPYRIGHT OFFICE.

Sixty-fourth annual report of the Register of Copyrights for the fiscal year ending June 30, 1961. Washington, 1962. 16 p.

In addition to an account of administrative and legal (domestic and international) developments during the fiscal year, this report includes, *inter alia*, an appreciation of the late Register Arthur Fisher and a chart illustrating the average creative period and longevity of authors, composers and songwriters.

2. FOREIGN NATIONS

253. ITALY. *Laws, statutes, etc.*

Loi du 1^{er} juillet 1961, no. 569. Institution d'une redevance sur les disques phonographiques et autres supports servant à la reproduction des sons. *Interauteurs*, no. 146 (1st quarter 1962), pp. 62-63.

A French translation of an Italian law of July 1, 1961, imposing a royalty of 10 per cent of the invoice price on each sale, by the producers, of phonograph records and other objects which may be used for the reproduction of sound. Includes special regulations applying to imported sound recordings and to educational materials. Under Art. 8 of the law, the Minister of Finance has the authority to issue regulations concerning the terms, methods and forms of royalty payments, and to empower the Italian Society of Authors and Publishers or other authors' organizations to collect such payments.

254. ITALY. *Laws, statutes, etc.*

Loi du 27 décembre 1961, n. 1337, modifiant l'échéance fixé par l'Article 1^{er} de la loi du 19 décembre 1956, no. 1421, sur la prorogation de la durée de protection des oeuvres de l'esprit. *Interauteurs*, no. 146 (1st quarter 1962), p. 63.

A French translation of an Italian law of December 27, 1961, modifying the term fixed by article 1 of Law no. 1421 of December 19, 1956 on extension of duration of copyright protection by substituting December 31, 1962 for December 31, 1961.

255. SWEDEN. *Laws, statutes, etc.*

Décret royal en application des lois du 30 décembre 1960 (nos 729 et 730) relatives au droit d'auteur sur les oeuvres littéraires et

artistiques et au droit sur les images photographiques; du 2 juin 1961. (Recueil des lois de Suède, 1961, n° 348, édité le 26 juin 1961). *Le Droit d'Auteur*, vol. 75, no. 3 (Mar. 1962), pp. 47-48.

An official French translation of the Royal decree of June 2, 1961, implementing the new Swedish copyright laws. The decree prescribes the conditions under which, without consent of the author (1) certain archival institutions and libraries may make photographic reproductions of copyrighted works; (2) certain libraries and organizations may make sound recordings of published literary works to be used for loans to blind and other seriously disabled persons; and (3) a radio and television organization may, for use in its own broadcast, record a work on instruments by which it can be reproduced. In addition, certain cultural organizations are empowered to institute judicial actions to enjoin the public use of works "detrimental to civilization and spiritual values."

256. SWEDEN. *Laws, statutes, etc.*

Décret royal relatif au Fonds des écrivains de Suède, du 17 juin 1955, modifié par les décrets royaux du 8 novembre 1957, du 30 avril 1959 et du 2 juin 1961. (Recueil des lois de Suède, 1955, n° 464; 1957, n° 597; 1959, n° 138; 1961, n° 296). *Le Droit d'Auteur*, vol. 75, no. 3 (Mar. 1962), pp. 49-50.

An official French translation of the Royal decree of June 17, 1955 concerning the Swedish Authors' Fund, as amended up to June 2, 1961. Under its provisions, sums of money are to be paid into the Fund by the State, the amount to be determined by the extent of the circulation, or other uses, by departmental public and state-supported school libraries, of Swedish books under copyright. Part of the money is to be paid directly to authors and translators—the amount to be determined by the frequency of use—and the rest to be used for pensions, prizes, welfare funds, scholarships, etc.

PART IV.

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

257. *Labr v. Adell Chemical Co.*, 300 F. 2d 256, 132 U.S.P.Q. 663 (1st Cir., Mar. 12, 1962) (Aldrich, J.). *For decision below, see* 195 F. Supp. 702, 9 BULL. CR. SOC. 91, Item No. 24 (D. Mass., 1961).

Action for invasion of privacy, defamation and unfair competition. Bert Lahr charges that defendant, in advertising "Lestoil", used as the voice of a duck in a television commercial "an actor who specializes in imitating" the unique and readily recognizable voice and delivery of plaintiff, and that those who saw the commercial believed they were hearing Lahr. The court below dismissed the complaint on the ground that plaintiff had made no showing of any applicable law under which this "label-less, anonymous tort" constituted an actionable wrong. Appealing from this dismissal, the plaintiff contends that he has alleged three causes of action—for unfair competition, invasion of privacy and defamation.

Held, reversed.

I. *Invasion of Privacy*: Plaintiff having agreed that only the law of Massachusetts and New York need be considered for purposes of this appeal, the court found that no sufficient claim for invasion of privacy was pleaded under the law of either state. The court said:

"The Massachusetts court has avoided recognizing such a right. *Kelley v. Post Publishing Co.*, 1951, 327 Mass. 275, 98 N.E.2d 286; *Themo v. New England Newspaper Pub. Co.*, 1940, 306 Mass. 54, 27 N.E.2d 753. . . . Any rights resulting from the special New York statute, sometimes called the right of privacy statute, flow from the use, for commercial purposes, of a party's 'name, portrait or picture.' New York Civil Rights Law, McKinney's Consol. Laws, c. 6 §§50 and 51. Plaintiff's claim here, at best, is that though the picture was that of a duck, the voice was the

'name,' which he enlarges to 'identity,' of the plaintiff. The statute is very specific. If the legislature intended that whenever an anonymous speaker extolled a commercial product a cause of action arose (and criminal penalties could be imposed) if anyone could claim the voice was mistaken as his, it should have used a phrase of more general import. In the absence of any New York authority, 'name' can be given no such catholic connotation."

II. *Defamation*: The court held, however, that with respect to defamation a claim had been stated. The court noted that it need not determine whether broadcasting a tape-recording is libel or slander since, as "the injury alleged was to plaintiff's professional reputation, it makes no difference," and went on to say with respect to plaintiff's allegation that the public was led to believe that plaintiff was reduced to giving anonymous television commercials, that:

"A charge that an entertainer has stooped to perform below his class may be found to damage his reputation. *Louka v. Park Entertainments, Inc.*, 1936, 294 Mass. 268, 1 N.E.2d 41; *Sim v. H. J. Heinz Co., Ltd.*, (C.A.) [1959] 1 W.L.R. 313, *semble*. Plaintiff's allegations in this respect are not insufficient. Whether audible identification was enough in a field where imitation is easy, and perhaps properly suspect, is a matter we do not wish to decide upon the bare allegations of a complaint. But it has never been held in defamation that a plaintiff must be identified by name. *Louka v. Park Entertainments, Inc.*, *supra*; *Robinson v. Coulter*, 1913, 215 Mass. 566, 102 N.E. 938; *Kern v. News Syndicate Co.*, 1958, 6 A.D.2d 404, 178 N.Y.S.2d 274."

The court stated that plaintiff's charge that the imitation damaged his reputation because it was inferior to his own delivery raised "a more doubtful question." The court said:

"Even entertainers who make no claim to uniqueness have distinctive vocal characteristics and may be thought to be recognized. If every time one can allege, 'Your (anonymous) commercial sounded like me, but not so good,' and contend the public believed, in spite of the variance, that it was he, and at the same time believed, because of the variance, that his abilities had declined, the possibilities would be too great to contemplate. Occasional disparagement of entertainers is the commonly accepted lot. Furthermore, there is no absolute test of excellence in dramatic performance. If what was attributed to the plaintiff was so manifestly inferior as to constitute actionable defamation, see, e.g., *Ben-Oliel*

v. Press Pub. Co., 1929, 251 N.Y. 250, 167 N.E. 432, we hold he must be able to point to some identification with himself more specific than the remaining similarities. We know of no case which gives a plaintiff such liberty to put a cap on and at the same time say it does not fit."

III. *Unfair Competition*: It was held that the complaint sufficiently alleged unfair competition in that the "duck's" voice was passed off as plaintiff's. The court stated:

"The defendant obscures the issue by arguing at length that imitation is not unfair competition. This may indeed be true, if there is no confusion of source. Cf. Chappell & Co. v. Fields, 2 Cir., 1914, 210 F. 864; Cheney Bros. v. Doris Silk Corp., 2 Cir., 1929, 35 F. 2d 279, cert. den. 281 U.S. 728, 50 S. Ct. 245, 74 L. Ed. 1145. But plaintiff here is not complaining of imitation in the sense of simply copying his material or his ideas, but of causing a mistake in identity. Such passing off is the basic offense. True, it was not defendant's product that was offered in competition, but that of the anonymous imposter whom defendant, for its benefit, subsidized. This is a distinction without a difference. Plaintiff's complaint is that defendant is 'stealing his thunder' in the direct sense; that defendant's commercial had greater value because its audience believed it was listening to him. In the light of plaintiff's allegations we could not say there was no such enhancement.

Furthermore, we can hardly agree with defendant that 'there is no competitive interest or purpose served * * * and no real confusion of product which would lead to the appellant's loss of opportunity in the entertainment field.' It could well be found that defendant's conduct saturated plaintiff's audience to the point of curtailing his market. No performer has an unlimited demand. We may agree with defendant that plaintiff has not shown any 'property' interest entitled to copyright protection. And we might hesitate to say that an ordinary singer whose voice, deliberately or otherwise, sounded sufficiently like another to cause confusion was not free to do so. Plaintiff here alleges a peculiar style and type of performance, unique in a far broader sense. . . . We think plaintiff's adjectival allegations should be tested in the crucible."

IV. The court did not decide whether, because of the single publication rule, the action may be barred by the statute of limitations. The court said:

"The complaint alleges that the offending activities occurred 'since the beginning of December 1958.' In Massachusetts the ordinary tort period of limitations is two years; for libel it is one year. Mass. G.L. c. 260, 2A, 4. The action was not commenced until January 1961. It does not appear for how long a period the duck trespassed on plaintiff's reputation. Defendant, relying on the single publication rule, asserts that plaintiff's rights became barred by December 1960. This rule is normally applicable to continued sales and new editions of a single literary work. See, e.g., *Dale System, Inc. v. Time, Inc.*, D.C. Conn., 1953, 116 F. Supp. 527; Uniform Single Publication Act (1952). . . . Whether the single publication rule should be applied to the circumstances of this case had best be decided when we know what they were. A fortiori, we will decide nothing about laches in respect to unfair competition."

258. *Arnold Productions, Inc. v. Favorite Films Corp.*, 298 F. 2d 540, 133 U.S.P.Q. 56 (2d Cir., Feb. 6, 1962) (Lumbard, C.J.).

Action for breach of distribution contract. Plaintiff, owner of two motion pictures, "Hangmen Also Die" and "It Happened Tomorrow," made a distribution agreement with defendant Favorite Films whereby the latter acquired an exclusive license to exploit the films "for reissue purposes" and for television for a period of seven years. The contract was personal and non-assignable by its terms, and contained a covenant by Favorite to "use its best efforts" to obtain as many bookings for the two films as possible. Favorite sub-licensed the television distribution to co-defendant Nationwide Television Corp., which in turn delegated the actual booking operation to a subsidiary. Plaintiff contends that Favorite breached its contract by delegating the television distribution instead of handling such distribution itself, and objects to the block-selling of the two films in packages which include motion pictures owned by others, alleging that this is not the most remunerative method of distribution.

Held, judgment for defendants on issue of breach of contract affirmed; judgment for plaintiff granting limited accounting under the distribution contract also affirmed.

I. The court found "no error" in the holding below that "Favorite did not assign the contract to Nationwide or abandon its duties under it, and thus committed no breach." Said the court:

"Favorite did not purport to divest itself of its ultimate responsibility to Arnold. Although it made Nationwide its 'sole and exclusive agent' it maintained certain supervisory powers over it. . . . Thus there was no breach of the specific covenant against assignment. Rather the question is whether the delegation of performance deprived Arnold of any right to Favorite's own services which it may have acquired explicitly from the provision that 'this agreement is personal' or implicitly from the 'best efforts' clause and the inherent nature of the contract."

The court stated that even if New York would impose the same implied duty of personal service upon a contracting corporation as on an individual, or if the explicit terms of the contract gave Arnold the right to demand Favorite's personal services in the performance of the contract "this performance" did not "exclude such use of Nationwide's services as Favorite made" in light of "the practices of the business in which the parties were engaged, and especially . . . the general understanding and course of dealings between them." That the duties of Favorite with respect to theatrical reissue of the films and with respect to television were the same, and that the contract contemplated that most of the theatrical distribution was to be delegated to various "franchise holders" throughout the country and was not to be handled by Favorite directly, foreclosed any inference, the court held, that Favorite's employees were expected to do all television distribution personally.

II. With respect to plaintiff's objections to the inclusion of its films in "packages" sold as units, the court saw "no reason to upset Judge Murphy's finding of fact that there was no proof that individual promotion would have been more profitable or his alternative finding that in any event the claimed injury was not shown with sufficient definiteness to permit any calculation of damages, cf. *Broadway Photoplay Co. v. World Film Corp.*, 225 N.Y. 104, 121 N.E. 756 (1919)."

III. Plaintiff sought an accounting for all receipts from the films during the entire period of its contractual relationship with defendant instead of an accounting for the period since the last prior accounting only. The court held that even the limited accounting allowed below was unjustified, but allowed it to stand because Favorite made no objection. The court said, quoting from *Terner v. Glickstein & Terner, Inc.*, 283 N.Y. 299, 28 N.E.2d 846 (1940):

"Even though an accounting were required to ascertain the amount of damages, that fact would be insufficient to support a

claim for equitable relief unless a fiduciary relationship were shown . . ."

259. *Ideal Toy Corp. v. Sayco Doll Corp.*, 302 F. 2d 623, 133 U.S.P.Q. 104 (2d Cir., April 3, 1962) (Hincks, J.).

Action for copyright infringement. Plaintiff alleges that defendant's "Chubby Toddler" doll is an infringing copy of its "Saucy Walker" doll. A preliminary injunction was granted on December 15, 1960 by Judge Dimock in the Southern District of New York. In his unreported opinion, Judge Dimock held that "A visual comparison between copies of plaintiff's SAUCY WALKER doll and defendant's CHUBBY TODDLER doll establishes that the head of defendant's doll incorporates so many distinctive features and characteristics of the head of plaintiff's doll as to lead to the conclusion prima facie that defendant's doll head was copied from plaintiff's." Defendant commenced an appeal to the Second Circuit, and thereafter moved to vacate the injunction on the ground that an uncopyrighted doll, introduced into evidence at the time of the motion, which antedated both plaintiff's and defendant's doll, was much more like defendant's doll than was plaintiff's, thus establishing that plaintiff did not have a valid copyright which had been infringed by defendant. Judge Bryan denied the motion on the ground that he had no jurisdiction to grant it because the introduction of new evidence was not proper at this stage of the proceedings. Defendant's appeals from both orders are here considered.

Held, affirmed.

I. It was held that the granting of the preliminary injunction was not an abuse of discretion. The court said that "Judge Dimock's factual finding of similarity and probable copying, while not necessarily one we would make ourselves, certainly was not clearly erroneous."

II. It was held further that on the motion to vacate the preliminary injunction, Judge Bryan did not have jurisdiction to grant the relief prayed for because the order sought to be vacated was before the Circuit Court on appeal. Noting that a district court has complete power over its interlocutory orders absent an appeal, the court said:

"Once the appeal is taken . . . jurisdiction passes to the appellate court. Thereafter the appellant is not usually entitled as of right to present new evidence or argument to the trial court, which in the exercise of a sound discretion will exercise jurisdiction only to preserve the status quo at the time of the appeal. Appellant's

proper procedure is then to request leave of the court of appeals to proceed in the lower court. He need not even dismiss his appeal, for we have always been ready to suspend proceedings while new matter was introduced below. . . . But absent permission of the appellate court to reopen, sound judicial administration demands that unless the judge is satisfied that his order was erroneous, he shall use his power under Rule 62(c) only to preserve the status of the case as it sits before the court of appeals. . . . Under the circumstances here we think Judge Bryan could not properly change the whole posture of the case on appeal by vacating Judge Dimock's injunction."

III. Judge Clark wrote a dissenting opinion in which he disagreed with the court both as to the procedural points involved and as to the propriety of deciding the issues on the basis of procedure alone. Judge Clark said:

"The opinion's concern solely with matters of procedure, including its retreat behind the assumed discretion of the trier, serves to mask the fact that here is being sustained a monopoly of unique and disturbing character. True, the subject matter—toy dolls—is not extensive; but the holding makes up in depth what it may want in extent. In the American concern for free competition, I know of no limitation because of the comparatively limited nature of the field involved. So our first question—one not directly considered in the opinion—must be whether the plaintiff has brought its product within the coverage of a statutory exception permitting a temporary monopoly, here that of copyright. My brothers' reliance upon trial court discretion is therefore definitely out of place on the basic issue whether or not the plaintiff has a proprietary right requiring protection against this defendant. For we have reiterated . . . that the question of legal right of a plaintiff must be reviewed on appeal from the grant of a preliminary injunction; and such right cannot be accepted as a mere matter of trial discretion. . . .

Thus, looking at fundamentals, I am convinced that the injunction was improvidently granted. For what the plaintiff could not get under the patent law . . . it has succeeded in getting in three-to-fivefold measure under the copyright law. . . . (I)t is obvious that the plaintiff's most natural appeal would be for a design patent giving a monopoly for different periods up to a maximum of fourteen years for a 'new, original and ornamental

design for an article of manufacture' 35 U.S.C. §§171, 172. But it is well known that manufacturers have been disappointed in this law, since almost no design patents have stood up in the courts, facing as they do the twin barriers of a showing of novel design and of infringement. . . . So with the Supreme Court's recent rulings upholding copyright on many articles beyond writings, there has been a shift to seek protection under the copyright laws. . . . Thus it is possible that a plaintiff may secure a 56-year monopoly by way of copyright *in an appropriate case*.

But . . . it cannot be that a plaintiff may secure a monopoly held unavailing under the patent laws by the mere device of a change of label by seeking copyright protection under another arm of the federal government. For the latter to be granted there must be a showing of appropriation by plagiarism or copying. . . . Reproduction should be apparent on inspection and not be based upon a counting of similarities which do not constitute or leave a total impression of copying. Compare *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 2 Cir., 274 F. 2d 487, 124 USPQ 154."

Judge Clark did not find that the two dolls were sufficiently similar to show plagiarism. With respect to the alleged specific similarities, he said:

"But is it so that one gets a 56-year copyright in normal arms and legs of a doll or in a hidden smile? This gives plaintiff a destructive power against competitors of unexplored extent. For a grin or a smirk in their otherwise dissimilar product may turn out to make them accountable as infringers."

The dissent also states that even accepting the idea, as Judge Clark does not, that Judge Bryan's authority below was limited to preserving the status quo, he could have vacated the injunction and should have done so. Judge Clark said:

"The injunction preserves what the court believes to be the lawful situation. Thus if for any reason the court were to change its estimation of the validity of plaintiff's case, its estimation of the *lawful* status quo would also change. In such a situation, dissolving the preliminary injunction would be the proper way to maintain the correct state of affairs."

260. *Prestige Floral v. Zunino-Altman, Inc.*, 203 F. Supp. 649, 133 U.S.P.Q. 75 (S.D.N.Y., Jan. 22, 1962) (Levet, J.), *aff'd* 301 F. 2d 286, 133 U.S.P.Q. 58 (2d Cir., Mar. 8, 1962) (*per curiam*).

Action for copyright infringement. Plaintiff, a French corporation which manufactures molded polyethylene flowers, is the "author and proprietor" of a "cactus dahlia" for which it has secured copyright registration as an original work of art. Defendant is charged with importing from Hong-Kong inferior copies of plaintiff's flower. Plaintiff moved for a preliminary injunction against distribution of defendant's imported flowers, and defendant cross-moved to have a temporary restraining order vacated.

Held, preliminary injunction denied; temporary restraining order vacated.

A. In the District Court:

It was held that plaintiff was not entitled to a preliminary injunction because it did not make the necessary showing of infringement. The court said:

"There is nothing novel in reproducing flowers in polyethylene and plaintiff does not here urge that its copyright prohibits the defendant from reproducing dahlias. It is the eminently logical view, and one which is not in dispute herein, that a copyright does not protect the dahlia itself but merely the creator's impression, treatment or reproduction of the object copyrighted." (See *Prestige Floral v. California Artificial Flower Co.*, 132 U.S.P.Q. 350, 353, 9 Bull. Cr. Soc. 254, Item No. 153 (S.D.N.Y. 1962).

. . . Visual observation of the plaintiff's dahlia and the defendant's dahlia indicate certain readily apparent differences. The defendant's dahlia has petals arranged in a ragged design and these petals face in an upward direction. The plaintiff's dahlia has petals which are arranged in a 'star-like' evenly-spaced pattern and these petals face in an outward direction. These differences standing alone appear to result in significantly different aesthetic effects. There are, however, other peculiar differences between the two flowers. . . .

It is arguable that none of these differences when taken alone would be conclusive in establishing that there has been no copying. However, when taken together the result is that the plaintiff's dahlia and the defendant's dahlia create different impressions on the court in its role as an inexperienced observer. . . .

It cannot be, and, indeed, it is not advanced that the defendant's dahlia is not similar to the plaintiff's dahlia. In the final analysis, in order to sell a reproduction as a dahlia it must resemble the natural flower as it exists in its natural state.

The fact that plaintiff asserts that defendant's dahlia is causing it to lose customers and sales cannot be determinative of the issues here. Any competitive product will normally have some effect on the sales of others and, as indicated above, a copyright on a reproduction of a natural object does not foreclose others from copying that natural object also. In point of fact, both sides concede that defendant's reproduction is inferior to plaintiff's in many respects and, therefore, competition between the products insofar as quality is concerned is non-existent."

II. In view of its holding that there had been no copying, the court found it "unnecessary to reach" the question of the validity of plaintiff's copyright, which had been challenged by defendant.

B. In the Court of Appeals:

The Second Circuit affirmed the "reasoned opinion" of the District Court, being "unpersuaded that in the posture of the case before the District Judge the plaintiff made the prima facie showing required of it to obtain a preliminary injunction."

261. *Royalty Designs, Inc. v. Thrifticheck Service Corp.*, 204 F. Supp. 702, 133 U.S.P.Q. 148 (S.D.N.Y., Feb. 15, 1962) (Bryan, J.).

In action for copyright infringement, motion for preliminary injunction. Plaintiff has copyright registrations for two plastic toy coin banks in the shape of dogs, one a boxer and the other a cocker spaniel. The copyright notice in each case is stamped on a metal plug which fits into the bottom of the bank. Plaintiff alleges that defendant's similar toy banks are copied from its copyrighted banks, and seeks an injunction restraining defendant from further copyright infringement and from further distribution and sale of defendant's banks.

Held, preliminary injunction granted.

Defendant did not deny that its banks were copied from plaintiff's, but resisted the application for injunction on two grounds. It alleged that the copyright notice was not properly affixed to the banks and that the plaintiff had failed to show that irreparable injury would result if the preliminary injunction were not granted.

I. It was held that a showing of irreparable injury was not required for the issuance of a preliminary injunction. The court said:

"If Royalty has valid copyrights which have not been lost by failure to affix proper notice as required by 17 U.S.C. §§10 and 19,

then it is entitled to a preliminary injunction on a finding that defendant has infringed without a detailed showing of irreparable injury. See, e.g., *Joshua Meier Co. v. Albany Novelty Manufacturing Co.*, 236 F. 2d 144, 111 USPQ 197 (2 Cir. 1956); *Rushton v. Vitale*, 218 F. 2d 434, 104 USPQ 158 (2 Cir. 1955); *Cortley Fabrics Co. v. Slifka*, 175 F. Supp. 66, 122 USPQ 321 (S.D.N.Y. 1959); *Scarves by Vera v. United Merchants & Manufacturers*, 173 F. Supp. 625, 121 USPQ 578 (S.D.N.Y. 1959).

II. Holding that "there is no doubt that copyright protection extends to Royalty's designs as productions of originality and novelty," the court stated:

"Royalty does not claim rights to all toy banks in the form of Boxer and Cocker Spaniel Dogs. Its copyrights are for the particular novel and original renditions created and designed by it, which are legitimate subjects of copyright registrations. Royalty by its treatment of the subjects has contributed something recognizably its own which is by no means trivial. See *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F. 2d 99, 90 USPQ 153 (2 Cir. 1951); *F. W. Woolworth Co. v. Contemporary Arts*, 193 F. 2d 162, 92 USPQ 4 (1 Cir. 1951), *aff'd* 344 U.S. 228, 95 USPQ 396."

III. The copyright notice on metal discs inserted into the bottom of the toy banks was held to be valid and effective. The court said:

"Though the discs themselves are not copyrighted, they are an integral part of the banks. Money is inserted into the bank through a slit in the top of the dog's head. A circular hole . . . is molded into the bottom of the bank itself. The disc, which is marked clearly with Royalty's name, place of origin and notice of copyright, fits securely into the hole and prevents coins from falling out of the bank. . . . The disc is firmly attached and is an essential part of the bank, and without it the product would not serve its purpose. The banks are sold with the disc securely inserted and it is so placed as to give adequate notice to anyone seeking to copy the article of the existence of the copyright. This method of affixing the notice amply satisfied the requirement of 17 U.S.C. §§10 and 19. See, e.g., *Coventry Ware v. Reliance Picture Frames Co.*, 288 F. 2d 193, 129 USPQ 83 (2 Cir. 1961), *cert. den.* 368 U.S. 818, 131 USPQ 499; *Peter Pan Fabrics v. Martin Weiner Corp.*, 274 F. 2d 487, 124 USPQ 154 (2 Cir. 1960); *Boucher v. Du Boyes*, 253 F. 2d 948, 117 USPQ 156 (2 Cir. 1958), *cert. den.* 357 U.S. 936, 117 USPQ 497."

262. *B & B Auto Supply, Inc. v. Plessner*, 133 U.S.P.Q. 247 (S.D.N.Y., Feb. 23, 1962) (Cooper, J.).

Action for copyright infringement. Plaintiff sells automobile parts and accessories, largely through a catalog which it revises and brings up to date every six months. Defendant, who is in the general exporting business, selling a wide variety of merchandise, prepared an automobile parts and accessories catalog of his own, with a cover page bearing his trade name, by "pasting the text and illustrations from B & B's Catalog No. 142 onto layout sheets, which were then reproduced, through the photo-offset method, by defendant's printer." Defendant does not deny the copying, but attacks the validity of plaintiff's copyright.

Held, judgment for plaintiff.

I. Defendant argued that plaintiff's copyright in its catalog had been forfeited because it was also published by "Denmay Merchandising Company," a trade name which B & B used, and by "Major Products, Inc." a corporation owned and controlled by the same persons who owned and managed B & B, in each case with such other company being listed as the copyright proprietor instead of B & B. It was held, however, that although neither "Denmay" nor "Major Products" was an assignee of the copyright, the notices in such names did not cause a forfeiture. The court said:

"(T)he underlying purpose of the notice requirement is to prevent innocent persons who are unaware of the existence of the copyright from incurring penalties for making use of the copyright work. See, e.g., *National Comics Publications, Inc. v. Fawcett Publications, Inc. et al.*, 191 F. 2d 594, 602, 90 USPQ 274, 280 (2nd Cir., 1951)."

Noting that this defendant could not have been prejudiced by the additional publications with the notices in the names of the other companies because he did see the notice in the name of B & B, and was not shown to have been aware of the other publications, the court went on:

"(T)he publication of the catalog by B & B with such notices, under the facts and circumstances of this case (did not) amount to a forfeiture of B & B's copyright. Here, each of such companies constituted merely an alter ego of B & B, with the same officers, directors and shareholders as B & B. The fact that the catalog was also published with a notice of copyright naming each of such companies as the copyright proprietor is not fatal . . .

where, as in this case, the companies were identical to the actual copyright proprietor from the standpoint of ownership and control.

This is in accord with the fundamental rationale and purpose behind the statute. As the Court of Appeals in this Circuit has noted, a 'reasonable construction of the statutory requirement shows that the name of the copyright proprietor is sufficient in form, if it gives notice of copyright to one who is looking for the truth and who desires to avoid infringement.' *Fleischer Studios, Inc. v. Freundlich*, 73 F. 2d 276, 277, 23 USPQ 295, 296 (2d Cir., 1934), cert. denied, 294 U.S. 717 (1935)." (See *National Comics Publications v. Fawcett Publications, Inc.*, 191 F. 2d 594, 603, 90 USPQ 274, 281 (2d Cir., 1951).

II. Defendant also contended that the copyright on B & B's catalog was void for defective notice, in that the catalog was derived from prior catalogs copyrighted before 1957, and the year given in the notice, 1957, was therefore an attempt to extend the copyright term. It was held, however, that the notice was entirely proper. The court said:

"[The copyright would be invalid] if the later work were merely a republication of a previously copyrighted catalog. Cf. *Ziegelheim v. Flohr*, 119 F. Supp. 324, 327, 100 USPQ 189, 191 (S.D. N.Y., 1954). However, here, Catalog No. 142 is manifestly not an instance of such republication of the same work at a later date. On the contrary, Catalog No. 142 contains numerous new illustrations and a multitude of significant changes in text, as well as changes in data arrangement and format. The Court finds, after comparison, that these changes are substantial and sufficient to constitute Catalog No. 142 a 'new work' subject to copyright under the provisions of 17 U.S.C.A. See *West Publishing Co. v. Edward Thompson Co.*, 176 F. 833, 837 (2d Cir., 1910); *Markham v. A. E. Borden Co.*, 108 F. Supp. 695, 704, 95 USPQ 313, 319 (D.C. Mass., 1952), rev'd on other grounds, 206 F. 2d 199, 98 USPQ 346 (1st Cir. 1953)."

263. *Orgel v. Clark Boardman Co.*, 301 F. 2d 119, 133 U.S.P.Q. 94 (2d Cir., Mar. 27, 1962) (Smith, J.). *For decisions below, see* 128 U.S.P.Q. 520, 530 (S.D.N.Y. 1960), also reported at 8 BULL. CR. SOC. 188, Item No. 144 (1961).

Appeal from judgment for plaintiff in action for copyright infringement. The section on valuation in defendant's "Jahr on Eminent

Domain—Valuation and Procedure” was found below to have been copied from plaintiff’s “Orgel on Valuation Under Eminent Domain.” Because the valuation section constituted 35% of defendant’s book a special master recommended an award to plaintiff of 35% of defendant’s profits, plus damages of \$7,000.00 and counsel fees of \$10,000.00. This recommendation was objected to by the parties and Judge Dimock rejected it, awarding instead all of the defendant’s profits, \$12,849.32. He disallowed the \$7,000.00 additional damages and allowed the award of counsel fees to stand.

Held, modified and affirmed. Plaintiff’s award was reduced to 50% of the profits, and the counsel fees reduced to \$5,000.00.

I. The court agreed with the holding of the District Court on the issue of plagiarism. The court said:

“Although Jahr has in some instances brought Orgel up to date . . . and has added or substituted in a number of places recent New York condemnation cases, it appears to this court that the essence of Orgel was ‘lifted’ by Jahr, and while he did not confine himself entirely to Orgel, he did adopt as his own, Orgel’s analysis, organization of material, phrasing and citations without any credit to Orgel as to most of the portions appropriated. While any two books treating the same subject, particularly in the field of law where words and phrases are often terms of art, and based upon common sources are bound to contain a large measure of innocent similarity, we think the portion of Jahr’s book dealing with valuation is so strikingly similar to plaintiff Orgel’s work that even the most indiscriminating reader would be forced to conclude that defendant Jahr did little more than edit and bring up to date plaintiff Orgel’s work. Defendant’s book is merely a ‘colorable variation,’ *Edward Thompson Co. v. American Law Book Co.*, 176 F. 922, 923 (2d Cir. 1903).

II. Defendants argued that the award of all of their profits on their book to plaintiff was “contrary to law”, since it was conceded that only 35% of the book dealt with the law of valuation under eminent domain. On the basis of the fact that the plagiarized portion was only 35% of defendant’s book, but was the single most important section, the court determined that 50% of the profits would be an appropriate award. The court said:

"While we appreciate the fact that defendants have failed to show with any certainty the portion of the sales attributable to the plagiarized portion, we cannot agree with the conclusion of the district court that therefore all of the profits should be awarded to the plaintiffs. In cases such as this where the infringer's profits are not entirely due to the infringement, and the evidence suggests some division which may rationally be used as a springboard, it is the duty of the court to make some apportionment."

Quoting from *Sheldon v. Metro-Goldwyn Pictures Corp.*, 106 F. 2d 45, 51, 42 U.S.P.Q. 540, 544 (2d Cir. 1939) (L. Hand, J.), the court went on:

"(W)e are resolved to avoid the one certainly unjust course of giving [to] the plaintiffs everything because the defendants cannot with certainty compute their own share. In cases where plaintiffs fail to prove their damages exactly, we often make the best estimate we can, even if it is really no more than a guess (*Pieczonka v. Pullman Co.*, 2 Cir., 102 F. 2d 432, 434), and under the guise of resolving all doubts against the defendants we will not deny the one fact that stands undoubted. . . . However . . . the defendants must be content to accept much of the embarrassment resulting from mingling the plaintiff's property with their own. . . . (W)e must make an award which by no possibility shall be too small. It is not our best guess that must prevail, but a figure [that] will favor the plaintiffs in every reasonable chance of error."

The court noted that the cases of *Belford, Clarke & Co. v. Scribner*, 144 U.S. 488, (1892), and *Callaghan v. Myers*, 128 U.S. 617 (1888) have been narrowly limited and have no application "where it is clear that all the profits are not due to the use of the copyrighted material, and the evidence is sufficient to provide a fair basis of division." *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U.S. 390, 402, 44 U.S.P.Q. 607, 611 (1940), affirming 106 F. 2d 45, 42 U.S.P.Q. 540 (2d Cir. 1939).

In concluding that 50% of the profits was an appropriate award to plaintiff, the court indicated that while expert testimony would have been useful, it was not necessary here, stating that: "in dealing with material such as we have here, designed primarily for use of bench and bar in legal contest, a reasonable estimate of the relative contribution of the plagiarized material may be made on the record before us."

III. The attorney's fees awarded by the court below were considered excessive and were reduced. The court said:

"The award of attorneys' fees is discretionary with the court. . . . Since such a provision for attorneys' fees is at variance with the usual practice in litigation before our courts, however, it has been sparingly used and the amounts awarded modest. . . . In the case at bar, while a substantial amount of time was spent by plaintiffs' counsel, much of it was necessitated by counsel's unfamiliarity with the field. Considering, as we must, the amount of work necessary, the amount of work done, the skill employed, the monetary amount involved and the result achieved, we feel that \$10,000 is more than a liberal allowance and order the amount of attorney's fees reduced to \$5,000."

264. *Tobias v. Joy Music, Inc.*, 204 F. Supp. 556, 133 U.S.P.Q. 181 (S.D.N.Y., Mar. 6, 1962) (Cooper, J.).

Action for declaratory judgment to determine the ownership of the copyright renewal in the song, "Miss You." In 1929 the authors assigned this song, together with "all copyrights and the rights to secure copyrights and extensions and renewals of the copyrights" to a publisher, and copyright registration was secured in that year. In 1956, during the 28th year of the term, first the authors and then the defendant (the original assignee's successor in interest) applied for and received registration of their applications for copyright renewal. The authors and a personally owned corporation to which they have assigned their interest in the renewal sue for a judgment declaring that they, and not the publisher, own the renewal rights. Defendant crossclaims for judgment declaring that it is the owner of the renewal.

Held, judgment for defendant.

I. The plaintiffs' contention that the 1929 agreement under which defendant claims does not carry renewal rights was summarily rejected by the court, which said:

"That the 1929 agreement in this case effectively conveyed renewal rights to the publisher-defendant can hardly be doubted. By that agreement, the authors plainly assigned to the publisher certain of their rights in the song, including, among others, all rights to the original copyright and the expectancy in the renewal copyright. Cf. *Rose v. Bourne, Inc.*, 279 F. 2d 79, 125 USPQ

509 (1960), cert. denied, 364 U.S. 880, 127 USPQ 555 (1960); *Rossiter v. Vogel*, 134 F. 2d 908, 57 USPQ 161 (2nd Cir., 1943).

It is well settled that prior to the statutory renewal period an author's interest in renewal rights is only an expectancy, which can be defeated in the event of his death before the commencement of that renewal period. *Miller Music Corp. v. Charles N. Daniels, Inc.*, 362 U.S. 373, 125 USPQ 147 (1960); 17 U.S.C. §24. In this sense the expectancy of the renewal of the copyright is like the interest of one who is entitled to a remainder after a term of years provided he outlives the term. It remains equally clear, however, that the author can effectively assign such an expectancy; and if he is still living at the commencement of the renewal period, the expectancy then vests in his assignee. *Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643, 57 USPQ 50 (1943). Here, the renewal period began on March 22, 1956; and since it is apparent that all three authors were alive on that date, the right to renewal thereupon vested in the assignee under the terms of the contract."

II. Plaintiffs argued that even if the 1929 agreement gave defendants the right to apply for copyright renewal, it provides no basis for defendant's application for such renewal in the name of the authors. This argument was also rejected. The court said:

"(T)he exercise of the assignee's renewal right is in no sense contingent upon the assistance of the authors. It is true, of course, that under the statute and the rules of the Copyright Office an application for renewal must be made in the *name* of the author. 17 U.S.C. §24, 37 C.F.R. 202.17(b). However, the assignment of the expectancy itself implies a power of attorney in the assignee to apply for such renewal in the author's name. *Rose v. Bourne, Inc.*, 176 F. Supp. 605, 610, 123 USPQ 29, 32 (S.D.N.Y. 1959), *aff'd* 279 F. 2d 79, 125 USPQ 509 (2nd Cir. 1960), cert. denied, 364 U.S. 880, 127 USPQ 555 (1960); *Rossiter v. Vogel*, 134 F. 2d 908, 911, 57 USPQ 161, 163 (2nd Cir. 1943)."

II. The court found that the plaintiffs had failed to prove their contention that the consideration paid them for the song was inadequate, since the royalty rate provided for in the 1929 contract was shown by defendant to have been "quite usual in the music business at that time." The court said:

"Plaintiffs . . . sought to show that the consideration had subsequently become inadequate as a result of changes in the business which were un contemplated at the time of the original bargain.

Essentially, these changes relate to certain higher standard royalties which came to be used in the business only many years after the parties had entered into their March 21, 1929 agreement. As this court noted in *Rose v. Bourne, Inc.*, supra, however, inadequacy of consideration which results from a subsequent event does not render the transaction voidable if the consideration was adequate at the time of the transfer."

IV. It was further held that "in view of the clear and settled nature of the authorities governing the issues, reasonable counsel fees will be allowed" to the defendant.

265. *C. S. Hammond & Co. v. International College Globe, Inc.* (S.D.N.Y., Mar. 30, 1962) (McGohey, J.) (Not yet reported.).

Plaintiff holds a copyright registration for "Hammond's International Globe," an inflatable plastic globe map of the world. Plaintiff did no original field surveying for this map. Its source material is its extensive library of maps and geographical data, kept constantly up to date by communications with government agencies, etc. Its editors, generally trained in geography or cartography, using this source material, select a base map from their files, and then make the necessary decisions as to inclusion or exclusion of various place names and geographical features. New drawings are then prepared by map draftsmen in accordance with these decisions. A drawing was made for each of the twelve elliptical gores of which this globe consists. It is charged that defendants' inflatable plastic globe map, variously sold as "International College Globe" and "Ideal School Globe" contains copyrighted material copied from plaintiff's globe, and that the name and general appearance of defendant's product are so similar to plaintiff's as to cause confusion, thus constituting unfair competition.

Held, judgment for defendants.

I. The court held that plaintiff had a valid copyright in "Hammond's International Globe." It said:

"The Copyright Act specifically recognizes maps as copyrightable material, 17 U.S.C. section 5(f), but, as with all such materials, they are subject to the requirement of originality. However, since the physical facts to be portrayed, and in most cases some actual portrayal of them, are already in the public domain, originality cannot mean novelty. A copy of something in the public domain will support a copyright if it is a 'distinguishable variation.' *Alfred Bell & Co. v. Catalda Fine Arts*, 2 Cir., 191 F. 2d 99, 102,

quoting *Gerlach-Barklow Co. v. Morris & Bendien*, 2 Cir., 23 F. 2d 159, 161. 'Originality in this concept means little more than a prohibition of actual copying. No matter how poor artistically the author's addition, it is enough if it be his own.' *Alfred Bell & Co. v. Catalda Fine Arts*, *supra*, at 103. 'The elements of the copyright consist in the selection, arrangement, and presentation of the component parts.' *General Drafting Co. v. Andrews*, 2 Cir., 37 F. 2d 54, 55. By the actual labor expended in laying out the map outlines on the grid drawings, and in the exercise of judgment in the selection, from a comparison of many sources, of place names to be shown, the plaintiff's cartographer clearly produced a work which owed its origin to its author."

II. The copyright was held not to include, however, certain airline routes which had appeared in Hammond's *Ambassador World Atlas* previously. The Atlas had been copyrighted as, apparently, a compilation, see *General Drafting Co. v. Andrews*, 37 F. 2d 54, with no prior copyright for the maps on which the airline routes appeared. Holding that this material was not copyrighted, the court said:

"It has been said that the copyright on a compilation 'protects all the matter embodied therein in which copyright is already subsisting.' Ball, *Law of Copyright and Literary Property* 105 (1944). But this means only that, because of the copyright on the compilation, no one can copy the old material *from that compilation*. It does not mean that one cannot go back to the source; that is protected only by the copyright on the original. The copyright on the compilation 'shall not * * * be construed to imply an exclusive right to such use of the original works' 17 U.S.C. section 7. 'Others are free to copy the original. They are not free to copy the copy.' *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 249."

III. As to the copyrighted material in plaintiff's globe, no copying was found. Pointing out that:

"The plaintiff does not claim that everything on the defendant's globe was copied from the plaintiff's globe. The claim is rather that in certain specified areas, the defendants have copied in substantially exact detail the plaintiff's selections of unusual town or area names, and the plaintiff's unusual omissions of important names, and even the plaintiff's errors."

the court went on to consider the specific allegations of copying in detail. On the whole, although there were many similarities in selection between plaintiff's and defendant's maps, there were also many differences, and

the similarities were often referable to earlier uncopyrighted sources available to both plaintiff and defendant. Except for the airline routes referred to above, concededly copied either from plaintiff's globe or from its Atlas, the court held that no copying was proved; and since the airline routes were held not to be protected by copyright, there was no infringement. Referring to the cartographer who had made the drawings for plaintiff's map, the court said:

"(H)is expression consists of the totality of his work; cartographic outlining, selection, and presentation, that is, the positioning, spelling, etc. of names. Kotschar did not copy Winslow's 'expression'."

IV. Plaintiff contended that defendants competed unfairly by "(1) duplicating the 'size and appearance' of the plaintiff's globe; (2) adopting the word 'International' as a part of their corporate name and a part of the name of their globe" causing actual confusion. Rejecting these contentions, the court said:

"Surely the plaintiff can have no monopoly on the 'size' of globes on which maps may be printed. The 'appearance' of all globes of approximately the same size will necessarily be the same except in so far as their colorings may vary. However, the range of color variety is, by custom, limited; especially in a cheap map produced for general use. Here the defendants have succeeded in making their globe distinguishable by its colorings from the plaintiff's. . . . Similarity of appearance is also predicated on the defendants' use of red as the color of the tube at each pole. This contention is rejected. The plaintiff has no protectible interest in such a common color. *Norwich Pharmacal Co. v. Sterling Drug, Inc.*, 2 Cir., 271 F. 2d 569, 573 (pink); *James Heddon's Sons v. Millsite Steel & Wire Works*, 35 F. Supp. 169, 174, aff'd, 6 Cir., 128 F. 2d 6, cert. denied, 317 U.S. 674 (1942) (red). The valves themselves, of course, are not non-functional features whose copying could give rise to a complaint. . . .

Of all the words which might be applied to a map, surely there would be few more descriptive than 'international.' Indeed the plaintiff's president so regarded it. He said it would be 'inappropriate' to use the word in the title of any map other than a world map, and that the plaintiff never did so. He conceded also that at least one other publisher of atlases used 'international' in their titles. I hold that the word 'international' as applied to world maps, globes, atlases, etc. has not acquired a secondary meaning indicating the plaintiff as the source of such publications."

266. *Burnett v. Lambino*, 204 F. Supp. 327, 133 U.S.P.Q. 325 (S.D.N.Y., Apr. 6, 1962) (Feinberg, J.).

Action for copyright infringement. Plaintiffs charge that the book and motion picture, "The Blackboard Jungle," infringes copyright in their plays "Shadows in the City" and "Hickory Stick", the latter being a rewritten version of "Shadows in the City." These plays, like "The Blackboard Jungle," deal with the problems of a New York City vocational high school teacher.

Held, judgment for defendants.

I. Defendants argued that when plaintiffs gave a number of copies of their plays to potential backers, this was a "general publication" and caused a forfeiture of their copyright. Holding that there had been a limited publication only, the court said:

"Restricted distribution to a circumscribed class of persons of an unpublished work, whether copyrighted under 17 U.S.C. §12 or uncopyrighted, for the purpose of raising interest in a possible sale or production, is a sufficiently limited distribution to work no forfeiture of an author's rights. *Hirshon v. United Artists Corp.*, 243 F. 2d 640, 644-645, 113 USPQ 110, 113 (D.C. Cir. 1957); *American Visuals Corp. v. Holland*, 239 F. 2d 740, 743, 111 USPQ 288, 290 (2 Cir. 1956); *Ilyin v. Avon Publications*, 144 F. Supp. 368, 373, 110 USPQ 356, 359 (S.D.N.Y. 1956)."

II. The court found, however, that although plaintiff's copyright was valid, it had not been infringed. It was not shown that Evan Hunter, author of "The Blackboard Jungle," had ever had access to plaintiff's plays, and the similarities alleged were not such as would prove copying even if access were shown. The court said:

"Hunter did not copy from plaintiffs. Any similarities between plaintiffs' plays and the novel and motion picture involve language that is insignificant or characters or plot ideas that are so general as to be uncopyrightable. It is true that all four works have similarities growing out of the vocational school background. Thus, in each work, there are idealistic teachers, cynical teachers, stupid students, intelligent students and unruly students and relationships between them. Such stock characters and situations are inherent in use of the school as background and are not copyrightable." *Nichols v. Universal Pictures Corp.*, 45 F. 2d 119, 122, 7 USPQ 84, 88 (2 Cir.), cert. denied 282 U.S. 902 (1930)." See *Rosen v. Loew's, Inc.*, 162 F. 2d 785, 788, 74 USPQ 196, 198-199 (2 Cir. 1947)

(burning of Jewish books and hostility of German students toward Jewish teachers in Nazi Germany); *Bein v. Warner Bros. Pictures, Inc.*, 105 F. 2d 969, 970, 42 USPQ 395, 396 (2 Cir. 1939) (life in a reform school); *MacDonald v. Du Maurier*, 75 F. Supp. 655, 660, 76 USPQ 290, 294 (S.D.N.Y. 1948) (second wife living in a home formerly occupied by her husband and his first wife); *Ruch v. Oursler*, 39 F. 2d 468, 5 USPQ 320 (S.D.N.Y. 1930) (murder in theater during a performance).

Considering such alleged similarities as the confusion at a teacher's first meeting with his class, a teacher forming an alliance with the class leader, discipline through physical punishments and a reference to bandleader Harry James, the court concluded that:

"(T)his action is based upon '* * * that obsessive conviction, so frequent among authors and composers, that all similarities between their works and any others which appear later must inevitably be ascribed to plagiarism.'" *Dellar v. Samuel Goldwyn, Inc.*, 150 F. 2d 612, 613, 66 USPQ 9, 10 (2d Cir.), cert. denied, 327 U.S. 790, 68 USPQ 462 (1945).

III. The court held that although Hunter was not found to have had access to plaintiffs' plays, their claim that MGM had independent access to them was credible, in that MGM admitted that the two plays had been submitted to the motion picture company. It was held, however, that "access alone without copying is insufficient to find infringement. *Arc Music Corp. v. Lee*, 296 F. 2d 186, 131 USPQ 338 (2 Cir. 1961)." Because there were no substantial similarities, no infringement was found.

The "similarities in play and movie, not in book" upon which plaintiffs relied to show independent copying by the motion picture company, including the "climactic device of indecision whether to quit teaching, the decision to quit, persuasion by others not to, and final decision to stay" and "students dancing at opening of scene" were described by the court as ranging "from the merely erroneous or noncopyrightable to the ridiculous."

267. *Dan Kasoff, Inc. v. Gresco Jewelry Co., Inc.*, 204 F. Supp. 694, 133 U.S.P.Q. 438, (S.D.N.Y., Apr. 30, 1962) (Bonsal, J.).

Action for copyright infringement and unfair competition. Plaintiff manufactures a small ornamental box, designed for holding rings or other small trinkets, which carries the copyright notice "Florenza ©,"

"Florenza" being plaintiff's trademark. Defendant is charged with copying plaintiff's box, and plaintiff seeks injunctive relief and damages.

Held, judgment for plaintiff.

I. Defendant argued that the trademark "Florenza" did not properly identify plaintiff as the copyright proprietor in the notice. The court held, however, that this was a sufficient identification. The court said:

"Plaintiff has used its trademark FLORENZA rather than "Dan Kasoff, Inc." to identify itself. The same issue was raised before Judge MacMahon of this Court in *Dan Kasoff, Inc. v. Novelty Jewelry Co., Inc.*, Miscellaneous No. 153-205, January 29, 1962. Judge MacMahon found the plaintiff had been using the trade name and trademark FLORENZA since February 20, 1956 and had extensively advertised it in various trade publications so that it became known in the trade as indicative of the plaintiff. It was held that the use of FLORENZA with a "c" in a circle following it was sufficient compliance with the Copyright Act. . . .

In the interpretation of §19 of the Copyright Act it has been held that 'any notice will serve which does in fact advise the public that there is a 'proprietor' who does claim copyright, provided the notice does not affirmatively mislead.' *National Comics Publ. v. Fawcett Publications*, 191 F. 2d 594, 602, 90 USPQ 274, 280 (2d Cir. 1951). In the same case the court went on to say "We are unwilling to allow a barefaced infringer to invoke an innocent deviation from the letter that could not in the slightest degree have prejudiced him or the public'. *National Comics* at 603, 90 USPQ at 28. I think it is obvious in the present case that the plaintiff has been sufficiently identified as the copyright owner."

II. It was held that plaintiff's ornamental box was not "a utilitarian object not subject to copyright protection." The court said:

"Plaintiff's boutique was accepted for copyright under 17 U.S.C. §5(g) which provides for the registration of a work of art or a model or design for a work of art. The leading case of *Mazer v. Stein*, 347 U.S. 201, 100 USPQ 325 (1954) held that statuettes intended for use as electric lamp bases were copyrightable as works of art. The court stated, 'We find nothing in the copyright statute to support the argument that the intended use or use in industry of an article eligible for copyright bars or invalidates its registration. We do not read such limitation into the copyright law.' *Mazer*, at 218, 100 USPQ at 333. Accord, *Rosenthal*

v. Stein, 205 F. 2d 633, 98 USPQ 180 (9th Cir. 1953); see also *Boucher v. Du Boyes*, 253 F. 2d 948, 117 USPQ 156 (2d Cir. 1958). I find that the plaintiff's boutique presents a novel and original design. The claim that this is not copyrightable under the Copyright Law is untenable."

III. Defendant's argument that plaintiff's copyright notice was illegible was rejected by the court as "without substance." The court found the notice to be "readily apparent to the naked eye."

268. *Herwitz v. National Broadcasting Co.* (S.D.N.Y., May 2, 1962) (Moore, J.) (*not yet reported*).

Action for infringement of common law copyright and for unfair competition. Plaintiff had formulated and took part in developing an idea for a radio program which was broadcast under the title "Everybody Wins" for 26 weeks in 1948. This was an audience participation show in which a master of ceremonies bid a cash sum against the undisclosed contents of a box, which might be worthless or quite valuable, and the contestant had to choose between the cash and the box. Plaintiff alleges that Jan Murray's television show, "Treasure Hunt" infringed his common law copyright in "Everybody Wins" by using a similar "auction gimmick" and also claims that this use of his idea on "Treasure Hunt" constituted unfair competition.

Held, judgment for defendants.

I. It was held that plaintiff's program idea and format were not copyrightable. The court said:

"To recover, plaintiff must show that he had a protectible property interest. Ideas as such are not subject to copyright. *Nichols v. Universal Pictures Corp.*, 2 Cir., 1930, 45 F. 2d 119, 121 (L. Hand, J.), cert. denied, 282 U.S. 902 (1931). A copyright does not pre-empt the field as against others who choose a different means of expressing the same idea. *Alexander v. Irving Trust Co.*, 132 F. Supp. 364, 367 (S.D. N.Y. 1955), aff'd on the opinion below, 2 Cir., 1955, 228 F. 2d 221, cert. denied, 350 U.S. 996 (1956). However, there may be a protectible interest in an idea or combination of ideas which is reduced to 'concrete' form. Even then it is only the form in which the ideas are expressed that is protected; the law does not award the originator a monopoly in the ideas themselves. To the courts is assigned the difficult task of drawing a line between expression and what

is expressed. . . . The law of New York allows recovery on a theory of express or implied contract for the misappropriation of program ideas. See, e.g., *Stone v. Goodson*, 8 N.Y. 2d 8, 167 N.E. 2d 328 (1960), involving the television series 'The Price is Right'. However, we are aware of no New York cases holding that there may be a protectible property interest in a mere combination of ideas for a program such that there may be recovery in tort for plagiarism. Nor is there sufficient authority for this proposition so that we may fairly infer that a New York court would so hold if the question were presented to it.

Furthermore, here we are dealing with a 'gimmick' which is practically an abstract idea, rather than the concrete expression of a combination of ideas. As plaintiff stressed throughout the trial, the single important element in his program was the dilemma of a contestant having to choose between a specific amount of cash and a prize of unknown value. Stated in this manner, this is certainly nothing more than an abstract idea. Plaintiff concedes, as he must, that a mere idea is not a property interest protected by common law copyright. Assuming, for the moment, that the cash-or-chest dilemma in 'Treasure Hunt' was consciously taken from 'Everybody Wins', a holding that this constitutes the tort of plagiarism would seem to result in protecting an abstract idea.

I conclude that plaintiff's idea was not a property interest protected by common law copyright under either the law of New York or under the common law of copyright generally."

II. Although the court found it unnecessary, in view of its conclusions as to copyrightability, to "struggle with the somewhat metaphysical problem of weighing the persuasiveness of permissible inferences" as to whether copying had been proved, it stated that plaintiff's case was weak in this respect also. The court said:

"Copying is normally shown by establishing access and similarity. See *Arc Music Corp. v. Bobby Lee*, 2 Cir. 1961, 296 F. 2d 186. Access there was. Plaintiff's program was on the air for 26 weeks, and Dodge, who produced 'Everybody Wins', was Murray's partner at the time 'Treasure Hunt' was developed seven years later. A recording of one of the radio programs and a movie of one of the television programs introduced in evidence reveal some similarity between 'Everybody Wins' and 'Treasure Hunt' insofar as the ideas of choosing between the known amount of cash and the unknown contents of the box are utilized. However, in determining whether there was sufficient similarity to establish copying, it must

be remembered that there is nothing particularly new or novel about any aspect of either of these programs except the quandary of having to choose between a prize of unknown value and a specific amount of cash. 'Grab bags' and 'treasure hunts' are concepts familiar to most children in our society, and bidding or playing against the Bank is the age-old basis for many gambling games—particularly 'Vingt-et-Un' (Twenty-one). Furthermore, the programs differed in many details such as name, how the amount of the bid was determined . . . and in whether the contestant won a chance at the big prize by answering all his questions correctly or merely by answering more questions correctly than another contestant against whom he was pitted. Thus there is the question of whether the basic similarity of the program formats, discounted by the relative lack of originality and the difference in detail, establishes by a 'preponderance' of the evidence that the testimony indicating that Murray created rather than copied the basic format of 'Treasure Hunt' was false."

II. The court also held that there was no unfair competition. It said:

"It seems . . . clear that plaintiff has failed to state a cause of action for unfair competition. Even if 'Treasure Hunt' were based on an idea previously used in 'Everybody Wins', and even if it could be said that Murray's program was in competition with the plaintiff's proposed television series, there was nothing 'unfair' about the defendants' actions as that word has traditionally been used in the law of unfair competition."

2. State Court Decisions

269. *Eagle-Freedman-Roedelheim Co. v. Allison Mfg. Co.*, 133 U.S.P.Q. 357 (E.D. Pa., Apr. 23, 1962) (Luongo, J.).

Action for copyright infringement. Plaintiffs distribute sweatshirts bearing portraits, in which they claim copyright, of Beethoven, J. S. Bach, and Brahms. The art work was copied from 19th century engravings of the composers which are in the public domain. After a number of these shirts had been distributed without copyright notice, the portraits were re-done, this time with a notice included. The notice appeared on all Beethoven, Bach and Brahms sweatshirts distributed by plaintiffs thereafter. Defendants are charged with manufacturing and distributing similar sweatshirts, having copied the art work from plaintiff's portraits. Plaintiff moved for a preliminary injunction.

Held, motion denied.

The court held that the art work on plaintiff's shirts was "sufficiently changed from the engravings in the public domain to be copyrightable" but that a distribution of a number of shirts without copyright notice cast such doubt upon the validity of the copyright that a preliminary injunction would not be justified. The court said:

"(T)here is no doubt in the Court's mind that the defendant copied Weiner's art work from the sweatshirts sold by Weiner's licensee, Eagle. Unfortunately for plaintiff, the validity of the copyright for that art work is subject to serious attack from prior publication by distribution of sweatshirts bearing substantially the same art work without notice of copyright. Such publication without notice would be fatal to plaintiff's claim. *Thompson v. Hubbard*, 131 U.S. 123 (1889); *Deward & Rich, Inc. 1. Bristol Savings & Loan Corporation*, 120 F. 2d 537, 50 USPQ 1 (4th Cir. 1941) unless the omission was due to mistake or accident. 17 U.S.C.A. 21 . . . With the admitted distribution of these sweatshirts bearing art work changed, it appears at this stage, only in minor degree from that claimed to be copyrighted, the Court cannot say with any degree of certainty that plaintiffs will ultimately prevail . . . at the trial of this action.

270. *Baxter v. Curtis Industries, Inc.*, 201 F. Supp. 100, 133 U.S.P.Q. 78 (N.D. Ohio, Jan. 18, 1962) (Green, J.).

Action for copyright infringement. Plaintiff charges that his copyright on certain books containing key code information about Volkswagen automobiles is being infringed by defendant's publication and sale of booklets containing similar information. It is alleged that this infringement has continued since "about February, 1958." Defendant moves to dismiss the complaint, which was filed in September, 1961, on the ground that it is barred by the statute of limitations, §115(b) of the Copyright Act, which provides that "(n)o civil action shall be maintained under the provisions of this title unless the same is commenced within three years after the cause of action arose."

Held, motion denied.

The copyright statute of limitations was held to run from the date of the last infringing act, rather than from the date of the initial infringement. Action on an infringement, therefore, alleged to have been continuous to the date of commencement of suit, was not barred although it began more than three years earlier. The court said:

"§115(b) was enacted on September 7, 1957, effective September 7, 1958. Prior thereto, the time in which an infringement action could be brought was governed by the limitation prescribed for the class of action to which the infringement action belonged, by the law of the state where the action was brought. *Brady v. Daly*, 175 U.S. 148; *McCaleb v. Fox Film Corp.*, 299 F. 48; *Pathe Exchange, Inc. v. Dalke*, 49 F. 2d 161. This created a wide diversity of limitations, and promoted "forum shopping" in infringement actions. It was to cure that evil this general limitation was adopted. 1957 U.S. Code Cong. & Adm. News, p. 1961.

The determinative issue in this case is, quite clearly, whether the three year limitation of 115(b) begins to run from the date of initial infringement, or dates from the last infringing act. If the former, then this action is barred by the passage of time."

Holding that the legislative history shows clearly that 115(b) was intended to be remedial in nature, the court continued:

"Prior to the 1957 amendment the weight of authority, applying state statutes of limitations, was that the limitation ran from the last infringing act." *Cain v. Universal Pictures Co.*, 47 F. Supp. 1013, 56 USPQ 8; *Hampton v. Paramount Pictures*, 279 F. 2d 100, 125 USPQ 623. . . .

"It is the opinion of the court that the amendment was not intended to and did not, change this basic concept. It simply made uniform a three-year limitation dating from the last act of infringement, in place of the multitude of state limitation periods. It is a remedial measure and should operate as such. . . . 17 U.S.C. 115(b) may limit the period of time for which damages are recoverable in this case, but by reason of the interpretation that the alleged infringement is continuous, the motion to dismiss is denied."

271. *Michael Todd Co. v. County of Los Angeles*, 134 U.S.P.Q. 47 (Cal., May 17, 1961) (Schauer, J.). *For decision below, see* 16 Cal. Rep. 921, 9 BULL. CR. SOC. 262, Item No. 159.

Appeal from a decision in the District Court of Appeals which affirmed the validity of the Los Angeles County Assessor's method of assessing motion picture negatives for ad valorem personal property taxes. This method, which has been in use for some years, involves subtracting from the production cost of the negatives and their duplicates a fraction equal to the total number of distribution prints manufactured up to the date of the assessment divided by the Assessor's estimate of the total

number of distribution prints to be made from the negatives. As a check, the Assessor also considers the proportion of the Assessor's estimate of the total monetary returns to be expected on the picture which have been earned up to the date of the assessment. Plaintiff contends that this method is improper and seeks to recover taxes paid under protest on the negatives of "Around the World in 80 Days."

Held, judgment for defendant affirmed.

Plaintiff argued that the assessment is void because it assertedly includes the value of plaintiff's copyright in the negatives. The court held, however, that although "plaintiff's statement of relevant principles of copyright law is correct the implications which plaintiff seeks to draw from such principles in the case at bench are unsound as a matter of tax law" and that, consequently, the assessment was valid.

I. Plaintiff contended, and the court held, that copyright is an intangible property right separate and distinct from the material object copyrighted. The court said:

"Plaintiff's copyright in the motion picture and the negatives is not the so-called 'common law copyright' . . . but the statutory copyright which exists solely by virtue of federal law. . . . Yet like the common law right, plaintiff's copyright is intangible property wholly distinct from any property interest that plaintiff may have in the material object copyrighted. (17 U.S.C. §27; *Stevens v. Gladding* (1854) 58 U.S. (17 How.) 447, 452-453; *Stephens v. Cady* (1852) 55 U.S. (14 How.) 528, 530-531; *Werckmeister v. Springer Lithographing Co.* (1894, C.C. N.Y.) 63 Fed. 808, 810-812; *Capitol Records v. Mercury Record Corp.* (1952, S.D.N.Y.) 109 F. Supp. 330, 338-339 (5, 6); *Remick Music Corp. v. Interstate Hotel Co. of Nebraska* (1944, D.C. Neb.) 58 F. Supp. 523, 535. . . .

The nature and extent of plaintiff's interests created by copyright, and the manner in which those interests may be transferred, are determined by federal law. . . . But there is nothing in the federal statute or in federal constitutional principles which renders such property interests immune from state taxation. (*Fox Film Corp. v. Doyal* (1932) 286 U.S. 123; *accord, Stone v. Stapling Machines Co.* (1954, Miss.) 73 So.2d 123, 125-127). It follows that we must look to the law of California to determine the validity of the assessment here challenged."

II. The court held that except for franchises and solvent credits, intangibles are not taxable in California, and that the plaintiff's copy-

right, *as such*, could not be subjected to the personal property tax in California. *Roehm v. County of Orange*, 32 Cal. 2d 280 (1948).

The defendants contended that plaintiff's interest as assessed is "simply its 'right to use the negatives' to make distribution prints of the motion picture" and that this right, which is a right to use tangible personality, is "not 'transformed' into an intangible merely by reason of being 'protected' by federal copyright law." The court rejected this argument as a misconception of the nature of copyright. The court said:

"To begin with, defendants confuse the *physical ability* to use the subject negatives for making distribution prints with the *legal right* to do so. In effect, defendants confuse the use of the physical means of reproducing the copyrighted object with the use of the copyright itself. Defendants assume that the right to use the negatives for this purpose is identical with the right of an owner to make lawful use of any tangible property in his possession. . . . But in so reasoning defendants overlook the fact that the two types of rights—the right to copy and the right to use tangible property in general—have different historical origins and have consistently received different legislative and judicial treatment. . . . (H)e who owns the material object ordinarily has both the physical ability and the legal right to use it for any lawful purpose. (Cf. *Keesling, Conflicting Concepts of Ownership in Taxation* (1956) 44 Cal. L. Rev. 866, 872-873.) But the legal right to make copies of copyrighted material derives from the copyright statute alone and has never been deemed an attribute of the ownership of that material or of the physical means of its reproduction." (*Stevens v. Gladding* (1854), 58 U.S. 447; *Capitol Records v. Mercury Record Corp.* (1952, S.D.N.Y.), 109 F. Supp. 330; *Davenport Quigley Expedition v. Century Productions* (1937, S.D.N.Y.), 18 F. Supp. 974, 977.)

II. Although it was held that the copyright itself could not be subjected to the tax, the court concluded that the assessed valuation of the negatives could nevertheless reflect the value of the copyright. The court said:

"Plaintiff's principal contention is that defendants may not do indirectly that which they are forbidden to do directly; i.e., that defendants may not levy an 'indirect property tax' on this intangible right by 'including its value in the assessment of separate and distinct tangible property in which the intangible does not inhere.'

In *Roehm v. County of Orange* (1948), supra, 32 Cal. 2d 280, 285, we stated, 'Intangible values, however, that cannot be separately taxed as property may be reflected in the valuation of taxable property. Thus, in determining the value of property, assessing authorities may take into consideration earnings derived therefrom, which may depend upon the possession of intangible rights and privileges that are not themselves regarded as a separate class of taxable property.'

Plaintiff also argued that "the test which must be applied in evaluating the motion picture negative here is what a willing buyer would pay for the uses to which *he* could put the negative, without consideration of the uses to which it could be put by its present owner who may also happen to own the copyright," i.e., the salvage or scrap value of the film, or \$1,000. The court held, however, that this "market value" test applies only to property which has an actual market value. The court said:

"(Plaintiff's) argument, although ingenious, is logically unsound. It is true that, as a matter of copyright law, the right to make distribution prints would not be acquired by one who purchased the subject negatives without the copyright. But it does not follow, as plaintiff contends, that *as a matter of tax law* the 'market value' of the negatives—which cost some \$5,000,000 to produce and has a potential earning power of many millions of dollars—was simply their salvage or scrap value of \$1,000. The record establishes, rather, that for the purpose of determining 'full cash value' there was *no actual market* for the subject negatives without plaintiff's copyright therein. The sole beneficial or productive use of the negative film of a motion picture is for making prints thereof for exhibition, whether such prints be sold or leased. Indeed, plaintiff acknowledges that in the present case a buyer of the negative would get no right to use the property *in any manner having any substantial value.*' (Italics added.) But 'market value' for assessment purposes is the value of property when put to beneficial or productive use; it is not merely whatever residual value may remain after the property is demolished, melted down, or otherwise reduced to its constituent elements. (Cf. *Mahoney v. City of San Diego* (1926) 198 Cal. 388, 399-402.) In the event that the beneficial or productive use of the property would not pass to a willing buyer on an open market, the assessor must treat the property as having no actual market for valuation purposes.

However, as we . . . stated in *De Luz Homes, Inc. v. County of San Diego* (1955) 45 Cal. 2d 546, 563, 'It is well settled that 'the absence of an 'actual market' for a particular type of property does not mean that it has no value or that it may escape from the constitutional mandate that 'all property . . . shall be taxed in proportion to its value' (Art. XIII, §1) but only that the assessor must then use such pertinent factors as replacement costs and income analyses for determining 'valuation.'

The court also held that the particular method used by the Assessor to arrive at a valuation for the negatives was non-discriminatory and fair.

ALSO OF INTEREST

272. *United States v. American Society of Composers, Authors & Publishers*, 202 F. 2d 339 (S.D.N.Y., Dec. 28, 1961) (Ryan, J.).

Petition by television stations under society's consent decree praying that society be directed to grant blanket renewal licenses limited only to the television programs which each station originates locally—excluding those programs filmed or taped by third party producers, the latter shows to be licensed directly by each ASCAP member individually.

Held, petition denied.

The court stated that so drastic a change (from blanket licenses covering all of a station's shows, whether or not originated by the station) should await final determination after full hearing, no strong necessity for disturbing the status quo in the meantime having been shown.

273. *Harrison v. Hearst Publishing Co.* (Calif. Super. Ct., L. A. County, Mar. 27, 1962) (David, J.) (unreported).

Plaintiff claimed that her right of publicity was infringed by publication of her name and picture in the Los Angeles Examiner as a purported endorser of certain products. Defendant demurred on the ground that the action was barred by the statute of limitations because the right of publicity "if it exists in California, is merely a division of the right of privacy" and so subject to the one-year California statute of limitations for personal rights. Plaintiff urged that the right of publicity is not part of the right of privacy, but is a separate property right to which a two-year limitation should apply.

Held, demurrer overruled (without opinion).

PART V.

BIBLIOGRAPHY

A. BOOKS AND TREATISES

1. United States Publications

274. WINCOR, RICHARD. From ritual to royalties; an anatomy of literary property. New York, Walker [1962]. 153 p. *Contents*.—Origins of literary property. Queen Anne's legacy. Who owns Sherlock Holmes? A one-act play. A case of spirits. Contracts.

"A sprightly, anecdotal history of the chicanery, the proper practices, and the problems of 'copyright' from tribal secrets to the jewelled cigaret holder of Auntie Mame."—(181 *Publishers' Weekly* 29, no. 6, Feb. 5, 1962.)

B. LAW REVIEW ARTICLES

1. United States

275. BERMAN, BAYARD F. Screen credit and the law, by Bayard F. Berman and Sol Rosenthal. (9 *UCLA Law Review* 156-189, no. 1, Jan. 1962.)

"The purpose of this article is to examine selected aspects of the 'law' of screen credit, although it must be recognized at the outset that there is a dearth of reported cases." Includes a discussion of the "paternity right," one of the principal elements of the "moral right" of authors.

276. DERENBERG, WALTER J. [Review of] Copyright, Unfair Competition and Other Topics . . . by Benjamin Kaplan and Ralph S. Brown, Jr. Brooklyn: The Foundation Press, Inc., 1960 . . . (14 *Journal of Legal Education* 410-416, no. 3, 1962.)

A review of the Kaplan & Brown casebook which was published in the well-known *University Casebook Series*, preceded by a brief critique of Professor Goldstein's *Cases on Patent, Trademark and Copyright Law* published 1959 in the same series.

277. DEUTSCH, EADIE F. Unauthorized use of live television broadcasts of public domain materials—theories of relief. (1 *Publishing, Entertain-*

ment, Advertising and Allied Fields Law Quarterly 288-314, no. 3, Dec. 1961; 423-447, no. 4, Mar. 1962.)

"An analysis of the available remedies for the unauthorized use of television broadcasts containing non-exclusive materials."

278. DEVLIN, RAYMOND J. Moral right in the United States. (35 *Connecticut Bar Journal* 509-516, no. 4, Dec. 1961.)

The purpose of this article, which was awarded first prize in the 1960-61 Nathan Burkan Memorial Competition at the University of Connecticut School of Law, is "to review the protection the doctrine of moral rights affords the artist and to compare with it the protection granted the artist in the United States to see if substantially the same protection can be had under our present legal concepts."

279. KUNZ, ARMAND D. Torts—right of privacy—duration of implied consent. (8 *Wayne Law Review* 348-351, no. 2, Winter 1962.)

A case note on *McAndrews v. Roy*, 131 So. 2d 256 (La. 1961).

280. MELVILLE, CHARLES H. Copyright notice in the light of recent decisions. (30 *University of Cincinnati Law Review* 487-498, no. 4, Fall 1961.)

This essay, which received first prize in the Nathan Burkan Competition at the University of Cincinnati, 1961, is devoted primarily to the general requirement of notice as a condition precedent to copyright protection.

281. MORRISON, PETER H. Copyright publication and phonograph records. (1 *Publishing, Entertainment, Advertising and Allied Fields Law Quarterly* 510-542, no. 4, Mar. 1962.)

Reprinted from (48 *Georgetown Law Journal* 683, 708, no. 4, Summer 1960.) See 7 BULL. CR. SOC. 304, Item 437 (1960).

282. NICOSON, WILLIAM J. Misuse of the misuse doctrine in infringement suits. (9 *UCLA Law Review* 76-110, no. 1, Jan. 1962.)

An analysis of the judicial treatment of the defense of misuse in patent, trademark and copyright suits in which a case is made for the exclusion of antitrust considerations in such litigation.

283. The Publisher's monetary liability for copyright infringement. (29 *University of Chicago Law Review*, 385-403, no. 2, Winter 1962.)

This essay, which was awarded First Prize in the 1961 Nathan Burkan Memorial Competition at the University of Chicago Law School, is divided into two parts, the first being a brief history of copyright and the author-publisher relationship prior to 1909, and the second a discussion of statutory and case law on monetary liability since 1909. The author suggests "several important clarifications" for consideration in the next revision of the Copyright Act, with special reference to the providing of more protection to the innocently infringing publisher.

2. Foreign

(a) English

284. ABEL, PAUL. Letter from Great Britain. (75 *Le Droit d'Auteur* [English inset] 32-40, no. 3, Mar. 1962; 57-63, no. 4, Apr. 1962.)

A survey of recent legislative, judicial and other developments in the field of copyright and related matters in Great Britain. Also appears in French in the main sections of the same issues of *Le Droit d'Auteur*.

285. BERGSTRÖM, SVANTE. Photocopying and fixations for broadcasting under the new Swedish copyright legislation. (*EBU Review* 40-41, no. 72B, Mar. 1962.)

A comment completing the first part of the author's article "The new Swedish copyright legislation," which appeared in the *EBU Review*, no. 68B (July 1961). The present article is concerned with those provisions of the Royal Decree no. 348 of June 2, 1961, implementing the Swedish copyright legislation, which deal with photocopying by certain archives and libraries, and fixations for broadcasting. See 9 BULL. CR. SOC. 182, Item 91a (1961).

286. HESSER, TORWALD. Some questions concerning the future revision of the Berne Convention. (75 *Le Droit d'Auteur* [English inset] 11-16, no. 1, Jan. 1962.)

An English translation of the author's study, the original of which was published in 74 *Le Droit d'Auteur* 238-243, no. 9, Sept. 1961. See 9 BULL. CR. SOC. 96, Item 43 (1961).

287. International convention on the protection of 'neighbouring rights'; Rome Diplomatic Conference. (*EBU Review* 37-44, no. 71B, Jan. 1962.)

A brief comparison between the provisions of the Hague Draft and those of the Rome Convention, followed by the English text of the Convention.

288. TOURNIER, JEAN LOUP. General considerations on the report of the Copyright Office toward a revision of American legislation on the protection of literary and artistic works. (75 *Le Droit d'Auteur* [English inset] 7-10, no. 1, Jan. 1962; 49-56, no. 4, Apr. 1962.)

A critical analysis of the Register's *Report on the General Revision of the U. S. Copyright Law*. Also appears in French in the main sections of the same issues of *Le Droit d'Auteur*.

289. WAGNER, EGON. Report from the Federal Republic of Germany. (*EBU Review* 48-51, no. 72B, Mar. 1962.)

A survey of recent developments in West German copyright law and related matters of interest to broadcasting organizations covering the following topics: new broadcasting institutions in the Federal Republic, the third television program, reform of the copyright law, and leading cases and court decisions.

290. MILES, JAMES W. The international protection of designs. (6 *Industrial Property Quarterly* 251-258, no. 4, Oct. 1961.)

An examination of the problems involved in securing adequate legal protection of industrial designs, with the author's contention that the solution "must be one of international application and capable of sanction within the framework of [the Berne and Paris] Conventions."

291. Protection of cinematographic works. (*E.B.U. Review* 44-45, no. 71B, Jan. 1962.)

A summary of a Desbois report on the subject.

(b) English, French and Spanish

292. Summaries of articles published in 'Le Droit d'Auteur.' (14 *UNESCO Copyright Bulletin* 185-913, 231-240, 277-286, no. 2, 1961.)

Contents. Letter from Norway, by B. S. Lassen (D.A., 1961, p. 76). Changes in copyright law and practice in Poland after the Second World War, by W. Y. Rudnicki (D.A., 1960, p. 258). Letter from Italy, by Valerio de Sanctis (D.A., 1961, p. 221). European Agreement on the Protection of Television Broadcasts, by Georges Straschnov (D.A.,

1960, p. 263). Letter from Germany, by Eugen Ulmer (D.A. 1961, p. 12).

293. MASSOUYÉ, CLAUDE. La prochaine conférence de Stockholm. (*Revue Internationale du Droit d'Auteur* 2-35, no. 34, Jan. 1962.)

Also appears in *Il Diritto di Autore*, vol. 32, no. 4 (Oct.-Dec. 1961), pp. 555-568.

A discussion of the major questions that, in the author's opinion, are likely to be put on the agenda of the conference for revision of the Berne Copyright Convention scheduled to be held at Stockholm in June 1965.

294. REIMER, DIETRICH. La protection jurisprudentielle des artistes exécutants en Allemagne Fédérale. (*Revue Internationale du Droit d'Auteur* 96-111, no. 34, Jan. 1962.)

An analysis of four West German Supreme Court decisions of May 31, 1960 dealing with the protection of the rights of the performing artist.

295. TOURNIER, ALPHONSE. La conférence de Rome sur la protection internationale des artistes interprètes ou exécutants, des producteurs de phonogrammes et des organismes de radiodiffusion. (*Revue Internationale du Droit d'Auteur* 48-95, no. 34, Jan. 1962.)

An analytical and critical commentary on the essential provisions of the Rome Convention on Neighboring Rights, with an evaluation of the convention from the point of view of authors. The positive accomplishments of the convention are called only modest, and a question is raised whether it would not have been more appropriate to postpone such a convention until various problems have been settled through national legislation.

(c) French

296. BÉGUIN, GEORGE. L'organisation des Bureaux internationaux réunis pour la protection de la propriété industrielle, littéraire et artistique. (75 *Le Droit d'Auteur* 9-19, no. 1, Jan. 1962.)

An analysis of the organization and purposes of the United International Bureaux for the Protection of Industrial, Literary and Artistic Property, with a brief discussion of some questions concerning possible changes therein.

297. DESBOIS, HENRI. Propriété littéraire et artistique. (14 *Revue Trimestrielle de Droit Commercial* 363-374, no. 2, Apr.-June 1961.)

A note on three recent decisions of French courts involving protection of one's likeness and given name, protection of a Soviet author against an infringement of his work by an unauthorized French translation, and protection of a title.

298. GASPAR, FLORENT. Le fisc et la propriété industrielle, commerciale, littéraire et artistique. (51 *Revue de Droit Intellectuel, l'Ingenieur-Conseil* 297-306, no. 11, Nov. 1961.)

A brief explanation of Belgian tax law with respect to transfers and licenses of industrial, literary and artistic property, written for the use of Belgian and foreign businessmen and industrialists.

299. LYON-CAEN, GÉRARD. Le cinéma, la télévision et les droits des auteurs en droit français. (75 *Le Droit d'Auteur* 51-56, no. 3, March 1962.)

A comparative study of the disparities between the treatment of television and motion pictures under the French copyright law. A brief note is included on Eurovision and the two European arrangements, one for the protection of television broadcasts, and the other for the exchange of television programs.

300. PASQUERA, FILIPPO. Pourquoi et comment nous défendons le droit d'auteur. (75 *Le Droit d'Auteur* 31-34, no. 2, Feb. 1962.)

An abridged translation of the author's introductory lecture delivered at a course organized by Centro Internazionale Magistrati "L. Severini" of Perugia in September 1961. The lecturer's purpose was "to present, by the example of the Italian copyright law which is now and has been in the past ahead of its time, a brief summary of the civil and penal sanctions of copyright, properly so called." See Item 322, *infra*.

301. SANCTIS, VALERIO DE. De la nature juridique du droit d'auteur. (*Inter-auteurs* 11-32, no. 146, 1st quarter 1962.)

A French translation of the author's commentary on the legal nature of copyright which appeared in 32 *Il Diritto di Autore* 76-100, no. 1, Jan.-Mar. 1961, under the title, "Sulla natura giuridica del diritto di autore." See 9 BULL. CR. SOC. 98, Item 53 (1961).

302. TROCCHI, VITTORIO. Diritti i doveri degli autori alla luce della Enciclica "Mater et magistra." (32 *Il Diritto di Autore* 329-341, no. 3, July-Sept. 1961.)

A discussion of the rights and duties of authors in the light of the encyclical letter "Mater et magistra" of Pope John XXIII, with emphasis on the affinity between the moral rights theory and the principles of social justice enunciated in the encyclical.

303. TROLLER, ALOIS. Diritto di autore e giustizia distributiva. (32 *Il Diritto di Autore* 342-349, no. 3, July-Sept. 1961.)

A plea for the elaboration of a workable legal system which would apply to copyright the principles of distributive rather than commutative justice.

(d) German

304. BAPPERT, WALTER. Wider und für den Urheberrechtsgeist des Privilegienzeitalters; Auseinandersetzung mit dem Versuch einer Revision des Geschichtsbildes. (63 *Gewerblicher Rechtsschutz und Urheberrecht* 441-449, no. 9, Sept. 1961; 503, no. 10, Oct. 1961; 553-560, no. 11, Nov. 1961.)

A critique of Pohlmann's studies on the origins of copyright in Germany. The author's purpose is to refute a number of Pohlmann's theses, among which were (1) that the author's privilege was granted to him by virtue of his act of creation rather than because he was the publisher; (2) that in the age of privilege the patrimonial rights of an author had been systematically acknowledged and enforced as originating from the creation of the intellectual work; and (3) that this recognition of patrimonial rights had its importance in the development of prescriptive law.

305. BRUGGER, GUSTAV. Zur Abgrenzung zwischen Fernsehnutzungsrechten und Verfilmungsrechten. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 187-195, no. 3/4, Nov. 1, 1961.)

The author's reply to a comment by Wilhelm Peter, 34 *UFITA* 141-150, no. 3/4, Mar. 1, 1961, concerning the dividing line between motion picture and television broadcasting rights.

306. BÜHLER, OTTMAR. Steuerliche Fragen aus dem Bereich der inlandischen und der ausländischen Filmwirtschaft. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 129-158, no. 3/4, Nov. 1, 1961.)

A discussion of various problems concerning taxation in the motion picture industry from the point of West German law, with special reference to current domestic, foreign and international developments.

307. FALTSHAUSER, WILHELM. Die vorzeitige Auflösung des Filmlizenzvertrages; ein Beitrag zu den Rechtsbeziehungen zwischen Produzenten und Verleiher, dargestellt an einem praktischen Fall. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 318-341, no. 5/6, Dec. 1, 1961.)

A study of the effect of premature termination of a motion picture license on the legal relationships between producer and distributor in West Germany, illustrated by a concrete court case.

308. HAENSEL, CARL. Die Kollision von Verfilmung und Fernsehsendung. (*Revue Internationale du Droit d'Auteur* 36-47, no. 34, Jan. 1962.)

A discussion, in German, French and English in parallel columns, of the legal problems of, and conflicts between, films and television under West German law by a comparative analysis of the two media of communication.

309. HIRSCH-BALLIN, ERNST D. Zum sog. Leistungsschutz des Interpreten; Kritik einer Kritik. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 48-63, no. 1/2, Sept. 1, 1961.)

A criticism of the views expressed by Heinrich Hubmann in his critical comment (34 *UFITA* 1-8, no. 172, May 1, 1961) on sec. 2, par. 2, of the German copyright statute, under the terms of which a sound recording is equated with an arrangement. See also 9 *BULL. CR. SOC.* 187, Item 109 (1961) and Item 316 *infra*.

310. LAUFKE, FRANZ. Die Allgemeinen Geschäftsbedingungen in der Filmwirtschaft unter Berücksichtigung der Generalklauseln. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 257-318, no. 5/6, Dec. 1, 1961.)

An extensive study of standard contract terms in West German motion picture industry and distribution, discussed in their two essential aspects, either as (a) standard contract forms, or (b) systematic sets of rules incorporated explicitly or implicitly in the contracts. A section of the study is devoted to copyright problems proper.

311. LEINWEBER, GERHARD. Urheberrechtlicher Denkmalschutz. (64 *Gewerblicher Rechtsschutz und Urheberrecht* 75-77, no. 2, Feb. 1962.)

A case is made for including in the forthcoming West German copyright law a provision designed to protect the integrity of public domain works which are important from the point of view of national culture.

312. MENTHA, BENIGNE. Film und Fernsehen in der Berner Übereinkunft; Artikel 14 und 11 bis. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 1-25, no. 1/2, Sept. 1, 1961.)

The history and the interpretation of articles 14 and 11 bis of the Berne Convention relating to copyright in connection with motion pictures and television. The author analyzes both provisions and suggests that their shortcomings be removed at the next conference for the revision of the Berne Convention to be held at Stockholm in 1965.

313. PLAISANT, ROBERT. Der Schutz ausländischer Urheber in Frankreich; Bemerkungen zu der Entscheidung der Cour de Cassation vom 22. Dezember 1959. (*Gewerblicher Rechtsschutz und Urheberrecht, Auslands- und Internationaler Teil* 14-17, no. 1, Jan. 1962.)

A comment on a decision of December 22, 1959 by the French Court of Cassation affirming the appeal court's decision according to which foreign works in France generally enjoy full copyright protection under Article 11 of the French Civil Code.

314. POHLMANN, HANSJÖRG. Zur notwendigen Revision unseres bisherigen Geschichtsbildes auf dem Gebiet des Urheberrechts und des gewerblichen Rechtsschutzes. Zugleich: Widerlegung von Bapperts Behauptung einer urheberrechtlichen Unmündigkeit der "Privilegienzeit." (64 *Gewerblicher Rechtsschutz und Urheberrecht* 9-25, no. 1, Jan. 1962.)

A rebuttal to Bappert's criticism of the writer's studies of the origins of copyright in German. See Item 304, *supra*.

315. RUNGE, KURT. Schutz der ausübenden Künstler. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 159-186, no. 3/4, Nov. 1, 1961.)

An analysis of the Hague Draft Convention on Neighboring Rights from the point of view of the forthcoming West German copyright law reform, with an occasional comment on the Austrian copyright reform efforts. For the purpose of this analysis, the author confines himself to (1) a critical explanation of the fundamental principles which were to be discussed at the Rome Diplomatic Conference on Neighboring Rights; and (2) a discussion, limited to the problems of the protection of performing artists, of the sharp criticism concerning particular provisions of the draft convention.

316. SCHORN, FRANZ. Zur Auslegung des § 2 Abs. 2 LitUG. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 341-349, no. 1/6, Dec. 1, 1961.)

Another article criticizing Hubmann's views. See Item 309 *supra*.

317. SPAIĆ, VOJISLAV. Der internationale Schutz ausübender Künstler. (35 *Archiv für Urheber-, Film-, Funk- und Theaterrecht* 26-48, no. 1/2, Sept. 1961.)

The historical development of efforts toward the international protection of neighboring rights leading to the Hague Draft Convention, with a brief survey of the pertinent legislation of some countries and a summary of the leading provisions of the Hague draft.

318. TETZNER, HEINRICH. Die Voraussetzungen des Kunstschutzes. (14 *Neue Juristische Wochenschrift* 1748-1751, no. 39, Sept. 1961.)

A discussion, in the light of the decisions of the West German Supreme Court, of the qualities which a useful article must possess in order to qualify for copyright protection as a work of art.

319. ULMER, EUGEN. Das Rom-Abkommen über den Schutz der Ausübenden Künstler, der Hersteller von Tonträgern und der Sendeunternehmen. (*Gewerblicher Rechtsschutz und Urheberrecht Auslands- und Internationaler Teil* 562-604, no. 12, Dec. 1961.)

An analysis of the provisions of the Rome Neighboring Rights Convention, preceded by a brief historical survey of events leading to the Convention as well as a report on the work of the Diplomatic Conference culminating therein. The article is followed by the text of the Convention in *English, French and Spanish* in parallel columns.

(e) Italian

320. BLUM, ARNO A. La legislazione sul diritto di autore in Israele e i suoi specifici problemi. (32 *Il Diritto di Autore* 569-581, no. 4, Oct.-Dec. 1961.)

An Italian translation of the author's article on Israeli copyright law which appeared in French and English in 74 *Le Droit d'Auteur* 244-253, no. 9, Sept. 1961, and in French in *Interauteurs* 110-117, no. 143, 2d quarter 1961. See 9 BULL. CR. SOC. 95 and 97, Items 41 and 46 (1961).

321. BOGSCH, ARPAD. Revisione generale della legge sul copyright negli U. S. A. (32 *Il Diritto di Autore* 384-393, no. 3, July-Sept. 1961.)

A brief summary of the recommendations of the Register's *Report on the General Revision of the [U. S.] Copyright Law* affecting the protection of works of foreign authors.

322. Centro Internazionale Magistrati "L. Severini," Perugia. [Corso sulla] Tutela civile e penale del diritto di autore. (32 *Il Diritto di Autore* 145-469, no. 3, July-Sept. 1961.)

Contents [translated]: Why and how we defend copyright, by Filippo Pasquera. Copyright, a natural right, by Antonio Ciampi. Neighboring rights, problems in judicial defense, by Valerio de Sanctis. Defenses and civil sanctions in copyright protection, by Mario Fabiani. Penal protection of copyright, by Leonello Leonelli.

A series of selected lectures which were delivered at a course organized by Centro Internazionale Magistrati "L. Severini" of Perugia between September 1 and 20, 1961, on the general topic, "Civil and penal protection of copyright."

323. JAUS, OSVALDO. Sul fallimento dell'editore. (32 *Il Diritto di Autore* 502-515, no. 4, Oct.-Dec. 1961.)

A study of legal effects of a publisher's bankruptcy on the publishing contract, interpreted from the point of view of Italian statutory and case law.

324. LIGI, FRANCO. La tutela dell'individualità dell'autore nella integrità della sua opera. (32 *Il Diritto di Autore* 477-493, no. 4, Oct.-Dec. 1961.)

A case is made for extension of protection of the author's right to the integrity of his work beyond the limits indicated by Article 6 bis of the Berne Convention (Brussels revision) and Article 20 of the Italian copyright statute of 1941, under which an author may oppose distortions, mutilations or alterations of his work only if such changes are prejudicial to his honor and reputation. It is proposed that, instead of protecting the author merely against the deformation of his work, his very individuality should be respected.

325. SIEKIERKO, STANISLAW. La protezione giuridica degli artisti esecutori in Polonia secondo la giurisprudenza della Corte suprema. (32 *Il Diritto di Autore* 394-396, no. 3, July-Sept. 1961.)

A note on a Polish Supreme Court decision of May 27, 1960, in which a Polish court for the first time recognized the rights of performing artists.

C. ARTICLES PERTAINING TO COPYRIGHT FROM TRADE MAGAZINES

1. United States

326. ABPC-ATPI policy statement on copyright law revision. (181 *Publishers' Weekly* 71-72, no. 17, Apr. 23, 1962.)

A summary of the major recommendations contained in a joint policy statement, prepared by the American Book Publishers Council and the American Textbook Publishers Institute, which set forth certain views on the pending revision of the U. S. Copyright Law. The joint statement was submitted to the Register of Copyrights in response to the request in his *Report on General Revision of the Copyright Law* for comments and suggestions thereon.

327. ABPC: religious publishers group studies joint projects, "Buying around." (181 *Publishers' Weekly* 29-34, no. 21, May 21, 1962.)

An account of the first annual meeting on April 24, 1962 of the Religious Publishers Group as an organization affiliated with the American Book Publishers Council. Included is a summary of the discussions on the problem, and some possible solutions for it, of "the purchase, by American schools, libraries and other buyers, of the British editions of books (especially religious books) to which American publishers have the rights in their own market."

328. ABPC: Council reviews varied problems—editorial, international, legal. (181 *Publishers' Weekly* 17-28, no. 21, May 21, 1962.)

Coverage, by *Publishers' Weekly*, of the annual meeting of the American Book Publishers Council, held April 24-27, 1962 at Skytop, Pennsylvania. Included are "the talks, discussions and exchanges of information on the subjects of copyright revision, taxation as it affects publishers and authors, international markets, the freedom to read and the conduct of author-publisher-editor relationships."

329. ANDERSON, OMER. GEMA to press royalty payment fight with AFN. (73 *Billboard Music Week* 4, 18, no. 50, Dec. 18, 1961.)

Article on a statement recently given to *Billboard Music Week* by Dr. Erich Schulze, board chairman of the West German performing right society, GEMA. In the statement Dr. Schulze "scotched" the assumption that, as the result of an unfavorable court decision, GEMA would drop its demands against the Armed Forces Network (AFN) to pay royalties for music played by the U. S. Military radio network in West Germany.

330. Ballets in symbol. (54 *Mademoiselle* 134-135, 141-143, no. 1, Nov. 1961.)

An article on "Labanotation," a system of dance notation named after its originator, Rudolf von Laban. The article deals principally with the work of Myrna Shedlin, one of the few professional notators.

331. BMI caught in a squeeze play? (62 *Broadcasting* 27-30, no. 11, Mar. 12, 1962.)

An article on a recent proposal by attorneys for ASCAP and for the All-Industry TV Music License Committee, and the reactions thereto. "Under the proposal, television stations would get an estimated reduction of 16% in ASCAP rates in exchange for their abandonment of all ownership or control in BMI."

332. BRIEF, HENRY. Legal problems of the recording industry. (22 *National Music Council Bulletin* 5-6, no. 2, Winter 1961-62.)

The executive secretary of the Record Industry Association of America discusses counterfeiting and the unauthorized duplication of records, and the Register's recommendation for the repeal of the compulsory license provision.

333. DIAMOND, SIDNEY A. Proposed changes in the copyright law. (75 *The Writer* 25-26, no. 1, Jan. 1962.)

A summary of some of the important features of the Register's *Report on Copyright Law Revision* "that will have direct impact on writers' activities and on the economics of the profession."

334. FEINSTEIN, HERBERT. Mark Twain & the pirates. (13 *Harvard Law School Bulletin* 6-18, no. 5, Apr. 1962.)

An amusing, anecdotal history of Mark Twain's influence on American copyright law and of his legal efforts against copyright pirates.

335. GREEN, STANLEY. Jukebox piracy. (209 *The Atlantic Monthly* 136, no. 4, Apr. 1962.)

A case is made by a well-known musicologist for repeal of the jukebox exemption.

336. KEATING, VIRGINIA. Knockout blasts rip into fashion knockoff artists. (104 *Women's Wear Daily* 3, no. 57, Mar. 22, 1962.)

An article on recent addresses by manufacturer, Philip Sills, and his designer, Bonnie Cashin, before the Washington (D. C.) Fashion Group, in which they lashed out against design piracy with particular reference to fashions. Some of the proposals offered by Miss Cashin were: "Payment for authorized copying; shunning of design pirates; freeing the press 'from the albatross' of advertising tie-ins with editorial coverage . . . and inclusion of the fashion industry in a proposed federal cultural department."

337. KLAPPER, MARVIN. U. S. and EEC design piracy pact is urged. (104 *Women's Wear Daily* 1,7, no. 47, Mar. 8, 1962.)

A brief article on statements by Jacques Heim, president, Chambre Syndicale, Paris, and Sylvan Gotshal, attorney for the Couture, urging "a mutual pact between the United States and the European Common Market 'to protect artists, designers, and creators against style piracy.'"

338. LASSITER, WILLIAM C. Law and press. *The North Carolina Press* 6-7, (Jan. 1962.)

A comment on the question whether there is "adequate protection for the newspaper publisher using conventional methods of printing against pirating by publishers using off-set printing processes who would reproduce and republish advertising composition which has been developed, designed, laid out and put into print by the original publisher at his sole cost and expense," with special reference to the decision in *Inter-City Press, Inc. v. Siegfried*, 172 F.Supp. 37, 6 BULL. CR. SOC. 36, Item 19 (W.D. Mo. 1958).

339. MANGES, HORACE S. The shape of copyright revision: rights and remedies of copyright owners. (182 *Publishers' Weekly* 42-45, no. 2, Jan. 8, 1962.)

A paper, presented to the ABA copyright symposium held at New York University, Dec. 1-2, 1961, commenting on chapters III and

IX of the Register of Copyrights' Report on the General Revision of the Copyright Law. "In it, Mr. Manges discussed several issues of major importance for book publishing, among them 'fair use,' photocopying by libraries and the use of printed materials on non-print media such as educational television."

340. MCCARTY, B. F. Offset printing doesn't include right to 'pirate' from other publications. (79 *The American Press*, 22, no. 12, Oct. 1961.)

A brief, critical comment on the decision in *Inter-City Press, Inc. v. Siegfried*, 172 F.Supp. 37, 6 BULL. CR. SOC. 36, Item 19 (W.D. Mo. 1958), by an official of the plaintiff corporation.

341. Performer bite of copyright royalties. (225 *Variety* 24, no. 1, Nov. 29, 1961.)

An article on the recent Rome neighboring rights convention and U. S. reactions thereto.

342. ROGERS, JOSEPH W. Library interests in copyright law revision. (33 *D. C. Libraries*, 2-7, no. 1, Jan. 1962.)

A review of developments in copyright law revision since the submission of the report of the Register of Copyrights to Congress on July 10, 1961, followed by a presentation in more detail of "some of the possible consequences for libraries of a longer term, of the two principal methods of computing it, and of certain other proposals which have been made."

343. Verdi's purgatorial term. From a correspondent in Rome. (203 *The Economist* 353, no. 6192, Apr. 28, 1962.)

A note on the "Ricordi monopoly over Verdi in Italy" as an issue in the series of extensions of the copyright term, the latest request for which came before the Italian Parliament late in 1961.

344. WITTENBERG, PHILIP. Copyright law revision; *Report of the Register of Copyrights*. (32 *Library Quarterly* 73-75, no. 1, Jan. 1962.)

A brief review of the *Report* with special attention to the recommendation on photocopying by libraries.

345. Symposium reviews the shape of copyright law revision. (182 *Publishers' Weekly* 54-56, no. 2, Jan. 8, 1962.)

A summary of the discussions at the ABA copyright symposium held at New York University, Dec. 1-2, 1961, at which "the Register

of Copyrights' report on the proposed revision of the U. S. Copyright Law got a thorough going-over by, chiefly, the 80-odd lawyers who constitute most of the U. S. copyright bar."

2. England.

346. DAWSON PANE, C. B. Copyright and performing rights. (1 *Recorded Sound* 1-10, no. 1, May 1961.)

A lecture, by the manager of the Copyright Department of E.M.I. Records Ltd., on the effect of copyright, including performing rights, on record libraries in Great Britain, with comments on the problems to which these rights give rise.

3. West Germany

347. FACK, FRITZ ULLRICH. Mehr Schutz für das geistige Eigentum; eine Übersicht über das geplante neue Urheberrecht. *Frankfurter Allgemeine Zeitung* 11, no. 295, Dec. 20, 1961.

A survey of various provisions of the latest West German draft copyright laws approved by the Cabinet and submitted to the Federal Parliament, with special emphasis on *domaine public payant*, use of private tape recorders, *droit de suite*, and rights of the performing artist.

NEWS BRIEFS

348. NEW ADHERENCES TO THE UNIVERSAL COPYRIGHT CONVENTION.

Canada. On May 10, 1962, Canada deposited with the Director-General of UNESCO its instrument of ratification to the Universal Copyright Convention and to Protocol 3 thereof. Under Article IX, paragraph 2, of the Convention, the latter will come into force in respect of Canada three months after the deposit of its instrument of ratification, i.e., on August 10, 1962.

Ghana. On May 22, 1962, Ghana deposited with the Director-General of UNESCO its instrument of accession to the Universal Copyright Convention and its annexed three Protocols. The Convention will come into force in respect of Ghana three months after the deposit of its instrument of ratification, i.e., on August 22, 1962.

Ghana is the 42nd country to adhere to the Convention.

349. The Celler COUNTERFEIT RECORDINGS Bill.

Hearings on H.R. 6354, 87th Cong., were held on May 10, 1962, before the Subcommittee on Patents, Trademarks and Copyrights of the House Judiciary Committee.

This bill has three parts. The first two parts (contained in section 1) would provide criminal penalties against anyone who, knowingly and with fraudulent intent, transports or receives in interstate or foreign commerce (1) sound recordings bearing "any forged or counterfeited label," or (2) sound recordings which reproduce another sound recording without permission of "the owner of the master recording." The third part (section 2 of the bill) would amend section 101(e) of the Copyright Law to make the general civil remedies for copyright infringements, as provided in section 101(b), applicable to the infringement of the mechanical recording right in music for which section 101(e) now provides special limited remedies.

Congressman Celler, who had introduced the bill, testified first, urging that legislation to combat the counterfeiting of phonograph records was needed. Representatives of the record industry testified in favor of section 1. Under questioning by the Committee, they distinguished between "counterfeiting" which involved the use of forged labels to give duplicates of records the appearance of the original ones, and "record piracy" which involved only the unauthorized duplication of the recording. They strongly supported the first part of the bill regarding counterfeit labels. Some of them also favored the second part regarding unauthorized reproduction of the recording. A representative of the broadcasting industry urged that the second part, if adopted, should be amended to apply only to reproductions made for purposes of sale.

Representatives of music publishers and songwriters testified in support of the third part (section 2) of the bill, urging that the present remedies are not adequate to deter unauthorized recording.

The Register of Copyrights indicated that while he had some doubts about the proposal for a Federal criminal penalty, he would not oppose the first part of the bill. He was opposed to the second part since it would create unqualified and unlimited rights in "the owner of the master recording," without regard to a number of unresolved issues. He supported the objective of the third part of the bill but expressed his preference that it be deferred for consideration in the general revision of the copyright law. He referred to a substitute bill that he would propose if the Committee felt that legislation to deter record piracy was urgent; the substitute would amend the Copyright Law by making the general civil remedies under section 101(b) and also the criminal penalties under section 104 applicable to unauthorized recording of copyrighted music, and by increasing the criminal penalties under section 104.

Copyright Society of the U.S.A.

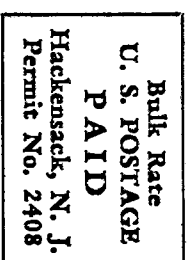
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PART I.

ARTICLES

350. THE ROAD TO PROGRESS IN REVISING THE COPYRIGHT LAW

By JOHN SCHULMAN*

More than a full year has elapsed since the Register of Copyrights issued his report upon Copyright Law Revision. It has been a year of intense activity marked by meetings of the Panel of specialists appointed by the Librarian of Congress, by a two day public symposium in New York City, by meetings of various formal copyright committees, and discussions within ad hoc groups. Comments by individuals and by various creator and industry groups have been circulated. Revision was debated at a three day conference held in San Francisco, California, in August 1962 immediately preceding the annual meeting of the American Bar Association Section on Patent Trademark and Copyright Law. The customary annual Copyright Symposium at the commencement of the section meeting also dealt with the revision problems.

A report from the Senate Judiciary Committee summarizing its yearly activities, in referring to the Register's studies and report, commented that "The Copyright laws, which have not been generally revised for over fifty years, are badly in need of revision".¹

In contemplation of an ultimate revision and an extension of the term of protection, action was taken by Congress to preserve copyrights which would otherwise have expired pending the preparation and adoption of a new statute. An interim bill to continue the renewal terms of these copyrights was enacted after an extensive public hearing, and was signed by the President on September 19, 1962. Pursuant to this legislation (P.L. 87-668) the renewal terms of all copyrights subsisting on its effective date will be continued until December 31, 1965.

* Member of the New York Bar, Member of the Panel of Experts Appointed by the Librarian of Congress to Revise the Copyright Law, one of the founders and a trustee of The Copyright Society of the U.S.A., and presently Chairman, Committee on Copyright, American Patent Law Association.

1. Report No. 1481, 87th Congress, Second Session.

As a result of the full debate which has taken place, it is now possible to outline some of the principal areas of agreement and of controversy, and to highlight some of the issues on which basic policy decisions will have to be made if the long awaited revision is to become a reality.

Although the studies made under the Register's auspices have won the highest acclaim as a statement and summary of existing law, the same approval has not been accorded to his recommendations for a new statute. Many of the Register's recommendations for improvement in our present law are wholeheartedly approved, and other changes in detail are considered to be acceptable. The real problem, however, lies in the basic structure of the copyright system which the Register proposes. The fundamental question is whether we are to continue the present dual system of common law and statutory copyright, with a fixed term of years commencing upon the issuance of a work and retaining mandatory formalities, or whether we should progress to a single statutory system, with protection stemming from creation without mandatory formalities, and providing a term predicated upon the life of the author.

The Register has not proposed any change in the basic structure of the existing statute. On the contrary, his proposals contemplate the retention of its framework, with limited changes, some of which are addressed to meeting specific new developments in technology, others which seek to remedy obvious weaknesses in the law, and still others which are intended to clarify ambiguities.

Consistent with this approach, the Register's report contemplates the retention of the existing dual system of copyright under which unpublished and unregistered works may claim protection only under the Common Law, and only those which are published or registered come within the orbit of the Federal Copyright Statute. However, because unpublished works are widely used in recordings on films or discs, and by performance in broadcasting, the report recommends a new line of demarcation between the Common Law and Statutory protection.

Under its concept a work would come within the purview of statutory protection upon public 'dissemination', i.e. upon publication in the form of copies, upon registration, upon public performance, or upon the public distribution of sound recordings, whichever of these events is the first to occur.

Accordingly, works for this purpose would seem to fall into a number of categories. One category would be those works which were neither published nor registered for copyright, another would be those registered but not published, recorded, or performed, and still another would be those publicly performed or recorded but not registered or published. There would also be a category of works which have been 'published' as the term is presently understood.

This new line of demarcation would play an important role in the copyright structure. For one thing it will determine the commencement and duration of copyright. The report, in rejecting a term based upon the life of the author, proposes that the duration of copyright be seventy-six years, divided into two periods. The original term would be twenty-eight years as it is under the present statute, but the renewal term would be lengthened to forty-eight years. The original term would commence upon 'public dissemination', and the renewal would be secured by an application filed at any time during the twenty-third through the twenty-eighth year, namely, during the last five years of the first term.

The contemplated renewal would not, as under the present statute, constitute a new estate available only to the author or his family. It would be only a prolongation of the original term, one which any person having an interest in the copyright might secure.

Although an assignee of an author could under this concept secure an assignment of the entire seventy-six year term at its outset, two features of the recommendations should be considered in this connection. The report recommends that the copyright, which presently is a unity, be made divisible. The separate exclusive rights embraced within copyright would be transferable to various assignees. Each assignee would have full legal ownership of the rights assigned to him, and would be competent to enforce these rights in his own capacity. The Register suggests, on the other hand, that assignments by authors be limited to twenty years, unless the agreement provides for the payment of royalties. There would not be any time limitation on assignments made in connection with a royalty agreement.

Notice of copyright and registration in a modified form would also continue to be an integral part of the copyright system. Although, according to the Register's recommendations, unpublished manuscripts and recordings of works would not be required to bear a copyright notice, a notice would be required upon all copies when works are published. Accordingly, some 'disseminated' works would bear notice, others would not.

The provisions concerning notice would nevertheless be relaxed so that a defect would not necessarily invalidate the copyright. The concept of the Universal Copyright Convention, i.e. that a notice is sufficient if imprinted in a place providing reasonable warning that copyright is reserved, is adopted by the Register. He recommends even greater flexibility so that the use of an erroneous date, or an error in naming the copyright proprietor would not necessarily be fatal. Nevertheless, the unexcused failure to affix the copyright symbol upon copies of a published work would deprive that work of copyright protection.

Corrective measures in respect of the copyright notice are linked with registration. The present pattern of registration and deposit would be continued, and again with modifications. Although the enjoyment of copyright would not be dependent upon registration or deposit, these formalities would continue to constitute a prerequisite to the commencement of litigation for infringement. In addition, to stimulate voluntary registration, the recommendation is, that (except for works protected by the Universal Copyright Convention) the remedies of a copyright proprietor in an action for infringement be curtailed if registration had not been effected within three months after the first dissemination of the work in the United States or within six months after first dissemination of the work abroad.

From the discussions which have taken place during the past year, including the views expressed at the San Francisco meeting, it is apparent that the structure of the statute proposed by the Register is not acceptable to various groups of creators and users and to a majority of the lawyers who are active in the copyright field. It is generally believed that a new statute such as that which is proposed in the Register's report would be more cumbersome and difficult of application than the Act of 1909, and would represent retrogression rather than progress in our copyright system.

The function of the new act should be to simplify and unify our copyright system, to adapt it to modern conditions and bring it into conformity with sound practices prevalent in the industries which deal with copyright, and by that means to create a climate in which authors and users will be secure in their rights and will have the opportunity of deriving fair returns from their efforts and investments.²

A concise statement of the basic criteria for a new Act was advanced by some of the members of a copyright committee in a report made to the American Bar Association Section on Patents, Trademarks and Copyrights in 1957.³ The concepts there proposed were as follows:

"1. Automatic Protection From Creation

There should be federal statutory protection, without mandatory formalities conditioning either the recognition or the continued enjoyment of the right, automatically from creation, before as well as after publication.

2. See New York State Copyright Act 1786 of which the preamble reads:

"Whereas it is agreeable to the principles of natural equity and justice that every author should be secured in receiving the profits that may arise from the sale of his or her works; and such security may encourage persons of learning and genius to publish their writings, which may do honour to their country and service to mankind:"

3. Report of the Committee on Program for Revision of Copyright Law, Section of Patent, Trademark and Copyright Law, American Bar Association, 1957, pp. 58-59.

2. An Exclusive Federal System

A single system of protection and enforcement, under federal law exclusively, should be provided for the incorporeal property in literary and artistic works expressed within the constitutional meaning of 'writings,' including transactions where the incorporeal property is mortgaged or otherwise given as security or collateral, and the foreclosure of such liens.

3. Permissive Formalities

Notice of copyright need not be mandatory for published works and a strong system of deposit and registration in a central office, but without conditioning the basic right, should be provided, with powerful incentives under the statute, to provide general registration and deposit.

4. Divisibility and Recordation of Grants

Divisibility should be recognized in the enforcement of rights, as well as in the permissive recordation of general or limited grants thereunder so as to be effective notice to third parties, with careful and detailed provision for an exclusive federal system of recordation, conveyancing and searching.

5. Renewal and Duration

The renewal concept should be abandoned as outmoded and confusing, and termination of protection should be predicated upon a stated period (preferably the end of the fiftieth calendar year), after death for individual authors, and after first public presentation, or deposit and registration, in the case of authors for hire and anonymous and pseudonymous authors.

6. Remedies

The principles found so efficacious under the Act of 1909 in providing a system of sanctions and remedies, for the incorporeal property created by the statute, to deter piracies of use and insure licensing of large and small rights, by its criminal and administrative provisions, as well as in the civil remedies of injunction, seizure, impounding, destruction and monetary recoveries by way of actual damages, profits and prestatd minimum and maximum statutory damages, should be substantially preserved, with appropriate safeguards to prevent unduly harsh recoveries against multiple innocent secondary infringers who are unaware of the primary infringement committed by the originating source of the infringing presentation."

It is the writer's opinion that the concepts so advanced in 1957 are still valid and that they represent presently the consensus of opinion of most

groups interested in copyright on the kind of statute which is needed to bring our copyright system in line with modern requirements.

One reason for the difference of approach between the Register's report and those who choose the new pattern, may be the many changes which have taken place in the past fifteen years in the use and needs for copyright protection. Mr. Abe A. Goldman,⁴ in his study on U.S.A. Copyright Law Revision from 1901 to 1954, refers to the obstacles which defeated the numerous attempts at revision between 1924 and 1940. He says (page 11), that the "major controversies were rooted in the conflicting interests of the various author and publisher groups on the one hand, and the users of copyright material—such as broadcasters, motion picture producers, and record manufacturers on the other hand."

He outlines the areas of irreconcilable differences as follows:

1. Automatic Copyright—i.e. protection without mandatory notice, deposit, or registration.
2. Removal of requirement for domestic manufacturers of foreign books and periodicals.
3. Retroactive copyright of foreign works.
4. A term of copyright based upon the life of the author and a period after his death.
5. Copyright in oral speeches.
6. The moral rights of authors.
7. Divisibility of copyright.
8. Elimination of the compulsory license for recording of music.
9. The elimination or diminution of statutory damages.
10. The protection of innocent infringers.
11. The removal of the privilege of scholars and libraries to import copies.
12. The restriction of performing rights.

The interesting developments of the past twenty years now evident from the discussions of the past year, lie in the circumstance that so many of these factors are no longer matters of controversy, and that none of those

4. Counsel to the Copyright Office.

which relate to the basic structure of a new statute would meet with general opposition today.

There is general agreement with the concept that copyright should attach upon creation of a work without the requirement of mandatory notice, registration or deposit. In its place, there is a willingness to adopt a voluntary system by which a notice or deposit would be encouraged by providing greater remedies. A term based upon the life of the author and a period thereafter is now conceived to be logical and equitable, and various proposals have been advanced for the treatment of corporate works to provide for a limitation of the term as required by the Constitution. There is little, if any, opposition to a "divisible" copyright. As to item (5), relating to oral works, there is no controversy since it is generally agreed that a work must be embodied in a "writing", i.e. that it must be reduced to a form from which it can be read or reproduced.

It is also significant that none of the other items highly controversial in 1940 represent insurmountable obstacles today. The manufacturing clause as it relates to works of foreign origin has been eliminated under the Universal Copyright Convention, and there has been no suggestion that it should remain a condition for protection of the works of our national authors. No proposals have been made for retroactivity or for statutory protection of an author's "moral" right. Such matters as performance rights and statutory damages provide areas in which accord can be reached if the structure of the law is sound. The elimination of the compulsory license is still a controversial factor, but straws in the wind disclose that some accommodations are possible even in this sector.

Accordingly, the obstacles to revision insofar as they were rooted in conflicting interests of authors, publishers and so called users, no longer constitute the major problem today. There are, on the other hand, a number of new difficult factors, stemming from changes in conditions since 1909, upon which various interests have divergent views strongly held and vigorously advocated. These include the entire concept of corporate authorship and authorship of works made for hire; the questions of limitations upon outright sales by authors and the ownership of rights in extended terms granted under the new statute, or in renewals if there should be a renewal pattern. Other areas which require additional investigation and solution include photo duplication by libraries, full rights in recordings, in motion pictures and in music, the treatment of commercial uses such as the rental of books by lending libraries, and the use of material in a form other than in conventional text books for teaching purposes.

However, none of these new areas of difference concern the basic structure of a modernized copyright system. The solutions of these problems will

require intensive study, discussion and a willingness to reach accord and compromises. It is the writer's view that reasonable accommodations can be achieved in all of these areas.

Agreement upon the structure of a new statute will obviously not solve all of the problems which must be dealt with in arriving at an acceptable revision. It is, however, the first prerequisite, and agreement upon a sound structure will go far to make revision possible.

351. COPYRIGHT SYMPOSIUM ON GENERAL REVISION OF THE LAW, AMERICAN BAR ASSOCIATION Patent Trademark and Copyright Section.

(San Francisco, California, August 4, 1962)

Panel Discussion: "Revision of the Copyright Laws"

Moderator: Samuel W. Tannenbaum, Chairman, Copyright Division.

Introduction by Mr. Tannenbaum

In behalf of the Copyright Division of the Section of Patent, Trademark and Copyright Law, I extend cordial greetings to the officers of the Section, Chairman Joseph Gray Jackson, Chairman-Elect William E. Schuyler, Jr., Vice-Chairman Beverly W. Pattishall, Secretary Karl B. Lutz, members of the Council, Chairmen and members of Committees 301 to 307, and the members of the Section. We are also honored by the presence of Honorable Abraham L. Kaminstein, Register of Copyrights, to whom the Copyright Bar is especially indebted for the excellent studies completed under his supervision and his comprehensive Report to the Congress on the Revision of the Copyright Law. We are heartened by this fine attendance, not only of members of the Copyright Bar, but also of our brother members of the Patent and Trademark Bars, most of whom joined us at the Breakfast Meeting of The Copyright Society of the U.S.A., presided over by the President of the Society, Professor Harry G. Henn.

Our Copyright Symposium will continue the subject, "Revision of the Copyright Law". [*Ed.*: For a report of the 1961 Symposium entitled "Copyright Office Recommendations for Revision of the United States Copyright Law," see 9 BULL. CR. SOC. 7, Item 1 (1961).] Our first speaker is Melville B. Nimmer, a member of the Panel of Experts on the Program for Revision of the Copyright Law and a professor of law at University of California Law School, Los Angeles.

352. SIGNIFICANT COPYRIGHT DECISIONS AND LEGISLATION OF THE PAST YEAR

By MELVILLE B. NIMMER*

The following represents a summary of and commentary on those copyright decisions rendered during the past twelve months which appear to be of greatest significance in shaping the law of copyright. Several important items of proposed copyright legislation are presently being considered by the Congress. Since these items have not as yet been enacted into law, they may not properly be considered in this report.

Orgel et al. v. Clark Boardman Co. Ltd. et al., 301 F. 2d 119, 133 U.S.P.Q. 94 (2d Cir. 1962) [*digested* 9 BULL. CR. SOC. 395, Item 263].

Facts and Proceedings Below: Plaintiffs, the author and publisher of Orgel on "Valuation Under Eminent Domain" brought an action for copyright infringement against the author and publisher of Jahr on "Eminent Domain—Valuation and Procedure". On the issue of infringement the District Court held for the plaintiffs and referred the issue of damages to a Special Master. 128 U.S.P.Q. 520 (S.D.N.Y. 1960). The Special Master found that the recovery of profits to plaintiffs should be limited to 35% of the net profits derived by defendants from the infringing work since only 35% of the infringing work consisted of material copied from plaintiffs' work. Accordingly, since the defendants' net profits amounted to \$12,849.32, the Master awarded to plaintiffs 35% thereof, or \$4,497.27. However, the Master added an additional \$7000 to the award of damages "to provide just compensation for the wrong", thus making a total award of \$11,497.27. The District Court thereafter modified the Master's award, 128 U.S.P.Q. 531 (S.D.N.Y. 1960), by striking the award of \$7000 damages, but increasing the award of profits to 100% of the defendants' profits, or \$12,849.32. The District Court reasoned that in the absence of evidence that defendants' profits were in any part due to the non-infringing 65% of their work, it must follow that plaintiffs are entitled to 100% of defendants' profits.

Holding on Appeal: The Court of Appeals affirmed the District Court's holding of infringement, and the finding that approximately 35% of defendants' work was copied from plaintiffs' work. The Appellate Court further agreed with the District Court that the award of profits need not be limited to 35% simply because that represented the quantitative proportion of infringing material. The Court of Appeals, however, concluded that the District Court erred in not providing for some apportionment in awarding profits even in the

* Member of the California Bar (Los Angeles); member of the Editorial Board, BULLETIN of the Copyright Society of the U.S.A.

absence of evidence on this issue. Accordingly the Court of Appeals ordered that the award of profits be reduced from 100% to 50% of defendants' net profits (the award of attorneys' fees was also reduced from \$10,000 to \$5,000).

Comment: This case raises anew the problem of apportionment of profits where the infringing work intermingles non-infringing material with the plaintiff's protectible material. The early rule, *Callaghan v. Myers*, 128 U.S. 617 (1888), that the defendant is liable for 100% of his profits where he has caused such intermingling, was modified but not overruled by the Supreme Court in *Sheldon v. Metro-Goldwyn Pictures Corp.*, 309 U.S. 390 (1940). In the *Sheldon* case it was held that there may be apportionment of profits "where it is clear that all the profits are not due to the use of the copyrighted material, and the evidence is sufficient to provide a fair basis of division . . ." The *Sheldon* opinion, however, validated the *Callaghan* rule where the court finds it impossible to separate the profits that derive respectively from the infringing and non-infringing material. Since the Court in *Sheldon* concluded that the evidence was sufficient to provide a fair basis of division (albeit not with mathematical exactness), it affirmed the award of the Court of Appeals, 106 F. 2d 45 (2d Cir. 1939), of 20% of the net profits to the plaintiff. Other courts have since applied the same 20% rule of thumb apportionment in motion picture infringement actions, *Universal Pictures Co. v. Harold Lloyd Corp.*, 162 F. 2d 354 (9th Cir. 1947); *Twentieth Century-Fox Film Corp. v. Stone-sifer*, 140 F. 2d 579 (9th Cir. 1944) and in one action involving an infringing legitimate state production a 35% apportionment was awarded, *Harris v. Miller*, 57 U.S.P.Q. 103 (S.D.N.Y. 1943).

The *Orgel* decision is significant in that it further circumscribes, if it does not completely obliterate, the remaining force of the *Callaghan* rule as it emerged after the *Sheldon* decision. Learned Hand in the *Sheldon* Court of Appeals opinion, apparently approved by the Supreme Court, carefully distinguished *Callaghan* as holding merely that a defendant will be held for 100% of the profits from an intermingled work where "he makes no effort to discharge the duty resting upon him" to show what portion of his profits are attributable to the infringing material and what portion to the non-infringing material. Judge Hand and the Supreme Court found that such a showing had been made in *Sheldon* and consequently apportionment was there proper. However, in *Alfred Bell & Co. v. Catalda Fine Arts*, 86 F. Supp. 399 (S.D.N.Y. 1949), modified on another point, 191 F. 2d 99 (2d Cir. 1951), the defendant was held liable for 100% of his profits precisely because (despite the testimony of one witness) it had failed to make a clear showing that its profits were only in part attributable to the plaintiff's material. In *Orgel* the defendants failed to offer any evidence on this issue. Accordingly a strict application of the *Callaghan* rule as interpreted in *Sheldon* would have required an award

of 100% of defendants' profits. In nevertheless decreeing a 50% apportionment, the *Orgel* court simply made its own comparison of the infringing and non-infringing material contained in the defendants' work and concluded that the latter was "needed and useful in approximately the same degree" as the former. The *Orgel* court may have believed itself qualified to make such a judgment, despite the absence of evidence, because the subject matter happened to be a law treatise. The opinion, however, does not suggest such a limitation, and may well constitute an implicit overruling of Judge Hand's characterization in *Sheldon* of the *Callaghan* rule that "an infringer carries the burden of disentangling the contributions of the several factors which he has confused."

Klasmer et al. v. Baltimore Football Inc. et al., 200 F. Supp. 255, 132 U.S.P.Q. 36 (D.C. Md. 1961) [*digested* 9 BULL. CR. SOC. 257, Item 155].

Facts: Klasmer and Lombardi were co-authors of the official theme song for the professional football team, the Baltimore Colts. The song was copyrighted as an unpublished work in 1947, and with the authors' consent was printed in the programs distributed by the Colts at their football games. It was also widely published and performed in diverse other ways, including performances on broadcasts of the Colts' games sponsored by the defendant, National Brewing Company. Although the song was first published in 1947, it was not redeposited as a published work until December, 1959. The present action for copyright infringement was brought by Lombardi and Klasmer's administratrix against the third successive owner of the Baltimore Colts and the sponsor of the broadcasts of its games. Certain additional pertinent facts are set forth in the comments which follow.

Holding: For defendants, on the cumulative grounds that (1) the plaintiffs' copyright had been forfeited by publication with defective notice, (2) abandoned by failure to assert rights for a long period including failure to redeposit as a published work for a period of some twelve years, and (3) in any event the copyright had been assigned by plaintiffs to the prior Colts corporation.

Comment: The decision might have rested solely on the grounds that plaintiffs had assigned away their copyright prior to filing the present action (although the evidence supporting this finding might have been subject to attack in that no written copies of the assignment could be produced) or on the grounds of a general publication of the work without any copyright notice affixed thereto (although as to the music, such publication having been made only to the Colts and to certain bands in the Baltimore area without charge, this might properly have been regarded as a limited publication—see *Hirshon*

v. *United Artists Corp.*, 243 F. 2d 640 (D.C. Cir. 1957)). The more questionable aspects of this case, and those which are most significant for future cases are discussed below.

Defective Notice: In addition to the publications referred to above which were made without any notice, the court further found that certain other publications were made with defective notice, and that this, too, constituted grounds for forfeiture of plaintiffs' copyright. The notice was held to be defective because it contained not only the names of Klasmer and Lombardi but also that of "The Baltimore Colts" at a time when no assignment of copyright had been made to the Colts. The notice was thus found defective even though it was in proper form and content but for the surplusage of an additional name of one who was not a co-owner. This, it is submitted, is an overly rigid application of the notice requirement. It is to be contrasted with the Supreme Court decision that an erroneous registration of copyright in the name of two persons only one of whom was the true copyright proprietor would not invalidate the copyright, at least where the defendants were not thereby misled. *Callaghan v. Myers*, 128 U.S. 617 (1888). It is further to be compared with a current case, *Prestige Floral v. California Artificial Flower Co.*, 201 F. Supp. 287, 132 U.S.P.Q. 350 (S.D.N.Y. 1962) [*digested* 9 BULL. CR. SOC. 254, Item 153], in which it was indicated that a copyright is not invalidated where two notices appear on a work, one of which is defective in form.

Abandonment by Failure to Deposit: Much the most significant aspect of the *Klasmer* opinion is its suggestion that an inference of abandonment of copyright may be drawn from the fact that the plaintiffs failed to deposit their work with the Copyright Office for some 12 years after publication. If this suggestion is followed in future cases it may well vitiate by indirection the rule of *The Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939). In *Washingtonian* the Supreme Court held that the "promptly" deposit requirement of Sec. 13 of the Copyright Act (absent a demand from the Register) permitted deposit any time after publication and prior to filing an infringement action, regardless of the length of such an interim period. In reliance upon this rule many copyrights owners have deliberately failed to register and deposit their works, even though they by no means intend an abandonment. The courts have validated copyrights despite extensive delays between publication and deposit, in one case for as long as 27 years, *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F. 2d 406 (2d Cir. 1946). It would seem, then, that the *Klasmer* suggestion that failure to deposit for an extensive period is some evidence of an intent to abandon the copyright is not well taken. It has, moreover, been held that mere lack of action may not constitute an overt act necessary to establish abandonment. *Hampton v. Paramount Pictures Corp.*,

279 F. 2d 100 (9th Cir. 1960), but cf. *Atlantic Monthly Co. v. Post Pub. Co.*, 27 F. 2d 556 (D.C. Mass. 1928) and *J. K. Sandler & R. Robins Inc. v. J. P. Katz*, 20 Copyright Office Bull. 621 (S.D.N.Y. 1925). Nevertheless the *Klasmer* decision may well constitute a straw in the prevailing judicial winds, so that more than ever prudence, if not the rule of the *Washingtonian* case, dictates prompt deposit after publication whenever this is practicable.

Brandon Films Inc. v. Arjay Enterprises Inc., 133 U.S.P.Q. 165 (Sup. Ct. N.Y. 1962) [*digested* 9 BULL. CR. SOC. 339, Item 214].

Facts: Two motion picture films (not identified by name in the opinion) had been distributed and exhibited for over thirty years in the United States and abroad without bearing a proper copyright notice. In 1951, rights in the films were vested by the Office of Alien Property and thereafter licensed by the Attorney General to *Brandon Films Inc.* *Brandon* brought the present action against *Arjay Enterprises Inc.* for infringement of common law copyright. Plaintiff and defendant each moved for summary judgment. Defendant supported its motion by the claim that the films had entered the public domain due to publication without notice.

Holding: Plaintiff's motion was granted and defendant's cross motion was denied. The acts of distribution and exhibition did not constitute a publication so as to divest common law copyright.

Comment: This lower court opinion is significant because it represents one of the very few reported decisions squarely dealing with the issue of whether general distribution as well as exhibition of a motion picture constitutes a divestive publication.

The *Brandon* opinion cites two cases with opposite results. The court's reasoning in rejecting one such decision and following the other seems most questionable. First, the court rejected the holding in *Blanc v. Lantz*, 83 U.S.P.Q. 137 (Calif. Supr. Ct. 1949), that distribution and exhibition of a motion picture constitute a general publication. The basis for the rejection was the fact that the *Blanc* case was decided under "a peculiar California statute defining publication which has since been repealed." It is true that *Blanc* was decided at a time when Calif. Civil Code Sec. 983 provided that property rights in "a product of the mind" were lost if the owner thereof intentionally "makes it public". Thereafter, Sec. 983 was amended with respect to compositions "in letters or art" to provide that divestment occurs if the owner "publishes" same. Implicit in the *Brandon* court's reasoning is the assumption that "makes it public" means something different than the copyright term "publishes". This ignores, however, a more recent California decision, *Smith v. Paul*, 174 Cal. App. 2d 804, 345 P. 2d 546 (1959), which expressly holds that both terms refer to the common law copyright concept of publication.

This is not to say that the *Blanc* case itself may not be questionable law, at least insofar as it suggests that performance alone may constitute a divestive publication. But if *Blanc* is to be challenged or distinguished, it must be done on grounds other than the meaning of the prior California statute. (Judge Stevens in the *Blanc* opinion suggests but then retreats from relying on a distinction between "makes it public" and "publication".)

But if the grounds for the *Brandon* rejection of *Blanc* are questionable, its acceptance of the other cited opinion, *De Mille Co. v. Casey*, 121 Misc. 78, 201 N.Y. Supp. 20 (Sup. Ct. 1923), as controlling authority seems even more unjustified. The *DeMille* case merely held that performance and distribution of a motion picture film did not necessarily constitute a publication of the underlying play upon which the film was based. (Cf. *O'Neill v. General Film Co.*, 171 App. Div. 854, 157 N.Y. Supp. 1028 (1916).) It did not rule on the question of whether such acts constituted a publication of the film itself. It is this latter question which was before the *Brandon* court.

It is submitted that the *Brandon* decision was correct insofar as it held that mere exhibition of a motion picture film does not constitute a publication (see *Tiffany Productions, Inc. v. Dewing*, 50 F. 2d 911 (D.C. Md. 1931); *M.G.M. Distr. Corp. v. Wyatt*, 21 Copyright Office Bull. 203 (D.C. Md. 1923); but cf. *Kaplan v. Fox Film Corp.*, 37 U.S.P.Q. 248 (S.D.N.Y. 1938)), but was in error in holding that unrestricted distribution of a motion picture is not a general publication. Although apart from the *Blanc* case there are no express prior holdings on this latter question, *Patterson v. Century Productions*, 93 F. 2d 489 (2d Cir. 1937), in holding that a limited distribution for non-commercial purposes was not a general publication of a motion picture film, seems clearly to imply that a general unrestricted distribution would constitute a general publication. (See also *Jewelers Mercantile Agency Ltd. v. Jewelers' Weekly Pub. Co.*, 155 N.Y. 241, 49 N.E. 872 (1898), by analogy.)

The result in the *Brandon* case, if followed, would mean that motion picture producers may retain perpetual ownership via common law copyright since sale, rather than leasing, of films is rare. It seems unlikely that this result was intended by Congress, or that it will achieve pervasive judicial recognition.

Lahr v. Adell Chemical Co. Inc. et al., 300 F. 2d 256, 132 U.S.P.Q. 663 (1st Cir. 1962) [*digested* 9 BULL. CR. SOC. 383, Item 257].

Facts and Proceedings Below: Plaintiff Bert Lahr brought an action for unfair competition, defamation and invasion of privacy. He alleged that defendants in advertising their product "Lestoil" on television used as a "commercial" a cartoon film of a duck whose voice was supplied by an actor imitating the distinctive and widely known vocal sounds of the plaintiff. He further alleged that the television audience and the entertainment industry believed that the

duck's voice was in fact supplied by the plaintiff. The District Court dismissed the complaint for failure to state a cause of action.

Holding: Judgment of dismissal vacated, and case remanded. The Court of Appeals agreed that no cause of action for invasion of privacy had been stated. (Note that the court considered only the laws of Massachusetts and New York applicable, and found that Massachusetts has not recognized the right of privacy, and that the statutory right in New York did not offer relief in these circumstances.) However, the appellate tribunal held that causes of action had been stated both for defamation (without attempting to distinguish between libel and slander) and unfair competition.

Comment: Although this is not strictly a copyright case, it is of significance to the Copyright Bar in that it represents the latest judicial contribution to the slowly developing doctrine of neighboring or performers' rights. True, the *Labr* court expressly disclaimed invoking any property theory, and in this respect departed from the conceptual approach of European theorists and some prior American cases (e.g. see *Ettore v. Philco Television Broadcasting Corp.*, 229 F. 2d 481 (3d Cir. 1956); *Waring v. WDAS Broadcasting Station, Inc.*, 327 Pa. 433, 194 Atl. 631 (1937); *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F. 2d 657 (2d Cir. 1955)). In this respect, *Labr* suggests that neighboring rights may ultimately achieve American recognition in the manner that authors' so-called moral rights have been recognized. That is, not by express recognition, but rather through accepted doctrines of unfair competition (e.g. *Granz v. Harris*, 198 F. 2d 585 (2d Cir. 1952)) and defamation (e.g. *Clevenger v. Baker, Voorhis & Co.*, 8 N.Y. 2d 187, 168 N.E. 2d 643 (1960)).

In one respect *Labr* goes beyond what is generally contemplated as the scope of neighboring rights in that it affords protection against the appropriation not of a performance per se, but of the imitation of such a performance. However, the time-honored judicial practice of placing new wine in old bottles may prove a limitation on full recognition of neighboring rights. Thus, the *Labr* court found an action for defamation was stated because of the allegation that plaintiff's reputation was injured through the impression given that he was reduced to giving anonymous television commercials. "An allegation that an entertainer has stooped to perform below his class may be found to damage his reputation". But what if the defendants' use is in a medium and manner not inferior to that customarily employed by the plaintiff? It would seem that under the *Labr* court's reasoning no defamation results, and yet the value of that which has been appropriated from the plaintiff may be even greater than where the use is in an inferior medium. Similarly, the *Labr* court found an action for unfair competition to be stated because of the passing off which resulted from the false impression given that the audience was hearing Lahr's

voice. Yet, plaintiff's loss would seem to be no less real even if a disclaimer had been included, indicating that the voice was merely an imitation of Lahr. However, it is to be noted that the *Lahr* opinion further hints that appropriation without passing off may be actionable. "It could well be found that defendant's conduct saturated plaintiff's audience to the point of curtailing his market. No performer has an unlimited demand." This seems to raise the possibility that in a type of dilution theory of unfair competition lies the future of the American version of the doctrine of neighboring rights.

In the remaining time and space the following additional cases may be briefly noted:

Doran v. Sunset House Distr. Corp., 197 F. Supp. 940, 131 U.S.P.Q. 94 (S.D. Calif. 1961) [*digested* 9 BULL. CR. SOC. 165, Item 75], *aff'd* (but possibly limited), 134 U.S.P.Q. 4 (9th Cir. 1962).

Significant Point: This case contains the questionable holding that the originality necessary to support an otherwise unoriginal work may be found in the fact that plaintiff was the first to embody the work in three dimensional plastic form.

Royalty Designs Inc. v. Thrifticheck Service Corp., 204 F. Supp. 702, 133 U.S.P.Q. 148 (S.D.N.Y. 1962) [*digested* 9 BULL. CR. SOC. 392, Item 261].

Significant Point: A copyright notice placed upon an integral part of a work is properly affixed even if such part is detachable. Cf. *Trifari, Krussman & Fishel Inc. v. B. Steinberg-Kaslo Co.*, 144 F. Supp. 577 (S.D.N.Y. 1956); Copyright Office Reg. Sec. 202.2(b)(9) and (10).

Wihol v. Crow, 199 F. Supp. 682, 132 U.S.P.Q. 392 (S.D. Iowa 1961) [*digested* 9 BULL. CR. SOC. 331, Item 210].

Significant Points: 1. Unauthorized copying and arranging by a teacher where the copies are used without charge exclusively by the teacher's own students held to be a fair use.

2. A state school district held immune from liability for copyright infringement under the state law doctrine of governmental immunity from tort liability. (*Note:* It is submitted that the fair use and tort immunity holdings in this case make it potentially of very great significance. Detailed analysis and comment has not been made because the writer is currently representing the plaintiffs on appeal before the Court of Appeals.)

Dan Kasoff Inc. v. Gresco, 204 F. Supp. 694, 133 U.S.P.Q. 438 (S.D. N.Y. 1962) [*digested* 9 BULL. CR. SOC. 404, Item 267]; and *Prestige Floral v. California Artificial Flower Co.*, 201 F. Supp. 287, 132 U.S.P.Q. 350 (S.D.N.Y. 1962) [*digested* 9 BULL. CR. SOC. 254, Item 153].

Significant Point: These cases carry the doctrine of *Mazer v. Stein*, 347 U.S. 201 (1954), to its farthest point to date in holding the following to be protectible "works of art": an ornamental ring box with a highly stylized cover (*Kasoff*) and an artificial reproduction of a flower (*Prestige Floral*). See also *Royalty Designs Inc. v. Thrifticheck Service Corp.*, *supra* (copyright in a "doggy" bank upheld).

Public Affairs Associates v. Rickover, 132 U.S.P.Q. 535 (U.S. 1962) [reported also, 9 BULL. CR. SOC. 321, Item 205]; and *Miller v. Universal Pictures Co.*, 10 N.Y. 2d 972, 180 N.E. 2d 248, 224 N.Y.S. 2d 663, 132 U.S.P.Q. 77 (1961) [reported also, 9 BULL. CR. SOC. 168, Item 78].

Significance: These cases are substantively important only insofar as they affect prior lower court decisions. *Rickover* vacated for insufficient record the Court of Appeals decision, 284 F. 2d 262 (D.C. Cir. 1960). *Miller* affirmed without opinion the Appellate Division decision, 11 App. Div. 2d 47 (1960), but see dissent by Burke, J.

353. OWNERSHIP OF COPYRIGHTS

By SEYMOUR M. BRICKER*

The recommendations of the Register of Copyrights relating to copyright ownership are divided into four broad classes: those affecting (1) initial ownership, (2) co-ownership, (3) the transfer of rights, and (4) the execution and recordation of transfers. One of the difficult problems in preparing this type of talk is determining the subjects to be excluded. Since I cannot do justice to any topic if I attempt to cover all of the recommendations, I have decided to discuss the recommendations which appear to me to be the most important, or, to put it another way, the recommendations which are most interesting to me. I am, for example, completely omitting the recommendations dealing with the execution and recordation of transfers. These recommendations are more technical than the others, and could not be adequately covered in the time which could be allotted to them. For the omitted proposals, I direct your attention to the Register's excellent report and the supporting studies.

1. INITIAL OWNERSHIP

With reference to initial ownership of copyright, the Register proposes that, in general, copyright may be secured by the author or his representatives, successors or assigns. This recommendation is substantially the same as the provision in our present Act; and should cause no problem. The Register also proposes the continuation of the present exception to the general rule, namely, that in the case of a work created for an employer by an employee, the employer should have the right to secure copyright. This recommendation is likely to meet with some opposition and it might be helpful to discuss it in some detail.

The employment exception is, of course, a codification of the common law. The philosophical justification for the rule and its continuance is that the motivating factor in the production of the work is the employer who induces its creation. Therefore, the employer can be considered as a kind of creator. The employee is paid for his work, whether good, bad or indifferent, and the employer, since he bears the risk of loss, should reap any gain.

It has been contended that the author is intended to be the primary beneficiary of copyright and that, therefore, the employer should acquire only a "shop right" in the work or, at most, an exclusive license for a limited period to use the work in his regular business activities. Similar results have been

* Member of the California Bar (Los Angeles); Vice-Chairman, A.B.A. Committee 304, Program for the Revision of the Copyright Law.

accomplished through collective bargaining agreements. In the motion picture and television industries, employee writers have been successful in reserving substantial rights in works created under employment contract, both by additional payments for specified uses of the work and by retention of rights in non-competitive fields. It is possible for men familiar with an industry to agree on such matters around a bargaining table. However, it would be impracticable and, in fact, undesirable to attempt to devise a copyright law to cover all industries or proposed uses.

Insofar as the copyright law is concerned, the work of an employee should be transferable and subject to the employment contract. Starting with this premise, I favor the Register's recommendation. The present rule is in accord with the result that will usually be brought about by contract. It does not prevent individual employees with sufficient bargaining power or groups of employees through guilds and unions from reserving rights in their material. In the fields with which I am familiar, employee writers have been very successful in these endeavors.

There are, however, two changes proposed by the Register relating to the employment exception with which I disagree.

The present Act covers "works made for hire", and the Register proposes that the language be changed to "works created by an employee within the regular scope of his employment" as being more precise. It has been contended that the phrase "works made for hire" might be held to include works created by an independent contractor on a commission basis. The only cases with which I am familiar which include a commissioned work as a work made for hire, hold that the copyright in a portrait or commercial photograph belongs to the person commissioning the work rather than to the photographer. Time does not permit an examination of the rationale of these decisions, but in my opinion, they are sound and should not be changed. *Yardley v. Houghton Mifflin Co.*, 108 F. 2d 28 (2d Cir. 1939), is often cited by commentators as holding that a work of art created on commission is a work for hire. I do not so read the decision. Although the court did rely on the well-established rules relating to photographs, I believe the court was merely construing the contract between the parties. The court did not hold that the mural in that case was a work made for hire. On the contrary, there is dictum to the effect that renewal rights went to the author's executor. If the court felt that the mural was a work made for hire, renewal rights would be vested in the employer.

The Report acknowledges that the courts have not generally regarded commissioned works as "works made for hire." Since a new Act will undoubtedly create many problems for the courts, we should not add to the confusion by changing language which has worked satisfactorily.

The Register also proposes the deletion of the present provision defining "author" as including "an employer in the case of works made for hire". As

a substitute, the new Act would contain a provision that the right to secure copyright vests in the employer.

The constitutional provision upon which our copyright law must be founded requires that there be an author. If the employer is not the author, then the employee must be. A number of needless problems then arise. As one example only, the Register proposes, and I believe correctly, that the new Act extend to all foreign and domestic works on the same basis, with a proviso authorizing the President to withhold, suspend or restrict statutory protection for the works of the nationals of any country. If the President should exercise this right with respect to a particular country, the American employer of a national of that country would be denied the right to secure copyright.

The Report does not indicate that there is any intention to change existing law. The only reason given for the recommendation is that the employer is not really the author, and should not be designated as such. Here again, it seems to me that the proposal can only create a confusion which does not now exist.

In the area of initial ownership, the Register also proposes that in the case of periodicals, encyclopedias and other composite works containing the contributions of a number of authors, the publisher should have the right to secure copyright, with the proviso that the publisher should be deemed to hold in trust, for the author, all rights in the author's contribution other than right to publish it in a similar composite work and any other rights expressly assigned to the publisher. The recommendation creates a presumption which will control in the absence of express contract. I do not have enough experience in the encyclopedia, dictionary or similar fields to comment broadly on the proposal. However, in the magazine field, it is my experience that the proposed presumption states generally the usual intent of publisher and author. In line with my general thinking that the new Act should preserve existing trade practices, wherever possible, I favor the proposal.

2. CO-OWNERSHIP

The second general area dealt with in the Report is that of co-ownership of copyright. We here deal with the legal relationship which arises when two or more persons own undivided interests in the same copyright. Co-ownership can arise in many ways. For example, a work may be created by two or more persons; a copyright owner may give, assign or bequeath undivided interests in the same copyright to more than one person; or the renewal copyright may be held by several members of one class.

Our present statute is silent on the subject of co-ownership. The terms "author" and "proprietor" always appear in the singular. The courts, therefore, have been required to fill the void and the major incidents of the relationship spelled out by decisions are, first, that a co-owner may himself use,

or grant a non-exclusive right for the use of, the work, and second, that the using or licensing co-owner must account to his co-owners for profits.

There has been some impetus in this country toward the adoption of a rule requiring the consent of all co-owners to any use or license, with some procedure, however, for forcing an unreasonably recalcitrant co-owner to join in the proposed use or license. Many foreign countries have similar rules which obviously do afford a high degree of protection to the property rights of the co-owners. The present American rule, however, has the virtue of permitting the widest possible dissemination of the work and is, therefore, in the public interest.

In addition, our present rule need not prejudice the rights of a non-consenting co-owner. He is entitled to an accounting of the profits made from the use or licensing of the work and, moreover, in my opinion, the courts will not permit a co-owner to deal with the work fraudulently or in bad faith to the detriment of his co-owner. Sound legal theories are available to prevent such an act.

The Register favors the continuation of our present rules dealing with the incidents of co-ownership and sees no need for their codification in the new statute. I favor this recommendation.

One of the most perplexing questions in the field of co-ownership is the rather basic one of what constitutes a work of joint authorship. Here again, the present statute is silent. Until the "Melancholy Baby" and "Twelfth Street Rag" cases, the sole criterion was the intent of the authors at the time of creation. If each author intended that his contribution be combined with the contribution of others into a single work, the resulting product was a work of joint ownership. It was not necessary that the co-authors make changes in each other's contributions, work together, know each other, or even write at the same point in time.

This rule was stretched in the "Melancholy Baby" case and broken in the "Twelfth Street Rag" case. In the latter, the composer of an instrumental song transferred his copyright to a publisher. Two years later, the publisher, without the consent or authorization of the composer, hired a writer to prepare a lyric. The court held that the resulting song was a joint work.

The case has been vigorously criticized and, in fact, is difficult to defend on traditional legal grounds. In my opinion, both "Melancholy Baby" and "Twelfth Street Rag" are examples of a fundamental rule of the common law—hard cases make bad law. Both cases dealt with that purely American phenomenon, the renewal system, and also with that rather unique institution, the popular song. In the "Melancholy Baby" case, no renewal application had been filed on behalf of the lyrics. Therefore, if the court found that the song was a composite work, the lyrics would have fallen into the public domain. By finding the song to be a joint work, the court held that the renewal appli-

cation filed protected the entire song. In recent years, the courts have strained to avoid throwing valuable rights into the public domain. In the "Twelfth Street Rag" case, the court pointed out that if the song was not a joint work, the lyric writer would have "but a barren right in the words of a worthless poem, never intended to be used alone." The court obviously did not consider such a result to be equitable.

The Register recommends codifying the definition of joint authorship as a work created initially by two or more authors with the object of integrating their contributions into a single work. I favor the proposal to define "joint authorship" in the new statute, but I have reservations about the proposed definition insofar as it applies to songs. This undoubtedly results from my partiality to good lyrics. I am reminded of Mrs. Hammerstein's alleged reply to someone who referred to Jerome Kern's "Old Man River." Mrs. Hammerstein is reported to have said that Jerome Kern only wrote "Da da da-da" and that her husband wrote "Old Man River."

Lyrics often play a major part in establishing the popularity of a song. However, the more popular a song becomes, the less important become the lyrics. The music itself brings the title and all or part of the lyrics to the mind of the listener. This principle is often used in motion picture background music. When the producer wants to establish mood or locale quickly, he often uses a few bars of a well-known song as instrumental background music.

Under the proposed definition, the author who writes a poem and later consents to the addition of music, and the lyric writer who adds words to an already existing instrumental piece, will be at a disadvantage because the song will not be a joint work. When such a song reverts to the authors, whether because of renewal rights or pursuant to agreement with the original publisher, the composer will own a much more valuable property. The lyricist can protect himself by contract at the time the words or music, as the case may be, are added, but I am not convinced that this is where the burden should be placed.

3. TRANSFER OF RIGHTS

Two most important recommendations have been made by the Register relating to transfer of rights—(1) the specific recognition of complete divisibility of copyright, and (2) a limitation on the duration of lump sum assignments. My personal interest is in the second proposal, and I will therefore speak briefly on divisibility.

A federal district judge in *Roberts v. Myers*, 20 Fed. Cas. 898 (1860), specifically found that copyright was divisible and that the author could convey a portion of his rights. Despite that opinion, however, the copyright law followed the patent case of *Watterman v. Mackenzie*, 138 U.S. 252 (1891), into the troubled waters of indivisibility.

The economic value of copyright to the author arises from the many uses which may be made of his work today and from his ability to deal separately with the bundle of rights which comprise the copyright. Each successful use of a work increases the value of the author's reserved rights. Any concept which hinders or impairs the author in transferring separate rights to his work does him a disservice without any corresponding benefit to the public.

It is true that today we seem to have indivisibility as law but divisibility as accepted commercial practice. Many of our trade customs, however, rest on a shaky legal foundation. Numerous cases hold that if an author retains a part of the rights in his work, his transferee is not a proprietor entitled to secure copyright, but a mere licensee. A publication with notice of copyright in the name of licensee will throw the work into the public domain. Despite the cases, however, publishers, particularly in the periodical field, whose right to be called proprietors of the works may be seriously questioned, often secure copyright. This is usually based on a contract which transfers the right to secure copyright to the publisher with an obligation on the part of the publisher to assign the copyright back to the author, subject to the publisher's rights, or on a so-called trade custom for the publisher to secure copyright and hold it in trust for the author. We should not risk the possibility of a court's holding the publisher to be a licensee in either or both of the foregoing instances.

I, therefore, agree with the Register's proposals that divisibility should be recognized, and that the transferee of any exclusive right in a work, without regard to the nature of the right or the duration or territory covered by the grant, should be the assignee and owner of the right. Fear of multiplicity of lawsuits against an alleged infringer can, to a large extent, be allayed by permitting the court, in its discretion, to require or permit joinder of any interested person.

The final recommendation I will discuss is the proposal that any assignment—including, if I understand the Report correctly, any exclusive license—by an author or his representatives or heirs, shall not be effective for more than twenty years from the date of its execution unless it provides for the continuing payment of royalties based on the uses made of the work or the revenue derived from it. The companion recommendation dealing with subsisting copyrights will be found in the chapter of the Report dealing with Duration of Copyright. Since I assume that Mr. Schaeffer will discuss the proposal as it relates to the subsisting copyrights, I will confine my remarks to the effect of the recommendation on copyrights secured after the passage of a new statute.

Many users of material will not be affected by the proposal. Authors of books, music and stage plays are usually compensated on a royalty basis. However, in the motion picture field, acquisition of basic material for a lump sum is still common. The Report contains the statement that in some situations—such as where a novel is converted into a motion picture—the payment of a

lump sum may be the only or most practical way of remunerating the author. Despite that statement, and without further comment, the Register makes a recommendation which discriminates against the motion picture producer for compensating the author in the only or most practical way.

Lump sum transfers are still common in the motion picture industry because a motion picture is a derivative use of the basic material in the development of which the talents of many persons are involved. Where publication rights in a novel are transferred to a publisher, it may be quite proper to compensate the author on a royalty basis in all cases. Although a good publisher may enhance the value of the novel by proper exploitation and distribution, fundamentally the success or failure of the novel depends on the work of the author. Where that same novelist, however, transfers motion picture rights in his novel, an entirely different situation emerges. What the producer adds to the novel in order to obtain a photoplay are the talents of a screenplay writer, director, stars and cast, composer, editor, costume designer, set designer and many others. It is often impossible to determine what ingredient or ingredients makes a motion picture a success. I am not in any sense minimizing the importance of the basic material. I am trying to show that it is only one of many important elements. Since the cost of the basic material is ordinarily a small fraction of the total cost of a photoplay, the producer can afford to pay a good price for the material without materially increasing his risk, while at the same time preserve for himself as much of the profits as he is able to keep from his stars—assuming, of course, that he is fortunate enough to have all elements jell into a successful motion picture.

The basic material for motion pictures comes from many sources—including one-page outlines, short treatments, original screenplays, and unpublished and published stories, novels and plays. The type of compensation that is fair for one need not be fair for another. Since highly developed material—such as successful novels and plays—is often purchased today for cash plus or against participations in gross receipts or net profits, the recommendation, in fact, discriminates against the producer in those very cases where he adds most to the basic material.

The Report contains another statement that deserves to be criticized. It reads as follows: "We suggest that a period of twenty years would be ample to enable a lump sum transferee to complete his exploitation of the work and to realize a fair return on his investment." Nowhere in the Report, or, so far as I know, in the Copyright Office studies, is there any evidence to support that suggestion. Anyone familiar with the motion picture industry can testify that many companies were saved from financial disaster by the release of their backlogs to television, and anyone familiar with television can testify that many of the motion pictures were more than twenty years old.

Having indicated why I do not believe that the recommendation will be acceptable to producers, I also want to say that I do not feel that the proposal is beneficial to the sellers of basic material. The Report proceeds on the assumption that royalty compensation is always more favorable to the author by permitting a greater grant of rights to the producer. I question the soundness of the assumption in the motion picture field. Which of the following offers for motion picture rights is more beneficial to the author of a novel—\$25,000 in cash or \$10,000 in cash against 5% of the profits of the picture? Glenn Ford is reported to have said recently that he was tired of having large profit participations in pictures that lost money and that he was going to increase his cash compensation in lieu of percentage compensation in the future. In my hypothetical case, the author must consider the possibility that the picture will not be produced; he must consider the reputation of the producer; and he must take into account that only a small percentage of pictures shows a net profit of \$500,000, which is the amount necessary for him to realize the full \$25,000. In addition, the author usually does not know at the time of sale whether the picture will be high or low budget, or who the screenplay writer, director or stars will be. In most cases, the author will be well advised to take the \$25,000 in cash and gamble the extra \$15,000 in Reno. His odds for winning will be greater. From the author's point of view, the difficulty with the recommendation is that if it achieves its objective of encouraging compensation on a royalty basis, a few authors will be benefited but many others will be hurt.

In dealing with the subject of transfer of rights, we should start with the proposition that authors, as other persons, are free to deal with their property as they desire. We should vary from this proposition only if we find that authors generally are not receiving a fair share of the economic value of their works and are being unfairly treated. This requires a factual survey into conditions in the copyright industries as they exist today, and we should not accept, without re-examination, general statements concerning the author's need for a second chance and the author's imprudence in business matters. What disturbs me about the recommendation is that, without evidence to show its need, it would disrupt current trade practices.

CONCLUSION

Before closing, I want to express my sincere admiration for the Register's Report. I realize that I have been critical of the Report in certain areas, but this does not detract from my opinion that the Register has performed a truly remarkable service. No report issued by the hand of man could possibly satisfy in all particulars the divergent interests which comprise the copyright field. I am, in fact, impressed by the number of recommendations on which there is substantial agreement.

A new Copyright Act is a necessity, and it is imperative that all interested parties make their views public as soon as possible. When all opinions have been aired, I believe that it will be possible to compromise the various conflicting views and to draft a bill which can be supported by the Copyright Bar and the copyright industries. " 'Tis a consummation devoutly to be wished."

DURATION OF COPYRIGHT TERM

By MORTON SCHAEFFER*

We have had 172 years of Statutory Copyright in the United States.

Today finds us again urgently pressing the necessity for an overall Revision of the Copyright Law which was last enacted in 1909, fifty-three years ago. So much has transpired in the last fifty years directly affecting copyright, that human comprehension could not possibly have foreseen the future.

Printing was a young art in 1909. The means of mechanical reproduction of sound and sight were swaddling infants. Radio and television as we know them today were not even on the horizon. Capturing sound on wire and tape, and reproduction on video tape could only have been envisioned by a Jules Verne.

Now as we labor on a Revision of the Copyright Law, perhaps we can use foresight in recognizing what the future may hold.

Laws and statutes do not just happen. They are the outgrowth of time, experience, public acceptance, and above all the dedicated effort of many.

One of the most important problems in the overall revision of the Copyright Law is duration. It is important because our thought and purpose as a nation is reflected by the products of originality as conceived by the human mind in the form of literature, music and the arts. We have made great strides in science and industry. It is just as essential that we improve and encourage our cultural advance.

Disraeli, the epitome of a man of letters, stated in a Parliamentary debate:

"There are works requiring great learning, great industry, great labor, and great capital, in their preparation. They assume a palpable form. You may fill warehouses with them, and freight ships. And the tenure by which they are held is, in my opinion, superior to that of all other property; for it is original. It is tenure which does not exist in a doubtful title, which does not spring from any adventitious circumstances. It is not found; it is not purchased; it is not prescriptive. It is original. So it is the most natural of all titles, because it is the most simple and least artificial. It is paramount and sovereign, because it is a tenure by creation. * * *"

This tenure by creation, when shall it begin and when shall it end? What statutory requirements shall be imposed during the time? Aye, that is the question.

* Member of the Illinois Bar (Chicago); lecturer on Copyright Law, Graduate Division, John Marshall Law School.

It was not until relative political liberty, the breaking down of the guild system, the rise of the fashionable author, and the great changes of the late 17th century in England came into being, that we find the first beginning of the now accepted theories of literary copyright. This led to the famous Statute of Anne, introduced in 1709 and passed March 1710, "For the Encouragement of Learning". This enactment gave the author of works, then existing, or his assigns, the sole right of printing for 21 years from that date and no longer; of works not then printed, for 14 years and no longer, except in case the author were alive at the expiration of that term when he could have the privilege prolonged for another fourteen years.

The Act of 1842 extended the period of copyright to the life of the author and seven years thereafter, or a period of 42 years, whichever should be longer. In spite of its defects, both in substance and in draftsmanship, it remained the governing statute of England as to literary copyright until it was repealed by the Copyright Act of 1911.

The Act of 1911, as well as the Copyright Act of 1956, provides that the term of copyright shall be for the life of the author and for a period of fifty years after his death.

The duration of copyright in the United States is circumscribed by the Constitution. It must be for a limited time and in the public interest.

The first Copyright Law of the United States was enacted in 1790. Only citizens of the United States could secure copyright, and the period was for 14 years with a renewal for the same number of years by the author, if living.

It was not until 1831 that musical compositions were afforded the protection of the copyright law. In this year the first term of copyright was extended to 28 years with a renewal of 14 years. The renewal was obtainable only by the author and if he be deceased by his widow or children at the expiration of the original term.

Under our present Act the total term of copyright protection is 56 years, a first term of 28 years, and a renewal term for an additional 28 years upon compliance with the special provisions of the Copyright Act. Protection begins for published works on the date of publication. If protection is desired for an unpublished work, then statutory copyright begins on the date of registration. However, a common law right exists in the author or proprietor of an unpublished work so long as it is unpublished and is not dedicated to the public. The common law right is a right in perpetuity.

We find that most of the countries throughout the world have adopted a period of copyright protection for the life of the author and 50 years after his death.

The United States is the only nation which limits copyright protection to 56 years.

It is not my intention to debate the subject but to present as objectively as possible the principal alternatives that have been suggested.

In connection with the revision as pertaining to the duration of the Copyright term, it appears that the period of copyright protection can be narrowed down to two schools of thought:

- I. For the life of the author and 50 years after his death, with a limitation of 50 years for corporate, anonymous or pseudonymous works.
- II. For a fixed period of 28 years with a renewal period of 48 years, or a total period of 76 years.

Let us first consider the life of the author and 50 years. The proponents of this position urge:

- a. It would do away with the common law right, and statutory protection would begin upon the creation of a work.
- b. It would avoid the distinction between published and unpublished works, and eliminate a definition of dissemination entirely.
- c. It would avoid the absolute necessity of a copyright notice, and thus prevent forfeitures by reason of omission of or an improper copyright notice.
- d. It would eliminate the renewal period with its besetting difficulties.

The need for the paternalistic attitude taken by Congress in 1909 that authors, composers and artists were irresponsible so that they needed the protection of a special law to provide for their inadequacies, no longer exists. Today there are many protective associations employing experienced counsel to protect the rights of authors, composers and artists.

- e. All of an author's works would go into public domain at the end of the 50th year after his death.

Proof of the date of death is generally much easier to ascertain than proof of the date of dissemination.

- f. No matter how many times a work had been revised, it would eliminate the difficulties of determining which portions were protected by copyright.
- g. It would bring our system of copyright parallel with the systems of most other countries, particularly those in which American books, plays, music and motion pictures have large audiences.

In so doing, it would eliminate the loss suffered by the nationals of those countries whose works would fall into public domain in the United States while still protected in their own country.

A new era has been heralded in live world-wide television transmission by the launching of "Telstar." This intensifies the international aspect.

- h. This period of duration has had the benefit of time, experience and public acceptance.
- i. No copyright would terminate during the lifetime of an author, and his family would be assured of the benefits thereof after his death.

No creator of a copyrighted work could outlive the protection afforded by this system.

The Register of Copyrights has proposed that statutory copyright shall begin on the public dissemination of a work, that is, publication, registration, public performance or public distribution of sound recordings. The copyright period would be effective first for a period of 28 years, with the right to make renewal application within the last 5 years of the first period by any person claiming any interest in the copyright. The additional period of 48 years would make the total life of the copyright 76 years. All terms would run to the end of the calendar year in which they would otherwise expire.

The proponents of this suggested revision as to duration press the following advantages:

1. It would be a simple matter to determine when a copyright terminated, as registration would be a primary inducement to preserve full protection.
2. The date of death of many authors under the duration of life and 50 years would be difficult to ascertain.
3. The same term would be applied to all works thus eliminating classifications of particular works.
4. Little change would be required in established practices of the industries dealing with copyrighted materials.
5. The period of 76 years is comparable to protection for the life of the author and 50 years.
6. Congress has consistently rejected a term of 50 years and life, and an extension of 20 years to the present 56 years would be more palatable.
7. The continuation of the renewal system would be liberalized by lengthening the time in which application of renewal could be made, thus preventing meritorious works from falling into the public domain.
8. A greater percentage of works which were copyrighted are not renewed, and there is no reason why they should be protected for a longer period.

9. All works would require registration and all published works would require a copyright notice and registration to preserve full rights.

This would serve the public interest by making available information regarding the copyright.

10. The certificate of registration would be *prima facie* evidence of copyright if timely filed.

The questions involving the duration of the copyright term cannot be summed up in a few words. Much earnest work has gone into the problems as evidenced by the exhaustive studies on the subject.

Briefly I have merely attempted to present the divergent points of view.

There are many conflicts on what should be revised in our Copyright Law. There is no doubt, however, that we desire to advance intellectually, culturally, and artistically as a nation, and to do so we must encourage the worthwhile arts by extending the period of copyright protection. It is, therefore, incumbent that we offer the greatest inducement and encouragement to those individuals whose creative ability will materially enhance our future.

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NON-INFRINGEMENTS USES

By JOSEPH A. McDONALD*

What is meant in the copyright field by "non-infringing uses"?

To define a non-infringing use, it seems to me, is very much like defining a "non-trespass".

As a first step in definition let us exclude all duly authorized uses. It would be a dull exercise to itemize and describe all uses which, by virtue of being authorized, do not constitute infringements.

At the same time let us not exclude uses which *may* constitute infringements under some circumstances. To do so would leave us with a sterile group of conservatively safe examples which are clearly not infringements in any case. Indeed a caustic student might observe that not only were they not infringements but that they probably ought not be called "uses" and that some of them at least should be disregarded under the doctrine of *de minimis*.

By "uses" in this context I mean the utilization, adaptation or employment, to a recognizable, appreciable extent, of copyrighted or copyrightable material. By "non-infringing uses" I mean uses which, while not expressly authorized or not impliedly authorized by word or conduct of the owner of the material, may be made without reasonable expectation that they will become, or could become, the subject of a successful suit for infringement. The difference between the criteria, "will become the subject of suit" and "could become the subject of suit", indicates the area in which causes of action exist at least technically but are likely not to be litigated because of various reasons generally referred to as the "practicalities of the situation".

Non-infringing uses are either "fair uses" as recognized in the decided cases or uses which are sanctioned by custom in the trade or in the business to which they relate. It might be argued that uses which are sanctioned by custom are impliedly authorized. This is true. However, such an authorization springs not from the owner of the material or his representatives but from the overall framework of creation, licensing and use in the field involved. Under such circumstances the authorization, express or implied, of the individual owner is not needed by the user.

1. The best known of all non-infringing uses is the "fair use" of literary material. The general concept of fair use is basic and simple but it is not always easy to apply. The criteria applied by the courts include the extent

* Member of the New York and District of Columbia Bars; member of the Board of Trustees, The Copyright Society of the U.S.A., and of the Panel of Experts on Revision of the Copyright Law; formerly General Attorney and Vice President, American Broadcasting Company; and Assistant General Counsel-Treasurer, National Broadcasting Company; now in private practice in Washington, D.C.

and relative value of the material taken, the purpose for which it was taken, the manner and extent of distribution of the work in which the taken material is incorporated and the effect of such distribution on the owner of the original work. Judge Yankwich covered the subject beautifully in an article published in 1954 entitled, *What Is Fair Use?* 22 U. of Chi. L. Rev. 201. In it, not confining his discussion to the literary review of books (which is, of course, a prime and understandable example of "use" which is clearly "fair"), Judge Yankwich said,

"If the amount reproduced is legitimately necessary to review the book, or is a part of a scientific or other exposition of the subject, in which the theories expounded by others must be discussed, the use, regardless of quantity, is fair. If, on the other hand, the appropriation of the copyrighted product of another is motivated by the desire to derive commercial benefit, the use, regardless of quantity, is unfair." (208, 9)

The doctrine of "fair use" is an equitable principle, the scope of which goes beyond the rights and wishes of the individual owner of material and includes a consideration of the common good. Fundamentally the determination of a fair use question involves the application of the basic golden rule to the underlying fact situation. The following paraphrasing of the rule, I suggest, is a good guide for users and for those reviewing the conduct of users: Take not from others to such an extent and in such a manner that you would be resentful if they so took from you.

The "fair user" may rely to a substantial extent on the generally held desire of the courts to encourage the free flow of information and discussion and to promote, rather than hinder, "the Progress of Science and useful Arts".

Two specific areas are deserving of mention in this respect. One is the field of science in which it is as natural as in book reviewing for substantial portions of writings to be excerpted and quoted as supporting proof or in connection with analysis and comparison or refutation.

Another special field is that of news. News itself may not be copyrighted. Copyright protects only the form of the expression of thought and to obtain redress for tampering with news content and with systems of collection and distribution of news requires the application of equitable principles outside the ambit of copyright. *International News Service v. Associated Press*, 248 U.S. 215 (1918).

In many instances, quite separate from any connection with the newspaper's book review section, news items are concerned with copyrighted material or with copyrightable material. The fact that a newsworthy figure has written and copyrighted a book is itself news and so is what he says in the book. Without doubt large portions of the material, as much as is necessary, may be quoted verbatim to tax the individual for inconsistency, for example, or to

establish the accuracy of a prediction or interpretation. The same reasoning would apply with even more immediacy and force to those speeches of public officials and others in the public eye in which individual rights of ownership in the material may exist. Assuming, for the purpose of this discussion, that a particular speech were copyrightable it is a foregone conclusion that any newspaper which wished to do so could, in covering the speech, quote from it as freely as the editor wished—even in its entirety—because not only that the speech was made, but exactly what the speaker said, was news.

2. An even older form of use of the material of others is the art and style of burlesque. Wide latitude is accorded the burlesquer, in the true sense, and to the parodist in the absence of what might be called over-commercialism. Akin to "fair use", much depends upon the manner of use and the purpose to which the use is put.

For example, a singer substituting lyrics for those in a copyrighted song in order to point up a dramatic situation or, in the interest of timeliness or humor to bring personalities and current events into the rendition of the song, need have little fear of committing an infringement. This is so even though we assume that the license under which the musical composition is performed authorized the performance of the song as written and not the performance of an infringing version. However, let the performer or his employer introduce a commercial note into the parody, i.e., let it be used in the form of an advertisement or "jingle", and he is headed for trouble.

The more traditional type of burlesque takes over an entire literary work and presents it in a different vein or key, usually satirical or simply humorous. Two beautiful, fairly recent examples providing a benchmark indicating how far a burlesquer may safely go are provided by the decisions in the Ninth Circuit in *Loew's Inc. v. C.B.S.*, 131 F. Supp. 165 (S.D. Calif. 1955), *aff'd*, 239 F. 2d 532 (1956), *aff'd*, 356 U.S. 43 (1957) and *Columbia Pictures Corp. v. N.B.C.*, 137 F. Supp. 348 (S.D. Calif. 1955).

The first dealt with the use by Benny and CBS of a droll, somewhat sophisticated version of the motion picture and play "Gaslight" on the Autolite program. The second dealt with a slapstick version by Sid Caesar of the motion picture "From Here to Eternity" broadcast on another commercial network program under the title From Here to Obscurity. As possibly indicated by the titles and by the distinctive style of the principal performers the Benny program was a more restrained, tongue in cheek, production using practically the same dialogue as the original but depending for its impact on timing. The Caesar production on the other hand was extremely broadly played with, to take the Beach Scene for example, the pounding surf breaking over the performers occasionally and even over the cameras. The script of the Benny take-off, studied in written form, more closely resembles the original work and while a television viewer of average discernment could readily tell that each produc-

tion was a burlesque of the original, the owner of the original material was successful in its suit in the Benny case and its counterpart was unsuccessful in the suit against Caesar. The rule of thumb seems to be: If you are going to be funny be obviously funny in your burlesquing.

3. A third type of taking which is generally recognized as permissible is the taking of the liberty to make and perform (but not to make and sell) special arrangements of popular musical compositions. The fact is that the owner of a musical copyright and everyone connected with him love to have the music performed frequently,—but not monotonously. On top of this it is well known that each group of instrumentalists and most vocalists have distinctive styles of presentation and delivery. A principal ingredient of this style is the nature of the special arrangement of the music, that is, the emphasis and phrasing and extent of embellishment and feeling with which the essential musical message of the composition is modified and embroidered for delivery. To reverse a well-known quotation:—"A melody is like a pretty girl". The copyright owner usually presents her in only one dress, his arrangement, and hopes she will be widely admired. But what girl wants to be seen in the same dress all the time? As a result, as long as the girl remains recognizable as his and is not held up to ridicule the owner cannot successfully object to others providing her with a change of wardrobe, more to their liking, for her performances.

4. One of the most interesting pairs of use practices, one non-infringing and the other infringing, is that of recording broadcast programs for what are known as delayed broadcasts. This is a good example of the development of a practice to the point where it is a built-in ingredient of the manner of doing business in one particular field followed by an abrupt change with respect to a newly developed portion of the field so that today both practices, diametrically opposite to each other, exist side by side.

In the early days of broadcasting each station desiring to broadcast a network program had to put the program on the air as it was being fed over the network inter-city lines or it was lost. There was no way of recording the programs for later broadcast. If it were desired to broadcast on the West Coast at 9:00 P.M., for example, a nation-wide network program which was scheduled to originate in New York at 9:00 P.M., New York Time, it was in those days necessary to send the network program out from New York twice in one evening. The program would be sent out to all affiliated stations in the Eastern and Central Time Zones at 9:00 P.M. New York Time and listeners in the Eastern Time Zone would hear it at 9:00 o'clock while those in the Central Time Zone would hear it at 8:00 P.M. Then at midnight New York Time the program would be repeated, actually produced a second time in its entirety in New York, and fed to stations in the Mountain and Pacific Time Zones,

arriving there and being broadcast at 10:00 P.M. and 9:00 P.M. respectively, as desired.

A portion of the problem, of great importance, involved the occasional inability of individual stations on the network to broadcast a particular network program because the stations were blocked by commitments to carry other programs at the time the network program was coming through on the network lines. Ambitious plans were made to meet these problems by recording the network programs off-the-line at the time of broadcast so that they might be broadcast later at the desired, or available, local time. However recordings then were made and played at 78 r.p.m. and less than five minutes could be recorded on one side of a platter. This would have involved using 3 or 4 separate discs for each fifteen minutes of programming and, while not impossible, it was wholly undesirable. In addition, a principal obstacle was the time lag required to produce a durable pressed copy which could be used for play-back.

Under the pressure of these demands the long-playing record was perfected to operate at 33-1/3 r.p.m., making it possible to record an entire fifteen minute program, or segment of a program, on one side of a 12" disc. At the same time the technique of recording and the materials used were improved so that there could be an instantaneous play-back of a recording on acetate with practically no loss of quality on the first playing. Since only one use was needed this was a perfect answer. This later play-back through the use of recordings came to be known as a "delayed broadcast" in the case of the blocked individual station.

The point of this lengthy description is that while much material of all kinds was recorded in this way no one thought of asking for a recording fee for a delayed broadcast and very few thought that the right to record should be cleared. The process was rationalized as a mere temporary suspension in point of time for a single use, within a reasonably short period, of material the performance of which had been cleared and would be paid for. It was equivalent to what would have happened had the engineers developed a means of keeping the signals whirling around the affiliates' master control rooms until the delayed broadcast time arrived, like stacked-up airplanes waiting for a clearance to land. Today most of this type of recording is done on tape but the same rules apply. When a radio program is recorded on tape or platters in advance for broadcasting, even for a one time performance, the recording rights are cleared but it is firmly established that the recording of material for "delayed broadcasts" does not require such clearance.

The interesting other side of the coin is that with the advent of commercial television in the late Forties, despite the existence of the precedent and custom in radio (or sound) broadcasting, it was necessary as a practical matter to recognize the recording rights as well as the performance rights in

music. A substantial part of early television network distribution was by mail or air express due to the scarcity of inter-city cables and circuits. This meant that practically all network programs had to be recorded at the time of broadcast or in advance of broadcast and procedures were established to procure authorizations from the owners of the recording rights in the musical compositions scheduled to be broadcast under the performing right licenses.

At present most of this recording is done on videotape but the legal consequences are the same and it is a fact of life that recording clearances must be obtained for music for delayed broadcasts in television but not for delayed broadcasts in sound broadcasting.

5. With a glance at the future there are other uses which may not be non-infringing but may possibly acquire that status. Time will tell.

The present wide-spread practice of making photocopies of all types and sizes and quantities goes apparently unquestioned. Students speculate as to the outcome and some copyright owners evidence concern but the practice rolls merrily on.

In the field of data storage and retrieval, recordings are constantly and almost indiscriminately made. This certainly involves the "making" of a "record" from which a work may in some manner be "reproduced" (Section 1(d)). It is true that it is the information itself, rather than the form in which it is set forth, that is retrieved but collections of data may be copyrighted. This may be an indication of the answer. It seems likely that the infringing or non-infringing status of a storage and retrieval system will depend on the nature of the protected work and the extent and purpose of the storage and retrieval of information from the work.

This returns us in our thinking to the elements of "fair use" and serves as a reminder, a welcome reminder, that whatever the speed and magnitude of scientific development, men will still be bound to apply basic rules of fairness. In an age of stainless steel we still strive to apply the Golden Rule.

356. THE CASE OF THE HORROR MONSTERS: ART AS LAW, ART AS FACT*

By JOHN F. WHICHER**

Once upon a time, children collected little pasteboard pictures, often in color, of famous baseball and football players, which were called "trading cards." The children got such cards as bonuses with their every purchase of bubble gum, and they made the cards so acquired objects of frequent barter and exchange among themselves. Happy was he who first completed a full set of pictures of the Yankee batting order! *Eheu, fugaces*: that innocent time is with us no more. Today's trading cards, sad to relate, are more likely to exhibit the dreadful features of Dracula or the Wolf Man than to display the pleasant smiles of Roger Maris or Mickey Mantle. This regrettable alteration in the objects of our juvenile commerce was brought to judicial attention not long ago by an unreported copyright suit heard in the United States District Court for the Eastern District of New York: *Universal Pictures Co., Inc. v. Nu-Cards, Inc.*¹

Nu-Cards, the defendant, was a small manufacturer of trading cards. It put out, in 1960, a series of "horror monster" cards, using (in most cases) miniature reproductions of publicity "stills" from motion pictures featuring these ghastly creatures of Gothic romance. Unfortunately, nearly a third of the cards in the series were unauthorized miniature reproductions of the publicity "stills" which the plaintiff, Universal, had originally created (and copyrighted) in connection with such chilling cinematic fare as "Blood of the Vampire," "The Return of the Creature," "The Thing That Couldn't Die," and the like.

While still unaware of Nu-Card's activities in this field, Universal had been dickering with a chewing gum firm which sought an exclusive license to reproduce all of Universal's "horror" stills on trading cards. The gum company's ardor for the deal, however, markedly cooled on the day it discovered that Nu-Cards was already forestalling the market for this novelty. Universal, thus suddenly apprised of Nu-Cards' activities, and faced thereby with the imminent loss of a profitable license of its copyrighted photographs, brought suit against Nu-Cards for infringement of its copyrights. At the outset of the case, of course, Universal moved for a preliminary injunction forbidding Nu-Cards to use the stills in question; and it obtained an *ex parte* temporary restraining order to that effect, pending a hearing on its motion.

* © 1962 by John F. Whicher.

** Member, New York Bar. A.B., Amherst, 1941; LL.B., Columbia, 1947.

1. Civil Action No. 61-C-144, U.S.D.C., E.D.N.Y.

Opposing that motion, Nu-Cards submitted affidavits and a very skillful brief in support of a wide variety of asserted affirmative defenses: license, forfeiture, estoppel, laches, and a claimed balance of equities in defendant's favor. In the event, however, none of its contentions proved persuasive. The plaintiff's motion was granted. Shortly after the order of preliminary injunction was entered, the parties settled their differences and a permanent injunction, coupled with a judgment for damages, was entered against the defendant on consent.

In all the preliminary argument over Nu-Cards' various defenses, however, one important question raised by Universal's motion passed almost without discussion. Universal had asked that the preliminary injunction restrain defendant not only from reproducing the particular photographs involved, but also from reproducing the "horror monsters" depicted in those photographs in *any* form or manner. In the brief submitted with its motion for such an injunction, plaintiff justified this request by reference to a line of cases which have held that the author of a series of cartoons is protected, by his copyrights, not only against copies of his particular cartoons, but also against reproduction of his original cartoon characters either by three-dimensional dolls,² or by performing actors on the stage.³ It was argued that Universal's "horror monsters" were entitled to the same broad protection as were the cartoon figures in those cases. When the court announced its decision to grant plaintiff's motion for a preliminary injunction, therefore, plaintiff naturally submitted a proposed order granting the broad restraint which it had demanded. Defendant thereupon submitted a counter-order which sought to confine the preliminary injunction to a prohibition against reproduction only of the particular photographs in suit.

It is not at all certain, however, that the Court was ever truly made aware of the question defendant thus meant to raise. Neither party filed a brief in support of its respective contentions on the proposed orders. It may well have seemed, to a busy Court, that the major apparent difference between the two orders submitted to it lay in the fact that defendant's counter-order contained no findings of fact and conclusions of law, as required by the Federal Rules,⁴ while plaintiff's proposed order conformed, at some length, to the procedural technicalities in this respect. Consequently, the Court's decision to sign and enter the plaintiff's order cannot be taken as a clear precedent for granting the broad relief which plaintiff had demanded (and secured) in this situation.

2. *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 276, 278 (2d Cir. 1934), cert. denied 294 U.S. 717 (1935); *King Features Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924).

3. *Hill v. Whalen & Martell, Inc.*, 220 Fed. 359 (S.D.N.Y. 1914).

4. Fed. R. Civ. P., Rules 52(a) and 65(d).

Had the point been argued, defendant's counsel might well have contended that the cartoon decisions were not in point. After all, a cartoon is not a photograph. When I direct the lens of my camera at a scene in the Adirondacks and click the shutter, I may copyright the resulting photograph, but I acquire no right thereby to forbid you to take another picture of the same scene. If I make and copyright a camera portrait of President Kennedy, I cannot prevent you from taking a picture of him as well. The cartoonist gets broad protection for the appearance and form of the characters presented by his comic strips because he *creates* them; but the photographer does not create the objects he photographs.

But such a contention, it might be answered, overlooks a key fact: though Universal's photographers do not create the horror monsters they photograph, Universal's make-up artists do. By molding foam rubber, nose putty, and false hair on an actor's face and body, they create a three-dimensional work, comparable in all respects to a sculptor's clay model molded upon a wooden or wire framework. The fact that a make-up artist builds his creature upon a *living* framework can hardly justify denying to him the same protection accorded to the sculptor; both realize, in the end, a three-dimensional figure which had its origins in the imaginative artistry of a human creator. In this view, the make-up artist's creation, like the sculptor's, is protectible by the Copyright Law as a "work of art."⁵

It cannot, in submission, be validly argued against this thesis that the monster make-ups are too ephemeral to be independently copyrightable. Some text-book authorities, to be sure, may be found to support such a contention;⁶ but the cases on which they rely to maintain the proposition that permanence of form is an essential prerequisite of copyright are all distinguishable.⁷ True, to be subject to copyright, an author's creation must necessarily be reduced to a form that may be copied; and this, in turn, implies *some* element of duration

5. 17 U.S.C. §5(g) and (h).

6. Warner, *Radio and Television Rights*, §104, pp. 280-82 (1953), citing *inter alia* Weil, *American Copyright Law*, 406 (1917).

7. Warner, *supra* note 6, fails to perceive that what Weil, *ubi supra* note 6, is talking about is not the permanence which a work must have to be copyrightable, but the permanence which an infringing copy must have if the infringement is not to be regarded as *de minimis*. See, on this distinguishable question, *Hanfstaengl v. Empire Theatre*, 2 Ch. 1 (1894); but cf. *Patterson v. Century Productions*, 93 F.2d 489 (2d Cir. 1937), cert. denied, 303 U.S. 655 (1938). Other cases which seem to support the notion that permanence is a prerequisite of copyrightability are: *Victoria Park Racing & Recreation Grounds Co. Ltd.*, 37 NSW 322, 38 NSW 33 (1937), denying copyright to information posted on a "tote" board; *Clayton v. Stone*, 5 Fed. Cas. 999, No. 2,872 (C.C.S.D.N.Y. 1829), denying protection to a daily publication of market price quotations. But as Weil points out, concerning the latter case, such decisions are "sustainable on the ground of lack of originality." Weil, *op. cit. supra*, at 226,

in the form. But, by hypothesis, our horror monster make-ups meet that test, for they survive long enough to be copied by photography. It may also, perhaps, be argued that ephemeral works, because of their rapid mortality, are intrinsically incapable of promoting the progress of human knowledge, and are therefore beyond the constitutional scope of American copyright protection.⁸ But the premise of such an argument does not withstand analysis. Jonah's gourd, which came up in a night and perished in a night, still managed, in the brief course of its existence, to teach Jonah and all mankind an imperishable lesson.⁹ Short-lived creations, we may conclude, can impart knowledge quite as effectively as permanent ones. The ephemeral character of the horror monster make-ups, therefore, would not deprive them of copyrightability.

Since both the make-up artist and the photographer work for Universal as employees for hire, Universal is the author, in the eyes of our Copyright Law, of the resulting product of their combined efforts.¹⁰ Consequently, Universal is just as much the creator of these monsters as cartoonists are the creators of the figures in their comic strips. Accordingly, the motion picture company should have the same broad protection for its photographs of such works as cartoonists have for their cartoon figures.

But how far may we carry this principle? Where do we stop, and why? If a theatrical make-up, embodied in a copyrighted photograph, is subject to collateral protection of this order, may the designers of high-fashion coiffures, on like logic, protect their original creations by photographing them and copyrighting the photographs? We cannot urge a valid distinction here based on the absence, from the fashionable hair-sets, of the kind of emotive force which produces a reaction of "horror" in the viewers of the theatrical make-ups, or of "humor" in the readers of cartoons. One has only to observe what passes for a coiffure with the avant-garde girls of the beatnik set to realize that "the Charles Addams hair-do" (so to name it) bids fair to become "the wave of the future" (in several senses, not excluding the Pickwickian).

It may, perhaps, be suggested that we can cut this Gordian knot by asserting that the coiffures, unlike the quasi-sculptured horror monsters, are not, even conceivably, independently copyrightable as "works of art." They are merely the products of skill in a trade. But a cloud of literary witnesses has testified, for centuries, to the fact that a lady's make-up is "art." Thus "rare Ben Jonson":¹¹

8. U.S. Constitution, Art. I, §8, cl. 8. And see *Clayton v. Stone*, *supra* note 7.

9. *Jonah*, 4, *passim*.

10. 17 U.S.C. §26.

11. *Epicene*, Act I (emphasis added).

"Still to be powdered, still perfumed:
 Lady, it is to be presumed,
 Though *Art's* hid causes are not found,
 All is not sweet, all is not sound."

Or, in a more gracious vein, W. S. Gilbert:¹²

"Paint the pretty face—
 Die the coral lip—
 Emphasize the grace
 Of her ladyship!
Art and nature, thus allied
 Go to make a pretty bride."

It will not do to sweep away this difficulty by saying that what was "art" for Jonson and Gilbert is not "art" for us of the copyright bar: Humpty-Dumpty could make a word mean "just what I choose it to mean—neither more nor less," but lawyers have to use words with more sense of responsibility to their hearers than that. If we refine the meanings of the terms we use, we must at least have a reason for doing so. We have such a reason here; there is a critical distinction to be drawn between the photographed product of the hairdresser's skill and the photographed creation of a theatrical make-up artist. In the case of the horror monster, the make-up is created as the outward form of the particular imagined creature depicted in the photograph; but in the case of the fancy hair-do of our hypothesis, the make-up is not similarly intended to be applied solely to the particular photographed lady. In the former case, the make-up is created for the sake of the picture, and what is protected by copyright is the *expression* of an artist—"this is how I conceive the appearance of this particular imaginary ghoul or werewolf." In the latter case, however, the picture is created for the sake of the make-up, and what the copyright seeks (improperly) to protect is an *idea*—"this is a good, or interesting, way for any lady to dress her hair." The distinction so drawn may well prove helpful in resolving many aspects of the familiar modern problem of distinguishing designs which are essentially "ideas," intended for repeated and practically useful application in a skilled trade, from designs which are imaginative expressions created for their own sakes, but which are found to be, incidentally, subject to one or more practical uses.¹³

12. The Mikado, Act II (emphasis added).

13. Cf., e.g., *Mazer v. Stein*, 347 U.S. 201 (1954); *Vacheron & Constantin-LeCoultre Watches, Inc. v. Benrus Watch Co., Inc.*, 260 F.2d 637, 642 (2d Cir. 1958); Report of the Register of Copyrights on the General Revision of the Copyright Law, House Committee Print, 87th Congress, 1st Session, at pp. 12-15 (1961).

Looking back at the course by which our imaginary argument has reached this point, however, is it not striking to observe how much both sides have relied on the old poetic device of metaphor? The horror monsters' make-ups, we have said, are *like* cartoons—*like* clay sculptures—and *like* fashionable coiffures. And, finally, we have compared both the make-ups and the coiffures to useful designs. We seem to be illustrating, in the field of copyright lawyering, the truth of Robert Frost's suggestion that "all thinking . . . is metaphorical."¹⁴ If so, we must also bear in mind his warning about this kind of thinking:¹⁵

"What I am pointing out is that unless you are at home in the metaphor, unless you have had your proper poetical education in the metaphor, you are not safe anywhere. Because you are not at ease with figurative values: You don't know the metaphor in its strength and its weakness. You don't know how far you may expect to ride it and when it may break down with you . . .

"All metaphor breaks down somewhere. That is the beauty of it. It is touch and go with the metaphor, and unless you have lived with it long enough you don't know when it is going. You don't know how much you can get out of it and when it will cease to yield. It is a very living thing. It is as life itself."

It is not the writer's purpose here to urge that all lawyers and judges should be poets (though the idea has much to commend it). But we certainly may and should profit by observing the poet's caution in using this mode of thought. By setting up opposing sets of "metaphors," we have tried to do so here. We can see, from their conflict, that none of them wholly disposes of our problem. They each come more or less close; but none of them so exactly fits the case before us as to leave our minds wholly at rest. As already noted, what we're really trying to do here, behind the screen of all our precedential metaphors, is to trace a segment of the line that separates "ideas" from "expressions"—more particularly, that part of the line which divides the product of mere skill in a trade from a "work of art."

The statute gives us some aid in this matter by referring to some of the more universally accepted forms or categories of art explicitly: books, maps, dramas, music, motion pictures, photographs, etc.¹⁶ But the inclusion of a

14. Robert Frost, "Education by Poetry," which first appeared in *Amherst Graduates' Quarterly*, and is here quoted as reprinted in Greenberg & Hepburn, *Robert Frost: An Introduction*, 79, 80 (Holt, Rinehart and Winston, 1961). Copyright 1931 by Robert Frost. Reprinted by permission of the Author and Holt, Rinehart and Winston, Inc.

15. *Id.*, 82-83.

16. 17 U.S.C. §5.

particular work in one or more of these categories is not always free of doubt, and in any case the protection which the statute affords is broader than these categories.¹⁷ It is in the penumbra of arguably uncopyrightable pictorial or three-dimensional "works of art," not otherwise categorized by the statute, that the question of skill vs. art presses.

The distinction between skill and art is easier to apprehend by intuition than it is to define. When we read Mr. Frost's poetry, we feel, somehow, that we have met Mr. Frost. But when we see a stylish coiffure on a lady's head, we may admire the lady, but we certainly do *not* feel that we have met her hairdresser. Art is, we may generally conclude, in some sense revelatory (however dimly) of an artist's personality (however colorless); but a tradesman's skill is not similarly revelatory of the personality of the tradesman. Having said this, we must also say that it does not help us lawyers much: how is a court to apply such a distinction? When do we call a designer of glassware a mere tradesman and when do we hail him as a true artist like Sidney Waugh? We can well sympathize with Justice Holmes's dictum in *Bleistein v. Donaldson Lithographing Co.*¹⁸

"It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations [or of *any* work of art], outside of the narrowest and most obvious limits."

However, it is one thing to judge the *worth* of a piece of art; it is another thing to judge whether it is "art" at all. The latter question may be equally dangerous for judges to try to solve; but if the presence of art, however humble, is essential to the validity of a copyright in a new, or arguably unprotectible, form of pictorial or three-dimensional creation, *somebody* has to take the risk. Holmes himself seems, in fact, to have done so in the *Bleistein* case, for he there felt obliged to declare:¹⁹

"... The [artist's] copy [of life] is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it *something irreducible*, which is one man's alone. *That something* he may copyright unless there is a restriction in the words of the act."
(Emphasis added.)

17. 17 U.S.C. §4, and cf. the concluding paragraph of 17 U.S.C. §5. Essentially, however, our problem centers on the term "work of art" in subdivisions (g) and (h) of §5, which is conveniently indefinite in scope.

18. 188 U.S. 239, 251 (1903).

19. *Id.* at 250.

But are our judges *capable* of knowing whether or not "that something" is there? How is its presence to be known? In *Bleistein*, Holmes used "the interest of any public" as the test, and declared that such interest was proved "by the desire to reproduce them [the artistic works in question] without regard to the plaintiffs' rights."²⁰ The trouble with this becomes apparent when we summarize his argument: (1) A copyright for a pictorial creation may be obtained if the pictorial creation is art. (2) It is art if it commands the interest of *any* public. (3) The interest of *a* public is proved by the fact that one person is willing to take the legal risk of reproducing the pictorial creation without regard to the creator's rights. (4) Those rights exist under the copyright in the pictorial creation. (5) *or* (1) A copyright for the pictorial creation may be obtained if the pictorial creation is art—and so back around the wheel again, for as long as we may wish to take the ride.

But despite the obvious circularity of Holmes's reasoning, one important idea emerges: the necessary presence of "art" in an arguably uncopyrightable creation of this kind is a matter *subject to proof by evidence*. This suggests that we ought to treat it as a question of fact.²¹ And this, in turn, means that the task too dangerous for judges to attempt would, in some cases at least, be shifted to juries. But if we had justifiable qualms about a judge's fitness for such a task, with how much more doubt and anguish will we confront the horrid thought that this question should be decided by twelve stolid citizens chosen from among their fellows in the manner that juries are chosen!

Unfortunately, no matter how we may try to duck or dodge the point, we shall find that there is no way of determining, in any case not clearly covered by the statute, whether a particular pictorial or three-dimensional creation is the product of art, as opposed to mere skill, save by its capacity to produce in us some recognition of a creator's personality inherent in the created work. We do not (at least not yet) recognize the coiffeur in the lady's hair-do. But, in submission, we seem to sense *a* creator's personality in a horror monster make-up. If you doubt this, ask any ten people, chosen at random, to name the role that made Boris Karloff famous. Chances are that almost all of them will answer, "Frankenstein." (Wouldn't you?) Only the very acute will answer (correctly), "*Frankenstein's monster*." This confusion between the created monster and Dr. Frankenstein, his fictional creator, evidences, in submission, how completely *a* creator's personality was felt, in this instance, to infuse the created object.²²

20. *Id.* at 252.

21. Compare the treatment given to the not dissimilar problem of "invention" as opposed to "mere mechanical skill" in patent cases. E.g., *Thomson Spot Welder Co. v. Ford Motor Co.*, 265 U.S. 445 (1924); *Keyes v. Grant*, 118 U.S. 25 (1886).

22. The difference here suggested between "art" and "skill" is that a work of art suggests, to the viewer, the personality of *a* creator, not (necessarily) of its *real* creator.

It may, perhaps, be argued that "Frankenstein" is a special case, attributable to the publicity attending the "Frankenstein" pictures rather than to any natural confusion in the public mind. If so, only a judge's or jury's *intuitive* perceptions can solve our problem. This is not necessarily cause for regret or alarm. How else, save by intuition, do judges or juries determine such seemingly insoluble problems as the compensable value of pain? Our common law tradition would be a poor thing indeed if our metaphorical use of precedents to solve novel problems were not, at some point, illuminated by, and subjected to, an intuitive, common sense determination by the community of the right—the fair—answers to such problems. Indeed (and oddly enough), that seems to be just what juries are for in our legal system. Wisely or not, it is they who are expected to supply (but only in the particular case) the intuitive answers of a cross-section of the community to those ultimate disputed questions of life which legal logic cannot be trusted to supply in the form of rules for all cases in general. If we accept this basic premise, then the "horrid thought" will not seem so horrid after all.

And there is some balm in Gilead for those who prefer to see judges decide the point rather than juries: since most copyright cases involve an application for a preliminary injunction, the initial job of fact-finding will have to be done by judges. But let's not allow this happenstance to confuse us. The essential point is that when and if a judge *or* a jury shall decide that a particular creation (like a horror monster make-up) is a "work of art,"²³ rather than of mere skill, he (or they) will be determining a fact, not laying down a law.²⁴

New forms of art cannot be defined and limited in advance by legal rules. Art changes ever, grows ever, by its own self-discovered principles. Its presence in any created work is a living fact. When that presence is recog-

It is thus not quite the same thing as the problem of "secondary meaning," familiar to trademark lawyers: that of determining whether a particular mark suggests, to the public, a *particular* manufacturer or distributor of the product to which it is attached. Moreover, the kind of inchoate "secondary meaning" we're after here flows from the inherent nature of the work, and is not the product of investment or advertising.

23. 17 U.S.C. §5(g) and (h).

24. *Mazer v. Stein*, *supra* note 13, *aff'g Stein v. Mazer*, 204 F.2d 472 (4th Cir. 1953), *rev'g* 111 F. Supp. 359 (D. Md. 1953) is not to the contrary. The question there presented was not whether or not the statuettes involved were works of "art," but whether their utilitarian use as lamp bases took them out of the scope of protection of the copyright statute and into the field of "designs" protected by the Patent Law. The error of the district court lay in supposing that the fact that protection for the lamp bases might be sought under the design patent law necessarily precluded protection of the statuettes by the Copyright Act—a proposition of law with which the Supreme Court was not in accord: 347 U.S. at 217-218.

nized in a new form with sufficient universality for the legislature to expand its statutory categories to include that new form explicitly in the coverage of the copyright statute, the fact has ceased to be debatable. It then becomes a mere rule of law to treat works that clearly fall in that category as works of art. But until then, in any doubtful case, the question should be regarded as one of fact. It is so, in submission, that the law ought to deal with it.

PART II.

**LEGISLATIVE AND ADMINISTRATIVE
DEVELOPMENTS**

1. UNITED STATES OF AMERICA AND TERRITORIES

357. U. S. CONGRESS. HOUSE.

H.R. 12450. A bill to provide for the payment of royalties by juke-box operators to the owners of performance rights in copyrighted music and for the fair and orderly determination of the amount and distribution of such royalties, and for other purposes. Introduced by Mr. Celler, July 11, 1962, and referred to the Committee on the Judiciary. 7 p. (87th Cong., 2d sess.)

A new jukebox bill which proposes, *inter alia*, the establishment of an "Office of Performing Rights Trustees," comprising three Trustees to be appointed by the Attorney General, to determine the amount and supervise the collection and distribution of royalties. Hearings were set for July 25, 1962 on this bill and on H.R. 70 (87th Cong., 1st sess., introduced Jan. 3, 1961), the pending jukebox bill.

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

Extending the duration of copyright protection in certain cases. Report to accompany H.J. Res. 627, submitted by Mr. Willis, May 28, 1962. 7 p. (87th Cong., 2d sess., H.Rept. No. 1742.)

A report recommending House passage of the resolution with an amendment which substitutes December 31, 1965 for December 31, 1967 as the cutoff date for interim continuance of renewal terms.

359. U. S. CONGRESS. HOUSE. *Committee on Interstate and Foreign Commerce.*

Amending the Trading With the Enemy Act. Report (to accompany H.R. 9045) submitted by Mr. Mack, July 31, 1962. 10 p. (87th Cong., 2d sess., H.Rept. No. 2091.)

A favorable report, without amendment. "The reported bill would divest the Government's interest in copyrights, trademarks, and unexpired contract interests involving copyrights and trademarks in favor of former owners or their successors in interest. It would also authorize the transfer of all vested motion-picture film prints to the Library of Congress."

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

Counterfeit phonograph records. Hearing before Subcommittee no. 3 of the Committee on the Judiciary, House of Representatives, Eighty-seventh Congress, second session, on H.R. 6354, a bill to provide (1) criminal penalties for the counterfeiting of phonograph records and (2) civil remedies for infringement of mechanical rights in copyrighted music. May 10, 1962. Washington, Govt. Print. Off., 1962. 97 p. "Serial no. 28."

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

Criminal penalties for trafficking in phonograph records bearing counterfeit labels. Report to accompany H.R. 11793, submitted by Mr. Willis, June 5, 1962. 10 p. (87th Cong., 2d sess., H.Rept. No. 1758.)

A favorable report on H.R. 11793, without amendment, recommending its passage by the House.

362. U. S. CONGRESS. SENATE.

Copyright restrictions on Government publications and documents. Extension of remarks of Hon. Harry Flood Byrd of Virginia. 108 *Congressional Record* A 5501, no. 122 (daily ed. July 18, 1962).

Senator Byrd inserts in the *Record* an editorial which appeared in the *Richmond, Va., Times-Dispatch* on July 13, 1962, entitled "Stop this dangerous trend." The editorial comments favorably on the activities of M. B. Schnapper, editor of the Public Affairs Press, directed against the placing of "copyright restrictions on the contents of Government publications and documents."

363. U. S. CONGRESS. SENATE.

Protection of authors of original ornamental designs of useful articles. 108 *Congressional Record* 13561-13568, no. 125 (daily ed. July 23, 1962).

The proceedings in the Senate with respect to its consideration of S. 1884, the Hart-Wiley-Talmadge design piracy bill. The bill was passed by voice vote without change from the amended version as reported out by the Senate Judiciary Committee on July 12th. See Item 364, *infra*.

364. U. S. CONGRESS. SENATE. *Committee on the Judiciary.*

Design Protection Act of 1962. Report, together with individual views (to accompany S. 1884) submitted by Mr. Hart, July 12, 1962. 31 p. (87th Cong., 2d sess., S.Rept. No. 1725.)

A report favoring passage of S. 1884 as amended by the Committee. The amendments include, *inter alia*, numerous changes in language, a fee schedule, and a limitation on the amount of damages to be awarded for infringements. Senator Kefauver opposed enactment in a brief statement of "Individual views" on grounds of his agreement with a statement of the Deputy Attorney General "that the bill raises serious constitutional and policy problems."

[Ed.: S. 1884 was passed by the Senate on July 23, 1962.]

365. U. S. CONGRESS. SENATE.

S. 3383. A bill relating to the tax treatment of transfers of rights to copyrights and literary, musical and artistic compositions. Introduced by Mr. Humphrey, June 7, 1962, and referred to the Committee on Finance. 4 p. (87th Cong., 2d sess.)

Companion bill to H.R. 9524 introduced by Mr. Lindsay on January 10, 1962. Senator Humphrey's remarks when he introduced the bill, and which appear in 108 Cong. Rec. 9163 (daily ed. June 7, 1962), include the following statement: "I fail to see any justification . . . for different tax treatment of patents and copyrights." See 9 BULL. CR. SOC. 247, Item 138 (1962).

366. U. S. COPYRIGHT OFFICE.

Copyright information about pictorial, graphic, and sculptural works. Washington, June 1962. 2 p. Cir. 70.

A circular which is designed to aid the registrant in selecting the appropriate class, and the proper form and position of the copyright notice, for the registration of pictorial, graphic and sculptural works.

367. U. S. COPYRIGHT OFFICE.

Registration of copyright claims for pictorial, graphic, and sculptural works. Washington, June 1962. 1 p. Chart 70.

A chart accompanying Circular 70 (see Item 366, *supra*), which lists the deposit requirements, appropriate application forms, and the registration fees for copyright claims in pictorial, graphic, and sculptural works.

368. U. S. COPYRIGHT OFFICE.

Renewal of copyright. Washington, June 1962. 2 p. Cir. 15.

A revised circular which explains the rules and procedures for the registration of renewal claims.

2. FOREIGN NATIONS

369. GREAT BRITAIN. BOARD OF TRADE. *Departmental Committee on Industrial Designs.*

Report. London, H. M. Stationery Off., 1962. 143 p. ([Gt. Brit. Parliament. Papers by command] cmd. 1808.)

The UK Board of Trade Committee recommends reform of design legislation.

Task of Johnston Committee. On May 11, 1959, the Board of Trade of the United Kingdom appointed an eight-member committee, chaired by Kenneth Johnston, to report on what changes, if any, would be desirable in the law concerning industrial designs. The only directive the Committee was given consisted in calling to its attention the possible need for UK designs "to receive cheap and effective protection in other countries on the basis of reciprocity."

Present Law. The present law on designs is the Registered Designs Act, 1949, as amended by the Copyright Act, 1956. "Design" means "features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged solely by the eye." Registration is effected by the Patent Office, which generally makes a search for novelty

and refuses registration if novelty is lacking. The "copyright" in a design lasts a maximum of 15 years from registration.

Certain things which would ordinarily be considered "designs" under the definition can be excluded from registration by the Board of Trade on the ground that they are more suited to protection under the Copyright Act (for example, greeting cards). If so excluded, they remain entirely under the Copyright Act no matter how many copies are reproduced.

The thorny question of what should happen to the copyright in an artistic work when it also "becomes" a design is roughly resolved in the following manner:

- (i) If an artistic work is used in 50 or more manufactured articles, or in yard-goods (whether the resulting design is registered or not), or
- (ii) If an artistic work, as used or intended to be used in manufactured articles, is registered in the Design Register (whether articles are actually manufactured or not);

then, once the term of the design protection expires (i.e., normally after 15 years), any person will be free to copy the manufactured articles and to use the artistic work in manufacturing other manufactured articles. However, any other use of the artistic work remains prohibited until the expiration of the copyright term.

Recommendations of the Johnston Committee. The Johnston Committee recommends that the present Registered Designs Act be maintained with certain minor modifications, but that a second, new, Act also dealing with designs be adopted. Protection under the former would be called "design monopoly," whereas protection under the latter would be called "design copyright."

The subject matter of both laws would be the same, that is, designs. This term would be defined in both laws in the same way, to wit: "Design shall mean features of shape, configuration, pattern or ornament of an article, or features of pattern or ornament applicable to articles, in so far as such features appeal to and are judged solely by the eye."

Protection, under both laws, would last for a maximum of 15 years.

The question of what should happen to the copyright in an artistic work when a corresponding design is registered (deposited) or applied to manufactured articles would remain to be resolved in the same manner as it is resolved now.

The main differences, very roughly stated, between the two laws would be the following:

<i>Design Monopoly</i>	<i>Design Copyright</i>
Novelty required	Originality required
Examination by Patent Office for novelty	No examination by Patent Office, except as to compliance with formal requirements of application
Any similar design is unlawful, even if similarity is accidental	Similar designs are unlawful if they are the result of copying
Symbol on articles: DM	Symbol on articles: DC or ®
Register called "Register"	Register called "Deposit List"

The Johnston Committee, whose report is dated May 14, 1962, recommends that adherence by the United Kingdom to the Hague Arrangement of 1960 on the international registration of designs should be sympathetically considered.

370. FINLAND. *Laws, statutes, etc.*

Décret en application des lois du 8 juillet 1961 (NOS 404/61 et 405/61) relatives au droit d'auteur sur les oeuvres littéraires et artistiques et au droit sur les images photographiques (Du 25 août 1961). 75 *Le Droit d'Auteur* 128-130, no. 6 (June 1962).

The official French translation of a decree implementing the provisions of articles 12, 22 and 53 to 55 of the new Finnish Copyright Act, and articles 6, 10, 12 and 17 of the new Finnish Law on Rights in Photographic Pictures.

371. FINLAND. *Laws, statutes, etc.*

Décret relatif à la meilleure application de la loi du 8 juillet 1961 (N° 404/61) relative au droit d'auteur sur les oeuvres littéraires et artistiques (Du 25 août 1961). 75 *Le Droit d'Auteur* 130, no. 6 (June 1962).

The official French translation of a Finnish decree providing that a permit for arranging a public spectacle or similar entertainment, and for the operation of a restaurant, café, or hotel be accompanied by a statement to the effect that the provisions of the new copyright law must be complied with.

372. FINLAND. *Laws, statutes, etc.*

Loi relative au droit d'auteur sur les oeuvres littéraires et artistiques (N^o 404/61 du 8 juillet 1961). 75 *Le Droit d'Auteur* 119-125, no. 6 (June 1962).

The official French translation of the new Finnish Copyright Act.

373. FINLAND. *Laws, statutes, etc.*

Loi relative au droit sur les images photographiques (N^o 405/61 du 8 juillet 1961). 75 *Le Droit d'Auteur* 126-127, no. 6 (June 1962).

The official French translation of the new Finnish Law on Rights in Photographic Pictures.

374. SWEDEN. *Laws, statutes, etc.*

Act on Rights in Photographic Pictures (December 30, 1960). 75 *Le Droit d'Auteur* 82-83, [English inset] no. 6 (June 1962).

The official English translation.

375. SWEDEN. *Laws, statutes, etc.*

Copyright Act (December 30, 1960). 75 *Le Droit d'Auteur* 76-82, [English inset] no. 6 (June 1962).

The official English translation.

375a. YUGOSLAVIA. *Laws, statutes, etc.*

Law on Designs and Models (4th November, 1961). 1 *Industrial Property* 120-125, no. 5 (May 1962).

A translation of a new law officially communicated by the Yugoslav Administration.

PART IV.

**JUDICIAL DEVELOPMENTS IN LITERARY
AND ARTISTIC PROPERTY**

A. DECISIONS OF U. S. COURTS

1. Federal Court Decisions

376. *Societe Comptoir de l'Industrie Cotonniere v. Alexander's Department Stores, Inc.*, 299 F. 2d 33, 132 U.S.P.Q. 475 (2d Cir., Feb. 14, 1962) (Smith, J.). *For decision below, see* 190 F. Supp. 594, 128 U.S.P.Q. 242 (S.D.N.Y., 1961).

Appeals from orders denying preliminary injunction in actions for trade mark infringement and unfair competition. Plaintiffs made two separate motions seeking to enjoin use of names "Dior" and "Christian Dior" by defendant in its "high-volume, low mark-up" department store operation. The garments advertised by Alexander's as copies of Dior creations were in fact reasonably good copies.

Held, affirmed.

I. Defendant's description of its garments as copies of Dior models was held not to be a trade-mark infringement. The court said:

"The Lanham Act does not prohibit a commercial rival's truthfully denominating his goods a copy of a design in the public domain, although he uses the name of the designer to do so. Indeed it is difficult to see any other means that might be employed to inform the consuming public of the true origin of the design."

II. It was also held that there had been no unfair competition. The court said:

"Common law unfair competition must be grounded in either deception or appropriation of the exclusive property of the plaintiff

"In the case at bar, it is conceded that the 'pirating' of the design is lawful and proper. *Fashion Originators' Guild of America v. F.T.C.*, 114 F. 2d 80 (2 Cir. 1940), *aff'd* 312 U.S. 457, 48 USPQ 483 (1941). The only property right alleged to have been invaded is the good will

embodied in the trade mark. But the right of the complainant in his mark is limited to dilution which is brought about by confusion as to source or affiliation. . . .

"Involved in the instant case is a conflict of values which necessarily arises in an economy characterized by competition and private property The interest of the consumer in competitive prices of garments using Dior designs without deception as to origin is at least as great as the interest of plaintiffs in monopolizing the name."

377. *Sunset House Distributing Corp. v. Doran*, 304 F. 2d 251, 134 U.S.P.Q. 4 (9th Cir., June 18, 1962) (Chambers, J.). *For decision below see* 197 F. Supp. 940, 131 U.S.P.Q. 94, 9 BULL. CR. SOC. 165, Item No. 75.

Appeal from judgment for plaintiffs in action for copyright infringement and unfair competition. Defendants' Santa Claus, which consisted of several plastic bags designed to be stuffed with crumpled newspaper and assembled, thus forming a life-size three-dimensional figure, was held below to have been copied from plaintiffs' similar Santa Claus.

Held, affirmed.

The court pointed out that the trial court had not given plaintiffs a monopoly on Santa Claus, but had only recognized their copyright in the particular version of which they were the authors. The court said:

"Obviously Santa Claus belongs to the whole world, and next he may be exported to outer space. He belongs to none of the parties.

No court can properly enjoin parties from the whole field of manufacturing Santa Claus. But defendants' trouble is that their Santa Claus was just a lazy copy of the Doran Santa Claus. There was some slight variation in design which was made by the defendants, but not much. They even copied plaintiffs' uncopyrighted instruction sheet, which shows how defendants went about the thing. We are cognizant that there was even some difference between plaintiffs' copyrighted garment and their marketed product. But here the trial court had fact questions which it resolved against defendants and we cannot say the determination was clearly erroneous.

The court below has not enjoined defendants from making a Santa Claus, a red and white plastic Santa Claus, or a Santa Claus with a slit in his back to permit him to be stuffed with newspapers.

It is not our function to design a Santa Claus for appellants that will be beyond the pale of an injunction, but it is obvious that such can be done."

The court denied plaintiffs' application for additional attorneys' fees for the appeal, on the ground that the appeal had "substantial merit."

378. *Surgical Supply Service, Inc. v. Adler*, 206 F. Supp. 564, 133 U.S.P.Q. 510 (E.D. Pa., Apr. 18, 1962) (Van Dusen, J.)

Action for copyright infringement and unfair competition. Plaintiff and defendant are the only Philadelphia firms engaged in the chiropody supply business. Plaintiff's predecessor created a combination trade catalogue, price list and order blank which plaintiff has revised from time to time and kept up to date, publishing it with copyright notice, always keeping such basic characteristics as the style of typography, classified headings, and the like. Defendant placed on the market a price list copied largely from plaintiff's. Plaintiff then changed the color of the papers on which its list was printed, and defendant promptly followed suit.

Held, judgment for defendant on issue of copyright infringement; judgment for plaintiff on issue of unfair competition.

I. Copyright infringement:

The court held that plaintiff's price list was not copyrightable. The court said:

"The exclusive right to employ a particular method of advertising cannot be acquired under the copyright statute and, therefore, is not the proper subject matter of a valid copyright."

The court stated further that although the copyright statute is construed liberally and covers many kinds of material, including catalogues and directories, there is still a requirement of some literary or artistic merit in order to create a copyrightable subject. The court went on:

"In the case at bar, there is a mere advertisement consisting of a bare list of articles and prices. The trial judge cannot, under any test of literary or artistic merit, find such advertisement to be the proper subject of a valid copyright. It clearly lacks the legal minimum of originality necessary for a copyright. . . .

The cases are uniform and settled in holding that a work, in order to be copyrightable, must a) represent the author's own skill,

labor and judgment and b) it must be meritorious in that it must be connected with the fine arts Plaintiff's price list does not present such genius and industry as to fall within the copyright statutes."

II. Unfair Competition:

The court held that although copying plaintiff's price list was not copyright infringement, it was unfair competition. The court said:

"Unfair competition exists where a person copies extracts and quotations from another's advertising price list which the original creator has created and placed in his price list, notwithstanding the same matter may be found in common and public sources which the second person, if possessed of sufficient skill, industry and judgment, could have selected for himself. Unfair competition exists separate and apart from any statutory rights which the owner of a copyright possesses, and the copyright law is but a part of the broad field of action of unfair competition: *House of Westmore v. Denney*, 15 F. 2d 261, 66 USPQ 373 (3d Cir. 1945) . . . Unfair competition is based on equitable principles and may be distinguished from infringement of a trademark or copyright in that it does not involve violation of the exclusive right to use a word, mark or symbol, but rather involves any violation of a right arising from the operation of an established business."

The court found that there was likelihood of customer confusion as to origin of the price lists and "clear and intentional palming off."

III. It was held that plaintiff's having placed a copyright notice in good faith on material which turned out not to be copyrightable did not constitute "unclean hands."

379. *Addison-Wesley Publishing Co. v. Brown*, 133 U.S.P.Q. 647 (E.D.N.Y., May 24, 1962) (Bruchhausen, J.)

Action for copyright infringement and unfair competition. Plaintiffs are the publisher and authors of a set of physics textbooks called "University Physics" and "College Physics." These texts contain problems which can be assigned to students for homework, etc. Defendants, without copying the problems themselves, have published a book with ready-made solutions for these problems, and professors have complained about this, threatening to stop using plaintiffs' books unless sale of the solved problems is stopped. Plaintiffs moved for a preliminary injunction.

Held, preliminary injunction granted.

It was held that the affidavits had amply shown that the market for plaintiffs' books would be seriously impaired if the sale of the solution manual was allowed to continue, since the books would not be used by most educators if the students did not work out the problems for themselves instead of having solutions readily available. It having also been shown that "the publisher is being wrongfully associated with the solution books of the defendants" the court held that the plaintiffs were entitled to a preliminary injunction. The court said:

"The trend of the law today is to enforce higher standards of fairness and morality in trade, depending upon the character and nature thereof. . . .

The governing principles with a complete review of the law and authorities are found in *Metropolitan Opera Association, Inc. v. Wagner-Nichols Recorder Corp.*, 199 Misc. 786, 101 N.Y.S. 2d 483, *affirmed*, 279 App. Div. 632, 107 N.Y.S. 2d 795; *Dior v. Milton*, 9 Misc. 2d 425, 155 N.Y.S. 2d 443; *International News Service v. The Associated Press*, 248 U.S. 215, 39 S. Ct. 68, 63 L. Ed. 211."

380. *Burnett v. Lambino*, 134 U.S.P.Q. 68 (S.D.N.Y., June 11, 1962) (Feinberg, J.)

Application for counsel fees by two prevailing defendants in a copyright infringement action involving "The Blackboard Jungle." By stipulation, consideration of this application was deferred pending resolution of the main issues. (See 204 F. Supp. 327, 133 U.S.P.Q. 325, 9 BULL. CR. SOC. 403, Item No. 266.)

Held, counsel fee of \$2,800 awarded to defendant Simon & Schuster, Inc., \$2,000 awarded to defendant Metro-Goldwyn-Mayer, Inc.

Plaintiffs argued that no counsel fees should be awarded, and that in any event, counsel fees should not be awarded to the extent that plaintiffs' claims were based upon their common law rights. *Caruthers v. R.K.O. Radio Pictures, Inc.*, 20 F. Supp. 906, 908, 35 U.S.P.Q. 115 and 542 (S.D.N.Y. 1937).

I. The court held that defendants were entitled to counsel fees because plaintiffs had been unreasonable in bringing this suit. The court said:

"While I may not be prepared to say that the claim of plagiarism in this case was 'wholly synthetic,' *Lewys v. O'Neill*, 49 F. 2d 603, 618, 9 USPQ 465, 479 (S.D.N.Y. 1931) or 'quite fantastic,' *Rose v. Connelly*, 38 F. Supp. 54, 55, 49 USPQ 170 (S.D.N.Y. 1941), I do believe that the asserted claim of infringement was so demonstrably lacking in merit that bringing it was clearly unreasonable. *Cloth v. Hyman*, 146 F. Supp. 185, 193, 112 USPQ 254, 259 (S.D. N.Y. 1956). Plaintiffs' case rested ultimately on alleged showings of similarities which ranged from the patently erroneous to the ridiculous or involved palpable trivialities. . . . Therefore, while 'provision for attorneys' fees * * * has been sparingly used and the amounts awarded modest,' *Orgel v. Clark Boardman Co.*, 301 F. 2d 119, 122, 133 USPQ 94, 96 (2 Cir. 1962), on facts such as these one should not be allowed to charge plagiarism with virtual impunity."

II. The court held that plaintiffs were correct in contending that attorneys' fees are not recoverable in an action based upon common law copyright, and that some common law rights had been asserted. "Taking into account all the questions in the case and the intertwining of those relating to the common law copyright and those relating to statutory rights," the court concluded "that an equitable allocation of attorneys' fees is 80 per cent to defense of the statutory claims and 20 per cent to the defense of the common law claims. *Eisman v. Samuel Goldwyn, Inc.*, 23 F. Supp. 519, 521, 37 USPQ 760, 761 (S.D.N.Y. 1938), *rev'd* on other grounds, 104 F. 2d 661, 42 USPQ 164 (2 Cir. 1939)."

The court held that the amount of work done, the skill of the attorneys, their professional reputation, and the amount of money potentially involved justified an award of \$5,500, which was reduced by the 20% allocated to defense of the common law claims, thus leaving the total award for counsel fees at \$4,800.

381. *Peter Pan Fabrics, Inc. v. Puritan Dress Co., Inc.*, 207 F. Supp. 563, 133 U.S.P.Q. 678 (S.D.N.Y., May 18, 1962) (Bryan, J.)

Action for copyright infringement. Peter Pan's much litigated fabric design, "Byzantium", was copied by Martin Weiner Corp., not a party here, who sold its infringing fabric to a number of dress manufacturers. Defendant was one of these purchasers and is charged with manufacturing and distributing dresses made of the infringing cloth. Plaintiff moved for summary judgment.

Held, judgment for plaintiff.

Defendant denied liability for infringement on two grounds: It denied that plaintiff's design was sufficiently original to be copyrightable, and it maintained that insufficient notice had been given of plaintiff's claim to copyright in the design. The court pointed out, however, that both of these issues had been resolved in plaintiff's favor in the considerable previous litigation with respect to the very same design. See, e.g., *Peter Pan Fabrics, Inc. v. Acadia Company, Inc.* and *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 173 F. Supp. 292, 121 U.S.P.Q. 81 (S.D.N.Y. 1959), *aff'd* 274 F. 2d 487, 124 U.S.P.Q. 154 (2d Cir. 1960).

I. Originality:

Quoting from a previous "Byzantium" case, *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, 280 F. 2d 88, 125 U.S.P.Q. 329 (2d Cir. 1960), the court held that:

"While the basis of the sketches appears to have been suggested by or perhaps taken faithfully from ancient art forms, their incorporation into a combined design by the Parisian designer is clearly sufficiently original to satisfy the originality requirement of the copyright laws * * *. Originality, not novelty, is the test."

The court regarded a statement by defendant's vice-president that "in my thirty years in the textile industry, I have seen literally hundreds of fabric designs similar to plaintiff's" as "wholly insufficient to raise any question of fact as to whether the design was sufficiently original to be copyrighted, particularly in the light of the previous decisions on this very subject, with which the defendant must be thoroughly familiar."

II. Notice:

The court termed defendant's second argument, that the notice was insufficient, "equally without merit." The court said:

"Publication is deemed 'to have occurred on sale of the printed goods to the dress manufacturers, and notice at that time is to be held constructive notice to all dress manufacturers, provided the notice was sufficient.' *Peter Pan Fabrics, Inc. v. Dixon Textile Corp.*, *supra*, ... The adequacy of the method of giving notice of copyright to dress manufacturers by printing the notice on the selvege of the cloth, has already been determined as a matter of law in the earlier litigation involving the Byzantium fabric. Such notice is clearly good."

The court also stated that defendant's contention that it had no actual notice of the copyright "does not bear on the issue of liability but only goes to the issue of the amount of damages. *F. W. Woolworth Co. v. Contemporary Arts*, 344 U.S. 228, 95 U.S.P.Q. 396 (1952)."

382. *Loomskill, Inc. v. Puritan Dress Co.*, 134 U.S.P.Q. 20 (S.D.N.Y., June 5, 1962) (Metzner, J.)

Action for infringement of the copyright in two fabric designs.

Held, preliminary injunction granted.

Noting that plaintiff's business is that of selling a "so-called style-leader line for customers willing to pay for distinctive patterns" the court held that plaintiff would be seriously damaged if the same patterns were offered in garments sold at a cheaper, and therefore more popular, price than that at which garments made from plaintiff's fabric could be sold. The court said:

"The life of a new design is a short one, and unless a preliminary injunction is issued, plaintiff will suffer substantial and irreparable injury from defendant's competition during a significant part of the period during which the designs will have value."

2. State Court Decisions

383. *Mastro Plastics Corp. v. Emenee Industries, Inc.*, 133 U.S.P.Q. 664 (App. Div., 1st Dept., May 29, 1962) (Bergan, J.), *reversing* 32 Misc. 2d 801, 223 N. Y. S. 2d 940, 132 U.S.P.Q. 413 (Sup. Ct., Feb. 6, 1962) (Hofstadter, J.).

Action for unfair competition. Defendant had purchased a number of plaintiff's trademarked bongo drums, removed the marks and substituted its own. It then used these drums as "samples" of its own product. It also offered trade pictures of plaintiff's drums, retouched to conceal plaintiff's name and trademark, to its prospective customers to use in advertising and catalogs. The court below, on a motion to dismiss the complaint, stated that the defendant had violated the penal law of New York in affixing a false trademark to the "samples" and held that it was guilty of unfair use of plaintiff's drums in misrepresenting that they were its own product.

Held, on appeal, reversed.

The appellate court held that since plaintiff's drums were in the public domain, and defendant was free to copy them, it was not unfair

competition for defendant to use the drums and photographs in promoting its own similar competing product. The court said that in removing plaintiff's trademark from the drums it had purchased,

"defendant did precisely what it should have done to avoid unfair competition before using them as samples in trade, because, although its right to resell or use for the purpose of trade the drums made by the plaintiff is clear, it had no such right to use the plaintiff's trademark."

Also of Interest:

384. *Hygienic Specialties Co. v. H. G. Saltzman, Inc.*, 302 F. 2d 614, 133 U.S.P.Q. 96 (2d Cir., Apr. 2, 1962) (Kaufman, J.).

Action for infringement of a design patent on a two-piece soap dish and for unfair competition.

Held, judgment for plaintiff below reversed.

The patent was held to be invalid because the design was neither inventive nor ornamental. Defendant's "slavish" copying of the "unpatented" design was not found to be unfair competition. The court stated that even if it were shown that secondary meaning had attached to non-functional features of plaintiff's design, plaintiff would still have the burden of showing that the copying had engendered confusion as to origin of the goods.

385. UNIVERSAL COPYRIGHT CONVENTION
LIST OF ACCESSIONS AND RATIFICATIONS

(As of May 30, 1962)

<i>Country</i>	<i>Effective Date</i>
Andorra	September 16, 1955
Argentina	February 13, 1958
Austria	July 2, 1957
Belgium	August 31, 1960
Brazil	January 13, 1960
Cambodia	September 16, 1955
Canada	August 10, 1962
Chile	September 16, 1955
Costa Rica	September 16, 1955
Cuba	June 18, 1957
Czechoslovakia	January 6, 1960

<i>Country</i>	<i>Effective Date</i>
Denmark	February 9, 1962
Ecuador	June 5, 1957
France	January 14, 1956
German Federal Republic	September 16, 1955
Ghana	August 22, 1962
Haiti	September 16, 1955
Holy See	October 5, 1955
Iceland	December 18, 1956
India	January 21, 1958
Ireland	January 20, 1959
Israel	September 16, 1955
Italy	January 24, 1957
Japan	April 28, 1956
Laos	September 16, 1955
Lebanon	October 17, 1959
Liberia	July 27, 1956
Liechtenstein	January 22, 1959
Luxembourg	October 15, 1955
Mexico	May 12, 1957
Monaco	September 16, 1955
Nicaragua	August 16, 1961
Nigeria	February 14, 1962
Pakistan	September 16, 1955
Panama	October 17, 1962
Paraguay	March 11, 1962
*Philippines	November 19, 1955
Portugal	December 25, 1956
Spain	September 16, 1955
Sweden	July 1, 1961
Switzerland	March 30, 1956
United Kingdom	September 27, 1957
United States of America	September 16, 1955

* UNESCO has advised the U. S. Government that on November 14, 1955, a letter was received from the Philippine Minister in Paris stating that the Philippine President had directed the withdrawal of the instrument of accession prior to November 19, 1955, the date on which the Convention would become effective in respect of the Philippines. No determination has been made as to the legal effect of this communication.

386. IMPORTANT NOTICE CONCERNING AN ACT EXTENDING
THE DURATION OF COPYRIGHT IN CERTAIN CASES

Under a recent Act of Congress, P. L. 87-668, 87th Congress, Second Session, any renewal term of copyright that was scheduled to expire between September 19, 1962, and December 31, 1965, is automatically continued in force until December 31, 1965.

In other words, no renewal (second-term) copyright will expire within the period from September 19, 1962, to December 31, 1965. For example, a work that was first entered for copyright on October 5, 1907, and renewed in 1935 would normally have fallen into the public domain on October 5, 1963; under the new law the renewal copyright is extended until December 31, 1965.

NOTE that the extension covers only those *renewal* copyrights that were *still in force* on September 19, 1962. The Act has no effect upon first terms of copyright, nor does it revive renewal copyrights that expired before September 19, 1962.

REGISTER OF COPYRIGHTS

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