ASCAP

COPYRIGHT LAW SYMPOSIUM

Number Thirty

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NATHAN BURKAN
MEMORIAL COMPETITION

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Foreword

VOLUME THIRTY of the ASCAP Copyright Law Symposium brings the Nathan Burkan Memorial Competition into the decade of the eighties. Sixty-four law schools submitted ninety-nine papers which won prizes at each school, to compete for the five national prizes awarded each year. This impressive law school participation in the Competition is indicative of the high level of interest in the field of Copyright Law; and the seriousness of approach shown by the students in their handling of complex topics was equally impressive.

We were especially struck not only by the quality of papers submitted, but also by the wide range of interests shown. Subjects included copyright legislation in the technical field of computer programs; compensation and protection for the artist in America through copyright; and criminal provisions in the Copyright Law.

Our task in selecting the best five papers was most difficult. We congratulate the five authors whose papers are published here for their success in making a contribution to the development of Copyright Law. In presenting these papers to the reader, we feel certain their excellence and relevance will be appreciated.

First prize was awarded to Kay H. Pierce, a graduate of the University of Tennessee Law School, for her paper, "Copyright Protection for Computer Programs." Ms. Pierce discusses proposed changes in copyright legislation designed to

protect computer programs more adequately, and explores the possibility of creating a "hybrid" system of protection encompassing elements of both federal copyright and patent law.

John A. Taylor of New England Law School won second prize for "The Uncopyrightability of Historical Matter: Protecting Form Over Substance and Fiction Over Fact." Mr. Taylor suggests that historical and biographical material should receive very different treatment under Copyright Law than does fictional matter. He details the elements necessary to protect historical matter and focuses on the fair use doctrine to illustrate how courts have attempted to protect such material.

"A Look at the Public Lending Right," the third-prize winning paper, is by Ernest A. Seemann of the University of Miami School of Law. He considers the right of an author to receive compensation for the use of his work by libraries. His study traces precedents for this right from ancient Rome to the modern world, as he presents the issues involved in compensating authors through a public lending right.

Fourth prize winner Robert E. Hathaway II, of the Franklin Thomas Backus School of Law of Case Western Reserve University, considers an artist's moral rights in "American Law Analogues to the Paternity Element of the Doctrine of Moral Right: Is the Creative Artist in America Really Protected?" Mr. Hathaway's paper is directed to the types of protection available to American authors to ensure control over their creative personality, as they have expressed it in their work.

Fifth prize went to James Lincoln Young of the University of Nebraska College of Law, Lincoln, for his paper, "Criminal Copyright Infringement and A Step Beyond." Criminal provisions for copyright infringement before and after the 1976 Copyright Act are explored and criminal and civil copyright infringement actions are compared.

We extend our congratulations to these national prize winners, and to all who submitted papers in the Competition.

HON. MARY M. SCHROEDER
UNITED STATES COURT OF APPEALS
NINTH CIRCUIT
HON. CHARLES W. JOINER
UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF MICHIGAN
HON. THEODORE R. KUPFERMAN
SUPREME COURT, STATE OF NEW YORK
APPELLATE DIVISION
FIRST DEPARTMENT

Preface

EACH YEAR of the Nathan Burkan Memorial Competition, a prestigious panel of legal scholars choose as National Award winners the finest papers from among those which have already won awards at law schools throughout the country. The generous contributions of time and effort by these individuals ensure the success of the Competition and encourage the study of Copyright Law.

Their participation at the national judging level in large part explains the vigorous support of law school deans, one of whom recently commented that the Nathan Burkan Memorial Competition "is surely the most successful of the legal essay symposia," and that "the many papers presented over the years have been an important contribution to copyright law."*

The 1980 National Competition was honored to have three prominent members of the Judiciary judge the ninety-nine papers submitted.

Judge Mary M. Schroeder, of the United States Court of Appeals for the Ninth Circuit, received her B.A. from Swarthmore College and her J.D. from the University of Chicago Law School in 1965. She was a trial attorney at the U.S. Department of Justice, Civil Division, from 1965 to 1969, and served as Law Clerk to the Honorable Jesse Udall of the Arizona Supreme Court in 1970. She entered private practice in 1971. From 1975 to 1979, she served as a Judge of the Arizona Court of Appeals. She was named to the Ninth Circuit in 1979.

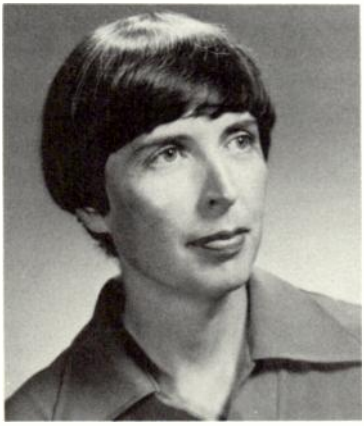
* Letter from Erwin N. Griswold, former Dean of the Harvard Law School. May 28, 1982.

Judge Charles W. Joiner has served as a United States District Court Judge for the Eastern District of Michigan since 1972. After receiving his B.A. and J.D. from the University of Iowa, Judge Joiner entered private practice. He served with distinction in the Air Force during World War II. After the war, he went on to teach at the University of Michigan Law School, serving as Associate and Acting Dean. From 1968 to 1972, he was Dean at Wayne State University Law School. He was named to the bench in 1972. Judge Joiner has been very active in bar and civic affairs, serving as President of the Michigan State Bar and as a member of the Advisory Committees on Rules of Evidence and Civil Rules of the Judicial Conference of the United States. He has also served in various capacities for the National Conference of Commissions on Uniform State Laws, the American Association of Law Schools and the American Bar Association.

Justice Theodore R. Kupferman of the Appellate Division of the New York State Supreme Court received his B.S. from City College of New York and his LL.B. from Columbia Law School, where he was Kent Scholar and editor of the Law Review. He spent his first years out of law school practicing in the area of copyright law, with Warner Bros. Pictures, Inc., NBC, and Cinerama Production Corp. Justice Kupferman then embarked on a distinguished political career, serving as a member of the New York City Council, and in Congress as a Representative of New York's 17th Congressional District in the 89th and 90th Congresses. He became a Justice of the New York State Supreme Court in 1969, and of the Appellate Division, First Department, in 1971. Justice Kupferman's interest in the Nathan Burkan Memorial Competition is longstanding: he won the Competition when a student at Columbia, and served as a Judge of the Competition when he was a Congressman.

Our grateful thanks go to these three eminent jurists, who contributed so unstintingly of their time and effort.

HERMAN FINKELSTEIN



MARY M. SCHROEDER



CHARLES W. JOINER



THEODORE R. KUPFERMAN

Rules Governing the Competition

1. *Participating Law Schools:* All accredited law schools are invited to participate in the Competition.
2. *Eligible Students:* Third-year students. In the discretion of the dean, second-year students may also be eligible.
3. *Subject Matter:* Any phase of *Copyright Law.*
4. *Determination of Awards:* The prizes will be awarded to the students who shall, in the sole judgment of the dean—or such other person or committee as he may delegate—prepare the two best papers. The dean may in his discretion withhold the awards entirely, if in his opinion no worthy paper is submitted, or may award only the first or second prize. *Students are not eligible for more than one prize in any Competition.*
5. *Prizes:* A *first prize of $500* and a *second prize of $200* at each participating law school, to be paid through the dean, upon his written certification. Winning papers will be entered in the National Competition, in which the best papers will be considered for awards of $3,000, $2,000, $1,500, $1,000 and $500 (see Rule 10, *infra*).
6. *Requirements as to length and form of manuscript:*
   (a) Manuscript must be typewritten (double-spaced) on 8½″ × 11″ paper, 1″ margin all around. All quotations exceeding four lines must be indented and single-spaced.
   (b) Manuscript must not exceed 50 pages.
   (c) Citations must be in approved law review form.
   (d) Table of Contents (subject matter) must appear inside front cover.
   (e) *Three* copies of manuscript must be submitted.
   (f) Cover for manuscript: any standard form stiff cover with label on outside showing title of paper, author's name, and permanent *home address.*

7. *Submission of papers and publication:*
   (a) Winning papers will be forwarded in *triplicate* by the dean to the Society, which may authorize publication.
   (b) Papers may appear in Law Reviews, provided their entry in the Nathan Burkan Memorial Competition is duly noted.
8. As papers are presumed to represent individual study, collaboration with others in their preparation (other than the usual law review supervision) is not permitted.
9. *Closing date:* August 15th—or any earlier date the dean may specify. Winning papers must be certified to the Society not later than August 31st.
10. *National Awards:* The five best papers selected by a National Awards Panel will receive awards of $3,000, $2,000, $1,500, $1,000 and $500, respectively. Only papers which conform to these rules will be considered for a National Award. The award papers will be printed in the *ASCAP Copyright Law Symposium*.

ASCAP

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NATIONAL FIRST PRIZE, 1980

Copyright Protection for Computer Programs

By KAY H. PIERCE

UNIVERSITY OF TENNESSEE COLLEGE OF LAW

INTRODUCTION

A TECHNOLOGICAL explosion during the past three decades in computer-controlled systems[1] has created a need to provide adequate legal protection for computer programs.[2] The framers of the United States Constitution did not envision computer technology when they drafted article I, section 8, clause

* This article has been published in 47 TENN. L. REV. 787 (1980).

** I would like to take this opportunity to thank my husband, George Pierce, for being so cooperative and supportive of my effort to research and write this paper, without his assistance in caring for our two young children during that period, this paper would not have been written.

[1] Computer technology has its roots in the 1800s with the work of Charles Babbage. His work was lost after his death and was not rediscovered until the late 1940s. The early stages of computer development were costly with few rewards. Later, a series of electrical-component developments together with software innovations skyrocketed the progress of computer technology and greatly reduced the cost of technological advancements. *See* J. SOMA, THE COMPUTER INDUSTRY: AN ECONOMIC-LEGAL ANALYSIS OF ITS TECHNOLOGY AND GROWTH 1–9 (1976).

[2] The need to provide protection for computer software has been called "[o]ne of the greatest challenges which has emerged in recent years." Pfeifer, *Legal Protection of Computer Software: An Update*, 5 ORANGE COUNTY B.J. (1978) [hereinafter cited as Pfeifer].

8, giving Congress the power to grant limited monopolies to authors for their writings and to inventors for their discoveries. Nevertheless, it seems implicit that Congress has the authority to protect computer programs through the grant of a limited monopoly. Presently, to obtain a limited monopoly under this article, a development must be either a "new and useful process, machine, manufacture, or composition of matter"[3] under the federal patent laws or an "original [work] of authorship fixed in any tangible medium of expression"[4] under the federal copyright laws. The problem with protecting a computer program under either of these laws is that a program is a unique hybrid of both "original works of authorship" and "new and useful process[es]." Consequently, it may not be possible to obtain complete protection within the existing legal framework. The threefold purpose of this paper is to (1) review the history of copyright protection for computer programs, (2) discuss proposed changes in copyright legislation to protect computer programs more nearly adequately, and (3) explore the possibility of creating a hybrid system of protection for computer programs.

TECHNICAL ASPECTS OF A COMPUTER PROGRAM

An adequate evaluation of the desirability of protecting computer programs through copyright requires a working knowledge of the technical aspects of a computer program. Computer programs, commonly referred to as software systems,[5] are basically a set of instructions designed to control the mechanical operations of a computer.[6] Software systems

[3] 35 U.S.C. § 101 (1976). "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." *Id.*

[4] 17 U.S.C. § 102(a) (Supp. II 1978).

[5] *See* W. CHOW & C. SIPPL, COMPUTER GLOSSARY FOR ENGINEERS AND SCIENTISTS 146 (1972).

[6] *See* Pope & Pope, *Protection of Proprietary Interests in Computer Software*, 30 ALA. L. REV. 527, 527 n.2 (1979). [hereinafter cited as Pope & Pope].

may range from a very limited set of simple instructions to operate a handheld calculator to a complex array of flow charts, subroutine programs, tapes, compilers, supporting documentation, and definitions of computer languages.[7]

The development of any software system may be divided broadly into four phases.[8] In the first phase, a flow chart is developed by the creator of the program to represent schematically on paper the logic of the program.[9] The second phase consists of translating the flow chart into a computer programming language such as FORTRAN or COBAL.[10] The program resulting from this phase is called a source program[11] and is typically on punched cards or magnetic tape. A computer printout of the program may be read by any computer programmer. The third phase is the development of an assembly program to translate the programming language into a machine program.[12] Assembly programs, for all intents and purposes, are unintelligible except to the machine itself. The fourth phase is the creation of an object program to translate the assembly program into the mechanical process of regulating electrical impulses in a computer. Special apparatus must be used to "read" an object program, and even then it cannot be understood by highly trained programmers.[13]

[7] *See* Rosen, *Software*, in ENCYCLOPEDIA OF COMPUTER SCIENCE 1283 (1976).

[8] Software can also be divided into categories for analysis of legal protection. Applications software directs the computer to act on raw data as either an adding machine or a logic system. Wide dissemination of applications software causes copyright law to be the most likely candidate for protection. Compiler software directs a computer to translate a flow chart into machine language. Compiler software is an integral part of the mechanics of a computer; thus, it could be protected by patent law. Operations software directs a computer to process multiple sets of data according to specified criteria. Operations software is highly individualized to maximize efficiency and is typically sold as a package deal. Trade secrecy may be the best form of protection for this category of computer software. Pope & Pope, *supra* note 6, at 531–32.

[9] *See* Data Cash Systems, Inc. v. JS&A Group, Inc., 480 F. Supp. 1063, 1065 (N.D. Ill. 1979).

[10] *Id.* at 1065.

[11] *Id.*

[12] *Id.*

[13] *Id.*

Thus a single software system or computer program may be considered a *writing* in its flow chart and source phases and a *mechanical device* in its assembly and compiler phases; yet the same basic process is involved in all four phases.

The advent of microprocessors in the computer industry has reduced the cost of manufacturing computer equipment from millions of dollars to a nominal sum.[14] This has created a fifth category or phase of computer programs wherein the object program is permanently reproduced in the electronic network of one or more microprocessing units.[15] The reproduction of a computer program in a microprocessing unit merely repeats the basic process of a computer program in the flow chart, assembly, object, and source phases. The only difference between an object program and a microprocessor is that a microprocessor permanently fixes a particular program in electronic circuitry, whereas the object program instructs more flexible electronic circuitry to behave in the same way. With the advance of computer technology, the distinctions between the various phases of computer programs have become increasingly blurred. This creates unique problems for computer programmers in obtaining legal protection for their efforts; these problems are particularly troublesome within the existing legal framework of the federal copyright laws.

IDEAL GOALS IN PROTECTING COMPUTER PROGRAMS

Before examining the scope of protection available to computer programs under the federal copyright laws, it is desir-

[14] "Computer central processing units as powerful as those that cost millions of dollars in the 1950's are now available for under $10." Maggs, *Some Problems of Legal Protection of Programs for Microcomputer Control Systems*, 1979 U. ILL. L.F. 453, 453 [hereinafter cited as Maggs].

[15] Many manufacturers of microprocessor chips make copying of microprocessors intentionally difficult by "taking such steps as sealing the chip in epoxy cement, removing type numbers from the chip, and enciphering the program." Maggs, *supra* note 14, at 454.

able to define generally some of the goals an ideal system of protection should meet. The goals of an ideal system of protection vary according to whether one is defining goals from the point of view of the computer programming industry or of the government acting on behalf of the general public.

With respect to industry, an ideal system of protection should meet at least seven goals. First, of course, the creator of a computer program should be protected against unauthorized copying of a program in the same format and form as the original.[16] Second, the computer industry would like to protect the translation of a source program from one computer language to another.[17] Third, an ideal system should protect the translation of a computer program from one phase to another *e.g.*, from source phase to object phase.[18] Fourth, the software industry would like to guard against what may be perceived as "customer theft."[19] This goal of protection requires some explanation for those not familiar with computer systems. Commonly, a seller of a computer system must expend large sums of money to train computer customers to use a particular computer program. A member of the software industry may then make further expenditures to aid the computer user in compiling raw data in a certain sequence and arrangement to be "read" by a computer. The sequence

[16] There is little doubt that computer programs in human-readable form are currently protected from this type of copying.

[17] Protection is available through copyright for such unauthorized copying. "[I]t is as clear an infringement to translate a computer program from, for example, FORTRAN to ALGOL, as it is to translate a novel or play from English to French." Synercom Technology, Inc. v. University Computing Co., 462 F. Supp. 1003, 1013 n.5 (N.D. Tex. 1978) (dicta).

[18] In a recent case an attempt to protect translation through copyright law failed. Data Cash Systems, Inc. v. JS&A Group, Inc., 480 F. Supp. 1063 (N.D. Ill. 1979).

[19] An attempt to protect against customer theft through federal copyright failed in Synercom Technology, Inc. v. University Computing Co., 462 F. Supp. 1003 (N.D. Tex. 1978). For further discussion of this case, *see* text accompanying notes 94–109 *infra*.

and arrangement of the raw data is called an input format.[20] In complex computer programs, the particular input format is, for all practical purposes, unique.[21] A competing software developer may, however, design a computer program to "read" raw data in the exact sequence and arrangement as its original competitor and thereby take advantage of the expenditures made by the original developer to train customers.[22] A fifth type of protection a computer software developer would ideally desire is against the duplication of a traditional phase of a computer program into a microprocessor.[23] A sixth area of protection would be to allow computer software to be leased with enforceable restrictions on copying by rightful possessors or others who have access to the program.[24] This would allow the software industry to freely disseminate computer programs and to recoup its investment by charging customers for the time actually spent using the program.[25] Finally, the computer industry may desire to protect against the copying of microprocessors.[26] That is, once a particular

[20] In order for raw data to be compatible with a specific program, a computer input format must be developed and used. An input format is generally implemented through the use of a specialized form that indicates to the user of the program how to arrange the known data so that the information may be found and read by the computer. *See* 462 F. Supp. at 1012; D. McCracken, A Guide to Fortran IV Programming 221 (2d ed. 1972).

[21] "[I]n the usual case sequence, choice, and arrangement [in an input format] have only stylistic significance." 462 F. Supp. at 1014.

[22] An example of this occurred between two competitors in the structural analysis market. *Id.* at 1009.

[23] Maggs, *supra* note 14, at 454.

[24] This goal of computer industry is currently protected through the use of trade secrecy. Lawlor, *A Proposal for Strong Protection of Computer Programs Under the Copyright Law*, 20 Jurimetrics J. 18, 20 (1979) [hereinafter cited as Lawlor].

[25] *Id.*

[26] If microprocessors were considered "works of authorship," note 4 and accompanying text, *supra*, the extent of protection provided probably would be limited by the statutory definition of copies in 17 U.S.C. § 101 (Supp. II 1978), which requires a copy to be "perceived, reproduced, or otherwise communicated." *Id.* One commentator described a simple scheme for overcoming copyright infringement liability:

program has been embodied in the electronic circuitry of a microprocessor, the originator of that particular microprocessor would like to protect against copying of the circuitry of the microprocessor. Each of the goals of industry has as its principal purpose the maximization of profits for the originator of a computer program.[27]

Not all the goals as outlined above are in the best interests of the public. The government, acting on behalf of the public, has three major goals in an ideal system of protection. First, an ideal system of protection should encourage creativity and new developments by rewarding the original developers for their efforts.[28] Second, maximum dissemination of information resulting from creative developments is desirable.[29]

A competitor could make an exact reproduction of the program and seal it along with the microprocessor that executes the program instructions in a block of epoxy cement. Once sealed, the program could not be 'perceived, reproduced, or otherwise communicated,' so there would appear to be no 'copy' made.

Maggs, *supra* note 14, at 463–64.

[27] "The cost of developing computer programs is far greater than the cost of their duplication. Consequently, computer programs . . . are likely to be disseminated only if . . . the creator may recover all of its costs plus a fair profit . . . ." CONTU, FINAL REPORT OF THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS 11 (1979) [hereinafter cited as CONTU REPORT].

[28] Industry's goal of increasing profit through government-granted monopolies is not inconsistent with the basic purpose behind the constitutional copyright clause.

The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in Science and useful Arts. Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.

Mazer v. Stein, 347 U.S. 201, 219 (1954).

[29] Federal copyright laws attempt to provide for maximum dissemination of information through two means. First, deposit and registration statutes encourage the creator to provide copies to the Copyright Office for use or disposition by the Library of Congress. 17 U.S.C. §§ 407, 408 (Supp. II 1978). Registration is, however, of limited benefit to the public because of the difficulty of searching a specific category of writings. Second, copyright laws attempt to encourage dissemination by granting certain exclusive rights under 17 U.S.C. § 106 (Supp. II 1978). Encouraging dissemination of computer programs in this manner is limited to the extent that computer programs can actually be protected under section 106.

Third, an ideal system of protection should be manageable; it should not be exceedingly expensive for the government to operate and should provide adequate notice of exactly what is protected.[30]

DEVELOPMENT OF TRADITIONAL COPYRIGHT LAW

The basis of federal copyright law is founded in article I, section 8, clause 8, of the United States Constitution that grants Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their respective Writings."[31] The first federal copyright act protected only maps, charts, and books.[32] The term "writing" in the Constitution has, however, been broadly construed by both Congress[33] and the courts[34] to protect various new forms of expression created by technological advances. For example, photographs were recognized as "writings" within the scope of the copyright laws by the Supreme Court in 1884.[35] Similarly, motion pictures were recognized in 1911,[36] and, more recently, sound recordings were recognized in 1973.[37] The present copyright act reflects this broad construction of the term "writing" by extending copyright protection to "original works of author-

[30] *See* text accompanying notes 164–68 *infra*.

[31] U.S. CONST. art. I, § 8, cl. 8.

[32] "[T]he author . . . of any map, chart, [or] book . . . shall have the sole right and liberty of printing, reprinting, publishing and vending such. . . ." Act of May 31, 1790, ch. 15 § 1, 1 Stat. 124 (current version at 17 U.S.C. §§ 102, 106 [Supp. II 1978]).

[33] "The term used in the constitution is 'writings.' But Congress has always construed this term broadly, and in doing so has been uniformly supported by judicial decision." S. REP. No. 6187, 59th Cong., 2d Sess. 4 (1907).

[34] *See* Shaab v. Kleindienst, 345 F. Supp. 589 (D.D.C. 1972), *per curiam*. "The copyright clause of the Constitution must be interpreted broadly to provide protection for [the sound recording industry] . . ." *Id.* at 590.

[35] Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884).

[36] Kalem Co. v. Harper Bros., 222 U.S. 55 (1911).

[37] Goldstein v. California, 412 U.S. 546 (1973).

ship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, produced, or otherwise communicated, either directly or with the aid of a machine or device." [38]

Brief references in both House [39] and Senate [40] reports, discussing the 1976 Copyright Act indicate an interest in protecting computer programs within the scope of copyright. However it is not clear whether all phases of computer programming can be protected as a "writing" by copyright. The House report states, "The courts have indicated that 'all the writings of an author' under the [1909 Copyright Act] . . . is narrower in scope than the 'writing' of 'authors' referred to in the Constitution." [41]

Relevant to the issue of extending copyright protection to computer programs are judicial decisions that clearly indicate that the artistic merit of the work is not to be considered in extending copyright.[42] In the 1903 landmark decision of *Bleistein v. Donaldson Lithographing Co.*[43] the United States Supreme Court held that Congress intended to protect "useful arts" even when the art was created for commercial purposes.[44] The Court in its wisdom recognized that "[i]t would

[38] 17 U.S.C. § 102 (Supp. II 1978).

[39] H.R. REP. No. 1476, 94th Cong., 2d Sess. (1976), *reprinted in* 4 M. NIMMER, NIMMER ON COPYRIGHT at app. 4 (1980) [hereinafter cited as H.R. REP.].

[40] S. REP. No. 473, 94th Cong., 1st Sess. 1–167 (1975) [hereinafter cited as S. REP.].

[41] H.R. REP., *supra* note 39, at 51, *reprinted in* 4 M. NIMMER, NIMMER ON COPYRIGHT at app. 4–10 (1980). If the statutory and constitutional wording was coextensive, the courts might be faced with holding something copyrightable which constitutionally is not or vice versa. *See* Kernochan, *Subject Matter of Copyright; Rights in General; Rights in Relation to Computers*, in 1 CURRENT DEVELOPMENTS IN COPYRIGHT LAW 49, 52 (1977).

[42] *See, e.g.*, Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) (commercial lithograph for circus is protected); Reiss v. National Quotation Bureau, Inc., 276 F. 717 (S.D.N.Y. 1921) (cablecode book containing coined words with no meaning for private cablecode correspondence purposes is protected); Harcourt, Brace & World, Inc. v. Graphic Controls Corp., 329 F. Supp. 517 (S.D.N.Y. 1971) (answer sheets for student achievement tests protected).

[43] 188 U.S. 239 (1903).

[44] *Id.* at 251.

be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of [a work of art] . . . , outside of the narrowest and most obvious limits."[45] This determination that Congress intended the scope of the copyright statute to include more than merely the traditional fine arts has met with approval in later cases upholding copyright of commercial lamp bases,[46] compilations of coined words used to create secret codes,[47] and optical scanning sheets.[48] A 1976 House report reflects these past judicial determinations and indicates that computer programs and data bases may be considered "literary works."[49] The House report states, "The term 'literary works' does not connote any criterion of literary merit or qualitative value. . . . It . . . includes computer data bases, and computer programs to the extent that they incorporate authorship in the programmer's expression of original ideas, as distinguished from the ideas themselves."[50]

Authorship does not create a significant hurdle to obtaining copyright protection of computer programs. The term "author" has been broadly construed to include simply to whom anything "owes its origin."[51] Even when a computer program "owes its origin" to numerous individuals, it may be considered a joint work[52] or a work made for hire[53] and be protected by copyright.

[45] *Id.*

[46] Mazer v. Stein, 347 U.S. 201 (1954).

[47] Reiss v. National Quotation Bureau, Inc., 276 F. 717 (S.D.N.Y. 1921). "In light of *Reiss*, it could be argued that a computer program, even though it may appear nonsensical, is the 'writing of an author.'" Note, *Protection of Computer Software—A Hard Problem*, 26 DRAKE L. REV. 180, 193 (1977) [hereinafter cited as 26 DRAKE L. REV.].

[48] Harcourt, Brace & World, Inc. v. Graphic Controls Corp., 329 F. Supp. 517 (S.D.N.Y. 1971).

[49] H.R. REP., *supra* note 39, at 54, *reprinted in* 4 M. NIMMER, NIMMER ON COPYRIGHT at app. to 4–13 (1980).

[50] *Id.*

[51] Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951) (citing Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57–58 (1884)).

[52] 17 U.S.C. § 201(a) (Supp. II 1978).

[53] *Id.* § 201(b).

Another traditional requirement of copyright is that a work must be deemed to be "original." [54] The requirement of originality for copyright is distinct from the requirement of novelty for a patent.[55] Originality for copyright purposes requires only that a work is independently created, not that the work is unique or even different from that previously existing in the public domain. Moreover, even if portions of a work are copied from the public domain, copyright may still subsist in portions of the work that are not copied, provided that they are more than trivial variations [56] or demonstrate more than mere "physical skill" or "special training" to reproduce.[57] In such circumstances, it has been held that "[a] considerably *higher* degree of skill is required, true artistic skill, to make the reproduction copyrightable." [58] This requirement of originality has particular relevance for copyright of computer programs. A computer program generally comprises a set of instructions designed to perform a series of tasks of a rote nature, and while each step may not be original with the author, the sequence and arrangement of the steps may involve something more than the bare expression of an underlying idea. Consequently, copyright may subsist in the expression of the idea.[59]

In view of the broad construction of the scope of the availability of copyright of a work as a "writing" with minimal or

[54] *Id.* § 102(a). It has been suggested that there is no constitutional power under article I, section 8, clause 8 to grant monopolies or exclusive franchises to authors whose product lacks all creative originality. Chamberlin v. Uris Sales Corp., 150 F.2d 512, 512–13 (2d Cir. 1945).

[55] "Originality is . . . distinguished from novelty; there must be independent creation, but it need not be invention in the sense of striking uniqueness, ingeniousness, or novelty, since the Constitution differentiates 'authors' and their 'writings' from 'inventors' and their 'discoveries.'" L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 490 (2d Cir. 1976). It should be noted that "patentability of an article does not bar copyright of the article as a work of art." G. B. Lewis Co. v. Gould Products, Inc., 297 F. Supp. 690, 698 (E.D.N.Y. 1968).

[56] G. P. Putnam's Sons v. Lancer Books, Inc., 239 F. Supp. 782, 785 (S.D.N.Y. 1965).

[57] L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486, 491 (2d Cir. 1976).

[58] *Id.*

[59] Synercom Technology, Inc. v. University Computing Co., 462 F. Supp. 1003 (N.D. Tex. 1978).

nonexistent literary merit or originality requirements, the courts have attempted to prevent undue monopolies by strictly defining and construing infringement.[60] The first major restriction on the scope of protection available through copyright occurred in *Baker v. Selden*[61] in 1879. In *Baker* the United States Supreme Court held that it was not infringement for another to use a system of accounting described in plaintiff's copyrighted book. This decision has been followed repeatedly in later cases[62] that have held that infringement occurs only when the expression of an idea in a copyrighted work has been copied by another; no infringement occurs when another copies merely the underlying idea. This limitation on copyright infringement is particularly crucial for computer programs because the true value of a computer program is in its ultimate use in a computer.[63]

Another limitation on the scope of protection afforded by copyright is that no infringement will be found unless plaintiff can prove that defendant copied[64] plaintiff's copyrighted work and that such copying was an unlawful and substantial appropriation of a protected portion of plaintiff's work.[65] In the ordinary case of direct copying of a computer program in the same phase as a copyrighted work of another, the proof

[60] In order to succeed in a copyright infringement action, "plaintiffs must prove (1) that defendants copied from their works and (2) that such copying worked an unlawful appropriation of at least a substantial, protected part of the allegedly infringed work." Bevan v. Columbia Broadcasting System, Inc., 329 F. Supp. 601, 604 (S.D.N.Y. 1971).

[61] 101 U.S. 99 (1879).

[62] *See* Franklin Mint Corp. v. National Wildlife Art Exchange, Inc., 575 F.2d 62, 64 (3d Cir.), *cert. denied*, 439 U.S. 880 (1978); Midas Productions, Inc. v. Baer, 437 F. Supp. 1388, 1390 (C.D. Cal. 1977).

[63] For this reason, a computer program is considered by one commentator to be "more like an invention than a work of art." 26 DRAKE L. REV., *supra* note 47, at 195.

[64] *See* Herbert Rosenthal Jewelry Corp. v. Kalpakian, 446 F.2d 738 (9th Cir. 1971) (copyright only bars copying); Roberts v. Dahl, 6 Ill. App. 3d 395, 286 N.E.2d 51 (1972) (evidence of similarity insufficient to create inference of copying).

[65] Bevan v. Columbia Broadcasting Sys., Inc., 329 F. Supp. 601, 604 (S.D.N.Y. 1971).

may not be difficult. The finding of infringement becomes much more complex and tenuous, however, when the copying involves changing a computer program from one phase to another or, in the customer theft situation, when the alleged infringer constructs a computer program especially designed to receive the copyrighted input formats of another.[66]

Another judicial restriction on the scope of available copyright protection is that no infringement occurs when the idea expressed in a copyrighted work can be expressed only in a limited variety of ways. This restrictive view of copyright protection is clearly expressed in *Morrissey v. Procter & Gamble Co.*[67] in which the court held that the description of contest rules could be varied only in a limited fashion and that to permit one to obtain copyright on the variations of expression would, in effect, allow one to obtain a virtual monopoly in the underlying idea.[68] This holding is consistent with the general proposition in *Baker v. Selden*[69] that copyright may not subsist in an idea. The limitation on finding infringement may create substantial difficulties for protecting computer programs, particularly when it is not recognized by those unskilled in the programming art that the particular ideas in a source program can take an almost infinite variety of forms, depending upon the labeling of variables and the particular arrangement and sequence of operational commands.[70] Hopefully, however, the ability to vary the labeling of variables and the sequence of commands should prevent computer programs from falling prey to the doctrine that in-

[66] *See* text accompanying notes 110–21 *infra*.

[67] 379 F.2d 675 (1st Cir. 1967).

[68] *Id.* at 678–79. The court in *Morrissey* aptly concluded that "[w]e cannot recognize copyright as a game of chess in which the public can be checkmated." *Id.* at 679.

[69] 101 U.S. 99 (1879).

[70] For an example of the problems computer programmers face in persuading a court that underlying ideas may be expressed in more than one manner, *see* Synercom Technology, Inc. v. University Computing Co., 462 F. Supp. 1003, 1012 (N.D. Tex. 1978).

fringement does not occur when an idea can be expressed only in a limited fashion.[71]

On the other hand, the ability to change variable names and operational sequences creates another problem for protecting computer programs. That is, a buccaneer of a program may be able to avoid infringement simply by changing a few variable names and adding unnecessary commands to the computer.[72] This pitfall in copyright protection possibly may be avoided, however, since there is support in prior case law for finding an infringement under these circumstances. In *Tennessee Fabricating Co. v. Moultrie Manufacturing Co.*,[73] a 1970 Fifth Circuit case dealing with a metal casting unit for room screen dividers, the court stated that copyright "[i]nfringement is not confined to exact reproduction but includes colorable alterations made to disguise the piracy."[74] Other courts have recognized that copyright infringement must be decided "in an *ad hoc* fashion, through a particularized assessment of the facts . . . in light of . . . [the] 'vague' legal test for infringement."[75] Although these holdings suggest that colorable variations to disguise the piracy of computer programs may constitute infringement, the scope of protection available is defined so vaguely that a computer programmer intent on protecting his work may be wary of relying on copyright law for that protection.

Congressional and administrative responses to the prob-

[71] *But see id.* The court held that defendant's exact duplication of data sequence and arrangement constituted only a taking of ideas and not expression, although statistically a particular program may be written more than three million different ways. *Id.*

[72] For example, an unscrupulous competitor wishing to avoid copyright infringement may be able to do so by adding a sufficient number of nonfunctional "do-loops" in another's computer program. *See generally* L. COOPER & M. SMITH, STANDARD FORTRAN: A PROBLEM-SOLVING APPROACH 129–44 (1973).

[73] 421 F.2d 279 (5th Cir.), *cert. denied*, 398 U.S. 928 (1970).

[74] *Id.* at 284.

[75] Couleur Int'l Ltd. v. Opulent Fabrics Inc., 330 F. Supp. 152, 153 (S.D.N.Y. 1971) (citing Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960)).

lems posed by the protection of computer programs through copyright law have been cautious.[76] The first concrete indication that computer programs could receive copyright protection came in 1964 in an announcement from the Register of Copyrights[77] that allowed computer programs to be registered in the Copyright Office.[78] By statute copyright registration is prima facie proof of copyright validity;[79] however, the validity of such registration has never been seriously contested in the courts.[80]

The Act of March 4, 1909,[81] was in effect at the time of the Register's announcement. For obvious reasons there is no accompanying legislative history directly dealing with copyright of computer programs. The 1909 Copyright Act extended copyright protection to "all the writings of an author." [82] In view of the broad interpretation of the term "writing," it appears that the Register had the authority to accept computer programs for registration.[83] Relatively few computer programs have, however, been submitted for registration since the 1964 announcement.[84] This fact may indicate, not a lack of need for protection of computer programs, but rather a skepticism about the availability of meaningful protection under the copyright laws.

[76] H.R. REP., *supra* note 39, at 51, *reprinted in* 4 M. NIMMER, NIMMER ON COPYRIGHT at app. 4–9 to 4–10 (1980).

[77] UNITED STATES COPYRIGHT OFFICE, COPYRIGHT REGISTRATION FOR COMPUTER PROGRAMS, (1964), *reprinted in* 11 BULL. COPYRIGHT SOC'Y 361 (1964).

[78] The announcement stated that accepting computer programs for registration is "in accordance with . . . [the Copyright Office] policy of resolving doubtful issues in favor or registration wherever possible." *Id.*

[79] 17 U.S.C. § 410(c) (Supp. II 1978).

[80] 1 M. NIMMER, NIMMER ON COPYRIGHT § 2.04 [C] (1980) [hereinafter cited as NIMMER].

[81] Act of March 4, 1909, ch. 320, 35 Stat. 1075 (current version at 17 U.S.C. §§ 101–810 (Supp. II 1978)) [hereinafter cited as 1909 Copyright Act].

[82] *Id.* ch. 320, § 4.

[83] NIMMER, *supra* note 80, at § 2.04 [C].

[84] It has been estimated that one million programs are developed each year, but as of January 1, 1977, only 1205 programs had been registered for copyright. CONTU REPORT, *supra* note 27, at 34.

With the passage of the Act of October 19, 1976,[85] the House clearly indicated an intent to protect computer programs through copyright.[86] The intent of the Senate at that time, however, was unclear.[87] Thus, the scope of copyrightable subject matter and the extent of protection available under the 1976 Copyright Act are debatable.[88] The Senate expressed concern that copyright in computer programs should not be allowed to extend protection "to the methodology or processes adopted by the programmer, . . . [but] merely to the 'writing' expressing his ideas."[89] The Senate report states, "Section 102(b) is intended, among other things, to make clear that the expression adopted by the programmer is the copyrightable element in a computer program, and that the actual processes or methods embodied in the program are not within the scope of the copyright law."[90]

Owing to the overall uncertainty between the House and Senate on the application of copyright law to computer programs under the 1976 Copyright Act, section 117 was included in the 1976 Act to exclude protection of computer programs. Section 117 maintains the status quo of protection available under the 1909 Copyright Act until further notice.[91] A special commission, the National Commission on New Technological Uses of Copyrighted Works (CONTU), was created in 1974 under the Library of Congress to study the problem of protecting computer programs.[92] CONTU recommended that the 1976 Copyright Act be amended to protect

[85] Act of Oct. 19, 1976, 17 U.S.C. §§ 101–810 (Supp. II 1978) [hereinafter cited as 1976 Copyright Act].

[86] H.R. REP., *supra* note 39, at 54, *reprinted in* 4 M. NIMMER, NIMMER ON COPYRIGHT at app. 4–13 (1980).

[87] S. REP., *supra* note 40, at 54.

[88] *See* NIMMER, *supra* note 80, at § 2.04 [C].

[89] S. REP., *supra* note 40, at 54.

[90] *Id.*

[91] 17 U.S.C. § 117 (Supp. II 1978).

[92] Act of Dec. 31, 1974, Pub. L. No. 93-573, § 201, 88 Stat. 1873 (1974).

computer programs that are fixed in a tangible medium and embody an author's original creation.[93]

JUDICIAL DECISIONS ON COPYRIGHT OF COMPUTER PROGRAMS

Before analyzing the changes in the copyright law proposed by CONTU and others, it is desirable to survey the few court decisions pertaining to copyright protection of computer programs under the 1909 Copyright Act. In 1978 the case of *Synercom Technology, Inc. v. University Computing Co.*[94] came before the United States District Court for the Northern District of Texas. The case essentially involved customer theft.[95] Plaintiff, an engineering consulting firm, had developed and obtained copyright on unique input formats that were to be used with a complex, structural-analysis com-

[93] CONTU REPORT, *supra* note 27, at 12. Specifically, CONTU proposed:

1. That section 117 as enacted be repealed.
2. That section 101 be amended to add the following definition:
   A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.
3. That a new section 117 be enacted as follows:
   § 117: *Limitations on exclusive rights: computer programs*
   Notwithstanding the provision of § 106, it is not an infringement for the rightful possessor of a copy of a computer program to make or authorize the making of another copy or adaptation of that computer program *provided:*
   (1) that such a new copy or adaptation is created as an essential step in the utilization of the computer program in conjunction with a machine and that it is used in no other manner, or
   (2) that such new copy or adaptation is for archival purposes only and that all archival copies are destroyed in the event that continued possession of the computer program should cease to be rightful. Any exact copies prepared in accordance with the provisions of this section may be leased, sold, or otherwise transferred, along with the copy from which such copies were prepared, only as part of the lease, sale, or other transfer of all rights in the program. Adaptations so prepared may be transferred only with the authorization of the copyright owner.

Id.

[94] 462 F. Supp. 1003 (N.D. Tex. 1978).

[95] *See* text accompanying notes 19–22 *supra.*

puter program.[96] Defendants later developed a structural-analysis computer program purposefully designed to accept plaintiff's input formats.[97] The *Synercom* court, in applying the 1909 Copyright Act, assumed that if plaintiff's input format contained stylistic expressions beyond that necessary to convey an idea, then defendants' actions constituted copyright infringement.[98] The court recognized that on a purely statistical basis the chances of arranging the data in an identical order were less than one in three million.[99] The *Synercom* court further noted that "[t]here are hundreds of programs available for structural analysis, and at least fifteen are competitive with [plaintiff's]. [Yet all] but [plaintiff's and defendants' programs] have different input formats."[100] The *Synercom* court held, however, that the ideas expressed in plaintiff's formats could be expressed only by using the identical sequence and arrangement of plaintiff's formats; therefore, defendants' use of plaintiff's sequence and arrangement did not constitute copyright infringement.[101]

The *Synercom* case is interesting for several reasons. First, the basis for the *Synercom* holding greatly expanded the doctrine enunciated in *Morrissey v. Procter & Gamble Co.*[102] that copyright will not be allowed to subsist when an idea can be expressed only in a limited number of ways.[103] Past cases expressing that doctrine have generally involved highly simplified writings such as musical titles[104] and contest rules.[105] Similarly, routine legal forms in which word phrases

[96] A structural-analysis computer program can be basically described as a program designed to compute the stresses on each member of a structure (for example, each I-beam in a bridge) when the structure is in actual use. 462 F. Supp. at 1005 n.2 (1978).

[97] *Id.* at 1008.

[98] *Id.* at 1011–13.

[99] *Id.* at 1012.

[100] *Id.* at 1007.

[101] *Id.*

[102] 379 F.2d 675 (1st Cir. 1967).

[103] *See* text accompanying notes 67–68 *supra.*

[104] Arnstein v. Porter, 154 F.2d 464, 467 (2d Cir. 1946).

[105] 379 F.2d at 676.

have become firmly established in the profession are seldom found to be infringed because a finding of infringement based on the similarity of language "would have the effect of giving the copyright owner a monopoly on his idea."[106] The *Synercom* case stands alone in the use of this doctrine to deny copyright protection when the sequence and arrangement of data had been expressed by others in different ways.[107]

Second, the *Synercom* decision is interesting because the court assumed that if copyright did subsist in plaintiff's formats, then defendants' use of plaintiff's sequence and arrangement in a program to receive data prepared by a customer would be copying.[108] In making this assumption, the court implied that copyright of one phase of a computer program would protect against use of the same expression contained in the copyrighted work in other phases of the computer program. The *Synercom* court apparently was confused on this issue because the court also stated in dicta that copyright in a flowchart phase of a computer could not be extended to protect against the copying of the source phase.[109] The result of the *Synercom* decision was to create more questions than it answered and possibly to discourage future use of copyright for protection of computer programs.

In *Data Cash Systems, Inc. v. JS&A Group, Inc.*,[110] a 1979 district court opinion, plaintiff had copyright on a source program that directed a computer to play chess with a human opponent.[111] Plaintiff marketed a computer chess device that implemented plaintiff's copyrighted source program in the form of a read only memory (ROM).[112] One year later defendant began marketing a competitive computer chess

[106] Continental Cas. Co. v. Beardsley, 253 F.2d 702, 705 (2d Cir.), *cert. denied*, 358 U.S. 816 (1958).
[107] 462 F. Supp. at 1012.
[108] *Id.* at 1013.
[109] *Id.* at 1013 n.5.
[110] 480 F. Supp. 1063 (N.D. Ill. 1979).
[111] *Id.* at 1065–66.
[112] A ROM is an object program. In this case the ROM was "installed in the computer as part of its circuitry." *Id.* at 1066.

game having an identical ROM as plaintiff's computer chess device.[113] The court assumed that defendant directly copied plaintiff's ROM but granted summary judgment in favor of defendant on the ground that defendant had "a complete defense as a matter of law with respect to plaintiff's claim of copyright infringement."[114] In applying the 1909 Copyright Act, the court held that a ROM is not a copy within the meaning of the Act, because it "is not in a form which one can 'see and read, with the naked eye."[115] The court based its decision on the holding in *White-Smith Music Publishing Co. v. Apollo Co.*,[116] in which the Supreme Court held that a perforated roll, commonly known as a piano roll, which causes a player piano to play a certain composition, did not infringe copyright of the underlying composition.[117] The *Data Cash* court stated in dicta that even if the 1976 Act had applied, there still would have been no infringement, on the ground that although

> the new definition of copy [under the 1976 Copyright Act] encompasses works which may be perceived "with the aid of a machine or device," . . . the 1976 Act applies to computer programs in their flow chart, source and assembly phases but not in their object phase, *i.e.*, the ROM, for the following reasons:
> (1) [The court noted that section 401(c) of the 1976 Copyright Act requires adequate notice, and the court quoted a proposed regulation for satisfying the notice requirement on various types of works] . . .
> (2) In its object phase, the computer program is a mechanical device [and thus not the proper subject of copyright because it] . . . is engaged in the computer to become an essential part of the mechanical process.[118]

While the *Data Cash* court may have been correct in its analysis of the availability of copyright protection under the

[113] *Id.*
[114] *Id.* at 1069.
[115] *Id.*
[116] 209 U.S. 1 (1908).
[117] *Id.* at 18.
[118] 480 F. Supp. at 1066 n.4 (quoting 17 U.S.C. § 101 (App. 1976)).

1909 Copyright Act, its dicta concerning the scope of protection under the 1976 Copyright Act must be viewed skeptically. For example, the section 101 definition of "copy" and the section 102 definition of "works of authorship" in the 1976 Copyright Act legislatively overrule the doctrine of *White-Smith Publishing Co. v. Apollo Co.*[119] Both definitions include within the scope of copyright any fixed work that may be "perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device."[120] There is some question whether, in the absence of section 117, the expanded definitions of the 1976 Copyright Act would extend copyright protection to computer programs in their assembly or object phases.[121]

The probable impact of the *Data Cash* decision will be to discourage the software industry from obtaining copyright protection for their efforts. Both the *Synercom* and *Data Cash* decisions are likely to cause computer program developers to resort to trade secrecy and to restrictive agreements with their customers to protect their investments—practices that would undesirably limit the software industry's opportunity to benefit from the technical expertise of others, a consequence not in the best interest of the public.

PROPOSED CHANGES IN TRADITIONAL COPYRIGHT LAW

After much research[122] and evaluation of the problem of protecting computer programs, CONTU's final report[123]

[119] 209 U.S. 1 (1908). *See* NIMMER, *supra* note 80, at § 2.05 [A].

[120] 17 U.S.C. §§ 101–102 (Supp. II 1978).

[121] One commentator stated that "the new Act extends protection to . . . the transformation of a higher level computer language into machine language for use by a computer." Pfeifer, *supra* note 2, at 235. *But see* CONTU REPORT, *supra* note 27, at 31 ("[C]omputer programs are exactly the type of work barred from copyright by these considerations.") (Hersey, Comm'r., dissenting); *see also* Lawlor, *supra* note 24, at 20.

[122] CONTU REPORT, *supra* note 27, at app. 113–41.

[123] CONTU REPORT, *supra* note 27.

recommended that the 1976 Copyright Act be amended to include expressly computer programs "to the extent that they embody an author's original creation."[124] CONTU should be commended for attempting to provide adequate protection for computer programs and to clarify the precise scope of protection that would be available if changes were made in the copyright statutes according to the Commission's recommendations.[125]

CONTU's report noted the disagreement concerning the propriety of extending copyright protection to computer programs[126] because computer programs are "used in conjunction with machines."[127] The Commission forcefully dismissed this objection by stating that "[p]rograms should no more be considered machine parts than videotapes should be considered parts of projectors or phonorecords parts of sound reproduction equipment."[128] The medium of a computer program, like a videotape or phonorecord

> [I]s moved past a sensing device at a set speed, causing electric current to flow, and ultimately resulting in the movement of machine parts to print words, display pictures, or create sounds. . . . All that copyright protection for programs, videotapes, and phonorecords means is that users may not take the works of others to operate their machines. . . . [O]ne is always free to make the machine do the same thing as it would if it had the copyrighted work placed in it, but only by one's own creative efforts rather than by piracy.[129]

These statements indicate that the Commission believed it apparent that copyright protection may extend not only to the source phase of a computer program but also to the assembly and object phases, since these phases are ultimately necessary to direct the electrical impulses of a computer. If so, the dicta

[124] CONTU REPORT, *supra* note 27, at 12. *See* note 93 and accompanying text *supra*.
[125] Recommendations of the CONTU report are quoted in note 93 *supra*.
[126] CONTU REPORT, *supra* note 27, at 15.
[127] *Id.* at 20–21.
[128] *Id.* at 21.
[129] *Id.*

in *Data Cash*[130] concerning the scope of protection under the 1976 Copyright Act is erroneous. It is not clear, however, that the Commission actually intended to imply that copyright in a source phase of a computer program would protect against copying in either the assembly or object phases. For example, in another portion of the report, the Commission stated that "[c]opyright . . . protects the program so long as it remains fixed in a tangible medium of expression but does not protect the electro-mechanical functioning of a machine."[131] Since the object phase of a computer program is an integral part of the computer itself,[132] it may not be protected by traditional copyright. Similarly, protection through traditional copyright appears to be unavailable to microprocessors that permanently embody a computer program in the object phase.[133] This is not unreasonable in view of the fact that the Commission attempted to protect computer programs without distorting the traditional concepts of copyright, but it is undesirable in view of the ideal goals of industry. Withholding protection to assembly and object phases of a computer program may also be undesirable for the public. If no protection is provided, program originators in situations similar to that of the plaintiff in *Data Cash*[134] will not register the source phase of their programs and, instead, will rely on trade secret protection to prevent others from copying. Consequently, the dissemination of technical expertise will be retarded, and the public will suffer the long-term detrimental effects.

The goals of the Commission were, *inter alia*, that "[c]opyright should not block the development and dissemination of . . . [comptuer] works"[135] and that "[c]opyright should

[130] *See* text accompanying note 118 *supra*.
[131] CONTU REPORT, *supra* note 27, at 20.
[132] *See* text accompanying note 13 *supra*.
[133] *See* CONTU REPORT, *supra* note 27, at 32 (Hersey, Comm'r., dissenting).
[134] *See* text accompanying notes 16–26 *supra*.
[135] CONTU REPORT, *supra* note 27, at 12.

not grant anyone more economic power than is necessary to achieve the incentive to create."[136] These goals, by their very nature, are often conflicting. In balancing these goals and attempting to maintain the traditional boundaries of copyright protection, the Commission believed that the best alternative was to provide limited protection through copyright instead of either creating a separate federal software protection act[137] or providing no federal protection for computer programs at all.[138] It is impossible to test the validity of the Commission's decision with any economic or technological certainty. The CONTU Report has been criticized by some; however, it should be recognized that there is no single solution to the complex problem of protecting computer programs, and the recommendations by CONTU were made after much serious research and study by highly respected scholars in the field of copyright law.

Commissioner Hersey,[139] in a thoughtful dissent in the

[136] *Id.*

[137] A separate software protection act having hybrid characteristics of both patent and copyright theories of protection has been suggested by various commentators. *See* Galbi, *Proposal for New Legislation to Protect Computer Programming*, 17 BULL. COPYRIGHT SOC'Y 280 (1970); Pope & Pope, *supra* note 6, at 529, 554 at app. A.; Scafetta, *Computer Software Protection: The Copyright Revision Bills and Alternatives*, 8 J. MAR. J. PRAC. AND PROC. 381, 398–99 (1975); 26 DRAKE L. REV., *supra* note 47, at 197. At Commissioner Hersey's request, the Computer Software Protection Act was prepared as an alternative to the report of the Software Subcommittee of CONTU. Pope & Pope, *supra* note 6, at 592, 554 at app. A.

[138] The CONTU report suggests that the computer software industry does not need protection to encourage development in view of the present rapid development in the area, the lack of dominant software companies acting as a barrier to those entering the market, and the relative insignificance of software expenditures in the overall development picture. CONTU REPORT, *supra* note 27, at 9 & 23. However, it has been suggested by one commentator that these views are misguided. The commentator believes that the Commission and Commissioner Hersey "did not realize that there is *no* trade association concerned with software protection that has not been infiltrated by representatives of the hardware industry." Lawlor, *supra* note 24, at 28.

[139] Commissioner Hersey is a Pulitzer prize winner in the fiction area. He has served as President of the Authors League of America, Inc., and as Secretary of the American Academy of Arts and Letters. CONTU REPORT, *supra* note 27, at app. 107.

CONTU report, set forth the position that if the recommendations made by the majority were enacted, then copyright would extend to computer programs in their assembly and object phases.[140] Commissioner Hersey felt that this result would give needless protection to the computer software industry.[141] Citing various studies,[142] Commissioner Hersey expressed the view that actual instances of computer "rip-off" [143] are rare and that such instances are "amenable to correction by laws other than copyright." [144] Commissioner Hersey stated that "[t]he existing network of technological, contractual, nondisclosure, trade-secret, common-law misappropriation, and (in a few instances) patent forms of protection . . . will be wholly adequate . . . to the needs of developers." [145] A problem with the existing forms of protection, however, is the undesirable requirement of nondisclosure to the public to protect the programmer's investment.

Commissioner Hersey viewed extending copyright to the machine-readable phase as completely different from extending copyright to phonorecords or motion pictures.[146] He distinguished the purpose of a phonorecord or tape, which is to communicate to human beings, from the ultimate purpose of a computer program, which is to communicate with a machine.[147] Commissioner Hersey maintained that extending copyright to the machine-readable phase of a computer program would be protecting "a labor-saving mechanical device" [148] and would be a tremendous distortion that "in the long run [would] tend to corrupt and erode the essential purposes of copyright." [149]

[140] CONTU REPORT, *supra* note 27, at 32 (Hersey, Comm'r., dissenting).
[141] *Id.* (Hersey, Comm'r., dissenting).
[142] *Id.* at 30 n.133–35.
[143] *Id.* at 30.
[144] *Id.*
[145] *Id.* at 30–31.
[146] *Id.* at 28–29.
[147] *Id.*
[148] *Id.* at 30.
[149] *Id.* at 31.

In reaction to Commissioner Hersey's dissent, Commissioner Nimmer[150] concurred with the proposals of the majority in the CONTU report. Commissioner Nimmer suggested, however, that copyright should be limited "to those computer programs which produce works which themselves qualify for copyright protection."[151] This is a highly commendable proposal because by so limiting copyright protection, less distortion of the traditional role of copyright would occur. The distinction, however, between those computer programs that generate output readable by a user and those programs that have as their sole function to operate as a machine is a highly artificial one. This distinction is an excellent example of the complexity of the program of extending traditional copyright protection to computer programs.[152]

PROPOSED HYBRID SYSTEMS OF SOFTWARE PROTECTION

In a subcommittee report prior to the issuance of the final report by CONTU, Commissioner Hersey proposed special legislation that would "'protect both the expression (appropriate to copyright) and the innovative ideas (appropriate to patent) involved in the creation of computer programs.'"[153] This approach appears to be more reasonable than attempting to protect computer programs through traditional copyright.

The proposed act would protect

[150] Commissioner Nimmer, one of the most highly regarded scholars in the area of copyright law, is the author of the treatise NIMMER ON COPYRIGHT. CONTU REPORT, *supra* note 27, at app. 107.

[151] CONTU REPORT, *supra* note 27, at 27.

[152] Commissioner Nimmer was concerned with the problem of copyright protection's being extended to areas traditionally reserved for patent protection. He did not wish to have his proposal implemented immediately but offered it only in the event that the proposals recommended by the majority were found unconstitutional. *Id.* at 26–27.

[153] Pope & Pope, *supra* note 6, at 529 (quoting SOFTWARE SUBCOMMITTEE OF THE NATIONAL COMMISSION ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS, REPORT [1977]) (Hersey, Comm'r., dissenting).

[C]omputer software [154] which is the product of original intellectual effort, produced in any form or medium, and which includes as one of its component elements a computer program [155] capable of interacting directly with a computer to control its operations in order to obtain a desired result.[156]

The proposed act would give a

[L]awful proprietor of computer software . . . the exclusive right to do and authorize the following:

(1) to reproduce the software in whole or substantial part, including any original method or process embodied in the software, in any medium;
(2) to distribute copies of the software, in whole or substantial part, to the public by sale or lease; [and]
(3) to use the software, in whole or substantial part, to operate a computer.[157]

The requirement that software be an "original intellectual effort" before allowing protection is similar to the standard of "original works of authorship fixed in any tangible medium of expression" [158] under the present copyright laws. The proposed software protection act would expand protection to cover not only the work as it is "fixed in a tangible medium of expression . . . from which they can be perceived, reproduced or othewise communicated" [159] but also the reproduction of the protected software "in any medium." [160]

Other legal commentators have suggested similar propo-

[154] The proposed Computer Software Protection Act defines computer software as "a computer program and all accompanying documentation." Computer Software Protection Act § 2 (1977), *reprinted in* Pope & Pope, *supra* note 6, app. A at 554.

[155] Computer program is defined in the proposed Software Protection Act as "a set of machine directions designed to control the operations of a computer in order to obtain a desired result." *Id.*

[156] *Id.* § 3(a).

[157] *Id.* § 4.

[158] 17 U.S.C. § 102(a) (Supp. II 1978).

[159] *Id.*

[160] Computer Software Protection Act § 4(1) (1977), *reprinted in* Pope & Pope, *supra* note 6, app. A at 554.

sals.[161] For example, one commentator suggested combining the criteria of "utility, novelty, and non-obviousness" required for patent protection with the criterion of originality required for copyright protection.[162] This suggestion would, however, make the availability of protection for computer programs almost nonexistent if the stringent standards currently applied to "novelty" by the patent office were applied to computer programs.[163] Furthermore, combining the requirement of originality with the requirement of novelty adds nothing to the proposed protection standard since, by definition, anything that is novel is also original.

Another suggestion is that under a hybrid system of protection, exclusive rights should be granted to the creator of a program for a shorter period of time than is granted to the recipient of a patent. This shorter period is justifiable in light of the "rapid advance in technique and technology in the computer industry."[164] Such a grant "would provide [increased] incentive for further innovations."[165] This proposal has merit and has been the partial rationale of countries[166] that grant exclusive patent rights for relatively short periods of time.

To have a federal system of computer program protection that is economically feasible, registration of computer programs without a search of the prior act to determine if the appropriate standards have been met may be desirable. A relatively small fee could be required for registration, and one wishing to determine the validity of such registration could later request a search and pay a larger fee to support the cost of making a validity determination. If no search is requested within a reasonable period, for instance five years,

[161] *See* note 137 *supra*.

[162] 26 DRAKE L. REV., *supra* note 47, at 198.

[163] *See* CONTU REPORT, *supra* note 27, at 17.

[164] 26 DRAKE L. REV., *supra* note 47, at 197; *accord*, Proposed Software Protection Act § 7 (1977), *reprinted in* Pope & Pope, *supra* note 6, app. A at 554.

[165] 26 DRAKE L. REV., *supra* note 47, at 197.

[166] Argentina, Brazil, Bulgaria, Chile, China, Czechoslovakia, Egypt, India, Iran, Iraq, Mexico, and Uruguay grant patent rights for less than 15 years. 1–3 COPYRIGHT LAWS AND TREATIES OF THE WORLD (BNA).

the registered material could become part of the public domain. This procedure is similar to the patent systems of other countries.[167]

A hybrid system of software protection should protect against unauthorized copying of one phase of a computer program into another phase of the same program to encourage the software industry to disclose a computer program to the public in return for a limited monopoly.[168] It may also be desirable in a hybrid system of protection to guard against an unauthorized embodiment of a computer program in a microprocessor.

Among the major difficulties of creating a hybrid system of protection is the problem of defining the exact standards a computer program must meet before it will be entitled to protection. Should it be required to be fixed in a tangible medium of expression? Should it be required to be novel, original, or perhaps neither? Should it be required to be in a form that is readable by humans? Another problem posed by any attempt to implement a hybrid form of protection is the difficulty of precisely defining which acts constitute infringement. Should protection extend only to unauthorized copying of expression, or should the underlying ideas also be protected? Should independent operation by another of the same computer program be sufficient to overcome an infringement action? Should there be a doctrine of fair use or a doctrine of necessity? Along the same vein, it may be desirable to require compulsory licensing in certain circumstances in a hybrid system of protection.

CONCLUSION

Under traditional copyright law, some protection for computer programs is available.[169] This protection allows some

[167] *Id.* Australia, Brazil, France, Hungary, Japan, Mexico, the Netherlands, and West Germany.

[168] *See* text accompanying note 18 *supra.*

[169] *See* text accompanying notes 77–90 *supra.*

of the goals of industry and the public to be met at least partially.[170] For example, copyright registration of a computer program currently protects against direct copying in the same phase[171] and thus provides at least minimal protection to industry. Further, copyright legislation allows the public to benefit through disclosure of information.[172] It is apparent, however, copyright can by no means meet all the goals of both government and industry, and even the recommended changes proposed by CONTU would advance the goals of government and industry only in a limited fashion.[173] Finally, any system of protecting computer software that adequately meets the goals of government and industry will most likely be a hybrid system of protection. The creation and administration of a hybrid system clearly would be an extremely complex task, and therefore the advent of such a system is unlikely in the foreseeable future. Such a system need not, however, be unduly expensive either for government to manage or for the software industry to use.

POSTSCRIPT

Two developments in copyright law have occurred since this paper was submitted to the Nathan Burkan Competition that warrant a postscript comment. The first and most important development is that 17 U.S.C. has been amended to remove the limitation that the 1978 Copyright Act could not afford the owner of copyright in a computer program any greater or lesser rights with respect to the use of that work than was available under the 1909 Copyright Act. 17 U.S.C. §101 has been amended to define a computer program as "a set of statements or instructions to be used directly or indirectly with a computer in order to bring about a certain

[170] *See* text accompanying notes 16–30 *supra*.
[171] *See* note 17 *supra*.
[172] *See* note 29 *supra*.
[173] *See* text accompanying notes 126–38 *supra*.

result." Computer programs, as so defined, are now clearly within the scope of the 1978 Copyright Act. 17 U.S.C. §117 has been amended to permit the owner of an authorized copy of a computer program to make an additional copy of that program for archival purposes. It also permits the owner to make an additional copy of the program if such a copy is essential to utilize the program in conjunction with a machine. These amendments to the 1978 Copyright Act, in essence, incorporate the recommendations of the CONTU Report. The extent to which computer programs will be protected under the 1978 Copyright Act, as amended, however, remains to be seen.

The second recent development in copyright law of importance to this paper is that *Data Cash Systems, Inc. v. SJ&A Group, Inc.*, F. (208 U.S.P.Q. 197) (BNA), discussed in depth, *supra*, at notes 110–121 has been appealed. The appellate court affirmed the district court's holding, but on different grounds. The district court had held that a read-only-memory (ROM) computer source program is not a copy within the meaning of the 1909 Copyright Act, because it was not in a form which one can see and read with the naked eye. The appellate court most interestingly commented that this issue had been neither briefed nor argued by either of the parties, and neither side on appeal defended the district court's position. The appellate court soundly based its decision on the fact that the ROMs had been "published" without notice of copyright and that such publication under the 1909 Copyright Act resulted in forfeiture of copyright. The "publication" in this case occurred when the defendant integrated the computer program in the form of a ROM into a "Compuchess" game. Over 2,500 Compuchess games were sold in 1977 to the general public without restriction. The plaintiff argued that it did not know that it was possible to read the copyrighted program from a ROM. The defendants, however, were able to read the program from the ROM. Also, there was

no notice on the ROM, the game board, the packaging, or the accompanying instructions that there was copyright on the program. The court, therefore, properly held that the plaintiff had forfeited all rights under the 1909 Copyright Act. This decision should be a further indication to developers of computer programs that it is not desirable to be overly dependent upon federal copyright law, or the courts in applying that law, for protection from outright copying unless the particular phase of the program sought to be protected has been registered.

NATIONAL SECOND PRIZE, 1980

The Uncopyrightability of Historical Matter: Protecting Form Over Substance and Fiction Over Fact

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INTRODUCTION

WHEN NORMAN MAILER wrote *The Executioner's Song*, a story centering upon the life of convicted murderer Gary Gilmore, he and his publisher decided to call it a work of fiction. This decision stirred considerable controversy when the book was awarded the 1980 Pulitzer Prize in the fiction category because of its seemingly nonfictional nature.[1] The question that naturally arises from this example is why would an author want to cast a biography of a notorious figure involved in a historically significant event in a fictional mold? One reason might be the prospect of securing greater copyright

[1] The Boston Globe, April 15, 1980, p. 10 ("The book had been critically acclaimed but stirred controversy, for Mailer and his publisher have termed it a work of fiction, even though it tells the story of real people involved in a highly publicized event"). It is interesting too that Mailer's only other Pulitzer, won in 1969 for his ARMIES OF THE NIGHT, was in the nonfiction category. *Id.*

protection. By representing the material in one's work to be fictional rather than factual, an author arguably could estop a plagiarist from denying the originality of the contents of the copyrighted work.[2]

The essential point is that historical and biographical matter receives markedly different treatment in copyright law than fictional matter does. Traditionally, historians and biographers, whether writing primarily for academic or commercial reasons, have received scant judicial support in their attempts to protect their work product from exploitation. Recent decisions offer, however, some indication that a countertrend may be developing.[3]

This article focuses upon the copyright protection afforded an author dealing with historical and biographical matter in a fixed work.[4] Part I sets out the bare essentials of what elements need to be present for historical matter to be protectible. Part II examines the extent and scope of protection afforded such matter by the courts through their application of the fair use doctrine.

ORIGINAL FEATURES OF HISTORICAL WORKS

It is a settled principle in the field of copyright law that a person may not claim a copyright as to factual matter con-

[2] *See* text at pages 17–19 *infra*.

[3] *See* Miller v. Universal City Studios, Inc., 460 F. Supp. 984 (S.D. Fla. 1978); Meeropol v. Nizer, 560 F.2d 1061 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978). *See also* Wainwright Securities, Inc. v. Wall Street Transcript Corp., 558 F.2d 91 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978). *But see* Hoehling v. Universal City Studios, Inc., 618 F.2d 972 (2d Cir. 1980).

[4] The differences between biography and history are so indistinct that the two forms may be treated as one for present purposes. One court has noted that "(b)iographies, of course, are fundamentally personal histories," Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967), while Ralph Waldo Emerson opined that "[t]here is properly no history; only Biography." R. W. EMERSON, ESSAYS FIRST SERIES, HISTORY (1841).

tained in a work of authorship.[5] The accepted view taken by the courts is that facts, at least in their barest form, are in the public domain and may, therefore, be freely repeated by anyone who may wish to use them.[6] The rationale for this view centers upon the concept of originality;[7] a person may "discover" factual matter and bring it to public attention before anyone else, but a person may not "create" factual matter by his own devices.[8] Through this tautological distinction between originality and discoverability, the courts have,

[5] Greenbie v. Noble, 151 F. Supp. 45, 65–66 (S.D.N.Y. 1957) ("There is no copyright of facts, news or history"). *See* 1 M. NIMMER, NIMMER ON COPYRIGHT § 2.11[A] n.1 (1979) [hereinafter cited as NIMMER], for cited cases.

[6] Fuld v. National Broadcasting Co., Inc., 390 F. Supp. 877, 881 (S.D.N.Y. 1975). *Accord* Greenbie v. Noble, 151 F. Supp. 45, 66 (S.D.N.Y. 1957) ("By drawing upon materials and sources available to all, an author does not thereby obtain the right to exclude others from using the same materials").

The soundness of this rule was aptly illustrated by Judge Leon Yankwich in Echevarria v. Warner Bros. Pictures, Inc.:

> One cannot build a story around a historical incident and then claim exclusive right to the use of the incident. If originality can be claimed in opposing Aguinaldo to Funston, as the plaintiff claimed in open court, then all the novels, short stories, and dramas written about the Civil War, opposing Grant and Lee, might never have been written after the first one because the author of the first one could have claimed exclusive right to the product.

12 F. Supp. 632, 638 (S.D. Cal. 1935).

[7] *See* The 1976 Copyright Act, Title 17 U.S.C., 90 Stat. 2541 *et seq.*, Public Law 94-553 (hereinafter cited as 1976 ACT) § 102(a). Originality means that the matter owes its creation to the author, with a view toward ensuring that it was not slavishly or mechanically copied from other sources that are either copyrighted or in the public domain. L. Batlin & Son, Inc. v. Snyder, 536 F.2d 486 (2d Cir. 1976) (*en banc*).

[8] As stated by Melville Nimmer:

> No one may claim originality as to facts. Facts may be discovered, but they are not created by an act of authorship. One who discovered an otherwise unknown fact may well have performed a socially useful function, but the discovery as such does not render him an "author" in either the constitutional or statutory sense.

2 NIMMER, *supra* note 5, § 2.11.

Of course, it is entirely possible for a narrator to represent a particular incident or event as a factual account when it is actually fictional in character. In such a case, the purported factual matter would owe its creation to the narrator so as to meet the test for originality. The courts will nevertheless estop the author from claiming protection over such matter on equitable principles in certain instances. *See* notes 33–46 and accompanying text *infra*.

in effect, ascribed an independent and separate existence to "facts" ordinarily reserved for matter having more tangible characteristics, such as gems and continents.

To fully appreciate how troublesome this area of copyright law is, one needs to be aware that there are important, but inconsistently applied, exceptions to the rule that factual matter contained in a work is not copyrightable. The basis for these exceptions generally was intimated in *Greenbie v. Noble:* "Copyrighted work based on material in the public domain then can be infringed only when so transformed by the first taker as to entitle him to a claim of originality."[9] The question then is how does the user, or even discoverer, of historical facts succeed in enshrouding his use of them within a cloak of originality? Four recognized exceptions provide the answer.

THE TANGIBLE EXPRESSION OF IDEAS AND EVENTS

Just as historical or newsworthy events are deemed to be matters of public record and, hence, uncopyrightable,[10] the premise that copyright protection is unavailable for ideas is firmly entrenched in copyright law.[11] While the uncopyrightability of factual matter may be explained on the basis of its independent existence,[12] the converse rationale holds true for ideas; it is the lack of independent existence that explains their uncopyrightability. The substance of an idea is, by necessity, too amorphous to lend itself to judicial determinations of whether one person has copied another's idea. Since an "idea" is little more than a label for the product of man's thought processes, its formulation cannot be traced in terms

[9] 151 F. Supp. at 65 (S.D.N.Y. 1957).

[10] Time, Inc. v. Bernard Geis Associates, 293 F. Supp. 130 (S.D.N.Y. 1968). *See* note 5 *supra* for additional cites.

[11] 1976 ACT supra note 7, 102(b). *See also* Jackson v. Washington Monthly Co., 481 F. Supp. 647 (D.D.C. 1979); Reyher v. Children's Television Workshop, 533 F.2d 87 (2d Cir.) *cert. denied*, 429 U.S. 980 (1976); Roth Greeting Cards v. United Card Co., 429 F.2d 1106 (9th Cir. 1970).

[12] *See* notes 7–8 and accompanying text *supra*.

of how its creator came by it. Once an idea is given tangible expression in the form of words or symbols so as to be understandable by others, however, the literal expression of the idea is entitled to copyright protection.[13] Similarly, the literal expression of factual matter is entitled to copyright protection. Thus, one author is free to use the facts and ideas contained in another author's work, but he is not free to use the same, or a substantially similar[14] arrangement of words in expressing those facts and ideas.[15]

The case of *Eisenschiml v. Fawcett Publications*[16] is illustrative of the limited nature of copyright protection in the dual context of factual matter and ideas. The plaintiff, Otto Eisenschiml, was a renowned historian of the Civil War period whose particular area of expertise was the assassination of Abraham Lincoln. Eisenschiml wrote a scholarly book entitled *Why Was Lincoln Murdered?* in which he recounted the events leading to Lincoln's assassination and the subsequent history of the participants.[17] The defendants were a

[13] Holmes v. Hurst, 174 U.S. 82, 86 (1899) ("The right thus secured by the copyright act . . . is to that arrangement of words which the author has selected to express his ideas"). *See also* Scott v. WKJG, Inc., 376 F.2d 467 (7th Cir.) *cert. denied*, 389 U.S. 832 (1967).

[14] For copyright purposes, "paraphrasing is copying," and will constitute an infringement, "if carried to a sufficient extent." Eisenschiml v. Fawcett Publications, 246 F.2d 598, 603 (7th Cir.) *cert. denied*, 355 U.S. 907.

[15] When a book is designed to convey information, a reader is entitled to avail himself of the facts contained therein and may use such information, whether correct or incorrect, in his own literary work, provided that his expression and treatment is distinctly his own and not merely the result of copying from the book. The second author may also adopt the first author's historical ideas and theories since the law of copyright only protects an author's mode of expression and not his ideas.
Greenbie v. Noble, 151 F. Supp. 45, 67 (S.D.N.Y. 1957) (citations omitted).

[16] 246, F.2d 598 (7th Cir.) *cert. denied*, 355 U.S. 907 (1957).

[17] The distinctive feature of the book, apart from its thorough presentation and treatment of primary source material, was the author's thesis that Secretary of War Edwin Stanton had received advance knowledge of the assassination plot and had made no attempt to prevent its fatal fruition. The thrust of this thesis was the speculative suggestion that Stanton may have been an actual conspirator to the plot. *Id.* at 600.

publisher and a free-lance writer who joined in the preparation of a magazine article on Lincoln's assassination. The article was alleged to have followed the same general organizational outline, focused upon the same historical figures, and advanced the same novel hypothesis—that Edwin Stanton may have been involved in the conspiracy—found in Eisenschiml's book.[18]

With respect to the factual matter contained in both works, it was clear that the defendant author had relied, to some extent at least, upon Eisenschiml's version of certain events without seeking any corroboration from available primary sources.[19] In addition, the defendant author candidly admitted that he was indebted to the plaintiff's work for many of the ideas, or theories, contained in his article.[20] This use of Eisenschiml's research and ideas was not sufficient to support an infringement action, and so the ultimate decision revolved around the issue of whether defendant had copied the plaintiff's "mode of expression" in substantial form. In addressing this issue, the plaintiff produced more than sixty passages

[18] *Id.* at 601. *See* note 17 *supra.*

[19] For instance, the plaintiff obtained some of his factual information from police records which had never been reported in any account of the events prior to its use in his book. This information also appeared in the defendant's version of the events. *Id.* at 602. Clearly, the police records were in the public domain and, having been alerted to their existence by the footnotes to the plaintiff's book, the defendant could have consulted them freely. He did not. He simply used the facts as represented by the plaintiff in his own article, which he was apparently free to do since the plaintiff could not claim a copyright to such *factual* material.

A contrary result might be reached today as more courts show a willingness to find a basis for copyright protection arising from the commercial value of one's research. *See* notes 71–79 and accompanying text *infra.*

[20] The defendant's testimony included the following responses:

"That, I believe, was queued [*sic*] to me by Dr. Eisenschiml's book," "Oh, I got some of it from the Eisenschiml books"; "The thought was undeniably inspired by Dr. Eisenschiml"; "The idea, I think, is an inspiration of Dr. Eisenschiml"; "The idea, I think, I can positively state, was Dr. Eisenschiml's"; "The material, I think, came from Dr. Eisenschiml."

Id. at 602.

that were alleged to have been copied from his book,[21] only to have the court note in its decision that "(t)he question of infringement of copyright is not one of quantity but of quality and value," [22] and conclude that the defendants' copying came within the fair use privilege.[23]

In summation, while an author's literal expression of historical facts is copyrightable, the question of infringement is necessarily tempered by the fair use privilege. The proper application and scope of that privilege is addressed in the second part of this article. It is sufficient to point out at this juncture that the *Eisenschiml* court utilized a subjective standard of evaluation by focusing on the "quality" of the plagiarisms rather than the number of instances, presumably in order to downplay the substantial copying, as measured quantitatively, that appeared in the defendants' article. The effect of this approach is to give the courts tremendous discretion in deciding whether to permit even numerous instances of a later author's copying the literal expression of an earlier author's facts and ideas. The *Eisenschiml* court, for one, appears to have been anxious to exercise that discretion to afford minimal copyright protection at best to the author of a historical work.

THE SELECTION AND ORDER OF PRESENTATION OF FACTS

The preparation of a historical treatise requires a great degree of independent judgment on the part of the author in deciding which facts to use and how much weight or emphasis to give them in his treatment of the general subject matter. As to the arrangement of selected facts, one may reasonably anticipate that most authors will present their historical facts in

[21] Illustrative of these allegedly pirated passages is the plaintiff's version of an incident: "In his memoirs, Grant passed over this episode quickly and skillfully . . . ," as compared to the defendants' version of the same incident: "In his memoirs, Grant skillfully slid over the incident." *Id.* at 601.

[22] *Id.* at 603, *quoting* H. BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 357 (1944).

[23] The fair use doctrine is discussed in Part II *infra*.

chronological sequence, or, as Judge Learned Hand averred, "at least, such is the convention—the order in which facts are reported must be the same in the case of a second supposed author."[24] Judge Hand was of the opinion that neither the selection nor the arrangement of facts was copyrightable, even though he recognized that "into that selection may go the highest genius of authorship, for indeed, history depends wholly upon a selection from the undifferentiated mass of recorded facts."[25]

At least one modern court has subscribed to Hand's conclusion with respect to the uncopyrightability of one's *arrangement* of facts where it is chronological in format.[26] Common sense dictates that other courts would follow suit should that precise issue arise in future infringement actions. A different result would be warranted where an eccentric author chose to arrange his facts in an unconventional (*i.e.*, nonchronological) manner. For example, suppose an author chose to present a history on the lives of the Presidents on the basis of their astrological signs or through a totally random, alphabetical or other unusual method of arrangement, and a second author, inspired by his acquaintance with the prior work, opted to adopt the same order of presentation for a similar work on the same subject matter. In such an instance, one could argue that the order of presentation in the first work was distinctive enough in terms of originality to justify copyright protection.

An even stronger argument may be advanced for the copyrightability of a historian's *selection* of facts, and the courts have appeared receptive to such an exception.[27] The case of

[24] Norman v. Columbia Broadcasting System, Inc., 333 F. Supp. 788, 796–97 (S.D.N.Y. 1971), *citing* Myers v. Mail & Express Co., 36 Cr. Off. Bull. 478, 479 (S.D.N.Y. 1919) (unreported).

[25] *Id.*

[26] *Id.* at 795 ("Plaintiff's claim that defendants have infringed upon his work by reason of using identical sequences is without merit since the continuity of plaintiff's biography of Pound is chronological").

[27] *See* 2 M. NIMMER, *supra* note 5, § 2.11[D] n.26 for cited cases.

Meredith Corp. v. Harper & Row, Publishers, Inc.,[28] is illustrative of the soundness of this trend. The case involved a dispute between the publishers of two competing textbooks on child psychology. At trial, Meredith Corp. and additional defendants conceded that the language of eleven percent of their text had been plagiarized from Harper & Row's copyrighted text and that this reliance exceeded the scope of the fair use doctrine. Consequently, a preliminary injunction upon the further release of the Meredith text was issued.[29] The issue before the court centered upon the status of the remaining eighty-nine percent of the book. Similar to what one would expect the defense in an action between competing historical works to be, Meredith claimed that its text was the product of independent effort by the author and that any similarity between the two texts, aside from the admittedly plagiarized portion, was attributable to their common subject matter and chronological approach. At trial, the court had admitted into evidence four other leading texts on child development, each of which used a chronological approach, and, in light of the comparison between the various texts, the court concluded that the "extensive duplication" between the Meredith and Mussen (*i.e.*, Harper & Row) texts was hardly coincidental.[30] In holding that a permanent injunction was warranted upon this basis, the court held that:

> (W)hile the Meredith text contains *some* independent ideas of the author, *some* independent research, *some* additional topics and *some* differing structure, the topic selection and arrangement of the Meredith book are in substantial part the result of copying of the Mussen book not attributable to independent effort by Meredith or the neces-

[28] 413 F. Supp. 385 (S.D.N.Y. 1975).

[29] *Id.* at 385, *referring to* Meredith v. Harper & Row, Inc., 378 F. Supp. 686 (S.D.N.Y. 1974).

[30] *Id.* at 386 ("It is clear that the unusually high correlation in topic sequencing . . . was the result of copying and not the coincidental outcome of an independent structuring by Meredith").

sary result of limited possibilities for organizing and presenting the material to be covered. The copying thus affects the entire text and not just the eleven percent admittedly infringed.[31]

The significance of the *Meredith* decision is its clear implication that the selection and arrangement of factual matter may be copyrighted. But as long as continued deference is accorded Learned Hand's views to the contrary, this issue remains unsettled. If an expansive interpretation is to be given to infringement controversies of this type, the extent to which similarities in the selection and topical arrangement of the material may reasonably be expected to be due to the similarity in subject and the conventionality of the treatment accorded it emerges as the primary test. Reference to other competing works offers an effective and objective method for determining the reasonableness of the similarity between the contending works, while it is borne in mind that the fair use doctrine will undoubtedly afford some leeway to the copier.

FICTIONAL FEATURES IN A FACTUAL WORK

Since the rationale behind the uncopyrightability of factual matter is the notion that facts may not be created by an author, an accepted corollary is that fictional features in an otherwise factual account are copyrightable insofar as they originate with the author.[32] This exception appears logical in theory, and yet its application in practice persents certain problems. These problems center upon a question of labeling, or delineating, the fiction from the fact.

To illustrate, suppose an author embellishes a historical account of the life of a famous, but boring, figure with a fic-

[31] *Id.* at 387 (emphasis in original) (citations omitted).

[32] "[T]he fictionalizing of events and incidents in the life of an historic figure is the author's original treatment of the life of such figure and is subject to protection against appropriation by others." Greenbie v. Noble, 151 F. Supp. 45, 65 (S.D.N.Y. 1957). *See* DeAcosta v. Brown, 146 F.2d 408 (2d Cir.), *cert. denied sub nom*, Hearst Magazines v. DeAcosta, 325 U.S. 862 (1944). *See also* 2 M. NIMMER, *supra* note 5, § 2.11[C] n.16 for additional cites.

tional, but fascinating, love affair.[33] The author would be entitled to copyright protection for the fictionalized portion of the biography. The Machiavellian ripple to this statement is that the author would be estopped from asserting his copyright against an infringer if a court finds that he created the impression to the general public that the fictional feature, the love affair, was factual. As stated succinctly by one court, "he who puts forth a thing as verity shall not be heard to allege for profit that it is fiction."[34] This rule of estoppel operates to protect the unwary plagiarist who relies upon another person's version of historical events without bothering to verify the information through independent research, apparently on the theory that the first author should not be permitted to benefit from his own misrepresentation. It is difficult to determine, however, precisely when the rule of estoppel applies. In other words, how blatant and how believable must the misrepresentation be before an author loses his protection?

At least one court has declined to gauge the gullibility of the general public. It applied an estoppel against an author who affirmatively asserted that his book was a factual and verbatim account of interplanetary life as dictated to him by an inhabitant of another planet named Phylon the Thibetan.[35] Whether this result is unduly harsh in such a situation bordering upon the outer limits of credulity is highly debatable. Would J. R. R. Tolkein similarly be precluded from copyright protection for his epic trilogy *The Lord of the Rings* because he avers that his information is based upon the hobbit Bilbo's personal diary and other presumably "lost" contemporaneous records?[36]

[33] *See* discussion of DeAcosta v. Brown, 146 F.2d 408 (2d Cir. 1944), notes 44–47 and accompanying text *infra*.

[34] Davies v. Bowes, 209 F. 53, 55 (S.D.N.Y. 1913), *aff'd*, 219 F. 178 (2d Cir. 1914).

[35] Oliver v. Saint Germain Foundation, 41 F. Supp. 296 (S.D.Cal. 1941).

[36] Nimmer draws a similar example with Sir Arthur Conan Doyle's Sherlock Holmes stories as told by Dr. Watson. 2 M. NIMMER, *supra* note 5, § 2.11[D].

The case of *Lake v. Columbia Broadcasting System, Inc.*[37] pitted competing accounts of the life and adventures of Wyatt Earp against one another. In granting the defendant's motion to dismiss, the court noted that the plaintiff had declared in the preface to his book that it was "an accurate historical biography based on a factual account of Wyatt Earp's career and 'in no part a mythic tale.'"[38] This express declaration apparently deprived the plaintiff of the copyright protection that ordinarily accrues to "new and original material (added) to matter already in the public domain."[39]

Absent an express representation that the events and accounts of a work are factual, the exception for fictional features will apply unless a court implies a presumption of complete accuracy. The nature of the particular work may be relevant in invoking such a presumption.[40] Thus, it would be contrary to usual expectations for a telephone directory to contain fictionalized names and addresses, and to the extent that one did, a court might construe them merely as errors in fact, which are not copyrightable *per se*.[41] Similarly, one would not ordinarily expect a news story to contain fictional elements because of its terse and concise form, so that the author of a news story that proved to be a fabrication has been estopped from asserting copyright protection on at least one occasion.[42]

Historical works may present a different situation since a greater degree of literary license may be anticipated in order to render the accounts more palatable to the reader. But, here again, the nature of the work within its particular genre may

[37] 140 F. Supp. 707 (S.D.Cal. 1956).
[38] *Id.* at 708.
[39] *Id.* at 709.
[40] *See* 2 M. NIMMER, *supra* note 5, § 2.11[C].
[41] *See* Oxford Book Co. v. College Entrance Book Co., 98 F.2d 688, 691 (2d. Cir. 1938). Even if the erroneous entries were included intentionally in order to show copying, a court would be unlikely to construe them as original features distinct from the accurate data.
[42] Davies v. Bowes, 209 F. 53 (S.D.N.Y. 1913), *aff'd*, 219 F. 178 (2d. Cir. 1914).

be a relevant factor for a court to consider. For instance, an author relying upon a youth's history of the Civil War, as narrated in conversational style by a flamboyant and moralistic character named Uncle Willie,[43] for its factual information would have greater reason to suspect that certain elements of the book were fictional than an author referring to a scholarly, college-oriented textbook on the Civil War.

The principal case dealing with this exception in the area of historical fact is *DeAcosta v. Brown*.[44] The plaintiff wrote a screenplay dealing with the life of Clara Barton, founder of the American Red Cross. To make the movie more viable commercially, she created a lover for Clara Barton, as well as other fictionalized events in her life. The defendant wrote a biography of Clara Barton in which "some seven persons created by the plaintiff appear in the same characters and the same scenes with unsubstantial variations, except that Arthur Holt has become Arthur Hold."[45] Obviously, the defendant had copied at least these elements from the plaintiff's play, but the defense claimed that this material was in the public domain since it dealt with the life of a public figure.[46] The court was unpersuaded by this argument and held that "original treatment of the life of a historic character, like such treatment of any material even in the public domain, is entitled to protection against appropriation by others."[47]

The implication of the *DeAcosta* decision is that a second historian or author faces some risk if he uses an earlier copyrighted work as the source for some or all of his factual information. Absent an express representation that all of the material contained therein is true, he may be liable if some of it proves to be fictional. Anticipating the next section, the "safe harbor" solution is for the second historian to engage

[43] *See* W. THAYRE, A YOUTH'S HISTORY OF THE CIVIL WAR, 4 vol. (1866).
[44] 146 F.2d 408 (2d. Cir. 1944).
[45] *Id.* at 409.
[46] *Id.* at 410.
[47] *Id.* (citations omitted).

in independent research, while remaining free to use the first historian's efforts as a reference, if it appears that his use of the earlier work is so extensive as to fall outside the fair use umbrella. The inability to verify copied material through independent research would warn an author that the material may be copyrightable because it was not factual and, therefore, not in the public domain.

One potential labeling problem that has not been litigated yet is whether an estoppel may be applied offensively against an infringer. This issue would arise in a situation where an author expressly represents his work to be fictional even though significant portions of it are factual. Norman Mailer's *The Executioner's Song* springs to mind. Will a second biographer who copies information relating to Gary Gilmore's life be estopped from asserting the uncopyrightability of the historically accurate material as a defense because of Mailer's categorization of the book as a work of fiction? It would appear that the rule should, theoretically, be capable of such reverse application. Where an author misrepresents fictional matter as factual, a subsequent plagiarist is deemed to be the more innocent party since he could reasonably have thought that the copied material was in the public domain. Where an author misrepresents factual matter as fictional, a subsequent plagiarist should be deemed the less innocent party since he could not reasonably have thought that the copied material was in the public domain.

The disquieting feature of this possibility of securing copyright protection for otherwise uncopyrightable material through the artifice of mislabeling the material is that it takes a rather distended and dishonest route. It must be remembered though that the first author has not secured any exclusive right to the factual matter simply by stating that it is fictional; he is simply endeavoring to prevent others from copying that matter from his immediate work product. And if the author is willing to sacrifice the credibility of his work in

an attempt to secure greater copyright protection, he should be permitted to obtain the perceived benefit from that trade-off. As for the second author, his voluntary choice is either to conduct independent research in obtaining the bulk of the factual matter or risk liability if the first author succeeds in proving copying.

THE PRODUCT OF ONE'S RESEARCH

The preceding exceptions for the literal expression, selection and arrangement, and fictional features of factual matter can be justified on the grounds that they represent original features of a historian's treatment of his subject. Yet there is indication that an additional exception may be available to protect the product of one's research. The issue that is addressed through this asserted exception is whether an author should be protected from the wholesale copying of facts that he obtained for his own use through extensive and expensive research. This suggestion runs counter to the originality-discoverability distinction that underpins the basic tenet that facts are uncopyrightable.[48] As might be expected, then, the exception has had difficulty in attracting widespread acceptance from the courts.[49]

The seminal case for the research exception is *Toksvig v. Bruce Publishing Company*.[50] The plaintiff had prepared a biography of Hans Christian Andersen. Her research stemmed primarily from Danish sources, including Andersen's original works and correspondence and her own conversations with intimates of his life. The defendant was unfamiliar with the Danish language and, consequently, had relied upon English sources, including the plaintiff's book, in preparing her novel

[48] *See* notes 7–8 and accompanying text *supra*.

[49] The court in Miller v. Universal City Studios, Inc. may have overstated the case somewhat in averring that "[t]he law is clear that research can be copyrightable." 460 F. Supp. 984, 987 (S.D. Fla. 1978), since several courts have expressed their disfavor, either by act or express disaffirmance, with this proposition. *See* notes 59–67 and accompanying text *infra*.

[50] 181 F.2d 664 (7th Cir. 1950).

on Andersen's life. The plaintiff contended that certain concepts and information had appeared for the first time in her book and that the defendant had necessarily copied from it since the original sources were in Danish.[51] As posed by the court:

> The question is not whether Hubbard could have obtained the same information by going to the same sources, but rather did she go to the same sources and do her own independent research? In other words, the test is whether the one charged with the infringement has made an independent production, or made a substantial and unfair use of the complainant's work.[52]

In addressing this issue, the court observed that defendant had received a substantial benefit from her reliance upon the plaintiff's research, enabling her to complete her book in less than one year as compared to the three years it had taken the plaintiff, and concluded that this use of the plaintiff's work constituted an infringement and not a fair use.[53]

The *Toksvig* decision falls squarely in line with the general theory of copyright law that a work need not be novel in conception for its author to be protected from undesired copying;[54] it needs only to be original in the sense that its inception was not attributable to copying in the first instance.[55] Accordingly, even in compilations of factual matter, such as

[51] In support of this claim, the trial court found incidents of copying in twenty-four specific passages appearing verbatim in both works. *Id.* at 666. As noted by Melville Nimmer, the holding in *Toksvig* could have been based upon these plagiarisms alone without the necessity of dwelling upon the plaintiff's research as an independent basis. 2 M. NIMMER, *supra* note 5, § 2.11[E] n.35.

[52] 181 F.2d at 667, *citing* Nutt v. National Institute, Inc., 31 F.2d 236, 237 (2d Cir. 1929).

[53] *Id.* at 667.

[54] The drafters of the 1976 ACT intentionally left the meaning of "original works of authorship" as established by the courts intact. As the comments to #102 indicate, "[t]his standard does not include requirements of novelty, ingenuity, or esthetic merit, and there is no intention to enlarge the standard of copyright protection to require them." COPYRIGHT LAW REVISION, H.R. REP. No. 1476, 94th Cong., 2d Sess. 51 (1976), *reprinted in* [1976] U.S. CODE CONG. & AD. NEWS 5659, 5664.

[55] A. LATMAN, THE COPYRIGHT LAW 1 (5th ed. 1979).

directories and maps, where there is little room for significant variations in content or form, the mere fact that competing works may be identical or nearly so is unimportant so long as they were each independently produced. The focus of copyright protection is upon the effort expended by an author in producing his work and not upon his exclusive claim to the product of that effort *per se*—unlike patent protection.[56]

The rationale behind copyright's concern with an author's effort stems from the first author's legally recognizable interest in the form of the "substantial investment of time, money and labor"[57] expended toward the preparation of his work, which investment is worthy of protection against commercial exploitation through "fast buck" imitations. In *Toksvig*, it was not the plaintiff's English translations of Andersen's writings that were being protected as much as her effort expended in preparing those translations.[58] In short, the defendant was perfectly free to make her own translations of his writings, either herself or by hiring someone competent to do it for her, since they were in the public domain, but she was not free to incorporate the plaintiff's translations into her work without securing permission or tendering compensation for such use.

While the *Toksvig* requirement of independent effort is consistent with the general purposes of copyright law, it should be noted that several courts have paid lip service to the *Toksvig* exception for historical works while endeavoring to evade

[56] *Id.* ("A patent is the greater monopoly; the patentee may exclude anyone from the field covered by the patent, however independently the latter may have developed the same invention").

Thus, if one person compiles a telephone directory for the city of Boston, he cannot scream "foul" if another individual does the same—unless it can be demonstrated that the competitor substantially relied upon the first person's copyrighted directory as the source for his data.

[57] Wainwright Securities, Inc. v. Wall Street Transcript Corp., 558 F.2d 91, 96 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978).

[58] This concept was nicely phrased in a recent case: "The court views the labor and expense of the research involved in the obtaining of these uncopyrightable facts to be intellectually distinct from these facts and more similar to the expression of the facts than to the facts themselves." Miller v. Universal City Studios, Inc., 460 F. Supp. 984, 987 (S.D. Fla. 1978).

its application. The *Eisenschiml* case, discussed earlier,[59] affords a prime example. That court noted that Otto Eisenschiml's research, leading to the publication of two scholarly treatises on Lincoln's death,[60] had taken more than eighteen years with an out-of-pocket cost of $20,000. The opinion does not indicate how long the defendant had spent in writing his magazine article, but it does acknowledge that the defendant must have used the plaintiff's research for at least some of his information since the plaintiff was able to prove at trial that the defendant had used certain information in his article that had never appeared in print prior to Eisenschiml's use of it and that the defendant had not gone to the original sources.[61] The court avoided a finding of infringement on the basis of *Toksvig's* test of independent research by finding that "a large portion of Millard's article resulted from his independent work."[62] The results in the two cases are hard to reconcile with one another because the issue in *Toksvig* was not properly whether the defendant had done any, or even a large portion of independent research on the general topic—*i.e.*, the life of Hans Christian Andersen—but whether she had made independent reference to the original Danish materials in the twenty-four instances in which she quoted from Andersen's writings. In choosing to go through the motions of applying *Toksvig*, the issue for the *Eisenschiml* court should have been whether Millard had gone to the police records used by the plaintiff in gathering his information, and not whether he had done independent research on the general topic—*i.e.*, the assassination of Lincoln.

The *Eisenschiml* court, moreover, is not alone in its restrictive interpretation of *Toksvig*. New York courts have pro-

[59] *See* notes 16–23 and accompanying text *supra*.

[60] 246 F.2d 598, 600.

[61] *See* note 19 *supra*. Thus, the court conceded that the defendant had made use of "material which resulted from plaintiff's research," and found it to be apparent that "a number of extracts from plaintiff's works were used in Millard's article." *Id.* at 602, 603.

[62] *Id.* at 603.

ceeded from an *Eisenschiml*-type analysis to express repudiation of the research exception. In a 1960 decision, *Huie v. National Broadcasting Corp.*,[63] the district court acknowledged that "(t)he second historian or second directory publisher cannot bodily appropriate the research of his predecessor," and "it would be an infringement of the copyright for another historian to publish a history rewritten from the first historian without *any* independent research."[64] The Second Circuit Court of Appeals cast a critical eye upon *Toksvig* six years later in its noted decision, *Rosemont Enterprises, Inc. v. Random House, Inc.*[65]

The *Rosemont* court reversed a lower court decision on the basis of its reliance upon *Toksvig* and its finding of an "apparent lack of independent research" as authority for refusing to accept a fair use defense.[66] The court was unwilling to "subscribe to the view that an author is absolutely precluded from saving time and effort by referring to and relying upon prior published material," since "(i)t is just such wasted effort that the proscription against the copyright of ideas and facts . . . are [*sic*] designed to prevent."[67] Using this quoted language as authority, the same court declared sweepingly in a decision handed down in March 1980: "Indeed, this circuit has clearly repudiated *Toksvig* and its progeny."[68] The court accordingly found it unnecessary to even consider whether the defendants had engaged in *any* independent research

[63] 184 F. Supp. 198 (S.D.N.Y. 1960).

[64] *Id.* at 200 (emphasis added).

[65] 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[66] *Id.* at 310.

[67] *Id.*, *citing* Oxford Book Co. v. College Entrance Book Co., 98 F.2d 688 (2d Cir. 1938), and, Gorman, *Copyright Protection for the Collection and Representation of Facts*, 76 HARV. L. REV. 1569, 1584 (1963) (criticizing the *Toksvig* decision).

[68] Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 979 (2d Cir. 1980). The court also noted that "[t]his circuit has permitted extensive reliance on prior works of history." *Id.* at 978 n.5. *See* notes 92–93 and accompanying text *infra*.

under the test formulated in *Huie*[69] and cited approvingly in *Rosemont*.[70] Whether the court inadvertently misstated New York's prior position or did so intentionally to avoid any litigable issues in supporting a motion for summary judgment for the defendants is uncertain.[71] Whatever the reason for the "repudiation," the decision marks a misplaced step for the Second Circuit; one that hopefully will stumble no further.

Few courts have had to consider the research exception since *Toksvig*.[72] Among those which have, the most notable decisions relating to historical fact, apart from the New York line of cases discussed above, have come from two district courts sitting in California and Florida respectively. In *Holdredge v. Knight Publishing Corporation*,[73] the defendant had used the plaintiff's books as the basis for his own biographical article on Mammy Pleasant, while skimming two other books by different authors on her life. After endorsing the research exception as accepted law generally,[74] the court addressed the additional issue of whether there is a distinction between relying upon secondary (*i.e.*, the two other books here) rather than primary sources in determining whether the second author has done sufficient independent research. Restated, may an author copy from multiple historians in piecemeal fashion even though he would not be permitted to copy from

[69] *See* note 63 and accompanying text *supra*.

[70] 366 F.2d 303, 310 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[71] The court lauded the Southern District Court of New York for "permitting courts to put 'a swift end to meritless litigation' and to avoid lengthy and costly trials," by granting summary judgment in a series of cases involving "alleged similarity related to *non*-copyrightable elements of the plaintiff's work." Hoehling v. Universal City Studios, Inc., 618 F.2d 972, 977 (2d Cir. 1980). The *Hoehling* court has, in effect, rendered aid to this disposition by declaring research a non-copyrightable element as a matter of law.

[72] *See* 2 M. NIMMER, *supra* note 5, § 2.11[F] n.36 for citations relating to non-historical forms of factual matter.

[73] 214 F. Supp. 921 (S.D. Cal. 1963).

[74] *Id.* at 922–23 ("The cases are clear on the proposition that when an alleged infringer has done his own independent research, and based his own work on that research, there can be no infringement. . . .").

just one in wholesale fashion?[75] Such a distinction would be unjustified. As Judge James Carter stated:

> It is apparent that, whether or not original sources for Merwin's work were available to him, he did not avail himself of them. Merwin testified that he had spent three whole days on his research and a fourth to write the article; this alone is sufficient to negate the possibility of any real independent effort, particularly when compared with the eight or nine years that plaintiff testified she had spent on her Mammy Pleasant Books.[76]

In *Miller v. Universal City Studios, Inc.*,[77] the plaintiff collaborated with Barbara Mackle, the victim of a diabolical kidnapping that included her being buried alive in a "coffin" for five days, to prepare a book describing her ordeal. The defendants became interested in making a television movie based upon the book but were unwilling to meet Miller's monetary demands for the purchasing rights. Instead, they simply directed a script writer to prepare a film version of the kidnapping. Since the book was the only source for Ms. Mackle's version of the events, the plaintiff was able to cite a number of similarities between the book and the script and film regarding information that was available only through the book. The plaintiff's attorney also enjoyed the rich pleasure of being able to produce at trial a memorandum from the script writer to his superiors in which he expressed his uneasiness in relying so heavily upon the book.[78] The jury found for the plaintiff and awarded damages of $200,000. The defendants moved for a retrial, claiming error in a jury instruction that stated that an author's research is copyright-

[75] One may hazard that the Second Circuit presently would permit such multiple use even were it to retreat from its total repudiation position enunciated in *Hoehling*, since the court admonished that "[t]his circuit has permitted extensive reliance on prior works of history." 618 F.2d 972, 978 (2d Cir. 1980).

[76] 214 F. Supp. 921, 923 (S.D. Cal. 1963).

[77] 460 F. Supp. 984 (S.D. Fla. 1978).

[78] *Id.* at 986 ("[A]ll I have to go on—and have been using while waiting [for newspaper accounts and a trial transcript to be sent]—is the book, and that is verboten. . . . I can only suggest that I wait until the source material arrives before proceeding, or go to Miami and Atlanta myself and do my own digging").

able. In denying the motion, the court expressed its view that the labor and expense of the research involved in obtaining factual matter are intellectually distinct from the facts themselves, which are uncopyrightable, and more similar to the expression of them, which is copyrightable.[79] As stated by the Miller Court:

> (I)t doesn't square with reason or common sense to believe that Gene Miller would have undertaken the research involved in the writing of *83 Hours Till Dawn* (or to cite another more famous example, that Truman Capote would have undertaken the research required to write *In Cold Blood*) if the author thought that upon completion of the book a movie producer or television network could simply come along and take the profits of the books and his research from him. In the age of television "docudrama" to hold other than research is copyrightable is to violate the spirit of the copyright law and to provide to those persons and corporations lacking in requisite diligence and ingenuity a license to steal.[80]

The point that seems to be missed by those courts and commentators who would emasculate the *Toksvig* test by reading in a requirement that no independent research be found before infringement will lie, is the prohibitive effect such a license to copy may have upon historians and their ilk. It is difficult to believe that the public interest in historical accounts and trivia is so great that the law should be willing to immunize copiers from liability in light of the risk of discouraging time-consuming research and of perpetuating fictional and erroneous elements of a prior work as purported fact. A desire to ensure that factual matter is presented in reasonably accurate form would seem to be of greater public utility than a competing desire to encourage the indiscriminate, wholesale merchandising of such matter.

As an example, suppose a historian reveals that Presidents Harrison and Taylor were, in fact, assassinated as part of a longstanding conspiracy, headed by Senator John C. Calhoun,

[79] *Id.* at 987.
[80] *Id.* at 988.

to perpetuate and extend slavery in the United States, and further reveals that he is relying upon heretofore concealed affidavits of attending physicians that state their belief that poison caused the Presidents' deaths.[81] Next, suppose a free-lance writer prepares a historical exposé using the information that he has gained from the earlier work and submits it to the publisher of a sensationalist rag entitled the *Local Enquirer*, which prints the story with bold headlines: CHIEF CALHOUN SPICES PRESIDENTIAL DIETS WITH CYANIDE. If there was no factual basis for the key element to this historical account—that Harrison and Taylor were murdered—the first author would be estopped from benefiting from his misrepresentation via copyright protection. If the affidavits did exist and supported the asserted contention, on the other hand, it is unjust to allow a person with greater commercial clout and media access to reap the financial benefit from the revelation discovered by the first historian's research. Nor is it reasonable to take the position that the *Local Enquirer* could avoid liability so long as the story exhibited *any* independent research—say, on the life of Calhoun—as the anti-*Toksvig* courts have done. The law should state that while "discovered" factual matter is in the public domain and uncopyrightable *per se* in the sense that anyone is free to go to the same public sources and report the same information as the initial discoverer,[82] the subsequent user is at risk if the discoverer can prove that the former copied the information from the latter's copyrighted work rather than from the public source.

A proper application of the *Toksvig* rule would be to find a prima facie case of infringement once the court is satisfied that a defendant has relied solely upon a plaintiff's research

[81] For such an account, *see* J. S. Dye, The Adder's Den, or, Secrets of the Great Conspiracy to Overthrow Liberty in America (1864).

[82] As Justice Holmes stated: "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 (1903).

for certain information. Where the relative extent to which he relied upon the complainant's research and the value of that reliance become germane is in deciding the further question of whether liability should be imposed for that reliance. The ease with which verification of factual matter referred to in an earlier work is possible would be a countervailing factor to be weighed in making this determination. Where Eisenschiml documented his sources and stated their location and the historian in the example did not indicate where the physician's affidavits were to be found, Eisenschiml would have a more compelling basis for contending that the infringement of his work product was unfair since he was not concealing his sources. Conversely, the *Local Enquirer* would have a better defense than the defendant in *Eisenschiml* if it could show that a diligent effort to verify the copied information would be futile.

The same bipartite consideration holds true for each of the exceptions from the rule that factual matter is uncopyrightable. If an author copies the literal expression, selection and arrangement, fictional features, or research of another author's copyrighted presentation of fact, the first element of the prima facie test for infringement is present. The court must then determine as the second element whether to excuse the copier from liability, depending upon whether the copying falls within the ambit of the fair use doctrine.

THE FAIR USE DOCTRINE

The fair use doctrine arose as a judicially spawned rule of reason designed to ameliorate the exclusivity of copyright protection.[83] Fair use is commonly defined as a "privilege in others than the owner of a copyright to use the copyrighted material in a reasonable manner without his consent, notwith-

[83] *See* Folsom v. Marsh, 9 F.Cas. 342, 348 (C.C.D.Mass. 1841) (No. 4901); Emerson v. Davies, 8 F.Cas. 615, 624 (C.C.D.Mass. 1845) (No. 4436).

standing the monopoly granted to the owner."[84] The doctrine imposes a burden upon the copyright holder to show more than one or two isolated instances of copying in any infringement action. Consequently, the appropriation of a substantial or material portion of another's copyrighted work must be demonstrated before infringement results.[85]

The 1976 Copyright Act provided the first statutory recognition of this doctrine through the adoption of Section 107.[86] The drafters expressly stated in their comments to this section that it was not their intention to change, narrow, or enlarge the purpose or general scope of the doctrine as it had evolved to that time.[87] Rather, the codification was designed merely to restate the existing judicial recognition of fair use.

The fundamental justification for the privilege owes its derivation to the constitutional language enabling copyright protection in the first instance: "To promote the Progress of Science and the Useful Arts."[88] Accepting that the copyright laws are aimed at the encouragement of the production of literary and artistic works generally, reward to the individual author or owner becomes a secondary consideration.[89] Thus, the copyright holder's personal interest in reaping a maximum financial return from his work will be subordinated to the public's general interest in developing the arts and sci-

[84] H. Ball, The Law of Copyright and Literary Property 260 (1944), *quoted in* Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303, 306 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[85] Greenbie v. Noble, 151 F. Supp. 45, 68 (S.D.N.Y. 1957), *citing* Marks v. Leo Feist, Inc., 290 F. 959 (2d Cir. 1923).

[86] This section reads in pertinent part: "Notwithstanding the provisions of section 106, the fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright." 1976 ACT, *supra* note 7, § 107.

[87] H.R. Rep. No. 1476, 94th Cong., 2nd Sess. 66 (1976), *reprinted in* [1976] U.S. Code Cong. & Ad. News 5659, 5680.

[88] U.S. Const. art. 1, § 8. *See* Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[89] United States v. Paramount Pictures, Inc., 334 U.S. 131, 158 (1947).

ences.[90] This development is achieved by fostering the free dissemination of information affecting areas of universal concern, such as history and biography.[91]

The practical effect of the doctrine in the context of historical matter is to limit the protection offered by the exceptions enumerated in Part I. A historian does enjoy in essence a limited license to copy from other historians.[92] Unfortunately, it is impossible to objectively fix the parameters of this limited license to copy.[93] The best one can do is to analyze the dominant factors that Congress and the courts have advanced

[90] Berlin v. E. C. Publications, Inc., 329 F.2d 541, 544 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964). *Accord* Sampson & Murdock Co. v. Seaver-Radford Co., 140 F. 539 (1st Cir. 1905); Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[91] In applying fair use, it has often been noted that the arts and sciences should be defined with the broadest possible latitude, particularly in view of the expansion of the social sciences in contemporary thought. Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967), *citing* Sampson & Murdock v. Seaver-Radford Co., 140 F. 539, 541 (1st Cir. 1905). *See* Wainwright Securities Inc. v. Wall Street Transcript Corp., 558 F.2d 91 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978); Meeropol v. Nizer, 560 F.2d 1061, 1068 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

[92] Chief Judge Kaufman, author of the *Hoehling* decision, would apparently disagree with this statement, preferring to think instead in terms of a virtually *unlimited* license to copy:

> A grant of copyright . . . provides a financial incentive to those who would add to the corpus of existing knowledge by creating original works. Nevertheless, the protection afforded the copyright holder has never extended to history, be it documented fact or explanatory hypothesis. . . . Accordingly, the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain. As the case before us illustrates, *absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful.*

618 F.2d 972, 974 (2d Cir. 1980) (emphasis added). *See supra* note 68 and *infra* note 134 and accompanying text for further discussion and criticism of their decision.

[93] "The exact scope and limits of the doctrine are not clearly defined, with each case resting on its own facts—a situation which has led some commentators to call the doctrine 'the most troublesome in the whole area of copyright.'" Meeropol v. Nizer, 417 F. Supp. 1201, 1206 (S.D.N.Y. 1976), *application denied in part, aff'd in part*, 560 F.2d 1061 (2d Cir. 1977), *cert. denied* 434 U.S. 1013 (1978), *citing* 1 M. NIMMER, *supra* note 5, at § 149.

toward determining whether particular instances of copying are fair uses.[94]

PURPOSE AND CHARACTER OF THE USE

Section 107(1) of the 1976 Act lists "the purpose and character of the use" as a factor for fair use.[95] This factor explicitly includes a consideration of whether the use is for commercial or nonprofit educational purposes.[96] While this enunciated factor is consistent with judicial opinion for other types of works,[97] it flatly contradicts what was the leading case on the fair use doctrine for historical works, *Rosemont Enterprises, Inc. v. Random House, Inc.*[98]

In reversing a district court decision that had emphasized the commercial aspects of a biography of Howard Hughes in finding its author liable for his plagiarisms from three copyrighted magazine articles on Hughes, the *Rosemont* court concluded: "(W)hether an author or publisher has a commercial motive or writes in a popular style is irrelevant to a determination of whether a particular use of copyrighted material in a work which offers some benefit to the public constitutes a fair use."[99] If the court was correct in averring that the district court had stated as a rule of law that "a biography that is designed for commercial success falls outside the protec-

[94] "[T]he courts have evolved a set of criteria which, though in no case definitive or determinative, provide some gauge for balancing the equities. These criteria have been stated in various ways, but essentially they can all be reduced to the four standards which have been adopted in section 107 . . ." COPYRIGHT LAW REVISION, H.R. REP. No. 1476, 94th Cong., 2d Sess. 65 (1976), *reprinted in* [1976] U.S. CODE CONG. & AD. NEWS 5659.

[95] *See* 1976 ACT, *supra* note 7.

[96] *Id.*

[97] *See, e.g.*, Loew's Inc. v. Columbia Broadcasting System, Inc., 131 F. Supp. 165, 182–83 (S.D.Cal. 1955), *aff'd sub nom.* Benny v. Loew's Inc., 239 F.2d 532 (9th Cir. 1956); Associated Music Publishers, Inc. v. Debs Memorial Radio Fund, Inc., 141 F.2d 852 (2d Cir.); *cert. denied*, 323 U.S. 766 (1944); Henry Holt & Co., v. Liggett & Meyers Tobacco Co., 23 F. Supp. 302 (E.D.Pa. 1938).

[98] 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[99] *Id.* at 307.

tion of the fair use doctrine,"[100] it would have been fully justified in reversing the opinion on the grounds that the trial court had misstated the law. An economic motive on the part of a copier should militate against the availability of the fair use privilege to him; it should not, however, preclude its availability á priori. The *Rosemont* court ventured to the other extreme in holding that economic motive is totally irrelevant.

The Court of Appeals for the Second Circuit was afforded an opportunity to reconsider its earlier decision after the 1976 revision of the Copyright Act. It did not reverse its holding in *Rosemont,* but it did defer to § 107(1) in acknowledging that "it is relevant whether or not the Rosenberg letters were used primarily for scholarly, historical reasons, or predominantly for commercial exploitation."[101]

The significance of this factor lies in its implicit recognition that authors who are writing for the sake of scholarship with little prospect of remunerative return for their efforts should be granted greater leeway in the amount of material they may copy from another's work than authors who are writing with a hand on their wallets. Thus, the *Eisenschiml* court, after finding numerous instances of copying, should have considered the fact that the defendant was a prolific freelance writer by profession who had prepared his work as the main article of an issue of a popular magazine in deciding whether he had made a fair use of Eisenschiml's books. If he had been penning the article for a periodical of a more serious bent, such as the *Journal of American History*, with a more sophisticated and selfless purpose in mind than monetary remuneration, the court would have had greater reason for its unwillingness to impose the burden of compensating the copyright owner or to enjoin the release of the work.

[100] *Id.*

[101] Meeropol v. Nizer, 560 F.2d 1069 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

THE NATURE OF THE COPYRIGHTED WORK

This second factor listed under §107(2) of the Act appears to focus on the public interest and on whether that interest should prevail over the possible damage to the copyright owner. The assumption is that some works have greater utility for later authors than others because of their nature. The expectation of the first author is also an important criterion, since the author of a form book may be presumed to have anticipated that others would copy his forms as a natural consequence of referring to his work in the first instance.

In this context, the nature of the work impacts upon fair use through an implied consent theory:

> (W)ith reference to works in regard to the arts and sciences, using those words in the broadest sense, . . . any publication is given out as a development in the way of progress, and, to a certain extent, by common consent, including the implied consent of the first publisher, others interested in advancing the same art or sciences may commence where the prior author stopped.[102]

If it is recalled that the fair use privilege is restricted to several set genres,[103] whether the *nature* of the work within its genre is relevant has not been addressed directly. It does appear certain, however, that the relative *merit* of the work within its genre is not germane to its protectibility.

The *Rosemont* court indicated that the biography of Howard Hughes in controversy was not a "profound" work, but once it was satisfied that the nature of the work (*i.e.*, a biography) was such as to come within the fair use doctrine generally, the

[102] Greenbie v. Noble, 151 F. Supp. 45, 67–68 (S.D.N.Y. 1957), *quoting* Sampson and Murdock Co. v. Seaver-Radford Co., 140 F. 539, 540 (1st Cir. 1905). As aptly phrased by Professor Chaffee: "The world goes ahead because each of us builds on the work of our predecessors. 'A dwarf standing on the shoulders of a giant can see farther than the giant himself.'" Chaffee, *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 503, 511 (1945).

[103] *See* note 85 and accompanying text *supra*.

court expressed unconcern about the profundity of the particular work.[104] As stated by another court:

> In order to be a "historical" work for the purposes of invoking the fair use doctrine, defendants' book thus need not evidence (even a minimum) scholarly effort or be in the form prescribed by academic historians, as plaintiffs' experts apparently believe. Rather all that need be shown is that there be some serious attempt to describe a historical event which could be of some benefit to the public at large.[105]

Presumably, the relative merit of the first author's work is equally unimportant. While it is hard to feel sympathetic toward the author of a sensationalistic and grossly inaccurate historical work, one can easily understand the reluctance on the part of the courts to penalize authors via copyright law for their lack of skill as historians. Thus, it does not appear that a first author of a sensationalistic account supposedly of her own ancestors' lives and ordeals as slaves would be afforded less protection against copying as a matter of law than would an author of a more scholarly and documented work on the same topic, or that a second author of a similarly "unworthy" work academically would be afforded more liberty in copying.[106]

Query whether the first author of a sensationalistic history should be entitled to greater protection than the first author of a scholarly history on the grounds that the implied consent theory is less apropos. Certainly, the author of *Jubilee*, for example, would have less reason to expect others to copy the historical information in her novel than would an author of a more scholarly text on slavery, nor is it reasonable to assume that she impliedly consented to the use of her work by "others

[104] Rosemont Enterprises, Inc. v. Random House, Inc., 366 F.2d 303, 307 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

[105] Meeropol v. Nizer, 417 F. Supp. at 1209 (S.D.N.Y. 1976), *application denied in part, aff'd in part*, 560 F.2d 1061 (2d cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

[106] *See generally* Alexander v. Haley, 460 F. Supp. 40 (S.D.N.Y. 1978) (dispute between the authors of *Jubilee* and *Roots* in which the court found that no protectible matter had been copied).

interested in advancing the same art or science."[107] If the implied consent rationale supporting the nature of the work factor is to avoid the graveyard reserved for legal fictions, perhaps the standing and character of a work within its genre should be a relevant consideration in determining whether to use this factor in a given instance. This suggestion would have the practical effect of affording greater protection to quasi-historical works[108] in recognition of their hybrid nature. The alternative of misrepresenting a work as entirely fictional might thereby be rendered less attractive.[109]

AMOUNT AND SUBSTANTIALITY OF PORTIONS USED

The third factor outlined in §107 of the Act is "the amount and substantiality of the portion used in relation to the copyrighted work as a whole."[110] The importance of this factor in any infringement action is obvious since it pertains not only to a determination of fair use but also to a determination of damages if fair use is denied. The courts, however, have made no effort to promulgate objective guidelines in terms of quantitative figures for when copying exceeds fair use, preferring, it would seem, to rely upon their "gut reactions" on a case-by-case basis. Thus, one court refused to credit an alleged standard rule within the publishing industry that use of more than 300 words of a copyrighted work does not qualify as a fair use.[111] The courts have preferred to focus upon *what* was copied and its relative importance rather than upon *how much* was copied.

[107] See note 101 and accompanying text *supra*.

[108] "[A]malgams of fact and fiction," to use Judge Frankel's phrase in Alexander v. Haley, 460 F. Supp. 40, 42 (S.D.N.Y. 1978).

[109] *See* textual discussion of Mailer's *The Executioner's Song*, Part I(c) *supra*. Note that if a so-called fact and fiction work is represented as entirely factual, which was not the case in the *Haley* case, the rule of estoppel would apply, and the nature of the work as represented would be a relevant fair use factor.

[110] 1976 ACT, *supra* note 7, § 107(3).

[111] Meeropol v. Nizer, 417 F. Supp. 1201, 1210 (S.D.N.Y. 1976), *application denied in part, aff'd in part*, 560 F.2d 1061 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978) ("Fair use is a legal question to be determined by the court not by alleged industry practice").

In *Toksvig*, infringement was based upon the copying of twenty-four passages. These passages constituted an insignificant percentage of both works in terms of their cumulative length, and yet the court felt that the passages were a material part of the plaintiff's work since they were original translations of Andersen's writings.[112] As stated by that court: "It is sufficient [for copyright infringement] if a material and substantial part shall have been copied, even though it be but a small part of the whole."[113] The wording of both this statement and of § 107(3) indicates that the amount and substantiality of the copied material is to be considered in relation to the work from which it was copied. Nevertheless, the tendency of those courts that have relied upon the amount and substantiality factor in their deliberations has been to adopt the opposite vantage point—*viz.*, the substantiality of the copied material to the work using it.

In *Meeropol v. Nizer*, the defendant reprinted excerpts from twenty-eight copyrighted letters, totaling 1957 words, or 2.4 percent of the plaintiff's work.[114] The excerpts composed less than one percent (in fact, 0.85%) of the defendant's book.[115] Nevertheless, the appeals court indicated that the district court would be justified in finding that this use was material and substantial owing to the emphasis placed upon the letters in promotional literature for the book.[116]

[112] Toksvig v. Bruce Publishing Co., 181 F.2d 664, 666 (7th Cir. 1950). The court also restated the accepted rule that an acknowledgment of one's sources will not excuse infringement. *Id.* Similarly, the *Eisenschiml* court refused to consider the defendants' ethics in not giving a credit reference to the plaintiff's works in its decision. 246 F.2d 598, 603 (7th Cir.), *cert. denied*, 355 U.S. 907 (1957).

[113] 181 F.2d 664, 667 (7th Cir. 1950) (citations omitted). The Second Circuit has taken a contrary position: "In works devoted to historical subjects, it is our view that a second author may make significant use of prior work, so long as he does not bodily appropriate the expression of another." Hoehling v. Universal City Studios Inc., 618 F.2d 972, 980 (2d Cir. 1980).

[114] 417 F. Supp. 1201, 1206 (S.D.N.Y. 1976), *application denied in part, rev'd in part*, 560 F.2d 1061, *cert. denied*, 434 U.S. 1013 (1977).

[115] *Id.*

[116] 560 F.2d 1061, 1071 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

In *Rosemont*, the copied material consisted of two direct quotations and an eight-line paraphrase taken from three articles totaling 13,500 words. The court doubted whether a fact-finder would consider such a small amount of copied material to be a material and substantial portion of these articles while pointing out that it formed an even less significant part of the defendant's 304-page book.[117] So too, in *Meredith v. Harper & Row, Inc.*,[118] the most damning evidence at trial was a finding that the defendants' plagiarism of the plaintiffs' work extended to 11 percent of the infringing text without any correlative indication of what percentage of the copied work was affected thereby.

The apparent willingness of the courts to use this factor from whichever point of view casts the more critical eye upon the use of the material in a given instance is a sounder approach than the one-sided view taken facially by the 1976 Act. Using the facts in *Eisenschiml* as an illustration, suppose the plaintiff was correct in his insistence that the defendant's article was a slavish imitation of his two books.[119] Could the court have used the fact that the defendant's 20,000-word article, for the sake of argument, taken in its entirety, constituted an insubstantial portion of the plaintiff's voluminous 900-plus page treatment of Lincoln's death as a factor toward finding that the fair use privilege attached? Such a result would

[117] 366 F.2d 303, 306 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967). As one commentator has correctly observed:

> The court did not decide whether the degree of copying was fair use, only that if it were not, both the determination of that issue and the remedy, if any, would have to be at law. The fair use issue would have been more clearly drawn if the court had simply found infringement, since the unacknowledged copying of exact parts of a copyrighted work was both clear and *unnecessary*, while denying the injunction and leaving the remedy (which was bound to be minimal) at law.

L. E. Seltzer, Exemptions and Fair Use in Copyright 42 (1978). *Accord*, Nimmer, *Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?* 17 UCLA L. Rev. 1180, 1203 (1970).

[118] 378 F. Supp. 686 (S.D.N.Y. 1974).

[119] Eisenschiml v. Fawcett Publications, Inc., 246 F.2d 598, 601 (7th Cir.), *cert. denied*, 355 U.S. 907 (1957).

clearly be illogical. A proper understanding of this factor is that the courts will look to the amount or nature of the copied material in terms of its substantiality in relation to the whole of *either* of the works in controversy. If the appropriated material forms a substantial part of either work, the use of that material is unfair and the user should be liable to the copyright owner for the infringement.

ECONOMIC EFFECT OF THE USE

The final factor mentioned in the 1976 Act is "the effect of the use upon the potential market for or value of the copyrighted work."[120] Restated, a court will consider whether the defendant's work tends to diminish or prejudice the potential sales of the plaintiff's work.[121] This consideration is generally regarded as the most significant of all the factors,[122] leading one court to call it "the one test which when applicable, would seem ordinarily decisive."[123] This factor may be regarded as a practical hedge against the rhetoric surrounding the fair use doctrine to the effect that the private interest of the individual copyright holder is subordinate to the public's general interest in promoting the useful arts and sciences.[124]

Note that the courts that have stressed this factor in cases involving commercially viable factual works have instinctively looked to the intent of the user as an aid in making their determination. For example, the court in *Wainwright Securities Inc. v. Wall Street Transcript Corporation* concluded that "appellants' use of the Wainwright reports was blatantly self-serving, with the obvious intent, if not the effect, of fulfilling the demand for the original work," and, "there is no other

[120] 1976 ACT, *supra* note 7, § 107(4).

[121] Meeropol v. Nizer, 560 F.2d 1061, 1070 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978). *See* Marvin Worth Productions v. Superior Film Corp., 319 F. Supp. 1269, 1274 (S.D.N.Y. 1970); 2 M. NIMMER, *supra* note 5, § 145.

[122] A. LATMAN, THE COPYRIGHT LAW 214 (5th ed. 1979).

[123] Hill v. Whalen, 220 F. 359, 360 (S.D.N.Y. 1914).

[124] *See* notes 88–89 and accompanying text *supra*.

way to describe it, chiseling for profit."[125] Similarly, the court in *Miller v. Universal City Studios, Inc.* expressed concern that in this age of television "docudrama," the ease with which "a movie producer or television network could simply come along and take the profits of the books and his research" from an author provides "those persons and corporations lacking in requisite diligence and ingenuity a license to steal."[126]

These two courts appear to have embraced a notion, sounding in equity, of unclean hands in denying the fair use privilege to the respective defendants in these recent cases. In doing so, the focus of the fourth factor is shifted away from the harm done to the marketability of the copied work by the use and toward the "shiftless" motive of the copier and the benefit accruing to him from the use. Insofar as the fair use doctrine originated as an equitable exception to the legal prohibition against copying, it does not seem unjust for the intent of the user to be a factor. Nonetheless, this concern is inconsistent facially with the accepted rule that intention, good or ill, is immaterial if infringement appears.[127]

The courts have not exhibited any general agreement in response to whether the commercial failure or dormancy of a copyrighted historical work should be regarded as a significant factor in support of a fair use defense. *Rosemont*, *Greenbie*, *Toksvig*, and *Nizer* each involved plaintiffs whose works were out-of-print and no longer commercially successful. Two of the courts noted this fact in support of their conclusions that the respective plaintiffs had failed to prove that the defendants' works had lessened the value of their copy-

[125] 558 F.2d 91, 96–97 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978).

[126] 460 F. Supp. 984, 988 (S.D. Fla. 1978).

[127] Toksvig v. Bruce Publishing Co., 181 F.2d 664, 666 (7th Cir. 1950), *citing* Buch v. Jewell-LaSalle Realty Co., 283 U.S. 191, 198 (1931); American Press Ass'n v. Daily Story Pub. Co., 120 F. 766, 769 (7th Cir. 1902); Chappell & Co. v. Costa, 45 F. Supp. 554, 555 (S.D.N.Y. 1942); and 34 Am. Jur. 447.

righted works or their ability to market them.[128] Another court held that the plaintiff was not precluded from recovering statutory damages even where she had suffered no loss, nor the defendant any benefit, from the use.[129] The remaining court took the optimistic, if not quixotic, position that the mere fact that the plaintiff's materials had been out-of-print for twenty years "does not necessarily mean that they have no future market which can be injured."[130]

Accepting the split of authority as to whether the copyright holder must show present or future economic harm before the fourth factor will be invoked against a profit-minded user, a distinction is warranted where the copier is using the material in a noncompetitive manner, notwithstanding that his work may be commercially oriented and his use of the material substantial. *Kane v. Pennsylvania Broadcasting Co.*[131] illustrates this point precisely. The defendant published a series of advertisements intended for radio broadcast that featured a different "first fact" in each advertisement as an attention-grabber. The facts were admittedly obtained from the plaintiff's books, entitled *Famous First Facts* and *More First Facts*, and undoubtedly comprised a material part of the advertisements. The court found that the parties' works were not in competition with one another, since "(c)onsidering the comparative objects of the respective publications, it appears that they have nothing whatever in common . . . and the material appropriated by it cannot injure the plaintiff either by prejudicing the sale, diminishing the profits or superseding the objects of the original work."[132] Whether a use may truly be thought to be noncompetitive with the original one in a

[128] Rosemont Enterprises, Inc. v. Random House, Inc. 366 F.2d 303, 311 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967); Greenbie v. Noble, 151 F. Supp. 45, 69 (S.D.N.Y. 1957).

[129] Toksvig v. Bruce Publishing Co., 181 F.2d 664, 667 (7th Cir. 1950).

[130] Meeropol v. Nizer, 560 F.2d 1061, 1070 (2d Cir. 1977), *cert. denied*, 434 U.S. 1013 (1978).

[131] 73 F. Supp. 307 (D. Pa. 1947).

[132] *Id.* at 307.

given instance is, naturally, a question of fact to be determined at trial.

CONCLUSION

Proceeding from the simple-sounding tenet: facts are uncopyrightable *per se*, this area of copyright law unexpectedly presents a dense and formidable jungle of exceptions and competing interests. The presence of exceptions to the tenet, of an exception to the exceptions in the form of fair use, and of ill-defined factors to be applied in determining what extent of use is fair necessarily requires the court in any infringement action to embark on a rather tortuous safari. The paths that have been blazed have proved neither easy nor safe to follow. Thus, the *Toksvig* requirement of independent research, while not a casualty, still bears the scars inflicted by those courts that would provide escape for an author who does *any* research. Yet the *Wainwright* and *Miller* decisions indicate that *Toksvig* may be lionized anew. So too, the *Rosemont* pronouncement that commercial motive is irrelevant appears to have been poached by the *Nizer* court, applying the factors enumerated under the 1976 Act.

Because the exceptions and the factors for fair use lack objective standards, the courts have had few restraints imposed upon them in deciding whether to side with the interest of the individual copyright owner in retaining control over his work product or the interest of the public in the free reporting of factual matter. How to choose between these competing interests is basically a function of judicial philosophy rather than of legal principle. To the extent that generalization is possible, the courts have traditionally evinced a restrictive attitude toward the copyrightability of historical matter—offering sanctuary to copiers under the guise of fair use. The judicial favor with which the fair use doctrine has been held is illustrated by *Eisenschiml* and *Rosemont*, two leading decisions handed down in 1957 and 1966 respectively. A shift in

philosophy appears to have taken place in recent years, for the 1970s produced several decisions—notably, *Meredith*, *Nizer*, *Wainwright* and *Miller*—that offer greater protection to authors of historical works than formerly existed. The lone case to have dealt with the copyrightability of historical fact in the 1980s to date, the *Hoehling* decision, marks a reactionary departure from the modern trend and a perversion of the traditional view.[133] No other court has ever held that summary judgment is warranted unless virtual identity and expression can be clearly demonstrated.[134] It is hoped that *Hoehling* will not stem the tide.

[133] *Hoehling* is rendered even more inexplicable by its failure to discuss *Wainwright* and *Nizer*, both of which come from the same circuit and should have been very much on point. *See* notes 114–16, 125 and accompanying text *supra*.

[134] Thus, in granting or reviewing a grant of summary judgment for defendants, courts should assure themselves that the works before them are not virtually identical. . . . In works devoted to historical subjects, it is our view that a second author may make significant use of prior work, so long as he does not bodily appropriate the expression of another.
618 F.2d 972, 980 (1980).

NATIONAL THIRD PRIZE, 1980

A Look at the Public Lending Right

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INTRODUCTION

"THE HISTORY of copyright law has been one of gradual expansion in the types of works accorded protection,"[1] and the same statement can be made about the nature and extent of that protection. The Public Lending Right [hereinafter PLR] is one of the more recent examples of expansion of protection in favor of the author that allows him to be compensated for the use of his work by libraries either in the form of the lending of his books or the use of his books in reading and reference rooms.

In ancient Rome neither the author nor the work could claim legal protection, and the ownership of all rights, whatever their nature, rested in the possessor (*dominus*) of the

This author is indebted to Professor David Ladd, now Register of Copyrights, in Washington, D.C., who, as professor at the University of Miami School of Law (Florida), stimulated the writer's interest in the copyright law, encouraged selection of the topic of the public lending right, and opened doors to helpful libraries and persons.

[1] H.R. REP. No. 1476, 94th Cong., 2d Sess. 51 (1976) (concerning a general revision of the copyright act), 17 U.S.C. § 101 *et seq.*, Pub. L. No. 94-553, 90 Stat. 2541 (1976) [hereafter cited as New Act].

physical object.[2] This state of affairs lasted through the Middle Ages until, during the Renaissance, the production and distribution of books increased tremendously owing to Johann von Gutenberg's invention of movable type about 1440. Princes and kings then began to create royal monopolies and privileges of printing and publishing that were meant to inhibit the spreading of religious ferment during the Reformation by means of strict censorship.[3] These privileges also protected the printer-publishers against reprints of their publications; the author, however, was left out and did not gain any protection for his work.

The city-state of Venice seems to have been the first to establish such a privilege system in 1469,[4] seven years before William Caxton established the first English printing press in Westminster.[5] To protect the Roman Catholic faith after Restoration, Queen Mary I of England charted the "Worshipful Company of Stationers" in 1556 so that publication of heretical books could be prevented;[6] infringers were subject to Star Chamber proceedings until 1641, when this institution was abolished by parliament.[7]

The first copyright act in the modern sense of the term was passed in England during the reign of Queen Anne in 1710;[8] it was innovative insofar as the author was the one primarily

[2] K. VISKY, GEISTIGE ARBEIT UND DIE "ARTES LIBERALS" IN DEN QUELLEN DES RÖMISCHEN RECHTS 116 (1977). It is interesting that the sophisticated Roman legal systems did not develop the concept of protection of ownership of intellectual property. Society recognized authorship as such. Seneca speaks of "*libros dicimus esse Ciceronis, eosdem Dorus librarius suos docet, et utrumque verum est* [We say that Cicero's books are his, while the bookseller Dorus informs us that they belong to him, and each statement is correct.]" *De beneficiis* 7.6.1. [transl. supplied]. Society also acknowledged the author's right to have his name on his work, but there was no legal protection for such "rights."

[3] 1 S. P. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 13 (1938) [hereafter cited as 1 LADAS].

[4] A. LATMAN, THE COPYRIGHT LAW 2 (5th ed. 1978).

[5] II THE NEW ENCYCLOPAEDIA BRITANNICA MICROPAEDIA 660 (1976).

[6] 1 LADAS, *supra* note 3, at 14.

[7] 2 W. CHURCHILL, A HISTORY OF THE ENGLISH-SPEAKING PEOPLES 222 (1960).

[8] 8 Anne, c. 19 (1710).

protected. On the continent, Denmark next provided protection for authors in the form of an ordinance in 1741,[9] followed by France, which passed, stimulated by the Revolution, no less than four different acts in the years 1791–93.[10] In the rest of Europe, the privilege-monopoly system prevailed longer. The Kingdom of Prussia, for instance, passed a copyright act only in 1837,[11] and a single law applicable to all Germany did not come about until 1870.[12] Almost ninety years earlier, the United States Constitution had recognized the need for such legislation,[13] and by 1870 Congress had passed six statutes dealing with copyright.[14]

The copyright laws of the various nations of the eighteenth and nineteenth century did not afford the authors a protection as broad as do most modern laws today, and the expansion of the types of rights protected proceeded at a measured pace. Early laws had focused primarily on literary output, and terms such as "writings" had to be stretched by judicial interpretation to accommodate other, and sometimes new, forms of expression.[15]

[9] Ordinance of January 7, 1741; *see* 1 LADAS, *supra* note 3, at 18.

[10] 1 LADAS, *supra* note 3, at 18; *see also* 1 Lyon et Delalain, *Lois françaises et étrangères sur la propriété littéraire et artistique* 11 *passim* (1889).

[11] Prussian Law for the protection of Property of Works of Science and Art of June 11, 1837; see O.-F. VON GAMM, URHEBERRECHTSGESETZ 40 (1968) [hereafter cited as VON GAMM].

[12] Urheberrechtsgesetz [UrhG] of June 11, 1870; *see* VON GAMM, *supra* note 11, at 43.

[13] "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art I, § 8, cl. 1, 8.

[14] The first statute was the Copyright Act of May 31, 1790, 1 Stat. 124 (1790), which was extended to cover prints in 1802, 2 Stat. 171 (1802), to musical compositions in 1831, 4 Stat. 436 (1831), to dramatic compositions and the right of public performance in them in 1856, 11 Stat. 138 (1856), and in 1865, to photographs, 13 Stat. 540 (1865). When the newly united German Empire passed its first act, the United States was working on its sixth statute, the revision of 1870, 16 Stat. 212, Rev. Stat. § 4948–71 (1870).

[15] In the United States, this interpretation dates back to expressions of intent of Congress in the early nineteenth century and was reiterated during that century. It was clearly spelled out in Burrows-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884), which held that a photograph of Oscar Wilde was an original

Neither were the periods of protection as long in the past as they are now, whether in the common-law tradition of the Statute of Anne that allowed for new works a protection of fourteen years and, if the author were still alive at the end of that period, provided for the privilege of renewal for another fourteen years, or the protection of life plus thirty years *post mortem auctoris*, which recently was still in effect in civil-law Switzerland.[16] Most modern jurisdictions now allow a term of protection of life plus fifty years *post mortem auctoris*, and the Federal Republic of Germany [hereafter West Germany] even one of seventy years.[17]

Originally many, if not all, of the copyright laws were understood to regulate property rights, a view shared by common-law and civil-law jurisdictions alike. But in civil-law countries the emerging ideas of the inherent and inalienable rights of authors, the French *droit moral* and its slightly dif-

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work of art and that the wording of U.S. CONST. art. I, § 8, cl. 8, includes all forms of writing, printing, engraving, etching, etc., by which the ideas of the mind of the author are given visible expression. Most recently, this view was reemphasized in Goldstein v. California, 412 U.S. 546 (1973), which held that the term "writings" is not limited to script or printed material but also includes any physical rendering of the fruits of creative intellectual or esthetic labor.

Similar views can be found in many civil-law jurisdictions even if based on slightly different philosophies; *see generally*, H. DEBOIS, LE DROIT D'AUTEUR EN FRANCE, §§ 1–2 (3rd ed. 1978) [hereafter cited as DEBOIS]; VON GAMM, *supra* note 11, at 170.

[16] The Swiss copyright act of Dec. 7, 1922 (1922 Bundesgesetzsammlung [B.S.] vol. 2, 817) was the last major Western European law to allow only a 30-year protection *post mortem auctoris* until the amendment of June 24, 1955 (1955 Amtliche Sammlung der Bundesgesetze und Verordnungen der schweizerischen Eidgenossenschaft [A.S.] 855) extended it to 50 years in order to bring it in line with those of other European nations. A major copyright reform act, under discussion for many years but not yet passed, would incorporate this amended term; *see* Nordemann, *Stillstand oder Fortschritt?* 81 ARCHIV FÜR URHEBER-, FILM-, UND THEATERRECHT [UFITA] 1 *et seq.* (1978) [hereafter cited as Nordemann, 81 UFITA]. It seems that the new draft proposal would rule out the granting of PLR privileges. *Id.* at 5.

[17] § 64(1) Gesetz über Urheberrecht und verwandte Schutzrechte (Urheberrechtsgesetz [UrhG] of Sept. 9, 1965 (1965 Bundesgesetzblatt [BGBl.] I, 1273), *as variously amended*. For English text, see COPYRIGHT LAWS AND TREATIES OF THE WORLD (UNESCO Supp. 1977) [hereafter cited as CLTW].

ferent German cousin *Urheberpersönlichkeitsrecht* (rights inherent in the person of the author), pushed aside property aspects to a certain degree.[18] These developments led to the view in some civil-law countries that copyright per se is inalienable and can be passed only *mortis causa* by testate or intestate succession;[19] the rights of exploitation of these copyrights are seen as separate rights, subordinate to the moral rights of the author, that can only be licensed.[20]

Many continental European scholars now speak of copyright as an absolute human right[21] and conclude that any use of the intellectual creation of an author must be compensated.[22] The logical final step is that the state must provide for a method by which the author may collect a fee of some sort even for the gratuitous use of his work in a library for

[18] Generally speaking, *droit moral* and *Urheberpersönlichkeitsrecht* declare that the author has an inherent right in his creation of which he cannot dispose except by transfer *mortis causa*. The difference between the two philosophies lies in the French law regarding *droit moral* as arising in the person of the author, preceding the actual publication of his work and thus being part of the general intellectual personality right of the author; see DEBOIS, *supra* note 15, § 381. The German view is that the *Urheberpersönlichkeitsrecht* is so intricately intertwined with the author's work that it arises only with the creation of a work capable of copyright protection, *i.e.*, in American terms, with fixation in tangible form. The German view specifically rejects the idea of a general personality right; *see* VON GAMM, *supra* note 11, at 293. The difference between the two doctrines expresses itself further in the fact that the moral rights expire in Germany when the work enters the public domain, whereas it is eternal (*perpétuel*) in France.

[19] Besides France and Germany, Italy and Belgium also consider copyright inalienable *inter vivos*. The Scandinavian countries, Austria, Switzerland, and the Netherlands represent the opposite view, allowing total transfer *inter vivos*—the Scandinavian countries forbid such a transfer of PLR rights that were enacted outside the copyright statutes.

[20] *See* DEBOIS, *supra* note 15, § 210, for the French rule; *see also* F. K. FROMM & W. NORDEMANN, URHEBERRECHT 197 (4th ed. 1979) [hereafter cited as FROMM & NORDEMANN].

[21] *E.g.*, Kreile, *Rechtsvergleichende Darstellung Über die Bibliogheksabgabe*, 3 INTERNATIONALE GESELLSCHAFT FUR URHEBERRECHT [INTERGU], Jahrbuch 1975, 51 (1975) [hereafter cited as Kreile]; *but cf.* Cohen Jehoram, *Uiteindelijk no toch een leen- of leesrecht?* 1970 NEDERLANDS JURISTENBLAD [N.J.B] 253, 257 [hereafter cited as Cohen Jehoram I], who argues against "the absolute auteursrecht."

[22] A. P. Herbert, *Freedom or Free-For-All?* 3 HOBART PAPERS 243 (2d rev. ed. 1965) [hereafter cited as Herbert].

which he had previously received the royalty payable for the sale of one copy of his book. This is what PLR is supposed to accomplish.

PLR has become popular not only in Europe but also in Australia and New Zealand and is being discussed in North America as well. It goes under a variety of names none of which gives a reliable clue to its true nature: *droit de prêt* in French, Büchereigroschen "library dime" or *Bibliothekstantieme* "library royalty" in German, or *Författarpenning* "author's coin" in Swedish, to name just a few appellations.

Is PLR a new, positive right created by legislative fiat, a grant bestowed upon impecunious authors by a benevolent government, or an inherent right due all authors that, for some reason or other, had not until now been properly recognized by the lawmaker? Is it part of the copyright law, of Public Library legislation, or a social security arrangement? Depending upon the country involved, it may be any or all of these, plus a dash of *angst* thrown in for the survival of the national culture, particularly in smaller countries.

PLR is based upon the idea that every time a book (and, in certain countries, a record, tape, filmstrip, slide, videotape, or even painting) is lent out by a library or similar institution housing lendable material, a royalty or fee of some kind should be payable to the actual creator of the work—the author. Some jurisdictions include in this definition the use of reference books in the library, or the reading of library books in the reading room. Not only the author may benefit; in some countries, the publisher is either allowed to collect a percentage of the author's fee or to accept a grant of the author's right to compensation under PLR by means of contract; in other countries, such publishers' rights are expressly or impliedly excluded.

All existing or proposed PLR laws, with the notable exception of Great Britain and West Germany, allow benefits only to native authors and perhaps also to resident aliens; foreign

authors are totally excluded. Some countries also make provisions for those who translate foreign works into the national tongue; Sweden also includes book illustrators.

All PLR regulations have in common that no fees can be collected by authors directly and that claims can be made only through collecting societies that deal directly with the governments involved, not with individual libraries. All such laws are funded not from fees paid by individual borrowers of books but by appropriation in the respective governmental budgets, and the amounts due authors are estimated in a variety of ways.

PLR has an almost forty-year history. The first country to take up the idea was Denmark, where an agreement made in 1943 between professional groups representing bookstores and the *Dansk Forfatterforening* (Danish Authors' Society) called for the payment of a royalty for the rental of books by "reading clubs" operated by the bookstores.[23] This led to the creation of the *Dansk Forfatterfond* (Danish Fund for Writers), which, after receiving royal endorsement, became the official collecting society to receive all payments and to disburse them to entitled authors. Public libraries were included in this system by passage of the Danish Public Libraries Law of March 30, 1946.[24]

Norway was next with a PLR law in 1947[25] and thus established a trend that Sweden followed in 1956.[26] None of these

[23] Lund, *The Lending of Phonograph Records and Books*, 9 BULL. COPYRIGHT SOC'Y 367, 374 (1962) [hereafter cited as Lund].

[24] *Id.*

[25] Law No. 12 on Public and Educational Collections of Dec. 12, 1947, c. III, § 12 (1947 Norsk lovtidende I, 1002) (cited as Law No. 12 on Public and School Libraries in CLTW *supra* note 17).

[26] The Swedish parliament passed a resolution that PLR should be instituted, and *Sveriges Föfattarfond* (The Swedish Authors' Fund) was created by Royal Decree No. 464 of June 17, 1955 (1955 Svensk författningsamling [SFS] 1533), *amended by* Royal Decree No. 597 of Nov. 8, 1957 (1957 SFS 975), Royal Decree No. 296 of June 2, 1961 (1961 SFS 707), and Royal Decree No. 652 of Nov. 13, 1962 (1962 SFS 1437). Since none of these are available in CLTW, *see generally* MÖHRING, SCHULZE, ULMER & ZWEIGERT, QUELLEN DES URHEBERRECHTS (1961).

Scandinavian laws were passed as part of the copyright acts of the respective nations.

In other countries, lively debates about PLR ensued in the 1950s and 1960s, especially in Great Britain and West Germany, but little action resulted. Only West Germany made a stab at resolving the question when in 1965 it completely revised its copyright act.[27] This *Urheberrechtsreform* bill included a library royalty for renting books by commercial lending libraries.[28] Yet this povision was of little practical value because such establishments, which rent books for a charge, were already on the decline and thus were of little economic consequence. The absence of a workable enforcement mechanism in the act was an additional reason why the provision was meaningless from the beginning. No royalties were ever collected under its authority.[29]

Most of the legislative action happened in those countries that followed the Scandinavian lead in the 1960s and 1970s by adopting PLR: Finland in 1964,[30] Iceland in 1968,[31] New Zealand in 1973,[32] West Germany in 1973,[33] Australia in 1974,[34] and Great Britain in 1979.[35]

In North America, the PLR subject found vigorous attention only in Canada where it has been discussed since the late

[27] UrhG (1965).

[28] § 27 UrhG (1965).

[29] Meyer, *Zur Bibliothekstantieme*, 1975 Mitteilungen der Arbeitsgemeinschaft für juristisches Bibliotheks- und Dokumentationswesen, 67.

[30] Public Library Act of 1961; *see* Lund, *supra* note 23, at 377.

[31] The Icelandic Author's Fund was established in 1968; *see* Kreile, *supra* note 21, at 59.

[32] Established by cabinet decision in 1973.

[33] Amendment of § 27 UrhG of Nov. 10, 1972 (1972 BGBI. I, 2081); for English text, *see* CLTW, *supra* note 17, *but note* mistranslation copied from 1973 Copyright 88: the first word in the parenthesis listing institutions accessible to the public, "bookstore," should be "library." This error in translating Bücherei misled Canadian researchers to assume that "the authors share in the cash turnover from bookstores," which they do not; *see* Jackson & Brégaint, Public Lending Right 37 (1975) (unpublished survey by the Arts and Culture Branch, [Canadian] Secretary of State Department) [hereafter cited as Jackson & Brégaint].

[34] AUSTRALIA COUNCIL, PUBLIC LENDING RIGHT 2–3 (1977) [hereafter cited as AUSTRALIA COUNCIL].

[35] Eliz. 2, c. 10 (1979).

1960s, even though no legislation has resulted from those discussions.[36] Many individuals, organizations, and governmental agencies have investigated the question, among them particularly the Arts and Culture Branch of the Secretary of State Department.[37]

In the United States, PLR has raised little interest except in the Authors Guild, which is presently investigating how PLR functions elsewhere,[38] and which is said to have inspired Rep. Ogden Reid of New York to introduce in the House of Representatives on February 27, 1973, a bill to establish "a commission to study and make recommendations on methods for compensating authors for the use of their books by libraries."[39] This bill died in committee and was never reintroduced.[40] Whereas some trade magazines had an occasional short article on the subject,[41] American journalists were so unfamiliar with PLR that, *e.g.*, Herbert Mitgang in 1976 called it "a comparatively novel notion" in the *New York Times* although it was already thirty-three years old.[42] While elsewhere in the world authors' societies and professional organizations of libraries and publishers debated, sometimes hotly, the pros and cons of PLR, no American authors' society except the Authors Guild paid much attention to it,[43] nor did

[36] The first article in Canada on the subject seems to have been by Brongers, *The Author's Lending Right*, 30 B.C.L.Q. 4 (Jan. 1967); nevertheless, most of the discussions there occurred during the 1970s.

[37] Jackson & Brégaint, *supra* note 33.

[38] Letter from Peter Heggie, Exec. Secy., The Authors Guild, Inc. New York, N.Y. (March 10, 1980).

[39] H.R. 4850, 93rd Cong., 1st Sess., 119 CONG. REC. 1067 (daily ed., Feb. 27, 1973).

[40] Letter from Waldo H. Moore, Assistant Register of Copyrights, Washington, D.C. (Feb. 22, 1980).

[41] *E.g.*, Wagner, *Bill Would Pay Authors Library Royalties*, 203 PUBLISHERS WEEKLY 48 (March 26, 1973), or Notice, *Author League Pushes Bill Creating Lending Royalties*, 98 LIB. J. 1422 (May 1973).

[42] Mitgang, *Britain Weighs Library Royalty*, 126 N.Y. Times, Oct. 14, 1976, p. 34, col. 3 (city ed.).

[43] Eliciting statements from authors' organizations was not very rewarding: "The ASJA has not adopted a position with respect to [PLR] is not familiar with me [*sic*]," Letter from John Newlander, Pres., Teacher-Author League of America, Tarrytown, N.Y. (March 3, 1980).

other organizations that could have been more than tangentially interested.[44]

THE RATIONALE BEHIND PLR

AUTHORS NEED HELP

The main argument advanced in favor of PLR in all jurisdictions is that authors need help because they cannot make a living in their chosen profession. In Great Britain, most people who write books earn less than half the national average wage;[45] only one author in six earns more than £1000 annually from his books, one author in ten makes between £500 and £1000, and the remainder earn much less.[46] In West Germany, author Heinrich Böll (later to become a Nobel Prize winner) called attention to the plight of this "underprivileged group" in a speech delivered on the occasion of the founding of the *Verband Deutscher Schriftsteller* (Association of German Writers),[47] and the German government, in a draft of a PLR amendment to the West German Copyright Act, spoke of giving the author "an adequate share of the economic fruits obtained from his work whenever possible."[48]

[44] Some professional organizations were either unaware of, or uninterested in, PLR: "To the best of my knowledge [PLR] has not been brought up by our organization," Letter from Margret M. Milles, Exec. Dir., Am. Acad. & Inst. of Arts & Letters, New York, N.Y. (Jan. 30, 1980). "The American Academy of Arts and Sciences has not engaged in discussions of the topic," Letter from Jane L. Deegan, Am. Acad. of Arts & Sciences, New York, N.Y. (Jan. 28, 1980). "I believe your question is about the 'fair use' policy in copyright legislation," Letter from Stanley J. McFarland, Dir. of Govt. Rel., Nat'l Educ. Assoc., Washington, D.C. (Feb. 14, 1980). All told, 17 letters of this nature were received.

[45] R. FINDLATER, A MATTER OF JUSTICE 11 (1971).

[46] Ellis, *Public Lending Right*, 1970 Interauteurs 44, 46 [hereafter cited as Ellis]; for a more specific breakdown, *see* Herbert, *supra* note 22, at 239.

[47] Dietz, *The Social Endeavors of Writers and Artists and the Copyright Law*, 3 INTERNATIONAL REVIEW OF INDUSTRIAL PROPERTY AND COPYRIGHT LAW [IIC] 451, 451 (1972) [hereafter cited as Dietz, 3 IIC].

[48] Bundestagsdrucksache IV/250, 54 (1962); *see also* Khadjavi-Gontard, *Büchereitantieme und Schriftstellerfonds auch für ausländische Autoren?* in *Gewerblicher Rechtsschutz-Urheberrecht-Wirtschaftsrecht: Mitarbeiterfestschrift zum* 70. GEBURTSTAG VON EUGEN ULMER 90 n.7 (1973) [hereafter cited as Khadjavi-Gontard].

The Australia Council, the statutory authority providing government support for the arts in Australia, showed in 1966 that the average author's income was well below the Australian minimum wage.[49] In Denmark, only 11% of all authors are able to live off royalties earned through their literary endeavors,[50] and for 60% of all Danish writers, revenues from their writing activity accounted for only 20% of their gross income.[51] In Canada, where PLR is still in the discussion stage, Stuart-Stubbs claims that "all but a few of the best-selling authors live a marginal existence."[52]

This recitation could be expanded to any country in which the economic status of the author is discussed. The discussions also show that the full-time, self-employed author as the propagator and disseminator of national culture is seen as socially desirable[53] and that he should be supported if he is not as fortunate as his best-selling colleague.

This view differs from past practice and understanding of the role of the author in society. Whereas the popular cliché of the poet starving in his garret no doubt had real-life counterparts in the past, it is a fact that a by far larger percentage of the masters of world literature and scholarship used to be engaged in other occupations that provided their main income yet enabled them to accomplish a sometimes monumental amount of literary work. As examples, quite randomly selected, may serve such men as Johann Wolfgang von Goethe (diplomat); Walt Whitman (journalist); Thomas Arnold (school master); Robert Frost (farmer and college teacher); Immanuel Kant (university professor); and a host of physicians, lawyers, and clergymen. Only a small number

[49] AUSTRALIA COUNCIL, *supra* note 34, at 2.

[50] E. Jørgensen, *Author in Denmark* 9 (1979) unpublished report of the Dansk Författerforening for the III. Congress of the European Organizations of Authors, Vienna (1979) [hereafter cited as Jørgensen].

[51] *Id.*

[52] Jackson & Brégaint, *supra* note 33, at 12.

[53] Sveriges Författarfond, *Public Lending Rights in Sweden* 1 (1979) (unpublished report by the Swedish Authors' Fund) [hereafter cited as *PLR in Sweden*].

of writers tried to make a living with their art—but hardly anyone expected them to be able to do so.

The realities of modern economic life make the wish to live entirely as a free-lance author just as difficult to fulfill as in the past, and so the government is now called upon to assist him. Nobody appears to discuss seriously the infrequently heard argument that a struggling writer should not be subsidized from public funds so that he can continue to live as a *literatus*—but it is raised occasionally, even if elliptically.[54]

THE AUTHOR AS A CULTURAL ASSET OF HIS NATION

An unspoken agreement seems to avoid categorization of "author" as just another job classification of uncertain financial value as, say, "trapeze artist." The author is generally perceived as a national resource, as a pillar of national culture, and thus worthy of support. "The Norwegian culture is assaulted rather massively from abroad . . . [i]n order to preserve national traditions, the government has adopted strategies to stimulate art and literature."[55] Australia sees PLR as an "important component in the never-ending struggle to maintain a medium-sized country's cultural identity."[56] In Canada, the Writer's Union feels that PLR "would also be a very real contribution to national cultural policy through the agency of the public library,"[57] and the Ontario Royal Commission on Book Publishing believes that PLR would "make a most important contribution toward the development of Canadian writing, publishing, and manufacturing, with concomitant effects on Canadian identity and unity."[58] Similar attitudes can be found in many of the countries surveyed,

[54] Jackson & Brégaint, *supra* note 33, at 12.

[55] Den Norske Författerforening, *Authors in Norway* 1 (1979) (unpublished report by the Norwegian Authors' Society) [hereafter cited as *Authors in Norway*].

[56] AUSTRALIA COUNCIL, *supra* note 34, at 2.

[57] Ellsworth, *Libraries and Lending Rights*, 31 CAN. LIB. J. 502, 508 (Nov.-Dec. 1974).

[58] Jackson & Brégaint, *supra* note 33, at 12.

but they seem to be stronger in smaller countries; large countries are apparently less worried about the survival of their cultures.

THE SOCIAL PROTECTION ASPECT OF PLR

It comes therefore as no surprise that almost all jurisdictions speak of the "social intentions" of their respective PLR laws and that aspects of social security and old-age insurance become the main *raison d'être* even where, as in West Germany, the measure became part of the copyright act.[59] In West Germany, where labor laws generally provide for very liberal job security, PLR was also considered a "substitute for job protection" [60] for the self-employed author. Ulmer declares that "decisive are the social aspects. Copyright law serves the economic protection of the creators of intellectual work." [61] Kreile states that the law should

> [A]llow the author to participate also in such uses of his work which do not serve commercial ends. . . . Copyright motives would hardly have spurred the lawmakers into their legislative activities on behalf of a library impost.[62] A socio-political motivation was added, and in some countries became of prime importance. The library impost proved to be a suitable instrument for the creation of an old-age insurance system for authors. . . . It is no exaggeration to say that the library impost was introduced by [various] States either as a copyright law in the cloak of social legislation—as predominantly in Scandinavia—or as social legislation in the cloak and shape of a copyright act.[63]

[59] § 27(1) UrhG (1972); *see also* note 33 *supra*.

[60] FOHRBECK, WIESAND & WOLTERECK, ARBEITNEHMER ODER UNTERNEHMER? 354 (1976) [hereafter cited as FOHRBECK I] [transl. supplied].

[61] E. ULMER, URHEBER- UND VERLAGSRECHT XI (5th rev. & enl. ed. 1974) [hereafter cited as ULMER] [transl. supplied].

[62] Note the terminology "library impost" "*Biblio*-theksabgabe." In 1975, the German PLR law had been in effect for almost three years, and the term generally used was *Bibliothekstantieme* "library royalty." *Büchereigroschen* "library dime" began to fall from use, probably because the actual rate of payment per loan was not a *Groschen* (DM.10), but a little more than 5.5 *Pfennige*. Does Kreile, even if subconsciously, make a tax analogy?

[63] Kreile, *supra* note 21, at 50 [transl. supplied].

Dietz comments that "[t]here is no doubt, however, that without the idea of the social fund for writers which lay behind the reform drive, the copyright amendment [in West Germany] would not have been enacted in this form."[64] Dieter Lattmann of the *Verband Deutscher Schriftsteller* stated in 1971 that the point of PLR was "to improve thoroughly the economic status of artistic authors."[65]

The general social legislation of a given country will influence greatly how PLR is viewed. While Lund describes the Norwegian library act[66] as a "maintenance fund for Norwegian writers,"[67] there is less need for such social security in Denmark. Every Dane, including free-lance authors, is guaranteed at age 67 an annual retirement pension that in 1980 paid Dkr. 31,000 for single persons, and Dkr. 28,000 for each married person.[68] Thus there was no need for old-age insurance funded through PLR.

In West Germany, however, a free-lancer was not eligible for social security and similar insurance systems unless he were employed. While the German system categorizes free-lance authors into a number of slots, such as "employed," "semi-employed," "free-lancer with employment-type features," or "free-lancer with entrepreneurial functions" (distinctions of importance also under the German tax law),[69] it suffices to state that in 1971, when the average gross income of a free-lancer was DM 18,000, and one-third of them earned less than DM 12,000, barely more than one-quarter of them had any statutory social security insurance, approximately one-third had private old-age insurance, and one-fifth of those over age 60 had no insurance whatsoever, not even a modest

[64] Dietz, *The Public Lending Right in the Federal Republic of Germany*, 7 IIC 220, 223 (1976) [hereafter cited as Dietz, 7 IIC].

[65] Horst, *Zum Nutzen der Autoren*, 99 BERTELSMANN BRIEFE 53, 53 (1979) [transl. supplied].

[66] *See* note 25, *supra*.

[67] Lund, *supra* note 23, at 376.

[68] Jørgensen, *supra* note 50, at 10.

[69] FOHRBECK I, *supra* note 60, at 104.

amount of medical insurance.[70] It stands to reason that not only the legislature but also the professional organizations wanted to do something about this situation.

But since the West German PLR covers all writers of any kind, it is no wonder that some voice brought up the fact that the nation's sizable number of scholarly authors did not need PLR. These authors are generally employed and thus covered as far as social benefits are concerned. Yet some consider them still the stepchildren of the German system because they have to write their manuscripts on their own time at night, without extra compensation, and cannot hope for large popular sales, because of the specialized nature of their publications; they would, therefore, have not much to hope from PLR fees either. Hubmann voiced the fear that PLR might reduce library acquisitions budgets and thus reduce the only source of royalties for scholarly authors, for libraries were usually most or all of the market for this type of book.[71] Voiced before PLR was put into effect in West Germany, it turned out to be unfounded, which is fortunate for the scholarly authors.[72]

But the same subject can also be viewed from a different angle:

> PLR favors especially academic as well as civil-service or [elsewhere] employed authors of non-fiction and textbooks whose main occupation is not the writing of books. They may consider additional income through PLR lagniappe, but do not depend on such income by virtue of their economic or social position. Few in their group are faced by problems of old-age security.[73]

It seems that Fohrbeck's comment raises the socialist view, whereas Hubmann defends the capitalist one. It seems rea-

[70] *Id.* at 136.

[71] Hubmann, *Die geplante Büchereitantieme und die Interessen der wissenschaftlichen Autoren*, 62 UFITA 1, 2 (1971).

[72] Nordemann, *Public Lending Rights in Federal Germany*, 90 DROIT D'AUTEUR [DdA], 61, 69 [hereafter cited as Nordemann, 90 DdA].

[73] K. FOHRBECK & A. J. WIESAND, BIBLIOTHEKEN UND BIBLIOTHEKSTANTIEME 76 (1974) [hereafter cited as FOHRBECK II].

sonable that a person should be entitled to a monetary reward for the work he does, wherever he does it, or whenever. Fohrbeck leaves out of consideration this very point and concerns herself only with whether the author starves or not.

The only jurisdiction in which sociopolitical questions were disavowed, beyond the uncontroverted fact that authors make too little money, is Great Britain, where the unsupported assertion was made that that country treated its authors worse than any other country.[74] Even though British authors do not make as much money as they need to live without outside employment, social security and insurance arguments were rejected out of hand. A typical comment refused to allow that PLR had anything "to do with patronage or charity towards authors, involving some kind of subsidy, inducement or subvention for the promising, meritorious, or poverty-stricken author, young or old. It is simply a right due to all copyright owners for the use of their works in libraries."[75] Therefore, none of the PLR income "should be diverted towards the provision of such things as pensions and grants."[76]

Sir Alan Herbert made clear that authors did not ask for subsidies on charitable grounds for indigent authors and pointed out by way of analogy that no "means test" is employed when paying performance rights fees to composers and others.[77] He extended the analogy by citing his own experiences as a composer of musicals, maintaining that the analogy "acknowledges in principle that every time a work is exploited it should pay something."[78] There would be no social fund in Great Britain.

The performance rights analogy found its supporters in

[74] Abel, *Die Entwicklung in Grossbritannien auf den Gebieten des Urheberrechts und der benachbarten Rechte im Jahre 1969*, 60 UFITA 101, 123 (1971).

[75] Bonham-Carter, *Public Lending Right—Its Situation in Great Britain*, 1969 PERFORMING RIGHT 98, 98.

[76] *Id.*

[77] Herbert, *supra* note 22, at 238.

[78] *Id.* at 234.

Canada,[79] but it was handled in a more down-to-earth fashion in Germany where it was seen as a power question. Dietz shows that the idea of collective representation isn't new in copyright law and that composers had it better only because they had had, for a long time, the powerful collecting society GEMA (*Gesellschaft für musikalische Aufführungs- und mechanische Vervielfältigungsrechte*)[80] to represent their interests, whereas authors until recently had lacked that kind of clout.[81]

In Austria, the analogy was rejected on philosophical grounds by at least one writer: "The receptive cognition of a work by a reader, listener, or viewer is, as a purely intellectual process, outside of the realm of legal regulation. That in itself is reason enough why copyright cannot attach to [private] enjoyment of the work."[82] This seems to be the prevailing view in that country, for the attempted introduction of PLR was rejected by its parliament.[83]

DO LIBRARIES HURT BOOK SALES?

The income of the average author depends on the sale of copies of his books and the royalties he will in turn receive from his publisher. No doubt there are other sources of revenue from subsidiary rights such as from serialization, movies, TV, translation, and other rights, but for most authors the amounts actually received from such sources are insignificant.

A debate usually arises over the question whether sales of books to libraries are beneficial or detrimental to the income position of the author. Some maintain that many books would not be published, *e.g.*, poetry, were it not for assured library

[79] Jackson & Brégaint, *supra* note 33, at 5.

[80] This is the German equivalent of the American Society of Composers, Authors and Publishers (ASCAP).

[81] Dietz, 3 IIC, *supra* note 47, at 453–54.

[82] Dittrich, *Die Weiterentwicklung des Urheberrechtsgesetzes in Österreich*, 3 INTERGU 163, 171–72 (1975) [transl. supplied].

[83] Letter from Dr. Gerhard Prosser, Secy. Gen., Hauptverband des österreichischen Buchhandels, Vienna, Austria (Feb. 12, 1980).

orders.[84] The Canadian magazine *Saturday Night* quotes a British publisher as claiming that libraries buy 85% to 90% of the copies of books he publishes.[85] This seems unusually high, for library acquisitions in other countries amount to 3% to 5% of the annual output of the book publishing industry.[86]

Others claim that lending activity of libraries, which in many countries increased tremendously after World War II, has indeed reduced the sale of copies to the general public, as in Great Britain,[87] Germany,[88] Belgium,[89] the Netherlands,[90] or Canada.[91] Whether these statements are correct, or whether "publishers look upon libraries as an assured market which can mean the difference between publishing or not publishing a work,"[92] is probably of greater significance for smaller countries, especially those whose national languages are spoken by a more limited number of people than those who speak English, French, or German, because their market is so small.

The evidence furnished by PLR proponents to prove the impact of library activities on authors is not immediately verifiable, but since there seems to have been very little argument

[84] CANADIAN LIBRARY ASSOCIATION, POSITION STATEMENT: FINANCIAL REWARDS TO WRITERS (approved by the Annual General Meeting, June 15, 1976) § 2.

[85] Woodcock & Stubbs, *When You Read a Library Book, Should the Author Be Paid?* SATURDAY NIGHT 25 (March 1974) [hereafter cited as Woodcock].

[86] F. SIMORA & N. B. GLICK, THE BOWKER ANNUAL OF LIBRARY STATISTICS AND BOOK TRADE INFORMATION 284, 286, 318 (24th ed. 1979).

[87] Herbert, *supra* note 22, at 240.

[88] "*Die Ausleihziffern der Bibliotheken nehmen . . . überall in Europa seit Jahren zu. Das bedeutet, dass die normale Einnahmequelle für Urheber und Verleger, nämlich durch den Verkauf von Vervielfältigungsstücken, auch durch den Leihverkehr beeinträchtigt wird.*" Nordemann, 81 UFITA, *supra* note 16, at 5.

[89] "*[L]a rémunération d'un littérateur dépend en premier lieu du chiffre de vente de son livre. Cette source de revenus risque de tarir lorsqu'une bibliothèque, après avoir acheté une seule exemplaire, se met à le prêter en lecture a un nombre indéfini de personnes.*" Gotzen, *Le droit de prêt dans le cadre de la législation belge sur le droit d'auteur*, 96 DdA 33, 33 (1978) [hereafter cited as Gotzen].

[90] "*De biblioteeken verminderen dus het aantal kopers.*" Cohen Jehoram, *Leeszegel, Büchereitantieme, Lending Rights*, 1961 N.J.B. 337, 337 [hereafter cited as Cohen Jehoram II].

[91] Woodcock, *supra* note 85, at 26.

[92] *Id.*

about the correctness of the following statistics in those countries where PLR schemes have been enacted, they will be accepted here as correct.

In Great Britain, where 440 million loans of books were made in 1960–61, the evidently very active public library system was established more than a century ago to educate a largely illiterate populace, "the artisans of the towns and labourers of the villages."[93] Nobody anticipated that, by 1960–61, 70% of the books borrowed would turn out to be fiction: "What was once a utilitarian instrument for spreading light and learning in the dark corners of nineteenth century industrialism . . . has become increasingly an engine of mass entertainment in the transformed circumstances of the second half of the [twentieth] century."[94] A member of parliament stated in December 1960 in the House of Commons "that eleven books are borrowed from public libraries for every one purchased,"[95] while other sources make it 9½ books borrowed for every one bought.[96] Sir Alan Herbert claimed that his two most popular books, stocked in seven copies by his local library, were lent out 3,600 times in 20 years, for which his total royalty amounted to 3*s*.[97] The lending frequency in Great Britain increased to 600 million loans by 1968—books only, not counting records, tapes, and other materials,[98] and grew further to approximately 660 million loans in 1970.[99]

In West Germany, where annual library loans in 1975

[93] Herbert, *supra* note 22, at 207.

[94] Harris, *Introduction: Some Issues in Political Economy*, *in* Herbert, *supra* note 22, at 208.

[95] *Id.* at 227.

[96] L. E. Seltzer, Exemption and Fair Use in Copyright 110 (1978). Seltzer says that 38 books were borrowed for every 4 bought in Great Britain in 1971 and gives comparable figures for the United States: 13 books borrowed for 14 bought. Are we really such enthusiastic book buyers, or do we make that much less use of the excellent library facilities available to us, than our British cousins use theirs?

[97] Herbert, *supra* note 22, at 219.

[98] Ellis, *supra* note 46, at 45.

[99] [British] Society of Authors, *The British Public Lending Right*, 83 Author, no. 2, 65 (Summer 1972), *reprinted in* 19 Bull. Cr. Soc. 443 (1972).

amounted to approximately 160 million volumes,[100] the same concern was mentioned frequently, as by Dietz:

> The steadily increasing importance of public library services implies the danger that the number of copies of literary works sold may steadily decrease in relation to the number of readers, even if it is taken into consideration that in some instances it is only anticipated purchases by libraries which make it possible to publish a work.[101]

Reading habits in Germany are different from those in Great Britain. While 70% of loans from English libraries were fiction, less that one-third of West-German loans fell into that category.[102] Nordemann agrees that the increase in lending activity in public libraries all over Europe reduces the normal source of income of author and publisher, and concludes that this fact is reason enough to compensate the author for the use of his works by library patrons.[103]

The Netherlands seem to be a country of particularly avid readers. In 1975, libraries contained 20 million books, and lending totals amounted to 115 million. Twice as many adult books were lent out as were bought by the public, and for each juvenile book bought, eight to nine volumes were lent.[104]

The majority opinion is that libraries reduce book sales, but it must be pointed out that nobody has proffered any hard evidence as to the magnitude of this reduction; such evidence does not exist.

LEGAL ASPECTS OF PLR

LEGAL FOUNDATIONS OF PLR

If "[e]veryone has the right to the protection of the moral and material interests resulting from any scientific, literary

[100] von Notz, *Verwertungsgesellschaften und Bibliotheksabgabe, Börsenblatt für den deutschen Buchhandel*, FRANKFURTER AUSGABE, no. 43, 714 (May 30, 1975).

[101] Dietz, *Public Lending Right and Compensation Fund for Authors*, 2 IIC 285, 286 (1971) [hereafter cited as Dietz, 2, IIC].

[102] FOHRBECK II, *supra* note 73, at 75.

[103] Nordemann, 81 UFITA, *supra* note 16, at 5.

[104] Spoor, *Lenen moet lonen*, AUTEURSRECHT, no. 4, 53, 53 (Oct. 1977).

or artistic production of which he is the author,"[105] then one should look to that statute of a nation which is designed to protect these rights: the copyright act. Indeed, many European countries insist that "the protection of the author is a basic human right"[106] and that this right is even "eternal, inalienable, and imprescriptible."[107] Why is it then that only one country, West Germany, chose to enact its PLR law as a provision of its copyright laws?[108] Other civil-law jurisdictions have based their PLR laws on public library legislation[109] or on administrative regulation.[110]

The common-law jurisdictions are no more consistent with the pronounced intent of PLR. Great Britain passed its PLR act outside the copyright statute even though much of the preceding debate centered on the proposition that authors are entitled to such payments because of the utilization of their work[111] and that PLR had nothing whatsoever to do with subsidies or social support payments.[112] The trend in Canada seems to be in the same direction, but there the social aspects were greatly emphasized. Australia and New Zealand seem to have avoided the problem by instituting PLR by administrative regulation.[113]

One might have assumed that the reluctance to pass PLR as part of the copyright act had stemmed from philosophical differences about the nature of copyright. Those countries which emphasize the author's moral rights might have been

[105] United Nations, A Declaration of Human Rights, art. I, § 2 (1948).

[106] Kreile, *supra* note 21, at 47.

[107] Art. 6, French Law No. 57-296 on Literary and Artistic Property of March 11, 1957 [March 14, 1957] JOURNAL OFFICIEL 2723, [1957] Dalloz, Législation; for English text, *see* CLTW, *supra*, note 17.

[108] § 27 UrhG 1972.

[109] As, *e.g.*, the Scandinavian countries, *supra*.

[110] The Netherlands is the only civil-law jurisdiction of this type that instituted PLR by administrative regulation in 1971; *see* Cohen Jehoram, *Biblioteekrecht voor auteurs*, AUTEURSRECHT, no. 4, 58, 59 (Oct. 1977) [hereafter Cohen Jehoram III].

[111] Boland & Bonham-Carter, *PLR—Some of the Grit*, 1973 AUTHOR 73, 75.

[112] *Id.* at 76.

[113] AUSTRALIA COUNCIL, *supra* note 34, at 2.

in conflict with jurisdictions that consider copyright a pure property right, such as Great Britain or the Scandinavian countries.[114] But this would have been an erroneous conclusion, for no pattern based on such reasoning can be discerned in any of the PLR solutions.

The "author's rights" jurisdictions, whether they subscribe to the monistic or the dualistic concept of copyright[115] could still accommodate PLR under the rubric of exploitation rights or the "neighboring rights" (*droits voisins*) section. The "property rights" theorists could have analyzed PLR as one of the straws of the "bundle of rights" recognized in Anglo-American thought or might even, with Lund, have declared it a servitude[116] on the property similar to a compulsory license. But neither type of jurisdiction did so.

In the Netherlands, a "property rights" jurisdiction, a scholar went so far as to describe the gratuitous lending of

[114] The British copyright statute of Nov. 5, 1956, 4 & 5 Eliz. 2, c. 74 (1956), *as amended* Oct. 25, 1968, Eliz. 2, c. 68 (1968), and Feb. 17, 1971, Eliz. 2, c. 4 (1971), provides in Part I, § 4, and in Part VI, § 6, that copyright is a typical property right, resting in the proprietor who may or may not be the author himself; the right is totally or partially assignable. The Scandinavian countries also reject any restraint on alienation in their copyright acts, but they do include such restrictions in their PLR legislation; *see generally* Lund, *supra* note 23, at 372 *passim*.

[115] A typical representative of the monistic concept of copyright is the present West German act, which defines copyright as being unitary. Ulmer likens it to a tree whose trunk derives its strength from the roots, which are the material and philosophical spheres of interest, while the exploitation rights (*Verwendungsrechte*) and the utilization rights (*Nutzungsrechte*) are the branches growing from that trunk; *see* E. ULMER, URHEBER- UND VERLAGSRECHT 101 (2d ed. 1960); *see also* FROMM & NORDEMANN, *supra* note 20, at 137–38. The *Urheberpersönlichkeitsrecht*, a specifically German variant of the *droit moral*, which is inalienable except by transfer *mortis causa*, is one root of this tree, but the property-like "branches" exploitation and utilization rights are transferable in a limited fashion.

The dualist concept as represented by the French copyright act specifically rejects the monistic view. Debois charges that the monists confuse cause and effect and claims that intellectual property arises from the intellectual activity itself, not from the product of that activity; *see* DEBOIS, *supra* note 15, § 208. He shows that French jurisprudence has ever since 1881 upheld the theory that there is a bifurcation into property rights (*droit pecuniares*) and moral rights (*droits moraux*); where the two conflict, the *droit moral* wins out; *see id.* § 210(3).

[116] Lund, *supra* note 23, at 367.

books as "expropriation without compensation,"[117] thereby implying a constitutional issue that indeed could best be resolved in the copyright act. But he, too, would like to see a noncopyright solution.[118] A constitutional challenge to an earlier version of the PLR law was made in West Germany, when, under the 1965 act, only books lent by commercial lending libraries were subject to the "library royalty." The complaint alleged that the exemption of noncommercial libraries, and in particular church and plant libraries, was unconstitutional. The West Germany Supreme Constitutional Court rejected that challenge and let the act stand the way it was.[119] The West German parliament subsequently granted in the 1972 copyright revision bill those rights that the challengers had demanded.[120]

The real reason why all nations other than Great Britain decided to avoid inclusion of PLR in their respective copyright acts was to exclude foreigners from eligibility for payments. Since in all PLR countries the funds come directly out of governmental appropriations and not from users' fees paid by library patrons, none of these states saw any particular need to support foreign authors not resident in their countries.[121] In addition, certain smaller countries, such as Norway or Denmark, determined that so much foreign literature

[117] Cohen Jehoram II, *supra* note 90, at 338.

[118] Cohen Jehoram I, *supra* note 21, at 255.

[119] *Beschluss* of July 7, 1971 Entscheidungen des Bundesverfassungsgerichts 31, 229 (1971). The question before the court was whether the exemption of gratuitous lending libraries from § 27 UrhG (1965) constituted a taking without just compensation under Art. 14 *Grundgesetz*, the West German constitution. The court, pointing to the exhaustion principle contained in § 17(2) UrhG (1965), rejected the claim and upheld the constitutionality of § 27 by distinguishing between lending for profit, *i.e.*, renting, and not-for-profit lending. *See* 63 UFITA 174–78 for the text of the decision.

[120] Here is one typical example: "The Dutch government can allow an administrative regulation which substantially approaches a subsidy of domestic authors, but a Dutch subsidy for all the authors of the world whose books were lent out in the Netherlands seems a bit too much of a good thing." Cohen Jehoram I, *supra* note 21, at 257 [transl. supplied].

[121] § 27 UrhG (1972).

is read in their countries that to include foreigners would siphon off too much money needed for authors at home.[122]

This explanation does not, however, work for Great Britain, which, like West Germany, does not exclude foreign authors—yet it has passed PLR as a separate statute, not related to its copyright act.

The foreigner exclusion strategy seems to have been successful up to now. How long it will remain so can only be guessed. There are voices that claim that this method of regulating PLR is, as a circumvention of international treaties, invalid.

Kreile argues convincingly[123] that the international conventions are meant to internationalize the national protection of authors. The principle of national treatment—the French assimilation principle[124]—is expressed in Art. 4, § 1, of the Brussels text of the Berne Convention for the Protection of Literary and Artistic Works, which proclaims that authors of the convention countries enjoy the same "rights which their respective laws do now or may hereafter grant to their nationals."[125] The European nations here involved have all acceded to the Berne Convention, as have Australia and New Zealand.[126]

Similarly, the Universal Copyright Convention, in both the 1952 Geneva text as in the 1971 Paris text, declares in Art. II, § 1, that nationals of contracting states "shall enjoy in each other Contracting States the same protection as that other State accords to works of its nationals first published in its own territory."[127] The nations involved here, again, have all ratified the UCC.[128]

[122] Dietz, 2 IIC, *supra* note 101, at 288.

[123] Kreile, *supra* note 21, at 63.

[124] H. Debois, A. Françon & A. Kerever, *Les conventions internationales du droit d'auteur et des droits voisins* § 135 (1976).

[125] *See* CLTW, *supra* note 17.

[126] 4 M. NIMMER, NIMMER ON COPYRIGHT app. 22 (rev. ed. 1979) [hereafter cited as NIMMER].

[127] *See* CLTW, *supra* note 17.

[128] 4 NIMMER, *supra* note 126, app. 21.

Are PLR rights rights arising out of authorship? Both the Berne Convention and the UCC deal only with those national rights that are understood by the conventions to be encompassed in the concept of copyright protection.[129] Nordemann does not mince words, stating that "[A] national solution outside the copyright laws . . . represents a flagrant violation of the international copyright treaties. Every legal claim arising from authorship is subject to the domestic principle of the Convention of Berne and the Universal Copyright Convention."[130]

Other German scholars agree with that view. The understanding of the term "protection of the author" under both conventions "[I]ncludes all protective regulations of civil, criminal, or administrative law which concern the securing, prosecution, and enforcement of those rights which involve claims by the author of the work, regardless whether these rights are specifically contained in that law serving the purpose of copyright protection or not."[131]

Are the noncopyright PLR laws therefore invalid? Not yet—it seems that there has never been a challenge anywhere under the international conventions.[132] But even as the treaty of the European Economic Community specifically outlaws, in Art. 7, any discrimination for reason of nationality, whether or not a regulation within or outside copyright law is concerned,[133] it would not be surprising to see such a challenge arise. It appears that Denmark or Sweden would be particularly likely places where it might succeed, since neither country could argue convincingly that PLR has nothing to do with copyright; even though their regulations were passed outside

[129] Khadjavi-Gontard, *supra* note 48, at 93.
[130] Nordemann, 90 DdA, *supra* note 72, at 83.
[131] Khadjavi-Gontard, *supra* note 48, at 93 [transl. supplied].
[132] Neither Nordemann nor the CS Wort had heard of any actual challenges as of April 1980; Letter from Prof. Dr. jur. W. Nordemann, Berlin (April 18, 1980).
[133] A. Dietz, Copyright Law in the European Community 99 (1978).

the copyright acts,[134] they were incorporated into them by direct reference.[135]

PLR'S EFFECT ON COPYRIGHT THEORY

THE EXHAUSTION THEORY

The exhaustion theory is based on the idea that once a copy of the author's work, published under a valid contract, has been sold in the marketplace and a contractual royalty has been paid, the rights of the author as to this physical object cease and its purchaser can resell, lend, or even destroy it at will. This theory, well known to American copyright doctrine,[136] is not as universally accepted as one might think. The civil-law jurisdictions are, again, not in agreement about this theory.

The old German copyright acts of 1901[137] and 1907[138] expressly provided that the copyright owner's rights were exhausted after the first sale and that his exclusive rights did not extend to the lending of such a copy.[139] The 1965 revision of

[134] For the Danish law, *see* note 23 and accompanying text, *supra*; for the Swedish law, *see* note 26, *supra*.

[135] The Danish situation may serve as an example: § 23(1) of the Danish Law No. 151 of May 31, 1961, on Copyright in Literary and Artistic Works (1961) Lovtidende A, XI, 295) (for English text, *see* CLTW, *supra* note 17) states that "[w]hen a literary or musical work has been published, copies included in the publication may be further distributed or exhibited publicly." But § 23(2) restricts the pronounced exhaustion principle by providing that "the rule in the foregoing paragraph does not restrict in any way the author's right to remuneration for books loaned to the public through libraries, cf. statutory order No. 128 of 16 April 1959, section 7, subsection 2 b." Can the Danes expect to be successful with the argument that their PLR is indeed outside the scope of copyright, at least for international purposes? It would appear that they could not. A similar argument could be made in Sweden's case.

[136] This principle is codified in § 109(a) New Act, which authorizes "the owner of a particular copy or phonorecord . . . to sell or otherwise dispose of the possession of that copy or phonorecord." *See generally* 2 M. NIMMER, NIMMER ON COPYRIGHT § 8.12[D] (rev. ed. 1979).

[137] Gesetz betreffend das Urheberrecht an Werken der Literatur und der Tonkunst of June 19, 1901 (1901 Reichsgesetzblatt [RGBl.] 227).

[138] Gesetz betreffend das Urheberrecht an Werken der bildenden Künste und der Photographie of Jan. 9, 1907 (1907 RGBl. 7).

[139] Dietz, 2 IIC, *supra* note 101, at 286.

the act in West Germany repeated the provision in § 17(2) but narrowed it in § 27 by decreeing that reasonable compensation must be paid in case of renting for profit. The 1972 amendment then included gratuitous lending in that section.[140] Thus, a breach in the bulwark of the exhaustion theory has appeared, and the breach is even bigger if one considers that the West German act does not cover just books but all kinds of lendable material, including records, tapes, etc. One might call this only an exception to the exhaustion principle, as Lund did in reference to the comparable situation in Denmark and Sweden,[141] but the question arises whether in the future this new principle could not be applied in other situations, especially in connection with the philosophy of *Urheberpersönlichkeitsrecht*, which gives the author extensive control except in those exploitation-right aspects that are being limited now and also in connection with the idea of *droit de suite*, which is discussed *infra*.

Countries that do not recognize the exhaustion principle, such as France or Belgium and others,[142] could theoretically never approve of PLR since the author has absolute control over the uses of his work. Thus, the French law allows the author to forbid the lending of his work if an appropriate inscription in each copy of the work prohibits it,[143] and Belgian law provides similarly.[144] But both countries have the best functioning *droit-de-suite* provisions,[145] which, while not

[140] § 27(1) UrhG (1972).

[141] Lund, *supra* note 23, at 369.

[142] As, *e.g.*, Greece, *see* Asprogerakas-Grivas, *Das Urheberrecht in Griechenland*, 52 UFITA 3, 14 (1969).

[143] French law recognizes the authors' absolute *jura erga omnes* in Art. 31(3) of the copyright statute, Law No. 57-296 on Literary and Artistic Property [1957] Journal Officiel de la République Française, [1957] Recueil Dalloz, Législation. English text in CLTW, *supra* note 17.

[144] Art. 1 of the Belgian Law on Copyright of March 22, 1886 [1886] Moniteur Belge, *as variously amended*. English text in CLTW, *supra* note 17.

[145] Art. 42 of the French copyright act, *supra* note 143; Art. 1 of the Belgian Law of June 25, 1921 [1921] Moniteur Belge (English text in CLTW, *supra* note 17) imposing, in the case of works of art sold at public auctions, a levy in favor of the artist of the work sold.

now applicable to books or other non-fine-art objects, could easily be extended to cover, in form of a lending royalty, print and nonprint objects other than objects of fine art. Then what would happen to the author's right to forbid certain uses? Could one not argue that on that basis alone PLR should be possible in these countries, not even drawing on the music-performance right analogy, which, added to the *droit-de-suite* idea, would most certainly limit an author's power to control the uses of his work?

Interestingly enough, Belgium has what one might call a rather old PLR statute,[146] which resembles the West German § 27 UrhG (1965) covering commercial lending for profit, notwithstanding the fact that Belgian law clearly allows the author to forbid lending[147] in the same manner as French law does on the theory of *droit de destination.*[148] Yet this Belgian statute was never officially enforced.[149]

It seems that on the one hand the exhaustion theory has received a serious blow in those countries where it exists, allowing authors in the future to make a straight-faced argument that they should have more of a say about the destination of their works; on the other, *droit de suite* and the not-as-yet enforced Belgian statute may point to a narrowing of French and Belgian authors' rights to forbid lending and thus open a gap through which, at least doctrinally, PLR could slip; *droit de destination* would not be left untouched, either.

[146] Art. 2 of the Belgian Law of Aug. 18, 1947 [1947] Moniteur Belge, creating a National Literature Fund, provides that "a tax of 2 percent shall be levied to the profit of the Fund on the amount of subscriptions to reading rooms and circulating libraries," to be administered by the Fund's management committee, and the funds to be transferred to the Royal Academies of Language and Literature, to be used for aid to writers and scholars. But since the law did not contain any enforcement procedures, and the government declined to set up the necessary implementation procedures, it was never enforced. *See* Gotzen, *supra* note 89, at 35–36.

[147] Gotzen, *supra* note 89, at 39.

[148] Desbois, *supra* note 15, § 290.

[149] *See* note 146, *supra.*

THE DROIT-DE-SUITE THEORY

Not much has been said about what influence on PLR thought the "consequential right," better known as *droit de suite*, may have. The performing rights analogy has received a little more play.[150] Yet it may be worthwhile to take a look at the *droit de suite* as well.

The consequential right arises under many continental European statutes[151] with the purpose of allowing an artist to reap additional income when his painting is later resold, often at a higher, if not substantially higher, price than the artist was able to command when he first sold it. It is not necessary here to investigate the various provisions of different national statutes, for they differ only in form and size of levy, but not in intent. In the United States, one state has a similar statute that recently was upheld as not infringing upon the Supremacy Clause of the U.S. Constitution.[152]

If an artist, especially a younger one, does not receive more than a modest sum for his original work of art and is thus allowed to participate in the appreciation in value with

[150] *See, e.g.*, Kreile, *supra* note 21, at 48, for Germany; Herbert, *supra* note 22, at 243–44, for Great Britain; Woodcock, *supra* note 85, at 25, for Canada; Cohen Jehoram III, *supra* 110, at 58, for the Netherlands.

[151] *See* note 145, *supra*, for France; note 144, *supra*, for Belgium; § 26 UrhG (1965) for West Germany.

[152] The California Artists' Resale Royalty Act, CAL. CIV. CODE § 986 (West) was construed as to its constitutionality in Morseburg v. Balyon, 201 U.S.P.Q. 518 (C.D. Cal. 1978), where it was claimed that the Resale Royalties Act was preempted under the Supremacy Clause of the U.S. Constitution, art. VI, cl. 2, by the Copyright Act of 1909, 17 U.S.C. § 1 *et seq.* [hereafter cited as Old Act] and by the New Act. Summary judgment was granted defendants on the basis that Congress had not expressed an intention to occupy the field of regulating sales of works of art so as to prevent all state regulation thereof; that this law does not impair federal interest but is the very type of innovative lawmaking that our federalist system is designed to encourage; and that, most importantly for this discussion, since the California law applies only to resales, not the first-sale rights, it does not infringe on the right to vend. The court pointed out that its decision was applicable only to transactions occurring in California and that it did not rule whether the "long-arm features" of the Resale Act were in conflict with the Commerce Clause of the Constitution, art. I, § 8, cl. 3.

a small percentage levied at a later sale, does not the same hold true by analogy for the author?

If we exclude from this argument the best-seller author who constitutes a very small percentage of all authors and who, therefore, would falsify the picture, is the author of a book not in a similar situation? Although a painter sells only one piece of his work, the original, whereas the author may receive royalties for a few thousand copies sold, the author's reward may be no higher, and is often lower, than that of the painter. If his book later excites interest in the reading public who, as demonstrated above,[153] is more apt to go to the public library than to buy a book, should he not be allowed to participate in this increase in de facto value to the reading public, just as the painter is allowed to share a little in the de facto increase in value to the art-loving public of his work of art?

It seems reasonable to allow an author this privilege, if the painter is given the same, and if composers and songwriters are permitted to collect a fee every time their musical works are performed. No reasonable argument has been advanced why the author should be left out. Kreile points out that voices have been heard that "once the author made his work available to the public, no one should be denied access to it" and that therefore the author should not insist on remuneration "in the public interest."[154] He condemns this line of thought, which demands of authors to pay for public policy—cultural policy. The question lies at hand why such a burden should be imposed only upon authors, and not also on composers and painters as well. All three surely contribute to national culture. PLR could be analyzed as another consequential right.

THE COMPULSORY LICENSE THEORY

The reading of a book might be compared to the performance of a musical work because the respective works do not

[153] *See* p. 13–15, *supra*.
[154] Kreile, *supra* note 21, at 49–50.

come alive without realization, *i.e.*, reading or playing. If certain jurisdictions allow the author to forbid certain uses,[155] then denying the author the right to forbid lending of his books constitutes, in a certain sense, a compulsory license to allow the library that particular use of his work. An analogy could also be found even in American law, which does not subscribe to the Franco-Belgian philosophy of allowing an author to forbid certain uses of his work once the book has been distributed. Both § 115 New Act, which deals with compulsory licenses for the reproduction of nondramatic musical works and its predecessor, § 27 Old Act, address themselves to a limitation of the author's exclusive rights that the lawmaker found to be in the public interest. It is conceivable that the lawmaker, even in America, could find such a limitation for PLR's sake in the public interest on the basis of cultural policy.

Another analogy might be said to arise in § 116 New Act, which rescinds the jukebox exemption of § 1(e) Old Act because "[t]he exemption not only deprives copyright owners of revenue to which they are fairly entitled, but it also discriminates against all other commercial users who must pay in order to perform copyrighted music."[156] The commercial use of a book, such as the adaptation for a play, a movie script, or the stage performance of a book without adaptation, such as the Will Rogers show, must be compensated. The lending activity of the ubiquitous public library—even though not a commercial activity but one that seems to have a durable effect on other commercial activities, *e.g.*, such as the sale of books—could be covered under the same philosophy as the jukebox exemption—the customer doesn't pay for the music, either; it is only an adjunct to some other form of business. The public library serves as a gratuitous adjunct to many commercial activities—reference books serve business re-

[155] *See* notes 143, 144, *supra*.
[156] H.R. REP., *supra*, note 1, at 112.

search, general education improvement serves upward job mobility, and so on.

Some European writers do not favor the compulsory license theory, because they would rather see the author's rights broadened than diminished. For historical reasons alone one can sympathize with a view that would like to see *jus cogens* increased in favor of the author's right to forbid uses. The reasoning behind this wish is that statutorily enacted compulsory licenses may be overtaken by technological developments, becoming then in due course meaningless clauses in a copyright act.[157] Oddly, this view for the benefit of the author would be counterproductive here; PLR gives the author additional income in return for restricting his right to forbid uses or for limiting his exclusive rights. Most authors probably don't care that legal theorists cannot agree on what PLR actually is, whether a "new right,"[158] an additional exploitation right previously unknown but governed by *jus cogens* that allows the license right to originate for the user without the will of the author,[159] or a social measure that should not have been intermingled, as in West Germany, with copyright theories.[160]

The library as we know it today will probably be around for a long time, but universal, national knowledge retrieval systems that record all the holdings and all the acquisition and lending activities of all the libraries in a country are not too far in the future. Would such a development make PLR obsolete? It would not seem so, for it would only simplify the ascertainment of the actual utilization of an author's work, whether in book or any other form. If one agrees that the

[157] Nordemann, *Legal Relationships Between Authors and Users and the Position of the Author in Society*, 98 DdA 51, 65 (1978) [hereafter cited as Nordemann, 98 DdA].

[158] Chartrand, *Le droit de prêt au public*, Documentation et bibliotheques, 181, 182 (Dec. 1977).

[159] Nordemann, 98 DdA, *supra* note 157, at 51.

[160] Vogt, *Urheberrechtsnovelle und Bibliothekstantieme*, 59 UFITA 5, 11 (1971) [hereafter cited as Vogt, 59 UFITA].

author be entitled to compensation for the mere use of his work, then such a development would make it easier to compensate him adequately and fairly. There does not seem to be much reason for fear that PLR will be a dead letter soon, and the term "compulsory license" may indeed be a correct identification of this new right, whether enacted inside or outside of copyright.

HOW DOES PLR WORK?

WHO PAYS FOR PLR?

In the early discussions of PLR, the fear was often expressed that if library patrons had to pay a fee for using the books, the library staff would be swamped by extra work;[161] the library might lay itself wide open to lawsuits by disgruntled authors or might lose desperately needed operating or acquisitions budgets because it was assumed that traditionally stingy legislatures would not make additional funds available.

These worries seem to have been unfounded. As a general rule, each country appropriates funds for PLR separately,[162] and whether library budgets have suffered as a consequence cannot be shown. It is entirely possible that legislators, taking into consideration that millions also had to be appropriated for PLR, may have been more reluctant to grant increases in library budgets. In any event, no jurisdiction has reported cuts in library funds because of PLR. In view of the social purposes motivating PLR almost everywhere, it would have been difficult to explain why library budgets should pay for such noble intentions.

THE BASES OF CLAIMS UNDER PLR

There is quite a variety in the methods used to compute PLR claims. Ideally, each loan of each copy of each book or

[161] Dörffeldt, *Büchereigroschen und Schriftsteller-Sozialfond*, 1970 BIBLIOTHEKSDIENST 429, 433.

[162] Cohen Jehoram I, *supra* note 21, at 255.

other item covered by PLR should be recorded in each library and then tabulated nationwide. But since no country has, as yet, such a totally computerized setup, such a system is presently not feasible. Slightly less modern but still practicable means are therefore employed at present.

METHOD BASED ON LIBRARY HOLDINGS

This Danish method counts all copies of eligible titles held in each library and tabulates them annually. To be eligible, an author must first apply to the Danish Authors' Society with a list of titles for which he wants to be compensated. The title becomes eligible if there are at least 50 copies in the nation's libraries. The authors' annual compensation per copy of each title amounted to Dkr. 2.06 in 1978; the amount is indexed to compensate for inflation and thus goes up each year.[163]

METHOD BASED ON LIBRARY ACQUISITIONS

The Norwegian scheme is based on library purchases of eligible titles, on which the government pays a certain percentage to the Author's Fund. In this system numbers of copies on the shelves or lending frequency is of no concern. The percentage payable by the government was supposed to be 5% of purchases, but since the government balked at that rate, arbitration between the Authors' Society and the government settled on a lower figure—how much is not entirely clear, but it seems to be around 3%, or Nkr. 7 million, in 1978 and 1979.[164]

METHOD BASED ON LENDING FREQUENCY

This is no doubt the most complicated but probably also the most equitable method if one wants to take the view that an author whose books are read more frequently than an-

[163] Jørgensen, *supra* note 50, at 6.

[164] Dörffeldt, *Im Ansatz verfehlt: Neues zur Bibliothekstantieme*, 1974 BUCH UND BIBLIOTHEK 902, 904.

other's is therefore also entitled to a larger payment out of PLR funds.[165] In general, this system works in Sweden and West Germany on the basis of sampling certain libraries each year, rotating annually (semiannually in West Germany) the libraries to be sampled. The "sampling libraries" have to keep accurate records of actual loans and in-library uses, which will then be tabulated and extrapolated nationally.[166] By this method, Great Britain, for instance, hopes to have sampled each library in a ten-year period, which will then permit establishment of a statistical model that will make subsequent sampling less complex and, at the same time, more accurate.[167]

The lending frequency method has raised some complaints. It is claimed that the social intentions of PLR are being defeated when the best-selling author, who makes a lot of money in regular royalties and on his subsidiary rights, probably also gets the lion's share of the PLR income because his books are presumably being borrowed more frequently.[168] The less well-selling author would also be the one whose books were borrowed less frequently, and thus he, the truly needy author, would get less of a share of the pie than the law actually intended.[169]

The same complaint could also arise under the other two methods, for the best-seller is probably represented in more copies on the shelf in the library holdings method, or in more copies purchased in the acquisitions method. Nowhere, though, would it have as much effect as in the lending frequency arrangement.

The demand was therefore made to pay authors on a decreasing scale as his entitlement, under any method, increased. This was roundly rejected in Denmark on the basis

[165] Sveriges Författarfond, Fakta om Forfattarfonden, 9–10 (1977).
[166] Nordemann, 90 DdA, *supra* note 72, at 81.
[167] Office of Arts and Libraries, *Public Lending Right*, 7 (1979).
[168] *See* note 164, *supra*.
[169] *Id.*

that PLR had its foundations in the author's rights, not the egalitarian social intentions,[170] but found more friendly ears in Sweden, where such a decreasing-scale system has been used for years. In 1979, *e.g.*, the scale was

17 *öre* per loan up to 100,000 loans,
8.5 *öre* for all loans between 100,000 and 200,000 loans,
3.4 *öre* for all loans up to 400,000 loans, and
1.5 *öre* thereafter

These sums are the actual amounts of *författarpenning*, or author's coin, paid out to the author; additional sums were put into the social fund.[171]

In West Germany, where the collecting society Wort [CS Wort] operates in a similar manner as the music collecting society GEMA, each loan frequency is divided into categories that seem to receive similarly scaled disbursements. The actual scaling method is not known.[172] Originally, the plan was that each loan should pay a *Groschen* or DM.10, but actual government appropriations reduced this amount to DM.05,5. After deducting administrative cost, the resulting total nationwide, approximately DM 9 million in 1976, was divided in two halves, one to go into the social fund, the other to be disbursed to entitled authors. The disbursement in Category I (3000 loans per title) amounted to a little more than 1 *Pfennig* per loan, or DM 31.50.[173]

[170] Jørgensen, *supra* note 50, at 6.

[171] The Swedish compensation basis, *i.e.*, the sums transferred into the Swedish Authors' Fund, is 29 *öre* per loan and 116 *öre* per reference copy of an original Swedish book, and 14.5 *öre* per loan and 58 *öre* per reference copy of books translated into Swedish. *See* PLR in Sweden, *supra* note 53, at 2.

[172] Mundt, *Die vereinigten Verwertungsgesellschaften*, 99 BERTELSMANN BRIEFE, 55, 56 (1979) [hereafter cited as Mundt, 99 BERTELSMANN] shows that the total in 1978 had reached DM 11 million. At that time, there was another collecting society for scholarly books, CS Wissenschaft, which merged with CS Wort on June 29, 1978. No later statistics are available to determine the exact amount available to CS Wort, nor the approximate share per loan actually disbursed; *see* note 173, *infra*.

[173] Mundt, *Bibliothekstantieme in der VG Wort: II. Die Realisation*, FILM UND RECHT [FuR] 1976, no. 9, 599, 607 [hereafter cited as Mundt, FuR].

PLR IS NOT FOR ALL

Who is an "entitled author" under PLR rules? First, the term "author," used rather generically up to now, must be refined, at least for the purpose of some jurisdictions. While Great Britain[174] and West Germany[175] make no distinctions among types of authors or the supposed quality of their works, some countries limit the term to those authors who are writers of *belles-lettres*, as, for instance, Norway[176] or the Netherlands.[177] The term *belles-lettres* differs from fiction insofar as it is a qualitative determiner and thus excludes gothic novels, who-done-its, and the like. The reasoning behind this limitation is the support of Culture with a capital C and the hope to stave off the previously mentioned massive assault of foreign cultural influences.

If the author is in whatever appropriate category the national law places him, and his work thus qualifies, he must still pass another test before he may become eligible for payments: the nationality test. Among the various jurisdictions, three different principles are encountered that are the more restrictive the more pronounced the *Kulturangst* of the country.

NATIONALS ONLY

The Scandinavian countries and the Netherlands grant PLR privileges only to their nationals, wherever they reside, and exclude foreigners completely. They allow the citizen-trans-

[174] Office of Arts and Libraries, *Public Lending Right*, 2–3 (1979).

[175] Kreile, *supra* note 21, at 68.

[176] Den Norske Författerforening, *Authors in Norway*, 2 (1979) (unpublished report of the Norwegian Authors Society of Oct. 10, 1979) [hereafter cited as *Authors in Norway*] states that in order to preserve national traditions, the government has adopted strategies to stimulate art and literature. Included in PLR are only fiction writers, poets, and dramatists, *i.e.*, writers of *belles-lettres*, and translators (presumably of *belles-lettres* only), whereas all other writers seem to be left out.

[177] The nonliterary authors are not taken into consideration in the Netherlands according to § 2 of the report of the Commissie Auteursrecht van de Dr. Dr. E. Boekmanstichting, *as cited in* Cohen Jehoram I, *supra* note 21, at 259.

lator of a foreign work to share in the benefits, but not the author of the work.[178]

NATIONALS AND RESIDENT ALIENS

Australia and New Zealand count sizable numbers of "landed immigrants" who may not yet have become citizens or may not want to acquire citizenship. These immigrants are eligible for PLR benefits together with nationals if the immigrant's work was published in the country and if the author expresses his intention to remain in the country.[179] The preliminary discussions in Canada advocate a similar arrangement for that country.[180]

ALL AUTHORS, REGARDLESS OF NATIONALITY AND DOMICILE

Under the existing West German rules, and under the new British act, foreigners are not discriminated against. How the British law will in effect work is not known yet, for it is too new, and the regulations to be worked out by the Register of Public Lending[181] are not expected sooner than by 1981 or 1982. The West German law declares the foreigner eligible for the amounts disbursed to authors (thus approximately 38% of the entitlement[182])—but even though disbursements have been made regularly since 1976, no foreign author has been paid anything. In order to be able to collect in West Germany, an author must join the CS Wort, but foreigners are not eligible for membership. This is not, though, a catch-22 craftily designed into the West German law to avoid paying

[178] For Norway, *see Authors in Norway*, *supra* note 176, at 1; for Sweden *see PLR in Sweden*, *supra* note 53, at 4.

[179] AUSTRALIA COUNCIL, *supra* note 34, at 5.

[180] Jackson & Brégaint, *supra* note 37, at 15.

[181] *See* Schedule § 1 *et seq.* to Eliz. 2, c. 10 (1979).

[182] The CS Wort divides PLR receipts as follows: 5.5% taxes and 10% administrative expenses are first deducted; of the remaining balance of 84.5%, 42.25% goes into the *Altersversorgungswerk*, an old-age social support and maintenance fund; 4.225% is earmarked for the social fund; and 38.025% is disbursed directly to authors. *See* Mundt, FuR, *supra* note 173, at 604.

foreigners, as it may seem, but takes into consideration that reciprocity of national treatment under the international conventions[183] and the EEC treaty[184] must apply. Thus, CS Wort is interested in concluding reciprocal agreements with foreign collecting societies, such as, *e.g.*, the recently signed contract with the British Authors' Lending and Copyright Society that is to go into effect as soon as full reciprocity is assured.[185] CS Wort has actually determined all sums due foreign authors since 1973 and has sequestered the appropriate funds in escrow. But it insists on a general reciprocity that the Scandinavian countries have not granted. The West German collecting society also takes the attitude that it does not matter under which label PLR was enacted in each country, because PLR is based on the intellectual creation of the author and thus is always subject to the national treatment required by the international conventions.[186]

WHO BENEFITS FROM PLR?

As mentioned before, there are three basic distribution systems for PLR benefits to those who qualify under the rules developed *supra*. For simplicity's sake, administrative expenses, which vary from 5 to 10% under the different systems, will have been considered deducted before any further allotments take place under the systems described below.

ALL MONIES ARE DISBURSED DIRECTLY

Th oldest PLR jurisdiction, Denmark,[187] as well as Australia,[188] uses this method, and Great Britain's act provides similarly, subject to rules not yet developed.[189]

[183] *See* note 17, *supra*.
[184] *See* note 133, *supra*.
[185] Letter from Dr. H. J. Mundt, Man. Dir., Verwertungsgesellschaft Wort, Munich (April 28, 1980).
[186] *Id.*
[187] Jørgensen, *supra* note 50, at 6.
[188] AUSTRALIA COUNCIL, *supra* note 34, at 3.
[189] Office of Arts and Libraries, *Public Lending Right*, § 2.2 (1979).

ALL MONIES ARE SPLIT BETWEEN THE AUTHORS AND A SOCIAL FUND

In keeping with the oft-pronounced social intentions, this method is used in Sweden,[190] West Germany,[191] and many other countries and seems to be favored in Canada.[192] While specific regulations vary slightly, the general idea is that half the income from PLR is disbursed to authors, the other half to the social fund, which uses it for, among other things, the "employer's share" of social security insurance in West Germany,[193] for old-age and other insurance purposes, for scholarships, travel grants, stipends, and other subventions. In Sweden, part of it is used to create a guaranteed annual income for especially deserving authors,[194] the only jurisdiction that seems to have such a plan.

ALL INCOME GOES INTO THE SOCIAL FUND

Only one country, Norway, is said to use this system according to the literature reviewed up to 1979.[195] All funds are to be used for support of needy authors and their widows and children, for scholarships, travel grants, etc. None of the benefits accrue directly to authors on the basis of the use of their books in libraries.

But there are doubts whether this system is still in effect in Norway. The most recent report received from the *Norske*

[190] PLR in Sweden, *supra* note 53, at 1.

[191] Mundt, FuR, *supra* note 173, at 604.

[192] Jackson & Brégaint, *supra* note 37, at 11.

[193] Uninsured German authors can now join the social security system; CS Wort pays the "employer's share" of DM 250 per month as if the author were employed; *see* Mundt, 99 BERTELSMANN BRIEFE, *supra* note 172, at 57.

[194] 160 highly qualified authors, translators, and illustrators are guaranteed Skr. 36,000 per year, independent of the number of loans of their books. *See* PLR in Sweden, *supra* note 53, at 3.

[195] Cohen Jehoram II, *supra* note 90, at 340, reports that "the individual authors do not, however, benefit from the fund." [transl. supplied]; *accord*, Dietz, 2 IIC, *supra* note 101, at 295; Jackson & Brégaint, *supra* note 37, at 33; Kreile, *supra* note 21, at 58; Lund, *supra* note 23, at 376; and others.

Forfatterforening[196] indicates that all income from PLR is received by the *Norsk Forfatter-og Oversetterfond* (Norwegian Authors' and Translators' Fund), which then decides "to what extent the compensation will be used for scholarships, and to what extent it will be paid as individual compensation to its members."[197] Recent correspondence with the Norwegian Authors' Society asking for clarification and citation of administrative rules or amendments to the existing PLR act remains unanswered, and so it may be assumed that Norway has, in some form, adopted a system similar to Sweden's. But this is merely conjecture.

PLR AND THE PUBLISHER

The publisher, who has to invest his money, know-how, and time in publishing the author's book, and who has to rely on his gambling instincts when it comes to publishing a first novel of an unknown writer, has more than a passing interest in PLR. If one adopts the view that "a direct victim of the diminution of sales of copies which are lent or rented is the publisher,"[198] then the publisher should be entitled to some compensation.

Only a few PLR jurisdictions have been sympathetic to the publisher's desires. Australia proudly announced that "[t]he Public Lending Right scheme in Australia is demonstrably the most advanced Public Lending Right scheme in the world. It is the only one which allows the publisher to share the recompense."[199] Australia does, indeed, retroactively as of April 1, 1974,[200] allow publishers a payment of 12.5 cents per compensable lending event,[201] but it is not the only nor the first one to do so. West Germany divides the PLR payments

[196] *Authors in Norway*, *supra* note 176, at 4.
[197] *Id.*
[198] Gotzen, *supra* note 89, at 35 [transl. supplied].
[199] AUSTRALIA COUNCIL, *supra* note 34, at 2.
[200] *Id.* at 3.
[201] *Id.* at 4.

for *verlagsgebundene Werke*, works still under a publishing contract, into a 70% share for the author and 30% for the publisher,[202] retroactively as of January 1, 1973.[203]

In Great Britain, where the specific details of PLR are being worked out right now,[204] the publisher is not mentioned in the text of the act. Its language might suggest that only the author is to be a beneficiary: "In accordance with a scheme to be prepared and brought into force by the Secretary of State, there shall be conferred on authors a right, known as 'public lending right.'"[205] During the discussion stage prior to enactment, a Joint Statement by the Society of Authors and the Publishers Association urged that PLR royalties be divided 75% for the author, 25% for the publisher,[206] because the latter is the author's essential partner for the production of an original work, risking judgment, capital, and reputation, and would have to bear the cost of identifying books for PLR and of inserting machine-readable slips.[207] It remains to be seen what specific regulations will be set up by the Register of Public Lending; that the publisher is not excluded by implication can be demonstrated in the language of the act, which allows full "assignment or assignation"[208] of the author's PLR rights.

The West German law does not mention publishers specifically, either,[209] but when the scheme was worked out in form of a "General Contract Concerning the Compensation of Copyright Claims According to § 27 UrhG" between the West German federal, state, and municipal governments, on one hand and the collecting societies on the other,[210] publishers

[202] Mundt, FuR, *supra* note 173, at 605.
[203] *Id.* at 603.
[204] *See* note 189, *supra*.
[205] § 1(1) British Public Lending Right Act, Eliz. 2, c. 10 (1979).
[206] *See* note 99, *supra*, 19 BULL. CR. SOC., at 445.
[207] *Id.*
[208] § 1(7) (b) British Public Lending Right Act.
[209] § 27(1) UrhG (1972).
[210] Mundt, FuR, *supra* note 173, at 603. The contract draft was finalized on Dec. 18, 1974, and became effective upon affixation of the final signature on June 18, 1975; *see* 75 UFITA 174 (1976) for the German text of the agreement.

were included.[211] Thus it is conceivable that the British scheme will follow the suggestions of the Society of Authors and the Publishers Association.

In Canada, the Writer's Union would like to exclude publisher, and relies on a statement made earlier by the British Writers Action Group that opposed sharing with publishers in Great Britain: An author is excluded by contract from partnership with the publisher in the design, promotion or selling of his book, and the author's share of the proceeds of the sale of the book is limited by contract to a fixed percentage . . . whereas the publisher's share is limitless.[212] This factually incorrect language, having already been rejected in Great Britain, seems to find little support in Canada where, *e.g.*, the Canadian Copyright Council suggested a fifty-fifty split.[213] But there are fears that any sharing would mainly benefit foreigners, for 80% of Canada's publishing industry is said to be controlled from abroad, and a separate subsidy for Canadian publishers was therefore urged.[214]

Other jurisdictions where PLR is in force or being contemplated do not mention publishers or give them a share. Leaving them out might make sense if the sole object of PLR is to improve the economic status of the author and to insure his social security—but then, this was supposed to be the object of the West German legislation, too.

CONCLUSION

PLR laws seem to be basically sociopolitical solutions upon which a layer of legal theory was superimposed for the purpose of interpretation. Even in West Germany, where the law was passed as a provision of the copyright act, it had been unsuccessfully argued prior to enactment that, as a fundamen-

[211] Mundt, FuR, *supra* note 173, at 603.
[212] Jackson & Brégaint, *supra* note 37, at 16.
[213] *Id.*
[214] *Id.*

tally social protection measure, it should be dressed in a non-copyright cloak.[215]

Thus, PLR has two sides: on one side is the purely socio-political question of whether to subsidize the author as a perpetuator of national culture when he cannot make enough money on his own to pay for his daily living expenses and for the various types of insurance perceived as basic in modern-day life. It is the political scientist's task to determine whether a PLR law should include only the literary author, the poet, and the dramatists, as in some Scandinavian countries and the Netherlands, or whether there should be more to culture than just *belles-lettres*. He would also have to determine whether cultural subsidies might not be made available in ways other than through PLR.

On the other side is the legal aspect, which must be analyzed this way: (1) If PLR is declared a new, positive right by the legislator, (2) can it be accommodated under existing copyright theories, at least from the common-law view of a country like the United States?

As in West Germany prior to 1965,[216] the exhaustion principle is firmly anchored in American law. Yet legislative decision can, if based upon a solid public policy basis, narrow that principle to accommodate a new right. The use of a library book is almost like a secondary transmission of the author's work. As the legislator approved of a compulsory license in §111(d) New Act for cable transmission, it might be argued that library use is a reutilization similar to that made by cable operators of television programs. If one reads this section together with § 118, which provides for "reasonable terms and rates of royalty payments" with respect to the use of published musical works and published pictorial, graphic, and sculptural works, then one could argue that there is little reason why such secondary use as the library use of

[215] Vogt, 59 UFITA, *supra* note 160, at 11–12.
[216] *See* note 137, *supra*.

books should not also find compensation in a similarly structured form. Finally, the "small rights" in music find a vigorous champion in the collecting societies such as ASCAP—the book author represents a similar cultural value as the composer and might be similarly entitled to compensation for his literary property through PLR.

If music, in order to be accessible to the majority of persons, must be played, and if such playing in public must be compensated, then one might raise the point that an unread book is of just as little value as an unplayed musical score and that the act of realization—borrowing of the book followed by the reading of it—might be a compensable event. The analogy also applies to rental music for public performance as compared to sheet music for home playing; the latter carries only one royalty, the one due the author after the sale in the store, regardless of how many times the piece is played at home, but the public performance demands a royalty each time. Books bought for home reading fall in the latter category, and books borrowed could be considered as belonging to the former.

The power argument[217] is very germane. Composers joined to show a strong front when demanding remuneration for the small rights; the lobby of the recording industry and their artists is also powerful. Not so the authors who did not join into a similar "union"[218] either because they abhorred the organized-labor analogy and the more and more common idea in Europe that defines them as "intellectual workers"[219] rather

[217] *See* p. 12, *supra*.

[218] Dietz, among others, mentions that the basic idea of intellectual work for compensation has led to the notion that copyright law is actually part of labor law in the broader sense where the primary focus is on the activity per se and its result, not the working relationship between employer and employee; *see* Dietz, 3 IIC, *supra* note 47, at 453; he states that German writers such as Günter Grass had made efforts to join the organized labor movement either by joining an existing union or by creating a new union for artists and writers; *id.* at 455.

[219] Ulmer, *supra* note 61, at XI, also speaks of "*geistige Arbeit*," intellectual work, and stresses the social aspects of copyright law.

TABLE 1 Public Lending Right Regulations in Ten Countries

BASES OF PUBLIC LENDING RIGHT LAWS			
Country (date PLR instituted	*Legal Basis*	*Lending computed on basis of*	*Total governmental contribution*
Australia (1974)	Administrative Regulation	sampling of holdings	Australian $ 579,000 (1976)
Denmark (1946)	Public Library Act	listing of holdings	Dkr. 25 million (1978)
Finland (1961)	Public Library Act	sampling of lending frequency	exact amount unknown
Great Britain (1979)	separate law, implementation to come	sampling of lending frequency	Treasury promises ab. £2 million
Iceland (1968)	Administrative Regulation	listing of holdings	exact amount unknown
The Netherlands (1971)	Administrative Regulation	acquisitions	Fl. 465,000 (1976)
New Zealand	Administrative Regulation	sampling of holdings	NZS 140,000 (1973)
Norway (1947)	Public Library Act	acquisitions 7 million	Nkr. 7 million (1978/79)
Sweden (1956)	Public Library Act	sampling of lending frequency	Skr. 30 million (1979)
West Germany (1972)	part of Copyright Act	sampling of lending frequency	DM 11 million (1978)

Table 1 (*Continued*)

BASES OF PUBLIC LENDING RIGHT LAWS

Computation basis	*Types of works covered*	*Reference books included?*	*Other Material*
$.50 per copy per loan	all types of books	yes	no
Dkr. 2.06 per copy per loan per year	all types of books	no	no
5% of state grants to libraries	belles-lettres only	?	no
approx. halfpenny per copy per loan	all types of books	no	to be determined
10% of state and municipal grants to libraries	belles-lettres only	no	no
no specific basis known	belles-lettres	no	no
$1.30 per copy per loan (1973)	all types of books	?	?
approx. 2% of total acquis. budgets	belles-lettres only	no	no
see text page 000	"literary and artistic works"	yes	no
approx. DM 05.5 per copy per loan	all types of books, tapes, records, AV	yes	yes

TABLE 2 Public Lending Right Benefits in Ten Countries

	BENEFITS UNDER PUBLIC LENDING RIGHT LAWS		
Country date PLR instituted)	*Who benefits*	*Is PLR inheritable?*	*Is PLR assignable?*
Australia (1974)	Nationals and landed immigrants" as long as residents	by spouse living permanently with author, whether legally married or not; children only if no spouse filed prior claim.	yes, but ceases at author's death or 50 yrs after publication whichever is later
Denmark (1946)	nationals only	by spouse, unless remarried: and minor children	no
Finland (1961)	nationals only	?	no
Great Britain (1979)	Nationals and foreigners (reciprocity demanded)	by testate or intestate succession	yes
Iceland (1968)	nationals only	?	?
The Netherlands (1971)	nationals only	?	no
New Zealand	nationals and "landed immigrants"	?	?
Norway (1947)	nationals only	?	?
Sweden (1956)	nationals only	by testate or intestate succession	no
West Germany (1972)	nationals and foreigners (reciprocity demanded)	by testate or intestate succession	no

Table 2 (*Continued*)

BENEFITS UNDER PUBLIC LENDING RIGHT LAWS

Distribution after deduction of admin. cost and taxes		*Transl. incl. ?*	*Illustr. incl. ?*	*Publisher incl. ?*
Author	*Social Fund*			
100%	none	yes	yes, share with author	12½ cents per copy per loan
100%	none	to be determined	no	no
35%	60%	5%	no	no
100% but £1000 max. per title	none	to be determined	to be determined	to be determined
60%	40%	?	no	no
100%	none	?	?	no
100% minimum $65 p.a.)	none	?	?	no
uncertain	uncertain	yes	no	no
32%	68%	yes	yes	no
15.5% admin. expenses, taxes, 42.25% old-age assistance fund, 4.225% social fund, 38.025% pay-out to authors		50% of foreign author's share	yes	30% of author's share

than as loftier spirits or because it may not have occurred to them or their authors' societies that such a banding together might be valuable and successful.

The legislator should not find it difficult to rationalize PLR in one form or another within copyright theories. Once the further narrowing of the exhaustion principle is accepted, then a definition as either a compulsory license or as a "small right" should not be difficult. The *droit-de-suite* theory would presently be of less value, for it is recognized only in one state, and not at all by federal law.

Lest this be understood as a general advocacy of PLR, it must be said that nothing more is presented than an argument for PLR as a feasible copyright solution. It is not necessary to define PLR as part of public library acts or any other separate act. Being based on the rights of the author in his work and in the theory that each right may be utilized separately, as the New Act defines it, PLR could, and in the event that it were enacted, should be part of the copyright act.

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American Law Analogues to the Paternity Element of the Doctrine of Moral Right: Is the Creative Artist in America Really Protected?

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WHEN AN artist[1] creates a finished work of art he has two distinct interests at stake in that work. The first interest is an economic one; he wants to guard against an outsider's pirating the work or otherwise reaping the pecuniary benefits to be derived from the work. In the United States, this interest is granted federal statutory protection in the form of the Copyright Act of 1976.[2] The second interest is one of honor and reputation; the artist wants to ensure that his creative

[1] The terms "artist" and "author" are used interchangeably in this research paper. The constitutional foundation for copyright law is contained in the following language: "To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8, cl. 8. This clause has long been interpreted to extend constitutional protection to the fine arts. *See* 1 J. MERRYMAN & A. ELSEN, LAW, ETHICS AND THE VISUAL ARTS 4–42 (1979).

[2] 17 U.S.C. §§ 101–118 (1976). *See generally* H. HENN, COPYRIGHT PRIMER (1979); M. NIMMER, NIMMER ON COPYRIGHT (1979).

personality, as expressed in the work, is preserved.[3] Unfortunately, this second interest is afforded no express statutory or common law protection in America. In many civil law countries, however, such plenary protection is granted to the artist under the doctrine of *droit moral* or moral right.[4] This moral right doctrine picks up the shield of protection at the very point that American copyright law lays it aside.

The doctrine of moral right is a jurisprudential concept with definable parameters that is generally recognized around the globe. An artist's moral right is construed to include those "non-property attributes of an intellectual and moral character which give legal expression to the intimate bond which exists between a literary or artistic work and its author's personality."[5] The principle of moral right is, however, more than a nebulous legal philosophy. Moral rights have been codified by several nations[6] and comprise a principal element of the international Berne Convention for the Protection of Literary and Artistic Works.[7] Article 6^{bis} of the Berne treaty states as follows:

> (1) Independently of the author's economic rights, and even after the transfer of said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.[8]

[3] This distinction admits of some artificiality since much of the artist's reputational interest can also have a direct pecuniary impact.

[4] The literal translation of the French *droit moral* is "moral right," and this latter phrase, although misleading, is firmly entrenched in the jurisprudential literature of English-speaking countries. The more precise term is the German *Unheberpersönlichkeitsrecht*, which translates as "the right of the author's personality." 1 S. LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 575 n.2 (1938).

[5] Sarraute, *Current Theory on the Moral Right of Authors and Artists under French Law*, 16 AM. J. COMP. L. 465 (1968).

[6] *See* 1 J. MERRYMAN & A. ELSEN, *supra* note 1, at 4–5 to 4–7 for excerpts of codifications of moral rights in France, Germany, and Italy. The doctrine of moral rights is recognized in no less than 63 nations. Valentine, *Copyright: Moral Right—A Proposal*, 43 FORDHAM L. REV. 793, 797 n.47 (1975).

[7] The pertinent portions of the Berne Convention are reprinted in 1 J. MERRYMAN & A. ELSEN, *supra* note 1, at 4–4 to 4–5.

[8] *Id.*

The United States is not a signatory to the Berne Convention;[9] otherwise, American artists would automatically be cloaked with the armor plate of moral rights.

For purposes of a detailed analysis, moral rights may be divided into five main categories. These are:

1. The right of the artist to insist that his name be connected with his work and only his work. (Paternity right.)
2. The right of the artist to insist that the integrity of his work be respected. (Integrity right.)
3. The right of the artist to have his work published only with his consent.
4. The right of the artist to withdraw his work from sale.
5. The right of the artist to protection from excess criticism.[10]

Of these categories, only the first one, the paternity right, is examined in this Note. The intent of this research paper is to analyze and evaluate critically, and in detail, the existence of any protection in the United States that is analogous to the guardianship provided by the paternity rights recognized by other nations.

The extent to which an artist's moral right is protected in the United States is currently a subject of controversy. It is generally agreed that the actual doctrine of moral right "has not achieved acceptance in the common law jurisdictions of the United States."[11] On the contrary, when confronted with

[9] Neither is the United States a signatory to the Universal Declaration of Human Rights, adopted by the United Nations General Assembly on December 10, 1948, which states in pertinent part: "(2) Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author." Art. 27(2), *Universal Declaration of Human Rights*, 6 UNITED NATIONS BULL. 8 (No. 1, Jan. 1, 1949). For a more detailed discussion, see Diamond, *Legal Protection for the "Moral Rights" of Authors and Other Creators*, 68 TRADEMARK REP. 244, 245–47, 271–72 (1978).

[10] Devlin, *Moral Right in the United States*, 35 CONN. B.J. 509, 510 (1961).

[11] Cukell, *Author's Moral Right: Can Louisiana Adopt the Doctrine?* 51 TUL. L. REV. 309, 314 (1977).

the doctrine, courts typically have rejected it out of hand.[12] In addition, it is indisputable that "[t]he Copyright Act accords no recognition of moral rights."[13]

Still, some legal commentators have asserted that the functional equivalent of the moral right doctrine has developed in the United States under a variety of common law and statutory theories:[14]

> Nevertheless, the time honored judicial practice of distilling new wine in old bottles has resulted in an increasing accretion of case law which in some degree accords the substance of moral rights either under copyright, or under other conventional and respectable labels such as unfair competition, defamation, invasion of privacy or breach of contract.[15]

The balance of this Note represents an evaluation of this "accretion of case law" and an appraisal of its efficacy as an alternative to the doctrine of moral right.

PATERNITY RIGHT

The artist's paternity right is one of fundamental importance. It is virtually impossible for an artist to develop a reputation without identification and rightful attribution of his creative ability. Yet it has been stated that "American law has, relatively speaking, a callous disregard for the paternity

[12] *See* Vargas v. Esquire, Inc., 164 F.2d 522, 526 (7th Cir. 1947); Crimi v. Rutgers Presbyterian Church, 194 Misc. 570, 89 N.Y.S. 2d 813 (Sup. Ct. 1949); Diamond, *supra* note 9, at 259 ("The traditional approach of courts in the United States to an attempt to invoke the moral right doctrine has been outright hostility."). *But cf.* Shostakovitch v. Twentieth Century-Fox, 196 Misc. 67, 70, 80 N.Y.S. 2d 575 (Sup. Ct. 1948) (court intimates that in proper case doctrine might be applied).

[13] 2 M. NIMMER, *supra* note 2, at § 8.21[D].

[14] *See* Strauss, *The Moral Right of the Author*, 4 AM. J. COMP. L. 506 (1955); Devlin, *supra* note 10.

[15] 2 M. NIMMER, *supra* note 2, at § 8.21[D]; *accord*, Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 340 n.5 (S.D.N.Y. 1968) ("[T]he doctrine of moral right is not part of the law in the United States . . . except insofar as parts of that doctrine exist in our law as specific rights—such as copyright, libel, privacy and unfair competition").

rights of creative persons."[16] The problem lies in the fact that in the United States the paternity right does not exist unless written into an enforceable contract.[17] This is to be contrasted with French law, for example, which states that the moral right is, "inalienable, unbarrable, and perpetual. . . . Respect for this principle takes precedence over the enforcement of contracts and may always be invoked."[18] Thus, even the most cursory introduction to the paternity right concept exposes a fundamental difference between the American and French viewpoints regarding moral rights of the artist.

For purposes of analysis, the paternity right may be divided into four separate elements: (1) The right of the artist to prohibit the attribution of his work to a third person; (2) the artist's right to require that his name be joined to each copy of his work; (3) the right that an artist's *nom de plume* be respected; and (4) the right that the artist not be named the creator of work that is not his own.[19] Although each of these rights is discussed individually, it should be remembered that they share a common heritage and many common features.

THE RIGHT OF THE ARTIST TO PROHIBIT THE ATTRIBUTION OF HIS WORK TO A THIRD PERSON

One well-defined aspect of the doctrine of moral right is the author's right "to prevent others from usurping his work by naming another person as the author."[20] Some commentators have concluded that American artists are accorded analogous protection by either resort to copyright law or a theory

[16] Treece, *American Law Analogues of the Author's "Moral Right,"* 16 AM. J. COMP. L. 487, 494 (1968).

[17] *Id.* at 505; McNabb, *Moral Right and the American Court*, 13 HOUS. L. REV. 781, 787–88 (1976).

[18] Sarraute, *supra* note 5, at 485; *accord*, 1 S. LADAS, *supra* note 4, at 599–601. *But cf.* Strauss, *supra* note 14, at 516 ("An express contractual waiver of the moral right by the author is usually held valid").

[19] *See* Devlin, *supra* note 10, at 511–12; Strauss, *supra* note 14, at 508.

[20] Strauss, *supra* note 14, at 508; *accord*, 1 S. LADAS, *supra* note 4, at 585–86.

of unfair competition.[21] Both putative analogues are examined.

COPYRIGHT

It is true that an artist who avails himself of copyright protection may have a legal cause of action against a plagiarist. The violation would be one of copyright infringement.[22] Moreover, once such a violation is proved, the artist would be entitled to the full range of remedies,[23] including an award of reasonable attorneys' fees.[24]

Yet this seemingly impressive aegis of copyright protection is much less comprehensive than the actual protection afforded by the moral right doctrine. Copyright guardianship is not a natural right; an action for infringement may be brought only if the artist first satisfies the formalities of registration.[25] The notorious reluctance of American artists to register their work and to thereby utilize copyright law to advantage has, in fact, been made the subject of one law review article.[26] Thus, the element of human nature as a practical limitation on the effectiveness of copyright law should not be ignored.

Another deficiency in any dependence on the copyright law to protect an artist's paternity right is that copyright protection is of finite duration.[27] While the exact duration depends upon diverse factors[28] not relevant to the scope of this paper, in all cases copyright protection will expire even if the artist

[21] *See* Devlin, *supra* note 10, at 511.
[22] The Copyright Act of 1976, 17 U.S.C. § 501 (1976).
[23] *Id.* §§ 502–505.
[24] *Id.* § 505.
[25] *Id.* § 411.
[26] Sheehan, *Why Don't Fine Artists Use Statutory Copyright? An Empirical and Legal Survey*, 22 BULL. COPYRIGHT SOC'Y 242 (1975). Note, however, that this survey was conducted prior to the enactment of the Copyright Revision Act of 1976, which substantially minimizes the technical formalities of registration.
[27] The Copyright Act of 1976, 17 U.S.C. §§ 301–305 (1976).
[28] *Id.*

meticulously satisfies each and every requirement of registration and renewal.

Finally, it is noteworthy that, whatever protection copyright law offers, it is offered solely to the holder of the copyright. This may or may not be the creator of the copyrighted work. An artist may, because of an inequality of bargaining power or for any other reason, contract away the copyright with the sale of the work.[29] Moreover, if the work is characterized as a "work made for hire,"[30] the copyright to such work is never in the possession of the artist, even though he may be the sole creator of the work.[31] Thus, it is evident that copyright law falls far short of the high-water mark established by the doctrine of moral right as regards the protection of the artist against plagiarism.

UNFAIR COMPETITION

In the United States, an artist stands a much better chance of prohibiting the attribution of his work to a third person if he employs the legal theory of unfair competition. This is true despite the fact that such a theory is directed at protecting the artist's pecuniary interest rather than his personal interest.[32]

In *Fisher v. Star Co.*,[33] the Court of Appeals of New York enjoined the use of plaintiff's characters, Mutt and Jeff, in a comic strip drawn by defendant's employees, based on a

[29] This issue is explored in greater detail at notes 64–67 *infra* and accompanying text.

[30] The Copyright Act of 1976, 17 U.S.C. § 101 (1976).

[31] Section 201(b) of the Copyright Act states:

> In the case of a work made for hire, the employer or other person for whom the work was prepared is considered the author for purposes of this title, and, unless the parties have expressly agreed otherwise in a written instrument signed by them, owns all of the rights comprised in the copyright.

Id. § 201(b).

[32] *See* Kirby, *An Artist's Personal Rights in His Creative Works: Beyond the Human Cannonball and the Flying Circus*, 9 PAC. L. J. 855, 871 (1978).

[33] 231 N.Y. 414, 132 N.E. 133, *cert. denied*, 257 U.S. 654 (1921).

theory of unfair competition. Although the plaintiff was the creator of the comic strip characters, he held no copyright in the comic strips and no trademark for the characters. Still, the court concluded that "[n]o person should be permitted to pass off as his own the thoughts and works of another."[34] The court did not openly recognize, however, the plaintiff's personal as distinguished from economic interest in the characters. Rather, the court emphasized the possibility of "financial damage" that the plaintiff might suffer if the defendant's practice of wholesale imitation was not enjoined.[35] Nevertheless, the outcome of the decision was that the plaintiff received treatment analogous to what he would have received under the moral rights doctrine.

The plaintiff in *Harris v. Twentieth Century-Fox Film Corp.*[36] was not so fortunate. In that case, the plaintiff contracted away all right, title, and interest, including expressly any moral rights, which she possessed in the screenplay she had written.[37] The court held that, even though the defendant gave total credit for the finished screenplay to one with whom the plaintiff had collaborated, she could not be heard to complain.[38]

The *Harris* case illustrates that, even under a theory of unfair competition, an artist will not be protected from himself; *viz.*, he will still be permitted to contract away his paternity right. Yet, as the *Fisher* decision demonstrates, an artist is not altogether without relief from unauthorized copying of his work. In sum, unfair competition appears to be an effective, although not foolproof, cognate to the aspect of the paternity right that protects the artist from attribution of his work to another.

[34] *Id.* at 433, 132 N.E. at 139.
[35] *Id.*
[36] 43 F. Supp. 119 (S.D.N.Y. 1942).
[37] *Id.* at 120 n.1.
[38] *Id.* at 121.

THE RIGHT OF THE ARTIST TO REQUIRE THAT HIS PATERNITY BE RECOGNIZED

The moral right doctrine instructs that "the author may demand the affixation of his name to his work."[39] Yet, in the United States, the artist is accorded no such innate right. Rather, the general rule is that "[a]bsent an appropriate contractual provision, an author who sells or licenses his work does not have an inherent right to be credited as the author of the work."[40] This requirement that an artist's right to credit must be reserved expressly by contract has been criticized by those who advocate adoption of the plenary protection afforded artists under the moral right doctrine.[41]

Two principal legal theories have been alleged at trial and one other has been proposed by a legal commentator as a basis in American law for ensuring that an artist's paternity is recognized. The two that have received judicial consideration are breach of contract and breach of implied contract;[42] the proposed theory is the right of publicity.[43] Before examining these theories in detail, it should be noted in passing that it is hornbook law that federal copyright law provides no remedy for the failure to attribute an author's name to his work.[44]

[39] 1 S. LADAS, *supra* note 4, at 585 § 280; *accord*, Sarraute, *supra* note 5, at 478.

[40] M. NIMMER, *supra* note 2, at § 8.21[E]; *accord*, Kirby, *supra* note 32, at 863; Comment, *Toward Artistic Integrity: Implementing Moral Right Through Extension of Existing American Legal Doctrines* 60 GEO. L. J. 1539, 1541 (1972). *But cf.* CAL. GOV'T CODE § 15813.5(a)(I) (West Supp. 1979) (granting to creators of works of visual art in state buildings the right to claim recognition of their works).

[41] *See, e.g.*, Kirby, *supra* note 32, at 863 ("The analogy to moral right is at its weakest here since an inherent right to credit is not recognized in the United States").

[42] *See* Devlin, *supra* note 10, at 512.

[43] *See* Comment, GEO. L. J., *supra* note 40, at 1545–47.

[44] Note, *An Author's Artistic Reputation Under the Copyright Act of 1976*, 92 HARV. L. REV. 1490, 1505–06 (1979).

BREACH OF CONTRACT

A provision in a contract that requires the purchaser of a work of art to credit the artist with its creation will be enforced in a court of law.[45] Such was the case in *Lake v. Universal Pictures Co.*[46] The author in that case had the foresight and bargaining power to reserve expressly in the contract the right to be given credit as author, if the purchaser caused the plaintiff's story to be published in book or magazine form.[47] When the story was subsequently published in a magazine without the plaintiff's bargained-for credit, he brought an action for breach of contract. The court entered judgment for the plaintiff[48] and thus confirmed that an artist may protect this aspect of his paternity right via contract.

A more troublesome decision is the oft-cited and oft-quoted *Clemens v. Press Publishing Co.*[49] While the facts on which this decision is premised were not completely developed by the court, it appears that the plaintiff sold a manuscript to the defendant who thereupon sought to publish it in its newspaper publication without giving credit to the plaintiff.[50] When the plaintiff objected, the issue was brought before the court. The majority of the court decided in favor of the defendant:

> Title to the manuscript having passed by the completed contract made on August 3, 1909, the defendant was not obligated to publish it at all, *nor could plaintiff compel or prevent its publication, with or without his name.* The objections, refusals, and wishes of the plaintiff after parting with the title in the property . . . have no greater weight in law than the wishes of a stranger to the transaction after it was consummated.[51]

[45] DeBekker v. Stokes, 168 A.D. 452, 153 N.Y.S. 1066 (1915), *modified in part*, 172 A.D. 960, 157 N.Y.S. 576, *aff'd mem.*, 219 N.Y. 573, 114 N.E. 1064 (1916); *see* Zorich v. Petroff, 152 Cal. App. 2d 806, 313 P.2d 118 (1957).

[46] 95 F. Supp. 768 (S.D.Cal. 1950).

[47] *Id.* at 769.

[48] *Id.* at 771.

[49] 67 Misc. 183, 122 N.Y.S. 206 (Sup. Ct. 1910).

[50] *Id.* at 185, 122 N.Y.S. at 206–07.

[51] *Id.* at 185, 122 N.Y.S. at 207 (emphasis supplied).

But the case derives its notoriety, not from its holding, but from the concurring opinion written by Judge Seabury. He apparently considered that there was a negative inference in the contract that implied that the right to require the recognition of paternity was retained by the author unless specifically contracted away. Judge Seabury reasoned as follows:

> Even the matter-of-fact attitude of the law does not require us to consider the sale of the rights to a literary production in the same way that we would consider the sale of a barrel of pork. . . . While an author may write to earn his living, and may sell his literary productions, yet the purchaser, in the absence of a contract which permits him so to do, cannot make as free a use of it as he could of the pork which he purchased.
>
> The rights of the parties are to be determined primarily by the contract which they make, and the interpretation of the contract is for the court. If the intent of the parties was that the defendant should purchase the rights to the literary property and publish it, the author is entitled, not only to be paid for his work, but to have it published in the manner in which he wrote it. The purchaser cannot garble it, or put it out under another name than the author's; nor can he omit altogether the name of the author, unless his contract with the latter permits him so to do.[52]

It is generally agreed that Judge Seabury incorrectly stated the law with regard to interpretation of such a contract.[53] Professor Nimmer kindly characterizes the above-quoted passage as "persuasive," but nonetheless "misleading."[54]

The issue of the right to require that an artist's paternity be recognized was specifically addressed by the Seventh Circuit in *Vargas v. Esquire, Inc.*[55] The plaintiff was a well-known artist who sued to enjoin the production of drawings made by him for the defendant, a magazine publisher, under a contract to regularly produce drawings for the magazine.[56] The draw-

[52] *Id.* at 183–184, 122 N.Y.S. at 207–08.
[53] *See* notes 68–70 and accompanying text *infra*.
[54] M. NIMMER, *supra* note 2, at § 8.21[E].
[55] 164 F.2d 522 (7th Cir. 1947).
[56] *Id.* at 523–24.

ings at issue were used by the defendant without any credit being given to the plaintiff, although it had been an ongoing practice for several years for the defendant to credit such drawings to the plaintiff.[57] After expressly rejecting the plaintiff's assertion that the moral right doctrine controlled the issue,[58] the Seventh Circuit concluded that Vargas had, "by plain and unambiguous language completely divested himself of every vestige of title and ownership of the pictures, as well as the right to their possession, control and use."[59] Having contracted away all his rights, the plaintiff could not be heard to complain and judgment was entered in favor of the defendant.[60]

The ineluctable implication of this decision is that unless an artist expressly reserves the right to require that his paternity be recognized, he will be deemed to have waived any such right.[61] Professor Katz has decried the *Vargas* decision as "judicial abdication most foul."[62] A more recent commentator suggests that the harshness of such a strict contractual interpretation may be somewhat attenuated "in light of the trend toward less technical interpretation of contracts where the parties' bargaining power is considered unequal."[63] In any event, *Vargas* is one decision that evinces that the grant of all rights by an artist to a purchaser may be strictly construed and enforced.

One practical problem that must be recognized with any

[57] *Id.*

[58] *Id.* at 526.

[59] *Id.* at 525.

[60] *Id.* at 527; *accord*, Crimi v. Rutgers Presbyterian Church, 194 Misc. 570, 576, 89 N.Y.S. 2d 813, 819 (Sup. Ct. 1949); Harris v. Twentieth Century-Fox Film Corp., 43 F. Supp. 119 (S.D.N.Y. 1942). *But cf.* Harms, Inc. v. Tops Music Enterprises, Inc., of Cal., 160 F. Supp. 77, 83 (S.D.Cal. 1958) ("Courts will protect against (a) the omission of the author's name unless, by contract, the right is given to the publisher to do so . . .").

[61] *See* note 60 *supra*.

[62] Katz, *The Doctrine of Moral Right and American Copyright Law—A Proposal*, 24 S. CAL. L. REV. 375, 412 (1951).

[63] Kirby, *supra* note 32, at 864.

reliance on a contract to protect an artist's paternity right is the reality that the artist rarely enjoys bargaining power equal to that of the purchaser of his work. "The author's bargaining position is inherently weaker in the vast majority of cases, not only because he often negotiates with commercial giants, but also because he is selling a commodity the value of which is not ascertainable until after exploitation.[64] Moreover, most artists do not routinely execute a formal written agreement of any kind upon the sale of their work and, in any event, such an agreement would not necessarily be binding on subsequent purchasers of the work.[65]

One proposed solution to the artist's predicament is to develop a rule of construction whereby a presumption is created that an artist retains any rights not expressly surrendered by contract.[66] Yet even such a presumption would not aid an artist if he truly lacks effective bargaining power. Rather, those purchasers of works of art who enjoy economic leverage would simply devise form contracts whereby artists would expressly surrender their paternity rights.[67]

BREACH OF IMPLIED CONTRACT

It has been asserted that, in the United States, the artist's right to claim paternity could be "protected under a theory of an implied-in-law contract that whoever uses an artist's work shall also use his name."[68] While this may be an appealing hypothesis, it is without precedential support. Indeed, just such a theory was asseverated by the artist in *Vargas*[69]

[64] Comment, GEO. L. J., *supra* note 40, at 1560; *accord*, Comment, *Protection of Artistic Integrity: Gilliam v. American Broadcasting Companies*, 90 HARV. L REV. 473, 478 (1976); Merryman, *The Refrigerator of Bernard Buffet*, 27 HASTINGS L.J. 1023, 1043 (1976).

[65] Merryman, *supra* note 64, at 1043.

[66] Comment, HARV. L. REV., *supra* note 64, at 480; Kirby, *supra* note 32, at 887.

[67] *See, e.g.*, Harris v. Twentieth Century-Fox Film Corp., 43 F. Supp. 119 (S.D.N.Y. 1942).

[68] Devlin, *supra* note 10, at 512.

[69] *See* notes 55–60 and accompanying text *supra*.

and was completely rejected by the court.[70] Since the courts have, at least to date, been reluctant to read implied conditions into contracts, such a legal theory is unlikely to provide an artist with any rights that are not expressly reserved to him by contract.

RIGHT TO PUBLICITY

One final, rather novel legal theory has been suggested as a basis for ensuring an artist's right to claim paternity. It has been suggested that the present right to publicity could be expanded so as to encompass the right of an artist to develop a reputation.[71] Specifically, this expanded right to publicity would provide an artist with a legal theory with which to guard against the omission of formal recognition that he was the creator of a particular work. The rationale for such an expansion is stated in the form of a rhetorical question: "If appropriation of an already valuable name is considered an actionable wrong, should not the right to publicity also include the author's right to prohibit another from restraining growth of his reputation by exploiting his work without giving him authorship credit?[72] No court in any reported decision has had occasion to rule on this theory.

It is doubtful that such a theory would meet with any degree of success. In reply to the rhetorical question posed, it should be noted that a major distinction can be drawn between fact patterns involving appropriation or false attribution and those involving the affirmative right to claim paternity. False attribution actions are distinguishable because the artist in such cases has not granted to a third party by contract the right to attach the artist's name to work that the artist did not

[70] *Id.* Similarly, an averment that an artist retained the right of integrity as a consequence of an implied-in-fact condition in a contract was rejected by the court in Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 339–40 n.5 (S.D.N.Y. 1968).

[71] Comment, GEO. L. J., *supra* note 40, at 1546–47.

[72] *Id.* at 1546.

in fact create. In the decisions involving the right to claim paternity, the artist has invariably bargained away his rights to the defendant. This is a critical difference.

Moreover, it would be extremely difficult to quantify the damages sustained by an artist as a result of a purchaser's failure to proclaim to the world that a particular piece of work was created by the artist.[73] This could prove to be a formidable obstacle to judicial acceptance of such a novel doctrine.

To briefly summarize the issue of an artist's right to claim paternity, there is a great chasm between the patronage an artist would receive under the doctrine of moral rights and the scant protection that same artist would enjoy by virtue of the American jurisprudential analogues to that doctrine. The fundamental weakness of American law lies in the fact that an artist may contract away his paternity right. This is especially debilitating when one considers the inequality of bargaining power that exists between most artists and the principal purchasers of their works.

THE RIGHT OF AN ARTIST TO HAVE HIS "NOM DE PLUME" RESPECTED

Under the doctrine of moral right, "if the author does not desire to reveal his true name, his pseudonym or anonymity must be respected."[74] Unfortunately, the same is not necessarily true in the United States. Although this particular aspect of the paternity right has not been the subject of much litigation, it is evident that no true analogue to this right exists in American jurisprudence. This statement is made notwithstanding that certain others who have reviewed this sub-

[73] The problem of proving compensable injury is not to be dismissed lightly. In Zorich v. Petroff, 152 Cal. App. 2d 806, 313 P.2d 118, 122 (1957), even though the court found that the plaintiff was entitled by contract to screen credit, the plaintiff was awarded no damages for the failure to properly credit plaintiff since the film was a financial failure.

[74] 1. S. LADAS, *supra* note 4, at 585 § 280; *accord*, Devlin, *supra* note 10, at 512.

ject have reached the opposite conclusion, finding that an artist is protected on a theory of right of privacy.[75] The difference of opinion is due principally to a misplaced reliance by these others on a decision that was rendered nugatory by subsequent litigation between the same parties.[76]

Before discussing the controversial decision, however, the case of *Clemens v. Belford, Clark & Co.*[77] merits analysis. At issue in this litigation were certain uncopyrighted stories written by Samuel Clemens under the well-known *nom de plume* of Mark Twain.[78] Clemens attempted to prevent a reprint publisher from using his pseudonym in connection with these stories. The court ruled that, in the absence of copyright, the defendant could use either an author's true name or his pen name even though the work was originally written under a *nom de plume*.[79]

In 1910, when the court first heard the case of *Ellis v. Hurst*,[80] it appeared that the rule established in *Belford, Clark* was to be set aside. The facts of *Ellis* are as follows: The plaintiff was a writer who early in his career had published certain works under a pseudonym. Afterward, the plaintiff began to publish using his real name. The litigation arose when the defendant republished the plaintiff's older works, only this time under the plaintiff's real name. The plaintiff brought an action based on the then newly enacted New York statutory right of privacy.[81] The court granted the plaintiff the temporary injunction that he sought, distinguishing *Belford, Clark* on the basis that no statutory right of pri-

[75] *See* Devlin, *supra* note 10, at 512; Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Creators, and Authors*, 53 HARV. L. REV. 554, 562 (1940); Stevenson, *Moral Right and the Common Law: A Proposal* 6 ASCAP COPYRIGHT L. SYMP. 89, 99 (1953).

[76] *See* notes 84–86 and accompanying text *infra*.

[77] 14 F. 728 C.C.N.D. Ill. (1883).

[78] *Id.* at 730.

[79] *Id.* at 732.

[80] 66 Misc. 235, 121 N.Y.S. 438 (Sup. Ct. 1910).

[81] *Id.* at 236, 121 N.Y.S. at 439.

vacy was therein involved.[82] This is the reported decision of *Ellis* (hereafter referred to as *Ellis* I), which the above-mentioned commentators have relied on as evidence that the artist's *nom de plume* is entitled to respect under the laws of the United States.[83]

There can be no argument that this is an accurate interpretation of that decision. The error lies, however, in the fact that the ensuing litigation regarding this matter has been omitted from the discussions of the mentioned commentators. Later that same year, the plaintiff brought an action to permanently enjoin the publication and sale of the identical books by the defendant, which action will hereafter be referred to as *Ellis* II.[84] At the trial on the merits, the court found for the defendants, concluding that they had "published a truthful statement." [85]

> In the case at bar the defendants concededly had the right to publish the books in suit with the *nom de plume* of plaintiff, and this right carried with it the right to state the true "name of the author in such form in the book, either upon the title page or otherwise, as to show who was the writer or author thereof." [citing *Belford, Clark*].[86]

Thus, while the court in *Ellis* I distinguished *Belford, Clark*, in *Ellis* II the court cited this same decision as support for its holding. Clearly the precedential value of *Ellis* I has been wholly vitiated by the subsequent ruling of *Ellis* II.

In no instance has an artist in the United States sought, and ultimately received, relief from a defendant who republished the artist's work using his real name, when that work was originally published under the artist's pseudonym. Still, it is not inconceivable that with the proper facts an artist could

[82] *Id* at 237, 121 N.Y.S. at 440.

[83] *See* note 75 *supra*.

[84] Ellis v. Hurst, 70 Misc. 122, 128 N.Y.S. 144 (Sup. Ct. 1910), *aff'd mem.*, 145 A.D. 918, 130 N.Y.S. 1110 (1911).

[85] *Id.* at 125, 128 N.Y.S. at 146.

[86] *Id.*, 128 N.Y.S. 146, citing Clemens v. Belford, Clark & Co., 14 F. 728, 730 (C.C.N.D. Ill. 1883).

fashion a successful argument for demanding respect of his pseudonym, predicated on a theory of invasion of his right to privacy. But this particular theory is replete with pitfalls for one who seeks to use it to protect his artistic rights of personality. These pitfalls are treated in detail later in this paper as they arise in the context of false attribution litigation.[87] One shortcoming of a legal theory based on the right of privacy, however, warrants consideration here, for it pertains directly to the use of a pseudonym by an artist. Certain statutory rights of privacy, such as that codified in New York,[88] expressly exclude protection of an assumed name. Therefore, if an artist was to first create under his true name and then adopt a pseudonym, a third party could republish the earlier works under the pseudonym with statutory impunity.[89]

In sum, an action by an artist for an invasion of his right of privacy is a grossly inadequate expedient for ensuring that his *nom de plume* is respected. This putative analogue to the moral right doctrine provides at best a glimmer of the protection guaranteed by the *droit moral.*

THE RIGHT OF THE ARTIST TO AVOID BEING NAMED AS THE CREATOR OF WORK THAT IS NOT HIS OWN

The doctrine of moral right straightforwardly stipulates that an artist "may prevent his name's association with a work he did not create."[90] As early as 1883, an analogous juristic principle was recognized in the United States.[91]

> No person has the right to hold another out to the world as the author of literary matter which he never wrote; . . . no one has the right,

[87] *See* notes 103–6 and accompanying text *infra.*

[88] N.Y. Civ. Rights Law §§ 50–51 (McKinney 1976).

[89] *See* Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 356 (S.D.N.Y. 1968) ("The Court holds that the name 'Dr. Seuss' is an assumed name or pseudonym rather than a surname and is, therefore, not a protectible 'name' within the meaning of Section 51 of the New York Civil Rights Law").

[90] Comment, Geo. L. J., *supra* note 40, at 1540; *accord,* 1 S. Ladas, *supra* note 4, at 585, § 280.

[91] Clemens v. Belford, Clark & Co., 14 F. 728 (C.C.N.D. Ill. 1883).

either expressly or by implication, falsely or untruly to charge another with the composition or authorship of a literary production which he did not write.[92]

Since that early decision, however, the right of an artist to prohibit false attribution of his name to the work of another has been the subject of much litigation in the United States. This case law has not proceeded in any orderly fashion to safeguard the artist from false attribution. Rather, these decisions have traveled divergent paths, with the unfortunate consequence that not all travelers have ultimately arrived at the same destination.

This vast body of false attribution litigation has generated no less than four distinct potential legal theories for relief.[93] They are as follows: (1) invasion of right of privacy, (2) defamation, (3) unfair competition, and (4) breach of contract.[94] In order to demonstrate the veritable morass that an American artist confronts in this area, each of these theories is analyzed individually and in detail.

Before undertaking a discussion of these legal theories, it is important to note the conspicuous absence of any theory predicated on copyright infringement. The 1976 Copyright Act, as its predecessor statutes did, simply furnishes no remedy for the false attribution of an artist's name to another's work.[95] This is so because "copyright protects the disposition of an author's work, but not of his name."[96] This serves as further evidence of the restricted scope of existing copyright legislation in the United States.[97]

[92] *Id.* at 731.

[93] 2 M. NIMMER, *supra* note 2, at § 8.21[D].

[94] *Id.*

[95] Note, *supra* note 44, at 1505–06. *See generally* 2 M. NIMMER, *supra* note 2, at § 8.21[D][2].

[96] Note, *supra* note 44, at 1513.

[97] *Cf.* Law of Germany, Copyright Law of September 9, 1965, arts. 12–14, *reprinted in* 1 J. MERRYMAN & A. ELSEN, *supra*, note 1, at 4–5, 4–6 (moral rights expressly incorporated in statutory copyright).

INVASION OF RIGHT OF PRIVACY

The right of privacy was first used by an author to prevent the false attribution of his name to the work of another in *Eliot v. Jones*.[98] The defendant in that case had used Eliot's name (at the time Eliot was the president of Harvard University) to advertise a set of ten volumes of books that the defendant had published. The court found that Eliot was in no way associated with the defendant's publication and, therefore, enjoined the defendant from using the plaintiff's name to advertise the books.[99]

More recently, the allegation of invasion of one's right of privacy was successfully argued in *Kerby v. Hal Roach Studios*.[100] In *Kerby*, the defendant distributed an advertising letter purportedly signed by the plaintiff in the form of an invitation to a movie premiere. This unauthorized letter was designed specifically to appeal to the prurient interest of the recipients. The court had no difficulty in finding defendant guilty of an invasion of the plaintiff's right of privacy.[101]

As these two decisions indicate, an artist may be protected from false attribution of his name to another's work by virtue of his right to privacy.[102] Yet this legal theory is not without its shortcomings. For example, it is well settled that an action for invasion of privacy, "does not survive the death of the person whose right was violated."[103] This is a significant limitation on the protection accorded an artist's reputational interest.

Moreover, as with other tort remedies, the applicability of

[98] 66 Misc. 95, 120 N.Y.S. 989, *aff'd*, 140 A.D. 911, 125 N.Y.S. 1119 (Sup. Ct. 1910).

[99] *Id.* at 100, 120 N.Y.S. at 990.

[100] 53 Cal. App. 2d 207, 127 P.2d 577 (1942).

[101] *Id.* at 210, 127 P.2d at 579–80.

[102] *Contra*, Geisel v. Poynter Prods., Inc., 295 F. Supp. 331 (S.D.N.Y. 1968); Yameta Co. v. Capitol Records, Inc., 279 F. Supp. 582 (S.D.N.Y.), *rev'd on other grounds*, 393 F.2d 91 (2d Cir. 1968).

[103] COMMENT, GEO. L. J., *supra* note 40, at 1549 n.59.

the right of privacy may be limited in particular cases by technical common law prerequisites.[104] One such prerequisite that could prove problematical is the requirement that an artist must first have a reputation to protect before an actionable invasion of privacy will be found.[105] This requirement, if observed, places young and inexperienced artists squarely on the horns of a dilemma. Such artists find themselves in an unenviable position—unable to protect their professional honor and integrity because they have not developed reputations, yet unable to develop reputations because they cannot protect their professional honor and integrity.[106]

Still, despite these flaws, it cannot be gainsaid that the right of privacy has in the past provided authors with a viable cause of action to prevent specific false attributions. Moreover, with certain limitations, this legal theory has retained its vitality. But *quaere* the uniformity of such protection as applied on a state-by-state basis.

DEFAMATION

The suggestion has been made that an artist in the United States is shielded from false attribution, "on the theory that it is a libel to attribute to an artist work which is not his product."[107] The analysis that follows establishes that this statement will not bear up under scrutiny.

In *Ben-Oliel v. Press Publishing Co.*,[108] the plaintiff success-

[104] *See* Comment, HARV. L. REV., *supra* note 64, at 478.

[105] *Cf.* Clemens v. Belford, Clark & Co., 14 F. 728, 731 (C.C.N.D. Ill. 1883) ("So, too, an author of acquired reputation, *and, perhaps, a person who has not obtained any standing before the public as a writer,* may restrain another from the publication of literary matter purporting to have been written by him, but which, in fact, was never so written." (emphasis supplied)).

[106] *See* Comment, GEO. L. J., *supra* note 40, at 1550.

[107] Devlin, *supra* note 10, at 512. Devlin proposes, in addition, an alternative theory predicated on unfair competition. It is his contention that, based on these two legal theories, "the law in the United States could afford the artist substantially the same protection he would have under this section of the doctrine of moral rights." *Id.*

[108] 251 N.Y. 250, 167 N.E. 432 (1929).

fully brought an action for libel to redress the false attribution of another's work to her.[109] The defendant had published an article in a newspaper that was falsely attributed to the plaintiff. The article concerned life in Palestine under Mosaic law, a subject in which the plaintiff was reputed to be an expert. The thrust of the plaintiff's complaint was that she had suffered compensable injury as a direct result of the manifold gross errors that the news article contained since these errors had been falsely attributed to her.[110] The court agreed:

> In order to constitute a libel, it is not necessary for the defendant in its paper to directly attack the plaintiff as an ignorant imposter. The same result is accomplished by putting in her mouth or attaching to her pen words which make self-revelation of such a fact.[111]

Thus, the court accepted the plaintiff's libel theory and reversed the lower court judgment that had dismissed the plaintiff's complaint.[112]

A similar holding was obtained in 1960 when a lawyer who had authored a legal practice manual objected to the attribution to him of annual supplements to that manual.[113] In fact, the supplements had been prepared by employees of the defendant. The plaintiff brought an action in libel alleging that the supplements were so poorly written and contained such errors that the attribution of such writings to him caused him to suffer disgrace and humiliation.[114] The court, citing the *Ben-Oliel* decision, agreed[115] that the plaintiff's complaint stated a cause of action in libel.[116]

At first glance it might appear that libel constitutes a valid American law analogue to the component of the moral right

[109] *Id.* at 256, 167 N.E. at 434.
[110] *Id.* at 254–55, 167 N.E. at 433.
[111] *Id.* at 255, 167 N.E. at 433–34.
[112] *Id.* at 256, 167 N.E. at 434.
[113] Clevenger v. Baker Voorhis & Co., 8 N.Y. 2d 187, 168 N.E. 2d 643 (1960).
[114] *Id.* at 189, 168 N.E. 2d at 644.
[115] *See* notes 108–112 and accompanying text *supra*.
[116] Clevenger v. Baker Voorhis & Co., 8 N.Y. 2d 187, 190, 168 N.E. 2d 643, 645.

doctrine that provides that an artist not be named the creator of work that is not his product. Such validity is merely superficial, however, and will not endure close examination.

The drawbacks to any reliance on a libel theory to safeguard this important component of the artist's reputational interest are many and varied. As noted in the preceding discussion of the viability of a right of privacy action,[117] the applicability of a tort remedy (such as defamation) may be limited in certain instances by the technical requirements of the common law action. Similarly, an action in libel does not survive the death of the one who was defamed.[118] Moreover, "the author must be sufficiently well-known to have a reputation before he can be libeled."[119] Thus, the extent of protection accorded an aspiring artist under a libel theory is severely restricted.

A further limitation on the efficacy of an action in libel in this context is that "the injunctive relief crucial to protecting the artist's personal rights is discouraged in libel actions."[120] Some commentators have gone so far as to state categorically that an injunction to halt the defamatory publication will not issue for restraint of a personal libel.[121] This is a critical deficiency.

Another potential barrier to a successful action for libel is the plaintiff's ability to prove special damages. In the past, courts have required that to prevail on a defamation theory an artist must demonstrate special damages.[122] Moreover,

[117] *See* notes 103–06 and accompanying text *supra*.

[118] Diamond, *supra* note 9, at 264.

[119] *Id.* at 265.

[120] Comment, HARV. L. REV., *supra* note 64, at 479.

[121] Diamond, *supra* note 9, at 264; Comment, *Moral Rights for Artists Under the Lanham Act: Gilliam v. American Broadcasting Co.* 18 WM. & MARY L. REV. 595, 601 (1977).

[122] Locke v. Gibbons, 164 Misc. 877, 299 N.Y.S. 188 (Sup. Ct. 1937), *aff'd mem.*, 253 A.D. 887, 2 N.Y.S. 2d 1015 (1938); Booth v. Colgate-Palmolive Co., 362 F. Supp. 343 (S.D.N.Y. 1973); Comment, WM. & MARY L. REV., *supra* note 121, at 601. *Contra*, Ben-Oliel v. Press Publishing Co., 251 N.Y. 250, 255–56, 167 N.E. 432, 434 (1929).

since it is the artist's reputational interest that is at stake here, if the artist cannot show harm to his reputation or if perchance his reputation has been enhanced by the false attribution, then the artist may be held to have proved himself out of court.[123]

The ability of an artist to vindicate his paternity interests through a common law libel action has probably been most acutely attenuated by the recent Supreme Court decisions[124] that limit the use of such an action when the plaintiff can be characterized as a "public figure."[125] In fact, the development of a different standard of treatment for public figures may sound the death knoll for the use of a libel action by an artist to prevent false attribution of his name to another's creation.

> No false attribution libel cases appear to have been decided more recently than 1960. Since then, still another formidable obstacle has been erected to the use of libel law as a basis for enforcing moral rights. A libel plaintiff who is a "public figure" must meet difficult standards of proof of malice in order to succeed, under Times v. Sullivan and succeeding cases.
>
> . . . It is hardly likely that any author seeking to enforce his moral rights in an action for libel would fail to qualify as a public figure, and it therefore would be necessary for the author to meet the strict standards of Times v. Sullivan, i.e., to prove that the libel was published with actual knowledge of its falsity or with reckless disregard of whether or not it was false.[126]

While the ultimate effect of *Times v. Sullivan* and its progeny has not been fully determined, one thing is certain: it has not made it any easier for an artist to bring a libel action.

[123] Kirby, *supra* note 32, at 872; *see* Zorich v. Petroff, 152 Cal. App. 2d 806, 313 P.2d 118, 122 (1957).

[124] Time, Inc. v. Firestone, 424 U.S. 448 (1976); Gertz v. Robert Welch, Inc., 418 U.S. 323 (1974); Rosenbloom v. Metromedia, Inc., 403 U.S. 29 (1971); Curtis Publishing Co. v. Butts, 388 U.S. 130 (1967); New York Times Co. v. Sullivan, 376 U.S. 254 (1964).

[125] Comment, *The Monty Python Litigation—of Moral Right and the Lanham Act*, 125 U. PA. L. REV. 611, 617 n.29 (1977).

[126] Diamond, *supra* note 9, at 265.

Though defamation may have been a persuasive legal theory for the preservation of an artist's paternity rights in the past, its present efficacy is quite suspect. As explained above, in order to bring an action in libel, an artist must be sufficiently well known to have developed a reputation.[127] Yet recent Supreme Court pronouncements indicate that if the artist is sufficiently well known to be characterized as a public figure, then he will be required to satisfy standards so difficult as to effectively foreclose libel as a realistic remedy.[128] Even if a navigable courseway remains between these two coral reefs, such a track is beset by procedural, technical, and remedial shoals. Thus, the remedy of an action in libel is readily distinguishable from the protection against false attribution to which an artist is entitled under the moral right doctrine.[129]

UNFAIR COMPETITION

Actions based on a theory of violation of state unfair competition laws have, on occasion, been successfully used to prohibit the attribution of an artist's name to the work on another. Similar actions brought by artists under the Lanham Act,[130] the federal counterpart to state unfair competition statutes, have also met with limited success.

In *Prouty v. National Broadcasting Co.*,[131] the court accepted the artist's allegation of a violation of unfair competition law as grounds for prohibiting the defendant from

[127] *See* note 119 and accompanying text *supra*.

[128] *See* notes 124–26 and accompanying text *supra*.

[129] *See* 1 S. LADAS, *supra* note 4, at 585–86, § 280.

[130] Lanham Trade-Mark Act of 1946, ch. 540, 60 Stat. 427 (codified in scattered sections of 15 U.S.C.). Section 43(a) of this Act provides:

> Any person who shall affix, apply, or annex, or use in connection with any goods or services, . . . a false designation of origin, or any false description or representation . . . and shall cause such goods or services to enter into commerce . . . shall be liable to a civil action by any person . . . who believes that he is or is likely to be damaged by the use of any such false description or representation.

15 U.S.C. § 1125(a) (1970).

[131] 26 F. Supp. 265 (D. Mass. 1939).

pirating the well-recognized name of a character created by the artist. The court ruled that "unfair competition is only a convenient name for the doctrine that no one should be allowed to sell his goods as those of another."[132] This case demonstrates that an allegation of unfair competition under state law may offer an artist some relief from certain types of false attribution.

State unfair competition laws have seldom, however, been resorted to since the enactment of the Lanham Act. This Act has become the primary implement of American jurisprudence with which artists in the United States have achieved protection analogous to that of the moral right doctrine.[133] The key to the successful application of the Lanham Act to the protection of such disparate interests as trademark, paternity, and integrity rights has been the broad scope that the judiciary has lavished upon it.[134] The rationale for such an expansive reading of the statute has been that this is dictated by its remedial character.[135]

One example of the use of the Lanham Act to prevent a false, or at least misleading, attribution of an artist's name to the work of another is the case of *Yameta Co. v. Capital Records, Inc.*[136] At issue in *Yameta* was a phonograph record whose cover created the false impression that Jimi Hendrix was the principal performer and singer thereon. In fact, the record had been made before Hendrix had become popular

[132] *Id.* at 266 *quoting* Vogue Co. v. Thompson-Hudson Co., 300 F. 509 (6th Cir. 1924).

[133] *See* Gilliam v. American Broadcasting Cos., 538 F.2d 14 (2d Cir. 1976); Yameta Co. v. Capitol Records, Inc., 279 F. Supp. 582 (S.D.N.Y.), *rev'd on other grounds*, 393 F.2d 91 (2d Cir. 1968); Rich v. RCA Corp., 390 F. Supp. 530 (S.D.N.Y. 1975); Geisel v. Poynter Prods., Inc., 295 F. Supp. 331 (S.D.N.Y. 1968). The Lanham Act has been especially beneficial with regard to the right of an artist to see that the integrity of his work is respected.

[134] *See* cases cited in note 130 *supra*; Comment, WM. & MARY L. REV., *supra* note 121, at 604.

[135] Geisel v. Poynter Prods., Inc., 283 F. Supp. 261, 267 (S.D.N.Y. 1968).

[136] 279 F. Supp. 582 (S.D.N.Y.), *rev'd on other grounds*, 393 F.2d 91 (2d Cir. 1968).

and his contribution to the album was strictly limited to musical accompaniment for another vocalist. Hendrix asseverated four legal theories of recovery: (1) Lanham Act, (2) breach of contract, (3) unfair competition, and (4) invasion of privacy.[137] Remarking that the scope of the Lanham Act had become "quite extensive" in the last decade,[138] the court entered judgment for plaintiff on that theory.[139] All other theories were expressly rejected.[140] This decision illustrates the elasticity of the Lanham Act, a characteristic that has on occasion made it appropriate for resolving issues akin to moral rights.

The Lanham Act is not without its drawbacks, however, and these seriously undermine its effectiveness as a guardian of an artist's moral rights. The fundamental drawback is the inappropriateness of the use of a federal trademark statute to protect an artist's personality interest. The Lanham Act is designed to maintain one's business reputation, not to ensure one's personal or emotional interest in a work of art.[141] Thus, it has been held that as one requirement of a Lanham Act violation, the plaintiff must show "direct injury to [his] property rights."[142] Since the focus of this Act is on the redress of economic injury to one's property rights, it is evident that the Act protects an artist's personal rights only tangentially.

Another limitation on the applicability of the Lanham Act is that it safeguards an artist's name only if and when that name is publicly recognized.[143] "Section 34(a) [of the Lanham Act] can apply only where artists' names have acquired substantial public recognition. . . . For that reason, the Lan-

[137] *Id.* at 584.
[138] *Id.* at 586.
[139] *Id.* at 587.
[140] *Id.* at 585–87.
[141] Kirby, *supra* note 32, at 875 ("Since business reputation is only a reflection of sales potential, and not a repository of plaintiff's personal or emotional interest, the use of a trademark statute to protect such an interest seems inappropriate").
[142] Chamberlain v. Columbia Pictures Corp., 186 F.2d 923, 925 (9th Cir. 1951).
[143] Comment, *Monty Python and the Lanham Act: In Search of the Moral Right*, 30 RUTGERS U. L. REV. 452, 476 (1977).

ham Act 'is of no help to the unknown artist.'"[144] This threshold requisite places the unknown artist at a tremendous disadvantage. He is denied protection under the Act because his name lacks public recognition; yet without this protection it may be impossible for him to attain any public recognition.

One final failing of the use of either unfair competition or the Lanham Act to police false attributions is that distinctive and accurate labeling by the defendant may bar recovery upon such theories.[145] If, instead of unqualifiedly attaching an artist's name to the work of another, a defendant states accurately that the work in question was "derived from," "based on," "inspired by," or "suggested by" the plaintiff's work, liability will not necessarily attach.[146] "[U]nfair competition cases have considered a disclaimer, or other distinctive labeling, adequate to protect the plaintiff's business interest in his creative works."[147] Thus, where defendant manufactured a toy doll without in any way consulting the plaintiff, yet advertised the doll to be "based on . . . illustrations by" the plaintiff, an action for violation of the Lanham Act was unsuccessful.[148] Yet few would fail to acknowledge the potential blow that the defendant's conduct might strike to the plaintiff's reputation. This serves to further illustrate the intrinsic inaptness of using a statute that focuses on economic harm as a vehicle to redress injury to an artist's reputational interest.

It can be said then that unfair competition and more particularly the Lanham Act endow an artist with protection from false attribution, at least when the artist can demonstrate that he has suffered economic injury as a direct consequence of such attribution. Unfortunately, not every instance of false

[144] Diamond, *supra* note 9, at 268–69, quoting in part from Comment, RUTGERS U. L. REV., *supra* note 143, at 476.

[145] Kirby, *supra* note 32, at 871; *see* Note, *supra* note 44, at 1499 (No action lies where the threat of consumer confusion has been removed by clear labeling).

[146] *See* Geisel v. Poynter Prods., Inc. 295 F. Supp. 331, 353 (S.D.N.Y. 1968).

[147] Kirby, *supra* note 32, at 871.

[148] Geisel v. Poynter Prods., Inc., 295 F. Supp. 331, 353 (S.D.N.Y. 1968).

attribution of an artist's name to the work of another will result in provable economic harm. Thus, while actions for unfair competition under state laws and the Lanham Act offer the American artist some cognizable support in this context, the scope of such actions pales by comparison with the embracing reach of the doctrine of moral right.

BREACH OF CONTRACT

It is possible, although unusual, that the person accused of falsely attributing an artist's name to the work of a third person enjoys a contractual relationship with the artist. In such a case, the artist may be able to quash the false attribution on a theory of breach of contract.

Typically, these cases involve a situation where the defendant contracts with the plaintiff to adapt the plaintiff's work to a different medium. If the adaptation is considered to be unworthy, then the artist could proceed along either of two avenues to obtain legal relief.[149] The artist could choose to bring an action for mutilation, alleging that the integrity of his work has been violated by virtue of the adaptation. In the alternative, the artist could allege that when this grossly distorted version of his work is presented to the public with his name attached to it, the effect is tantamount to a false attribution.[150] The first theory lies outside the scope of this paper and will be left to the scholarly treatment of others.

A classic example of the successful application of the second theory is *Curwood v. Affiliated Distribs.*[151] In *Curwood*, the defendant had acquired from an author, by contract, the right to "select a capable man to elaborate on said story, with addition of characters, etc., however needed. . . ."[152] When the so-called elaboration was completed, and the story had been made into a movie film, little remained of the au-

[149] *See generally* 2 M. NIMMER, *supra* note 2, at § 8.21[D][2].
[150] Diamond, *supra* note 9, at 258.
[151] 283 F. 219 (S.D.N.Y. 1922).
[152] *Id.* at 221.

thor's original story except its title and his name, both of which were emphasized in advertising the film. On these facts, the court enjoined the defendant's further use of either the author's name or the original story title.[153] The court ruled that "elaboration of a story means something other than that the same should be discarded, and its title and authorship applied to a wholly dissimilar tale."[154] The *Curwood* decision is evidence that when a defendant egregiously distorts an artist's work he may be held liable for a breach of contract.

A similar conclusion was reached by the Second Circuit in a case involving a less radical alteration of an artist's work.[155] In *Granz v. Harris*,[156] the defendant converted the original twelve-inch jazz recordings of the plaintiff into ten-inch recordings by deleting several minutes of the plaintiff's music from the original. In an interesting act of contractual interpretation, the court concluded that the contractual duty to attribute the recordings to the plaintiff carried with it, "by implication, without the necessity of an express prohibition, the duty not to sell records which make the required legend a false representation."[157] Thus, the court read into the contract an implied condition not to so alter the recordings as to make attribution thereof to the plaintiff a falsehood.[158]

The manifold failings of an action for breach of contract as a means of ensuring that an artist's paternity rights will be respected have already been discussed in this paper[159] and will not be repeated. One special defect of such a theory in the false attribution domain is the reality that the artist is not

[153] *Id.* at 233.
[154] *Id.* at 222–23.
[155] Granz v. Harris, 198 F.2d 585 (2d Cir. 1952).
[156] *Id.*
[157] *Id.* at 588.
[158] *But cf.* Geisel v. Poynter Prods., Inc. 295 F. Supp. 331, 339–40 n.5 (court rejected the plaintiff's assertion that, "there was a custom or usage in 1932 which *implied in fact* in the agreement a condition that the magazine would not alter or change a drawing." (emphasis by the court)).
[159] *See* notes 60–61 and 64–67 and accompanying text *supra*.

always in the position of having a direct contractual relationship with the individual charged with the false attribution. So, while this theory may provide an occasional artist with an American law rack to hang his paternity rights hat on, it does not even begin to approach the type of plenary protection that the doctrine of moral rights guarantees.

CONCLUSION

A comparison of the American jurisprudential system and the moral rights doctrine as regards the protection of an artist's paternity rights discloses that the differences far outnumber the similarities. There is no single analogue in the United States to the doctrine of moral rights. Moreover, even an amalgamation of all the rights an American artist can muster from every available source is no match for the expansive protection of the moral rights doctrine.

The analogy between American law and the doctrine of moral rights is greatest where the artist asserts his right to prohibit the attribution of his work to a third person. This is not surprising since there are few legal, economic, or social benefits to be derived from plagiarism.

The analogy is weakest with regard to the right of an artist to claim paternity. Unless the artist expressly reserves this right by contract, he will undoubtedly find that the American judiciary will turn a deaf ear to his cries for relief.

The same appears to be true of an artist who attempts to demand that his *nom de plume* be respected. There is, however, such a paucity of precedent on this particular subject, all of which is somewhat dated, that it would be highly speculative to try to characterize the current status of this right in the United States.

Finally, in some middle ground between the above-cited extremes of analogous protection on the one hand and almost contrapositive treatment on the other, lies the right of an art-

ist to prohibit his being named as the creator of work that he did not in fact create. Generally speaking, artists have met with relative success in attempting to assert this right on a variety of legal theories. But the very existence of a multiplicity of legal theories bespeaks the deficiency of the protection accorded artists in the United States. Each theory has its own technical requirements and limitations. Occasionally these theories coincide, furnishing an artist with alternative bases for recovery; all too frequently, however, these theories are not even complementary. In such instances they leave gaping holes in the protection to be afforded the paternity rights of American artists.

Such is the current state of the law. The remedies that have been propounded by legal writers to safeguard the paternity rights of American authors are many and varied. Some have proposed to supplement or amend the present system of protection while others have advocated the introduction of a new and innovative constituent to American jurisprudence.

In the latter category, it has been urged that a personal *sui generis* tort action be created to vindicate an author's moral rights.[160] It is thought that such a cause of action would easily meld into existing law since it "would parallel prior developments in the law protecting aspects of personality and reputation."[161] The fundamental disadvantage of such a solution is its inherent reliance on the independent development of state law. Such a measure could hardly be expected to ensure uniform treatment of authors in all fifty states.

Instead of creating a new cause of action, one legal writer has recommended that special "artists courts" be developed to hear moral rights cases.[162] Evidently, it is believed that a panel of arbiters with special knowledge of artistic and cre-

[160] *See* Roeder, *supra* note 75, at 575–76; Treece, *supra* note 16, at 501 (suggesting a new tort cause of action for mutilating a creative work).

[161] Treece, *supra* note 16, at 501.

[162] Associated Councils of the Arts, the Visual Artist and the Law 43 (1971).

ative matters would be better able to resolve disputes sounding in moral rights. This panel could be composed of respected personalities of the art and literary worlds or of members of the American Arbitration Association.[163] Such a recommendation seems to imply that the present arbiters, the civil court judiciary of America, are somehow incapable of justly resolving moral rights cases. Yet it is error to fault the contemporary judiciary for its doctrinal adherence to *stare decisis*, which in this instance unequivocally states that moral rights are not recognized in the United States. No evidence has yet been adduced that demonstrates the inability or inefficiency of the current juridical system to resolve moral rights issues.

Moreover, the creation of new and specialized courts would not directly address the underlying problem, to wit, a dogmatic reluctance in the United States to give legal recognition to an author's moral rights. The official recognition of such an important right should issue from the legislative quarter. Once moral rights are recognized by the legislature, the present judiciary will be fully competent to decide cases arising thereunder.

Before considering the prospect of such innovative legislation, however, certain other proposed solutions to the moral rights problem are deserving of mention. For example, it has been suggested that an author's moral rights may be protected by simply expanding the traditional doctrine of right of privacy so as to safeguard the author's personal rights, while reserving protection of the author's economic interest in his work to the Copyright Act of 1976.[164] Also, several commentators have advocated, as one means of preserving an artist's moral rights, the adoption of a rule of construction that holds that an artist retains any right that he does not expressly sur-

[163] *Id.*

[164] *See* Kirby, *supra* note 32, at 880.

render by contract.[165] Finally, one commentator has constructed a novel solution that not only consists of a strict interpretation of an artists' contract in his favor but also provides for an imaginative expansion of the traditional doctrines of waste and right of publicity.[166] All of these proposed solutions share two critical weaknesses: (1) no guarantee or even prospect of uniform application from state to state and (2) an unrealistic dependence on the author's ability to reserve certain rights by contract.

The remedial measure that has acquired the greatest support of the legal community is the enactment of an amendment to the copyright statute.[167] In fact, one commentator has concluded that, "the barriers to enforcement of moral rights under state law . . . would seem to preclude a satisfactory solution to the moral rights problem in the United States by any means short of specific federal legislation."[168] One advantage of providing for an author's moral rights by adding a personal rights section to the Copyright Act of 1976 is the uniform and comprehensive protection that such a national statute could ensure. Not only would this facilitate a less

[165] *See id.* at 887; Comment, GEO. L. J., *supra* note 40, at 1561; Comment, HARV. L. REV., *supra* note 64, at 480.

[166] *See* Comment, GEO. L. J., *supra* note 40, at 1561.

[167] *See* Diamond, *supra* note 9, at 281; Katz, *supra* note 62, at 375; Stevenson, *supra* note 75, at 116–17; Valentine, *supra* note 6, at 818–19.

One example of such an amendment is the bill introduced in 1979 by Representative Robert F. Drinan, which would explicitly incorporate moral rights into copyright law with respect to the visual arts. The text of this bill reads in pertinent part as follows:

> (d) Independently of the author's copyright in a pictorial, graphic, or sculptural work, the author or the author's legal representative shall have the right, during the life of the author and fifty years after the author's death, to claim authorship of such work and to object to any distortion, mutilation, or other alteration thereof, and to enforce any other limitation recorded in the Copyright Office that would prevent prejudice to the author's honor or reputation.

Visual Artists Moral Rights Amendment of 1979, H.R. 288, 95th Cong., 2d Sess. § 2(d) (1979), *reported in* PAT. T.M. COPYRIGHT J. (BNA), Mar. 15, 1979, at A–6.

[168] Diamond, *supra* note 9, at 281.

troublesome transition to recognition of moral rights but also it would simultaneously reaffirm the national policy of promotion and preservation of creative works. Moreover, if the moral rights legislation is incorporated into the existing copyright statute, there is less likelihood of statutory overlap or conflict. Instead, the copyright statute and the moral rights amendment would be more likely to complement one another.

While the proposed remedies vary, the one common thread they share is a growing awareness that American authors receive less favorable treatment of their personal and reputational interests in their work than their European counterparts do, where the doctrine of moral rights is the law of the land. The time has come for Congress to recognize the important contributions of American creative artists and to provide them with protection, long overdue, that is truly comparable to that provided by the moral right doctrine.

NATIONAL FIFTH PRIZE, 1980

Criminal Copyright Infringement and a Step Beyond

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INTRODUCTION

THE CONSTITUTION explicitly confers upon Congress the power "[t]o 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."[1] Pursuant to this grant of authority, Congress enacted various statutes to define the rights and scope of protection to be afforded to authors. The basic notion underlying these statutes, the copyright laws, is that authors should control the right to reproduce their own works. Traditionally, a copyright infringement—a violation of the exclusive statutory rights provided to a copyrighted work—has been redressable under these federal statutes in a civil action for damages or equitable relief.[2] It has only been within the last century that Con-

[1] U.S. CONST. art I, § 8, cl. 8.

[2] From the very beginning of federal copyright, civil remedies have provided the foundation for the protection of authors' rights in their works. *See* Act of May 31, 1790, ch. 15, § 6, 1 Stat. 124 (1790). As the date of this Act indicates, matters relating to copyright have been the subject of federal legislation since the initial session of the United States Congress. The 1790 Congress passed

gress has seen fit to expand the sanctions for copyright infringement by providing criminal penalties.[3]

Although generally available for use since 1909,[4] federal criminal copyright provisions were seldom invoked by the government until the 1970s. Several reasons have been offered for this lack of prosecution. First, very little legislative history existed to aid attorneys and the courts in interpreting the criminal copyright provisions. This fact, coupled with the traditional hesitancy of lawyers to "sample unploughed linguistic ground,"[5] may have caused prosecutors to shy away from attempts to employ the criminal sanctions. Another reason offered for the paucity of criminal copyright prosecutions was the belief that federal civil remedies, including statutory damages,[6] provided sufficient punishment to copyright infringers.[7] Accompanying this notion was the long-standing be-

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"[a]n Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned." Act of May 31, 1790, ch. 15, 1 Stat. 124 (1790). This act was followed by many others, expanding and redefining the scope of copyright protection to achieve the present federal copyright laws found at 17 U.S.C. §§ 1–810 (1976).

[3] *See* Act of Mar. 4, 1909, Pub. L. No. 60-349, 35 Stat. 1075 (1909). Section 28 of the 1909 Act is reprinted in note 23 *infra*.

[4] Some limited criminal infringement provisions did exist prior to 1909. *See, e.g.*, Act of Jan. 6, 1897, ch. 4, 29 Stat. 481 (1897) (an unauthorized public performance of a copyrighted dramatic or musical composition, if done willfully and for profit, deemed a misdemeanor and made punishable by imprisonment for not more than one year); Act of May 31, 1790, ch. 15, § 2, 1 Stat. 124 (1790) (an unauthorized copying of a copyrighted map, chart, or book resulted in fixed civil penalties to be assessed per copy confiscated, with one-half of said penalties being paid to the United States).

[5] Gawthrop, *An Inquiry into Criminal Copyright Infringement*, 20 ASCAP COPYRIGHT L. SYMP. 154, 168 (1972). *Accord*, Wicher, *Criminal Copyright Infringement and the General Revision of the Copyright Law*, 2 PUBLISHING, ENTERTAINMENT, ADVERTISING & ALLIED FIELDS L. Q. 391, 396–97 (1963).

[6] Act of Mar. 4, 1909, Pub. L. No. 60-349, § 25, 35 Stat. 1075 (1909).

[7] H. WARNER, RADIO AND TELEVISION RIGHTS § 175, at 701 (1953); Gawthrop, *supra* note 5, at 167–69.

It may be that civil actions are preferred by injured copyright owners since they offer a more lucrative result. To "charge an author with willfully infringing a copyright by plagiarism is to charge him with a crime," [Cloth v. Hyman, 146 F.

lief that the criminal penalties for copyright infringement were too slight, even when employed, to be effective deterrents of such conduct.[8] In addition, it has been noted that recent Supreme Court cases liberalizing the rights of defendants have so increased the burdens of criminal prosecution that "any lawyer of wisdom [w]ould opt for the surer civil field whenever possible."[9]

Despite these considerations, which tend to diminish the enforcement of the criminal infringement provisions, the importance of criminal penalties for copyright infringement has increased with the rise in the prominence and profitability of the sound recording and motion picture industries. The economics of commercial authorship have changed drastically since the enactment of the first criminal provisions:

> Prior to 1909 most copyrightable works were created by individuals working alone and the financial investment of copyright entrepreneurs (primarily publishers) was relatively small by today's standards. After 1909 with the rapid growth of the sound recording, motion picture and television industries, the creation of a large number of copyrighted works involved not merely a single author but groups of individuals each adding his own expertise to the creation of a final work. This in turn involved large amounts of initial capital investment to bring these author teams together and to acquire the high cost technology required for creating the works. These factors greatly increased the risks of a fair economic return on any particular coprighted work,

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Supp. 185, 192 (S.D.N.Y. 1956)] and though charges of that nature are sometimes made in civil actions there is seldom any resulting criminal prosecution.

Strauss, *Remedies Other Than Damages for Copyright Infringement*, 2 STUDIES ON COPYRIGHT 1029, 1040 (1963) (footnote citation bracketed). *Cf.* Gawthrop, *supra* note 5, at 167–68 (exploring suggestion that civil remedies are so severe and penal in nature that they are, in effect, criminal sanctions).

[8] Wicher, *supra* note 5, at 397. *Cf.* A. LATMAN, THE COPYRIGHT LAW: HOWELL'S COPYRIGHT LAW REVISED AND THE 1976 ACT 252 (5th ed. 1979) (copyright not a high priority to most United States attorneys in their fight against crime); Sargoy, *Rescinding the Supreme Court's Rules for Copyright Procedure under Sec. 101, Title 17*, 9 BULL. COPYRIGHT SOC'Y 349, 355 (1962) (United States attorneys reluctant to invoke expense and pursue difficult investigation and trial to prosecute copyright infringers when result of conviction is merely a misdemeanor).

[9] Gawthrop, *supra* note 5, at 169.

always dependent on the promotional skills of the entrepreneur and the whim of public taste.[10]

The growth of the recording and motion picture industries has been paralleled by a corresponding increase in the unauthorized copying and vending of such works.[11] In response to this increase and perhaps as an implicit recognition of the toll taken by inflation,[12] Congress enacted stiffer penalties for criminal infringement[13] and the United States Department of Justice initiated an intensive enforcement program designed to apprehend large-scale commercial copyright infringers.[14]

The result of the recent congressional attention given to criminal copyright is found in section 506 of the 1976 Copyright Act.[15] This section, a consolidation of the prior federal criminal provisions relating to copyright,[16] provides two sets of criminal penalties for copyright infringements. With respect to infringements committed "willfully and for the purposes of commercial advantage or private financial gain," section 506(a) provides: (1) for infringement generally, a maximum fine of $10,000 and/or one year's imprisonment; and (2) for infringement of sound recordings and motion pictures, a maximum fine of $25,000 and/or one year's imprisonment for the first offense, and a maximum fine of $50,000 and/or two years' imprisonment for any subsequent offense.[17] Section 506(b) provides that upon a defendant's

[10] Lindenberg-Woods, *The Smoking Revolver: Criminal Copyright Infringement*, 27 BULL. COPYRIGHT SOC'Y 63, 67 (1979).

[11] R. BROWN, CASES ON COPYRIGHT 564 (3d ed. 1979); Grumar, *Criminal Infringement of Copyright*, J. BEVERLY HILLS B.A. 62 (July/Aug., 1976).

[12] Gawthrop, *supra* note 5, at 157.

[13] 17 U.S.C. § 506 (1976). *See* notes 50–58 & accompanying text *infra*.

[14] Lindenberg-Woods, *supra* note 10, at 76; N.Y. Times, May 30, 1975, at 62, col. 1.

[15] 17 U.S.C. §§ 1–810 (1976). Except for selected portions given immediate effect, this comprehensive copyright law revision became effective on January 1, 1978.

[16] *Compare* 17 U.S.C. § 506 (1976) *with* 17 U.S.C. § 104 (Supp. V 1975) *and* 17 U.S.C. § 105 (1970).

[17] 17 U.S.C. § 506(a) (1976). The complete language of § 506 is reproduced in the text accompanying note 29 *infra*.

conviction of copyright infringement, the court must order the destruction and forfeiture of all infringing copies and all equipment used in their manufacture.[18] Other conduct is also deemed criminal by the provisions of section 506. Sections 506(c) and (d) provide a maximum fine of $2,500 for the fraudulent use, alteration or removal of a copyright notice.[19] In addition, the false representation of a material fact in the application for copyright registration is subject to a similar fine under the provisions of section 506(e).[20]

This article focuses primarily on the criminal provisions for copyright infringement contained in section 506(a). The statutory changes resulting from the 1976 copyright revision are explored and the existence of state criminal copyright provisions for the infringement of pre-1972 sound recordings is discussed. In addition, the interaction between criminal and civil copyright infringement actions arising from the same conduct is examined, with particular emphasis upon the application of collateral estoppel principles in a civil infringement action following a section 506(a) conviction.

[18] 17 U.S.C. § 506(b) (1976).

[19] *Id.* § 506(c), (d). With regard to "copyright notice," 17 U.S.C. § 401(a) (1976) provides:

> Whenever a work protected under this title is published in the United States or elsewhere by authority of the copyright owner, a notice of copyright as provided by this section shall be placed on all publicly distributed copies from which the work can be visually perceived, either directly or with the aid of a machine or device.

The "notice of copyright" prescribed by § 401 must include three elements: (1) the symbol ©, the word "Copyright" or the abbreviation "Copr."; (2) the name of the copyright proprietor; and (3) the year that the work was first published. *Id.* § 401(b). In addition, the notice must be affixed on the copies in such a manner and location so that "reasonable notice" is given of the copyright claim. *Id.* § 401(c).

[20] *Id.* § 506(e). The 1976 Copyright Act does contain one additional criminal provision. A fine of not more than $2,500 may be imposed on any person who, in filing an application for a compulsory license for a coin-operated phonorecord player, knowingly makes a false representation of a material fact, knowingly alters a compulsory license certificate, or knowingly affixes such a certificate to a phonorecord player other than the one it covers. 17 U.S.C. § 116(d) (1976).

THE LANGUAGE AND INTENT OF SECTION 506

THE ANCESTRY OF SECTION 506: 1909–1974

As previously noted,[21] criminal sanctions for infringement were not always included in the scheme of American copyright law. The first general criminal provision appeared in the 1909 Copyright Act[22] as a section 28.[23] A conviction of criminal infringement under section 28 was deemed a misdemeanor and carried a maximum fine of $1,000. This provision of the 1909 Act, which covers all types of works and nearly all means of infringement, ultimately became 17 U.S.C. § 104.[24]

Section 104 remained virtually unchanged until 1974 when Congress amended it to add separate penalties for the unauthorized reproduction (often referred to as "piracy") of sound recordings.[25] The 1974 amendment provided much greater penalties for record piracy in order to reduce the economic incentives flowing from such conduct.[26] After the 1974 amendment, section 104 appeared as follows:

[21] *See* notes 3–4 & accompanying text *supra*.

[22] Act of Mar. 4, 1909, Pub. L. No. 60–349, 35 Stat. 1075 (1909). A brief review of federal criminal copyright sanctions in the United States prior to 1909 is contained in Grumar, *supra* note 11, at 63–64.

[23] That any person who willfully and for profit shall infringe any copyright secured by this Act, or who shall knowingly and willfully aid or abet such infringement, shall be deemed guilty of a misdemeanor, and upon conviction thereof shall be punished by imprisonment for not exceeding one year or by a fine of not less than one hundred dollars nor more than one thousand dollars, or both, in the discretion of the court: *Provided, however,* That nothing in this Act shall be so construed as to prevent the performance of religious or secular works, such as oratorios, cantatas, masses, or octavo choruses by public schools, church choirs, or vocal societies, rented, borrowed, or obtained from some public library, public school, church choir, school choir, or vocal society, provided the performance is given for charitable or educational purposes and not for profit.

Act of Mar. 4, 1909, Pub. L. No. 60-349, § 28, 35 Stat. 1075 (1909).

[24] Act of July 30, 1947, Pub. L. No. 80–281, 61 Stat. 652 (1947).

[25] Act of Dec. 31, 1974, Pub. L. No. 93-573, 88 Stat. 1873 (1974).

[26] H.R. REP. No. 1581, 93d Cong., 2d Sess., *reprinted in* [1974] U.S. CODE CONG. & AD. NEWS 6849.

(a) Except as provided in subsection (b), any person who willfully and for profit shall infringe any copyright secured by this title, or who shall knowingly and willfully aid or abet such infringement, shall be deemed guilty of a misdemeanor, and upon conviction thereof shall be punished by imprisonment for not exceeding one year or by a fine of not less than $100 nor more than $1,000, or both, in the discretion of the court: *Provided, however,* that nothing in this title shall be so construed as to prevent the performance of religious or secular works such as oratorios, cantatas, masses, or octavo choruses by public schools, church choirs, or vocal societies, rented, borrowed, or obtained from some public library, public school, church choir, school choir, or vocal society, provided the performance is given for charitable or educational purposes and not for profit.

(b) Any person who willfully and for profit shall infringe any copyright provided by section 1(f) of this title [sound recordings], or who should knowingly and willfully aid or abet such infringement, shall be fined not more than $25,000 or imprisoned not more than one year, or both, for the first offense and shall be fined not more than $50,000 or imprisoned not more than two years, or both, for any subsequent offense.[27]

This was the state of the federal criminal provision for copyright infringement when the 1976 Copyright Act was passed. However, before section 506 is examined, it should be noted that the 1974 amendment to section 104, besides extending criminal law protection to sound recordings, provided another major addition to the criminal copyright scheme. A second conviction for sound recording infringement was made punishable by a maximum prison sentence of two years in addition to the possible fines. Since any crime punishable by imprisonment for a term exceeding one year is classified as a felony under federal law,[28] this change meant that a willful and profit-motivated infringement was no longer merely a misdemeanor in all cases.

SECTION 506

Enacted as part of a comprehensive revision of the federal copyright laws, section 506 provides:

[27] 17 U.S.C. § 104 (Supp. V. 1975).
[28] 18 U.S.C. § 1 (1976).

(a) Criminal infringement

Any person who infringes a copyright willfully and for purposes of commercial advantage or private financial gain shall be fined not more than $10,000 or imprisoned for not more than one year, or both: *Provided, however,* that any person who infringes willfully and for purposes of commercial advantage or private financial gain the copyright in a sound recording afforded by subsections (1), (2), or (3) of section 106 or the copyright in a motion picture afforded by subsections (1), (3), or (4) of section 106 shall be fined not more than $25,000 or imprisoned for not more than one year, or both, for the first such offense and shall be fined not more than $50,000 or imprisoned for not more than two years, or both, for any subsequent offense.

(b) Forfeiture and destruction

When any person is convicted of any violation of subsection (a), the court in its judgment of conviction shall, in addition to the penalty therein prescribed, order the forfeiture and destruction or other disposition of all infringing copies or phonorecords and all implements, devices, or equipment used in the manufacture of such infringing copies or phonorecords.

(c) Fraudulent copyright notice

Any person who, with fraudulent intent, places on any article a notice of copyright or words of the same purport that such person knows to be false, or who, with fraudulent intent, publicly distributes or imports for public distribution any article bearing such notice or words that such person knows to be false, shall be fined not more than $2,500.

(d) Fraudulent removal of copyright notice

Any person who, with fraudulent intent, removes or alters any notice of copyright appearing on a copy of a copyrighted work shall be fined not more than $2,500.

(e) False representation

Any person who knowingly makes a false representation of a material fact in the application for copyright registration provided for by section 409, or in any written statement filed in connection with the application, shall be fined not more than $2,500.[29]

Although this article is concerned primarily with the implication of actions for criminal infringement of copyright under section 506(a), other conduct specified by section 506 as de-

[29] 17 U.S.C. § 506 (1976).

serving of criminal penalties should not be seen as completely unimportant. The section 506 provisions prohibiting the fraudulent use, alteration or removal of a copyright notice (subsections (c) and (d)) were carried forward with no major changes[30] from section 105 of the 1909 law.[31] Note that the only reported case under section 105, *Scarves by Vera, Inc., v. American Handbags, Inc.*,[32] was not even a criminal prosecution. In that civil action, injunctive relief was sought for the removal of copyright notice, but the court held that section 105 implied no civil remedy since it was strictly a criminal provision based on fraudulent intent.[33]

The other criminal provision of section 506, subsection (3),[34] which provides a fine for any person making a false representation of a material fact in accordance with a copyright application, is a recent addition to the criminal sanctions of copyright law.[35] The Register of Copyrights was initially opposed to this provision[36] because the United States Criminal Code provides severe penalties (up to five years in prison and/or a fine of up to $10,000) for anyone who knowingly makes false statements or uses false documents "in any matter within the jurisdiction of any department or agency of the United States."[37] However, the Register later agreed to the inclusion of subsection (e), determining that it was probably better to classify false representation before the

[30] *Compare* 17 U.S.C. § 506(c), (d) (1976) *with* 17 U.S.C. § 105 (1970).

[31] Originally § 29 in the Act of Mar. 4, 1909, Pub. L. No. 60-349, § 29, 35 Stat. 1075 (1909).

[32] 188 F. Supp. 255 (S.D.N.Y. 1960).

[33] For an extended analysis of § 105, *see* Berger, *False Use of Copyright Notice*, 1 STUDIES ON COPYRIGHT 297 (1963). In addition, Nimmer provides a cursory discussion of subsections (c) and (d) in his treatise. 3 M. NIMMER, NIMMER ON COPYRIGHT § 15.02 (1980).

[34] Nimmer *briefly* reviews subsection (e) in his treatise. M. NIMMER, *supra* note 33, § 15.03.

[35] *But see* 17 U.S.C. § 18 (1970) (making false affidavit for the purpose of obtaining registration of a claim to copyright deemed a misdemeanor).

[36] HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 135 (Comm. Print 1961) [hereinafter cited as REGISTER'S REPORT].

[37] 18 U.S.C. § 1001 (1976).

Copyright Office as a misdemeanor rather than a felony. In addition, the Register decided that there would be some practical advantage in having such a provision explicitly stated in the body of the copyright laws.[38]

CRIMINAL INFRINGEMENT CHANGES: SECTIONS 104 TO 506(A)

The alterations, additions, and deletions made upon the existing criminal infringement provision to achieve the language of section 506(a) were badly needed and were long overdue. However, these changes do not represent a major change in the *nature* of criminal infringement. The old criminal provision, as well as the entire scheme of federal copyright law, was in need of revision to keep pace with the technological and economic advances of society. The basic impact of the federal criminal infringement provision was not altered by the 1976 Act; a willful infringement for purposes of financial gain could still incur criminal liability. Nevertheless, the changes that were made by the 1976 Act deserve examination.

Section 506(a) is divided into two sections: a general infringement section and a section devoted exclusively to the infringement of sound recordings and motion pictures. The general infringement section, although remaining the same in spirit, underwent four basic alterations in the 1976 Act: (1) a refining of the language relating to the "for profit" element of criminal infringement; (2) the deletion of any reference to aiders and abettors; (3) a reassessment of the criminal infringement penalties; and (4) the elimination of the clause which provided certain choral groups the privilege of freely performing copyrighted works if the performance was for nonprofit educational or charitable purposes.[39]

[38] HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, PART 4, FURTHER DISCUSSIONS AND COMMENTS ON PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW 171 (Comm. Print 1964) (Statements of Barbara A. Ringer, Copyright Office).

[39] There was one other change. The clause, "in the discretion of the court," which followed the enumeration of the applicable penalties for criminal infringement in § 104, was not included in the language of § 506(a), presumably because it was unnecessary.

The portion of section 104 dealing with sound recordings was also altered in the 1976 revision. In order to be consistent with the general criminal infringement section, the language pertaining to the "for profit" element was appropriately revised and the reference to aiders and abettors was dropped. Further changes in the sound recording clause include the specific inclusion of motion picture infringements in this increased penalties section and the enumeration of the specific exclusive rights in sound recordings and motion pictures, infringement of which will give rise to criminal liability.[40]

FOR PURPOSES OF COMMERCIAL ADVANTAGE OR PRIVATE FINANCIAL GAIN

For liability to accrue under section 104, the criminal provision of the 1909 Act, an infringement must have been committed "for profit." This element of criminal infringement is made more distinct by the language of the 1976 Act. In order to incur criminal liability under section 506(a), an infringement must be committed "for purposes of commercial advantage or private financial gain." The congressional reasoning behind this change was not revealed, but it appears that the two phrases are meant to be substantially equivalent.[41]

Perhaps the reason for this change was to emphasize the profitable *purpose* of an infringement rather than the profitable *result* of an infringement. Under the phrase "for profit," it may have been a viable defense to an infringement prosecution for an accused to offer proof that no financial gain actually resulted from the infringing conduct.[42] This aspect of criminal infringement was the focus of the district court's attention in *United States v. Taxe*,[43] a prosecution for the in-

[40] 17 U.S.C. § 506(a) (1976). *See* notes 64–67 & accompanying text *infra*.

[41] M. NIMMER, *supra* note 33, § 15.01, at 15-1 n.1, 15-4 n.16. *See* HOUSE COMM. ON THE JUDICIARY, COPYRIGHT LAW REVISION, H.R. Rep. No. 1476, 94th Cong., 2d Sess. 163 (1976) [hereinafter cited as HOUSE REPORT].

[42] Gawthrop, *supra* note 5, at 165.

[43] 380 F. Supp. 1010 (C.D. Cal. 1974), *aff'd* 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977).

fringement of sound recordings under section 104. Upon the defendant's conviction, the *Taxe* court issued a memorandum opinion accompanied by its instructions to the jury. Regarding the profitable aspects of the defendant's conduct, the court instructed.

> "Profit" includes the sale or exchange of the infringing work for something for value in the hope of some pecuniary gain. It is irrelevant whether the hope of gain was realized or not. The requirement of profit is intended to delineate commercial infringements from infringements for merely personal use and philanthropic infringements.[44]

This court's interpretation of the "for profit" requirement of a criminal infringement appears to be in accord with the "for purposes of commercial advantage or private financial gain" language of section 506(a). Note, however, that under section 506(a) it is possible that an infringer may be liable even for an infringement made for personal use if there is any aspect of "private financial gain" involved.[45]

[44] 380 F. Supp. at 1018.

[45] The distinction between commercial and personal infringements made by the *Taxe* court was also noted by the court in United States v. Bily, 406 F. Supp. 726 (E.D. Pa. 1975). Bily, who owned a massive collection of motion picture films, was accused of criminal copyright infringement. Stating that "Congress did not intend to make the bona fide film hibbiest [*sic*] a criminal," *id.* at 733, the *Bily* court essentially held the single sale of a film print by a film collector or hobbyist insufficient to bring that person's conduct within the "for profit" requirement of § 104. In addition, the court observed that even if a film hobbyist *willfully* infringed the copyright in a motion picture by making an unauthorized copy, "he is civilly liable to the copyright holder for the damages caused by the infringement, but for that act alone he cannot be convicted under 17 U.S.C. 104." *Id.*

The statements made by the *Taxe* and *Bily* courts implying exemption from criminal liability for the private infringer are dictum and of doubtful force in light of the "private financial gain" language of § 506(a). A private film or record collection may represent a substantial asset and the willful sale of infringing prints or phonorecords to support and enlarge such a collection is clearly an act done for private financial gain. Lindenberg-Woods, *supra* note 10, at 82. A technical reading of § 506(a) may even make the requirement of a "sale" unnecessary. Even an unauthorized reproduction of a copyrighted work for the purely personal reason of enlarging the size (and value) of a private collection may satisfy the "private financial gain" element of criminal infringement.

AIDERS OR ABETTORS

Besides imposing criminal liability on a willful and for profit infringer, section 104 also provided the same penalties for any person who knowingly and willfully aided or abetted such infringing conduct. In addition to broadening the scope of the criminal infringement sanctions, this provision provided authors in 1909 with a statutory deterrent against the vendors, agents, and theater managers who aided elusive or judgment-proof infringers in promoting their unauthorized copies.[46] Even though this "aid or abet" provision was eliminated from the language of section 506(a) in the 1976 Copyright Act, such conduct is not less a concern today. The continued inclusion of such a provision in the new section 506(a) would have been merely superfluous, however, because under the provisions of 18 U.S.C. § 2,[47] aiders, abettors, and other accessories before the fact of any offense defined as criminal by federal law are treated as principals in the commission of the offense.[48] Therefore, there is no longer the need to include any mention of aiders or abettors in section 506(a).[49]

While the private collector may technically qualify for criminal liability under § 506(a), such persons should not be the subject of government prosecutions. The sanctions of § 506(a) are best imposed upon the large-scale commercial infringers whose conduct has greater economic implications upon the entertainment industry than the acts of a hobbyist.

[46] Pirates of all categories of copyrighted works were both financially irresponsible and transient in their business locations, making injunctions and civil damages futile. In the same vein authors of musical and dramatic works emphasized the need to make it a crime to aid and abet willful infringement because it was impossible to apprehend actors or singers who performed works without permission because they were constantly moving from town to town. The only feasible deterrent to these unauthorized performances was to hold theater managers and agents criminally liable for aiding and abetting.

Lindenberg-Woods, *supra* note 10, at 66 (footnote omitted).

[47] 18 U.S.C. § 2 (1976).

[48] *See Copyright Law Revision: Hearings before the Subcomm. on Courts, Civil Liberties, and the Administration of Justice of the House Comm. on the Judiciary*, 94th Cong., 1st Sess. 157 (May 8, 1975) (statement of Irwin Goldbloom, Deputy Assistant Attorney General, Civil Division, Department of Justice) [hereinafter

PENALTIES

Fines. The revision of the applicable fines for conviction of a general criminal infringement represents the most substantial, and probably the most necessary, change resulting from the 1976 revision of section 104. The 1909 law provided maximum and minimum fines of $1,000 and $100 respectively, for conviction of willful and for profit infringement. In section 506(a), the maximum fine, for all infringements except those of sound recordings and motion pictures,[50] has been increased substantially to $10,000,[51] and "in conformity with the general pattern of the Criminal Code (18 U.S.C.), no minimum fines have been provided."[52] This increase, although certainly provided to enhance the deterrent effect of the law, is undoubtedly linked to the pattern of general inflation prevailing in the United States economy. The pattern of fines applicable to sound recording (and now motion picture[53]) infringements was unaltered in the 1976 revision. This

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cited as *Copyright Hearings*]. Accessories after the fact of any offense defined as criminal by federal law, *e.g.*, criminal copyright infringement, are covered by 18 U.S.C. § 3 (1976), and conspirators to such conduct fall within the bounds of 18 U.S.C. § 371 (1976).

[49] Interestingly, one commentator points out that the original version of 18 U.S.C. § 2 was passed by Congress on the same day as the 1909 Copyright Act (March 4, 1909), so there may have been no reason to include the "aid or abet" provision in the federal copyright laws in the first place. *See* Grumar, *supra* note 11, at 74.

[50] *See* notes 62–63 & accompanying text *infra*.

[51] The hearings and reports preceding the copyright revision illustrate the concern that the increased criminal penalties for infringement were needed to deter blatant piracy. *See, e.g.*, HOUSE COMM. ON THE JUDICIARY, 89TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, SUPPLEMENTARY REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW: 1965 REVISION BILL 139 (Comm. Print 1965); HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, PART 2, DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 179–82 (Comm. Print 1963).

[52] HOUSE REPORT, *supra* note 41, at 163. *See* HOUSE COMM. ON THE JUDICIARY, 89TH CONG., 1ST SESS., COPYRIGHT LAW REVISION, PART 5, 1964 (REVISION BILL WITH DISCUSSION AND COMMENTS 200 (Comm. Print 1965) (Statements of Abe A. Goldman, Copyright Office).

[53] *See* notes 62–63 & accompanying text *infra*.

lack of change is understandable, since these fines were not outdated, having been established in the latest (1974) amendment to section 104.

Incarceration. Although the maximum fine for a general criminal infringement is now $10,000, conviction is still only a misdemeanor, since it is punishable by not more than one year's imprisonment.[54] In 1975, efforts by the Justice Department to increase the incarceration penalty to the level of a felony for subsequent offenders[55] failed, and the term of imprisonment under section 506(a) remains the same today as it was in 1909. The incarceration penalties for criminal infringement of sound recordings (and now motion pictures) were unchanged by the 1976 revision.[56]

The failure to enact stiffer incarceration penalties for criminal copyright infringement indicates an apparent hesitancy on the part of Congress to classify criminal infringers as felons. Perhaps this is in adherence to the time-honored concept that a felony is "as bad a word as you can give to man or thing."[57] Note also that there are no criminal penal-

[54] There is some sentiment that the § 506(a) penalties applicable to sound recording and motion picture infringements *are* outdated and inadequate. This is evidenced by recent bills introduced in Congress to stiffen the possible punishment for such offenses.

On May 12, 1981, Rep. Barney Frank introduced H.R. 3530, a bill entitled the "Piracy and Counterfeiting Amendments Act of 1981." This bill, if enacted, would subject anyone who traffics in counterfeit labels for records, motion pictures, or audiovisual works to a maximum fine of $250,000 and/or five years' imprisonment. In addition, the illegal copying of the copyrighted works themselves would result in similar penalties. *See* [1981] 532 PAT. T.M. & COPYRIGHT J. A–1 (this commentary includes a reproduction of the full text of H.R. 3530). Identical legislation, introduced on March 12, 1981, by Sen. Strom Thurmond, is also pending in the Senate. Committee hearings on both bills were scheduled for June, 1981. [1981] 534 PAT. T.M. & COPYRIGHT J. A–20. In 1980, an almost identical bill was introduced in the House by Rep. Robert Drinan. [1980] COPYRIGHT L. REP. (CCH) ¶ 20,085 (H.R. 8285, 96th Cong., 2d Sess. (1980).

[55] 18 U.S.C. § 1 (1976).

[56] *Copyright Hearings, supra* note 48, at 157. *See also* SENATE COMM. ON THE JUDICIARY, COPYRIGHT LAW REVISION, S. REP. No. 473, 94th Cong., 1st Sess. 145–46 (1975) [hereinafter cited as SENATE REPORT].

[57] *But see* the Senate version of the 1976 Act, S. 22, 94th Cong., 1st Sess. § 506(a) (1975), which provided that a first-time conviction for sound recording or motion

ties specifically stated in either the federal patent or trademark statutes, even for willful infringement.[58]

THE CHORAL PERFORMANCE EXEMPTION

The exemption from criminal infringement liability given certain nonprofit choral performances[59] and contained in section 104 of the 1909 law was not carried forward into section 506(a). It was also part of the excess verbiage of the 1909 Act that, upon revision, could be excised. Indeed, it was said that "[s]ince all nonprofit performances of music are exempt under the general provision of the law, this proviso . . . is entirely superfluous."[60] Under the 1976 Copyright Act, it appears that section 110[61] provides these types of exemptions for both civil and criminal instances, so the inclusion of any such exemptions in section 506(a) would be redundant.

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picture infringement would carry a three-year maximum sentence, with each subsequent offense punishable by up to seven years in prison. SENATE REPORT, *supra* note 55, at 30, 146.

Increased terms of imprisonment for such infringers may not be too far in the offing, however. *See* note *supra*.

The courts are attempting to make the present penalties as effective as possible. *See* United States v. Taxe, 572 F.2d 216 (9th Cir.), *cert. denied*, 436 U.S. 918 (1978) (trial court did not abuse discretion in sentencing convicted copyright infringer on each of twenty counts of willful infringement of copyrights for profit, rather than merging the violations into a course of conduct and treating them as a single offense).

[58] 2 F. POLLOCK & F. MAITLAND, THE HISTORY OF ENGLISH LAW 465 (2d ed. 1905). One commentator suggests that the failure by Congress to enact stiffer prison penalties resulted from "countervailing perceptions of copyright and its relationship to the principles of a competitive economy." Lindenberg-Woods, *supra* note 10, at 69.

[59] For a thoughtful analysis of this apparent inconsistency, *see* Lindenberg-Woods, *supra* note 10, at 69–71.

[60] *See* note 23 *supra*.

[61] REGISTER'S REPORT, *supra* note 36, at 27. One pre-revision commentator, although agreeing with the proposed deletion of the choral performances exception, criticized this statement by the Register as too broad. *See* Wicher, *supra* note 5, at 392–94.

INCREASED PENALTIES FOR MOTION PICTURE INFRINGEMENT

Although motion pictures have been federally copyrightable since 1912,[62] prior to the 1976 Copyright Act an action for the criminal infringement of such works could result in, at most, only one year's imprisonment and a fine of $1,000. Recognizing that the piracy of motion pictures had developed into a very lucrative enterprise,[63] Congress included the infringement of such works in the greater penalties portion of section 506(a) dealing with sound recordings.

SOUND RECORDING AND MOTION PICTURE COPYRIGHT RIGHTS PROTECTED BY SECTION 506(A)

Section 506(a) specifically denotes the section 106[64] exclusive rights[65] in sound recordings that, upon infringement, will give rise to criminal liability. These rights are enumerated as: (1) the right to reproduce the copyrighted sound recording, (2) the right to prepare derivative works based upon the copyrighted sound recording, and (3) the right to distribute phonorecords[66] of the copyrighted sound recording to the public by sale, rental, lease, lending, or other transfer of ownership. The inclusion of these specific section 106 rights in the new criminal infringement section is not a change in effect from section 104; instead, it is merely a change in lan-

[62] 17 U.S.C. § 110 (1976) ("Limitations on exclusive rights: Exemption of certain performances and displays").

[63] Act of August 24, 1912, Pub. L. No. 62-303, 37 Stat. 488 (1912).

[64] *See* N.Y. Times, May 30, 1975, at 62, col. 1. This news item reports the indictment of 16 persons for the criminal infringement of motion pictures, conspiracy, and transporting stolen property. *See also* BILLBOARD, Mar. 18, 1978, at 3 (report that between 1974 and 1978, authorities found $150 million of illegal duplicating and pressing machines and destroyed 2.2 million bootleg 8-track tapes worth $1.3 million along with 40,000 reels of film and/or videotapes).

[65] 17 U.S.C. § 106 (1976) ("Exclusive rights in copyrighted works").

[66] It should be noted that the "exclusive rights" of § 106 are subject to the provisions of sections 107 through 118 of the 1976 Copyright Act. *Id. See, e.g.*, note 68 *infra*.

guage so that section 506(a) will be in accord with the rest of the revised copyright statutes.[67]

With the inclusion of motion pictures in the greater penalties section of 506(a), it also became necessary to specify the applicable exclusive rights of section 106 that would be protected with criminal liability. These rights are: (1) the right to reproduce the copyrighted motion picture; (2) the right to distribute copies of the copyrighted motion picture to the public by sale, rental, lease, lending or other transfer of ownership; and (3) the right to perform the copyrighted motion picture publicly. The enumeration of the rights protected by section 506(a) for both sound recordings and motion pictures, while probably not absolutely necessary, should serve to quell confusion concerning exactly what conduct will give rise to criminal liability.

SECTION 506 (B)—FORFEITURE AND DESTRUCTION

Section 506(b) provides that, upon conviction for criminal infringement, the presiding court must "order the forfeiture and destruction or other disposition of all infringing copies or phonorecords and all implements, devices, or equipment used in the manufacture of such infringing copies or phonorecords."[68] This provision is completely new and apparently

[67] Phonorecords are the material objects in which sound recordings are fixed. They are statutorily defined as the

> [M]aterial objects in which sounds, other than those accompanying a motion picture or other audiovisual work, are fixed by any method now known or later developed, and from which the sounds can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "phonorecords" includes the material object in which the sounds are first fixed.

17 U.S.C. § 101 (1976).

[68] *See Copyright Hearings*, *supra* note 48, at 137. "The exclusive rights of the owner of copyright in a sound recording are limited to the rights specified by clauses (1), (2), and (3) of section 106, and do not include any right of performance under section 106(4)." 17 U.S.C. § 114(a) (1976). Section 114 further narrows these exclusive rights of sound recording copyright ownership in subsection (b), which must be considered to determine if there has been an infringement (civil or criminal) of such works.

was included in the 1976 Act upon the urging of the Justice Department. The reason this provision became necessary was merely one of "jailhouse housekeeping," as noted at the 1975 House Committee on the Judiciary hearings on the general copyright revision:

> At present, the government has no clear-cut authority to destroy infringing articles which have been seized or otherwise obtained in the investigation or prosecution of a tape piracy case or, for that matter, any criminal copyright infringement case. This lack of specific authority had resulted in critical storage problems for many F.B.I. and U.S. Marshalls' offices throughout the country and poses the embarrassing possibility that the government may be ordered to return known infringing articles to a convicted defendant.[69]

There is a similar provision relating to civil infringements, 17 U.S.C. § 503(b),[70] under which the presiding court, upon final judgment or decree, may order the destruction of all infringing copies or phonorecords and any equipment used to produce them. These criminal and civil provisions differ in one major respect. In a civil infringement action, the remedy of destruction is in the court's discretion, while upon conviction in the criminal context, such destruction is mandatory.[71]

STATE CRIMINAL PROVISIONS

State laws designed to provide or to protect rights equivalent to those provided by federal copyright and attached to works that are within the scope of federal copyright are invalid by operation of the federal preemption doctrine. This notion is made quite clear by the codification of the federal preemption doctrine in the 1976 Copyright Act at 17 U.S.C. § 301.[72] One class of works, sound recordings, is not fully

[69] 17 U.S.C. § 506(b) (1976).

[70] *Copyright Hearings supra* 48, at 156. *See also id.* at 144–45 (comments of Mr. John Murphy, Justice Department, and Rep. Robert F. Drinan).

[71] 17 U.S.C. § 503(b) (1976).

[72] 17 U.S.C. § 509 grants the government the authority to seize all articles (copies, phonorecords, equipment, etc.) used in violation of § 506(a). Again, a similar provision exists in the civil arena as well: 17 U.S.C. § 503(a) (1976). Nimmer notes the possible constitutional problems of these two seizure sections in his treatise. M. NIMMER, *supra* note 33, §§ 14.07, 15.01, at 15–2 n.5.

included in this general rule of preemption.[73] Federal copyright in sound recordings did not exist prior to February 15, 1972,[74] so only those sound recordings fixed after that date are protected by federal law, and state laws dealing with the exclusive rights of federal copyright in sound recordings prepared after that date are specifically preempted by section 301. In order for a party to obtain relief, either civilly or criminally, for the unauthorized copying of sound recordings fixed prior to February 15, 1972, it is necessary to resort to state law.[75] The need for state action in this area was made particularly acute by the tremendous increase in record piracy[76] and counterfeiting[77] activity during the late 1960s and early 1970s.[78]

[73] 17 U.S.C. § 301 (1976).

[74] *See* 17 U.S.C. § 301(c) (1976).

[75] Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391 (1971).

[76] Of course, the underlying musical composition, if copyrighted, is protected by federal copyright law. The interesting aspect of this fact is that prior to 1972, it was possible for record pirates to make and vend unauthorized phonorecords without being subjected to federal criminal prosecution if they tendered to the copyright proprietor of the underlying musical composition the royalty fees demanded under the compulsory licensing provision of the 1909 laws. *See* Act of Mar. 4, 1909. Pub. L. No. 60-349, § 1(e), 35 Stat. 1075 (1909) (current version at 17 U.S.C. § 115 [1976]). This notion has fallen into general disfavor, however, with several federal courts holding that the making of identical copies of recorded versions of copyrighted musical compositions is not a "similar use" as permitted by the compulsory license provision of the 1909 Copyright Act. *See, e.g.*, Heilman v. Levi, 391 F. Supp. 1106, 1110–11 (E.D. Wis. 1975). The effect of these decisions is that record pirates may be held criminally liable for duplicating sound recordings fixed prior to February 15, 1972, even if they tendered the two-cent licensing fee to the composition copyright proprietor.

[77] "Piracy in the record business applies to the unauthorized duplication of tapes or records sold openly as manufactured without permission of the record company. The pirates may sell under their own label or with no label identification at all." S. SHEMEL & M. KRASILOVSKY, THIS BUSINESS OF MUSIC 93 (rev. & enlarged 4th ed. 1979). Record or tape piracy is not a small problem. It is estimated that the recording industry incurred losses of approximately $200 million in 1979 because of such conduct. Whitefield, *Record Pirates Hit Gold*, Omaha World Herald, Mar. 30, 1980, Entertainment Magazine, at 1, col. 1.

[78] "Counterfeiting in the record business consists of the unauthorized manufacture and distribution of copies of records under the guise of products of the authorized manufacturer." S. SHEMEL & M. KRASILOVSKY, *supra* note 77.

As a direct result of the increase in unauthorized reproduction of sound recordings and the lack of federal protection for such works fixed prior to 1972, recording companies began a concerted campaign to achieve antirecord piracy legislation in all states.[79] This activity has resulted in appropriate legislation in the majority of states—thirty-seven at last

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From its crude beginnings in the 1960s, record counterfeiting has blossomed into a multimillion-dollar underground business, threatening the livelihood of record producers, singers and musicians.

Counterfeiting now is believed to be the major source of income for criminals with ties to organized crime, aided, it has been charged, by some record retailers and distributors. Hundreds of professional counterfeiting networks are said to stretch across the United States and into foreign countries.

The recording industry lost $400 million—or nearly $1.1 million per day—to counterfeiters last year [1979], according to the Recording Industry Association of America. The FBI's estimate is $600 million.

. . .

The Recording Industry Association of America now estimates that one in four pre-recorded tapes and one in 10 albums are counterfeit.

Id.

In addition to federal copyright protection for sound recordings fixed after February 15, 1972, it is also a federal crime to knowingly and with fraudulent intent transport, sell or receive any phonorecord to which is affixed any forged, falsely made, or counterfeited label. 18 U.S.C. § 2318 (1976). The sanctions under § 2318 are similar in nature to those of § 506(a) for the infringement of sound recordings.

[79] *See* S. SHEMEL & M. KRASILOVSKY, *supra* note 77, at 93–94. The problem of the making and selling of unauthorized phonorecords is not a new one, *see* Comment, *Performers' Rights and Copyright: The Protection of Sound Recordings from Modern Pirates*, 59 CALIF. L. REV. 548 (1971) and Note, *Piracy on Records*, 5 STAN. L. REV. 433 (1953), but the increase in market and advances in reproduction technology have made it substantially more lucrative. *See, e.g.*, Elektra Records Co. v. Gem Electronics Distrib., Inc., 360 F. Supp. 821 (E.D.N.Y. 1973); S. SHEMEL & M. KRASILOVSKY, *supra* note 77, at 93.

The problem is not merely a local one, either. In March, 1981, 200 delegates from 60 countries met in Geneva under the auspices of the World Intellectual Property Organization to discuss the extent of the commercial piracy of sound and audiovisual recordings. After hearing that the value of pirated recordings worldwide was more than one billion dollars and that enforcement of antipiracy legislation can effectively be carried out only through criminal (as opposed to civil) laws, the delegates passed a resolution urging individual governments to strengthen domestic legislation guaranteeing the rights of those affected by piracy, to increase the pursuit of such pirates and to strengthen international antipiracy conventions. [1981] 524 PAT. T.M. & COPYRIGHT J. A–12.

count[80]—in an attempt to give some protection to those sound recordings not protected under federal law. Typical of the nature of state liability in this area is the Nebraska law, which in part provides:

> [I]t is unlawful for any person, firm, partnership, corporation, or association knowingly to (1) transfer or cause to be transferred any sounds recorded on a phonograph record, disc, wire, tape, film, or other article on which sounds are recorded onto any other phonograph record, disc, wire, tape, film, or other article, or (2) sell, distribute, circulate, offer for sale, distribution or circulation, possess for the purpose of sale, distribution or circulation, or cause to be sold, distributed or circulated, offered for sale, distribution or circulation, or possessed for sale, distribution or circulation, any article or device on which sounds have been transferred without the consent of the person who owns the master phonograph record, master disc, master tape, master wire, master film, or other article from which the sounds are derived.[81]

Conviction under this Nebraska statute is a class II misdemeanor, carrying a maximum imprisonment of six months and/or a maximum fine of $1,000.[82] These penalties are typical of those imposed by most state antipiracy statutes, although some states, particularly those in which the entertainment and recording industries are prominent, provide much stronger sanctions upon conviction.[83] Besides enacting "record piracy" statutes similar to Nebraska's, many states prohibit the "counterfeiting" of recording packaging or identifying data. In addition, some states also prohibit the unauthorized recording of live performances.[84]

[80] A. LATMAN, *supra* note 8, at 251; S. SHEMEL & M. KRASILOVSKY, *supra* note 77, at 96.

[81] *See* [1979] COPYRIGHT L. REP. (CCH) ¶¶ 10,901–11,241. This service reproduces the pertinent statutes from each of the 37 states with antirecord piracy legislation. *See generally* 23 BULL. COPYRIGHT SOC'Y 321 (1976) ("State Antipiracy Legislation"). The validity of such state laws was upheld under a challenge based on the federal preemption doctrine in Goldstein v. California, 412 U.S. 546 (1973).

[82] NEB. REV. STAT. § 28-1323 (Reissue 1979).

[83] *Id.* § 28-1326. *See id.* § 28-106.

[84] *E.g.*, CAL. PENAL CODE § 653h(b) (West Cum. Supp. 1980) (Hollywood); TENN. CODE ANN. § 39-4249 (1975) (Nashville).

There are naturally some differences in the scope of protection and form of copyright between the federal and state systems. While the 1976 Copyright Act places a time limit on the copyright protection of all materials copyrighted thereunder,[85] none of the state statutes contain such time limits. Therefore, it is conceivable that a sound recording covered by the state statutes would never pass into the public domain and thus never lose its protection under those statutes. This is not the case, however, since the preemption provision of the 1976 Act effectively places a time limit on all state protection equivalent to that of federal copyright. Section 301(c) of the 1976 Act provides, "[w]ith respect to sound recordings fixed before February 15, 1972, any rights or remedies under the common law or statutes of any State shall not be annulled or limited by this title until February 15, 2047."[86] A further distinction between state antirecord piracy statutes and federal copyright law is that, unlike the federal law, no form of notice or registration is necessary to entitle sound recordings to the protection of the state statute.[87]

Note also that just because a particular state has not enacted a specific antirecord piracy statute does not necessarily mean that pre-1972 protection is unavailable to a sound recording owner in that jurisdiction. Other forms of prosecution may be available. Some states have employed more general civil and criminal property protection statutes, such as those prohibiting "unfair competition," to protect sound recording owners against record piracy.[88]

[85] [1979] COPYRIGHT L. REP. (CCH) ¶ 10,901.

[86] *See* 17 U.S.C. §§ 302–05 (1976).

[87] 17 U.S.C. § 301(c) (1976). The year 2047 was chosen because it is 75 years from 1972. Seventy-five years is the copyright duration determined appropriate by Congress for works existing when the new copyright laws were enacted. *See Copyright Hearings, supra* note 48, at 1911 (Dec. 4, 1975) (comments of Barbara Ringer, Register of Copyrights).

[88] Dunaj, *Tape Piracy and Applicable Florida Criminal Laws*, 48 FLA. B. J. 338, 340 (1974).

CRIMINAL AND CIVIL COPYRIGHT INFRINGEMENT

Under the 1976 Act, both criminal and civil liability for copyright infringement may arise from the same activity—an unauthorized reproduction of a validly copyrighted work. The imposition of liability in these two areas is not identical, however. The distinctions between a civil and criminal action for infringement, and the problems inherent in relating the two to the same conduct, are explored in this section.

The obvious tie that binds civil and criminal liability for copyright infringement is the "infringement" itself.[89] The federal copyright statutes do not define infringement,[90] and not all infringements are entirely suited to criminal liability. For purposes of this discussion, an "infringement" is limited to the conduct of a person who reproduces the copyrighted work *exactly* and sells the copies without the copyright proprietor's permission. This is the usual situation in large-scale commercial copying operations, such as record, tape, or movie piracy, which are clearly the most appropriate for the imposition of criminal liability. "[P]lagiarism, where the infringer adopts a substantial amount of the protected expression in a copyrighted work as his own original creation,"[91] is

[89] [1979] COPYRIGHT L. REP. (CCH) ¶ 10,901.

[90] "[C]riminal copyright infringement incorporates as one of its elements the concept of civil copyright infringement." United States v. Bily, 406 F. Supp. 726, 730 (E.D. Pa. 1975).

[91] Although there is no statutory definition of infringement of copyright, it may be readily inferred from the provisions of Title 17 United States Code § 1(a), conferring upon the copyright proprietor the exclusive right to print, reprint, publish, copy and *vend* the copyrighted work. (Emphasis supplied.) The grant of these exclusive rights implies the prohibition that others shall not exercise them without the consent of the copyright proprietor; to do so without such consent would be infringement of copyright.

United States v. Wells, 176 F. Supp. 630, 633 (S.D. Tex. 1959). Under this interpretation, a general infringement under § 506(a) would be the unauthorized invasion of any of the copyright proprietor's exclusive rights under § 106, and a criminal infringement of a sound recording or motion picture would be the un-

too indefinite and vague for the imposition of criminal liability. It involves too much of a factual determination to be appropriate as conduct giving rise to criminal sanctions,[92] since it requires a person to speculate as to whether a certain act or manner of conduct is forbidden. On this point, one commentator has noted that criminal penalties are inappropriate for plagiarism "because to draw the line between idea and expression and to further determine when substantial expression has been taken are questions which by necessity are vague and uncertain."[93] In addition, to subject a person to criminal sanctions for merely misjudging what quantum of expression may be taken without permission from a particular copyrighted work would certainly have a chilling effect

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authorized invasion of any of the § 106 exclusive rights enumerated in § 506(a). *See* notes 64–67 & accompanying text *supra*.

While the 1976 Copyright Act does not provide a definition of a copyright "infringement," it does provide a definition of a copyright "infringer": "Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright." 17 U.S.C. § 501(a) (1976). While this may be a satisfactory definition for civil infringement purposes, criminal infringement requires additional elements as prerequisites to liability. *See* notes 139–51 & accompanying text *infra*.

[92] Lindenberg-Woods, *supra* note 10, at 73.

[93] The basic problem inherent in imposing liability for plagiarism is: How much copying is enough? 50%? 75%? This is a problem in civil instances as well as criminal. It would seem that in the criminal arena, the only possible exception to nonliability for plagiarism would be if the copy was nearly identical to the original work, *e.g.*, 95% copies. *See id.* at 74.

Only two cases have been reported where criminal liability was invoked for plagiarism: United States v. Backer, 134 F.2d 533 (2d Cir. 1943) and Marx v. United States, 96 F.2d 204 (9th Cir. 1938). In these cases, the quantum of copyright of the original work was unclear, although apparently the courts thought it enough, since convictions under § 104 were upheld in both. *See generally* Lindenberg-Woods, *supra* note 10, at 74–76. The fact that only two criminal plagiarism cases have been brought since 1909 may indicate that injured copyright proprietors get complete satisfaction from civil remedies and thus do not pursue criminal complaints. The more likely reason, however, is that federal prosecutors, realizing the potential difficulties, have no desire to become involved in the complex factual issues inherent in a plagiarism case. *Id.* at 76.

A related problem, the difficulty of proving similarity in a less than identical work, is briefly discussed (with respect to musical scores) in Gawthrop, *supra* note 5, at 163–64.

upon the dissemination of ideas.[94] It is possible that certain ideas may go unexpressed, because authors would be forced to employ considerable caution in borrowing from or drawing upon other works in order to avoid the onus of criminal liability.[95] The imposition of criminal liability for plagiarism, in all but perhaps the most extreme cases,[96] is entirely inappropriate.

Although civil and criminal infringement liability may arise from the same conduct, the nature of the resulting infringement actions under each is different in several respects. The most obvious difference relates to the parties involved. In a criminal prosecution, the federal government is the party initiating legal action, whereas in a civil suit, the plaintiff is a private party.[97] Another obvious difference involves the required burden of proof: in criminal law, the government must prove its case to the fact finder "beyond a reasonable doubt," whereas in most civil actions, the plaintiff's burden is merely to prove its case "by a preponderance of the evidence."

One other criminal-civil distinction, of particular importance in copyright law because it is completely codified, is the general rule of criminal law that a penal provision is strictly construed against the prosecution and in favor of the defendant.[98] The reason for this statutory rule of construction, applicable to each element of the offense,[99] is to provide adequate notice to a person as to what conduct is prohibited.[100] Since

[94] Lindenberg-Woods, *supra* note 10, at 74.

[95] *Cf.* Grumar, *supra* note 11, at 76–77 (discussion of the first amendment implications of § 104 and the "fair use" defense in a criminal infringement action).

[96] *Id.*

[97] *See* note 92 *supra.*

[98] *But see* United States v. Brown, 400 F. Supp. 656 (S.D. Miss. 1975), where it was held that the United States may seek injunctive relief in a civil infringement action "in its capacity as *parens patriae* in order to protect the rights of all persons whose economic interest may be adversely affected by copyright infringers." *Id.* at 659.

[99] *See, e.g.*, United States v. Resnick, 299 U.S. 207, 209 (1936); M. NIMMER, *supra* note 33, § 15.01, at 15-4.

[100] *See* Coughlan v. United States, 216 F.2d 324 (9th Cir. 1954).

there is no such corresponding rule in the civil law area, its effect is to further limit the scope of liability under section 506(a) relative to civil liability.[101]

Besides these general distinctions between criminal and civil actions, there are some distinctions particular to copyright law alone. As pointed out by Nimmer, "[c]ertain, but not all civil infringements of copyright, will also constitute criminal infringements."[102] The reason for this statement is that an action for criminal infringement requires certain additional elements beyond those required to make out a civil action. Some of these additional elements are necessitated by statute,[103] while others arise because the nature of criminal law requires that certain things must be proved by the prosecution rather than the defense.[104]

In spite of the differences between civil and criminal infringement, the lack of case law dealing with criminal infringement has forced courts to turn to civil cases in order to interpret and apply the criminal copyright provision. Indeed, the court in *United States v. Wells*[105] stated:

> There are few guides to the interpretation of this seldom-used criminal statute [section 104 of the 1909 laws]. To gain any idea of its coverage or of the protection afforded by the copyright law one must resort to the civil law of copyright and to the provisions of Title 17 as a whole.[106]

All reported cases in the area of criminal infringement have arisen under section 104 of the 1909 Copyright Act, but since the fundamental principles of criminal infringement were basically unchanged in the 1976 revision, these cases are still viable for interpretive purposes of the new law.

[101] *See* notes 92–97 & accompanying text *supra*.
[102] M. NIMMER, *supra* note 33, § 15.01, at 15-4.
[103] *Id.* at 15-1.
[104] *See* notes 139–51 & accompanying text *infra*.
[105] *See* notes 117–38 & accompanying text *infra*.
[106] 176 F. Supp. 630 (S.D. Tex. 1959).

THE ELEMENTS OF AN ACTION UNDER SECTION 506(A)

AN INFRINGEMENT

A prerequisite for an action under section 506(a) is that the government must prove that there was an unauthorized reproduction of a copyrighted work, *i.e.*, an infringement. Basic to both civil and criminal infringement are two findings: (1) ownership of a valid copyright by a person other than the alleged infringer and (2) an unauthorized reproduction of the copyrighted work by the accused.[107]

Registration is a statutory prerequisite to the commencement of an infringement action (civil or criminal)[108] under the 1976 Copyright Act,[109] and with respect to registration, section 410(c) of the Act further provides that the certificate of registration of a copyrighted work "shall constitute prima facie evidence of the validity of the copyright and of the facts stated in the certificate."[110] These prima facie presumptions have been employed in the area of criminal infringement in order to supply proof that a valid copyright existed at the time of the alleged infringement[111] and to supply evidence of the date of fixation of copyrighted sound recordings.[112] Presumably, the certificate also serves to provide other rebuttable evidence in criminal infringement actions, such as the fact that ownership of the copyright infringed was vested in someone other than the alleged infringer.[113]

Since this analysis is limited to the situation where an

[107] *Id.* at 633.

[108] M. NIMMER, *supra* 33, § 13.01, at 13-3.

[109] United States v. Backer, 134 F.2d 533, 535 (2d Cir. 1943).

[110] 17 U.S.C. § 411 (1976).

[111] *Id.* § 410(c).

[112] *See, e.g.*, United States v. Sherman, 576 F.2d 292, 296 (10th Cir.), *cert. denied*, 439 U.S. 913 (1978); United States v. Taxe, 380 F. Supp. 1010, 1016–17 (C.D. Cal. 1974), *aff'd*, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977); United States v. Rose, 149 U.S.P.Q. 820, 823 (S.D.N.Y. 1966).

[113] United States v. Taxe, 540 F.2d 961, 966 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977). *See* United States v. Backer, 134 F.2d 533, 536 (2d Cir. 1943).

identical copy of a copyrighted work is made,[114] it may not be too difficult for the government to prove that the alleged infringer made an unauthorized reproduction. For instance, in the case of sound recordings, most of the reported criminal infringement cases have involved defendants who were directly involved in both the manufacture and distribution of unlawfully produced phonorecords.[115] Proof of infringement in these cases was made by direct evidence of unauthorized manufacture.[116]

[114] The propriety of the government's use of the presumptions arising from the certificate of copyright registration in criminal infringement cases has been questioned. *See* Grumar, *supra* note 11, at 74–76. Two reasons are posited as to why such presumptions are out of place in a criminal action. First, by presuming the facts in the certificate to be true, the court is presuming one of the elements of the offense—a valid copyright—against the accused, rather than following the established rule that a criminal defendant is innocent until proven guilty as to every element of the offense. Second, the use of the registration certificate at trial is hearsay, because it is an out-of-court statement used to prove the truth of the matter asserted. *Id.*

While these are, of course, valid concerns, the courts that have allowed the introduction of such certificates into evidence in criminal infringement actions have apparently done so with temperance, clearly noting that the defendant had the opportunity to offer evidence contravening the facts stated in the certificates. For example, in United States v. Taxe, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977), a criminal action for record/tape piracy, the court of appeals stated:

> While the certificates are hearsay when offered to prove the truth of the date thereon, the certificates should be deemed at least prima facie accurate about the dates of fixation until the contrary appears. There was no known reason for them to be inaccurate. Appellants offered no proof, and have suggested no basis for attacking the validity of any particular fixation dates. Absent a concrete showing of lack of trustworthiness, the admission of the certificates and the attendant instruction was proper.

Id. at 966. *See also* United States v. Rose, 149 U.S.P.Q. 820, 823 (S.D.N.Y. 1966) (in the jury instructions, the trial judge noted that certificates of copyright were placed in evidence by the government to prove the existence of valid copyrights at the time of the alleged infringement and no proof to the contrary was proffered by the defendant).

[115] *See* notes 90–96 & accompanying text *supra*.

[116] *See* United States v. Heilman, 614 F.2d 1133 (7th Cir.), *cert. denied*, 447 U.S. 922 (1980); United States v. Moore, 604 F.2d 1228 (9th Cir. 1979); United States v. Taxe, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977); United States v. Blanton, 531 F.2d 442 (10th Cir. 1975), *cert. denied*, 425 U.S. 935 (1976); United States v. Malicoate, 531 F.2d 439 (10th Cir. 1975); United States v. Bodin, 375 F. Supp. 1265 (W.D. Okla. 1974).

In those instances in which the infringement prosecution is brought only on the basis of the unauthorized distribution of copyrighted works, the government is faced with a much more formidable case. "Implicit in its burden of proof on infringement by vending is the duty to prove the absence of a first sale as to those copyrighted articles which the defendant is charged with infringing."[117] What constitutes a "first sale" and the difficulties involved in proving its absence have posed substantial problems for government prosecutors.

Before examining the first sale doctrine in criminal infringement, it is necessary to understand what it represents.

> [T]he first sale doctrine provides that where a copyright owner parts with title to a particular copy of his copyrighted work, he divests himself of his exclusive right to vend that particular copy. While the proprietor's other copyright rights (reprinting, copying, etc.) remain unimpaired, the exclusive right to vend the transferred copy rests with the vendee, who is not restricted by [the copyright] statute from further transfers of that copy, even though in breach of an agreement restricting its sale.[118]

If the government can prove that no authorized copies of a copyrighted work have been sold, an irrebuttable presumption is raised that any copy of that work found in the possession of the accused was either stolen from the copyright owner or unauthorized. This may be quite difficult to prove, however, when the copyrighted work has been the subject of widespread distribution by license. This was the very problem that faced the Ninth Circuit in three 1977 cases involving copyrighted motion picture infringements.[119]

[117] *See* Lindenberg-Woods, *supra* note 10, at 82.

[118] United States v. Wise, 550 F.2d 1180, 1190 (9th Cir.), *cert. denied*, 434 U.S. 929 (1977).

[119] 550 F.2d at 1187 (footnote omitted). If a vendee breaches an agreement not to sell the transferred copy, he may be liable for the breach, but the sale does not constitute an infringement. *See* Independent News Co. v. Williams, 293 F.2d 510, 515–17 (3d Cir. 1961); Harrison v. Maynard, Merrill & Co., 61 F. 689, 691 (2d Cir. 1894).

The first sale doctrine is not of judicial origin but arises from the language of § 27 of the 1909 copyright laws (currently codified at 17 U.S.C. § 202 (1976),

In *United States v. Wise*,[120] the court partially overturned a criminal infringement conviction for the vending of feature-length motion pictures. After outlining the scope and nature of the first sale doctrine and thoroughly examining the facts, the court found that the government had not sustained its burden of proving the absence of a first sale of two of the films allegedly infringed. This result was reached because those films, although purportedly only licensed, in effect had been sold to television networks and studio V.I.P.s.[121]

The detailed factual analysis of *Wise* was again employed by the court of appeals in *United States v. Drebin*.[122] However, in *Drebin*, which also involved motion picture infringement by vending, the opposite result was reached. Since the court could find no evidence of a first sale of the allegedly infringed films,[123] the convictions for criminal infringement were upheld.

The final case in this Ninth Circuit triad is *United States v. Atherton*,[124] in which the defendant had bought and sold prints of motion pictures and was subsequently convicted of criminal infringement under section 104. On appeal, the

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which makes the distinction between the copyright and the material object embodying the copyright. *See* H.R. REP. No. 2222, 60th Cong., 2d Sess. 1909). This doctrine is also a factor in civil actions for infringement by vending. *See, e.g.*, American Int'l Pictures, Inc. v. Foreman, 576 F.2d 661 (5th Cir. 1978); Platt & Munk Co. v. Republic Graphics, Inc., 315 F.2d 847 (2d Cir. 1963); Fawcett Publications, Inc. v. Elliott Publishing Co., 46 F. Supp. 717 (S.D.N.Y. 1942).

[120] Prior to 1977, only two criminal infringement cases were reported that dealt with the first sale doctrine: United States v. Bily, 406 F. Supp. 726 (E.D. Pa. 1975), and United States v. Wells, 176 F. Supp. 630 (S.D. Tex. 1959). In neither case did the government meet its burden of proving the absence of a first sale.

[121] 550 F.2d 1180 (9th Cir.), *cert. denied*, 434 U.S. 929 (1977).

[122] 550 F.2d at 1190–92. Wise also claimed that the sale of worn-out film stock to film salvage companies constituted a first sale, but the court rejected this claim on the facts before it. *Id.* at 1192–93. *But see* Independent News Co. v. Williams, 293 F.2d 510 (3d Cir. 1961); Harrison v. Maynard, Merrill & Co., 61 F. 689 (2d Cir. 1894).

[123] 557 F.2d 1316 (9th Cir. 1977), *cert. denied*, 436 U.S. 904 (1978).

[124] 557 F.2d at 1326–28. In reaching this determination, the court again conducted a detailed examination of all license agreements, V.I.P. contracts, and sales of film for salvage.

Atherton court determined that there were five elements the government must prove beyond a reasonable doubt in a section 104 prosecution for infringement by vending: "(1) Infringement of a copyright, (2) of a work that has not been the subject of a 'first sale,' (3) done willfully, (4) with knowledge that the copyrighted work has not been the subject of a 'first sale,' and (5) for profit."[125] Atherton's conviction was reversed because the court found the government not only had failed to prove the absence of a first sale but also had failed to prove the necessary scienter element.[126] By adding the requirement of knowledge on the part of the infringer (that the copies he is selling have not been subject to a first sale), the court has limited the scope of criminal liability when the infringing conduct involves only the unauthorized vending of a copyrighted work. This is a desirable limitation, however, since many retailers of unauthorized copies of copyrighted works may not possess the requisite knowledge for criminal liability.

This first sale problem was also specifically addressed in several recent cases involving the infringement of sound recordings by vending. Upon conviction under section 104, the defendant in *United States v. Whetzel*[127] argued that the government had not sufficiently proved the absence of a first sale. Whetzel asserted that the government had not negated the possibility that the vended eight-track tapes were manufactured and distributed under sublicenses granted by licensees of the copyright proprietors. Disagreeing with this contention and pointing out that the defendant was overstating the government's burden, the court held that the government "was not required to disprove every conceivable scenario in which [the defendant] would be innocent of infringement."[128] In

[125] 561 F.2d 747 (9th Cir. 1977).
[126] *Id.* at 749.
[127] *Id.*
[128] 589 F.2d 707 (D.C. Cir. 1978).

this case, the circumstantial evidence that the tapes vended were unauthorized[129] was so overwhelming that the court stated: "The tapes Whetzel peddled *obviously* were never the subject of 'first sale' transactions entered into by copyright holders or their agents . . ."[130]

A similar holding was reached in *United States v. Moore*,[131] where the defendants were also convicted of criminal infringement for the distribution of unauthorized sound recordings. Contending that the government failed to prove the absence of a first sale, these defendants argued that the government must completely account for the distribution of all authorized phonorecords of the copyrighted sound recordings to satisfy its burden. Upon reviewing the circumstances of the case and finding "a total absence of evidence suggesting that the tapes were legitimate,"[132] the court held that "evidence suggesting that the tapes had an illegitimate origin negates the possibility of a valid first sale as much as proof from tracing the distribution of the tape to its original source."[133]

The *Whetzel* and *Moore* decisions appear to remove some of the "first sale" obstacles that the government faced in earlier cases involving motion pictures. However, even with this lightened burden, the government apparently must still prove a knowledge on the part of the accused either that the copies of the copyrighted work that he is vending were not lawfully manufactured[134] or that there was no first sale of copies of the copyrighted work that he is selling.

Forcing the government to trace the origins of the particu-

[129] *Id.* at 711.

[130] Whetzel sold the tapes out of a van in a parking lot, with labels that listed a manufacturer with a nonexisting address and with a price of one dollar per tape. *Id.* at 709, 712. The court went so far as to say "there was a complete absence of anything that would suggest that the tapes were legitimate." *Id.* at 712.

[131] *Id.* at 712 n.21 (emphasis added).

[132] 604 F.2d 1228 (9th Cir. 1979).

[133] *Id.* at 1233.

[134] *Id.* at 1232–33.

lar copy of a copyrighted work found in the possession of the accused may present a virtually impossible task. In the House Report on the 1976 Copyright Act, there is language to the effect that to require a copyright proprietor to prove that a particular copy of a copyrighted work in the possession of an alleged infringer was neither lawfully manufactured nor acquired is an impossible and unfair burden.[135] These statements were made in response to a civil case, *American International Pictures, Inc. v. Foreman*,[136] which held that a civil plaintiff indeed carries such a burden. Consistent with the established legal principle that the burden of proof should not be placed upon a litigant to establish facts peculiarly within the knowledge of his adversary, Congress in this House Report expressed its intent that under the 1976 Act, an alleged infringer would bear the burden of proving that the copies of a work in his possession were lawfully manufactured or acquired.[137]

> Such a burden may not be unreasonable in a civil case. . . .
>
> However, to shift the burden of proof in a criminal infringement case whereby a defendant must prove a clear chain of title to [copies] in his possession to avoid being found guilty of a misdemeanor clearly violates due process. The Supreme Court has consistently held that the prosecution bears the burden of proving beyond a reasonable doubt each element of an alleged crime.[138]

Although this factor presents no problem when the evidence clearly indicates the illegality of the copies being vended, the carrying of this burden of proof may still prove troublesome when such a showing is not so obvious.

[135] *See, e.g.*, United States v. Muhammad, [1980] 471 PAT. T.M. & COPYRIGHT J. A–21 (M.D. Tenn. Oct. 29, 1979), where the court held that a defendant charged with criminal copyright infringement as a result of selling "bootleg" tapes could not use the "first sale" doctrine as a defense and stated: "The illegality of the tapes makes it unnecessary for the Government to prove the absence of a first sale."

[136] HOUSE REPORT, *supra* note 41, at 80–81.

[137] 400 F. Supp. 928 (S.D. Ala. 1975), *rev'd*, 576 F.2d 661 (5th Cir. 1978).

[138] HOUSE REPORT, *supra* note 41, at 80–81.

WILLFUL INTENT

For an infringement to invoke criminal liability under section 506(a), the alleged infringer must have acted "willfully." This element, which has never been a requirement in civil infringement actions, has been a required aspect of criminal copyright infringement since 1897.[139] Since willfulness is a question of intent, direct proof is rarely available, and its presence will generally be inferred by examining "the critical facts known by the defendant."[140] In other words, willfulness is almost always established by circumstantial evidence.[141]

The establishment of this element of criminal infringement does not appear to have presented too many problems for the courts.[142] Although commentators have disagreed on whether "willfully" means an intent to copy, or an intent to infringe,[143] the courts appear willing to employ the generally

[139] Lindenberg-Woods, *supra* note 10, at 80–81 (footnote omitted). *See* American Int'l Pictures, Inc. v. Foreman, 576 F.2d 661, 663–64 & 663 n.2 (5th Cir. 1978). *But cf.* Nolan, *A Brighter Day for the Magic Lantern: Thoughts on the Impact of the New Copyright Act on Motion Pictures*, 11 LOY. L.A.L. REV. 1, 37 (1977) (first sale doctrine burden of proof presumed to be the same whether raised in civil or criminal context).

A more extensive analysis of the issues raised in allocating the first sale doctrine burden of proof in a criminal infringement action is provided in Note, *Burden of Proving First Sale Under the Copyright Act of 1976*, 67 GEO. L.F. 293, 298–99, 310–12 (1978). This commentator concludes that "the Government should always bear the burden of proving the absence of a first sale." *Id.* at 312.

[140] Congress first made willfulness an element of criminal infringement in Act of Jan. 6, 1897, ch. 4, 29 Stat. 481 (1897), which provided that an unauthorized public performance of a copyrighted dramatic or musical composition, if done *willfully* and for profit, was a misdemeanor.

[141] United States v. Heilman 614 F.2d 1133, 1138 (7th Cir.), *cert. denied*, 447 U.S. 922 (1980). *See also* United States v. Sherman, 576 F.2d 292, 296–97 (10th Cir.), *cert. denied*, 439 U.S. 913 (1978).

[142] United States v. Rose, 149 U.S.P.Q. 820, 824–25 (S.D.N.Y. 1966).

[143] *See, e.g.*, United States v. Heilman, 614 F.2d 1133, 1137–38 (7th Cir.), *cert. denied* (1980); United States v. Wise, 550 F.2d 1180, 1195–96 (9th Cir.), *cert. denied*, 434 U.S. 929 (1977); United States v. Backer, 134 F.2d 533, 535 (2d Cir. 1943).

"accepted definitions of willfulness."[144] For purposes of section 506(a), the element should be satisfied if the infringer knew the relevant facts concerning the commission of the offense and acted deliberately and knowingly in infringing a copyright. A mere intent to copy would not be enough.[145]

FOR PURPOSES OF COMMERCIAL ADVANTAGE OR PRIVATE FINANCIAL GAIN

For an act to constitute criminal infringement under section 506(a), it must be committed "for purposes of commercial advantage or private financial gain." This aspect of criminal copyright infringement superficially serves to distinguish it from civil infringement. In most cases, the fact that an infringement was done for commercial or private gain is not something a copyright proprietor must prove in a civil infringement action. There are, however, instances under the 1976 Copyright Act when such a showing may be necessary to obtain a civil judgment of infringement.[146] In fact, in-

[144] *Compare* M. NIMMER, *supra* note 33, § 15.01, at 15-3 n.13, *with* Grumar, *supra* note 11, at 70–71. For further discussion on the requirement of willfulness in criminal copyright infringement, *see* Gawthrop, *supra* note 5, at 164–65; Lindenberg-Woods, *supra* note 10, at 72–73; Wicher, *supra* note 5, at 396.

[145] United States v. Heilman, 614 F.2d 1133, 1138 (7th Cir.), *cert. denied*, 447 U.S. 922 (1980). In this case, which involved a criminal copyright conviction under § 104, the court of appeals looked to the United States Supreme Court for guidance in ascertaining the "accepted" definition of willful intent. The court adopted the definition of "willful" used in United States v. Murdock, 290 U.S. 389 (1933), as the standard for criminal infringement:

> The word often denotes an act which is intentional, or knowing, or voluntary, as distinguished from accidental. But when used in a criminal statute it generally means an act done with a bad purpose . . . without justifiable excuse . . . stubbornly, obstinately, perversely. . . . The word is also employed to characterize a thing done without ground for believing it is lawful . . . or conduct marked by careless disregard whether or not one has the right so to act.

Id. at 394–95 (citations omitted). *See* Screws v. United States, 325 U.S. 91 (1945); 22 C.J.S. *Criminal Law* § 31(4) (1961).

[146] Under this approach, an innocent infringer (one who did not know that the work being copied was copyrighted) would never be criminally liable for copyright infringement. "Thus the omission of a copyright notice on [authorized] copies of the copyrighted work would seem to negate the 'knowing' intent required for criminal liability." Lindenberg-Woods, *supra* note 10, at 72.

stances may arise where a profitable purpose is a required element for civil infringement liability, but no finding of criminal liability may be possible.[147]

Ascertainment of the purpose of an alleged infringer's conduct as in a determination of willfulness is an attempt to determine that person's state of mind and the result generally hinges on circumstantial evidence.[148] This element of criminal infringement should not ordinarily pose much difficulty to government prosecutors, however, since the types of infringing conduct most suited to the imposition of criminal liability (large-scale commercial piracy operations) are obviously entered into for profitable purposes.[149] These operations, where there is a direct commercial advantage or private financial gain, are the kinds of "flagrant and economically harmful types of infringement for which criminal penalties

[147] The commercial/noncommercial use of a copyrighted work may play a critical role in determining whether a particular use of a work is a fair use or falls within the infringement exemption sections of the copyright law. *See* 17 U.S.C. § 107 (1976) (fair use exemption), *id.* § 108(a)(1) (library exemption); *id.* § 110(1) (education exemption); *id.* § 110(2) (educational transmission exemption); *id.* § 110(5) (commercial establishment exemption); *id.* § 110(9) (transmission for handicapped exemption); *id.* § 111(a)(1) (hotel/apartment house relay exemption); *id.* § 116(a), (e)(1)(B) (jukebox exemption); *id.* § 118 (public broadcast entity exemption). Except for fair use, a direct or indirect commercial advantage will automatically result in the loss of an exemption and present the possibility of civil and criminal infringement liability.

[148] Discussing the "for profit" aspect in the civil and criminal contexts under § 104 of the 1909 copyright laws, one commentator noted:

> In civil cases it is irrelevant that the gain may be only an indirect result of the infringement. But criminal statutes are subject to the dual principles of strict construction and *mens rea*, and these would operate to narrow the scope of the profit requirement when applied to criminal cases. . . . Consequently, the profit in a criminal infringement apparently must inure to the defendant as a more direct result of the infringement than would suffice for a civil case, so as to make the defendant aware that he is profiting, and to make it quite clear that it involves the type of commercial activity which the statute was designed to prohibit.

Grumar, *supra* note 11, at 72 (footnote omitted). This narrowing of criminal liability may have been the case under the "for profit" language of § 104, but with the new "for the purpose of" language of § 506(a), criminal liability may have been broadened. *See* notes 42–45 & accompanying text *supra*.

[149] United States v. Rose, 149 U.S.P.Q. 820, 825 (S.D.N.Y. 1966).

should be imposed."[150] Prosecutors should exercise discretion in the bringing of actions under section 506(a), pursuing for the most part, only large-scale commercial infringers who realize a direct financial advantage from their conduct. The sanctions of criminal infringement should be imposed in a situation of indirect commercial advantage only when the possible civil remedies have been completely exhausted in attempts to obtain infringement relief.[151]

EFFECT OF A CRIMINAL INFRINGEMENT CONVICTION IN A SUBSEQUENT CIVIL SUIT

Since both criminal and civil liability may arise from the same conduct, once a criminal infringement conviction has been obtained, may any portion of that finding be employed by the copyright proprietor to obtain a civil judgment against the convicted infringer? There have been no reported copyright cases that discuss this question,[152] but it appears that the principles of collateral estoppel could be effectively employed in a subsequent civil infringement action in order to give conclusive effect to common issues previously litigated in the criminal case.[153]

In its traditional sense, collateral estoppel simply means that "when an issue of ultimate fact has once been determined by a valid and final judgment, that issue cannot again be litigated between the same parties in any future lawsuit."[154] The

[150] *See, e.g.*, United States v. Wise, 550 F.2d 1180 (9th Cir.), *cert. denied*, 434 U.S. 929 (1977).

[151] *See* Lindenberg-Woods, *supra* note 10, at 72.

[152] *Id.*

[153] *But see* Lees, *Psst: Get Your Hot Glen Campbell Tapes Here*, N.Y. Times, Dec. 1, 1974, § 2, at 21, col. 1. This New York Times article reported the initial decision in United States v. Taxe, 380 F. Supp. 1010 (C.D. Cal. 1974), *aff'd*, 540 F.2d 961 (9th Cir. 1976), *cert. denied*, 429 U.S. 1040 (1977), and noted that civil suits were filed by the recording companies whose albums had been pirated.

[154] It does not follow that the reverse is true, however, because of the differing standards of proof, an issue determined in a civil action is *not* precluded from relitigation in a later criminal prosecution.

underlying purpose of collateral estoppel is to preclude repeated controversy over matters judicially determined; it is a "reasonable measure calculated to save individuals and courts from the waste and burden of relitigating old issues." [155] This concept, sometimes more precisely termed "issue preclusion," [156] does not act to prevent inquiry into matters that may not have been placed in issue and determined in the prior action.

GENERAL REQUIREMENTS FOR COLLATERAL ESTOPPEL EFFECT

Before any determination made in a former action can be given collateral estoppel effect, there are at least four elements that must be satisfied: (1) the issue sought to be precluded must be the same as that involved in the prior action, (2) that issue must have been actually litigated, (3) that issue must have been determined by a valid and final judgment, and (4) the determination must have been essential to the prior judgment.[157] If these conditions are met, then the

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The collateral estoppel effect of criminal convictions has sometimes been confused with the question of admissibility under a hearsay exception of prior judgments of conviction as rebuttable evidence of issues previously adjudicated. R. CASAD, RES JUDICATA § 5-73, at 257 (1978). *Cf., e.g.*, FED. R. EVID. 803(22) (admissibility of evidence of previous felony conviction); note 158 *infra* (statutory rule in antitrust instances).

[155] Ashe v. Swenson, 397 U.S. 436, 443 (1970). This traditional view, which requires identity of parties in both actions, has been broadened so that it is available to the copyright proprietor in a situation such as discussed herein. *See* notes 159–70 & accompanying text *infra*.

[156] Tillman v. National City Bank of New York, 118 F.2d 631, 634 (2d Cir.), *cert. denied*, 314 U.S. 650 (1941).

[157] F. JAMES, JR. & G. HAZARD, JR., CIVIL PROCEDURE § 11.16 (2d ed. 1977); RESTATEMENT (SECOND) OF JUDGMENTS §§ 68, 68.1 (Tent. Draft No. 1, 1973). *See also* R. CASAD, *supra* note 153, § 5-1, at 123:

> Basically, the rule of issue preclusion is as follows: An issue essential to the judgment rendered, which was actually litigated and determined by a court having jurisdiction of subject matter and over the person of the parties, may not be relitigated by the same parties or those in privity with them.

issue in question is precluded from a reexamination in a subsequent action.[158]

TRADITIONAL DIFFICULTIES IN INVOKING COLLATERAL ESTOPPEL FROM CRIMINAL TO CIVIL ACTIONS

Two factors may serve to limit the use of the collateral estoppel effect of a criminal conviction in a later civil suit, even where the issues in question are identical. One is the doctrine of mutuality; the other is the different standard of proof required in criminal as opposed to civil proceedings.

The Doctrine of Mutuality. The doctrine of mutuality, now on the wane, essentially required identity of parties for the application of collateral estoppel. If the second action involved different parties, then an issue decided in the earlier action is *not* precluded from consideration in the second action, even if one of the parties had been a party in the first action and had unsuccessfully litigated the issue in question on that occasion.[159] The mutuality doctrine had gained nearly universal acceptance until it was initially repudiated in 1942 in the leading case of *Bernhard v. Bank of America.*[160] The California Supreme Court in *Bernhard,* developed a formula, known as the *Bernhard* rule, for determining whether a prior decision would be given collateral estoppel effect: "Was the

[158] *See* F. JAMES, JR. & G. HAZARD, JR., *supra* note 157, §§ 11.16–19; 1B MOORE'S FEDERAL PRACTICE ¶ 0.443[1] (2d ed. 1974).

[159] *Cf.* note 154 *supra* (not possible to preclude issues from civil to criminal actions).

There is one instance, the area of antitrust litigation, where the fulfilling of these conditions results in a different effect. Section 5(a) of the Clayton Act (15 U.S.C. § 16(a) [1976]) provides that a prior judgment adevrse to the defendant in any civil or criminal antitrust proceeding brought by or on behalf of the United States shall have prima facie evidentiary effect only in subsequent private suits against the same defendant. Consequently, a beleaguered defendant may still offer evidence to rebut findings in the prior action, conduct that would not be possible if those findings were given conclusive effect. *See* Sam Fox Publishing Co. v. United States, 366 U.S. 683, 690 (1961); Illinois v. General Paving Co., 590 F.2d 680, 681–83 (7th Cir.), *cert. denied,* 100 S. Ct. 168 (1979); Note, *Section 5(a) of the Clayton Act and Offensive Collateral Estoppel in Antitrust Damage Actions,* 85 YALE L.J. 541 (1976).

[160] F. JAMES, JR. & G. HAZARD, JUR., *supra* note 157, § 11.24, at 578.

issue decided in the prior adjudication identical with the one presented in the action in question? Was there a final judgment on the merits? Was the party *against* whom the plea is asserted a party or in privity with a party to the prior adjudication?"[161]

Although many jurisdictions adopted the *Bernhard* rule, the United States Supreme Court did not follow suit until 1971. In a civil patent infringement action, *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*,[162] the Court held that the holder of a patent, who had lost a prior action to enforce the patent on the ground that the patent was invalid, was bound by the determination of invalidity in a subsequent action against another alleged infringer.[163] As a result of this ruling, the *Bernhard* rule gained still greater acceptance and was ultimately adopted in the *Restatement (Second) of Judgments*.[164]

The demise of the doctrine of mutuality still left some question as to whether issue preclusion could be invoked "offensively," *i.e.*, where a plaintiff seeks to estop a defendant from relitigating issues that the defendant previously litigated and lost against another plaintiff.[165] The Supreme Court recently addressed this question in *Parklane Hosiery Co. v. Shore*,[166] in which a plaintiff in a civil action sought to preclude the defendant from relitigating issues that the defendant had unsuccessfully litigated in a prior civil action brought by the Securities and Exchange Commission. In accord with the trend of recent authority to the effect that there is no intrinsic difference between "offensive" and "defensive" issue preclusion,[167] the Court held that "the preferable ap-

[161] 19 Cal. 2d 807, 122 P.2d 892 (1942).
[162] *Id.* at 813, 122 P.2d at 895 (emphasis added).
[163] 402 U.S. 313 (1971).
[164] *Id.* at 349–50.
[165] RESTATEMENT (SECOND) OF JUDGMENTS § 88 (Tent. Draft No. 2, 1975).
[166] *See id.* § 88, at 99, Reporter's Note.
[167] 439 U.S. 322 (1979).

proach for dealing with these problems in the federal courts is not to preclude the use of offensive collateral estoppel but to grant trial courts broad discretion to determine when it should be applied."[168] The Court noted that in exercising such discretion, a trial court should not allow offensive issue preclusion where the plaintiff could easily have joined the earlier action or where its application would be unfair to the defendant.[169] Since both of these qualifications on the use of offensive issue preclusion would be satisfied, the doctrine of mutuality should no longer present an obstruction to the application of collateral estoppel against a convicted copyright infringer in a subsequent civil action brought by the copyright proprietor.[170]

Differing Standards of Proof. While the differences in burden of proof between civil and criminal actions may limit the collateral estoppel effect of certain judgments[171] in a former criminal action, a judgment of conviction is generally held to be conclusive in a later civil action. The accepted rule is that because a defendant is surrounded by greater safeguards in criminal rather than civil litigation and because the standard of proof to which the complainant is held is much higher, a judgment of conviction is conclusive in civil litigation between the defendant and the party whose rights he was convicted of invading as applied to issues that were litigated and adjudicated in the criminal prosecution.[172] The only obstacles

[168] RESTATEMENT (SECOND) OF JUDGMENTS § 88, at 99, Reporter's Note (Tent. Draft No. 2, 1975).

[169] 439 U.S. at 331.

[170] *Id.* at 329–33.

[171] A private party certainly cannot join the government in a criminal action, and with the higher burden of proof and other attendant safeguards in criminal proceedings, it is difficult to conceive of a situation in which such an application of offensive issue preclusion in a subsequent civil action would be unfair to the defendant, although such a situation may undoubtedly arise. *See generally id.* at 330–31.

[172] If the prior criminal prosecution resulted in an acquittal, that action concludes no issues of civil liability in favor of the defendant because a failure to show criminal liability beyond a reasonable doubt does not preclude the possibility that civil liability can be shown by a preponderance of the evidence. 1B

to giving collateral estoppel effect to a conviction in a later civil action would seem to be those applying to issue preclusion generally.[173]

COLLATERAL ESTOPPEL AND COPYRIGHT

Much has been written about the concept of collateral estoppel, but it has not heretofore been considered in the context of federal copyright law. Naturally, to preclude an issue in a later action by collateral estoppel, all of the usual conditions must be fulfilled.[174] In the case of a civil infringement action brought by a copyright proprietor against a defendant previously convicted of infringing the proprietor's copyrights, the conditions would appear to be satisfied. The issue sought to be precluded—the occurrence of an infringement—has already been litigated and determined in a valid, final judgment,[175] and that issue was certainly essential to the prior criminal action. The differences in standards of proof and moving parties in the two actions do not act to diminish the effect of such an application of collateral estoppel.

MOORE'S FEDERAL PRACTICE ¶ 0.418[1], at 2703–04 (2d ed. 1980); *Developments in the Law—Res Judicata*, 65 HARV. L. REV. 818, 879 (1952). A criminal judgment may also fail to receive full collateral estoppel effect when the defendant has pled guilty or nolo contendere. *See* 1B MOORE'S FEDERAL PRACTICE ¶ 0.418[1], at 2706–08 (2d ed. 1980).

In addition, it was once believed that the form of the verdict in a criminal conviction was a factor in determining the collateral estoppel effect in a later civil action. That position is no longer favored:

> [T]he working of an estoppel in a subsequent civil proceeding is not frustrated by the fact that the prior criminal conviction was in the form of a general jury verdict. It is the task of the trial judge in the subsequent civil proceeding to determine through an examination of the pleadings, court opinions if any, and the record of the criminal trial which questions were "'distinctly put in issue and directly determined' in the criminal prosecution."

SEC v. Everest Management Corp., 466 F. Supp. 167, 173 (S.D.N.Y. 1979) (quoting Emich Motors Corp. v. General Motors Corp. 340 U.S. 558, 569 (1951)).

[173] 1B MOORE'S FEDERAL PRACTICE ¶ 0.418[1], at 2703 (2d ed. 1980).

[174] R. CASAD, *supra* note 154, § 5-73, at 257. *See, e.g.*, notes 183–87 & accompanying text *infra*.

[175] *See* text accompanying note 158 *supra*.

As a matter of law, a conviction under section 506(a) must include those elements necessary to make out a civil judgment against an infringer because "criminal copyright infringement incorporates as one of its elements the concept of civil copyright infringement."[176] In addition to proving beyond a reasonable doubt that there was an infringement, the government in a section 506(a) prosecution is also required to prove several additional elements to establish criminal liability, *e.g.*, that the infringement was willful and for purposes of commercial advantage or private financial gain.[177] The application of issue preclusion, in this instance to make out a conclusive case of civil infringement, achieves the kind of result desired by the policies underlying collateral estoppel; granting conclusive effect to the finding of an infringement in a prior 506(a) action avoids the waste and burden of relitigating issues that have already been sufficiently determined.

DIFFICULTIES IN INVOKING COLLATERAL ESTOPPEL IN COPYRIGHT

Shifting Burdens. A conviction of criminal infringement under section 506(a) is a situation perfectly suited to the use of issue preclusion by the aggrieved copyright proprietor. The only obstacle peculiar to copyright law that could possibly prevent a complete preclusion of the infringement issue in a subsequent civil action is a possible shifting of the burden of proof respecting the origin of the infringer's copies.[178]

In a section 506(a) prosecution, the government generally has shown that the defendant's copies are unauthorized by proving either unauthorized manufacture, the absence of a first sale, or the existence of circumstantial evidence that shows the obvious illegality of the copies beyond a reasonable doubt.[179] The government is required to make such proof be-

[176] *But see* note 183 & accompanying text *infra*.
[177] United States v. Bily, 406 F. Supp. 726, 730 (E.D. Pa. 1975).
[178] *See* notes 139–51 & accompanying text *supra*.
[179] *See* notes 136–39 & accompanying text *supra*.

cause of due process considerations—the prosecution bears the burden of proving all the essential elements of an alleged crime.[180] In the House Report on the 1976 Copyright Act, however, Congress expressed its intent that in civil infringement actions the alleged infringer should bear the burden of proving that copies of a copyrighted work in his possession were lawfully manufactured or acquired.[181] This was an attempt by Congress to ease the burden on copyright proprietors who had faced substantial difficulties proving the illegality of the defendant's copies in civil infringement actions.

If this congressional intent and due process are both strictly adhered to, the effect will be a "shifting" of the burden of proof from the prosecution in the criminal action to the defendant in a subsequent civil suit. While this burden change may appear to be a concern, it should have little practical impact on the application of collateral estoppel in this instance. The defendant should be precluded from raising a first sale defense in a civil action if he has already suffered an adverse determination on that issue beyond a reasonable doubt in the criminal proceeding. To allow this shift in burden to prevent the complete preclusion of the infringement issue would be a rather peculiar result, since both the application of collateral estoppel and Congress' stated intent purportedly benefit the copyright proprietor.

The Unpredictability of Collateral Estoppel Application. As issue preclusion and the *Bernhard* rule became refined through experience and application, a two-step process of factual determination evolved:

> The first inquiry is whether the person against whom preclusion is to be applied had a full and fair opportunity to litigate the issue in the first action—an opportunity at least equivalent to that which he would have in the second action. If it appears that he did have such an opportunity, issue preclusion presumptively applies—that is, the party

[180] *See* notes 115–39 & accompanying text *supra*.
[181] *See* Lindenberg-Woods, *supra* note 10, at 80–81.

against whom the issue was resolved cannot relitigate the issue *unless he can show a good reason why he should be enabled to do so.*[182] The reasons that may justify relitigation are several and have been catalogued by the *Restatement (Second) of Judgments.*[183] For example, if the prior determination is of dubious reliability (inconsistent with another determination of the same issue, affected by relationships between the parties, etc.) or if treating the issue as conclusive would prejudice another party involved in the second action, the defendant may deserve an opportunity to relitigate that particular issue. This Restatement list is not meant to be exclusive. In fact, the final clause states the broad rule that "other compelling circumstance" may also justify allowing a party to relitigate a particular issue.[184]

Because of these exceptions, the effect of collateral estoppel in copyright, as well as any other area of law, is not as ironclad as it may first appear. These exceptions give the application of issue preclusion "a substantial degree of flexibility, [and] the question of preclusion now depends to an important degree on 'sound judicial discretion'"[185] The resulting unpredictability of an attempt at issue preclusion invokes an inherent uncertainty among lawyers as to whether it should even be relied upon in a particular case.[186] Nevertheless, from the copyright proprietor's point of view, a rejection of issue preclusion by the court is not a great setback. The proprietor still has an opportunity to prove civil infringement—the task is merely made a bit more burdensome.

Statute of Limitations. All infringement actions are subject

[182] HOUSE REPORT, *supra* note 41, at 80–81.

[183] F. JAMES, JR. & G. HAZARD, JR., *supra* note 157, § 11.25, at 583 (emphasis added).

[184] RESTATEMENT (SECOND) OF JUDGMENTS § 88(1)–(8), Appendix (Tent. Draft No. 3, 1976). *See* Parklane Hosiery Co. v. Shore, 439 U.S. 322, 330–31 (1979).

[185] RESTATEMENT (SECOND) OF JUDGMENTS § 88(8), Appendix (Tent. Draft No. 3, 1976).

[186] F. JAMES, JR. & G. HAZARD, JR., *supra* note 157, § 11.25, at 583. *See* Parklane Hosiery Co. v. Shore, 439 U.S. 322 (1979).

to the provisions of section 507 of the Copyright Act,[187] which establishes a three-year statute of limitations for both criminal proceedings and civil actions.[188] Since the limitation periods for both criminal and civil actions presumably begin to run at the same time, a copyright proprietor awaiting the outcome of a criminal prosecution prior to pursuing civil remedies should at least file his case with the proper court so as to preserve his right to bring suit. If he waits for a final judgment in the criminal proceeding, he may find himself without civil recourse by operation of section 507.[189]

CONCLUSION

"The bite of law is in its enforcement."[190] These words, written in 1946 by Justice Felix Frankfurter of the United States Supreme Court, typify the historical role of criminal infringement in the federal copyright scheme. For many

[187] F. JAMES, JR. & G. HAZARD, JR., *supra* note 157, § 11.25, at 583–84.

[188] 17 U.S.C. § 507 (1976).

[189] (a) Criminal Proceedings

No criminal proceeding shall be maintained under the provisions of this title unless it is commenced within three years after the cause of action arose.

(b) Civil Actions

No civil action shall be maintained under the provisions of this title unless it is commenced within three years after the claim accrued.

Id. The language of this provision, adopted in 1957, was not altered in the general revision. HOUSE REPORT, *supra* note 41, at 164.

[190] Although not peculiar to copyright law, an additional concern to the copyright proprietor when bringing a civil suit for damages against a convicted infringer is the possibility that the defendant will be judgment-proof. Of course, this problem does not affect the mechanical aspects of the application of collateral estoppel and although it is merely a practical concern, the financial status of a convicted infringer should certainly be considered before civil remedies are pursued. Presumably, the defendant has just been through the rigors of an unsuccessful criminal defense, including possible appeals, which is not an inexpensive undertaking. In addition, the conviction probably resulted in the levying of fines against the defendant, a further drain on his financial well-being. It should also be noted that large-scale commercial infringement operations are not limited to those with a great deal of capital. In 1979, one recording industry source estimated the costs of going into business as a tape pirate at less than $10,000. S. SHEMEL & M. KRASILOVSKY, *supra* note 77, at 93.

years, the criminal infringement sanctions were ineffective even when enforced, but in the 1970s, the modernization of the criminal infringement provisions by Congress has opened the door for meaningful prosecutions. This is not to imply that the government should prosecute every infringer who satisfies the section 506(a) criteria. The criminal infringement provisions should be utilized only when the infringing conduct is of such magnitude as to substantially encroach upon the artistic and economic rights of a copyright proprietor. In other words, government attorneys should exercise their discretionary powers of prosecution and pursue only those large-scale commercial infringement operations that are able to produce and distribute large quantities of unauthorized copies.[191] Prosecutors must limit themselves to pursuing only those infringers engaged in such activities. "Criminal infringement must not, even to the slightest degree, chill the right of authors and artists to freely borrow ideas and learn from the works of others."[192]

Many of the relationships between the criminal and civil copyright infringement provisions have yet to be tested. However, bringing these two areas of law together by applying the principles of collateral estoppel appears to be quite proper and will make a civil action that much easier for the maltreated copyright proprietor.[193]

[191] Fisher v. United States, 328 U.S. 463 (1946) (Frankfurter, J., dissenting).

[192] Besides violating federal copyright laws, those engaged in and associated with large-scale commercial infringement operations may also be liable for other federal offenses. *E.g.*, 18 U.S.C. § 371 (1976) (conspiracy to commit any offense against the United States); *id.* §§ 1961–1968 (Supp. 1980) (Racketeer Influenced and Corrupt Organizations Act); *id.* § 2314 (1976) (transportation of stolen goods, securities, moneys, fraudulent state tax stamps, or articles used in counterfeiting); *id.* § 2318 (1976) (transportation, sale, or receipt of phonorecords bearing forged or counterfeited labels).

[193] Lindenberg-Woods, *supra* note 10, at 87. *Cf.* Gawthrop, *supra* note 5, at 169 (for criminal infringement to be effective and useful, its benefits must be more directed to the copyright proprietors).

Appendixes

Panels of Judges

SYMPOSIUM NUMBER ONE (1939)

Edward A. Sargoy, Stephen P. Ladas, Edward S. Rogers, Dr. Louis Charles Smith, John H. Wigmore, members of a Committee of the American Bar Association appointed by Thomas E. Robertson, Chairman of the Section of Patent, Trade-Mark and Copyright Law.

SYMPOSIUM NUMBER TWO (1940)

Herman Finkelstein, General Counsel, American Society of Composers, Authors and Publishers

SYMPOSIUM NUMBER THREE (1940)

John H. Wigmore, Dean of Northwestern University School of Law

SYMPOSIUM NUMBER FOUR (1952)

Judge Herbert F. Goodrich, United States Court of Appeals for the Third Circuit

Justice Roger J. Traynor, Supreme Court of the State of California

Judge George T. Washington, Court of Appeals for the District of Columbia Circuit

SYMPOSIUM NUMBER FIVE (1954)

Judge Stanley H. Fuld, Court of Appeals of the State of New York

Chief Judge Leon R. Yankwich, United States District Court for the Southern District of California

SYMPOSIUM NUMBER SIX (1955)

Chief Judge Sam Driver, United States District Court for the Eastern District of Washington

Dean Wesley A. Sturges, President of the American Association of Law Schools

SYMPOSIUM NUMBER SEVEN (1956)

Justice George Rossman, of the Supreme Court of Oregon

Lloyd Wright, President of the American Bar Association

Edward A. Sargoy, Louis E. Swarts, former Chairmen of the Copyright Subsection of the Patent, Trade-Mark and Copyright Section of the American Bar Association

SYMPOSIUM NUMBER EIGHT (1957)
Chief Judge Charles E. Clark, United States Court of Appeals for the Second Circuit
Chief Justice A. Cecil Snyder, Supreme Court of Puerto Rico

SYMPOSIUM NUMBER NINE (1958)
Chief Judge John Biggs, Jr., United States Court of Appeals for the Third Circuit
Chief Judge Simon E. Sobeloff, United States Court of Appeals for the Fourth Circuit
Judge William H. Hastie, United States Court of Appeals for the Third Circuit

SYMPOSIUM NUMBER TEN (1959)
Chief Justice Frank R. Kenison, Supreme Court of New Hampshire
Chief Judge Alfred P. Murrah, United States Court of Appeals for the Tenth Circuit

SYMPOSIUM NUMBER ELEVEN (1962)
Panel for 1959 National Competition
Chief Judge Charles S. Desmond, New York Court of Appeals
Judge David T. Lewis, United States Court of Appeals for the Tenth Circuit
Panel for 1960 National Competition
Justice Tom C. Clark, United States Supreme Court
Chief Justice Paul Reardon, Superior Court of Massachusetts
Judge Elbert P. Tuttle, United States Court of Appeals for the Fifth Circuit

SYMPOSIUM NUMBER TWELVE (1963)
Panel for 1961 National Competition
Justice Walter V. Schaefer, Illinois Supreme Court
Judge Sterry R. Waterman, United States Court of Appeals for the Second Circuit
Panel for 1962 National Competition
Judge Frederick G. Hamley, United States Court of Appeals for the Ninth Circuit
Judge John Minor Wisdom, United States Court of Appeals for the Fifth Circuit

SYMPOSIUM NUMBER THIRTEEN (1964)
Justice Leonard v. B. Sutton, Supreme Court of Colorado
Justice Samuel Freedman, Court of Appeal of Manitoba
Justice James L. McLennan, Supreme Court of Ontario

SYMPOSIUM NUMBER FOURTEEN (1966)
Judge Carl McGowan, Court of Appeals for the District of Columbia Circuit

Judge Charles M. Merrill, United States Court of Appeals for the Ninth Circuit

Justice Haydn Proctor, Supreme Court of New Jersey

SYMPOSIUM NUMBER FIFTEEN (1967)

Judge Roger J. Kiley, United States Court of Appeals for the Seventh Circuit

Judge Francis Bergan, New York Court of Appeals

SYMPOSIUM NUMBER SIXTEEN (1968)

Justice Byron R. White, United States Supreme Court

Congressman Theodore R. Kupferman, of New York

Congressman Robert G. Stephens, of Georgia

Congressman Wendell Wyatt, of Oregon

SYMPOSIUM NUMBER SEVENTEEN (1969)

Chief Judge Stanley H. Fuld, Court of Appeals of the State of New York

SYMPOSIUM NUMBER EIGHTEEN (1970)

Judge Shirley M. Hufstedler, United States Court of Appeals for the Ninth Circuit

Judge Luther M. Swygert, United States Court of Appeals for the Seventh Circuit

Justice Samuel J. Roberts, Supreme Court of Pennsylvania

SYMPOSIUM NUMBER NINETEEN (1971)

Chief Judge Alfred P. Murrah, United States Court of Appeals for the Tenth Circuit and Director, Federal Judicial Center

Chief Justice Robert B. Williamson, Supreme Judicial Court of Maine

Justice Harry A. Spencer, Supreme Court of Nebraska

SYMPOSIUM NUMBER TWENTY (1972)

Lord Richard Wilberforce, Lord of Appeal in Ordinary of England

Justice Paul C. Reardon, Massachusetts Supreme Judicial Court

SYMPOSIUM NUMBER TWENTY-ONE (1973)

Chief Justice Samuel Freedman, Court of Appeal of Manitoba

Justice George Rose Smith, Supreme Court of Arkansas

Justice William M. McAllister, Supreme Court of Oregon

SYMPOSIUM NUMBER TWENTY-TWO (1977)

Walter Derenberg, Professor of Law, New York University School of Law

Edward A. Sargoy, Former Chairman of the Copyright Subsection of the Patent, Trade-Mark and Copyright Section of the American Bar Association

SYMPOSIUM NUMBER TWENTY-THREE (1977)

Chief Judge Stanley H. Fuld, Court of Appeals of the State of New

York and Chairman, National Commission on New Technological Uses of Copyrighted Works

Chief Justice Robert B. Williamson, Supreme Judicial Court of the State of Maine

SYMPOSIUM NUMBER TWENTY-FOUR (1980)

Jefferson B. Fordham, Dean Emeritus, University of Pennsylvania Law School

Page Keeton, Dean Emeritus, University of Texas School of Law

Robert B. McKay, former Dean of the New York University School of Law and Director, Program on Justice, Society, and the Individual, Aspen Institute for Humanistic Studies

SYMPOSIUM NUMBER TWENTY-FIVE (1980)

Charles Clark, Judge of the U.S. Court of Appeals, Fifth Judicial District

Abraham L. Kaminstein, Register of Copyrights, 1960–1971

Page Keeton, Dean Emeritus, University of Texas Law School

SYMPOSIUM NUMBER TWENTY-SIX (1981)

J. Edward Lumbard, U.S. Court of Appeals, Second Circuit

Thomas C. Brennan, Commissioner, Copyright Royalty Tribunal

George D. Cary, Former Register of Copyrights

SYMPOSIUM NUMBER TWENTY-SEVEN (1981)

Charles D. Ferris, Chairman of the FCC

Robert W. Kastenmeier, Congressman from Wisconsin

Barbara A. Ringer, Former Register of Copyrights

SYMPOSIUM NUMBER TWENTY-EIGHT (1982)

Walter Ely, United States Court of Appeals, Ninth Circuit

A. Leon Higginbotham, United States Court of Appeals, Third Circuit

Walter R. Mansfield, United States Court of Appeals, Second Circuit

SYMPOSIUM NUMBER TWENTY-NINE (1983)

Arlin M. Adams, United States Court of Appeals, Third Circuit

Amalya L. Kearse, United States Court of Appeals, Second Circuit

Patricia M. Wald, United States Court of Appeals, District of Columbia Circuit

SYMPOSIUM NUMBER THIRTY (1983)

Mary M. Schroeder, United States Court of Appeals, Ninth Circuit

Charles W. Joiner, United States District Court, Eastern District of Michigan

Theodore R. Kupferman, Supreme Court, State of New York, Appellate Division, First Department

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Number Eighteen

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NATHAN BURKAN
MEMORIAL COMPETITION

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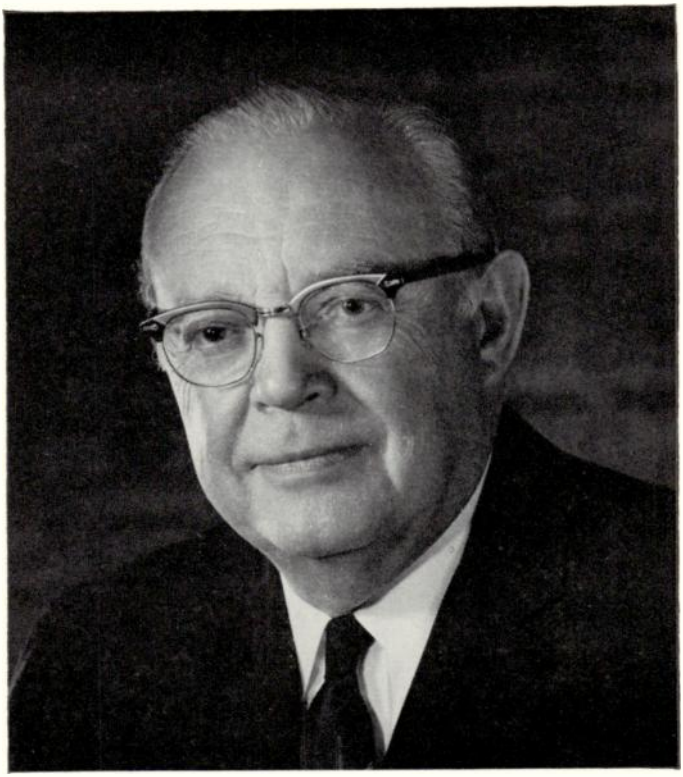
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JUDGE SHIRLEY M. HUFSTEDLER
of the United States Court of Appeals
for the Ninth Circuit



JUDGE LUTHER M. SWYGERT
of the United States Court of Appeals
for the Seventh Circuit



JUSTICE SAMUEL J. ROBERTS
of the Supreme Court of Pennsylvania

Preface

NO MEMORIAL to a lawyer can be professionally more significant than one which regularly challenges and stimulates the imagination, the scholarship, and the creativity of law students at the great centers of legal learning in America. The Nathan Burkan Competition is just such a memorial.

It is particularly fitting that the matrix in which the Competition is set is copyright law, for it is that law which, by measuring and mediating the rights of creative writers and artists, and the interests of the public, both shapes and directs the intellectual growth of our changing society.

This year, as in the past, the Competition has produced papers of outstanding quality. The thirty-five papers submitted to the selection committee contain searching examinations of the problems in the craggiest of copyright terrains. The approach of the writers to the problems was as varied as the problems themselves. The committee has thus been led to the reaches of space, to the perimeters of our globe, to the outer edges of computer technology, and to the inside of the Register.

To select five winners from this array of legal scholars has been a challenging task. We are honored to present those winners to the profession and to let them speak for themselves in their essays which follow.

JUDGE SHIRLEY M. HUFSTEDLER OF THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

JUDGE LUTHER M. SWYGERT OF THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

JUSTICE SAMUEL J. ROBERTS OF THE SUPREME COURT OF PENNSYLVANIA

Foreword

ON BEHALF of the more than 15,000 members of the American Society of Composers, Authors and Publishers, it is a pleasure, once again, to introduce this latest issue of the ASCAP Copyright Law Symposium series.

Volume 18 contains the National Award winning essays of the 30th Annual Nathan Burkan Memorial Competition. The Competition, which was named in honor of the first General Counsel of the Society, who died in 1936, continues to be a source of pride to the Society's many members. The kind words of praise which the Competition has received from distinguished members of the judiciary and of the Bar, from law school deans and professors indicate that the Competition not only stimulates student interest in an area of the law that might otherwise not be explored but is among the prime contributors to the scholarly writing on the law of intellectual property.

The essays in this volume were chosen by a National Panel of Judges consisting of Judge Shirley M. Hufstedler of the United States Court of Appeals for the Ninth Circuit, Judge Luther M. Swygert of the United States Court of Appeals for the Seventh Circuit, and Justice Samuel J. Roberts of the Supreme Court of Pennsylvania, continuing a long line of outstanding jurists who have served as previous judges of the Competition. A complete listing of prior Panels of Judges appears at page 207.

It is fitting to say a few words about each member of this Panel.

After graduating from Stanford University School of Law in 1949, Judge Hufstedler was associated with the Los Angeles

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firm of Beardsley, Hufstedler & Kemble. She served as special legal consultant to the Attorney General of California in connection with Colorado River litigation in 1960 and 1961. Judge Hufstedler's career on the bench commenced with her appointment as Judge of the Superior Court of Los Angeles County in 1961. She was elected Judge of that Court in 1962 and served until 1966 when appointed Associate Justice of the California Court of Appeals. Judge Hufstedler was named to the Ninth Circuit in 1968.

Aside from memberships in professional organizations such as the American and Los Angeles Bar Associations, Judge Hufstedler is a member of the American Judicature Society, American Law Institute, the Institute of Judicial Administration, and of the Board of Trustees of the Institute for Court Management. She has served also as Advisor to the California Commission on the Status of Women in 1966 and 1967 and is at present Advisor to the California State College and the Civic Education Panel for the State Board of Education.

Judge Hufstedler's recent lectures and writings include "To Do Justly" in the 1967 *UCLA Law Review;* "Constitutional Revision and Appellate Court Decongestants" in the 1970 *University of Washington Law Review;* and "The Shape of the Law of Ideas" in the 1969 *Bulletin of the Copyright Society.*

Judge Swygert received his LL.B. degree, magna cum laude, from Notre Dame Law School in 1927, and practiced law in Indiana until 1931, when he was named deputy prosecuting attorney for Lake County, Indiana. In 1934, he was appointed Assistant United States Attorney for the Northern District of Indiana, which position he filled until being named as United States District Judge for the Northern District of Indiana in 1943. Judge Swygert was Chief Judge of that Court from 1954 through 1961, when he was elevated to the United States Court of Appeals for the Seventh Circuit.

Judge Swygert is a member of the American and Ham-

mond Bar Associations, of the American Judicature Society, and of the Indiana Society of Chicago Clubs, Union League.

Justice Roberts received his Bachelor of Science degree in Economics and his LL.B. degree from the University of Pennsylvania in 1928 and 1931, respectively, and practiced in Erie, Pennsylvania, from 1931 until 1935, when he was named Assistant District Attorney for Erie County. From 1939 to 1952, Justice Roberts served as Referee in unemployment compensation cases and as Special Deputy Attorney General for the Commonwealth of Pennsylvania. In 1952, he became Judge of the Orphans' Court of Erie County and served as its presiding judge from 1952 through 1962, at which time he was elected Justice of the Supreme Court of Pennsylvania.

Justice Roberts's many civic commitments include memberships on various civic, educational, and welfare boards and committees. He is a member of the Board of Trustees of Gannon College and is the holder of honorary Doctor of Law degrees from Gannon College, Dickinson School of Law, and Villa Maria College. He serves as a member of the Board of Law of the Law School of the University of Pennsylvania and is Associate Trustee of that university. Justice Roberts is also on the Board of Incorporators of Hamot and St. Vincent Hospitals and serves on the Governor's Advisory Committee of Mental Health and Mental Retardation.

A member of the American Law Institute and the American Judicature Society, he has served as a faculty member of the Appellate Judges Seminar of the Institute of Judicial Administration. Justice Roberts is the author of several articles in professional legal journals.

He is a member of the Judge's Advisory Committee to the Standing Committee on Professional Ethics—American Bar Association; Advisory Committee on the Function of the Judge—American Bar Committee; Minimum Standards for the Administration of Criminal Justice; and the Advisory

Committee—American Law Institute—A Model Land Development Code.

He served as a Lieutenant Commander in the United States Naval Reserve from 1944 through 1946.

To these Judges, who spent many, many hours in reviewing the papers and making their final determinations, goes the sincere appreciation of the members of the Society. And to the five students whose essays are included in this volume go our warmest good wishes for continued success.

HERMAN FINKELSTEIN
GENERAL COUNSEL, AMERICAN SOCIETY OF COMPOSERS, AUTHORS AND PUBLISHERS

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Rules Governing the Competition

1. *Participating Law Schools:* All accredited law schools are invited to participate in the Competition.
2. *Eligible Students:* Third-year students. In the discretion of the dean, second-year students may also be eligible.
3. *Subject Matter:* Any phase of *copyright law.*
4. *Determination of Awards:* The prizes will be awarded to the students who shall, in the sole judgment of the dean—or such other person or committee as he may delegate—prepare the two best papers. The dean may in his discretion withhold the awards entirely, if in his opinion no worthy paper is submitted, or may award only the first or second prize.
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   (a) Manuscript must be typewritten (double-spaced) on 8½″ × 11″ paper, 1″ margin all around; indent and single space all quotations exceeding four lines.
   (b) Manuscript must not exceed 50 pages.
   (c) Citations must be in approved law review form.
   (d) Submit *two* copies of manuscript.
   (e) Cover for manuscript: any standard form stiff cover with label on outside showing title of paper, your name, and permanent *home address.*
   (f) Two copies of winning papers will be forwarded by the dean to the Society, which may authorize publication.
   (g) Papers may appear in law reviews, provided their entry in the Nathan Burkan Memorial Competition is duly noted.
7. As papers are presumed to represent individual study, collaboration with others in their preparation is not permitted.
8. *Closing Date:* August 15th—or any earlier date the dean may specify. Winning papers must be certified to the Society not later than August 31st.
9. *National Awards:* The best papers certified to the Society will be selected for National Awards of *$1,500, $1,000, $750, $500* and

$250, respectively. The award papers selected by the judges will be printed in the form of a "Copyright Law Symposium."

Questions concerning the Competition may be addressed to the Society's General Counsel, Herman Finkelstein, 575 Madison Avenue, New York, N.Y. 10022.

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Number Eighteen

NATIONAL FIRST PRIZE, 1968

The Role of the Register of Copyrights in the Registration Process: A Critical Appraisal of Certain Exclusionary Regulations

By THOMAS A. REED

UNIVERSITY OF PENNSYLVANIA LAW SCHOOL

UNDER THE COPYRIGHT ACT [1] the only action required to obtain a valid statutory copyright in a published work is publication with the prescribed notice.[2] To perfect the rights accruing under his copyright, however, the claimant must also "promptly" deposit two copies of the best edition of the copyrighted work, together with a claim of copyright, in the

[1] 17 U.S.C. §§ 1–215 (1964).

[2] Washingtonian Publishing Co. v. Pearson, 306 U.S. 30 (1939); United States v. Backer, 134 F.2d 533 (2d Cir. 1943). 17 U.S.C. § 10 (1964) provides: "Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title." 17 U.S.C. § 9 defines a "person entitled" as "the author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns" (subject to certain conditions set forth therein).

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

Copyright Office.[3] Fulfillment of this requirement of registration and deposit is a condition precedent to any action for copyright infringement, but the copyright itself ordinarily remains valid pending fulfillment.[4] Thus, although most claimants register their works as a matter of course, registration may be deferred, without losing any rights, until the eve of suit.

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

THE FUNCTION OF REGISTRATION

Unlike the Commissioner of Patents, whose statutory function is to grant or deny applications for patents after conducting a thorough search of his files and examining the inventions submitted to ascertain whether they meet certain statutory standards,[6] the Register of Copyrights is not charged with the function of granting copyright protection.

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

[4] *Id.*

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

[6] 35 U.S.C. §§ 100-4, 131 (1964).

Copyright in published works is provided for in section 10 of the Copyright Act.[7] With respect to certain classes of works not reproduced for sale, section 12 provides that copyright "may . . . be had" by making the appropriate deposit, accompanied by claim of copyright.[8] Thus, the steps required to secure copyright lie wholly within the control of the copyright claimant.

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

[7] 17 U.S.C. § 10 (1964), see note 2 *supra*. The requirements regarding the proper form and placement of the copyright notice are specified in 17 U.S.C. § 19 (1964).

[8] *Id.* § 12. Works covered by this section include lectures and similar productions; dramatic, musical, and dramatico-musical compositions; motion-picture photoplays; photographs; motion pictures other than photoplays; and works of art, plastic works, and drawings.

[9] *Id.* § 13.

[10] The Copyright Act provides that "Copyright secured under this title or previous copyright laws of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will." 17 U.S.C. § 28 (1964). The act facilitates tracing of assignments by requiring that "every assignment of copyright shall be recorded in the copyright office within three months after its execution" (or six months, if executed outside the United States). If this is not done, the assignment becomes "void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded." *Id.* § 30. These records are an indispensable aid to one who wishes to trace title to a copyright.

[11] The Copyright Act provide that a copyright, once secured, shall run for

serve to make public and easily accessible much valuable information which would otherwise remain unknown or difficult to locate, assisting copyright proprietors and users alike.[12]

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

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

---

a term of twenty-eight years from the date of first publication of the work (17 U.S.C. § 24 (1964)), or from the date of prior deposit (if any) as an unpublished work (Marx v. United States, 96 F.2d 204 (9th Cir. 1938); *see* Rose v. Bourne, Inc., 176 F. Supp. 605, 608 (S.D.N.Y. 1959), *aff'd*, 279 F.2d 79 (2d Cir. 1960)). The initial term of copyright may be extended for a renewal period of twenty-eight years, provided a renewal copyright has been obtained in accordance with the requirements of the statute. In most cases, the renewal may be obtained only by the original author or by one of his statutorily designated successors. In certain enumerated types of works, however, the renewal copyright vests not in the author but in the person who is the proprietor of the work at the time the renewal vests. 17 U.S.C. § 24 (1964). The problem of determining who is entitled to the renewal and the manner in which it is to be obtained have generated much litigation. *See, e.g.*, DeSylva v. Ballentine, 351 U.S. 570 (1956); Fred Fisher Music Co. v. M. Witmark & Sons, 318 U.S. 643 (1943). *See generally*, M. NIMMER, COPYRIGHT LAW §§ 112–18 (1967).

[12] For an appraisal of the values of the present registration system, *see* B. Kaplan, *The Registration of Copyright*, in 1 STUDIES ON COPYRIGHT 325, 366–71 (1963).

[13] *See, e.g.*, Rev. Stat., tit. 60, ch. 3, § 4956 (1873).

[14] Also available but rarely used are the sanctions provided in 17 U.S.C. § 14 (1964): If the copies called for by section 13 of the Copyright Act are not promptly deposited, the Register may at any time after the publication of the work, upon actual notice, require the proprietor of the copyright to deposit them. If the copies are not deposited within a specified time after the making of the demand, the proprietor of the copyright is liable for a fine of $100 as well as twice the amount of the retail price of the best edition of the work, and the copyright becomes void.

[15] 17 U.S.C. § 13 (1964).

Although the statute makes registration a prerequisite to any action for infringement, it was at first not thought necessary that the Register actually issue a certificate of registration. The statute nowhere defines compliance for the purpose of section 13, and the early decisions apparently assumed that compliance only by the claimant and not by the Register was all that was required. In other words, they assumed that a claimant would be entitled to bring an infringement suit once he had mailed his copy or copies, accompanied by the appropriate registration forms and statutory fees, to the Register of Copyrights. This was the reasoning in *White-Smith Music Publishing Co. v. Goff*,[16] in which plaintiff sought to enjoin the defendant from infringing its copyrighted musical composition, basing its claim to copyright on an assignment of the author's renewal rights. The Copyright Office refused to register the claim, apparently on the grounds that plaintiff was not entitled to the renewal. Nevertheless, the court noted that the plaintiff "offered registration under the statute," saying that "although registration was refused, yet [the plaintiff] fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension." [17]

The first contrary reading of the statute came in 1921, in *Lumière v. Pathé Exchange, Inc.*[18] *Lumière* involved a photographer who, at the time of filing a bill for an injunction to restrain infringements of his copyright in three photographs, made the required deposit but had not yet obtained the certificate of registration. The court held that actual possession of the certificate was a prerequisite to bringing suit and dismissed the complaint.

By far the most significant and devastating decision to copy-

[16] 187 F. 247 (1st Cir. 1911); *see also* New York Times Co. v. Star Co., 195 F. 110, 112 (S.D.N.Y. 1912) (dictum).

[17] 187 F. 247.

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

right claimants was that of the Second Circuit Court of Appeals in *Vacheron & Constantin–Le Coultre Watches, Inc. v. Benrus Watch Co.*[19] Plaintiff claimed copyright as a work of art in its elaborately designed jewel-studded watch and applied for registration (Class G).[20] The Register declined to issue a certificate of registration on the grounds that the watch was not a work of art but an article whose sole intrinsic function was its utility.[21] The district court agreed with the Register that the watch was uncopyrightable and dismissed the complaint on the copyright count.[22] Judge Learned Hand, writing for the majority of the Court of Appeals, assumed that the watch was copyrightable, but affirmed the lower court's disposition of the copyright count on the grounds that no action for infringement could be brought until the work had actually been registered and a certificate of registration issued.[23] He characterized the contrary position espoused in the *White-Smith* case as dictum,[24] resting the immediate decision chiefly on his reading of the statute.[25]

Under this holding, the only recourse open to a copyright claimant who desires to sue for infringement, if his application for registration has been denied by the Register, is to bring a separate mandamus action to compel the issuance of a

[19] 260 F.2d 637 (2d Cir. 1958), *affirming* 155 F. Supp. 932 (S.D.N.Y. 1957).

[20] 17 U.S.C. § 5(g) (1964).

[21] *See* 155 F. Supp. 932, 934. The Register probably based his determination on § 202.10 (c) of the Copyright Regulations, 37 C.F.R. § 202.10 (c) (1956 Supp.): "If the sole intrinsic function of an article is its utility, the fact that it is unique and attractively shaped will not qualify it as a work of art. However, where the object is clearly a work of art in itself, the fact it is also a useful article will not preclude registration." Compare the current version of this regulation, quoted and discussed in text at note 135 *infra*.

[22] The court also dismissed a count based on a charge of unfair competition, but granted the plaintiff a permanent injunction against infringement of a design patent which it had obtained upon the watch. 155 F. Supp. 932, 937.

[23] 260 F.2d 637, 639. The court reversed and remanded the judgment granting a permanent injunction upon the design patent count. *Id.* at 642.

[24] *See* text accompanying notes 16–17 *supra*.

[25] *See* 260 F.2d 637, 640–41. *But see* dissenting opinion of Clark, J., *id.* at 645–46.

certificate.[26] The requirement imposed by the *Vacheron* case on the unsuccessful applicant for copyright registration is formidable. Not only must he undergo the expense of two successive actions in order to vindicate his claim, but he must also risk the possibility that, if the infringement is a continuing one, his injury will be aggravated while he proceeds against the Register. The extra time involved in bringing the latter action might even cause the statute of limitations to run on his infringement action.[27]

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

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

[27] See the suggestion of Clark, J. in his dissenting opinion. *Id.* at 645. Any civil action under Title 17 must be commenced within three years after the claim accrued. 17 U.S.C. § 115(b) (1964).

[28] HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 75 (Comm. Print 1961).

[29] 17 U.S.C. § 209 (1964).

ing the subject matter, ownership, and existence of the copyright.[30] Without the benefit of the presumption, the claimant would have to prove each of these items separately. Even more significant than the procedural advantage expressly granted by the statute, however, is the widely held judicial view that the certificate of registration raises a prima-facie presumption of the validity of the copyright,[31] and the likelihood that courts would apply the converse of this view to create a reverse presumption of invalidity in the event that the Register refuses to issue a certificate.[32] Finally, the de-

[30] Specifically, § 209 requires the certificate of registration to contain the name and address of the claimant, the country of the author, the author's name (when the Copyright Office records show this), the title of the work, the date of deposit of copies, the date of publication (if any), the class designation and entry number, and (in the case of a book) the statement of receipt of affidavit of manufacture and date of completion of printing or publication date as stated in the affidavit.

[31] Courts generally give effect to the language of 17 U.S.C. § 209 (1964) and hold that prima-facie effect must be given to the statements in the certificate, whether or not within the Register's "personal knowledge." *See, e.g.*, Jerry Vogel Music Co., Inc., v. Forster Music Publisher, Inc., 147 F.2d 614 (2d Cir. 1945). In some cases, however, courts have gone even further and have spoken broadly of the certificate as presumptive evidence of the validity of the copyright, or of the plaintiff's title. *See, e.g.*, Wihtol v. Wells, 231 F.2d 550, 553 (7th Cir. 1956); Magnus Organ Corp. v. Magnus, 269 F. Supp. 981, 984 (D.N.J. 1967); Freudenthal v. Hebrew Pub. Co., 44 F. Supp. 754, 755 (S.D.N.Y. 1942).

[32] The probability that a court will defer to the Register's decision that a given work is uncopyrightable and therefore ineligible for registration is directly related to the court's view of the extent of discretion accorded by the Copyright Act to him in deciding this kind of question. The greater the Register's scope of discretion is, the less willing the court may be to disturb his decision, and vice versa.

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

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

nial of the certificate will necessarily deprive the applicant of the various advantages of registration apart from those relat-

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

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

Despite limits on the Register's discretion when it comes to denying registration of material which is "actually the subject of copyright," however, and apart from the standard of review that may be applied (*see id.* at 54), the court also made it clear that it did regard the statute as giving the Register some discretion to refuse registration. It rested this determination partly on its construction of the statute, *i.e.*, of 17 U.S.C. § 207 (1964), which provides that "subject to the approval of the Librarian of Congress, the Register of Copyrights shall be authorized to make rules and regulations for the registration of claims to copyright as provided by this title," reasoning that this language "must contemplate the exercise of some discretion, not only in the making, but in the administration of such rules." 122 F.2d at 53. Another reason for holding the Register empowered to refuse applications could be found in practical considerations: "In light of recent trends and the divergent philosophies of different schools of thought as to what constitutes *art*, to say nothing of the large possibilities inherent in *plastic works of a scientific or technical character*, it seems obvious that, unless the Register has some power to control deposits for copyright, it may soon become necessary to build a new library annex. It seems obvious, also, that the Act establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept." *Id.* (Emphasis in original.) Finally, the court found there was no doubt "that the Register may refuse to issue a certificate of registration until the required fee is paid, and until other formal requisites of the Act have been satisfied." *Id.* at 53–54.

In other words, although the functions of the Register in regard to registra-

ing to infringement actions,[33] perhaps the foremost among these being the readiness with which a certificate is accepted as evidence of copyright ownership for the purposes of transfer of title.[34]

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

> Such person may obtain registration of his claim to copyright by complying with the provisions of this title, including the deposit of copies, and upon such compliance the Register of Copyrights *shall* issue to him the certificates provided for in section 209 of this title.[35]

Some conclude from this that the Register's function is wholly ministerial, involving no power to decline to issue a certifi-

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tion of claims may be regarded as ministerial inasmuch as he has a duty to register claims which are submitted in accord with the statutory requirements and whose subject matter is clearly copyrightable, it is nevertheless clear that he does have "discretion" to the extent that copyrightability is doubtful, that is, to the extent that he must exercise judgment in construing the statute and in applying it to determine the eligibility of a particular claim. *See* C. Berger, *Authority of the Register of Copyrights to Reject Application for Registration*, in 1 STUDIES ON COPYRIGHT 393, 404 (mem. ed. Copyright Soc'y 1963).

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

[33] See text at note 12 *supra*.

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

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

cate, at least so long as there has been compliance with the formal requisites of the statute.[36] Other parts of the statute, however, indicate that the drafters must have intended to give the Register, at minimum, sufficient discretion to turn down claims he finds to be wholly without merit.[37] Reference has already been made to the prima-facie presumption of validity accorded by section 209 to the facts stated in the certificate.[38] It has been argued with good reason that this provision would be rendered meaningless if the Register were bound to issue a certificate to every claimant automatically upon receipt of the claim and accompanying deposit. If such were the case, the certificate could hardly be of greater evidentiary weight than the unsupported assertions of the copyright claimant; it is therefore difficult to see on what basis the presumption of validity might be justified.[39] Also, section 207 gives the Register authority to make "rules and regulations for the registration of claims to copyright as provided by this

[36] *See, e.g.*, Kaplan, *supra* note 12, at 367.

[37] In Bouvé v. Twentieth Century-Fox Film Corp., 122 F.2d 51, 53 (D.C. Cir. 1941), the court stated: "the Register may properly refuse to accept for deposit and registration 'objects not entitled to protection under the law.' . . . It seems obvious, also, that the Act establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept." *See also* Bailie v. Fisher, 258 F.2d 425 (D.C. Cir. 1958).

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

[39] *See* 30 Op. Att'y Gen. 422, 424–25 (1915); "The suggestion that the determination of the validity of the registration should be left to the courts, and the necessary inference involved that the duty of the register is purely automatic, and consists wholly (with the single exception of books) in determining whether the subject presented is . . . within the general class of articles which may be copyrighted, can not be reconciled with the power vested in the register to issue rules and regulations under which he will permit registration under the law. That section of the law plainly indicates that he has at least some measure of discretion in the administration of the act. Manifestly, in the exercise of that discretion he may make such investigation and require such showing of compliance with the law as may be necessary to enable him to determine whether the prerequisites imposed have been met. *Cf.* Bouvé v. Twentieth Century-Fox Film Corp., 122 F.2d 51, 52–54 (D.C. Cir. 1941); 41 Op. Att'y Gen. 395, 396–98 (1958). *See also* A. Fisher, *The Copyright Office and the Examination of Claims to Copyright*, in 1953 Copyright Problems Analyzed 11, 15–17 (T. Kupferman ed. 1953).

title." [40] If these provisions are to be given any effect, it seems clear that the Register must have at least the power to refuse registration to a work if the applicant is not a person entitled to copyright protection or if the claim falls wholly outside the scope of copyrightable subject matter or fails to comply with one or more of the statutory requisites of copyright protection, such as proper placement of notice.[41]

Several cases have upheld the Register's action in declining to make registration and to issue a certificate in specific instances, thereby giving weight to the view that he has the power to do so.[42] The United States Attorney General has added the weight of his authority to this view of the statute in an official opinion.[43] But owing to the indefiniteness of the statute and the dearth of case rulings on the point, the outer limits of the Register's discretion have never been defined.

Perhaps the principal reason why the point has not been ex-

[40] 17 U.S.C. § 207 (1964).

[41] "If the Copyright Office were to register claims and issue certificates without regard to the copyrightability of the material, the result would be to mislead the applicant and the public. What materials are copyrightable is a rather esoteric question on which the general public is not well informed. Many applications are received in the Copyright Office for the registration of uncopyrightable material such as titles, names, ideas, mechanical devices, tools, toys, and almost anything imaginable, usually under a misapprehension by the applicant of the copyright law. In some instances, protection may be available under the trademark or patent laws. Registration of a copyright claim in such material would lull the applicant into a false sense of security in believing he had copyright protection, instead of seeking advice and other means of protecting his interests; and the public would often be given the false impression that the material is copyrighted. Further consequences would also seem evident: the registration records would be cluttered with unfounded claims; registration records and certificates would be unreliable and would lose much of their probative value for copyright claimants, for other persons dealing with them, and for the courts; and many unfounded claims would probably become the source of litigation. Berger, *supra* note 32, at 405.

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

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

tensively litigated is that the Register has shown relatively little inclination to test the extent of his discretion.[44] Despite his powers, he would no doubt acknowledge that his office is ill-equipped and ill-suited to undertake a complete assessment of the validity of each copyright claim received: There are affecting copyrightability too many factors whose impact cannot be ascertained simply by examining the deposited work or the accompanying application.[45] For example, since the Copyright Office makes no attempt to conduct a search of its files before making registration, there is no way in which it is possible to determine by inspection whether a given work constitutes an original work of authorship, except in the rare instance when the examiner might recognize a plagiarism of a work with which he was already familiar.[46] The most that can ordinarily be done is to ascertain whether the work fits under one of the statutory classifications of copyrightable subject matter; whether the required notice is adequate;

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

[45] In addition to the impossibility of assessing all the factors which enter into a determination of copyrightability on the sole basis of an applicant's submissions, a former Register of Copyrights has pointed out that there is a severe restriction on the amount of time that can be devoted to any given application. Of the more than 1,000 applications for registration received every day (each primary examiner must process about 40 of these to keep the workload current), approximately 850, or 85 percent, appear to be in proper form and to meet all the statutory requirements. A brief examination of the remaining 15 percent reveals that they depart in some way from the statutory formalities. Fisher, *supra* note 39, at 15. *See also* Kaplan, *supra* note 12, at 361–62. More recent figures indicate that the number of applications has increased. In fiscal 1966, for example, 286, 866 registrations were made in all categories (no figures were published regarding the total number of applications received). 69 REGISTER OF COPYRIGHTS ANN. REP. 33 (1967). Unofficial figures for 1967 disclose that 323,415 applications were received, resulting in approximately 294,000 registrations. Interview with Richard E. Glasgow, Esq., Chief of Examining Division, United States Copyright Office, in Washington, D.C., Jan. 15, 1968. Assuming a working year of 250 days, this means that in 1967 the Copyright Office processed an average of nearly 1,300 applications per day.

[46] For example, if the applicant were to submit the Lord's Prayer or a quotation from Shakespeare, the examiner might enquire of him as to the element of originality. *See* Berger, *supra* note 32, at 403 n.38.

whether there is agreement in dates, names, or the like, between the application and the deposited copies; and possibly some other matters, such as whether the author is a person entitled to copyright.[47] Even within the narrow confines to which practical limitations restrict the Register's range of inquiry, however, close questions calling for nice judgments can arise. This is especially true in the area of copyrightable subject matter, as will be seen below.

A CRITICAL EXAMINATION OF COPYRIGHT OFFICE REGISTRATION PRACTICE AS CODIFIED IN EXCLUSIONARY REGULATIONS

THE REGISTER'S OWN CONCEPTION OF HIS ROLE: THE "RULE OF DOUBT"

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

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

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

[47] *See* Kaplan, *supra* note 32, at 361–62.

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

THE MECHANICS OF PROCESSING COPYRIGHT CLAIMS AND THE NEED FOR STANDARDS OF EXCLUSION

Upon receipt of an application for registration, the application form and accompanying deposit are sent to an examiner whose function is to ascertain whether or not a certificate should issue.[49] If the submitted material is clearly copyrightable and if there has been compliance with the other statutory requisites, the certificate will normally be issued as a matter of course. Should a question arise, the examiner will write to the applicant and attempt to secure whatever further information or clarification is needed. If, after examining the deposit and all the pertinent information regarding it, the examiner decides that the material is not copyrightable or that the applicant is not entitled to copyright, the applicant will be notified of the rejection and the reasons therefor. The applicant may then request reconsideration, in which case the initial decision is reviewed de novo by the Head Examiner of the appropriate section of the Examining Division,[50] who takes into account whatever arguments the applicant advances in favor of acceptance. If the decision is confirmed, further appeals lie to the Assistant Chief and, ultimately, to the Chief of the Examining Division. In rare cases presenting questions of particular importance it may be possible to appeal to the Register, but ordinarily, if the Chief of the Examining Division affirms the initial examiner's denial, the applicant's only recourse lies in bringing an action of mandamus against the Register. As mentioned above, the statute makes no provision for further administrative review or for direct review of such

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

[50] To facilitate the process of examination, the Examining Division is subdivided into four sections entitled "Arts," "Music," "Books," and "Renewals and Assignments," respectively. Each of these sections is supervised by a Head Examiner.

denials by a court. In fact, even the informal procedure just described is not required by statute; it has evolved solely on the initiative of the Register in the interest of fairness to copyright applicants.

Given the lack of statutory guideposts for the exercise of his discretion in passing upon applications for registration, yet faced with the necessity of establishing minimal administrative standards of exclusion which will enable his staff to process the flood of applications with reasonable dispatch,[51] the Register has had to formulate various policy statements defining specific categories of material which he regards as clearly ineligible for copyright under the statute and its judicial interpretations. While some of the statements are intended only for the internal use of the Copyright Office and hence are not generally available, the Register has traditionally published other regulations dealing with registration of claims to copyright for the guidance of the public.[52] Some of these deal with purely administrative and procedural matters, such as the proper procedure to be followed in submitting applications for copyright [53] or the conditions under which photographs of the copyrighted work may be deposited in lieu of copies required by section 13.[54] Most of the published regulations, however, attempt to define generally the scope of the statutory classifications of copyrightable subject matter.

In addition to providing general definitions, many of the regulations offer specific examples of the types of work which will or will not be accepted for registration.[55] Some of the

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

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

[53] 37 C.F.R. § 202.3 (1967). [54] *Id.* § 202.16.

[55] More specifically, these regulations elaborate on the classes enumerated in 17 U.S.C. § 5 (1964).

regulations in this latter category are designed to forestall certain obvious misunderstandings as to the scope of copyrightable subject matter. For example, under Class I (drawings or plastic works of a scientific or technical nature), a regulation makes it clear that the term *plastic* work refers to a three-dimensional work giving the effect of that which is molded or sculpted, and not to every object made of the synthetic chemical derivative, plastic.[56]

REGULATIONS WHICH DEFINE THE REGISTER'S DISCRETION TOO BROADLY OR TOO NARROWLY

Unfortunately, not all the questions which the regulations undertake to resolve are inherently capable of such clear-cut answers and not all the regulations are so easily justified. In certain cases, disputed questions of copyrightability have been arbitrarily settled by regulations which leave insufficient scope for the application of the rule of doubt. In others, the arbitrariness lies not in the regulations themselves but in the nature of the judgment which they require the Register to exercise. Careful consideration of these regulations is necessary in order to understand fully the problems which they create and the reforms in the law which these problems suggest.

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

The first rule, found under the regulations pertaining to works of art (Class G), provides:

[56] 37 C.F.R. § 202.12(b) (1967).

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

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

A claim to copyright in a scientific or technical drawing, otherwise registrable in Class I, will not be refused registration solely by reason of the fact that it is known to form a part of a pending patent application. Where the patent has been issued, however, the claim to copyright in the drawing will be denied copyright registration.[58]

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

In the field of works of art, the landmark case is *Mazer v. Stein*,[59] in which the Supreme Court held that an independently copyrightable work of art is not rendered uncopyrightable by virtue of its subsequent inclusion in a useful article. It expressly declined to decide whether the allowance of either a copyright or a design patent on a given work bars the

[57] *Id.* § 202.10(b). One might wonder how the Copyright Office could know officially whether a patent had already issued. The answer probably lies in 35 U.S.C. § 287 (1964), which provides: "Patentees, and persons making or selling any patented article for or under them, may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation "pat.", together with the number of the patent, or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement."

[58] 37 C.F.R. § 202.12(c) (1967).

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

grant of the other.[60] The court has never resolved this issue, and no lower court has held squarely that such dual protection is necessarily unobtainable. The one case cited informally [61] by the Copyright Office as a basis for this regulation, *Louis De Jonge & Co. v. Breuker & Kessler Co.*,[62] affords it very little support. In *De Jonge*, which arose under the Copyright Act of 1874,[63] plaintiff brought an action for infringement of his copyrighted painting which he used as the basis of a design on gift-wrapping paper. Defendant contended that the plaintiff should have obtained a design patent for his painting, and thus copyright protection must be barred, arguing that the areas covered by the patent and copyright statutes are mutually exclusive. After deciding that the painting was within the scope of the copyright law, the court rejected the defendant's argument, saying that there is some area of overlap between copyright and patent and that if a given work appears eligible for both forms of protection, either may be chosen.[64] The court did add its opinion that as soon as one of these monopolies is granted, the other becomes unavailable.[65] This last statement was clearly dictum, since the plaintiff had made no application for a patent, and the only issue to be decided was whether the mere availability of a patent barred the validity of the copyright. This dictum may perhaps be attributable to the court's fear of unduly extending one of these two statutory monopolies by superimposing the protection of the other.

In the case of scientific or technical drawings, the regulation in question apparently stems from the decision of the Second Circuit Court of Appeals in *Korzybski v. Underwood*

[60] *Id.* at 217.

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

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

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

[64] 182 F. 150 *passim*.

[65] *Id.* at 152.

& Underwood, Inc.,[66] in which a second theory was advanced as a ground for denying dual patent and copyright protection to the same work. The court held that the drawings or diagrams which form part of a patented invention are dedicated to the public in what amounts to a compulsory divestitive publication and therefore may not be copyrighted.[67] The court observed that the patent dedicates both the invention and the drawings, subject to the inventor's monopoly to make, use, and vend the invention during the term of the patent.

This argument purports to rest not on broad policy grounds but rather on a narrow legal technicality.[68] Even assuming its validity, however, it does not justify the broad exclusion of the regulations in question. Consistently with the holding in *Korzybski*, a person could preserve his claim to both monopolies simply by placing a copyright notice on his design or drawing before submitting it to the Patent Office,[69] since publication with notice is sufficient to invest statutory copyright.[70] Although filing a work not bearing the statutory notice in the Patent Office might well constitute a publication sufficient to divest common-law rights in the submitted work,[71] and hence render copyright unobtainable,[72] the ration-

[66] 36 F.2d 727 (2d Cir. 1929). [67] *Id.* at 729.

[68] *See* R. Pogue, *Borderland—Where Copyright and Design Patent Meet*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER SIX 3, 20–21 (1955).

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

[70] *See* note 2 *supra*.

[71] Holding that filing in a governmental office constitutes such a divestitive publication are Callaghan v. Myers, 128 U.S. 617 (1888); DeSilva Construction Corp. v. Herrald, 213 F. Supp. 184 (M.D. Fla. 1962); Wright v. Eisle, 86 App. Div. 356, 83 N.Y.S. 887 (2d Dept. 1903); Tumey v. Little, 186 N.Y.S.2d 94 (Sup. Ct. 1959). *Contra*, United States v. Certain Parcels of Land, 15 F.R.D. 224 (S.D. Cal. 1954); Smith v. Paul, 174 Cal. App. 2d 744, 345 P.2d 546 (1959); Edgar H. Wood Associates v. Skene, 347 Mass. 351, 197 N.E.2d 886 (1964).

[72] Publication without notice of copyright will inject a work into the public

ale of *Korzybski* affords no basis for refusing to register a validly copyrighted work which is subsequently patented.[73] Thus, the availability of dual protection would depend only upon which monopoly was obtained first.

The inconsistent results flowing from the narrow *Korzybski* theory have led at least one commentator to speculate that the regulations in question are based not on the holding in *Korzybski* but on the "fundamentally sound view that the creator

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domain, at least if published by authority of the copyright proprietor. Atlantic Monthly Co. v. Post Publishing Co., 27 F.2d 556 (D. Mass. 1928); *cf.* McDaniel v. Friedman, 98 F.2d 745 (7th Cir. 1938). No copyright may be obtained in a work that is in the public domain. 17 U.S.C. § 8 (1964).

[73] The whole concept of "publication" in copyright law is quite imprecise, owing largely to the fact that the term is nowhere defined in the Copyright Act. One source of confusion is the distinction that has been drawn between "investive" and "divestive" publication. As noted in the two preceding footnotes, publication is necessary in order to invest an author with federal copyright protection (except in the case of works enumerated in 17 U.S.C. § 12 (1964), as to which copyright may be obtained upon deposit before publication); but publication of a work without the statutory notice will serve to divest common-law copyright and render statutory copyright unobtainable. In American Visuals Corp. v. Holland, 239 F.2d 740, 744 (2d Cir. 1956), Judge Frank concluded: "The courts apply different tests of publication depending on whether plaintiff is claiming protection because he did not publish and hence has a common law claim of infringement—in which case the distribution must be quite large to constitute "publication"—or whether he is claiming under the copyright statute—in which case the requirements for publication are quite narrow. In each case the courts appear so to treat the concept of "publication" as to prevent piracy." Thus formulated, Judge Frank's doctrine may not be a particularly useful generalization, since it is stated in terms incapable of precise application. How large is "quite large," and how narrow is "quite narrow"? Nevertheless, other cases have approved or even extended the doctrine, albeit as dicta. *See* Public Affairs Associates v. Rickover, 284 F.2d 262 (D.C. Cir. 1960), *vacated for insufficient record*, 369 U.S. 111 (1962); Continental Casualty Co. v. Beardsley, 253 F.2d 702 (2d Cir. 1958); Hirshon v. United Artists Corp., 243 F.2d 640 (D.C. Cir. 1957); Burnett v. Lambino, 204 F. Supp. 327 (S.D.N.Y. 1962); Edgar H. Wood Associates v. Skene, 347 Mass. 351, 197 N.E.2d 886 (1964). Whatever may be the limits of the doctrine, however, it does indicate that a publication sufficient to divest common-law rights would also be sufficient to invest statutory copyright. Applied to the *Korzybski* situation, this means that even if filing in the Patent Office should be held a sufficient publication of the work to divest common-law rights, as indicated by the cases cited in note 71 *supra*, then a fortiori such filing of the work with notice of copyright would constitute sufficient publication to invest statutory copyright.

might have an election between the two forms of protection [74] . . . but that the federal protective scheme never intended double protection." [75] Such a view, however, is a rather flimsy base on which to ground an exclusionary regulation. Apparently recognizing the uncertainty of the "federal scheme" in this area, the same writer goes on to observe that while such a restrictive approach to double protection might be most consistent with over-all governmental policy toward monopolies, "it does not square easily with the ruling in *Mazer v. Stein* that there is an overlap between patentable and copyrightable subjects." [76]

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

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

[75] M. Nimetz, *Design Protection*, in ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER FIFTEEN 79, 85 n.23 (1967).

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

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

[78] 35 U.S.C. § 154 (1964) provides: "Every patent shall contain . . . a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof." In the case of design patents, the applicant may elect a term of three years and six months, seven years, or fourteen years, depending upon the amount of fee paid. *Id.* §§ 171, 41(a)(3)(b).

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

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

[80] 35 U.S.C. § 154 (1964).

[81] *See, e.g.*, Flowers v. Austin-Western Co., 149 F.2d 955, 958 (7th Cir. 1945): "One device is an infringement of another if it performs substantially the same function in substantially the same way to obtain the same result, so that if two devices do the same work, in substantially the same way and accomplish substantially the same result, they are the same, even though they differ in name, form or shape." As another judge put it, "A 'monopoly' [*i.e.*, the patent monopoly] means the exclusion of others from doing the same or a similar thing." Hoffman v. Berger, 18 F. Supp. 632, 634 (S.D.N.Y. 1937).

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

[83] 17 U.S.C. § 1 (1964) provides: "Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right: (a) To print, reprint, publish, copy, and vend the copyrighted work." The remainder of the section enumerates other rights of the copyrightholder, none of which is applicable to works of art or scientific or technical drawings.

[84] Originality is both a constitutional and a statutory prerequisite to copyrightability. The Copyright Clause of the Constitution restricts the power of Congress in granting copyright protection to "authors." U.S. CONST. art. 1, § 8. The Supreme Court defines "author" in the constitutional sense to be "'He to whom anything owes its origin; originator; maker.'" Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884). Thus, a person who has merely copied from others may not be deemed an author. Although the Copyright Act makes no express requirement of originality, courts have uniformly found the requirement to be implied. *See, e.g.*, Du Puy v. Post Telegram Co., 210 F. 883 (3d Cir. 1914); Edward Thompson Co. v. American Law Book Co., 122 F. 922 (2d Cir. 1903). This implication can be based on the limita-

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

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

The consequences of allowing dual protection to the first type may best be illustrated by an example. Suppose that the inventor of a radical new type of can opener wishes to copyright the technical drawings disclosing the invention. Before submitting them to the Patent Office, he places on them the statutory notice of copyright. (Assume that the drawings will

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tion in 17 U.S.C. § 9 (1964) that copyright protection may be claimed only by "authors" or their successors in interests. *See* Gladys Music Inc. v. Arch Music Co., 150 U.S.P.Q. 26 (S.D.N.Y. 1966).

[85] White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1 (1908); Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 249 (1903); Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 103 (2d Cir. 1951); Christie v. Cohan, 154 F.2d 827 (2d Cir. 1946); Arnstein v. Porter, 154 F.2d 464, 468–69 (2d Cir. 1946); Ansehl v. Puritan Pharmaceutical Co., 61 F.2d 131 (8th Cir. 1932).

[86] Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951); Sheldon v. Metro Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir. 1936), *aff'd*, 309 U.S. 390 (1940); Fred Fisher, Inc. v. Dillingham, 298 F. 145 (S.D.N.Y. 1924). *See* Reed v. Carusi, 20 F. Cas. 431 (No. 11,642) (C.C.D. Md. 1845).

[87] Another type of work which would conceivably qualify for both types of protection is a print or label, which might either be registered under 17 U.S.C. § 5 (k) (1964) or submitted for a design patent under 35 U.S.C. § 171 (1964). *See In re* Blood, 23 F.2d 772 (D.C. Cir. 1927) (dual protection denied).

be sufficiently published when filed to invest the copyright under section 10 of the Copyright Act.) [88] If a patent subsequently issues on the invention disclosed by the drawings, during the patent term the copyright will add little to the exclusive rights granted by the patent, for by the terms of the patent no one may make, use, or sell the invention without first obtaining a license from the patentee.[89] The only right conferred by the copyright which is not granted under the patent is the exclusive right to copy the drawings. The added coverage would mean, for example, that a person who wishes to publish a treatise on the art of making can openers, illustrating his text with the copyrighted drawings, will have to pay royalties to the copyright holder. This slight additional burden would not seem sufficient reason to deny copyright protection.

As part of the consideration for the grant of the patent monopoly, however, when the patent expires, the invention disclosed therein is supposed to become freely exploitable by the public.[90] If the copyright in the drawings were to interfere with free exploitation, it would have the difficult-to-justify effect of prolonging the patent monopoly. It is unlikely, however, that the continuing existence of the copyright would in fact create any such interference. Control of the right to

[88] See note 73 *supra*. [89] 35 U.S.C. § 154 (1964).

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

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

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

publish the drawings would in no way prevent anyone from using them as an aid in manufacturing the can opener, since the Copyright Act confers no monopoly of use. Nor, by the weight of authority, would the manufactured article constitute an infringing "copy" of the drawings.[91]

With respect to the second category of works potentially eligible for dual protection, works of art, there would seem to be no greater reason to prohibit the coexistence of the two monopolies. Assume that an extraordinarily talented craftsman has created a new design for a saltcellar. The design is sufficiently novel and inventive to qualify for a design patent, yet the finished product looks so much like a modern sculpture that it is unquestionably a work of art and copyrightable as such.[92] Copyright would protect the artistic features of the work as expressed in the particular form of the finished product; design patent would protect whatever new principle or idea had been embodied in the design.[93] Once the design patent had expired, others would be free to use this idea or prin-

[91] The subject of the drawings, a can opener, is by hypothesis not copyrightable, being neither a work of art (Class G) nor a plastic work (Class I). Copyright in the drawings will therefore protect only against reproduction of the drawings, not against copying of the can opener per se, as distinguished from the original elements (angle, perspective, etc.) contained in the drawings *qua* drawings. *Cf.* Modern Aids, Inc. v. R. H. Macy & Co., 264 F.2d 93 (2d Cir. 1959).

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

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

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

ciple with impunity in whatever way they might wish, so long as they did not copy the particular form of artistically expressing that principle embodied in the copyrighted saltcellar. Thus, for the balance of the copyright term, the designer would have no greater rights than he would have had if the design patent had never issued; he could not use the copyright to monopolize his new principle of saltcellar design, since others would be free to use that principle so long as their saltcellars did not resemble his so closely as to warrant an inference of actual copying.

Responding to the above or similar arguments, a court might not unreasonably find it consistent with Congress's over-all statutory scheme to allow both patent and copyright in different aspects of the same work, and thus uphold a copyright claim in drawings which form part of an issued patent or in a work of art on which a design patent had already been obtained. Such a finding seems all the more likely in the light of the Supreme Court's refusal to rule out the possibility of dual protection in *Mazer v. Stein.*[94] In the absence of an authoritative judicial opinion or statute clearly holding dual protection unavailable, the regulations denying registration to such copyright claims are clearly not formulated with due regard to the rule of doubt or to the policies which prompt that rule: They foreclose copyright as to works in which copyright might well be upheld by the courts.[95]

Regulations Which Unduly Limit the Registrability of a

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

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

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

The copyright statute makes no explicit mention of choreographic works as such; yet, in order to receive copyright protection, they must be classified under one of the statutory rubrics of section 5.[96] The most appropriate of these is Class D (dramatic or dramatico-musical compositions). Although the notation for a choreographic work might be registered in another class,[97] only Class D affords the copyright holder protection against unauthorized public performance of the work,[98] which in the case of choreographic works is at once the most likely and potentially the most damaging type of infringement.[99] The current regulation governing Class D

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

[97] *E.g.*, Class A (books); Classes L-M (Motion pictures). 17 U.S.C. §§ 5(a), (1), (m) (1964).

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

[99] *See* letter from Agnes George DeMille, reprinted in B. VARMER, COPYRIGHT IN CHOREOGRAPHIC WORKS, STUDY NO. 28, 86TH CONG., 2D SESS. 110 (Comm. Print 1961). *But see* letter from Lincoln Kirstein, *id.* at 113, suggesting that the expense of reducing a ballet to legible notation (roughly $1,200 for twenty minutes), together with the difficulty of reproducing the work from the notation alone, causes the benefits to be reaped from obtaining copyright protection for choreographic works to be outweighed by the trouble and expense involved.

permits the registration of choreographic works in this class if they are "of a dramatic character, whether the story or theme be expressed by music and action combined or by actions alone." [100] The same regulation, however, excludes from Class D registration "descriptions of dance steps and other physical gestures, including ballroom and social dances or choreographic works which do not tell a story, develop a character or emotion, or otherwise convey a dramatic concept or idea." [101]

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

[100] 37 C.F.R. § 202.7 (1967). [101] *Id.*

[102] Several early cases are generally cited for the proposition that in order for a composition to be considered a dramatic composition under the Copyright Act, it must tell a story. The authority most widely relied on is Fuller v. Bemis, 50 F. 926 (C.C.S.D.N.Y. 1892), which involved a claim of copyright in a description of the movements of a stage dance. As the court characterizes the dance, it "convey[ed] to the spectator, no other idea than that comely woman is illustrating the poetry of motion in a singularly graceful fashion." *Id.* at 929. In denying a preliminary injunction to the plaintiff, the court states, "It is essential to such a composition that it should tell some story. The plot may be simple. . . . The merely mechanical movements by which effects are produced on the stage are not subjects of copyright where they convey no ideas whose arrangement makes up a dramatic composition." *Id.* There is some ground for supposing, however, that the real basis for decision was that the court felt the dance to be risque or even immoral. *See* the description of the dance set out at 50 F. 926–27; *see also* L. Mirell, *Legal Protection for Choreography*, 27 N.Y.U.L. Rev. 792, 807–9 (1952). Two other cases also deny copyright protection as a dramatic work on similar grounds: Martinetti v. Maguire, 16 F. Cas. 920, No. 9, 173 (C.C. Cal. 1867) and Barnes v. Miner, 122 F. 480 (C.C.S.D.N.Y. 1903). Both cases, however, seem even more clearly to rest on the unspoken ground of immorality. *See* Mirell, *supra*, at 807–9. *But see* Daly v. Palmer, 6 F. Cas. 1132, 1135–36, No. 3,552 (C.C.S.D.N.Y. 1868), in which a stage presentation involving a single incident of rescue was held copyrightable as a "dramatic composition." *See also*

Many modern dances, however, are to dance as abstract expressionism is to painting; they explore movement and form, tell no story, and may convey no identifiable character or emotion. If an emotion is conveyed to the audience, it is likely to be wholly subjective, incapable of a generalized definition or description.[103]

The registrability of such a work is left in doubt by the regulation referred to above, and there is little available precedent to elucidate the standard therein set forth. Yet, a reasonable case can be made for the proposition that any choreographic work designed to evoke a reaction in its audience through the actions of one or more dancers—whether the reaction be emotional or purely intellectual—should be considered "dramatic," and hence entitled to copyright. The phrase "otherwise convey a dramatic concept or idea" [104] may be broad enough to encompass even the most abstract choreographic work, but it seems doubtful that the Copyright Office gives it such an interpretation, especially in view of its announced requirement that to be eligible for registration as an unpublished work, a copy of the choreographic work which is "merely diagrammatic of dance movement and actions (for example, if it is in Labanotation), . . . be accompanied by a verbal description of the production as a whole, explaining the plot, characters, themes, or emotions expressed by the choreography." [105] Under this rule, a work so abstract that it

Henderson v. Tompkins, 60 F. 758 (C.C.D. Mass. 1894) (public performance using idea and lyrics of plaintiff's song held a copyrightable dramatic composition); Green v. Luby, 177 F. 287 (C.C.S.D.N.Y. 1909) (sketch consisting of recitations and songs, with very little dialogue and action, held a dramatico-musical composition within the Copyright Act).

[103] *Cf.* Letter from Lincoln Kirstein reprinted in B. VARMER, COPYRIGHT IN CHOREOGRAPHIC WORKS, STUDY No. 28, 86TH CONG., 2D SESS. 113 (Comm. Print 1961): "Increasingly, ballets fail to tell stories. They are about the dance itself, just as symphonic music is about sound. Some critics attach programs of the 'March of Fate' or the 'Triumph of Love' to a piece but this is merely a point of departure to their prose-poems and has little to do with the ballet, itself."

[104] 37 C.F.R. § 202.7 (1967).

[105] Copyright Office Circular No. 51 "Choreographic Works." This require-

expresses no theme or emotion, let alone plot or character, is thus excluded from registration even though it could legitimately be considered "dramatic." One can only conclude that the rule of doubt has not been given sufficient scope with respect to this type of work.[106]

Regulations Which Permit the Register To Exercise Too Great a Degree of Subjective Judgment in Deciding What Is Copyrightable. The regulations just discussed embody the Register's advance decision to deny registration to certain fairly well-delineated categories of works, despite the fact that their copyrightability might conceivably be upheld by the courts. There is another series of regulations under Class G (Works of Art), however, which calls for the exercise of so great a degree of subjective judgment on the part of the Register in deciding what works are copyrightable that the claimant runs at least an equal risk of an unjustified denial of registration. This judgment is brought to bear in two successive determinations: first, whether the work in question is sufficiently creative to meet the minimum standard for copyrightability; and second, whether any mechanical or utilitarian as-

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ment could, of course, be quite easily circumvented, since it would be a simple matter for the author of the work to make up a verbal description of the production that would be sufficient on its face to gain approval by the examiners. This does not mean that the rule is harmless, however, since it may force the author to lie about his work on pain of being denied registration.

[106] There is some uncertainty as to how rigidly the Copyright Office intends to enforce the requirement mentioned in the preceding footnote. Mirell, *supra* note 102, at 810–11, relates that registration in Class D was obtained for the choreographic score (in Labanotation) of the musical "Kiss Me, Kate," although the dances were "mood and idea pieces, devoid of plot or story in the usual sense." *Id.* at 810. The score itself revealed no plot or story line, nor did any of the material accompanying the score. But the concession may have been more apparent than real, for an interoffice memorandum regarding this registration stated that the applicant had "'purported to fulfill the . . . conditions for registration of a work as a dramatic composition; that is, the indicated dance movements spelled out, to a person familiar with the system, a story told in action, marked by the prescribed boundaries of a particular stage or setting.'" United States Copyright Office interoffice memorandum regarding the registration of Miss Hanya Holm's dances for "Kiss Me, Kate," March 1952, quoted in Mirell, *supra* note, at 811 n.86.

pect the article may possess bars it from being considered a work of art.

All works listed in section 5 must possess a certain minimal amount of creativity to be copyrightable,[107] in addition to the requirement that they represent an independent effort ("originality") on the part of their authors.[108] However, this requirement applies to works of art in a manner qualitatively different from the way it applies to the other enumerated classes of works. As Professor Nimmer points out:

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

In other words, if someone properly submits a photograph for registration, all the Register need do is determine that the submitted item is in fact a photograph, and therefore registrable in Class J, a matter which ordinarily requires no exercise

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

[108] *See* note 84 *supra.*

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

of discretion. Any question as to whether the photograph is sufficiently creative to be copyrightable need not be decided by the Register, but can be left for a court to settle in future litigation. On the other hand, when an item is submitted to the Register for registration as a work of art, he must exercise discretion in deciding whether or not to accept it as such.

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

To illustrate this problem further, consider the following hypothetical case. Andy Artist wishes to register as a work of art a perfectly round, smooth, and unornamented metal

[110] The still-prevailing rule was stated by Mr. Justice Holmes in the landmark case of Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903): "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change." *Id.* at 251–52.

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

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

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

Even when the submitted article possesses sufficient creativity, however, it still must surmount a second hurdle, namely a determination by the Register that its "sole intrinsic function" is not its "utility." [113] This requirement stems from the fear, reflected by the Supreme Court's decision in the early case of *Baker v. Selden*,[114] that if copyright were permitted in works whose primary function is their utility, a monopoly would thereby be indirectly granted "not only of the use of the copyrighted work itself, but also of the system, function, process or art (i.e. the 'idea') upon which the work is based or for which it is fitted." [115] While the indirect monopoly of use of the copyrighted article would not of itself necessarily be contrary to the statutory scheme,[116] if this indirect monopoly were to extend to the art underlying the work, then copyright could be used to circumvent the stricter requirements of patent law by granting protection to ideas, which are specifically excluded from copyright protection.[117] The resul-

[113] 37 C.F.R. § 202.10 (c) (1967). [114] 101 U.S. 99 (1879).
[115] M. NIMMER, *supra* note 107, § 37.1, at 148. [116] *See id.*
[117] *See* text accompanying notes 77–95 *supra.*

tant rule,[118] as reflected in the Regulations, leaves an ill-defined line between works of art and works of utility. To the former, the Register must issue a certificate; to the latter, he must deny it. But since there is little case law on the distinction between the two,[119] the Register's discretion is virtually unbridled.

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

It has thus been established that the use to which a separately identifiable work of art is put will not affect its copy-

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

[119] *See* text accompanying notes 59–65 *supra*. [120] 347 U.S. 201 (1954).

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

[122] 347 U.S. at 218. [123] 37 C.F.R. § 202.10 (a) (1967).

rightability. In many objects, however, artistic or ornamental features are found combined with functional features in such a way that the two are not readily separable. This is true, for example, of an enameled ashtray, a jeweled pin, or an engraved glass vase. How is the Register to decide whether a work has artistic form apart from what its mechanical or utilitarian aspects demand? For example, jewelry can be copyrighted,[124] while an ordinary watch clearly cannot, since the form of a watch is dictated by its function, rather than by artistic expression. But what of a highly bejeweled watch? In the *Vacheron* case,[125] plaintiff sued for the infringement of its copyright in such a watch, having obtained a design patent, but having been refused registration for a copyright as a "work of art." The distinctive feature of the watch was the jeweled appearance of its face, which differed from most men's watch faces in two respects: it bore twelve oblong jewels in place of numerals, and instead of hands it had two transparent rotating disks, each bearing a jewel mounted on its periphery. Resting its decision primarily on the ground that the sole function of the watch was its utility, the district court upheld the Register's refusal to issue a certificate.[126] The court reached its decision notwithstanding its observation that the watch in some ways resembled jewelry: "The effect of plaintiff's grouping of the elements of the design did create a watch with the appearance of a piece of jewelry as distinguished from a watch embellished with jewels." [127]

The watch in *Vacheron* is representative of the objects with regard to which the Register must attempt to formulate and apply regulations which will define the line between a copyrightable work of art and a noncopyrightable article of util-

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

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

[126] 155 F. Supp. 932, 934. [127] *Id.* at 935.

ity. Although he denied registration to the watch, he has allowed it, with subsequent judicial approval, for such items as designs printed upon dress fabrics,[128] dinnerware patterns,[129] dolls,[130] Christmas decorations,[131] banks in the shape of dogs,[132] and artistic jewelry boxes.[133] Other items accepted for registration but not as yet tested in the courts include "book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays." [134]

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

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

While this Regulation does clarify the criteria for acceptance as a work of art, it leaves in doubt the standard which will be

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

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

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

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

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

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

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

[135] 37 C.F.R. § 202.10 (c) (1967) (emphasis added).

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

UNDUE RESTRICTIONS ON REGISTRABILITY OWING TO FAILURE OF REGULATIONS TO RESPOND QUICKLY TO CHANGED CONDITIONS

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

If Diaghilev sought copyright registration for one of his ballets in 1910,[137] when the first Regulations under the 1909 Act were promulgated, he would have been disappointed, for

[136] *I.e.*, that it is a prerequisite to bringing an action for infringement and also has certain other advantages. *See* note 12 *supra.*

[137] Conceivably he might have done so. Although the system of dance notation known as Labanotation, now the only universally recognized system, was not invented until 1928, other systems (albeit somewhat crude) did exist in 1910. One of these, perhaps coupled with a verbal description of the

the Regulations then provided that "the designation 'dramatic composition' does not include the following: Dances, ballets, or other choreographic works." [138] By 1917 his chances might have improved somewhat, for although the Regulations made no positive mention of ballets or choreographic works, only "dances" were retained as a specific exclusion from "dramatic compositions." [139] In the 1939 Regulations, there was still no positive mention of choreographic works or ballets, but "dances" continued to be excluded together with, *inter alia*, "animal shows, sleight-of-hand performances, and acrobatic or circus tricks of any kind." [140] It was not until 1948 that pantomimes and ballets were specially included in the Regulations under Class D.[141]

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

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ballet, might well have supplied a sufficient written record of the work to qualify it for registration.

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

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

[140] 37 C.F.R. § 201.4 (c) (4) (1939).

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

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

[143] 17 U.S.C. § 5 (g) (1964).

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

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

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

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

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

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

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

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

[146] R. Pogue, *Borderland—Where Copyright and Design Patent Meet*, *supra* note 68, 14 (1955).

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

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

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

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

The foregoing demonstrates that the "rule of doubt" policy [152] as applied by the Register has not been sufficient to ensure that only claims which are clearly without merit

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

[150] The Copyright Office has expressed the conditions under which registration for computer programs will be considered in Copyright Office Cir. 31D (1965). The office first announced that it would accept applications for registration of computer programs as such in April, 1964. 67 REGISTER OF COPYRIGHTS, ANNUAL REPORT 4 (1965). Three registrations were made in that year. *Id.* The number is growing, however; in fiscal 1965, sixteen claims covering computer programs were registered, 68 REGISTER OF COPYRIGHTS, ANNUAL REPORT 4 (1966), and in fiscal 1966, thirty-six. 69 REGISTER OF COPYRIGHTS, ANNUAL REPORT 5 (1967).

[151] With respect to registration of both video tapes and computer programs, the principal questions are: (1) whether the work is a "writing" within the meaning of the Copyright Clause, U.S. CONST., art. 1, § 8; (2) if so, whether it is encompassed by sections 4 and 5 of the Copyright Act, 17 U.S.C. §§ 4, 5 (1964); and (3) if so, in which class it should be registered.

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

[152] *See* text accompanying note 48 *supra*.

will be denied registration. It is perhaps to be expected that he would tend to undershoot rather than overshoot the mark, despite his announced policy of giving the applicant the benefit of the doubt,[153] and generally allow registration in doubtful cases only when the case for registration is quite substantial. Given this situation, some form of review for rejected applications short of bringing an action of mandamus against the Register is clearly warranted. What form of relief can be provided to fill this need without unduly disrupting the existing system? Little purpose would be served by stripping the Register of his discretion to decline to issue a certificate, as has sometimes been proposed.[154] Such a solution would deprive the registration system of its useful function of weeding out wholly worthless claims, as well as rendering virtually worthless the evidentiary presumption of validity accorded the certificate by section 209 of the Copyright Act.[155] A better approach would be to work out a means of allowing the Register to sift out worthless claims, while permitting the victim of an unwarranted rejection to obtain prompt redress. The present system adequately achieves the first goal, but it leaves the applicant for registration without sufficient recourse if his claim happens to be among those rejected.

The chief difficulty with the present system is that in most situations the Register is, for all intents and purposes, the final arbiter of copyrightability. (This is so because courts give substantial weight to his issuance of a certificate in assessing copyrightability [156] and because of the inherent difficulty in the only recourse against an adverse decision, namely, an action for mandamus.[157]) He is well-suited to make that determination initially because of his day-to-day administration of the copyright statute. But he is also subject

[153] *Id.* [154] *See* B. Kaplan, *supra* note 12, at 367.
[155] *See* text accompanying note 38 *supra.*
[156] *See* note 29 and accompanying text and note 31.
[157] *See* discussion of the difficulties attending a mandamus action in text accompanying notes 166–68 *infra.*

to the inherent limitations of an administrator when it comes to deciding the difficult questions of copyrightability. Faced with a huge daily volume of applications,[158] the Register, as an administrator, must minimize the number of exceptional cases. Therefore, having once settled upon a given regulation as defining the outer limits of copyrightability, he is likely to adhere to that position at least until a sufficient number of doubtful cases have arisen to warrant reevaluation. Meanwhile, a number of potentially worthy claims might have been denied registration.

Partial relief from the burdens of the present awkward and unsatisfactory procedure for review is provided in the pending Copyright Revision Bill,[159] which makes a number of basic changes in the system of copyright registration. In the new bill, the Register's duties are made explicit: he is *expressly* required to register the claim and to issue a certificate of registration

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

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

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

Reading these two sections together, it is clear that the drafters intended to lay an explicit statutory foundation for the Register's exercise of discretion to reject claims which he finds are not entitled to copyright under the statute.[162] Sec-

[158] *See* note 45 *supra.* [159] H.R. 2512, 90th Cong., 1st Sess. (1967).
[160] H.R. 2512, 90th Cong., 1st Sess. § 409(a) (1967). [161] *Id.* § 409(b).
[162] The existing law is silent of this point, but the courts have recognized an amplied power to reject claims in a number of cases upholding the

tion 410 of the bill carries over the requirement in section 13 of the current law that no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made. Section 410 goes on to provide, however, that

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

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

Despite the welcome overruling of the result in *Vacheron*, the new bill fails to correct two problems in the present law. First, the machinery proposed in section 410 makes no attempt to afford relief to an applicant whose application has been denied registration and whose work is not currently being infringed. Presumably, the rejected applicant would be relegated to a mandamus action against the Register, as under existing law. Mandamus, however, is hardly an adequate substitute for judicial review provided by statute, since it will not be granted to reverse discretionary decisions, at least in the

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Register's refusal to issue a certificate. *See* discussion of this point at note 32 *supra*.

[163] *Id.* § 410.

[164] If he so chooses, the Register may then join the action. The Revision Bill provides: "The Register may, at his option, become a party to the action with respect to the issue of registrability of the copyright claim by entering his appearance within sixty days after such service, but his failure to do so shall not deprive the court of jurisdiction to determine that issue." H.R. 2512, at § 410.

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

absence of abuse of discretion or arbitrary and capricious action.[166] As qualification, however, tends to break down in practice, because courts experience a considerable amount of confusion in attempting to distinguish ministerial from discretionary action,[167] particularly in matters involving the proper construction of the statute. The availability of mandamus in this situation is rendered still more uncertain by the existence in the Revision Bill of the partial remedy just discussed, for courts might well impute to Congress the intention of making that remedy exclusive.[168] Thus the new bill would bring about the anomalous result that unsuccessful copyright claimant *A* would be afforded a better opportunity to vindicate his interests than unsuccessful copyright claimant *B*, simply because *A*'s copyright had been infringed and *B*'s had not. Yet *B* has important interests at stake, equally, deserving of protection, even though his copyright is not currently being infringed. Registration would make it easier for *B* to protect his work against unauthorized use on account of the procedural advantage gained from establishing presumptive copyrightability before any infringement takes place. If B wishes to dispose of his work, he will find a readier market for it if it has been registered; it might be quite difficult to dispose of an unregistered work, because the assignees or li-

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

[167] *Id.* at 764–66.

[168] According to Professor Davis, the modern practice regarding the availability of mandamus where another remedy exists is that "'ordinarily mandamus may not be resorted to as a mode of review where a statutory method of appeal has been prescribed or to review an appealable decision of record.'" *Id.* at 763–64 (quoting Roche v. Evaporated Milk Ass'n, 319 U.S. 21, 27–28 (1943); *see* United States *ex rel.* Girard Trust Co. v. Helvering, 301 U.S. 540 (1937), in which the court relied on what it terms "the settled rule that the writ of mandamus may not be employed to secure the adjudication of a disputed right for which an ordinary suit affords a remedy equally adequate, and complete." *Id.* at 544 (citations omitted). It is conceivable that a court could be persuaded by the argument that the partial remedy afforded by the Revision Bill is sufficient to foreclose recourse to mandamus by a turned-down applicant, even if that remedy were not yet available because his copyright had not yet been infringed.

censees would have little confidence in the validity of the copyright or in *B*'s title.[169] Indeed, so important is registration, regardless of present infringement, that some claimants have been willing to bring suit to compel registration before any infringement has taken place, despite the obstacles and uncertainties of such actions.[170]

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

In order to correct the first of these defects, it is submitted that the Revision Bill should make special provision for a civil action against the Register in the District Court of the District of Columbia in the event that registration should be finally denied after the informal appeal procedure with the Copyright Office has been exhausted.[172] Such a provision would afford the unsuccessful claimant a means of trying the validity of his claim without having to wait for an infringement to take place.[173] How decisions and actions of the Regis-

[169] B. Kaplan, *The Registration of Copyright*, in 1 STUDIES ON COPYRIGHT 325, 368–69 (mem. ed., Copyright Society 1963).

[170] *See, e.g.*, King Features Syndicate, Inc. v. Bouvé, 48 U.S.P.Q. 237 (D.D.C. 1940).

[171] H.R. 2512, 90th Cong., 1st Sess. § 409(c) (1967). This section adds that the evidentiary weight to be accorded the certificate of registration made later than five years from the date of first publication "shall be within the discretion of the court."

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

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

ter taken in the course of denying registration should be reviewable de novo [174] by the District Court, so that both the applicant and the Register could introduce new evidence, a possibility sorely lacking in mandamus actions. Should the claimant succeed in persuading the court that his claim was valid, the court would uphold his copyright and direct the Register to issue a certificate of registration. The court could also direct the Register to amend or withdraw any Regulation which conflicted with the court's decision.

Precedent for such a system of de novo judicial review exists under the Patent Act.[175] That system is somewhat more elaborate, as it provides first for internal appeal to the Patent Office Board of Appeals by an applicant whose claim has been twice rejected by the Patent Office.[176] If the applicant is dissatisfied with the board's decision, he then may elect either (1) to appeal to the Court of Customs and Patent Appeals on the record made in the Patent Office [177] (2) to bring an action de novo against the Commissioner of Patents in the District Court for the District of Columbia.[178] While the structure created for patent appeals is more complex than is necessary or desirable in the case of copyrights, reflecting the far greater complexity of patent legislation,[179] there is no reason why copyright law cannot adopt part of the structure without appropriating the whole. There is no need to include the Patent Office internal appeal procedure, with its separate Board of Appeals, but the provision for de novo judicial review does furnish a desirable model. The court would not be confined by the narrow strictures on a remedy

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

[175] 35 U.S.C. §§ 1–293 (1964). [176] *Id.* § 134. [177] *Id.* § 141.

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

[179] Patent applications, unlike copyright registrations, entail a search of the prior art as well as an assessment of novelty and inventiveness. For the conditions under which patents are granted, see *id.* §§ 100–4.

in the nature of mandamus,[180] but would be free to weigh all the relevant arguments of law and policy advanced by the parties in order to decide whether the Register's refusal was proper in the light of all the circumstances.

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

CONCLUSION

The experience of nearly sixty years under the 1909 Act shows that the discretion of the Register to refuse registration to claims he considers unwarranted or ill-founded serves a

[180] *See* text accompanying notes 166–68 *supra*.

[181] These requirements are covered in sections 406, 408, and 708 respectively, of the Revision Bill.

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

[183] *See* note 30 *supra*.

useful function. Yet the extremely wide range of his discretion calls for an effective counterweight in the form of readily available recourse to remedial machinery, in order to prevent disadvantage to claimants in case the Register's denial of registration is improper. Presently available methods of review are, however, clumsy and unwieldy.

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

NATIONAL SECOND PRIZE, 1968

Incorporation of the Droit de Suite *into United States Copyright Law*

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THE *DROIT DE SUITE* ABROAD

BEFORE AN ATTEMPT is made to discuss the possibility of incorporating the *droit de suite* into United States copyright law, a brief review of the applications of this right in those countries where it has been adopted should be undertaken. This will serve a dual purpose: identification of the concept of the *droit de suite* and exposition of the practical experiences with the right. The origin of the concept of the *droit de suite*, or art proceeds right,[1] may be traced to late nineteenth-century France. It was there that the publicists and theorists of the art world first formulated the basic ideas later embodied in statutes.[2] And it is in France that the right has seen its longest and most successful application.

[1] *Droit de suite*, literally translated, means "follow-up right," and it has been so interpreted by some writers. However, the use of the term itself in French law has been criticized. *See, e.g.*, J.-L. DUCHÉMIN, LE DROIT DE SUITE DES ARTISTES 63 (1948) [hereinafter cited as DUCHÉMIN, DROIT DE SUITE] and F. Hepp, *Royalties from Works of the Fine Arts: Origin of the Concept of Droit de Suite in Copyright Law*, 6 BULL. COPYRIGHT SOC'Y 91, 93 (1958).

[2] The earliest of these being Albert Vaunois and Edouard Mack. R. Hauser, *The French Droit de Suite: The Problem of Protection for the Underprivileged Artist under the Copyright Law*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER ELEVEN 1, 3–4 (1962) [hereinafter cited as Hauser, *French Droit de Suite*].

FRANCE

The first two decades of the twentieth century saw repeated attempts to secure enactment of this right in legislation, attempts that succeeded with the adoption of the basic statute of 1920.[3] Composed of three articles, this law granted to artists an inalienable right to collect a percentage of the sales price of their original, personal creations sold at public auction. The right was to last throughout the term of statutory copyright and was applicable to all artistic works, including those sold by the artist before passage of the law.[4] A law of 1922 modified that of 1920 by lowering from 1,000 francs to 50 francs the "threshold", or minimum resale, price required to bring the *droit de suite* into operation.[5] The avowed purpose of this amendment was to enable the creators of original prints to take advantage of the art-proceeds right.[6] A graduated scale of assessments was established, with rates ranging from 1 percent on sales between 50 francs and 10,000 francs to 3 percent on sales above 50,000 francs.

The 1920 legislation required an administrative order to determine the actual conditions under which the *droit de suite* would operate. The first such decree was issued in 1920, and comprised eleven articles.[7] The artist was required to place a notice of his intent to collect on a specific, identified work in the *Journal Officiel*, a public record. Auctioneers, quasi-official agents, were given the duty of collecting the money due the artist on the sale of these notified works. Payment was to be made to the artist or to an organization appointed by him as his agent for collection. The liability of the auctioneer ended if the amounts which he had collected were not demanded within three months. In that case, the money was to

[3] For the legislative proposal of this period, *see* DUCHÉMIN, DROIT DE SUITE 35–46.

[4] Law of May 20, 1920. [5] Law of Oct. 27, 1922.

[6] DUCHÉMIN, DROIT DE SUITE 61. [7] Decree of Dec. 17, 1920.

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be returned to the vendor of the painting, from whom it had been collected. But the artist retained the right of proceeding against the vendor. Auctioneers were required to maintain a register of sales and to inform the artist of the name, address, and the amount owed by the vendor upon demand. The benefits of the *droit de suite* were extended to foreigners on the basis of reciprocity.[8]

Early in 1921 this decree was modified to permit artists' societies to insert collective declarations in the *Journal Officiel*, without the signature of the artist or a description of the work.[9] Finally, in 1924, two decrees were issued, of which only the second had any lasting effect.[10] This regulation provided for collaborative works. It permitted the artists to declare the proportion of the total proceeds to which each was entitled. In the absence of a declaration, the funds were to be held in reserve until agreement was reached. These were the only substantive changes of the law until 1957, when a recodification of the French copyright law was enacted.

The 1957 revision incorporated the *droit de suite* into the body of French copyright law.[11] A number of changes were made; the most significant extended the application of the right from auction sales to all commercial sales. However, this change has not yet been implemented because the necessary administrative order has not been issued.[12] Among other changes were a readjustment of the "threshold" price to

[8] By a decree of Sept. 15, 1956, this was extended to artists who had participated in the life of French art for five years.

[9] Ministerial order of Feb. 21, 1921.

[10] The first decree, of May 31, 1924, established a presumption of equal participation in collaborative works in the absence of agreement to the contrary. The decree of Dec. 24, 1924, instituted the scheme described in text.

[11] The new statute may be found in *France, Item No. 1*, 1 UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD, art. 42 (1956, Supp. 1966).

[12] G. BONNEFOY, LA NOUVELLE LÉGISLATION SUR LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 255 (1959); D. Schulder, *Art Proceeds Act: A Study of the Droit de Suite and a Proposed Enactment for the United States*, 61 NW. U.L. REV. 19, 33–34 (1966) [hereinafter cited as Schulder, *Art Proceeds Act*].

10,000 old francs and the establishment of a fixed, instead of a graduated, collection rate.

In practice, the law has been generally successful in regard to painters. The art market has not suffered appreciably from the application of the surcharge, and substantial sums have been collected.[13] The law, however, has not been too successful in its application to works of sculpture.[14]

Originally, the statute had been intended to provide a procedure for authentication of art works.[15] The requirement in the first decree implementing the statute that artists claiming the right publish descriptive notice of the works in the *Journal Officiel* was drafted with this end in mind. The development of collection societies, at first two: *La Société "Le Droit d'Auteur aux Artistes"* and the *Syndicat de la Propriété Artistique*, later only the latter, prevented the attainment of this goal.[16] When collective declarations of claims under the law were authorized for the benefit of these organizations in 1921, the possibility of effective authentication through the *droit de suite* was abandoned.[17]

The general success of the French law is indicated in part by the paucity of cases litigated under its provisions. In the first forty years, only three cases interpreting the statute were reported. Two of these involved the section relating to rights of inheritance of the art proceeds right.[18] Only one involved a refusal by a vendor to pay the demanded sum.[19] This last case involved the purchase by the vendor through an agent of a work which the vendor had put up for public sale in an ef-

[13] *See, e.g.*, the statistics in DUCHÉMIN, DROIT DE SUITE 112–24; Schulder, *Art Proceeds Act* 22 n.16.

[14] DUCHÉMIN, DROIT DE SUITE 84. [15] *Id.* at 86.

[16] These societies are described in *id.* at 80–83.

[17] Hauser, *French Droit de Suite* 10.

[18] Ledeut c. Turquin et Sté du Droit d'auteur, Gaz. du Pal. I. 351 (1937); Héritiérs Pissaro c. Sté du Droit d'auteur des Artistes, Gaz. du Pal. I. 178 (1930).

[19] Epoux Bernard c. Bellier et Ligue de la Defense d'art, Gaz. du Pal. I. 301 (1931).

fort to enhance its supposed value.[20] It was held that the statute applied to all public sales and the vendor was required to pay.

OTHER COUNTRIES

The *droit de suite* has seen a slow advance in acceptance by other states. Belgium was the first to follow the French lead in 1921.[21] A Czechoslovak statute followed in 1926, and a Polish one in 1935. Uruguay instituted the right in 1937; Italy, in 1941. The latest addition to the list of states affording this protection is West Germany, under the 1965 recodification of its copyright law. Most of these statutes reveal significant differences in approach.

In Czechoslovakia, the art proceeds right operated only upon the increase in value of the latest sales price over the preceding sales price. The amount of the award was to be determined by the courts, with the maximum rate set at 20 percent. A number of factors were to be considered, including the relative financial status of the artist and the vendor. The law had very little actual application; it has since been modified to apply only where a "socially unjustified" profit has been realized.

The Polish statute also imposed a charge only upon the added value in later sales. The vendor was required to pay the artist 20 percent of this sum, if it amounted to at least 50 percent of the acquisition price. The law was omitted in the 1952 recodification. In Uruguay, the percentage to be collected under the *droit de suite* amounts to 25 percent of the added value. This statute applies not only to artists but to all authors; it, too, has proved unsuccessful.[22]

[20] Hauser, *French Droit de Suite* 11.

[21] All of the statutes adopted before 1948 are collected in DUCHÉMIN, DROIT DE SUITE 166–94. The West German and new Czechoslovak statutes may be found in 1 UNESCO, COPYRIGHT LAWS, *supra* note 11, under the appropriate national headings.

[22] C. MOUCHET & S. RADAELLI, LOS DERECHOS DEL ESCRITOR Y DEL ARTISTA 156 (1953). The general failure of the Uruguayan law affords little hope for

Italy adopted an extremely complicated statute. A percentage ranging from 1 percent to 5 percent is levied upon the total price obtained in the first public sale of the work. This percentage reflects a presumption that there have been earlier private sales, and that the amount which the artist receives from this levy on the first public sale equals an appropriate percentage of the added value in those earlier private sales. This presumption may be defeated, and the charge avoided, by proof that the first public sale is, in fact, the first sale or that the price obtained is not higher than the original price paid to the artist. In the second and later public sales, creators of artistic works are entitled to a percentage ranging from 2 percent to 10 percent of the added value. Finally, if the price of art works in private sales is greater than five times the original price received by the creator, 10 percent of this gain is to be paid to the artist. In all these situations it is the vendor who must pay the artist. Minimum "threshold" prices are set before the *droit de suite* may be enforced. The statute applies only to originals of artistic works; only those prints signed by the artist and produced from the original plates are to be considered originals. The money due the artist is to be paid to the *Ente Italiano per il Diritto di Autore.* Regulations issued in 1942 set up the procedures whereby these sums were to be paid to and distributed by that body.

The Italian law has also met with a number of difficulties and has not proved to be very successful.[23] The major problems involve the noncooperation, frequently amounting to fraud, of auctioneers, the indifference of artists, and the difficulties inherent in tracing artists and their successors in interest.[24] In addition, the formalities of the system are truly awesome. At present, efforts at revision of the law are underway.

incorporation of a similar right for nongraphic or nonplastic artists in future laws establishing a *droit de suite.*

[23] V. de Sanctis, *Lettre d'Italie,* 74 Le Droit d'auteur 221, 221–22 (1961)

[24] Duchémin, Droit de suite 305.

The West German law, like the Belgian, is based on the French system. However, before the adoption of the 1965 revision of the copyright statute, a complicated system of some interest was considered.[25] It was suggested that the *droit de suite* be accorded to all the arts, excluding architecture and works of a utilitarian nature. The vendor would be required to pay the artist 3 percent of the total sales price in all public auctions. This amount was to be limited, in that it could not exceed 25 percent of the total gain realized by the vendor. The law actually adopted sets a 1-percent charge on all auction sales; its success is impossible to determine because of the relatively recent date of its enactment.

INCORPORATION: THE THEORETICAL ASPECTS

RATIONALE OF THE DROIT DE SUITE

The reasons asserted to justify the *droit de suite* are almost as numerous as the varieties of statutes proposed or adopted to implement the right. All, however, are dependent upon one primary consideration, the fact that frequently an artist is obliged to sell his work at a price that may appear miniscule in comparison with the price for which the work is later resold. In almost every discussion of this subject the story of the sale of Millet's *Angelus* for 1,000,000 francs while his granddaughter sold flowers in the streets is recounted. The drawing of Forain, depicting two children in rags observing the sale of a painting for 100,000 francs and saying: "Look, one of papa's paintings," is constantly described.[26]

This basic rationale of the art-proceeds right lies in the desire to secure for the representational artist a continuing in-

[25] This proposed system is described in E. Ulmer, *Lettre d'Allemagne*, 74 LE DROIT D'AUTEUR 12, 13 (1961).

[26] *E.g.*, DUCHÉMIN, DROIT DE SUITE 17–18; Hauser, *French Droit de Suite* 1; 2 P. OLAGNIER, LE DROIT D'AUTEUR 377 (1934); H. DESBOIS, LE DROIT D'AUTEUR EN FRANCE 336 (2d ed. 1966). To these two oft-repeated examples may be added those of the widows of Sisley and Lepine.

terest in his works, in a way paralleling, if not duplicating, the interest of the author who receives royalties.[27] This is grounded upon a belief that in justice the artist should benefit from subsequent sales at elevated prices, which would otherwise redound entirely to the benefit of wealthy collectors or speculators. The author of a literary work is accorded this right to participate in the exploitation of his work through copyright; the artist should also be protected. In a sense, then, the basic rationale of the *droit de suite* is the same as copyright: a desire to accord to the creator of an intellectual property the right to profit from the uses to which his work is put.[28] There is the same desire to stimulate and encourage production of artistic works by assuring that an adequate financial reward will accrue to the creator of the work.

To accomplish this purpose, the *droit de suite* is seen as a necessary and proper means by its proponents. Such a right to participate in the resale of his original manuscript is not needed by the writer, who can draw most of his profits from the sale of copies of his intellectual creation.[29] In the case of an artist, however, this source of profit is not available.[30] The value of an original work of art in most instances lies in the fact that it is an original.[31] Few artists draw large sums from the sale of copies of their works. It is the unique quality of a work of art, as well as the reputation and ability of its creator, which determines its value. Those reproduction rights now accorded artists are of minimal value.[32]

If the artist cannot profit through the sale of copies of his

[27] Schulder, *Art Proceeds Act* 24.

[28] DUCHÉMIN, DROIT DE SUITE 40; DESBOIS, *supra* note 26, at 338–39.

[29] *But compare* the provision of the Uruguayan *droit de suite*, which would extend the right to writers and their manuscripts. *See* text accompanying note 22 *supra*.

[30] DESBOIS, *supra* note 26, at 336.

[31] *Id.*; Schulder, *Art Proceeds Act* 24.

[32] *See infra* note 89. This conclusion is not vitiated by recent developments in the field of art reproductions. *See Look-Alikes*, 71 NEWSWEEK 90 (May 27, 1968). It would appear that the works of only a few, well-known artists will benefit. In addition, the problem of authentication (discussed *infra* p. 70) becomes more troublesome.

work and if he is nevertheless to be assured of an adequate return for his continuing labors, it is necessary to find some other means of compensation. When copies are eliminated as a source of revenue, there remains only the original, and it is upon the original that the *droit de suite* seeks to operate. Because sales of originals are frequently at rates higher than their first prices, the imposition of this charge is made easier to bear.[33] As a result, then, the rise in value of the work of art is both a justification and an opportunity for the operation of the art-proceeds right.

THE DROIT DE SUITE: THREE THEORIES

There are a number of subsidiary theories that have been urged in justification of the *droit de suite*. These fall into three basic categories and may be referred to by the nationalities of their chief exponents as the French, Belgian, and German concepts. The theory receiving the most widespread support in France regards the *droit de suite* as the equivalent of a royalty payment by the vendor for having had the privilege of enjoyment of the work of art.[34] This effort to assimilate the art-proceeds right to the concept of copyright serves to justify the imposition of a straight tax upon all sales, regardless of whether there has been any increase in the value of the work of art. The right is seen to relate more directly to the moral rights accorded the creator than to the pecuniary rights granted under the copyright statute.[35]

[33] One index of comparative values in the art market, which begins with 1925 as a base year with an index of 100, rates 1955 at 609 and 1960 at 1274. R. RUSH, ART AS AN INVESTMENT 374 (1961). Of course, this increase in value is not necessarily certain; values of individual works frequently decline sharply. *See, e.g., id.* at 246.

[34] DUCHÉMIN, DROIT DE SUITE 28.

[35] The doctrine of moral rights falls outside the scope of this essay. However, it might be noted that some legal commentators in France have regarded the *droit de suite* as a moral right. This appears to be contrary to the generally accepted doctrine that the art-proceeds right is a pecuniary or exploitative right, possessed of some characteristics, such as inalienability, frequently associated with the moral rights. *See* Hauser, *French Droit de*

Another theory, expounded by the *rapporteur* of the law adopted in Belgium, is tied more closely to a contract concept.[36] It is suggested that an analogy might be drawn, in the case where the value of a work has increased greatly, between the *droit de suite* and the theory of *imprévision* (or changed circumstances). In the latter case, where the continuation of a contract would result in a hardship to one of the parties, the civil law would permit a revision of its terms. Another contract law concept that has been analogized to the *droit de suite* by the same author is the continuing relationship between the artist and those who purchase his work. This has been criticized as unclear; [37] it is likely that the continuing relationship meant is one traceable to the growing fame and reputation of the artist, in which it is believed the purchaser shares when the value of a work increases. Viewed in this light, the theory aproaches the civil law concept of *enrichissement sans cause* (or unjust enrichment).

German theorists have, on the other hand, relied almost entirely upon a metaphysical concept closely related to the basic rationale of fairness that underlies the idea of the *droit de suite*. They argue that the increased value of the work has always been latent in it and that the payment the artist receives is no more than what he should have received in the original sale. As a result, these writers urge that artists should be accorded the right to participate only in the gains which accrue to their works in the market.[38] The German writers reject the idea of a straight levy upon all transactions and espouse a collection only upon the increase in value. This

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Suite 22. On moral rights, generally, *see* M. Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554 (1960).

[36] The theory, M. Wauvermans', is quoted extensively in P. Recht, *Has the Droit de Suite a Place in Copyright?* 3 UNESCO COPYRIGHT BULL. 51, 57 (1950).

[37] *Id.* at 57–58.

[38] DUCHÉMIN, DROIT DE SUITE 198, 198; Hauser, *French Droit de Suite* 17.

has been referred to as the "capital gains theory"; [39] here I call it the "value-added system." [40]

THE DROIT DE SUITE AND UNITED STATES COPYRIGHT THEORY

The general purposes of copyright in the United States may best be summed up in the words of the preamble of the Connecticut Copyright Act of 1783: [41]

> It is perfectly 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 works, and such security may encourage men of learning and genius to publish their writings; which may do honor to their country and service to mankind.

Copyright, therefore, has a dual purpose: remuneration of creators for the intellectual labor they put into their work and encouragement of creative production.[42] The two concepts are closely related. The second is secured by means of the first which, in turn, is secured by the grant of a monopoly or franchise. This monopoly extends only to the form of expression, and not the ideas contained in the work;[43] in this way the widespread dissemination of ideas is obtained while creative minds are encouraged to produce.

The *droit de suite* accords with this dual purpose of copyright. The actual production of art is encouraged by giving the artist a substantial incentive to release his works with the assurance of a realistic return on his investment of time and effort. In addition, others may be enabled to produce when re-

[39] The term is used frequently in Schulder, *Art Proceeds Act.*

[40] An example of the "value-added system" is that adopted in Italy, discussed *supra*, p. 55.

[41] Quoted in R. SHAW, LITERARY PROPERTY IN THE UNITED STATES 33 (1950).

[42] HOUSE COMM. ON THE JUDICIARY, 87TH CONG. 1ST SESS., [1] REPORT OF THE REGISTER OF COPYRIGHT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 5 (Comm. Print, 1961).

[43] Holmes v. Hurst, 174 U.S. 82, 86 (1899); *see also*, Annot. 23 A.L.R.3d 139, 156–57 (1969), and cases cited.

lieved of financial burdens and stimulated by the hope of an adequate reward.[44] At the same time, the interest of the public is promoted: both the incentive and the reward to productivity result in a greater availability of works of artistic merit.

None of the three major European theories is truly incompatible with the basic nature of copyright as understood in the United States. All are based upon the underlying rationale of justice for the creator of intellectual works, which also underlies American copyright theory. However, the "Belgian" theory of a continuing relationship between the creative artist and the purchasers of his works would be more nearly in accord with the dual purpose of United States copyright than either the "French" or "German" theories. This theory regards the growing fame and popular appreciation of the artist as the justification for the application of the *droit de suite.*[45] The artist who continues to create works of high quality, and who thus stimulates public demand, in a sense continues to add to the value of works which were sold before. It is in this addition to value that the artist shares. If the art-proceeds right is predicated upon continued production of works of a consistently high order, it serves to promote the public interest in the creation and dissemination of intellectual works,[46] in addition to the interest of the artist in an adequate financial return for his past efforts.

The "German" theories, suggesting that the increase in value is latent in the work, do not attain this goal, since they implicitly reward past performance, not continuing efforts. While this might satisfy one of the purposes of copyright in United States theory, it does not take into account the other

[44] *Compare* DUCHÉMIN, DROIT DE SUITE 271: "Si l'artist ne gagne pas sa vie il doit avoir de la fortune, or le génie n'est heureusement pas l'apanage des gens riches."

[45] *Supra* p. 59.

[46] SHAW, *supra* note 41, at 33, suggests that dissemination of knowledge is the primary purpose of copyright.

major purpose, the satisfaction of the interest of the public. In practice, however, these theories would have the same effect as the "Belgian," since they would require an increase in value before the *droit de suite* could become operative. Insofar as this increase is caused by the efforts of the artist,[47] it might stimulate such efforts, and the *droit de suite* would serve to promote the public interest.

The "French" analogy to royalties would also fail to take account of this interest.[48] The artist's gain would depend not on the value of his work but on the number of sales, regardless of the public appreciation of the artist's genius. The fact that sales may be made at a loss or that an artist's reputation may suffer because of later inactivity or failures serves to underline this point.[49]

INCORPORATION: THE PRACTICAL ASPECTS

WORKS COVERED

Any attempt to discuss the possible incorporation of a *droit de suite* into American copyright law must first attempt to answer the basic question: To what works would this protection extend? It is clear as a matter of definition that an art-proceeds right should apply only to works of art. However, this leaves a broad spectrum of possible applications ranging across the entire field of copyrightable materials. Any attempt at classification or enumeration of specific types of works would, in all probability, be futile. If the enumeration

[47] As the Belgian theory argues, at least in large part, is the case.

[48] This might also be said of copyright royalties applicable to the sale of books. However, there is a basic distinction: when a book is sold in large numbers, only copies of that book are being sold. The proper analogy in the case of art works would be to sales of reproduction and not to sales of originals. The *droit de suite* does not apply to the sale of copies, and the theory upon which it is based must be measured against the basic theory of copyright, rather than an inappropriate analogy. If a way more in accord with the basic theory exists, it should be adopted.

[49] *Supra* note 33.

were made exclusive, it would only result in the exclusion of works that might justifiably be included. If the enumeration were not limited, the result might be the inclusion of works of doubtful artistic merit. Instead, the process of definition of the works that such a law would cover must proceed upon an entirely different basis, that of selecting and enumerating criteria of a general nature serving to limit the application of the right.

The first criterion that might be used is that of functionalism, distinguishing between those works designed primarily for an esthetic or intellectual purpose and those intended primarily for some utilitarian function.[50] Only the former should be included under an art-proceeds right. This criterion would clearly exclude those works which are not at present granted copyright protection.[51] In addition, it would deny the right of profit to the creator for those works of artistic merit destined for further exploitation through the use of reproductions.[52] It would be possible, on the basis of this distinction, to provide for the automatic discontinuance of the *droit de suite* when utilitarian exploitation begins. In such a case, the primary rationale for imposition of the art-proceeds right, justice for the creator, would be satisfied, since the artist could make use of presently existing rights under the copyright statute. There should be no decrease in the incentive which now exists and the public interest would be served by a mere continuation of present law.

The fact that a work is of little apparent artistic merit should not exclude it from the protection of the *droit de suite;* appreciations of artistic merit may legitimately differ among individuals. However, the concept of utilitarian pur-

[50] *Compare* Holmes, J. in Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903): "The antithesis to 'illustrations or works connected with the fine arts' is not works of little merit or humble degree . . . ; it is 'prints or labels designed to be used for any other article of manufacture.'"

[51] *E.g.*, works which would be protected by design patents.

[52] *Compare* the statuettes in Mazer v. Stein, 347 U.S. 201 (1954).

pose would serve to limit the more extreme examples of "works of art" under the present statute.[53] It would also be more nearly in accord with the purposes of the *droit de suite*, which is designed to secure remuneration for the creator when there is no other means available.[54]

A second criterion would be that of "originality." [55] Original works would be subject to protection under this right; copies would not. To a certain extent this might be modified to include the practice of producing limited numbers of original prints and cast sculptures.[56] Again, the basic purpose of the right would be secured by this limitation. If the creative artist wishes to reproduce his original work, this is a right protected, albeit imperfectly,[57] by the present copyright law. The application of the art-proceeds right to copies would result in a double form of protection for the artist, first through the exercise of the reproduction right, second through the exercise of the collection right.[58] This would not serve the basic purpose of copyright, which seeks to balance the legitimate interests of the artist against those of the public with a resultant benefit to both.[59]

[53] *E.g.*, "designs printed on scarves and dress fabrics, dinnerware patterns, dolls, Christmas decorations, banks in the shape of dogs, and artistic jewelry boxes." M. NIMMER, COPYRIGHT § 19.3, at 88 (1963).

[54] *Supra* pp. 56–57.

[55] As used here, *originality* refers to the physical originality of the object itself, not the originality of the idea embodied in that object.

[56] *See* J. Cahn, *What Is an Original Print?* 37 N.Y.S.B.J. 546, 547–48, for a description of the procedures and definitions in this field.

The statute eventually adopted might contain a limitation, similar to that in the Italian law, discussed *supra* p. 6, limiting the right to prints produced from the original plates and signed by the artist.

[57] Under the law as presently interpreted, artistic copyright is lost upon transfer of the work of art unless specifically reserved. The same rule is applied under common-law copyright. Pushman v. New York Graphic Soc'y, 287 N.Y. 302, 39 N.E.2d 249 (1942). For a criticism, *see* S. Cohen, *An Artist Sells a Painting: The Courts Go Astray*, 5 U.C.L.A.L. REV. 235 (1958). The proposed copyright revision, § 202, H.R. 2512, 90th Cong., 1st Sess. (1967), if passed, would remedy this situation.

[58] This double protection should be distinguished from the parallel protection (also unnecessary) which would result if the first criterion of functionalism, discussed *supra* p. 63, were not adopted.

[59] SHAW, *supra* note 41, at 35.

A third criterion might be based on the source of value of the work. To be protected under the *droit de suite*, the value should inhere in the work itself, not in the materials used or the way in which the work is used. This is perhaps the most difficult criterion to enunciate without reference to particular categories. It is designed to exclude from protection those works, like jewelry, in which increases in value are due largely to the materials used.[60] In addition, it may be used to exclude those creative works, like architecture, which derive their value not only from their intrinsic merits but also from external factors, such as the situs of the construction, value of property, and landscaping.[61] When the increase in value is caused by factors other than the work itself and the growth of the artist's reputation, the purposes of the *droit de suite* are not fulfilled. The artist is rewarded for an eventuality, to the occurrence of which he did not and could not contribute. Thus, there is no element of either reward or incentive.

A final criterion might be based on whether the work is one produced by an employee or by an artist acting either as an individual creator or under contract.[62] In the first situation, the economic arguments for the imposition of a *droit de suite* would not be as compelling as in the latter. As an employee, the artist would presumably receive an adequate salary, paid when he is highly creative as well as when he is relatively inactive. However, this distinction is less persuasive than the

[60] Duchémin, *La Propriété artistique*, 19 Rev. Int'l du droit d'auteur 323, at 355–57.

The Czechoslovak statute, discussed *supra* p. 54, contained a similar limitation, in an effort to prevent application of the art-proceeds right caused solely by inflationary tendencies and scarcities, in the field of architecture.

[61] Duchémin, Droit de suite 71. *Compare* the Czechoslovak and proposed West German statutes, discussed *supra* pp. 54, 56.

Of course, even with these guidelines, there will be a number of areas of questionable applicability. *E.g.*, in the case of architecture, it would be difficult to distinguish between plans drawn up for eventual use and those in which the creator seeks only to exercise his and the viewer's imagination. The latter might readily be considered works of art deserving full protection.

[62] The French statute of 1920, discussed *supra* p. 51, required that the work be the "personal" product of the artist.

preceding three. The same rationale for the right applies whether the artist works for a salary or for a sales price. If the artist produces works in demand by the public for their artistic value, he should be rewarded, and his continuing productivity should be stimulated whenever possible.[63]

TRANSACTIONS COVERED

No country which has adopted the *droit de suite* has attempted to apply it on a regular basis to any other than public sales through either auctions or dealers.[64] This failure has been criticized;[65] it has been justified on the ground of the extreme difficulty of policing private sales.[66] Another argument that might be directed against extension of the art-proceeds right is the impossibility of determining the true value of works transferred through private exchange or barter. It is, of course, impossible to justify the exclusion of any transfer for profit on a theoretical basis. If it were possible to enforce the right, logic would demand its extension to all such transactions.[67] The question necessarily arises: Assuming the desirability of incorporating the *droit de suite* into American copyright, is it impossible to enforce the assertion of this right in private transactions?

It would be extremely difficult to institute a public or semi-public system of inspection. The invasion of privacy that would result would be an unbearable infringement upon the rights of individuals in a free society. Art works are largely intended to be enjoyed in the privacy of the home; to require

[63] The question of employee products is, however, closely related to the problem of collaborative works, discussed *infra* p. 78. There is always the question of how much the employer contributed to the final product.

[64] Italy's system applies only to a small number of nonpublic sales. *See supra* p. 55. And the success of the Italian system is questionable.

[65] 2 P. OLAGNIER, LE DROIT D'AUTEUR 378 (1934).

[66] A. LE TARNEC, MANUEL JURIDIQUE ET PRATIQUE DE LA PROPRIÉTÉ LITTÉRAIRE ET ARTISTIQUE 90 (1956).

[67] The discrimination which the additional charge of an art-proceeds right might cause against public sales is also an argument for its extension to private sales.

owners to submit to anything approaching a systematic check on possession of these works would be unreasonable.[68] As far as collection societies are concerned, the expense of maintaining an effective system of inspection would be vastly disproportionate to the amounts that might reasonably be expected to be collected. In the field of music, ASCAP, which licenses only the right of public performance for profit, finds it difficult to sample more than a small portion of radio broadcasts, by their nature public and not private.[69]

However, enforcement by public or semipublic agencies is not the only means of enforcement. It would be possible to create a system whereby self-policing would be to the best interests of both the vendor and the vendee of a work of art. For example, in a statute incorporating the *droit de suite,* the draftsman could require that every sales agreement specifically provide for assumption of the burden of payment to the artist by one of the parties to the contract. The penalty for failure to do so might be avoidance of the sale. Since, presumably, the parties would not consummate a sale if they did not wish it to be effective, this would be a powerful incentive for the inclusion of such an agreement. The statute could then provide that, if the party bearing this burden of payment failed to perform, the sale would be voidable at the option of the other party. This too would be a powerful incentive, forcing the burdened party to choose between payment and the risk of loss of a profitable agreement through recision. If the law were so worded, it could apply easily to all transfers of ownership under whatever form they might take. The difficulties of barter or exchange would also be overcome because the parties would have a strong incentive to clarify their agreement in an effort to avoid future litigation.[70]

[68] And probably unconstitutional. *Cf.* Camara v. Municipal Court, 387 U.S. 523 (1967).

[69] S. Shemel & M. W. Krasilovsky, This Business of Music 91–92 (P. Ackerman ed. 1964).

[70] This procedure is intended only as an example. Two others readily come to mind, both less drastic in effect. One would require insurance companies

The methods of self-enforcement described above would apply only in the case of transactions entered into for profit. In these cases, both parties have an interest in preserving the sale, since both hope to profit from it. Gratuitous transfers would not be governed by the same considerations, and it is doubtful whether they should be. In the instance of a gift to an individual, no profit is realized by the donor; there is nothing to which the *droit de suite* could attach.[71] In any event, when the donee decides to sell he will probably make a profit, including that which would have accrued to the donor, and the artist may collect on this transaction.[72] The second problem in applying the *droit de suite* to true gifts under this system of self-enforcement lies in the fact that the donor has no pressing interest in making his gift effective. He could assume the burden of payment under the procedure outlined above and then neglect to pay, having no fear that the donee would seek to rescind the transaction.

One exception to this reasoning about gifts might be noted. When a large gift is made to a charity, a donor may secure substantial tax savings under the charitable deductions provision of the Internal Revenue Code.[73] Here, then, the donor does have an interest in maintaining the effectiveness of the gift, since he is securing a gain upon the transaction. Addi-

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to ascertain whether the artist had been paid before insuring works of art. Another would simply regard the last public sale as the last sale for purposes of the *droit de suite*, unless payment were made in intervening private sales. None of the three possibilities is necessarily exclusive; all could be used to assure payment to the artist. Of course, the method outlined in the text would cast the widest net, a desideratum.

[71] This statement implicitly assumes that the "value-added system" of computation of rates, in which only monetary profit upon sale will be subject to the *droit de suite*, will be adopted. *See* the discussion *infra* p. 75–76. If the "royalty system" is adopted, there would, of course, be something to which the right might attach: the transfer itself.

[72] This reasoning applies not only to *inter vivos* gifts but also to all transfers without consideration, including gifts *causa mortis* and testamentary provisions in general. The fact that state and federal estate taxes might attach in the latter instances, however, would provide an excellent opportunity for imposition of the art proceeds right if the "royalty system" is adopted.

[73] INT. REV. CODE § 170 (1954).

tionally, such a donation might well be the last instance of a transfer of this work of art, if the gift is made to a museum. Further rights of the artist under the *droit de suite* would be lost with such a transfer. Here it would be possible to collect under the art-proceeds right on the amount claimed as the value of the work by the donor for Federal Income Tax purposes.[74]

Self-policing is not the only viable means of ensuring compliance with the provisions of an art-proceeds right statute, although it would be the most effective acceptable concept. In addition, some means of enforcement by private suit might be left to the artist. An action for treble damages could be created, in much the same way that the antitrust laws provide for private enforcement suits.[75] The costs of such litigation might be awarded to the plaintiff by the court when it has been shown that the nonpaying party has been deliberately at fault.[76] The sums so awarded can be substantial and might serve as an additional deterrent.[77] Finally, an effective system of registration tied to a procedure for authentication might provide an additional incentive for payment of the amounts due the creator of a work of art in two ways. First, it would provide a readily available source of information for collection societies in their efforts to trace and collect upon sales of art works. Second, the protection against fraud that such a system would offer purchasers would encourage registration with its concomitant effect of giving notice to artists or their representatives of transfers that did take place.[78]

[74] Parenthetically, it might be noted that this would be some incentive, albeit minor, for a more realistic evaluation of donated works of art.

[75] Clayton Anti-trust Act § 4, 38 Stat. 731 (1914), 15 U.S.C. § 15 (1964).

[76] As has been done in *id.* The present Copyright Act, 17 U.S.C. § 116 (1964). also contains such a provision in the case of suits brought under the law. *See also* the proposed revision, *supra* note 57, § 505.

[77] *E.g.*, F. W. Woolworth Co. v. Contemporary Arts, Inc., 193 F.2d 162 (1st Cir. 1951), *aff'd*, 344 U.S. 228 (1952), which resulted in the imposition of $2,500 in attorney's fees in addition to a judgment for $5,000.

[78] *See infra* pp. 72–73.

NOTICE, REGISTRATION, AND AUTHENTICATION

Every copyright statute adopted in the United States since that of 1802 has required the attachment of copyright notice as a prerequisite of federal protection.[79] The proposed revision would continue this requirement.[80] Although a number of arguments have been adduced for the elimination of this requirement,[81] it is clear that no exception should be made for works of art if a *droit de suite* is adopted. The claim of protection does serve the purpose of informing purchasers of the artist's right in a work; the general uniformity of the copyright law should be preserved as much as possible. In addition, since the art-proceeds right would not extend to all works of art,[82] an awkward system requiring notice for some art works, but not for others, would be created if a derogation from the general-notice requirement were permitted in this instance. On the other hand, special notice on the work of an intent to claim under the provisions of a *droit de suite* would not be necessary.[83] The general copyright notice would be sufficient to alert prospective purchasers to the possible existence of such a claim; the proliferation of notices should be avoided.[84]

Closely related to the question of notice is that of registration. If there is no requirement of a specific notification of intent to collect under a *droit de suite* on the work itself, some system whereby the purchaser would be informed of possible duties under the statute would be necessary. The minimal re-

[79] V. Doyle, G. Cary, M. McCannon, & B. Ringer, *Study No. 7: Notice of Copyright*, in 1 STUDIES ON COPYRIGHT 229, 231 (mem. ed. Copyright Soc'y, 1963).

[80] H.R. 2512, *supra* note 57, § 401.

[81] Doyle, Cary, McCannon, & Ringer, *supra* note 79, at 272.

[82] *Supra* pp. 62–65. [83] Schulder, *Art Proceeds Act* 38–39.

[84] It is clear that even under the present law the notice of copyright is insufficient to provide adequate information to interested parties. *See* Doyle, Cary, McCannon, & Ringer, *supra* note 79, at 46. A higher standard should not be required of artists.

quirements of an art-proceeds right would include filing some means of identification of the work for which protection is claimed, together with the signature of the artist and a statement of the original sales price. Indentification, possibly through photographs and a description of the work as well as the artist's signature, is required to protect against the possible assertion of false or fraudulent claims. If all works of art are not to be protected by the statute, a general statement, such as that permitted in France,[85] would be insufficient to notify prospective purchasers. The specific works protected would require identification to prevent an unscrupulous vendor from collecting money for works not within the coverage of the statute. In addition, if a "value-added" system of levies is established,[86] a statement of the original sales price would be necessary to inform purchasers of the amounts that they will have to pay.

The primary argument against registration would be the indifference or lack of knowledge of artists. However, in light of the probability that notice should be continued as a requirement, this objection loses much of its force.[87] Infrequent registrations of artistic copyright claims under the present law [88] do not indicate that the requirement of registration under a *droit de suite* would make the exercise of the right difficult or impossible. Since the rights granted to the artist under the present statute are unlikely to result in greatly increased income to artists,[89] there has been no real incentive

[85] *Supra* p. 52. [86] *Infra* pp. 75–76.

[87] Especially if registration need not be simultaneous with the claim of copyright protection. *See* infra pp. 73–74.

[88] In the six-month period, January–June 1955, there were only 5,409 registrations of works of art (classes G–K under the present law). Of these, only 2,114, or 39.1 percent, were works of individual creators. J. Guinan, *Study No. 30: Duration of Copyright*, in 1 STUDIES ON COPYRIGHT, *supra* note 79, at 500.

[89] 17 U.S.C. § 1(a) (1964) grants reproduction rights to artists. These are the most important present sources of income and are not particularly productive. Section 1(b) grants the right to complete models or designs; § 1(c) grants the right of exhibition.

for the registration of these works. On the other hand, if a *droit de suite* is instituted there would be a persuasive reason for registration.

Although it is clear that some registration system is desirable, the mechanics of this procedure leave room for much discussion. One of the major gains foreseen by the original proponents of the French *droit de suite* was the possibility of authentication of works of art through the system of registration of claims.[90] The French experience has shown that this goal is not essential to the effective operation of the art-proceeds right. The question remains: Is a registration procedure which aims not only at the recordation of claims but also at the authentication of art works desirable and workable in the United States?

The need for some such protection for purchasers in the burgeoning art market of today is clear.[91] A number of proposals for the institution of a system of registration and authentication, apart from the *droit de suite*, have been introduced.[92] An authentication procedure would itself be an aid in the enforcement of the *droit de suite*, while it would require little in the way of additional effort. Insofar as the filing required in such a system is concerned, the purposes of authentication could be satisfied by the artist merely by filing those papers which would be necessary to enable the *droit de suite* to function: a description of the work and his signature. The only further filing necessary would be by the purchaser, and this might be accomplished easily in conjunction with the payment to the artist under the art-proceeds right. Such a system would serve the dual purpose of furthering enforcement of the *droit de suite* and extending protection to purchasers of art works. If filing were required,[93] the artist or his represen-

[90] *Supra* p. 53. [91] See Schulder, *Art Proceeds Act* 26–27.

[92] *E.g.*, H.R. 13446, 89th Cong., 2d Sess. (1966). *See generally* A. Lane, *How the Bar Can Assist the Art Community*, 20 RECORD OF N.Y.C.B.A. 615 (1965).

[93] *Compare* the proposal in Schulder, *Art Proceeds Act* 41.

tative would be able to check upon transfers and the collection of the amounts due would become easier. On the other hand, by filing, the purchaser can continue a clear chain of title, protecting both himself in the case of resale and subsequent purchasers in the case of later attempted frauds. In addition to the filing of the name of the purchaser, the price paid for the work would also be necessary under a "value-added" system. Because of these obvious benefits, as well as the less obvious fact that the institution of such a system might make an art-proceeds right more palatable among collectors, the desirability of an authentication procedure is evident. The lack of success in France need not be a precedent in the United States; the differences between the systems makes any analogy on this point questionable.[94]

Once it has been determined that the requirement of copyright notice as a prerequisite to protection under the *droit de suite* will be retained, the time of registration becomes relatively unimportant. It would make little or no difference whether the artist were required to register at the same time copyright protection arises or whether he could do so later.[95] A requirement of registration at the time of assertion of copyright would impose no hardship; if the artist intends to reproduce his work, the art-proceeds right would be lost upon reproduction.[96] No choice between alternatives need be made. On the other hand, notice of copyright alone would be sufficient to alert prospective purchasers of the possible applicability of the art-proceeds right to the work purchased.[97] Additionally, under the proposed revision of the Copyright Act, the duration of protection—life plus fifty years—would remain the same whenever registration took place.[98] In this sit-

[94] *Id.* at 39–40.

[95] Assuming the registration requirements of 17 U.S.C. §§ 13, 14 (1964) are changed.

[96] *Supra* p. 63.

[97] Thus alerted, a purchaser would be in no position to complain if the art-proceeds right were to attach subsequently by registration.

[98] In this instance, and in that noted in note 95 *supra*, it has been

uation, it would seem desirable to leave the question of the time of registration to the discretion of the person seeking the protection of the statute.

RATES

There are three basic problems connected with the question of rates. First, at what price level should an art-proceeds right begin to operate? Second, should such a right apply to all transactions that take place at or above this level or only to those in which an increase in price has occurred? (Implicit in this question is another: If the latter answer is chosen, should the collection right apply only to the increase in price or to the entire sales price?) Third, should the rate levied be the same for all transactions covered or should it be graduated? [99]

The answer to the first question involves the problem of setting a "threshold" price. If the price so set is too low, a number of minor transactions, providing only miniscule revenues for the artist, will be covered. The problems of policing these transactions, which do not attain high levels of value, would be manifold. If the price set is too high, the artist will be deprived of revenues which he would otherwise be entitled to receive. This would result in a diminution of the artist's profit, the increase of which the *droit de suite* is designed to secure. Within these limits, any price set would be largely arbitrary,

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assumed that the present provisions of the law will be changed. If not, the same problem arises: What term of protection will be accorded to an art-proceeds right if nonsimultaneous registration is permitted? In case the present law is not revised, it would appear that the simplest solution would be the requirement of registration when copyright attaches.

[99] Another question, beyond the scope of this essay, relates to the actual rate set. Beyond the concept that in a "value-added system" the rate should be higher than that in a "royalty system," *infra* p. 76, only general guidelines may be considered. The rate should not be so high as to discourage compliance with the law or injure the market; it should not be so low as to prevent a fair return to the artist. The Belgian system, with rates extending to 6 percent of the entire sales price, seems to have been effective, at least as applied to public sales.

dependent upon the relative weight accorded to each of these alternatives by the legislator. The maximum "threshold" price should be lower than the average cost of paintings in the art market, to assure that some substantial revenues will be produced; the minimum price should result in a payment to the artist of a reasonable sum, not less than $10.[100]

This leads to the second problem: the choice between a value-added and a royalty system. Under a value-added system,[101] only the increment in value of the work at the time of the sale subject to the *droit de suite* would be subject to charge. The price paid by the vendor would be subtracted from the price which he receives, and the resultant figure is the amount on which the art-proceeds right is attached. The royalty system involves a straight charge upon the entire price paid to the vendor. The most desirable feature of the latter system is its basic simplicity.[102] The imposition of a straight rate will result in a higher payment to the artist in many situations, since it would apply regardless of declines in prices. The value-added concept, on the other hand, involves more computation; the artist would benefit only in those cases where there has been an actual increase in value.[103] If

[100] As an example, the "threshold" price might be set at $1,000. Under a royalty plan, at 3 percent this would result in a payment of $30. Under a value-added plan, at 5 percent, if the preceding price of the work on which the right was exercised were $100, the payment would be $45. If the preceding price were $500, the amount would be $25. If the preceding price were $800, the amount collected would be only $10.

[101] *Supra* p. 59.

[102] Another factor cited to support this system is the parallel to copyright protection under the present law. Schulder, *Art Proceeds Act* 30. *But see supra* note 48. A final reason for a royalty plan lies in the difficulties encountered when nonsubject sales occur under a value-added system. This will be discussed *infra* pp. 88–89.

[103] This concept has been criticized as theoretically unsound because it applies where both the base and present sales prices are below the original price. Here, where the artist, *e.g.*, sells his work for $1,000, it declines to $200 and is later sold for $800, a percentage of $600 would be collectible. Schulder, *Art Proceeds Act* 31–32. However, this does not consider the fact that one purpose of the right is stimulation of the artist into production of better quality works to improve his reputation. If he does so, the work should

the rates for both systems were the same, the artist would benefit much more from the royalty system than from the value-added, since under the latter, the base price, or price received at the immediately preceding sale, would be taken into account. To compensate for this, the rate is usually higher for a value-added plan than for a royalty system.[104]

Of the two concepts, value added seems preferable. It is more closely related to the basic concepts of the *droit de suite* and of copyright itself: reward and incentive.[105] Under the royalty system, the artist would benefit regardless of the continuing quality or productivity of his work: [106] the idea of selling to cut losses is not unknown in the art market, and the royalty plan would attach to these sales as readily as to any other. The value-added concept is not too difficult to compute; the possibilities of fraud and difficulties of policing are ordinarily no greater than in the royalty system, especially if private transactions are covered.[107] Finally, the value-added concept might occasion a greater degree of popular support in the art market than would the royalty plan.[108]

The third question should there be graduated rates?—is less complicated. It might be noted that the French *droit de suite* first employed a graduated system; under the 1957 revision this was abandoned.[109] The basic objection to graduated rates lies in that they reward those artists least in need of reward, those whose works are selling at the highest prices and who would be receiving higher benefits even under a straight percentage rate.[110] There appears to be little reason for adoption of a graduated system.

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be subject to the collection right. The problem might be avoided by a provision for no collection on sales below the original price, filed at registration. *Supra* p. 71.

[104] *Supra* pp. 54–56 (Italy, Czechoslovakia, Poland, and Uruguay).

[105] *Supra* p. 60.

[106] He will also fail to benefit as much as under the value-added system if his works increase sharply in value. *See supra* note 100.

[107] *See supra* pp. 66–69. [108] Schulder, *Art Proceeds Act* 32.

[109] *Supra* p. 52.

[110] *Compare* the suggestion made in a draft change in the French law, pro-

COLLECTION

The way in which amounts under the *droit de suite* would be collected and paid to the artist poses another major problem. In those countries where the art-proceeds right has been effective, France and Belgium, the principal means of collections has been through the use of agencies acting for a number of artists.[111] It is almost impossible to conceive of a successful application of the *droit de suite* without such a group or society. The expense of the necessary policing, collection, and litigation makes such an organization the only alternative to governmental action. While there is no such body in existence in the United States, there are a number of groups that might be able to develop to take on these functions.[112] The absence of a developed agency should be no bar to the inauguration of the right. At the time that such a statute would go into effect there would probably be no substantial collections for a number of years. An organization could readily develop along with the right. At the time of the grant of performance rights to composers of musical works in the 1909 statute,[113] there was no organization in existence capable of enforcing those rights. Today there are three.[114]

It is doubtful that collection should be undertaken by a governmental agency. Such an organizational plan could be an act of favoritism that might be objectionable,[115] and the

posed in 1937: "Enfin, ils proposent un tarif dégressif, au lieu de progressif, ce qui aurait l'avantage de faire profiter de la loi les peintres modestes et non seulment les plus connus." DUCHÉMIN, DROIT DE SUITE 149.

[111] For a description of the French group, *see* Hauser, *French Droit de Suite* 9–10.

[112] *E.g.*, the American Federation of Arts or the United States Committee of the International Association of Art, in Schulder, *Art Proceeds Act* 41.

[113] 35 Stat. 1075 (1909), 17 U.S.C. § 1(c) (1964).

[114] The American Society of Composers, Authors and Publishers (ASCAP), formed in 1914; Broadcast Music Incorporated (BMI), formed in 1940; and SESAC, Inc. (formerly, the Society of European Stage Authors and Composers), formed in 1930. *See generally*, S. ROTHENBERG, COPYRIGHT AND PUBLIC PERFORMANCE OF MUSIC 28–65 (1954).

[115] Schulder, *Art Proceeds Act* 40.

agency then could not perform all the functions that would be necessary for effective enforcement of a *droit de suite*. Litigation and education of the artist to the existence of his rights are only two examples of such functions. Finally, it is doubtful that the right can be legislated into effectiveness through governmental action alone. The failure of the Italian system, caused in part by the inertia of the art community,[116] indicates that governmental action is not enough. If an art-proceeds right is to be enforced, private action by the artists or those representing their interests is necessary.[117]

COLLABORATIVE WORKS

There would appear to be few difficulties in dealing with the ordinary problems presented by collaborative efforts under an art-proceeds act. The system adopted in the first French decree of 1924,[118] later repealed, is both effective and uncomplicated. Under this procedure, a legal presumption is created that each artist has contributed equally to the final work of art. This presumption could be overcome by specific agreement to the contrary.[119] A problem does arise, however, in connection with those instances of artistic creation where it is an employer who actually collaborates with an employee in the creation of a work of art.[120] In such a case, falling within the second definition of a "work made for hire" in the proposed revision of the Copyright Act,[121] the ordinary approach to the employer-employee relationship, which would leave the *droit de suite* in the hands of the employee until reproduction,[122] would not be properly applicable. The same might be said of the institution of a presumption of participation in equal shares. Here, the approach

[116] *Supra* p. 55.

[117] Of course, some governmental action, *e.g.*, registration, is necessary.

[118] *Supra* note 10. [119] *See also* Schulder, *Art Proceeds Act* 37.

[120] An example of such a situation would be the case in which an artist is commissioned to collaborate with a designer in producing sketches of ballet costumes. More prosaic would be the case of a script writer for a movie.

[121] *Supra* note 57, §101. [122] *Supra* p. 65.

taken in the proposed revision, leaving the matter to agreement among the parties at the time of entering into the relationship, would seem preferable.

INALIENABILITY

All the national laws instituting an art-proceeds right have included provisions establishing the inalienability of the right. One basic fact justifying the *droit de suite*—that frequently an artist is obliged by need to sell his works at unfairly low prices—is also a sufficient rationale for this provision. If the art-proceeds right is not inalienable, the hard-pressed artist, willing to sell his work for a pittance, will have no greater ability to withstand demands that he also transfer the right to collect. This concept of protection is not foreign to the present copyright law.[123] With inheritance rights, much the same reasoning is applicable to prevent dispositions to others than intestate successors.

RETROACTIVITY

Here, again, there is a difficult problem. If the art-proceeds right is not made retroactive, the artist who sold his work in the past will not be protected by the law. The injustice which the *droit de suite* seeks to remedy would be continued and perpetuated in the case of these creative workers. On the other hand, if the law is made retroactive, it will result in an unfair imposition of a duty to pay on those who have purchased the art work created before passage of the statute. These individuals, who otherwise might have negotiated with their vendors for a more even distribution of the burden as reflected in the sales price, will be compelled to bear the entire load.[124] Retroactivity would also make the goal of au-

[123] Compare the renewal provision of the present statute, 17 U.S.C. § 24 (1964). *See also* the discussion in Hauser, *French Droit de Suite* 26–27.

[124] This has been raised to the level of a constitutional problem by some writers, *e.g.*, Schulder, *Art Proceeds Act* 33. The problem does not appear that serious. *Compare* Hauser, *French Droit de Suite* 26. While it is true that a property right, once vested, may not be taken from a person by legislative

thentication more difficult to achieve. If the law were to be applicable to all those who had died in the preceding fifty years, there would be little chance of obtaining signature specimens, photographs and descriptions of the works, or a statement of the original sales price in many instances. If the right were made retroactive, the problems posed by the process of tracing and locating protected works would be equaled only by the seriousness of the invasions of privacy that could easily result from that process. Retroactivity is not essential; the purposes of reward and incentive would not be served by granting protection to works produced many years before, by artists long dead or inactive. On balance, retroactivity does not seem desirable in any *droit de suite* that might be adopted.

INCORPORATION: THE LEGAL ASPECTS

CONSTITUTIONAL

Although the question of whether a work of art may constitutionally be copyrighted has been raised,[125] there has been no final resolution of the problem by the United States Supreme Court.[126] The broad scope of this question, extending

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fiat, Campbell v. Holt, 115 U.S. 620 (1885), Stewart v. Keyes, 295 U.S. 403 (1935), the *droit de suite* would not be legislative action of this nature. It would create a new right, vesting it in the artist. It is difficult to conceive of this as a "taking" in any sense. The statute would apply only to future sales of the works in question and would not constitute an assessment levied on past transactions. Even if the statute is seen as a "taking", the question of constitutionality remains open. Courts will consider the public interest served by the statute, the extent to which the preexisting right has been altered or destroyed, and the nature of that right, in an effort to test the reasonableness of the legislation. C. Hochman, *The Supreme Court and the Constitutionality of Retroactive Legislation*, 73 HARV. L. REV. 692, 697 (1960). The *droit de suite* would satisfy these conditions. *Compare* Louisville & N.R.R. v. Mottley, 219 U.S. 467 (1911); Gange Lumber Co. v. Rowley, 326 U.S. 295 (1945); and North Am. Co. v. SEC, 327 U.S. 686 (1946).

[125] By Mr. Justice Douglas in Mazer v. Stein, *supra* note 52, at 219.

[126] The opinion of Mr. Justice Holmes in Bleistein v. Donaldson Lithographing Co., *supra* note 50, has been frequently cited for the proposition that

across the entire field of protection of artistic rights, is beyond the ambit of this study. However, it should be noted that federal courts frequently enforce copyrights granted to artistic works.[127] And it appears likely that if presented directly with the problem the courts would uphold the validity of congressional action in this area.[128]

Another question, more directly related to the point here, does arise: Granting the constitutionality of copyright protection for artistic works, would the *droit de suite* be seen as a permissible means of attaining this end? In opposition to the constitutionality of such legislation a number of arguments might be urged. First, there appears to be no legitimate object of the "exclusive right" to be secured to the author. The Constitution provides: "the Congress shall have Power . . . To promote the Progress of Science and the useful Arts, by securing for a limited time to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." [129] As interpreted in its application to copyright, the right granted is: [130]

> to that arrangement of words which the author has selected to express his ideas. Or, as Lord Mansfield describes it, "an incorporeal right to print a set of intellectual ideas, or modes of thinking, communicated in a set of words or sentences, and modes of expression. It is equally detached from the manuscript, or any other physical existence whatsoever."

Even taken outside the context of writings to which the quotation refers, the art-proceeds right would clearly appertain to the material object itself, and not merely to the original form

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Congress may legislate on this subject. However, the issue in that case did not go to the question of whether works of art were "writings," but whether such protection was accorded to the "useful arts." Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884), holding that a photograph is a "writing," is a more persuasive precedent, but not conclusive, especially in the field of three-dimensional works of art.

[127] *E.g.*, Mazer v. Stein, *supra* note 50; Syracuse China Corp. v. Stanley Roberts Inc., 180 F. Supp. 527 (S.D.N.Y. 1960).

[128] *See* M. NIMMER, *supra* note 53, §§ 8.1, 8.6.

[129] U.S. CONST. art. I, § 8.

[130] Holmes v. Hurst, 174 U.S. 82, 86 (1899).

of expression contained in the work. Congress, therefore, it might be argued, would be creating a continuing interest not in the constitutionally protectable form of expression but in the physical object in which that form of expression inheres.

Second, the *droit de suite* applies only to original works. It is not concerned with reproductions, except to exclude them from its protection,[131] and thus appears to be more a regulation of property rights in an article which moves in interstate commerce than a form of copyright protection.[132] Third, the right has the appearance of being, in effect, a tax [133] imposed for the benefit of an individual or group of individuals.[134]

These suggestions are based upon a misconception of the nature of the *droit de suite*. Any intellectual creation necessarily has two aspects: the original means of expression of an idea and the tangible medium through which this is communicated. An author first communicates through a manuscript. The physical embodiment of the expression is the written word, and the intellectual process through which this is perceived is that of reading. The concept may be communicated as easily through the printed page as through the typewritten or handwritten page. Because of this fact, the physical object by means of which the author communicates ordinarily has little or no commercial value.

The situation is different in respect to an artistic creation. Here, the idea within the means of expression is originally communicated through a canvas or other medium. The intel-

[131] *Supra* pp. 15–16.

[132] This is closely related to the first point. The artist by definition parts with rights in the material object upon sale. In effect, it might be argued, the *droit de suite* merely provides for a continuation of certain rights after sale, a regulation of interstate commerce. Although the scope of the federal commerce power has consistently expanded, Wickard v. Filburn, 317 U.S. 111 (1942), it is difficult to conceive of a more purely intrastate transaction than sale of an art work in New York, a center of production and sale. *See* Hauser, *French Droit de Suite* 10. M. NIMMER, *supra* note 53, § 9, would support the use of the commerce power

[133] Recht, *supra* note 36, at 61.

[134] *Compare* United States v. Butler, 297 U.S. 1, 61 (1936).

lectual process through which the creator's contribution is perceived is that of viewing. In the present state of art reproduction, the concept may not be communicated as easily or desirably through a photograph or other machine-made reproduction.[135] As a result, it is the physical object by means of which the artist shows his form of expression that is of the greatest commercial value.[136]

Just as the present statute protects the right of the author to exploit the most valuable process of perception of his ideas —reading—the *droit de suite* would protect the right of the artist to exploit the most valuable process of perception of his work—viewing. The art-proceeds right achieves this end by providing that, before another may be enabled to make use of a work for his own pleasure, the artist shall receive a reasonable compensation. The fact that both the tangible and intellectual products of the artist's labor are inseparable is irrelevant. They may be separated in theory, and the artist may receive remuneration for the copyrightable portion of his product.

Viewed in this light, the art-proceeds right does not fall outside the traditional area of copyright protection. An analogy might be made to the common-law copyright retained by the author of a manuscript, when ownership of the tangible object has passed to the recipient. Here, the right to publish is retained by the author, although the physical object has been transferred without reserve.[137] The "exclusive right" that is protected is not a property right in the object itself but a right to exploit a set of intellectual ideas contained therein. Under such an analysis, suggestions that the *droit de suite* falls outside the constitutional grant of congressional power in the field must necessarily fail.

[135] *But see supra* note 32. [136] *Compare* Schulder, *Art Proceeds Act* 30.

[137] For examples of distinctions between material object and intangible creation at common law, *see* Baker v. Libbie, 210 Mass. 599, 97 N.E. 109 (1912) and Chamberlain v. Feldman, 300 N.Y. 135, 89 N.E.2d 863 (1949).

STATUTORY

A *droit de suite* would fit into the present copyright law only with some difficulty and straining of fundamental concepts. In addition to the mechanical problems of definition, duration, registration, and collection,[138] the grant of an art-proceeds right would represent a marked departure from the framework of the present grant of rights.[139] At present, the law contains only limited, specific grants of protection to artists and their creations. The *droit de suite*, if incorporated, would require a complete review of the structure of granted rights, with a view to fitting into the legislation protection of only a part of what today would be classified as works of art.

The proposed revision of the copyright law would provide a much more suitable framework into which an art-proceeds right might be incorporated. The grants of rights in the revised bill do not proceed in the limited fashion characteristic of the present law. Section 106(3) provides that the "owner" of copyright has the exclusive right: "to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending." [140] The limitation upon this right, upon which an art-proceeds right could readily be built, is contained in section 109(a):

> Notwithstanding the provisions of section 106(3), the owner of a particular copy or phonorecord lawfully made under this title, or any person authorized by him, is entitled, without the authority of the copyright owner, to sell or otherwise dispose of the possession of that copy or phonorecord.[141]

It should be noted that under the revision, the term *copies*, "includes the material object, other than a phonorecord, in

[138] *Supra* pp. 62–65, 70–73, 77–78, and notes 95 and 98.

[139] It is doubtful whether 17 U.S.C. § 1(a) (1964) (right to "vend") could be stretched to cover the *droit de suite*.

[140] H.R. 2512, 9th Cong., 1st Sess. (1967), cited *supra* note 57 and *passim*, § 106(3).

[141] *Id.* at § 109(a).

which the work is first fixed," that is, the original in the case of a work of art.[142] To achieve the incorporation of the basic *droit de suite,* all that would be needed would be a further qualification of section 109(a). The art-proceeds right might be analogized to the "lending right" of books proposed by representatives of authors in the discussions of the proposed revision.[143] Although the proponents of this right were unsuccessful, the theory of the statute under which they proceeded is easily adaptable. A stronger analogy to the *droit de suite*—a right of exploitation of the original even after sale —may be found embodied in the proposed statute in the concatenation of sections 106(5) and 109(b).[144] The first of these sections grants the artist the right of public exhibition. The second limits this right in a manner analogous to the limitation by section 109(a) of section 106(3). However, section 109(b) does not leave the owner of a copy (or the original) free to display it as he sees fit, but only to viewers present at the place where the copy is located. This wording of the statute was chosen specifically to protect the interests of "graphic artists and photographers," who feared that they would substantially lose the rights of exhibition given in section 106(5) if owners of these works could display them on television.[145] In the same way that this limitation on the exhibition right of an ultimate purchaser has been attained under the proposed act, the limitation of the *droit de suite* on his resale right could also be attained.

One further analogy showing the conceptual acceptability of the art-proceeds right under the proposed revision might be drawn. Section 106(4) of the revision bill grants the exclusive right of performance to the owner of copyright in musi-

[142] *Id.* at § 101.

[143] *E.g.*, the proposals of I. Karp, in HOUSE COMM. ON THE JUDICIARY, 88TH CONG., 1ST SESS., 2 COPYRIGHT LAW REVISION: DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER OF COPYRIGHTS 22 (Comm. Print 1963).

[144] H.R. 2512, *supra* note 140, §§ 106(5) and 109(b).

[145] 5 COPYRIGHT LAW REVISION, *supra* note 143, at 66.

cal works.[146] Although the right is granted in the same general terms as those of sections 106(3) and 106(5), section 116(a) of the revision speaks of it in these terms: "the exclusive right granted under clause (4) of section 106 to perform the work publicly for profit by means of a coin-operated phonorecord player." [147] This working would appear to indicate that the scope of the rights granted in section 106 is intended to be quite broad, broad enough, indeed, to cover a *droit de suite* incorporated into American law. All that would be necessary then, would be the reformulation of the qualifications of section 109(a) upon section 106(3) to make such a right effective under the proposed changes.[148]

INCORPORATION: THE INTERNATIONAL ASPECTS

Under existing treaties, there should be no real problem with incorporation of the *droit de suite* into United States copyright law. Adoption by this country of such a system would, at most, result in the necessity of according "national treatment" to artists of other states belonging to the Universal Copyright Convention,[149] or the Buenos Aires Convention.[150] Even this result is doubtful. France, which belongs to both the Universal Convention and the Berne Union,[151] has apparently felt no necessity of giving national treatment in this respect to citizens of other signatory states. The French provisions for foreign protection would apply to all nonnationals, not only those of states adhering to the copyright conventions, and limit protection to those who have participated in the life of French art for five years, instead of giving protection immediately to nationals of signatory states.[152] The *droit de suite* is of doubtful status as one of

[146] H.R. 2512, *supra* note 140 § 106(4). [147] *Id.* at § 116(a).
[148] Of course, other mechanical additions would be necessary.
[149] T.I.A.S. 3324, [1955] 3 U.S.T. 2731. [150] T.S. 593, 38 Stat. 1785 (1910).
[151] Under the Brussels Convention of 1948, *infra* note 156.
[152] *Supra* note 8.

the bundle of rights included under these international conventions; [153] it is unlikely that the United States would be compelled by international law to accord national treatment to nonnationals under these agreements if it did not wish to do so. In this connection, it is interesting to note that the Berne Union convention of 1928 was quite broad in its coverage of protected rights; [154] if the art-proceeds right is one within the Universal Convention, it should have been within the 1928 agreement. However, the extension of the right by that treaty was disputed by a number of states,[155] and the 1948 Berne Union convention expressly limited the application of the right to a basis of reciprocity.[156] It would appear, then, that presently existing agreements would have little or no effect on the obligations of the United States if a *droit de suite* were adopted. Of course, under the same reasoning, adoption by this country of such a right would not affect protection accorded American nationals by foreign states.[157]

Another set of problems does arise with the adoption of an art-proceeds right as a result of international complications. First, it has been suggested that no such right can be implemented effectively when only a small number of states accord this protection.[158] Second, the realities of the international art trade make it unlikely that a value-added system could be implemented through a system of self-policing.

The first objection rests largely upon the belief that if na-

[153] Recht, *Has the Droit de Suite a Place in Copyright?* 3 UNESCO COPYRIGHT BULL. 51 (1950); *see also* Hauser, *French Droit de Suite* 21. *But see id.* at 23. While it is true that conceptually the art-proceeds right is "an authors right," *id.* at 22, the test of whether it is covered by international conventions is one of practice, not theory.

[154] Rome Convention, 1928, art. 2, *Berne Copyright Union, Item No. E-1*, 2 UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD 1 (1956).

[155] Hauser, *French Droit de Suite* 21.

[156] Brussels Convention, 1948, art. 14 *bis* (2), *Berne Copyright Union, Item F-1*, 2 UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD 6 (1956).

[157] Except, possibly, under reciprocity provisions. *See, e.g.*, the German-United States Treaty of 1892, T.S. 100, 27 Stat. 1022 (1892).

[158] C. MOUCHET & S. RADAELLI, LOS DERECHOS DEL ESCRITOR Y DEL ARTISTA 161 (1953); 2 P. OLAGNIER, LE DROIT D'AUTEUR 380–81 (1934).

tional legislation is adopted in this area, its application can be avoided easily. Fictitious sales abroad through intermediaries who could then resell in the original country would suffice to escape the operation of the statute. In addition, it has been suggested that sales will be lost to the country applying the right and transferred to another state—quite honestly—to avoid the imposition of the charge. This argument was made when the original French statute was passed; it was iterated there when the 1957 law sought to extend the right to all public sales.[159] At first sight, this argument appears to have merit. However, it rests upon the assumption that a *droit de suite* would base its operation only on sales made within the state applying the *droit de suite*.[160] This is not necessarily so. An art-proceeds act could easily be drafted so as to apply not to the sales but to the works themselves. In this case, if the work were situated in the United States, the collection right would apply even if the work might have been sold, for example, in London. If the work were located in London, the right would not apply under such a statute, even if the work were sold by and to American nationals. Sales made abroad could be subjected to enforcement quite easily in this case: export licenses could be refused unless the amounts due had been paid. Under such a provision, fictitious transfers of title abroad through nominal purchasers would be rendered void.

A more difficult problem connected with this first objection arises under any registration and authentication procedures that might be established under an art-proceeds right. The chain of title could easily be broken by sales abroad; there would be little reason to register such changes of ownership. In this way, any hope that an artist or a collection society act-

[159] Duchémin, *La Propriété artistique*, *supra* note 60, at 359.

[160] This is still a weak argument. The right has been successfully applied in France and Belgium, which apply their statutes to sales made only within their territories. Although it has been asserted that the *droit de suite* has had no adverse effect on the French market, this is by no means certain. It is possible that the adverse effect could be found in the slow growth of that market, and it is here that the objection may possibly have some validity.

ing in his name could have of tracking sales would be frustrated. The authentication system established with registration would also be irreparably injured. Once the chain of title is broken, the possibility of fraud increases greatly; the only means of authentication would be through the description, photograph, and signature registered with the claim to protection.

The second objection also raises a serious problem. If a value-added plan were to be adopted, art as an international commodity could wreak havoc with the collection procedure. Not only would there be no effective registration procedure,[161] but also there would be no way to establish the "base value" [162] of a work with certainty, even though it might be located in the United States, if the vendor had purchased it abroad. In the case of a three-party transaction, the problem of policing also becomes acute. Assume a foreign vendor, an American purchaser from him who in turn wishes to vend the work, and a United States purchaser who wishes to buy from this second party. There could be no self-policing in this instance because the second purchaser in the United States might be just as ignorant of the price paid abroad by the American vendor as would be the artist. There would be no incentive for the foreign vendor to bring forth this information; the sale of the work in his country might not have been subject to any art-proceeds right.[163] Since a "base value" could not be set with certainty, the American vendor could easily overvalue the work and thus deprive the artist of any gain. The procedure could result in the loss to the artist of all proceeds if the work were sold alternately abroad and in the United States. At any rate, a large portion of his in-

[161] This problem is, of course, presented under both royalty and value-added systems.

[162] Meaning the price paid in the immediately preceding purchase. *Supra* p. 75.

[163] It is at this point that the problem arises; if the first sale had been in the United States, self-policing would compel disclosure here.

come would be lost if the work were regularly vended in the international market.

CONCLUSION

There would be little difficulty in incorporating a *droit de suite* into United States copyright law on a theoretical level.[164] It would seem that the concepts of reward and incentive underlying copyright theory also underlie this right.

If incorporation is attempted, a number of practical problems would necessarily arise. None, however, seem insurmountable so far as internal law is concerned. Criteria enunciating the works to be covered can be developed. The transactions subject to this right should include all sales and transactions for profit, as well as charitable gifts. Copyright notice should be retained, but there is no need for a special notice of the applicability of an art-proceeds right. Registration would serve this purpose of notice, serving as an aid to enforcement as well as a simple means of authentication of art works. A value-added system should be adopted, as more in accord with the general purposes of copyright and the *droit de suite* itself. A "threshold" price should be set, and a straight rate should be imposed. The fact that there are presently in existence no collection societies for artists is not a bar to the adoption of such a right; it is not difficult to conceive of such organizations developing within a reasonable time to enforce the rights given artists. The right should be inalienable and nonretroactive. Provision should be made for collaborative works, subject to agreement by the parties.

There would appear to be no substantial constitutional difficulties with the incorporation of such a provision. The *droit de suite* fits into the constitutional concept of copyright with as little strain as any other form of protection of the rights of

[164] Hauser, *French Droit de Suite* 23–27 also reaches this conclusion, although by different reasoning. *See also* Schulder, *Art Proceeds Act.*

artists. As far as the proposed revision is concerned, an art-proceeds right could be fitted within the statutory framework with minimal difficulties. Under the present law, some difficulties of a conceptual nature might be encountered, but these could be overcome.[165]

An art-proceeds right would impose no additional international burden on this country. However, the right runs into severe difficulties when viewed in the context of current international practice. It is extremely doubtful that there could be effective enforcement of a statute of the nature contemplated (especially with computation based on a value-added procedure) without further international agreement. In the absence of such an agreement, establishing a multinational procedure for enforcement of an art-proceeds right and extending the *droit de suite* to a larger number of countries than now appear willing to accept it, the United States should not incorporate an art-proceeds act into its domestic copyright law. Of course, considering international developments in copyright over the past fifteen years, the possibility of obtaining such an agreement in the future appears reasonable, and, in such a case, the *droit de suite* would be a desirable addition to the body of American copyright law.

[165] *Compare* the performance right in the present statute, 17 U.S.C. § 1(c), (d) (1964).

NATIONAL THIRD PRIZE, 1968

The Impact of the Multiple Forms of Computer Programs on Their Adequate Protection by Copyright

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COMPUTER PROGRAMS,[1] as dissimilar as one designed to bring together compatible members of opposite sexes [2] and one which enables a computer rapidly to search the *Index to U.S. Chemical Patents*,[3] are among 134 computer programs filed with the Copyright Office as of January 31, 1968.[4]

The problem here is confined to the question of how the polymorphic nature of such programs—ranging from diagrams to humanly intelligible alphanumerics [5] to punch cards to magnetic tape readable only by machine—affects their copy-

[1] A computer program is, briefly (the subject is discussed more fully in the text at note 64 *infra*), the set of operating instructions fed into the computer. The program specifies what operations are to be performed and on what stored material.

It also should be noted here that the computers referred to in this paper are only electronic, digital computers, and whenever the word *computer* is used, it will have this meaning. The other type of electronic computer is the analog, which today is used only limitedly. Analog computers do not need programs. For more on analog computers see DESMONDE, COMPUTERS AND THEIR USES 255–56 (1964) and SIPPL, COMPUTER DICTIONARY 12 (1966).

[2] Program filed by Computer Match Co.

[3] Program filed by Gulf Research and Development Co.

[4] This information was compiled with the assistance of Richard Glasgow, Chief, Examining Department, Copyright Office. Interview Feb. 19, 1968.

[5] A technical compound word meaning "composed both of letters of the alphabet and numerals."

rightability. Specifically, the questions are (1) In which of its forms can a program be copyrighted? and (2) If some of the forms are not themselves copyrightable, are they nevertheless protected under the law of copyright infringement?

Let us proceed from the assumption that computer programs are copyrightable in at least their written, readable form and that the Copyright Office's policy of accepting them for registration is correct.[6] I do not, then, deal with questions concerning the general copyrightability of computer programs. One brief prefatory aside on this subject is in order, however: the scope of protection of any copyrighted work extends only to the means of expressing the ideas in the work, not to the ideas themselves.[7] Consequently, the mathematical relationships which underlie a computer program would not be protected, even if they were not already in the public domain. Anyone is free to use an idea in a copyrighted program in order to make his own program, which may be more or less efficient than the program copyrighted. The underlying idea may be expressed in many different programs, although

[6] This issue has received extensive treatment in legal and trade literature, and further discussion would be largely redundant. By far the best and most thorough work is J. Banzhaf, *Copyright Protection for Computer Programs*, in ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER FOURTEEN 118 (1966) [hereinafter cited as Banzhaf]. This article is also, in slightly altered form, in 64 COLUM. L. REV. 1274 (1964). Other articles on this subject, many of which are quite skimpy, are Etienne, *Patent and Copyright Implications of Electronic Data Processing* (Panel), 8 IDEA, THE PATENT TRADEMARK AND COPYRIGHT JOURNAL OF RESEARCH AND EDUCATION 176 (1964 Conference); Goldberg, *Patent and Copyright Implications of Electronic Data Processing* (Panel), 8 IDEA 183 (1964 Conference); G. Katona, *Legal Protection of Computer Programs*, 47 J. PAT. OFF. SOC'Y 955 (1965); Lawlor, *Copyright Aspects of Computer Usage*, 7 COMMUNICATIONS OF THE ACM 572 (1964); McTiernan, *The Protection of Programs Through Copyrights and Other Methods*, pamphlet from the Ass'n of Data Processing Service Organizations, Inc., Kansas City Management Symposium (1964); Nelson, *The Copyrightability of Computer Programs*, 7 ARIZ. L. REV. 204 (1966); Puckett, *Protecting Computer Programs*, 13 DATAMATION 55 (Nov. 1967); Rackman, *Re: Legal Protection of Computer Programs*, 48 J. PAT. OFF. SOC'Y 275 (1966); and Schiffer, *Computers and Copyright Law Revision*, 11 BULL. COPYRIGHT SOC'Y 404 (1964).

[7] *See generally*, M. NIMMER, COPYRIGHT LAW § 145 (1963) [hereinafter cited as NIMMER].

for any given type of computer there is an optimum formulation.

The general outlines of the computer software [8] industry provide an introduction to: the lack of other methods of commercially meaningful protection for programs, the policy of the Copyright Office to accept them for protection, their treatment under the proposed copyright law revision,[9] and lastly, the relevant technical aspects of computer programming.

THE COMPUTER SOFTWARE INDUSTRY

The economic size of the computer software industry is a relevant factor in predicting whether it will be afforded some type of legal protection for its original processes, in this case the intellectual creation of the programs themselves. As a practical matter, as the weight of the interests seeking protection increases—and there are very few groups actively interested in seeing that computer programs are not protectable by copyright [10]—a favorable determination for these forces is made more likely.[11] The size of the industry should, therefore, be noted.

[8] *Software* is another term for all the various types of programs which can be used in computer work. Hardware refers to the machinery itself.

[9] The text, as passed by the House of Representatives (H.R. 2512), can be found in HOUSE COMM. ON THE JUDICIARY, COPYRIGHT LAW REVISION, H.R. REP. NO. 83, 90TH CONG., 1ST SESS. (1967).

[10] In hearings on the Copyright Law Revision Bill (*ibid.*), which gives protection to all forms of computer programs, only one group objected to this protection, and then only as an aside. *See* Kaplan & Miller, *The Copyright Revision Bill in Relation to Computers*, 10 COMMUNICATIONS OF THE ACM 218 (May 1967), a statement approved by the Board of Trustees and the Task Force on Legal and Related Matters of the Interuniversity Communications Council.

[11] This fact is greatly rued, and documented, in Charlow, *Descent into the Market Place: A Survey of the Subject Matter of Copyright*, 8 HASTINGS L. J. 146 (1957). The point to be made is not, of course, that commercial pressures invariably induce courts to construe as "writings," in either the constitutional (art. I, § 8, cl.8) or statutory (17 U.S.C. § 4 (1964) sense, any commercially very valuable items arguably within the scope of copyright. The uncopyrightability of phonorecords is a notable case in point. What is

In 1951 the U.S. Bureau of the Census and the U.S. Air Force purchased UNIVACs, the first commercial electronic computers.[12] Since that time the computer industry has been among the fastest growing, and during the last five years probably has been *the* fastest growing, large industry. The value and growth of the hardware [13] portion alone is impressive. In January 1961 the value of general purpose digital computers, excluding special order computers for use in the military and space fields, was $1.8 billion; three years later the comparable figure had tripled to $5.3 billion.[14] A 1966 compilation showed 31,488 computers in operation in the United States, with unfilled orders for 21,181 more,[15] and it has been estimated that by 1975 there will be 85,000 computers in use, representing an investment of $30 billion.[16]

The software segment of the computer industry is increasing at an even greater rate. The 1964 software market has been estimated at $1.5 billion,[17] and indications are that this figure will be quadrupled by 1970.[18] In 1966 the industry required only 200,000 systems analysts and programmers, but the number necessary in 1970 will be much greater, estimates varying from 500,000 to 700,000.[19] At the present time there is a great need for more trained personnel, especially programmers, and as the above figures indicate, this shortage probably will continue for a long time. Compounding the problem is the impending change from "second generation" to the more advanced "third generation" computers.

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meant is that commercial value is relevant because of judges' evident feelings that what is valuable should somehow be protected.

[12] THOMAS, COMPUTERS 73 (1965). [13] *See* note 8 *supra*.

[14] BURCK, THE COMPUTER AGE 76 (1965).

[15] J. Banzhaf, *When a Computer Needs a Lawyer*, 71 DICK. L. REV. 240, 244 (1967).

[16] McCarthy, *Information*, 215 SCIENTIFIC AMERICAN 65, 67 (Sept. 1966). Approximately two thirds of the computers now in use are operated by businesses, and this proportion is increasing yearly. THOMAS, *supra* note 12, at 13.

[17] BURCK, *supra* note 14, at 98. [18] SIPPL, *supra* note 1, at 227.

[19] McCarthy, *supra* note 16, at 67, and BURCK, *supra* note 14, at 22.

This change will require reeducation of programmers, who will have to be trained not only differently but more extensively, since programming for the "third generation" is more difficult.

An immediate effect of this growing shortage is the increased use of "canned" programs for the new model computers.[20] *"Canned" programs* are programs prepared and distributed to users, usually on a rental basis, and their widespread use is possible because a large percentage of programs are usable by companies other than those for which they were designed, minor changes to adapt the program to the second company's bookkeeping system often being all that is necessary. Another major incentive for the use of canned programs is the great cost of developing programs. For instance, American Airlines SABRE system for virtually instantaneous reservations' information contains 1 million instructions,[21] and it is estimated that the average cost per instruction is $4 to $5.[22] Although SABRE is an unusually large program, even "medium-size" programs often contain over 10,000 instructions.[23] Because of the shortage of skilled programmers and the often enormous cost of developing programs, then, there is great incentive to have a system for protecting leased programs.

An analysis of the 134 programs filed with the Copyright Office as of January 1, 1968, shows, in fact, that members of the three major groups developing programs have availed themselves of whatever protection is afforded by copyright. These three groups are: hardware manufacturers who develop programs for distribution to those using their computers and who have registered about half of the 134 programs; computer users who are sufficiently large to develop programs they need and who have registered about one third of the pro-

[20] Sundeen, *General Purpose Software*, 14 DATAMATION 1 (Jan. 1968).
[21] BURCK, *supra* note 14, at 31.
[22] DESMONDE, *supra* note 1, at 141.
[23] SIPPL, *supra* note 1, at 228.

grams; and computer service companies which have registered approximately one sixth of the programs. This last group, numbering about 1,000 in the United States and Canada in 1965,[24] is in the business of developing programs for lease. They develop some programs on their own initiative and then try to market them, and others they develop at the request of computer users.

THE LACK OF MEANINGFUL PROTECTION OUTSIDE COPYRIGHT LAW

Programs are not meaningfully protected by any other area of the law, especially if the owner of a program attempts to lease it. The most likely alternative source of program protection might be thought to be the Patent Act,[25] but while England, Holland, Australia, and Japan issue patents for programs,[26] they are not presently available in the United States.[27] In March 1962 three Patent Office examiners specializing in data processing announced at a Federal Bar Association briefing conference that the Office's position was that programs were not patentable.[28] Two years later the Patent Office's Chief Counsel iterated this at a joint meeting of the Philadelphia and American Patent Law Associations,[29] and less than a week thereafter this policy was elaborated upon at the 1964 Spring Joint Computer Conference.[30]

The Patent Office justifies its position primarily in terms of the statute.[31] The Chief Counsel said that the Office was

[24] *Id.* at 229. [25] 35 U.S.C. § 1 (1964).

[26] Galbi, *The Unpatentability of Computer Programs*, in 1967 PATENT LAW ANNUAL 147, 153.

[27] Nor does the German patent office register computer programs. It considers them a "law of thought" and therefore not patentable. Nelson, *supra* note 5, at 210.

[28] McTiernan, *supra* note 5, at 6.

[29] Gonda, *Patents, Copyrights, Unfair Competition and Confidentiality of Information* (Panel), in LAW AND COMPUTERS IN THE MID-60's 218 (1966).

[30] Banzhaf, *supra* note 6, at 169. [31] *See* note 25 *supra.*

"standing on the statutory listing of what can be patented and they are a machine, an article of manufacture, a chemical composition, a physical, not a mathematical design, and specially bred plants. Nobody has convinced . . . [us] that a computer program is any of these." [32] It was noted by a commentator, however, that "process," which also is listed in the statute, was not mentioned by the Chief Counsel, and it was suggested that the real motive for denying programs patentability is a desire not to be thrown into an entirely new technical area in which there is a great deal of prior art, none of which is filed with the Office.[33]

The current Patent Office position has been formalized by the announcement of *Guidelines to Examination of Programs*,[34] which bases nonpatentability on the view that programs are mental processes analagous to mathematical formulae. The test set forth is whether the object submitted for patenting is an algorithm ("conclusions based upon a precise or mathematical premise and line of reasoning"),[35] in which case no patent can issue, or whether the object is a utility process ("useful things and substances"), for which a patent can be appropriate.[36]

[32] Gonda, *supra* note 29, at 218.

[33] *Id.* at 219. This reason was made explicit in *To Promote the Progress of the Useful Arts*, REPORT OF THE PRESIDENT'S COMMISSION ON THE PATENT SYSTEM 13 (1966): "The Patent Office now cannot examine applications for programs because of the lack of a classification technique and the requisite search files. Even if these were available, reliable searches would not be feasible or economic because of the tremendous volume of prior art being generated. Without this search, the patenting of programs would be tantamount to mere registration and the presumption of validity would be all but nonexistent."

[34] 829 OFFICIAL GAZETTE OF THE U.S. PAT. OFF. 1 (Aug. 2, 1966), announced June 30, 1966.

[35] Perhaps less confusingly, algorithms are the underlying mathematical premises, or logical underpinnings, of programs. Or as expressed by Nimtz, *The Supporting Disclosure*, in 1967 PATENT LAW ANNUAL 191, 192, the "term 'algorithm' means any self-consistent set of ordered steps specifying definable operations upon data and leading to a particular result. . . . An algorithm may be embodied in, and implemented by, a program, but the same algorithm can be embodied in, and implemented by, many different programs." *See* further Knuth, *What is an Algorithm*, 13 DATAMATION 30 (Oct. 1967).

[36] 829 OFFICIAL GAZETTE OF THE U.S. PAT. OFF. 1, 2 (Aug. 2, 1966).

Urgings that programs are patentable have, however, borne fruit.[37] On November 20, 1968, the U.S. Court of Customs and Patent Appeals upheld the Mobil Oil Company's appeal from the Patent Office's rejection of an application for a computer program patent.[38] In a decision by Judge Arthur Smith, the court held that the rejection was invalid because computer programs were a patentable item, notwithstanding the fact that the Patent Office would be put to a great deal of additional work in reviewing them. The Patent Office has strongly objected to this decision, and the Court of Customs and Patent Appeals has granted a request for a rehearing.[39]

Nevertheless, even if the Patent Office loses on the rehearing and on any subsequent appeals, it is doubtful that patents can be relied upon for protection of computer programs. Both the 1966 President's Commission on the Patent System and the Patent Reform Act of 1967 [40] specifically oppose the patentability of programs. Proposed section 106 of the Reform Act is entitled *Computer Programs not Patentable,* and says, "A plan of action or set of operating instructions, in whatever form presented, to cause a controllable data processer or computer to perform selected operations shall not be patentable." [41] It is important to note that this Reform Act is based on the Report of the President's Commission, which gave as a reason for urging nonpatentability the fact that "copyright protection for programs is presently available." [42]

While patent protection is, then, probably unobtainable for

[37] *See, e.g.,* Bender, *Computer Programs: Should They Be Patentable?* 68 COLUM. L. REV. 241 (1968) and the articles cited at n.3, 241; M. Jacobs, *Patent Protection of Computer Programs,* 47 J. PAT. OFF. SOC'Y 6 (1965); M. Jacobs, *Commission's Report (re: Computer Programs),* 49 J. PAT. OFF. SOC'Y 372 (1967); Nimtz, *Computers, Programs and the Patent Laws,* 11 IDEA 199 (1967); and Rackman, *The Patentability of Computer Programs,* 38 N.Y.U.L. REV. 891 (1963).

[38] In re *Prater and Wei,* 159 U.S.P.Q. 583 (1968).

[39] N.Y. Times, Jan. 17, 1969, 43:3.

[40] Transmitted to Congress by the President on Feb. 2, 1967 and introduced on that date in companion bills S. 1042 and H.R. 5924.

[41] 49 J. PAT. OFF. SOC'Y 170 (1967).

[42] President's Commission on the Patent System, *supra* note 33, at 13.

programs, other forms of legal protection are available, notably the trade secrets concept in the field of unfair competition. However, either the protection afforded is not commercially meaningful or the precautions necessary—and the actions which must be forgone—are so stringent that the remedy is in a practical sense unavailable. As the literature in this area is fairly complete,[43] let us note only briefly a few of the drawbacks of the trade secrets' protection as it applies to computer programs: contracts which restrict employee mobility and use of skills after switching employers are greatly disfavored by courts; even if a trade secret is appropriated in a clearly wrongful manner, a subsequent user in good faith and for value is protected and the trade secret is extinguished; [44] industrial espionage can effectively eliminate trade secrets; and leasing agreements must be drawn very restrictively and policed thoroughly at peril of losing the trade secret.

THE CURRENT REGISTRABILITY OF COMPUTER PROGRAMS

On May 19, 1964, the Copyright Office released Announcement SML-47, *Copyright Registration for Computer Programs,*[45] which set forth the standards a program must meet to be accepted for registration. The basic prerequisites for copyrightable works, such as authorship [46] and publication with notice,[47] were mentioned. The Announcement then went on to state that publication, to be sufficient, required that

[43] *See especially* Wessel, *Legal Protection of Computer Programs*, 43 HARV. BUS. REV. 97 (Mar.–Apr. 1965).

[44] *See* RESTATEMENT OF TORTS, §§ 757–58 (1939), especially § 758(b). A trade secret is also extinguished, even if the good faith user did not pay value, if he detrimentally relied.

[45] Reprinted at 11 BULL. COPYRIGHT SOC'Y 361 (1964) and 7 COMMUNICATIONS OF THE ACM 450 (1964).

[46] "The elements of assembling, selecting, arranging, editing, and literary expression that went into the compilation of the program [must be] sufficient to constitute original authorship." *Ibid.* See 17 U.S.C. § 4 (1964).

[47] *See* 17 U.S.C. § 10 (1964).

" 'copies' (i.e., reproductions of the program in a form perceptible *or capable of being made perceptible* to the human eye) bearing the notice have been distributed or made available to the public." [48] It is important to note here that the Copyright Office is allowing as "copies," *White-Smith Music Publishing Co. v. Apollo Co.*[49] notwithstanding, materials (such as magnetic tape) not perceptible to the human eye but requiring the use of a machine for interpretation.[50]

The Announcement set forth a registration requirement that

> the copies deposited for registration consist of or include reproductions in a language intelligible to human beings. If the only publication was in a form that cannot be perceived visually or read, something more (*e.g.*, a print-out of the entire program) would have to be deposited.[51]

This language is, however, somewhat unfortunate in that it suggests that a form of the program not perceptible to the human eye, *e.g.*, magnetic tape, would not be, by itself, a legally sufficient copy. Such is not, however, the case. As explained by Richard Glasgow, head of the Copyright Office's Examining Department,[52] the request that the filing include a form perceptible to the human eye is not a statutory requirement,[53] and is made for administrative convenience only. Without such a perceptible copy, the material submitted could not be verified as to notice, or indeed as to its even being a computer program. This point is also made specific by Barbara Ringer, Assistant Register of Copyrights for Examining, who explained the deposit requirement as being that the "copies deposited for registration, or some accompanying material, convey the content of the program in a form that

[48] *Supra* note 43 (emphasis added).

[49] 209 U.S. 1 (1908). This case will be discussed extensively *infra*.

[50] Letter to Banzhaf from Miss Barbara Ringer, Assistant Register of Copyrights for Examining, Apr. 23, 1964 (specifically mentioning magnetic and punched paper tapes). Banzhaf, *supra* note 6, at 145 n.112.

[51] *Supra* note 43. [52] *Supra* note 4.

[53] 17 U.S.C. § 13 (1964) requires deposit of "two complete copies of the best edition thereof then published."

makes it intelligible to human beings." [54] In fact, Copyright Office Circular 31D,[55] which restates the content of Announcement SML-47, is undergoing revision to eliminate any misunderstanding, since the Office was alerted to the Circular's ambiguity by an erroneous interpretation in a law review article.[56]

The Copyright Office has the authority to reject submitted material which it thinks is not copyrightable subject matter,[57] but it also is empowered to accept material the copyrightability of which it regards as doubtful. The Register of Copyrights, Abraham Kaminstein, explained the decision to accept computer programs and, specifically, to accept them in a nonhumanly perceptible form:

> This problem involves two fundamental legal questions: (1) whether a program as such is the "writing of an author" and thus copyrightable, and (2) whether a reproduction of the program in a form actually used to operate or be "read" by a machine is a "copy" that can be accepted for copyright registration. A good deal of research, discussion and correspondence went into finding answers to these questions. In April 1964, the Office decided that, although they are both doubtful questions, they should be resolved in favor of registration.[58]

As a result of this resolution, 134 programs have, as noted above,[59] been registered. A large majority of those registering are big corporations, probably because they have counsel who have had time to master the legal issues involved and

[54] Letter from Miss Ringer, *supra* note 48, at 145 n.111.

[55] Jan., 1965.

[56] *Supra* note 4. The offending statement is in Nelson, *supra* note 6, at 210: "The Copyright Office is not considering such [non-humanly perceptible] forms of a program as a writing."

[57] *See generally*, C. Berger, *Authority of the Register of Copyrights to Reject Applications for Registration*, 1 STUDIES ON COPYRIGHT 393 (1963) (page citations are to this book); also in SUBCOMM. ON PATENTS, TRADEMARKS & COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., STUDY NO. 18 (Comm. Print 1960).

[58] A. Kaminstein, *Copyright Developments*, 12 BULL. COPYRIGHT SOC'Y 3, 4 (1964).

[59] *Supra* note 4.

who can appreciate the probable scope of copyright protection. Bell Telephone Laboratories, Inc., for instance, has filed numerous programs, and each of the following large corporations has submitted more than one program: Burroughs Corporation, Douglas Aircraft Company, Inc., General Electric Company, Gulf Research and Development Company, and Westinghouse Electric Corporation. Other large companies which have registered programs are Bendix Corporation, Honeywell, Inc., North American Aviation Corporation (which was issued the first computer program copyright), and the Rand Corporation.

POSITION OF THE PROPOSED COPYRIGHT LAW REVISION [60]

Although this essay deals with the treatment of computer programs under the present Copyright Law, it is relevant to take notice of the disposition under current legislation of the problems with which we are dealing. Under the proposed Copyright Law Revision, computer programs would be copyrightable and protected in all their forms. In early drafts of the Revision, computer programs were expressly made copyrightable by a special clause,[61] but under the present formulation copyrightability would be granted by a more general provision, section 102:

> § 102. Subject matter of copyright: In general
>
> Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.[62]

The Committee's comments on this section are, *inter alia*, that

[60] COPYRIGHT LAW REVISION, *supra* note 9.
[61] B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 79 (1967).
[62] *Copyright Law Revision*, *supra* note 9, at 159.

. . . scientific discoveries and technological developments have made possible new forms of creative expression. . . . In some of these cases the new expressive forms—electronic music, filmstrips, and computer programs, for example—could be regarded as an extension of copyrightable subject matter Congress had already intended to protect, and were thus considered copyrightable from the outset without the need of new legislation. . . .

This broad language is intended to avoid the artificial and largely unjustifiable distinctions, derived from cases such as *White-Smith Publishing Co. v. Apollo Co.*, 209 U.S. 1 (1908), under which statutory copyrightability in certain cases has been made to depend upon the form or medium in which the work is fixed.[63]

All the forms of computer programs would be protected under the Revision because of sections 106(1) and 101 "copies": "§ 106. Exclusive rights in copyrighted works. . . . the owner of copyright under this title has the exclusive rights to do and to authorize any of the following: (1) to reproduce the copyrighted work in copies." [64] Section 101 defines "copies" as "material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device." [65]

THE NATURE OF A COMPUTER PROGRAM

The only remaining preliminary to a more detailed discussion of the legal problems involved in this topic is to delineate carefully the various forms programs take. Briefly, a program is the set of operating instructions fed into a computer. It consists of two elements, the instruction and the address. The former specifies what operation the computer is to perform, and the latter indicates the material on which the operation is to be performed. The computer's storage unit holds both the instruction material and the raw data on which it is

[63] *Id.* at 14–15. [64] *Id.* at 164–65. [65] *Id.* at 153.

to be performed. For instance, the instruction for addition might be in storage location 010, and the datum indicating x employee's pay to date during the calendar year might be in location 10111. The total phrase for indicating an addition of x employee's pay to date to another figure (not given here), such as that employee's current paycheck figure, would be 010 10111.[66]

There are five major forms a program takes in its passage from conception by the programmer to direct usability by the machine. The programmer must first develop an abstract, or outline, of the problem. This involves determining what processes and formulae are necessary to the solution of the problem and arranging them in an orderly fashion, minimizing redundant steps. The abstract is followed by the flow chart, which is a block diagram indicating the programmer's final solution to the problem. The flow chart is the schematic representation of the final program and indicates each step the computer must perform.

From the flow chart a source deck, the third stage, can be made by a process of almost mechanical conversion.[67] The programmer simply takes the schematized information on the flow chart and expresses it in terms of one of the many program languages, which are mnemonic systems of abbreviating instructions.[68] Typical abbreviations might be *HLT* for "halt," *STA* for "store in register *A*," *BR*+ for "branch if the register is plus," XZJ for "jump if index register is zero." The necessary mnemonic symbols are key punched on

[66] For more information on programs see the two sources cited in note 1 *supra*, and FLORES, COMPUTER DESIGN (1967), LEEDS & WEINBERG, COMPUTER PROGRAMMING FUNDAMENTALS (2d ed. 1966), and STARK, DIGITAL COMPUTER PROGRAMMING (1967). Each issue of the monthly COMMUNICATIONS OF THE ACM contains examples of both scientific and commercial programs.

[67] Both source and object card decks may be replaced by punched tape, but that is less usual.

[68] Some of the more widely used program languages are FORTRAN (FORmula TRANslation), COBOL (COmmon Business Oriented Language) and ALGOL (ALGOrithmic Language).

cards, which as a result have the printed symbols along the top margin and perforations expressing these symbols in the body of the card. The information in the source deck is, then, perceptible and conveys the substance of the program to a person familiar with the program language used.

The fourth stage is the object deck, which is obtained by a purely mechanical conversion from the source deck. The source deck is merely run through a machine programmed to convert the information into computer-usable form and to punch the information on cards. The object deck is not readable by a human in the sense that information concerning the program would be conveyed, both because the holes are very small and close together and because the conversion from the source deck to the computer language of the object deck is based on an arbitrary scheme which indicates the location in the storage unit of the instruction and the address.

The final form in the process of making the program usable by a machine is the magnetic tape, which is merely the information in the object deck transferred to a vastly more compressed form. Since information is recorded on the tape by magnetic discontinuities in the coating, and the degree of compression is five hundred or more bits of information per inch,[69] the information is visible only by microscope and even then undecipherable.[70]

The last major form in which a program can be expressed is a print-out. It is not usable by a machine, but can be obtained from a properly instructed computer by ordering it to divulge the program it is using. The information revealed is expressed in humanly intelligible alphanumerics printed on a long sheet of paper and is identical to the printing along the top margin of the source deck.

In conclusion, then, there are six forms a program can

[69] McCracken, Digital Computer Programming 150–52 (1957).

[70] Some computers use a disc or a drum instead of tape, but for purposes of simplicity I shall speak only of tape.

take: the five steps from the conception in the programmer's mind until the program is directly usable by the machine, and the print-out, which is not used by the machine. Of these six forms, two are unintelligible to humans: the object deck and the magnetic tape. The specific subject here is whether these two forms are themselves copyrightable and, if not, whether they are protected anyway by copyrighting the written, perceptible forms.

ARE OBJECT DECKS AND MAGNETIC TAPE COPYRIGHTABLE DIRECTLY?

CONSTITUTIONAL "WRITINGS"?

The first question to be answered is: Are nonperceptible program forms "writings" in the constitutional sense? [71] There is little doubt that they are. The best recent study of the "writings" clause concluded that "From a review of the actions of the colonial legislature, the Constitutional Convention, Congress, and the courts, it seems clear that the words 'writings . . .' will no longer limit the subject matter which can be copyrighted, at least insofar as the 'form' of the object is concerned." [72]

As to the evidence offered by congressional enactments and statements, *i.e.*, what Congresses have thought the constitutional clause meant, Walter Derenberg, the author of the study referred to, offers two hypotheses (which are perhaps functionally equivalent), either of which he thinks explains the

[71] Art. I, § 8, cl. 8: "Congress shall have Power . . . To promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

[72] W. Derenberg, *The Meaning of "Writings" in the Copyright Clause of the Constitution*, in 1 STUDIES ON COPYRIGHT 43, 108 (1963). Page citations are to this book. The article also appears in 31 N.Y.U.L. REV. 1263 (1956) and in SUBCOMM. ON PATENTS, TRADEMARKS & COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 1ST SESS., STUDY No. 3 (Comm. Print 1960).

congressional view. First, Congresses thought "the copyright clause reflects a desire to protect the commercial value of the productive effort of the individual's mind. From this evolves the plausible conclusion that the clause was intended to protect all intellectual property capable of extensive reproduction." [73] Alternatively, Derenberg considers a second principle to be consistent with congressional statements: "whatever may be construed as promoting science and the useful arts falls within the definition of 'writings.' " [74]

Derenberg also looked at all the reported cases dealing with the "writings" clause and concludes that

> The courts do not define writings as the form of particular subject matter but rather they determine if the subject matter meets certain standards or principles to which all objects, whatever their form, must conform if they are to be entitled to copyright protection. Writings, thus, are defined not in terms of concrete, tangible forms, but in terms of principles and standards.[75]

Another look at these cases yields the same conclusion. The first recorded instance of interpretation of the clause was the *Trade-Mark Cases*,[76] in which the Supreme Court said "writings" covered all "the fruits of intellectual labor," and subsequent cases have not deviated from this standard. Other copyright authorities concur with this view of what judicial construction has been.[77]

There are, however, two possible qualifications to this broad formulation of the scope of the "writings" clause: visibility and tangibility. Only the first is relevant here since nonperceptible computer program forms clearly are tangible.

The court in *Burrow-Giles Lithographic Co. v. Sarony*,[78] in the course of deciding that sufficiently creative photographs were constitutional "writings," said by way of dictum that

[73] *Id.* at 71–72. [74] *Id.* at 72. [75] *Id.* at 84.

[76] 100 U.S. 82, 94 (1879).

[77] For example, NIMMER, *supra* note 7, at § 8.2: "In general, it may be said that 'writings' include all tangible expressions of intellectual creation."

[78] 111 U.S. 53, 58 (1884) (emphasis added).

"By writings in that clause is meant the literary production of those authors, and Congress very properly has declared these to *include* all forms of writing, printing, engraving, etching, etc. by which the ideas in the mind of the author are given *visible* expression." One other case [79] has in dictum paraphrased this language and cited *Burrow-Giles*. It would be erroneous, however, to suppose that these two brief remarks establish a requirement that copyrightable material be visible.

First, the statement in question uses the word *include*, for which it is obviously not legitimate, as a matter of semantics, to read "consist exclusively of." Second, what is meant by the word *visible?* Probably the most common usage is "capable of being perceived by sight." Do object decks and magnetic tapes qualify? In their entirety they certainly are visible, and the material desired to be copyrighted also is visible. In the case of the object deck, the holes are visible without the aid of mechanical devices; magnetic tape dots are visible with magnification. It would be stretching *visible* too far to say that it meant "intelligible" in the sense of conveying information as to the meaning of the computer program. Additionally, magnetic tape may even be "intelligible" in that pushing a button on the computer console yields a print-out based on the tape. Alternatively, it is possible the court used *visible* as meaning "apparent," as in the phrase "no visible means of support." In this meaning, *visible* includes all the senses, not just sight. A third possibility is that the court meant *visible* in the sense of "concrete," thereby differentiating between works that had been given tangible form and works without tangibility, such as unrecorded, extemporaneous speeches. A final possible view of the court's meaning is that the reference "was made only to indicate that writings are not limited to verbal expression; not to suggest that writings necessarily require visible [in the sense of "intelligible to the eye"]

[79] American Mutoscope & Biograph Co. v. Edison Mfg. Co., 137 F. 262, 265 (D.C.N.J. 1905). This case too dealt with the copyrightability of photographs.

expression." [80] This interpretation seems particularly consonant with the question to be decided in *Burrow-Giles, viz.*, whether photographs are copyrightable.

The sum of all this is that for numerous reasons, the *Burrow-Giles* dictum quoted above does not mean that material such as magnetic tape (which does not without some modification convey the meaning of the copyrighted material contained therein) is excluded from "writings" in the constitutional sense. In any event, the question loses a great deal of its importance in light of *Capitol Records, Inc. v. Mercury Records Corp.*,[81] in which the court said "There can be no doubt that, under the Constitution, Congress could give to one who performs a public domain musical composition the exclusive right to make and vend phonograph records of that rendition." Judge Learned Hand in dissent agreed with the majority on this point: "I also believe that the performance or rendition of a 'musical composition' is a 'Writing' " in the constitutional sense "separate from, and additional to, the 'composition' itself." [82] In short, phonograph records, analogous in many respects to object decks and magnetic tape, are as a constitutional matter independently copyrightable. B. Kaplan [83] and Z. Chafee [84] have expressed agreement with this aspect of *Capital Records*.

It is worth noting at this point that many of the considerations relevant to object decks and particularly to computer magnetic tape are equally applicable to videotape, which also is a type of magnetic tape and which, unlike motion picture reels, is unintelligible until run through an appropriate ma-

[80] NIMMER, *supra* note 7, at § 8.2.

[81] 221 F.2d 657, 660 (2d Cir. 1955).

[82] *Id.* at 664.

[83] B. Kaplan, *Performer's Right and Copyright: The* Capitol Records *Case*, 69 HARV. L. REV. 409, 414 (1956): "The further possible objection . . . that a 'Writing' to be such must convey intelligence through the eye can surely not be accepted as a limit on Congressional power."

[84] Z. Chafee, *Reflections on the Law of Copyright: II*, 45 COLUM L. REV. 719, 736 (1945). Although this article was written before Capitol Records, in reference to extension of copyright to phonograph records the author stated that it "seems open for Congress to accomplish."

chine mechanism. The Copyright Office has also decided to accept videotapes for registration.[85]

STATUTORY "WRITINGS"?

Having determined that nonperceptible computer program forms are almost without doubt "writings" in the constitutional sense, it is next necessary to decide whether they qualify as statutory "writings" as mentioned in section 4 of the Copyright Act: "The works for which copyright may be secured under this title shall include all the writings of an author." It would seem that the correct approach to answering this problem would be to say, "Why not, since the same word in the constitutional clause included these computer forms?"

Judicial construction, however, has established that there is a difference in scope, although the extent is not determinable from the cases. Examples are *Mazer v. Stein*[86] and those cases, particularly *Capitol Records*,[87] which deal with the copyrightability of phonograph records. All these cases apparently rely on page 10 of H.R. Rep. No. 2222, 60th Cong., 2d Sess. (1909), which pertains to the bill adopted as the 1909 Copyright Act, to establish the distinction between the meaning of "writings" in the constitutional and statutory senses.

Mazer dealt with the copyrightability of a lamp-base design, and as part of the process of decision a review of the general coverage of the Copyright Law was made. The following passage occurs as dictum: "Some writers interpret this section [4] as being coextensive with the constitutional grant, but the House Report, *while inconclusive, indicates* that it was 'declaratory of existing law' only.[18] "[88] Footnote 18 reads, "H.R. Rep. No. 2222, 60th Cong., 2d Sess. 10. *The report is*

[85] *See generally*, B. Fritch, *Some Copyright Implications of Videotapes*, 37 So. Cal. L. Rev. 214 (1964), found also in ASCAP Copyright Law Symposium Number Thirteen 87 (1964); and W. Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U.L. Rev. 1081 (1955).

[86] 347 U.S. 201 (1954). [87] *Supra* note 79.

[88] *Supra* note 84, at 210 (emphasis added).

not very clear on this point, however." [89] The relevant portion of the House Report is:

> Section 4 is declaratory of existing law. It was suggested that the word "works" should be substituted for the word "writings," in view of the broad construction given by the courts to the word "writings," but it was thought better to use the word "writings," which is the word used in the Constitution. It is not intended by the use of this word to change in any way the construction which the courts have given it.

In short, not only did the court give no indication of where or to what extent the constitutional and statutory standards diverge, but it said twice, once in the text and once in a footnote, that it is even of doubtful correctness so to interpret the House Report.

The second group of cases, those dealing with the copyrightability of phonograph records, is less ambiguous. Judge Learned Hand in dictum in *RCA Mfg. Co. v. Whiteman* [90] assumed without discussion that records were not copyrightable, and in *Waring v. WDAS Broadcasting Station, Inc.*[91] both parties assumed the noncopyrightability of records. In *Capitol Records*, however, the issue was explicitly decided. The majority, written by District Judge Dimock, and the dissent, per Judge Learned Hand, agreed that records were not copyrightable, but disagreed on the reasons; since their disagreement is central to the statutory scope of "writings," it requires considerable discussion.

Judge Dimock's starting point is the unelaborated assumption that *White-Smith v. Apollo* [92] affects the direct copyrightability of records:

> It was determined that the music rolls were not "copies" of the musical composition within the copyright owner's exclusive right to make "copies" of the composition. From this it follows that it was not the intention of Congress that a virtuoso's rendition of a musical

[89] *Ibid.* (emphasis added).
[90] 114 F.2d 86, 89 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940).
[91] 327 Pa. 433, 194 A. 631 (1937). [92] *Supra* note 47.

composition in the public domain could be copyrighted under the unamended Act because it provided that "No person shall be entitled to a copyright unless he shall . . . deliver at the office of the Librarian of Congress . . . two copies" of the work of which the copyright was sought. . . . "Copies" were necessary to secure copyright and mechanical reproductions were not "copies." [93]

Having decided on the scope of *White-Smith v. Apollo*, Judge Dimock goes on to determine what section 1(e) [94] and the discussion of it in the House Report meant. He concludes—and this seems correct given his assumption—that section 1(e), by not overturning *White-Smith v. Apollo* but by merely giving the musical copyright holder certain royalty rights in the use by others of mechanical reproductions of his copyrighted work, evidenced a positive intention not to make the mechanical reproductions themselves directly copyrightable.

However, Judge Dimock's interpretation of *White-Smith v. Apollo* is wrong. In the passage quoted above he correctly states the holding of the case, but incorrectly assumes that certain things therefore follow. It by no means follows that because a mechanical reproduction of a musical composition is not a "copy" for infringement purposes that it is not a "copy" for registration purposes. There is no reason to as-

[93] Capitol Records, *supra* note 79, at 660.

[94] 17 U.S.C. § 1(e) (1964): "To perform the copyrighted work publicly for profit if it be a musical composition; and for the purpose of public performance for profit, and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced. . . . 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. . . . In case of failure of such manufacturer to pay . . . the full sum of royalties due . . . the court may, in its discretion, enter judgment therein for any sum in addition over the amount found to be due as royalty in accordance with the terms of this title, not exceeding three times such amount."

sume that the word has the same meaning in both parts of the statute. As Chafee has noted, "Remember that we are not dealing with the old question of the *Pianola* case—can a record infringe? We are asking—can you infringe a record." [95]

A careful study of *White-Smith v. Apollo* shows that the court did not deal with the second question, but only the first, *viz.*, whether a record infringes a copyrighted musical composition. The main basis of the court's decision was that a record was not a "copy" of sheet music because, simply enough, it embodied the same idea but not the same form, and the court considered similarity of form an essential attribute of a "copy": "What is meant by a copy? We have already referred to the common understanding of it as a reproduction or duplicate of a thing." [96] The court also quoted with approval the following definition: "A copy is a thing which comes so near to the original as to give every person seeing it the idea created by the original." [97] Additionally, the court said, "it is apparent that Congress has dealt with the concrete and not with an abstract right of property in ideas or mental conceptions." [98] In short, a record was not a copy of sheet music.

It is not difficult, however, to see how the case was misinterpreted by Judge Dimock. The problem is that the *White-Smith v. Apollo* court sometimes says it is discussing the question whether piano rolls are "within the copyright act," and only on close reading does it become clear that they mean "infringing copies within the copyright act." The following passage is illustrative:

> The decisions so far brought to our attention . . . have been uniformly to the effect that these perforated rolls . . . for the production of music are not within the copyright act. It was so held in *Kennedy v. McTammany*, 33 Fed. Rep. 584 [C.C.Mass. 1888]. . . . In that case the learned judge said: "I cannot convince myself that these perforated sheets of paper are *copies of sheet music* within the meaning of the copyright law." [99]

[95] Chafee, *supra* note 82, at 734.
[96] White-Smith v. Apollo, *supra* note 47, at 17.
[97] *Ibid.*
[98] *Id.* at 17.
[99] *Id.* at 13 (emphasis added).

Reference to the *Kennedy* case makes it clear, however, that only the question of whether piano rolls are infringing copies is dealt with; there is no ambiguous language, like that in *White-Smith v. Apollo*, which could be interpreted as dealing also, even if only in dictum, with the question of whether piano rolls are independently copyrightable. The only question in *Kennedy* was whether "Cradle's Empty, Baby's Gone," plaintiff's copyrighted composition, was infringed.

The *White-Smith v. Apollo* court also relied on two other cases, a reading of both of which shows that, as with the *Kennedy* case, there is no language indicating that the court was considering the question of whether mechanical reproductions are directly copyrightable. The two cases involved are *Stern v. Rosey* [100] (which considered whether defendant's wax phonograph cylinders infringed plaintiff's songs "Take Back Your Gold" and "Whisper your Mother's Name") and *Boosey v. Whight*,[101] which dealt with infringement by piano roll. Referring specifically to these cases as supporting its holding, the court said, "Since these cases were decided, Congress has repeatedly had occasion to amend the law," [102] and its inaction therefore justifies this decision. This is a clear indication that the scope of *White-Smith v. Apollo* and the scope of these other cases is coextensive.

In short, *White-Smith v. Apollo* is a case regarding infringement and is not a discussion of what constitutes a "writing" in the statutory or constitutional sense. Judge Learned Hand in dissent in *Capitol Records* impliedly adopts this view. While agreeing that records are not copyrightable, he does not agree with the majority's ground. Citing to the section of Chafee's article noted above,[103] he says that section 1(e) compels the conclusion that records are not copyrightable because if they were, the penalty for infringement would conflict with the statutory remedy set out in section 1(e). And

[100] 17 App. D.C. 562 (D.C. Cir. 1901).
[101] [1899] 1 Ch. 836; [1900] 1 Ch. 122.
[102] White-Smith v. Apollo, *supra* note 47, at 14.
[103] *Supra* note 93. Cited in Capitol Records, *supra* note 79, at 665.

while Judge Dimock thought *White-Smith v. Apollo* meant that records could not be directly copyrightable, and saw this view in the House Report's commentary also, Judge Learned Hand does not: "I cannot find in the language of the report anything even to intimate that the record of a performer of a 'musical composition' should not be copyrighted; for, if copyrighted, such records would be themselves the 'works,' not infringements of another 'work': i.e. the score." [104]

So after this extended but necessary excursion, we are back to the question of the extent to which the constitutional and statutory meanings of "*writings*" diverge. *Mazer v. Stein* is, as has been seen, no help because it merely indicates that there probably is, somewhere, a divergence; and the phonograph record cases apply only to records since they are based on section 1(e) and the House Report commenting on it. One possible view is that section 4 "writings" refers only to those things enumerated in section 5, but this possibility is expressly negatived in section 5 itself, which says "The above specifications shall not be held to limit the subject matter of copyright as defined in section 4." And the House Report relied on by *Mazer* and *Capitol Records* says "section 5 refers solely to a classification made for the convenience of the copyright office." [105]

As is often the case in the copyright field, probably the best answer is one supplied by Judge Learned Hand. His suggestion is that the constitutional and statutory meanings are coextensive except where the statute itself contains contrary language, as it does for records.[106] In fact, as a District Court judge, Learned Hand held that the constitutional and statutory grants were the same.[107] He evidently thought at

[104] Capitol Records, *supra* note 79, at 665.

[105] Quoted in NIMMER, *supra* note 7, at § 12.2.

[106] Capitol Records, *supra* note 79, at 665. NIMMER, *supra* note 7, at § 12.2 considers this the "proper construction."

[107] Reiss v. National Quotation Bureau, Inc., 276 F. 717, 718 (S.D.N.Y. 1921).

the time of *Capitol Records* that this was still the correct view unless Congress indicated otherwise in specific cases.

In short, then, the preferable view probably is that since Congress has nowhere indicated that unintelligible computer programs are not included within the statutory coverage, they are included since they were contained within the constitutional grant. The available cases which deal with subjects analogous to these forms of computer programs support this view. The two chief characteristics of nonperceptible program forms, especially the tape form, are the invisibility (to the naked eye) of the magnetic dots and the unintelligibility of the program. There appear to be no cases dealing with this first characteristic, but there is no reason to assume that the factor of visibility would have a different effect under the statutory than the constitutional grant.

There are, however, cases dealing with unintelligible subject matter, and the uniform result has been the decision that they are statutory writings. Three cases dealing with books of telegraph codes expressed in letters of the alphabet all held that the books were copyrightable. The first, *Reiss v. National Quotation Bureau*,[108] decided by Judge Learned Hand, dealt with a code book containing artificial groupings of letters. Purchasers of the book would, by agreement between sender and receiver, assign meanings to these artificial groupings so that telegraph messages could be kept secret. Despite the fact that the material involved was, therefore, unintelligible by itself, the court held that it was both a statutory and a constitutional writing. Two cases which followed, *American Code Co., Inc. v. Bensinger* [109] and *Hartfield v. Peterson* [110] were both concerned with telegraph code books which assigned meanings to artificial letter groupings, the meanings being either sentences or, sometimes, whole messages. The purpose was to make messages shorter and also secret, at least to the

[108] *Ibid.* [109] 282 F. 829 (2d Cir. 1922).
[110] 91 F.2d 998 (2d Cir. 1937).

extent that the person trying to read the message did not have access to the code book. Despite the unintelligibility of these letter groupings to a person who did not have a code book, both cases decided that the books were copyrightable.

Cases have also held nonalphabetic symbols copyrightable. *Edwards & Deutsch Lithographing Co. v. Boorman* [111] held that an interest and discount table composed of words, figures, and symbols was copyrightable. *Guthrie v. Curlett* [112] dealt with a consolidated freight-tariff index which was in such a compressed form that many symbols and different kinds of type were needed, these symbols and type faces being explained in a key. The court focused on the novel aspects of plaintiff's index, which it decided were the arrangement and the various symbols and concluded that they were enough to warrant copyright.[113] Judge Learned Hand, too, thought symbols other than alphabetic characters were copyrightable. In *Reiss v. National Quotation Bur.*, discussed above, he gave the following illustration:

> Mathematics has its symbols, indeed a language of its own, Peanese,[114] understood by only a few people in the world. Suppose a mathematician were to devise a new set of compressed and more abstract symbols, and left them for some conventional meaning to be filled in.[115]

Judge Hand thought that this nonalphabetic symbolism would not warrant a denial of copyright. In further discussion in the same case, Judge Hand offered the following observations:

> Works of plastic art need not be pictorial. They may be merely patterns, or designs, and yet they are within the statute. A pattern or an ornamental design depicts nothing; it merely pleases the eye.

[111] 15 F.2d 35 (7th Cir. 1926). [112] 36 F.2d 694 (2d Cir. 1929).

[113] *Id.* at 698.

[114] *Peanese*, developed by Italian professor Giuseppe Peano, has neither words nor alphabetic characters, but is a form of highly compressed notation based on principles of symbolic logic. For an example of Peanese writing *see* Lewis and Langford, *History of Symbolic Logic*, in 3 THE WORLD OF MATHEMATICS 1859, 1872 (Newman ed. 1956).

[115] *Supra* note 105, at 718.

If such models or paintings are "writings," I can see no reason why words should not be such because they communicate nothing. They may have their uses for all that, aesthetic or practical.[116]

Another case concerning subject matter analogous to nonintelligible computer-program forms, and particularly magnetic tape, is *Weir v. Gordon*,[117] which upheld copyright on an advertisement the central feature of which was dots which when connected made a picture. Other instances of copyrights being issued on subject matter using symbols other than alphabetic characters are, of course, musical notation and Laban notation. The latter, which expresses very accurately motions in choreographic works, is understood by only a very limited group of persons.[118]

In summation, there is little reason to expect that unintelligible program forms will be denied copyrightability as falling outside statutory "writings."

THE MACHINE PART OBJECTION

While we have determined that unintelligible computer programs almost certainly are constitutional "writings," and that there is little likelihood they would be held not to be statutory "writings," there is one further possible objection which must be considered before one concludes that these forms are directly copyrightable. Both *Taylor Instrument Co. v. Fawley-Brost Co.*[119] and *Brown Instrument Co. v. Warner* [120] denied copyrightability to a machine part, and it must be determined whether these cases control the situation before us. It is concluded that there is little doubt that they are *not* apposite.

[116] *Id.* at 718–19. [117] 216 F.2d 509 (6th Cir. 1954).

[118] *Re* choreographic works generally, *see* B. Varmer, *Copyright in Choreographic Works*, 1 STUDIES ON COPYRIGHT 103 (1963), also found in SUBCOMM. ON PATENTS, TRADEMARKS & COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG. 2D SESS., STUDY No. 28 (Comm. Print 1961). *See also* KAPLAN & BROWN, CASES ON COPYRIGHT 238–40 (1960).

[119] 139 F.2d 98 (7th Cir.), *cert. denied*, 321 U.S. 758 (1943).

[120] 161 F.2d 910 (D.C. Cir.), *cert. denied*, 332 U.S. 801 (1947).

The issue in *Taylor Instrument* and *Brown Instrument* was the copyrightability of charts which were blank except for lines of calibration and which were parts of recording machines, a stylus in the machine recording the information onto the charts. The chart in *Taylor Instrument* had only temperature recorded onto it, while the one in *Brown Instrument* received information, ascertained by the machine, about temperature, air pressure, and other meteorological factors.

The decisions in these two cases were based primarily on *Baker v. Selden*,[121] which was an action for alleged infringement of a book describing a bookkeeping system and also for infringement of accompanying blanks, which comprised the essence of the system. The court said:

> The use of the art is a totally different thing from a publication of the book explaining it. The copyright of a book on book-keeping cannot secure the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book. . . . It was not patented, and is open and free to the use of the public.[122]

Basing itself on this case, the *Brown Instrument* court said of the forms in *Baker v. Selden* and the forms before it, "Neither sort of forms is intended to communicate facts or ideas. Both sorts are intended solely for use in making records of facts." [123] In short, the blank, calibrated charts in *Brown Instrument* were not copyrightable because "their object is for use as parts of the plaintiff's machine and not for the purpose of giving information." [124]

But whereas the material under discussion in the two recording instrument cases was used solely for the purpose of having information written on it by the machine, computer programs which direct the machine are obviously quite different; they convey instructions to the machine. The blank charts in the recording instrument cases are analogous to a ruled sheet on which can be written the answers to calculations per-

[121] 101 U.S. 99 (1879). [122] *Id.* at 104.
[123] Brown Instrument, *supra* note 118, at 911. [124] *Id.* at 910.

formed by a human operator of a desk calculator; the computer program is analogous to a detailed set of instructions the operator might be given. A Copyright Office regulation further emphasizes the common nature of the forms in *Baker v. Selden* and the recording instrument cases, but does not include computer programs: "The following are examples of works not subject to copyright. . . . (c) Works designed for recording information which do not in themselves convey information." [125]

The second major ground on which *Taylor Instrument* and *Brown Instrument* were decided also is inapplicable to any of the forms of computer programs. This ground is that the copyright claimant's real goal was an extension of patent-like protection on his machine. The court in *Taylor Instrument* took note of defendant's introduction into evidence of twenty-five patented recording charts similar to plaintiff's and concluded that plaintiff "now seeks protection in the copyright field for an article long protected in the field of patents" and "which clearly belongs exclusively in the patent field." [126] The *Brown Instrument* court noted a similar purpose of the plaintiff:

> In several patents on recording machines, the necessary printed chart is rightly claimed as one of the operative elements. Since the machines which cooperate with the charts in suit are useless without them, to copyright the charts would in effect continue appellant's monopoly of its machines beyond the time authorized by the patent law.[127]

Copyrighting a computer program, on the other hand, would not in any way extend the patent life of the computer in which it is used. The only thing protected by a program copyright would be the means of expressing the program's underlying algorithm(s). To be analogous to the recording instrument cases, the magnetic tape itself would have to be the

[125] 37 C.F.R. § 202.1 (1959).
[126] Taylor Instrument, *supra* note 117, at 100–1.
[127] Brown Instrument, *supra* note 118, at 911.

thing for which protection was sought. Unlike a temperature-recording instrument for which protection of the blank chart will, in practical effect, also protect the entire machine, a computer program protects the computer no more than a movie—which is clearly copyrightable—protects the movie projector.[128]

In *Brown Instrument* there is one dictum which, taken in isolation, is troublesome:

> Articles intended for practical use in cooperation with a machine are not copyrightable. *White-Smith v. Apollo* [citation]. Both law and policy forbid monopolizing a machine except within the comparatively narrow limits of the patent system.[129]

The first sentence could not mean what it says, however, and must be read in light of the facts of the case. To read it literally would, for instance, exclude movies from copyright, since they are intended for use with a machine. The second sentence of the quotation indicates the proper scope of the first sentence, *viz.*, only when the matter sought to be copyrighted effectively extends the patent life of a machine will the recording instrument cases be dispositive.[130]

EFFECT OF COPYRIGHT OFFICE REGISTRATION

Statements made by Copyright Office personnel indicate that they regard nonperceptible computer-program forms as being directly copyrightable, but that this position involves "doubtful questions." [131] It would seem, in short, that this is not a situation in which the following Copyright Office statement would apply: "We register material which we feel a

[128] G. Cary, *Copyright Registration and Computer Programs*, 11 BULL. COPYRIGHT SOC'Y 362, 366 (1964).

[129] Brown Instrument, *supra* note 118, at 911.

[130] *See* also the quotation in the text at note 122 *supra*, in which the court shows that it views a machine part as something which cannot convey information. It seems clear that this meaning was also intended in the quotation in the text at note 127 *supra*.

[131] *See* the statement of Abraham Kaminstein, Register of Copyrights, at note 56 *supra*. *See also* G. Cary, Deputy Register of Copyrights, *supra* note 128, at 363.

court *might* reasonably hold to be copyrightable, even though, personally, we feel that it is not subject to copyright." [132] Nevertheless, in deciding whether nonperceptible forms of computer programs are directly copyrightable, it is unlikely that courts would accord the Copyright Office's acceptance for registration as being of more than marginal weight.[133]

Section 209 of the Copyright Act provides for the issuance to a registrant by the Copyright Office of a certificate of registration, which "shall be admitted in any court as prima facie evidence of the facts stated therein." Although these facts are merely the same ones provided to the Copyright Office upon the filing of a registration [134] and involve such things as the registrant's name and address, the title of the work, the class in which it is to be registered, *etc.*,[135] a large number of cases have decided that the certificate is also prima facie evidence of the validity of the copyright.[136] However, a review of these cases discloses none which involved the question whether the subject matter in question was constitutionally or statutorily copyrightable; the cases usually involved questions of originality or location of title. In any event, these cases seem quite hard to defend, and courts have not mentioned section 209 when declaring uncopyrightable material registered by the Copyright Office.[137]

Supreme Court cases have accorded Copyright Office deter-

[132] Library of Congress, Department & Divisional Manual No. 7, *Copyright Office* 38 (1950), quoted in KAPLAN & BROWN, *supra* note 116, at 156.

[133] *See*, however, NIMMER, *supra* note 7 at § 95.1, "The courts will generally treat with great weight the actual practices of the Copyright Office."

[134] *See generally*, KAPLAN & BROWN, *supra* note 116, at 155–56.

[135] 17 U.S.C. § 209 (1964).

[136] *See* cases noted in B. Kaplan, *The Registration of Copyright*, 1 STUDIES ON COPYRIGHT 325, 355 (1963), also found in SUBCOMM. ON PATENTS, TRADEMARKS & COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., STUDY No. 17 (Comm. Print 1960). Kaplan's listing is not complete. *See, e.g.*, Gerlach-Barklow Co. v. Morris Bendien, 23 F.2d. 159, 161 (2d Cir. 1927), and National Institute, Inc. v. Nutt, 28 F.2d 132, 133 (D. Conn. 1928). The most recent case in this line appears to be Wihtol v. Wells, 231 F.2d 550, 553 (7th Cir. 1956).

[137] *See*, to take a recently discussed case, Taylor Instrument, *supra* note 117. *See also* cases noted in C. Berger, *supra* note 57, at 399 n.15.

minations the force generally given administrative bodies' decisions,[138] but in light of the statements by Copyright Office personnel that while they consider nonperceptible computer-program forms copyrightable, the issue involves "doubtful questions," it would be unreasonable for courts to give the Copyright Office's decision on nonperceptible program forms the same weight given an administrative decision that such forms definitely were, in the Office's opinion, copyrightable. The most appropriate disposition would seem to be close to the one set forth in *De Sylva v. Ballentine*,[139] in which the court said:

> Although we would ordinarily give weight to the interpretation of an ambiguous statute by the agency charged with its administration. . . . we think the Copyright Office's explanation of its practice deprives the practice of any force as an interpretation of the statute and we therefore do not rely on it in this instance.

In short, while the acceptance of nonperceptible program forms for registration will be accorded some small weight, for the most part whether they are a proper subject matter for copyright will be decided on the merits. As indicated above, it seems that on the merits by far the most likely conclusion is that they are copyrightable.

IF NONPERCEPTIBLE PROGRAM FORMS ARE NOT DIRECTLY COPYRIGHTABLE WOULD THEY NEVERTHELESS BE AN INFRINGEMENT OF COPYRIGHTABLE, PERCEPTIBLE FORMS?

MUST PERCEPTIBLE COPIES BE MADE IN ORDER TO USE NONPERCEPTIBLE FORMS?

Computer programs might not be effectively protected by copyright if only written, perceptible forms, and not nonper-

[138] *See, e.g.*, Fred Fisher Music Co., Inc. v. M. Witmark & Sons, 318 U.S. 643, 657–58 (1943), and Mazer v. Stein, *supra* note 84 at 211–14.

[139] 351 U.S. 570, 577–78 (1956).

ceptible forms, were copyrightable because the making of a nonperceptible copy from a perceptible copy arguably is not, under present case law, an infringement. For the purposes of this entire section on infringement, it is assumed *arguendo* that nonperceptible program forms are *not* copyrightable, although as established above, this is almost certainly not the case. The purpose is to see whether independent copyrighting of nonperceptible forms is necessary for their adequate copyright protection.

Before examining the issue of infringement, however, let us see whether it would be practically possible for someone who obtained a nonperceptible copy [140] to utilize it fully without making a perceptible copy, which would infringe the registrant's copyright. Unless this is possible, there is no need for nonperceptible computer-program forms to be copyrightable, since access to the nonperceptible form alone would not be sufficient to allow a competitor to use the program. In fact, access to the nonperceptible form alone *is* sufficient to allow a competitor to use the program without creating an infringing copy.

A competitor cannot merely insert the magnetic tape into his own computer and begin grinding away; he would have to know exactly what the program does and what steps it takes to do it. Otherwise, he would be unable to have it act upon his raw data, since the data would not be at the correct addresses. Additionally, unless his computer were exactly the same type as registrant's, at least marginal changes would have to be made in the tape. While such changes could be made without creating a perceptible copy, since the computer could be instructed to make changes directly onto the tape (or more likely, in the memory unit into which the program could have been transferred without creating a perceptible copy), the competitor would not know what changes to make without seeing a perceptible copy.

[140] *See* text at note 41 *supra.*

An infringing perceptible copy need not be made, however. An employee of the competitor need only go to the Copyright Office and inspect the perceptible copy which must have been filed there for registration to have been made. Additionally, this employee could, if need be, hand-copy certain relevant parts, although probably not all, of the perceptible copy, since this would be fair use.[141] There would be no legal impediments to such a course because it is well-established that only the mode of expression of copyrighted material, and not its underlying idea, is protected.[142] Once it is known exactly what the program is, it is possible to use the nonperceptible form inside the computer without infringing the copyright by creating a perceptible copy.

An interesting question, and one not answered by case law, is: If the putative competitor I have been discussing were too lazy to go to the Copyright Office to see a perceptible program, would it be within the doctrine of fair use for him to have his computer make a print-out of what was on the magnetic tape? [143] One argument would be that this would be fair use because it is clear that copyright does not protect ideas, and, since a perceptible copy has to be seen to ascertain the ideas in the program, it cannot be an infringement to make such a copy. Still another argument that this would be fair use is similar to a claim that it would not be an infringement to make a single machine photocopy of a copyrighted book for personal use. In support of such a position, it has been said that "anyone may copy copyrighted material for the purposes of private study and review." [144] Similarly, it

[141] KAPLAN & BROWN, *supra* note 118, at 314.

[142] *See generally* NIMMER, supra note 7, at § 145.

[143] For a suggestion that the Revision Bill make this explicitly possible see letter of May 8, 1965 from Graham McGowan, General Counsel, Electronic Industries Association. *Hearings Before Subcommittee No. 3 of the House Committee on the Judiciary*, 89th Cong., 1st Sess., ser. 8, pt. 3, at 1898 (1966).

[144] S. Cohen, *Fair Use in the Law of Copyright*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER SIX 43, 58 (1955).

has also been said that "private use is completely outside the scope and intent of restriction by copyright." [145]

This conclusion is, although possible, unlikely to be upheld. A central tenet of fair use is that "a use which supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." [146] It is clear that making a perceptible machine copy would be a diminution, although of only a single customer, of the potential market for the copyrighted, perceptible program.

SECTION 1(A) COPY?: *White-Smith v. Apollo* [147]

In *White-Smith v. Apollo* the question was whether a piano roll which in conjunction with a player piano produced in sound the melody of plaintiff's copyrighted musical composition was an infringing "copy." The court decided it was not, saying that the question was one of statutory construction and that the proper definition of *copy* did not encompass piano rolls because a copy is "a reproduction or duplicate of a thing . . . which comes so near to the original as to give every person seeing it the idea created by the original." [148] In short, a piano roll could not be a "copy" of sheet music because they were not the same "thing" and because a piano roll does not bring to mind the musical notation of sheet music. The court also said, in reference to musical compositions, that a copy thereof would have to be "in intelligible notation" and "a copy which appeals to the eye." [149] If *White-Smith v. Apollo* were regarded as a good decision and a court were to expand its scope of application only a small amount,

[145] R. Shaw, *Publication and Distribution of Scientific Literature*, 17 COLLEGE & RESEARCH LIBRARIES 294, 301 (1956), quoted in Latham, *Fair Use of Copyrighted Works*, 2 STUDIES ON COPYRIGHT 781, 789–90 (1963), also found in SUBCOMM. ON PATENTS, TRADEMARKS & COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., STUDY No. 14 (Comm. Print 1960).

[146] COPYRIGHT LAW REVISION, *supra* note 9, at 35. [147] *Supra* note 47.

[148] *Id.* at 17. See also the quotation at note 96 *supra*.

[149] *Id.*

nonperceptible program forms easily could be held not to be an infringement of perceptible forms. And, in fact, although as noted below there are many grounds on which to distinguish a nonperceptible computer program form from a piano roll, many courts might not find these distinctions substantial.

One appealingly easy solution to this problem is to say that *White-Smith v. Apollo* should be overruled. For instance, Justice Holmes's remarks in a special concurring opinion seem accurate: "The result is to give to copyright less scope than its rational significance and the ground on which it is granted seem to me to demand." [150] The House Committee on the Judiciary's recent reference to "the artificial and largely unjustifiable distinctions" [151] emanating from *White-Smith v. Apollo* seem even closer to current thinking regarding the case. Further, some of the spirit of the case has been violated by recent practice of the Copyright Office. Besides accepting nonperceptible program forms for direct copyrightability, it has also been accepting video tapes, which are equally nonperceptible.[152] While *White-Smith v. Apollo* did not deal with the question of whether a piano roll was directly copyrightable,[153] some have erroneously interpreted it that way,[154] and if the Copyright Office were desirous of extending the scope of the opinion it could deny copyrightability to visually unintelligible objects.

Despite dissatisfaction with the opinion, however, it probably would be illegitimate to overrule it summarily. For one thing, it is an old standard for decisions in the copyright field, cited often by courts—although its irrational scope, as noted by Justice Holmes,[155] is often remarked upon. But, of most importance, Congress has done nothing to overrule the broad implications of the case although it has, in section 1(e), made special provision for mechanical reproductions of

[150] *Id.* at 18–19. [151] *Supra* note 61. [152] *See* text at note 83 *supra.*
[153] *See* text at note 93 *supra.* [154] *See* text at note 90 *supra.*
[155] *Supra* note 148.

musical copyrights.[156] It would in short seem illegitimate, after sixty years in which Congress could have changed *White-Smith v. Apollo*, to remove that court's distinctions regarding copies and for the judiciary itself to decide that the statute was, after all, wrongly interpreted. This view is given greater weight by the fact that Congress now has before it a copyright revision bill which would abolish the *White-Smith v. Apollo* distinction.[157]

There are, however, many relevant distinctions between the piano rolls in *White-Smith v. Apollo* and computer programs. One obvious but probably not very satisfactory distinction is that the case dealt only with the infringement of musical compositions. To confine the case to musical compositions, however, would be close to confining it to its facts. Support for such a position could, though, be found in various quotations from the case, such as:

> Various definitions have been given by the experts called in the case. The one which most commends itself to our judgment is perhaps as clear as can be made, and defines *a copy of a musical composition* to be "a written or printed record of it in intelligible notation." It may be true that a mechanical instrument which reproduces *a tune* copies it; but this is a strained and artificial meaning.[158]

Further, speaking of a musical composition, the court stated, "It is not susceptible of being copied until it has been put in a form which others can see and read." [159] The court also relied upon three prior cases, all of which involved musical compositions.[160]

The main problem which arises in interpreting the case to apply only to music and not to all other copyrightable works —of which the main category probably is books—is that this does not make sense functionally. Music, much more than books, is intended to be used nonvisually, and it would be

[156] *See* text at note 92 *supra*. [157] *See* text at note 61 *supra*.
[158] *Supra* note 47, at 17 (emphasis added).
[159] *Ibid*. [160] *See* text at note 97 *supra*.

strange to say that music is protected only in a written form but that books, for instance, are protectable in both written and nonvisual forms.

If it does not seem reasonable, however, to say that nonmusical copyrightable works in general should be protected in nonvisual forms, while musical works should not, it does make sense to say that nonperceptible computer forms should be protected even if nonvisual forms of musical works are not. There are numerous reasons for such a distinction. For one, to deny nonperceptible computer forms protection is to deny any practical protection to any form of computer program (assuming *arguendo* as we do throughout this section that nonperceptible computer forms are not directly copyrightable), while *White-Smith v. Apollo* only reduced, but did not eliminate, the value of a copyright on a musical composition. Another relevant distinction between computer programs and musical compositions is that the running of a mechanical, nonperceptible form of the latter, a phonograph record for instance, does not and cannot yield the original, copyrighted form, but produces merely sound. A nonperceptible computer form, however, can be converted to a perceptible print-out by the push of a button. In short, since the computer upon which the programs are used can almost immediately upon demand produce a perceptible form, nonperceptible forms are in a sense less nonperceptible, and distinguishing between perceptible and nonperceptible forms of computer programs is correspondingly less meaningful. One final distinction can be made. While it might on some ground be reasonable to distinguish between musical compositions in forms which appeal to the eye and in forms which appeal to the ear, there is no such distinction in regard to computer programs, the sole purpose of which is to work in conjunction with a machine.

In summation, a court would not have to strain to distinguish *White-Smith v. Apollo* so that it would not apply to

computer programs, and it probably should so decide. It would not be surprising, however, to find that a court would, because of the sheer age of the case, give some of its statements wider scope than they deserve.

SECTION 1(B): TRANSLATION OR OTHER VERSION?

Section 1(b) declares it to be an infringement "to translate the copyrighted work into other languages or dialects or make any other version thereof, if it be a literary work." Since "literary work" is not confined to belles-lettres, but applies to any written work,[161] it seems clear that a conversion from a source deck to an object deck would be the making of a "version." This literal reading, however, is not supported by case law. The most prevalent view is that section 1(b) is superfluous because any "version" is also a "copy." Nimmer says no reported case has been based on a claim that an alleged infringement was a "version" without its also being alleged that it was a "copy" and, further, that no reported case has decided that an infringing work was a "version" without also deciding that it was a "copy." [162]

The main case interpreting section 1(b), *Corcoran v. Montgomery Ward*,[163] seems to support this view. In that case plaintiff charged that a record of a musical version of his doggerel verse "Plain Bull" was infringing as both a copy and a version. The court held that it was neither. It was not a "copy" because of *White-Smith v. Apollo* and it was not a "version" for what appears to be the same reason: "Something new would be imported into the law if appellant's position were to have judicial approval." [164] The court's unspoken

[161] *See* NIMMER, *supra* note 7, at § 107.1; and H. HOWELL, COPYRIGHT LAW 134 (3d ed. Latman 1962).

[162] *See* NIMMER, §§ 105.2, 109.3. *See also* HOUSE COMM. ON THE JUDICIARY, REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 22, 87TH CONG., 1ST SESS. (Comm. Print 1961).

[163] 121 F.2d 572 (9th Cir.), *cert. denied*, 314 U.S. 687 (1941).

[164] *Id.* at 573.

premise seems to be that *White-Smith v. Apollo*'s restrictions on section 1(a) apply equally to section 1(b), although the only reason it gives for its decision regarding section 1(b) is that H.R. 2222 [165] said the subsection was "consistent with the existing law as construed by the courts."

There is, however, a recent case—*Addison-Wesley Publishing Co. v. Brown* [166]—which offers a hint that courts might begin to view section 1(b) more expansively. Further, some of the court's language is relevant to computer programs. The case involved a claim that a solution book to plaintiff's text book infringed the latter, and one of plaintiff's related claims was that defendant had changed verbal statements in the text book into mathematical notation which expressed the same thing and that this was a section 1(b) "version." The court viewed this claim favorably:

> Neither party has, however, been able to furnish authorities which directly, or even by close inference, support or require rejection of the construction plaintiffs would assign to . . . [§ 1(b)]. Were this issue presented for determination as res integra the Court would be constrained to hold in the context of our dawning space age that each science as it moves into new areas of research and discovery must needs invent its own Esperanto. Plaintiff's argument . . . would, in such event, persuade.[167]

The court decided, however, to find for the plaintiff upon unfair competition grounds.

Perhaps the most that can be said, then, is that section 1(b), if read literally, definitely would cover the making of a nonperceptible copy from a perceptible copy of a computer program. While the limitations of section 1(a) are currently applied to the subsection by the few cases involved, it would be very easy for a court which disapproved of the illogic of *White-Smith v. Apollo*'s distinction to use section 1(b) to evade it. The court could say that the subsection must be

[165] *See* text at note 85 *supra*. [166] 223 F. Supp. 219 (S.D.N.Y. 1963).
[167] *Id.* at 226.

given meaning beyond section 1(a), since the drafters obviously intended it to mean something. So to interpret section 1(b) would be a big step beyond its current use, but since only very few cases have interpreted it, it would not be difficult to take a fresh look. If the section were needed, there seems little reason for declining to give it the scope its language clearly suggests.

SECTION ON 1(c): RECORD, TRANSCRIPTION, OR REPRODUCTION?

Section 1(c) declares it to be an infringement "to make . . . any transcription or record thereof by or from which . . . it may in any manner or by any method be exhibited, delivered, presented, produced, or reproduced." Unlike section 1(b), the language of which seemed squarely to cover computer programs, the language of section 1(c) does not seem to be broad enough. While it might be stretched far enough if the history of the section were in doubt, it becomes clear upon investigation that the section was intended to pertain only to public performance of works. The Register of Copyrights says the section covers "in addition to sound recordings . . . the making of any form of visual record, such as a stenographic transcription or a motion picture of a performance." [168] The scope is well-summarized by Lawlor:

> The proscription against making a transcription or record is in the same language as that of section 1(d) which . . . was intended merely to prevent stenographers from recording what they heard at performances of unpublished works to enable someone else to make a performance. . . . The committee report recommending that section 1(c) be amended to refer to transcriptions and records makes it clear that only the making of sound records was intended. The report says: . . . "This extension is limited to public performing rights." [169]

[168] *Supra* note 160, at 23.

[169] Lawlor, *Copyright Aspects of Computer Usage*, 7 COMMUNICATIONS OF THE ACM 10 (1964).

A fair summation is that while the language of section 1(c) taken alone might support inclusion of computer programs, the history of the section shows unambiguously that it was not within the scope intended by the drafters.

In conclusion, nonperceptible computer program forms probably should be held to infringe copyrighted perceptible forms because of sections 1(a) and (b), but it would not be surprising to find that a court reached the opposite conclusion. Even if a court found there was not an infringement, however, we have seen that computer programs in nonperceptible forms are currently being accepted for registration, and the discussion above shows that they are almost without doubt constitutional "writings" and almost certainly are statutory "writings." Thus, assuming that computer programs in general are copyrightable, their polymorphous nature will not interfere with their protection under the present Copyright Act.

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The Standard Author Contract: A Survey of Current Draftsmanship

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As managing editor of Little, Brown and Company, Charles Everitt, wrote to me:

> Regarding the [standard author contract] form itself, this is a starting point which is continuously under scrutiny and the pressure of compromise in some areas, and never changed in other areas, and so as a document standing alone it is really not of much significance without being intimately aware of the background to the negotiations for each individual author and book.[1]

Since I cannot hope to be intimately aware of individual negotiations, I confine myself to what is "really not of much significance." Quite possibly this insignificance is compounded, because I am concerned with not "a document standing alone" but rather some two dozen documents standing together.

Formalism in author contracts is often a matter of fill in-the-blanks or multiple-choice clauses. Within this flexible framework, however, there are negotiated terms which rarely vary in the extreme. I examined about two dozen standard contracts currently in use by the more active houses in New York City to compare the ways in which certain basic clauses are drafted. The various consequences, incident to alterations

[1] Letter from Charles S. Everitt, Aug. 2, 1968.

in draftsmanship, are explored, and, where useful, a number of model clauses are proposed.

Author contracts, drafted as they are by the publisher, generally protect the interests of the house. This emphasis can appear rigid when the contracts are read in blank form before terms are negotiated. Other sources, therefore, must be consulted in order to present the author's viewpoint. I rely chiefly upon the standard contract proposed by the Society of Authors' Representatives, Inc., and a series of articles published in the Authors Guild Bulletin from May, 1963, to July, 1966.

THE GRANT CLAUSE

The grant clause limits the uses a publisher can make of the work, unless the author grants the *work itself*—in which case the publisher becomes the sole owner of all rights in the work. The author, as owner of the manuscript and common-law copyright proprietor, may either sell outright or license the various uses of his work. To a large extent, the scope of the grant's language renders unnecessary the subsequent specification of many subsidiary rights—subsumed under the grant itself. The grant clause is the legal key which unlocks the aggregate of rights a publisher can exercise.

The Authors Guild cautions authors never to grant the *work itself*.[2] Such a grant can operate to transfer complete ownership, that is, the exercise of all rights in the work rather than specifically enumerated rights, which could have been individually licensed. Thus if the author not only grants "sole and exclusive *rights in the work*" but "*conveys title* to the work" or "grants to the publisher *a work*," then he has transferred the full aggregate of rights in the work. Thereafter specific enumeration of rights—if it be deemed necessary—

[2] Authors Guild Bull. 13 (Oct.–Nov. 1963).

need only be prefaced by an explanation that the grant "*includes but is not limited to* the following rights."

At the opposite extreme from the transfer of ownership lies the grant clause proposed by the Society of Authors' Representatives:

> The Author hereby grants and assigns to the Publisher the exclusive right to publish in the English language in book form in the United States of America, its territories and possessions, in the Philippine Islands, and in Canada, a Work. . . . All other territory (except the British Commonwealth and Empire as politically constituted at the date of this agreement) shall be a non-exclusive territory for the sale of English language copies of the Work published hereinunder in the United States.[3]

Similarly the Authors Guild offers a grant which includes the Society's limitations upon form of publication and market area and adds a fixed period of time for exploitation:

> [The author] [g]rant[s] the publisher the sole and exclusive right to print, publish, copy, and sell the work in book form in the United States of America (and territories under its jurisdiction), Canada, and the Republic of the Philippines, during the original term of the United States copyright.[4]

The Guild stresses four limitations upon the grant, namely, that it be for publication:

1. *in book form only*—thereby reserving exploitation in other media for the author's express disposition
2. *in the English language*—thereby reserving publication in a foreign-language edition for the author's express disposition
3. *in the domestic market*—thereby reserving rights in the open market (all countries other than the United States, its possessions, the Philippine Republic, and Canada) for the author's express disposition

[3] Cl. 1 ("The Grant and the Territory"); *accord*, AUTHORS GUILD BULL., *supra* note 2, at 9.
[4] *Id.*

4. *within a fixed time period*—that is, only the first twenty-eight-year term of the original United States copyright, thereby reserving the renewal term of twenty-eight years for the author's express disposition.[5]

These four limitations—form, language, market, and time—suggest the scope of the rights which a grant clause may or may not convey, depending upon its specificity or its incorporation of future clauses by reference.

As a matter of trade practice, standard author contracts approach the requirements of the Authors Guild in varying degrees. Of the contracts I surveyed, none included all four of the Guild's limitations. The period of exploitation, for instance, was never fixed at twenty-eight years; instead, the publisher was granted the original term of copyright plus the renewal term.[6] On the other hand, however, no contract offended the Guild's basic warning against granting the publisher *a work* as opposed to *rights in a work*.

The scope of rights which a grant clause generally encompasses is fairly represented by the Grove Press contract:

1. AUTHOR'S GRANT: The Author hereby grants to the Publisher, its successors and assigns, during the full term of copyright and all renewals and extensions thereof:

(a) Exclusive license to print, publish and sell the Work in book form in the English language

(i) throughout the world.

(ii) in the United States of America, the Philippine Islands, and Canada, and to sell the same non-exclusively for export to all other countries other than the British Commonwealth and Empire, except Canada.

[5] *See, id.* at 9–10.

[6] *See, e.g.*, Ballantine Books contract, cl. 1 ("Grant of Rights"); Bantam Books contract, cl. 2; Bobbs-Merrill contract, cl. 1 ("Grant of Rights and Territory"); Doubleday contract, cl. 1(a) ("Rights Granted"); E.P. Dutton contract, cl. 2(a) ("Proprietor's Grant"); Grove Press contract, cl. 1 ("Author's Grant"); Harper & Row contract, cl. 1 ("Author's Grant"); Hill & Wang contract, cl. I.(A); J.B. Lippincott contract, cl. Second; Pergamon Press (single-author) contract, cl. 2; Random House contract, cl. 1 ("Grant of Rights"); World Publishing contract, cl. 1 ("Grant and Territory").

According to trade practice, this clause authorizes the publisher to exercise its rights for a period longer than that which the Authors Guild recommends. The reference to "book form" in 1(a) is not an unqualified limitation—as the Guild might wish—since it must be read in reference to a subsequent subsection included within the basic grant:

> (c) Exclusive right to publish and to license the Work for publication, prior to or after book publication, within the territory set forth in this Paragraph in anthologies, selections, digests, abridgements, magazine condensations, novelization of screenplays, serialization, newspaper syndication, picture book versions, and microfilming.

This subsection lists traditional "subsidiary rights," which are often saved for an independent clause—sometimes incorporated by reference in the basic grant.[7] Another traditional subsidiary right appears in subsection (d), which gives Grove Press the "exclusive right to license the Work for publication throughout the world in all foreign languages." This grant, if not deleted during negotiations, will modify the requirement in 1(a) that the publication be "in the English language."

Grove Press accommodates the potential scope of its market area through the use of multiple-choice clauses. Subsections 1(a) (i) and (ii) provide for the negotiated alternatives of unlimited exclusivity [1(a) (i)] or just "domestic market" exclusivity joined with "open market" nonexclusivity [1(a) (ii)]. If subsection 1(a) (i) is elected by the parties, then the difference between open market rights and domestic market rights becomes irrelevant. Under 1(a) (i) the publisher's rights are not subject to geographical limits or competition.

If subsection 1(a) (ii) is elected, then Grove Press must operate within defined markets. The domestic market in trade usage generally includes that area specified in 1(a) (ii), namely, the United States of America, the Philippine Islands,

[7] *See* text *infra* at p. 140.

and Canada. Although no contract surveyed detracts from the domestic market, some contracts add, for example, Mexico,[8] or the "dependencies" of the United States[9] or its "territories and possessions."[10] Regardless of the geographical area, however, the right granted, that is, exclusive publication and sale, remains uniform.

All areas not included within the domestic market belong to the open market—with the general exception of the British Commonwealth of Nations.[11] Slight variations consist of either including the "Free State of Ireland"[12] or excluding it along with the Republic of South Africa.[13] Whatever countries are specified, the publisher's rights therein are always nonexclusive and, hence, in potential competition with other licenses. "The [Authors] Guild considers it desirable to have this 'open market' right clearly spelled out, separately from the basic grant of publishing rights in the domestic area."[14]

In drafting flexible form contracts, careful attention must be paid to the sensitive balance between the grant clause and the subsidiary-rights clause. The scope of the former usually defines that of the latter: where the grant is silent, the subsidiary should speak; where the grant speaks, the subsidiary may echo in order to amplify terms. Perhaps, the neatest and most negotiable form of grant is a short and simple one, which unobtrusively incorporates subsidiary rights by reference. Such a clause might read:

> The Author hereby grants to the Publisher, its subsidiaries, affiliates and assigns, the exclusive right to publish and sell the Work in book form, in the English language, in the United States of America, the Philippine Islands, and Canada, during the full term of copy-

[8] Hill & Wang contract, *supra* note 6.

[9] Ballantine Books contract, *supra* note 6, at cl. 1(a); Bantam Books (reprint) contract, cl. 1 ("Reprint publication License"); E.P. Dutton contract, *supra* note 6.

[10] J.B. Lippincott contract, *supra* note 6.

[11] *See*, text *infra* at pp. 146–49.

[12] Bantam Books (reprint) contract, *supra* note 9.

[13] Houghton Mifflin contract, cl. 15.

[14] AUTHORS GUILD BULL., *supra* note 2, at 9.

right and all renewals and extensions thereof, and including the rights specified in Paragraph ——.

Confronted initially by such a clause, the author or his agent, is not intimidated by an endless giveaway; he may be presented with the services to be rendered by the publisher, before more detailed subsidiary rights are disclosed.

It should be noted that the limitations in my proposed clause—for example, "in book form," "in the English language"—necessitate the subsequent grant of certain subsidiary rights—for example, audio-visual reproduction and foreign-language rights. On the contrary, less restrictive terms in Bobbs-Merrill "Grant of Rights and Territory" reads:

The Author hereby grants to the Publisher and its successors, representatives and assigns . . . the exclusive right and the right to grant others the right to print, publish and sell the Work during the full term of copyright and all renewals thereof throughout the world and in all languages.

Phrases like "throughout the world" and "in all languages" obviate the need for subsidiary British rights and rights of translation. The Bobbs-Merrill draftsman chose, nonetheless, to include "translation and foreign language book publication" in a catalogue of subsidiary rights, which follows in the grant clause. When he came to the "Other [subsidiary] Rights" clause, however, his task was greatly simplified by the language he had used in the grant. The "Other Rights" clause reads in relevant part:

The net proceeds received from the disposition of the subsidiary right listed below shall be divided between the Author and Publisher as follows:

	Author	Publisher
(1) Translation and foreign language book publication	%	%
(2) Publication in the English language outside the United States	%	%

The legal effect of general language in the grant allows for statistical simplicity in the subsidiary-rights clause. In the fol-

lowing discussion on subsidiary rights, I frequently refer back to grant clauses like that in the Bobbs-Merrill contract, as well as the clause I proposed above.

SUBSIDIARY RIGHTS

THE AUTHOR'S VIEWPOINT

The question of who shall control the disposition of subsidiary rights has created some disagreement between author and publisher. All the contracts I have surveyed are drafted so as to convey the vast bulk of control to the publisher. The Authors Guild, however, is adamant in its demand for greater author control. In the area of subsidiary rights connected with the publishing industry—for example, book-club distribution, paperbacks, anthologies, sets, syndication, second serialization, and foreign-language publication—the Guild advocates written consent by the author, before the publisher can exercise any rights which have been granted.[15] The Guild's position finds substantial expression in the form contract proposed by the Society of Authors' Representatives

> The Publisher shall submit to the Author for his approval (such approval not to be unreasonably withheld) the terms of any proposed license for book club distribution, cheap edition publication, or post-publication periodical rights. . . .
>
> The Publisher may permit others to reprint selections from the Work in text books, or anthologies.[16]

The only other subsidiary rights granted in the Society's contract relate to special publication for the physically handicapped,[17] the use of short extracts,[18] and commercial use of the work upon the author's express permission.[19]

The Authors Guild further protests the granting of so-called

[15] *Id.* at 10, 11.
[16] Cl. 7 ("Advances, Royalties and Share of Proceeds; Examination of Account"); cl. 9 ("Permission to Reprint").
[17] Cl. 7(k). [18] Cl. 9. [19] *Id.*

"nonpublishing" subsidiary rights—for example, adaptations for radio, television, motion pictures, recordings, the theater, and other commercial uses—*under any conditions*. "None of these rights, big or little, should be granted to the publisher; nor should he share in the income from them." [20] In its "Reserved Rights" clause, the Society's contract reinforces the Guild:

All rights in the Work now existing, or which may hereafter come into existence, not specifically herein granted, are reserved to the Author for his use at any time. Reserved publication rights include, but are not limited to, the right to publish or cause to be published in any form, excerpts, summaries, and novelizations or dramatizations and motion pictures of the Work, thereof, not to exceed seventy-five hundred (7500) words in length, to be used for advertising and exploitation of motion pictures and televised motion pictures or dramatizations based upon the Work.[21]

The broad first sentence of the clause, especially in the context of those few subsidiary rights previously granted, retains in the author the majority of control over exploitation. The realities of trade practice present a far different picture.

DRAFTING THE CLAUSE

It will be remembered that the draftsman must seek to strike a flexible balance between the scope of the grant and that of the subsidiary-rights clause. A number of contracts surveyed avoid any problem by simply enumerating all subsidiary rights within the grant itself, for example:

The Author hereby grants the Publisher the sole and exclusive right to print, publish and market the Work in book form in the English language in the United States of America, its territories and possessions, the Dominion of Canada, the Philippine Islands and elsewhere throughout the world during the whole term of United States copyright and renewal thereof, and to license its publication in book form, and also grants to the Publisher the sole and exclusive au-

[20] AUTHORS GUILD BULL., *supra* note 2, at 11.

[21] Cl. 15. For a general discussion of rights reserved to the author, *see* text, *infra* at pp. 159–61.

thority to dispose of the following rights: First and Second Serialization, Selection, Translation, Digest, Subscription, Dramatization and/or Presentation on the Speaking Stage, Motion Picture (sight and/or sound), Radio Broadcasting, Television, and the right to make and/or cause or permit the making and use of Microfilms, of Mechanical Voice Renditions and/or Voice Recordings of the text of the Work or any part thereof, in visualized or sound form, singly or in combination, or partly in each.[22]

The same legal effect can be achieved with greater clarity and order if the subsidiary rights are first categorized—for example, according to so-called "publishing" and "nonpublishing" rights—and then grouped in separately numbered clauses within the grant.[23] This latter method, of course, acts as a focus upon the nature and extent of individual rights which, otherwise, tend to merge in a list of catchwords.

The grant clause which I propose[24] incorporates subsequent subsidiary rights by reference. This form is favored by many publishers.[25] In the Bantam Books contract, for instance, "the Seller [*i.e.*, author] further grants to the Publisher . . . such other rights hereinafter provided for in this agreement."[26] The subsidiary-rights clause drafted by Bantam contains broad granting language, as well as a royalty scale:

The Publisher is further granted the exclusive right to sell or license the use of the Work by others as a basis for other media use or for publication in whole or in part, in any form, or in a foreign language, anywhere in the world upon such terms as it deems advisable. The net proceeds of such sales or licenses shall be

[22] J.B. Lippincott contract, *supra* note 6; *see also*, Bobbs-Merrill, *supra* note 6; Pergamon Press contract, *supra* note 6.

[23] *See, e.g.*, Grove Press contract, *supra* note 6; Horizon Press contract, cl. I ("Rights Granted"); Random House contract, *supra* at note 6.

[24] *See* text supra at p. 140.

[25] *See, e.g.*, Ballantine Books contract, *supra* note 6, at cl. 1(a); E.P. Dutton contract, *supra* note 6, at cl. 2(c); Harper & Row contract, *supra* note 6, at cl. 1; Hill & Wang contract, *supra* note 6; Houghton Mifflin contract, cl. 1; Viking Press contract, cl. 1 ("Delivery of manuscript Publication rights granted"); World Publishing contract, *supra* note 6.

[26] Bantam Books, contract, *supra* note 6.

paid (less the amount of any advances then unearned) at the time of the next accounting as follows: [27]

	Publisher's Share	Seller's Share
Hard cover trade book publication by a U.S. publisher	50%	50%
Book Clubs	50%	50%
British and Continental Rights (in English)	50%	50%
Newspaper or Magazine Serialization, Excerpts, Digests, Condensations, and Misc.	50%	50%
Television, Radio, Sight and Sound and allied rights, Visual Reproduction	50%	50%
Motion Picture and Dramatic	25%	75%
Translation into foreign languages	25%	75%

The sweeping grant in the first sentence affords the publisher plenary power to be exercised *as it deems advisable.* As is the trade practice, the author retains no right of either consent or approval. All the clause affords him is a brief description of the rights he conveys along with a convenient indication of the royalties he may expect.

The Holt, Rinehart & Winston contract also uses the incorporation-by-reference approach. The "supplementary rights" referred to in the grant [28] are contained in an agency clause: "The Author hereby appoints the Publisher his duly authorized Agent and attorney-in-fact to negotiate and sell the following rights in the Work." [29] This clause is followed by listed subsidiary rights, each with its corresponding royalty scale.

One further drafting device is available in order to accomplish the grant's incorporation. The grant may refer to a specific paragraph or paragraphs, which contains separate clauses, each granting the publisher independent subsidiary rights. The Doubleday contract has a series of subsidiary

[27] *Id.* at cl. 6.
[28] Holt, Rinehart & Winston contract, cl. 2 ("Rights Granted; Territory").
[29] *Id.* at cl. 15 ("Agency Clause").

rights, individually stated in clauses 6 through 17. Clause 14, for instance, reads:

> Author grants to Publisher the sole and exclusive right to sell radio and/or television rights, throughout the world, in and to and in connection with said work. Publisher shall pay to Author ninety per cent (90%) of the proceeds of such sale.

This amounts legally to a grant clause. It is a neatly self-contained conveyance, which may be negotiated, if necessary, apart from any other clause. The opening words clearly alert the author that he is giving away something, while the closing words inform him what his grant may be worth.

Of the various ways of drafting subsidiary-rights clauses, that used in the Doubleday contract is preferable. It provides the most information and, perhaps, the easiest negotiation. The grant clause I propose [30] facilitates this form of draftsmanship. Let us examine how each subsidiary clause may be drafted.

BRITISH RIGHTS

The Authors Guild finds it unreasonable to grant the publisher rights in the British market:

> Many authors prefer to establish direct relationships with British publishers, or to ask their agents to handle this right, and they have . . . [the British-rights clause] in the printed contracts of their American publishers deleted. If this important right is left in the American publisher's hands, it should be made clear that the author's consent is required in arranging publication overseas; that the publisher is acting as an intermediary.[31]

As unreasonable as it may seem to the Guild, the trade practice appears uniform: *all* contracts I surveyed grant British rights; *none* requires the author's consent.

Not all form contracts provide for British publication in a separate subsidiary-rights clause. The "Proprietor's Grant"

[30] *See* text *supra* at p. 140.
[31] AUTHORS GUILD BULL., *supra* note 2, at 11.

in the E.P. Dutton contract, for instance, moves beyond the domestic market to accommodate the publisher's "exclusive right to arrange for the publication of the . . . work in book form in the British Empire and Commonwealth . . . and/or to export copies to these territories and countries." [32] Even where the grant does not explicitly define British rights, they may be subsumed under more general language covering rights *throughout the world* and in all languages.[33] The grant clause I propose, however, limits exploitation to the domestic market; [34] therefore, British rights must be expressed in another clause.

A reading of current subsidiary clauses reveals variations in the way British rights are exercised. While one publisher may be granted unqualified exclusive rights,[35] another is limited to sublicensing the exercise of these rights to any publisher other than himself.[36] There is an important difference between these two approaches: under the first the American publisher can sell copies of his own edition—that is, the original, hard-cover, trade edition or the unbound sheets alone or a new, less expensive edition; under the second approach, however, the American publisher is apparently limited to authorizing another publisher—presumably, but not necessarily, British—to bring out an independent edition for sale in the Commonwealth.

Both alternatives should be drafted into the subsidiary clause if the publisher is to have mobility in the exercise of his British rights. Such a clause might read:

The Author shall receive —— percent of the net proceeds on the publication and sale of the Work, in the English language, in the British Commonwealth of Nations, exclusive of Canada, either

[32] E.P. Dutton contract, *supra* note 6.
[33] *See* text *supra* at p. 141.
[34] *See* text *supra* at p. 140.
[35] *See, e.g.*, Hill & Wang contract, *supra* note 6, at cl. IX(A) (13) (a) and (b).
[36] *See, e.g.*, Ballantine Books contract, *supra* note 6, at cl. 13 ("Publication in the British Empire").

through manufacture and publication under another imprint or through sale of sheets or bound books of the Publisher's edition, which rights the Author grants to the Publisher.

In reality three options are open under this clause:

1. The publisher may license another house—domestic, British, or foreign—to publish an independent edition.
2. The publisher, itself, may bring out a separate edition through one of its own subsidiaries. This is so because publication under only *another* imprint—not necessarily an *independent* imprint—is required; and, furthermore, my proposed grant clause,[37] which incorporates the present clause by reference, conveys rights to the publisher "its subsidiaries, affiliates and assigns."
3. The publisher may sell its American trade-edition as is or in a less expensive format composed from the unbound sheets.

I deliberately refrain from requiring the American publisher to license publication of only a *hard-cover* edition by an *independent* British house; none of the contracts surveyed contains such a term—although the Authors Guild favors it to insure a competitive market for the work in the Commonwealth.[38]

British rights may be quite valuable to the American author. If he lacks the bargaining leverage by which to retain these rights, he may, nevertheless, be in a strong enough position to demand a reasonable time limit upon the publisher's sole option. The Random House contract includes such a limitation within the basic grant:

> The Author grants to the Publisher during the term of copyright, including renewals and extensions thereof: . . .
>
> Exclusive right to license in the English language throughout the British Commonwealth (other than Canada), the Republic of South

[37] *See* text *supra* at p. 140.

[38] AUTHORS GUILD BULL., *supra* note 6, at 11.

Africa, and the Irish Republic, the rights granted in subdivision a. above, *revocable* by the Author *with respect to any country* for which no *license or option* has been given within eighteen (18) months after first publication in the United States.[39]

It should be noted that this contract is the only one of all those surveyed which contains such a limitation. Furthermore, the power reserved in the author is a narrow one. British rights will not revert to him automatically as they might under a true reverter clause; instead he must exercise his power of revocation; and this must be done for *each* country where *neither* a license *nor* an option has been granted within the prescribed period.

TRANSLATION AND FOREIGN RIGHTS

My grant clause authorizes publication in English only and in the domestic market alone.[40] If the work is to be translated or distributed in English outside the domestic and British-rights markets, there must be an express subsidiary clause. Of course, if the grant were effective *throughout the world and in all languages*,[41] there would be no need for further specification.

One other possible provision in the grant will affect the scope of foreign rights. Some grants—although not the one I suggest—expressly define the "open market," for example:

It is further understood that the territories other than the United States of America, its Dependencies, the Philippine Islands, the Dominion of Canada, and the British Empire and Commonwealth, shall be an open market for copies of the American and English editions.[42]

The effect upon foreign rights, of course, is that they can no longer be granted on an *exclusive* basis, since the open market, unlike the domestic one, is competitive. Since my proposed grant contains no reference to the open market, foreign

[39] Random House contract, *supra* note 6, at cl. 1(b) (emphasis added).
[40] *See* text *supra* at p. 140. [41] *See, e.g.*, Bobbs-Merrill contract, *supra* note 6.
[42] E.P. Dutton contract, *supra* note 6, at cl. 2(b).

rights can still be granted exclusively to the American publisher.[43]

The subsidiary clause might read:

> The Author shall receive —— percent of the net proceeds on the sale or exercise of the exclusive rights of translation into, and publication in, languages other than English, throughout the world, and the Author shall receive —— percent of the net proceeds on the exclusive publication and sale of the Work, in the English language, in countries other than the United States of America, the Philippine Islands, Canada, and the British Commonwealth of Nations, either through manufacture and publication under another imprint, or through sale of sheets or bound books of the Publisher's edition, all of which rights the Author grants to the Publisher.

The result will be much the same as within the British Commonwealth under the British-rights clause.[44] Essentially the publisher, its subsidiary, or licensee can exercise the rights of translation and foreign publication on an exclusive basis. Since the translation right is not limited to a fixed market area, a foreign language edition can be published within the domestic market.

It should be noted, as it was under British rights,[45] that a reverter clause may be appended to the above clause. Only Random House, of all the contracts surveyed, limits the time in which the publisher can exercise translation rights—not, however, foreign rights in general. The period is three years from the first United States publication, and the author must exercise his power of revocation "with respect to each language or country for which no license or option has been given." [46] This three-year period is less generous than the two years considered reasonable by the Authors Guild.[47]

[43] *Accord*, Hill & Wang contract, *supra* note 6, at cl. I(A); cl. IX(A)(13)(c).

[44] *See* text *supra* at p. 147–48. [45] *Id.* at p. 148.

[46] Random House contract, *supra* note 6, at cl. 1(c).

[47] AUTHORS GUILD BULL., *supra* note 2, at 11.

SUBSIDIARY "PUBLISHING" RIGHTS

First Serialization. I have already had occasion to distinguish generally between so-called "publishing" and "nonpublishing" subsidiary rights.[48] Within the first category, first-serial rights are of increasing value as more national periodicals seek to publish soon-to-be-released trade editions. The contracts surveyed reveal that first-serial rights generally authorize (1) the publisher or his sublicensee (2) to publish the work—in full as a serial or in a condensed version of two or more installments (3) in magazines or newspapers (4) *before* the first trade edition comes out.

Since first serialization entails publication in *other than book form,* the grant clause I propose [49] does not convey the requisite authority, and an express subsidiary clause is necessary. The Authors Guild advocates retention of first-serial rights by the author.[50] Of the contracts surveyed only one leaves the rights to the author:

> On the sale of the first serial rights for publication of the work before publication in book form, which rights shall remain the property of the Author, the Publisher shall receive per cent of the net proceeds of such sale. The Author shall not sell the work for publication in one part before book publication *without prior consent of the Publisher,* which consent shall not be withheld if such publication in one part does not entail more than 25,000 words of the work and *if the purchaser of the first serial rights agrees* to publish with this condensation *a notice stating clearly* that said condensation is less than the whole work *to be published by the Publisher.*[51]

Thus the author's property is subject to distinct, though not unreasonable encumbrances. The publisher's power to consent and make demands of the purchaser simply insure that first serialization will not detract from but will add to the economic impact of the trade edition.

[48] *See* text *supra* at pp. 142–43. [49] *See* text *supra* at p. 140.

[50] AUTHORS GUILD BULL., *supra* note 2, at 11.

[51] Ballantine Books contract, *supra* note 6, at cl. 11 ("First Serial Rights") (emphasis added).

Since the timing, extent, and quality of first serialization can have such a large bearing upon the success of the trade edition, the publisher should seek control of the right. The E.P. Dutton contract [52] provides:

> The Publishers shall have the exclusive right, in the territories covered by this agreement, to arrange in its own name on behalf of the Proprietor and/or Publishers for the sale of the other rights listed below, and if such rights are sold, the net proceeds shall be divided between the Proprietor and the Publisher as specified:
>
> | Rights | % to Proprietor | % to Publishers |
> |---|---|---|
> | First Serial . . . | | |

One key phrase in this clause is "in the territories covered by this agreement." The reference is to the "Proprietor's Grant," which covers: (1) exclusive rights in the domestic market; (2) exclusive British rights in the British Empire and Commonwealth; and (3) nonexclusive rights in the open market, for both American and English editions. Therefore, E.P. Dutton acquires, in effect, exclusive first-serial rights throughout the world.

The "territories covered" phrase again indicates how close a balance must be struck between the grant and subsidiary clauses. Since my grant limits book publication to the domestic market, with no reference whatsoever to the open market,[53] special language is necessary in the subsidiary clause, for example:

> The Author shall receive per cent of the net proceeds from the sale *throughout the world* of the exclusive rights to publish or license others to publish the Work in whole or in part, in magazines and/or newspapers, in one or more installments, or in a condensed or abridged version in one part, prior to or simultaneous with book publication, which rights the Author grants to the Publisher.

Since the reference is to sale throughout the world, foreign-language first serialization is impliedly included.

Second Serialization and Other Post-Publication Rights.

[52] E.P. Dutton contract, *supra* note 6, at cl. 8(b) ("Other Rights").

[53] *See* text *supra* at p. 140.

Those publishing rights to be exercised after the first trade edition comes out may be grouped in one subsidiary clause, since the royalty provisions in the contracts surveyed are standardized at 50 percent.[54] The clause in the Houghton Mifflin contract is fairly representative:

> The Publishers may lease or sell the Work in the United States, the Philippines and Canada, paying to the Author 50% of the net receipts:
>
> (a) To a book club.
>
> (b) To another publisher for a reprint edition.
>
> (c) For publication in a magazine or newspaper after publication of their edition, provided these rights have not been included in the grant of the first serial rights.
>
> (d) For selections, abridgments and quotations in other books.
>
> (e) For mechanical reproduction by means of photographic or audio recording, or by direct or transmitted reading, of any part of the original text.[55]

It should be noted that subsection (e) does not include "dramatizations or adaptations on stage, screen, radio, and television." [56]

In addition to those uses specified in the Houghton Mifflin contract, a few incidental uses might be drafted into the clause: (1) Braille transcripts [57] and other forms suitable for the handicapped; [58] (2) pictorial versions of the work in book form, for example, "toy books" or specially illustrated editions for the juvenile market;[59] (3) pictorial adaptations of the work, for example, for cartoons or comic strips; [60] (4)

[54] This traditional royalty provision apparently has not changed much in the industry in recent years. *See*, AUTHORS GUILD BULL. 7–8 (Jan. 1965).

[55] Houghton Mifflin contract, *supra* note 13, at cl. 12 ("Principal Subsidiary Rights").

[56] *Id.* at cl. 13 ("First Serial and Adaptive Rights"). Rights in this separate audio-visual area are discussed in the text, *infra* at pp. 154–57.

[57] Ballantine Books contract, *supra* note 6, at cl. 15 ("Phonographic, Film and Braille Reproduction").

[58] Random House contract, *supra* note 6, at cl. 1.a. viii.

[59] *See*, Hill & Wang contract, *supra* note 6, at cl. IX(A) (5).

[60] *Id.; see also*, World Publishing contract, *supra* note 6, at cl. IX(A) (5) ("Subsidiary Income").

foreign anthology, selection, abridgment, condensation, digest, and second serialization;[61] (5) microfilm and microprint;[62] (6) sound recordings and visual recordings (nonmotion picture);[63] (7) telephonic reproduction;[64] (8) and programs for machine teaching.[65] In the area of items (5) through (8), some contracts use jargon reminiscent of a Victorian underground novel or the 1909 Copyright Act: for example, "Mechanical Voice Renditions and/or Voice Recordings,"[66] or "visual projections . . . by means of mechanics, light, electricity, or other medium known or to be known."[67] Such futuristic and, sometimes, inelegant language may seem amusing in this most advanced of all possible worlds; perhaps, it seemed so twenty-five years ago, before Milton Berle and Ed Sullivan began flickering across the nation. Publishers should never foreclose exploitation of developing technologies; one such publisher, with an eye toward a booming industry provides for use of the work in "any . . . method now or hereafter known or devised for information storage, reproduction, and retrieval."[68] It is not necessary, however, for a publisher to insert in this clause catch-all phrases, such as "and including all other similar adaptations and uses," especially where there are subsequent subsidiary grants of "nonpublishing" and commercial rights.

SUBSIDIARY "NONPUBLISHING" RIGHTS

Performance Rights. It will be recalled that the Authors Guild stands firmly against granting any nonpublishing rights to the publisher.[69] The Guild adopts as its watchword:

[61] Holt, Rinehart & Winston contract, *supra* note 29.
[62] Pergamon Press contract, *supra* note 6.
[63] *See* J.B. Lippincott contract, *supra* note 6.
[64] Horizon Press contract, *supra* note 23, at cl. I.5.
[65] Doubleday contract, *supra* note 6, at cl. 16 ("Sound Recording Filmstrips Teaching Machines Microfilm").
[66] J.B. Lippincott contract, *supra* note 6.
[67] Ballantine Books contract, *supra* note 57.
[68] Doubleday contract, *supra* note 65.
[69] *See* text *supra* at pp. 142–43.

" 'Lease rights to the industry or firm that is in the business of exploiting them.' " [70] It is not the business of publishers to produce plays or motion pictures; moreover, the agents available to authors are more experienced and effective than are the publishers in disposing of nonpublishing rights.[71] All contracts surveyed, nevertheless, grant nonpublishing rights to the house.

Performance rights may be characterized as those which authorize the publisher to adapt the work—or license someone else to do so—for exploitation in the entertainment media. The chief media are radio, television, motion pictures, and the stage, musical or dramatic or both. Rights in all these areas are exercised only after the first trade edition comes out.

Two subsidiary clauses in the Doubleday contract are fairly representative:

> Author grants to Publisher the sole and exclusive right to sell motion picture rights, dramatic rights with or without music, public reading and other non-dramatic performing rights throughout the world in and to and in connection with the said work. . . .
>
> Author grants to Publisher the sole and exclusive right to sell radio and/or television rights, throughout the world, in and to and in connection with said work.[72]

It should be noted that public readings of the work are sometimes included in the subsidiary clause dealing with second serialization and sound reproduction.[73] The only difference this can make to the author is in the amount of royalties. For instance, some of those houses which include public readings in a sound reproduction clause pay the author only 50 per-

[70] AUTHORS GUILD BULL., *supra* note 2, at 11.

[71] AUTHORS GUILD BULL. 16 (Feb. 1965).

[72] Doubleday contract, *supra* note 6, at cl. 13 ("Motion Pictures Dramatization Public Readings"); cl. 14 ("Radio Television").

[73] *See, e.g.*, Holt, Rinehart & Winston contract, *supra* note 28, at cl. 15(e) ("Agency Clause"); Houghton Mifflin contract, *supra* note 55; Viking Press contract, *supra* note 25, at cl. 5(c) ("digests, second serial, anthologies, mechanical reproduction").

cent of the net proceeds,[74] while these same houses pay the author 90 percent on the sale of performance rights.[75] Since the Doubleday clause lists public reading along with other performance rights, the author will receive 90 percent on all these rights.[76]

Allied motion-picture rights consist of using the work for limited visual reproduction in order to promote the main motion-picture rights. Doubleday's contract makes express provision for the exercise of these rights:

> Any sales of motion picture rights to the work may grant to the purchaser the right to publish, for advertising and exploitation, excerpts, summaries, and synopses of the work or dramatizations or motion pictures thereof, but no such excerpts, summaries or synopses shall exceed 7500 words in length, nor shall they appear as having been written by Author, nor shall they be offered to any person, firm or corporation for a monetary consideration.[77]

In addition to allied motion-picture rights, the clause allows the motion-picture producer the right to promote his adaptation through all the normal channels of publicity. The publisher receives no specific fee for this right, and correspondingly the author receives no royalty.

Certain other rights might be added to the subsidiary clause. One of these is the right to publish the script, score, or screenplay that results from an adaptation of the work for the dramatic and musical stages or for motion pictures. A publisher may also want it specified that the exercise of performance rights pertains not only to the work in its present form but to all future versions and revisions of the work. Finally as in the area of technological reproductions of the work,[78] catch-all language can be added so that the clause, in addition

[74] *See, e.g.*, Holt, Rinehart & Winston contract, *supra* note 73; Houghton Mifflin contract, *supra* note 73.

[75] Holt, Rinehart & Winston contract, *supra* note 73; Houghton Mifflin contract, *supra* note 56.

[76] Doubleday contract, *supra* note 72. [77] *Id.*

[78] *See* text *supra* at p. 153.

to the media named, also grants rights in, for example, "any other audio-visual adaptation."

Commercial Rights. With the grant of so-called commercial "tie-in's," the use to be made of the work moves further away from the publishing industry *per se*. The work now enters the realm of "Dr. Seuss" toys and "007" cologne, and the author is confronted with the very real possibility that his dignified treatise may someday be reduced to a family board game.

Some contracts simply refer to "commercial exploitation" [79] or "adaptations for commercial use" [80] without any definition; the whole area is caught in a phrase and inserted into a list of other subsidiary rights. The Bobbs-Merrill contract goes a little further, referring to "advertising, novelty or similar commercial use of the Work or material based on the Work." [81]

A workable definition of commercial rights appears in the Doubleday contract:

> Author grants to Publisher the sole and exclusive right to sell, and to license others to sell, *subject to the approval of the Author*, the commercial rights in and to Author's name and the work. 'Commercial rights' shall be understood to mean the exploitation of Author's name in connection with the work, and of the work itself and all material including the characters contained therein through their use, simulation, or graphic exploitation *on or in connection with* merchandise. Publisher shall pay to Author fifty per cent (50%) of the net proceeds of such sales.[82]

Perhaps, the most noticeable aspect of this clause from the author's point of view lies in his right of approval. This right will most likely be exercised in connection with commercial use of the author's name or, as is the case with the Random

[79] Houghton Mifflin contract, *supra* note 56.
[80] Harper & Row contract, *supra* note 6, at cl. 10(b) ("Subsidiary Rights").
[81] Bobbs-Merrill contract, *supra* note 6, at cl. 13(7) ("Subsidiary Rights").
[82] Doubleday contract, *supra* note 6, at cl. 15 ("Commercial Rights") (emphasis added).

House contract, the "name *and likeness* of the Author." [83] It is also possible that an author may not approve of certain distasteful uses of his creative work. At any rate, whatever the context in which the right is exercised, Doubleday and Random House are the only two contracts of those surveyed which provide the right.

It should also be noted that the Doubleday contract refers to commercial use both *on* and in connection with merchandise. Use *on* merchandise probably includes both promotional material *and trade names;* the latter is certainly true of the Random House contract, which grants the right to use the author's name or likeness and

> the work and the title of the work, in whole or in part, or any adaptation thereof as the basis for *trademark or trade name* for other products or for any other commercial use in connection with such other products.[84]

The right to exploit commercial tie-in's should not be confused with the normal advertising campaign staged by the publisher to sell the work. Whereas the author receives royalties for the commercial use of his work, he should not be entitled to payment for normal promotional uses. It is best to spell this out in the contract so as to avoid any misunderstanding. The Doubleday contract clearly states:

> No payment shall be made to Author by Publisher for permission gratuitously given by Publisher, before or after publication of the work in book form, to publish extracts from the work to benefit the sale thereof.[85]

This clause may be drafted so as to set up more definite guidelines and at the same time substitute a purely subjective

[83] Random House contract, *supra* note 6 (emphasis added). The Bobbs-Merrill contract, *supra* note 6, after listing *all* subsidiary rights—both "publishing" and "nonpublishing"—in the basic grant, adds at the end of the clause, the right to "authorize the use of the Author's name and likeness in connection therewith."

[84] Random House contract, *supra* note 83.

[85] Doubleday contract, *supra* note 6, at cl. 12(b) ("Permissions: Extracts Anthologies Abridged Versions").

standard for the essentially objective one in the Doubleday contract:

> The Publishers may, without charge and without compensation to the Author, publish, or permit others to publish, or to authorize critics or reviewers to broadcast or televise, for publicity purposes, such selections from said Work *as they think proper* to benefit its sale.[86]

The author's safeguard against an unlimited exercise of discretion can be drafted into the clause in the form of a fixed word limitation on permissible excerpts. Ballantine, for instance, allows only up to 750 words.[87]

RIGHTS RESERVED TO AUTHOR

This clause is a meaningless sop to the author. After a broad grant clause, extensive subsidiary rights, and a generous dash of catch-all phrases, few significant rights, if any, have slipped through the publisher's net. Those which have not been caught are *sometimes* reserved to the author.

Even though what may be reserved is rarely of value, it should be noted that there are some contracts which leave *absolutely no residuum* of rights; in fact, some contracts are explicitly drafted so as to convey *absolutely all rights* to the publisher. Sometimes this is achieved in the basic grant. The Bobbs-Merrill grant,[88] for instance, conveys publishing rights for the copyright term plus renewal, throughout the world, in all languages, as well as a complete list of subsidiary rights, and then concludes, "and any other rights now existing or that may come into existence." In a similar manner, the Pergamon Press contract grants basic publishing rights and then prefaces a list of subsidiary rights with the phrase, "including, but without limitation." [89]

[86] Houghton Mifflin contract, *supra* note 13, at cl. 11 ("Free Permissions") (emphasis added).

[87] Ballantine Books contract, *supra* note 6, at cl. 10 ("Permission to Quote").

[88] This particular clause is discussed in detail in the text, *supra* at p. 141.

[89] Pergamon Press contract, *supra* note 6.

The same effect can be achieved in the subsidiary-rights clause. After naming all such rights, the World Publishing contract continues:

> All revenue derived from the sale of rights not specifically herein enumerated, whether now in existence or hereafter coming into existence, shall be shared equally by the Author and Publisher.[90]

No doubt, the author will object to such language—if he notices it—whether it appears in the grant or a subsidiary clause. As the Authors Guild warns: "There can be no predicting now what new devices may at some future time become profitable." [91] The hard fact is that even with such language stricken, those profitable devices that do develop will probably fall under some other catch-all phrase drafted into a clause dealing with rights the publisher knows are subject to development. Without an express reservation of rights, then, the author's chances for some future windfall are minimal.

The clear majority of contracts surveyed contain no express reservation of rights to the author.[92] Even among those contracts that do contain the clause, the reservation is sometimes hedged with conditions. Random House, for instance, states the reservation in terms of a duty: "The Author agrees to notify the Publisher promptly of the disposition of any right which the Author has retained for himself." [93] Harper & Row limits the author's exercise of his reserved rights:

> All rights not specifically granted to the Publisher herein are hereby reserved to the Author and the Author agrees not to exercise or dispose of such rights in such a way as to impair the rights herein granted to the Publisher.[94]

[90] World Publishing contract, *supra* note 60; *see also*, E.P. Dutton contract, *supra* note 52.

[91] AUTHORS GUILD BULL., *supra* note 2.

[92] *See, e.g.*, Grove Press contract; Hill & Wang contract; Holt, Rinehart & Winston contract; Horizon Press contract; J.B. Lippincott contract; Viking Press contract.

[93] Random House contract, *supra* note 6, at cl. 12 ("Rights Retained by Author").

[94] Harper & Row contract, *supra* note 6, at cl. 21 ("Reservation of Rights").

The extreme case is reached in the following clause:

> In the event that any rights may hereafter accrue to the Work which are not at present commonly recognized as part of the Work, they shall be subject to mutual agreement by the Author and Publishers.[95]

Since the only reason why an author desires reserved rights is to reap greater profits from personal exploitation, the latter clause is hardly a reserved rights clause. If an effective reserved-rights clause is to be drafted, it can be done simply: "All rights not herein specifically granted to Publisher are reserved by Author." [96]

PUBLISHER'S OBLIGATIONS

THE DUTY TO PUBLISH

In consideration of the rights granted by an author, a publisher basically agrees to publish the work and pay royalties. Of course, no publisher seeks to impose stringent duties upon itself. Whereas time and exacting workmanship are of the essence in the author's duties,[97] the publisher's responsibility is usually drafted in flexible terms. The draftsman should afford his client leeway—with regard to time, expense, and care—or the contract may trap the publisher in a commercial bind. On the other hand, authors should beware loose language which makes the publisher's performance too discretionary.

The clause defining the duty to publish generally answers two questions: When, if ever, will the first trade edition come out? In what manner or style will that edition be produced? The answer to the first question depends, in turn, upon a prior date, namely, the date when the finished manuscript is

[95] Houghton Mifflin contract, *supra* note 13, at cl. 24 ("Agreements and Other Rights").

[96] Doubleday contract, *supra* note 6, at cl. 18 ("Rights not Specified").

[97] *See* text *infra* at pp. 166–71.

submitted to the publisher. A "finished" manuscript is generally stipulated to be one which is satisfactory *in the publisher's judgment,*[98] although some contracts require the mutual satisfaction of both parties.[99] Since it is the author's express duty to submit a finished manuscript,[100] his performance not only is a precondition to the publisher's but is also the single event which starts running the time in which the publisher must perform.

When, after proper submission of the manuscript, must the work be published? The contracts surveyed provide at least three answers: (1) within "a reasonable time" [101] or (2) "not later than eighteen (18) months" [102] or (3) within one year.[103] An author may object to the first answer. The Authors Guild emphasizes:

> The contract will lose much of its meaning unless it obliges the publisher to issue the book before a specified date (usually within one year after the manuscript is delivered). Delay in publication will put off the author's opportunity to earn royalties and other income; and it may diminish or even destroy that opportunity.[104]

Even with a specified date, however, it is possible that the work will be delayed—excusably—beyond that date, because of forces beyond the publisher's control—for example, strikes, lockouts, Acts of God.[105] In such a situation some contracts specify when, after the cause for delay stops, the

[98] *See, e.g.*, E.P. Dutton contract, *supra* note 6, at cl. 5 ("Publisher's Agreement to Publish and Copyright"); Random House contract, *supra* note 6, at cl. 6 ("Date, Style and Price of Publication").

[99] Ballantine Books contract, *supra* note 6, at cl. 6(a) ("Style, Price and Date of Publication"); Houghton Mifflin contract, *supra* note 13, at cl. 7 ("Publication and Royalties").

[100] *See* text *infra* at p. 166.

[101] Bobbs-Merrill contract, *supra* note 6, at cl. 9 ("Publication").

[102] J.B. Lippincott contract, *supra* note 6, at cl. Fourth.

[103] *See, e.g.*, Ballantine Books contract, *supra* note 99; E.P. Dutton contract, *supra* note 98; Harper & Row contract, *supra* note 6, at cl. 5 ("Publisher's agreement to publish, royalties, etc.").

[104] AUTHORS GUILD BULL. 13 (Oct.–Nov. 1965).

[105] *See, e.g.*, E.P. Dutton contract, *supra* note 98; J.B. Lippincott contract, *supra* note 6, at cl. Sixth (6); Random House contract, *supra* note 98; Viking Press contract, *supra* note 25, at cl. 2 ("Agreement to Publish")

publisher must perform: for example, within six months thereafter [106] or "until the next spring or fall season immediately succeeding." [107] It should be noted that the work may *never* be published—again, excusably—if, *in the publisher's sole opinion*, the work is "libelous or *otherwise injurious*" [108] or "*violates the common law* or statutory copyright or the right of privacy . . . or contains . . . obscene matter" [109] or "*may expose* the Publisher to suit." [110] Obviously the least danger of litigation may slow publication.

Who controls the style of production? Unquestionably it is the publisher who determines what style, imprint, and price will be most conducive to sale of the work.[111] Rarely are specific details drafted into the agreement to publish. Two exceptions are worth noting. Ballantine, for instance, *guarantees* that

> the Author's name shall appear on the spine, cover and title page of any paperbound edition and on the front and spine of the jacket and the binding and title page of any hardbound edition, in accordance with established publishing procedures.[112]

Bobbs-Merrill may

> (1) publish the Work in one or several volumes . . .
> (2) fix or alter the title and prices at which the Work shall be sold;
> (3) determine . . . all other publishing details, including the number of copies to be printed, if from plates or type or by other pro-

[106] Ballantine Books contract, *supra* note 99.

[107] Horizon Press contract, *supra* note 23, at cl. VI ("Publication of the Work"); *accord*, Hill & Wang contract, *supra* note 6, at cl. IV; World Publishing contract, *supra* note 6, at cl. IV ("Publication").

[108] Hill & Wang contract, *supra* note 6, at cl. V(A) (emphasis added).

[109] Random House contract, *supra* note 98 (emphasis added).

[110] Ballantine Books contract, *supra* note 99 (emphasis added).

[111] *See, e.g.*, Bantam Books contract, *supra* note 6 at cl. 3(g); Doubleday contract, *supra* note 6, at cl. 2 ("Publication"); E.P. Dutton contract, *supra* note 98; Harper & Row contract, *supra* note 103; Holt, Rinehart & Winston contract, *supra* note 28, at cl. 6 ("Agreement to Publish"); Horizon Press contract, *supra* note 107; Houghton Mifflin contract, *supra* note 99; J.B. Lippincott contract, *supra* note 102; Random House contract, *supra* note 98; Viking Press contract, *supra* note 105.

[112] Ballantine Books contract, *supra* note 99.

cess . . . size, type, paper to be used, and like details; (4) decide how long plates or type shall be preserved, when they shall be destroyed, and if and when reprintings shall be made.[113]

The clause may also be drafted so as to include the publisher's control over all details of promotion and distribution—including the distribution of free copies.[114] In short, the house exercises plenary authority in conducting its business; indeed, the contract obligates it to do so.

From the author's point of view, it is desirable to draft into the contract an express reverter clause, operative upon the publisher's failure to perform within the time designated. Although the contract of the Society of Authors' Representatives contains such a clause,[115] it appears in only three of the other contracts surveyed.[116] The clause is drafted so as to require written notice of termination by the author within twenty days after the end of the season or year set for publication. If the author fails to give such notice, then the contract shall remain in force until the immediately succeeding spring or fall season. Upon due notice, the contract terminates, and all rights granted therein revert to the author.[117] One contract further stipulates that before rights revert, the author must first agree to repay all advances and publication costs when the work is otherwise published.[118]

DUTY TO KEEP THE WORK IN PRINT

The out-of-print clause specifies conditions under which the contract may terminate, and rights thereunder revert to the author. I discuss the clause at this point, because, at least in a negative sense, it defines that minimum degree of exploitation

[113] Bobbs-Merrill contract, *supra* note 6, at cl. 101 ("Publisher's Determinations").

[114] Hill & Wang contract, *supra* note 107; World Publishing contract, *supra* note 107.

[115] Society of Authors' Representatives contract, cl. 13(c) ("Termination and Reversion of Rights").

[116] Hill & Wang contract, *supra* note 107; Horizon Press contract, *supra* note 107.

[117] *Id.* [118] Horizon Press contract, *supra* note 107.

necessary for the publisher to retain its rights. The publisher, operating on a royalty basis, as the licensee of rights secured by copyright, must exploit that copyright; if not, a reversion to the author may occur.

The basic obligation of exploitation is fulfilled by keeping the work "in print." The clause can be drafted so as to require minimal effort. A work is generally in print if it is on sale in *any edition* in the United States,[119] including a cheap edition [120] or *if there exists a contract* for a cheap edition—to be published when the regular edition is out of print.[121] Such a definition leaves the author at the mercy of waning sales, when a new publisher might be able to accomplish wider promotion and distribution. The author would, no doubt, prefer a specific number of books set as a threshold for the operation of the clause. In this regard, the Society of Authors' Representatives defines out-of-print as "fifty (50) copies or less in stock." [122]

Further conditions can be added to the traditional operation of the out-of-print clause: for example, that there be no contract in existence for the license of *any subsidiary rights;* [123] and that there be no unearned advance or indebtedness outstanding on the author's part; [124] and "subsequent to one year from publication date, no earnings have been payable to the Author hereunder during two consecutive accounting periods." [125]

Assuming the work meets the contract's out-of-print requirements, the author must notify the publisher,[126] in

[119] Horizon Press contract, *supra* note 23, at cl. XI ("Discontinuance of Publication").

[120] *Id.*; E.P. Dutton contract, *supra* note 6, at cl. 13 ("Reversion of Rights").

[121] Horizon Press contract, *supra* note 119; *see also*, Random House contract, *supra* note 6, at cl. 16 ("Discontinuance of Publication"); Viking Press contract, *supra* note 25, at cl. 14A. ("Termination of this Agreement").

[122] Society of Authors' Representatives contract, *supra* note 115, at cl. 13(a).

[123] Holt, Rinehart & Winston contract, *supra* note 28, at cl. 11 ("Reversion of Rights"); Houghton Mifflin contract, *supra* note 13, at cl. 21 ("Termination and Reversion").

[124] *Id* [125] Holt, Rinehart & Winston contract, *supra* note 123

[126] Hill & Wang contract, *supra* note 6, at cl. X.C.

writing,[127] that he demands the work be reprinted.[128] Some contracts give the publisher time in which to reply—for example, thirty days[129] or sixty days.[130] If the publisher duly replies that he will comply, then he has six months in which to bring out a reprint.[131] Where no reply is forthcoming or none is authorized in the contract, then the publisher must bring out a reprint within six months of notification by the author.[132] If the publisher fails to do so, then the contract terminates, and all rights thereunder revert to the author.[133]

The author may wish to include in the clause, a provision giving him the right to purchase the publisher's plates and stock upon termination. The sale is sometimes stipulated to be at cost,[134] or one-half cost,[135] or one-quarter cost,[136] and to be held within a fixed time after termination—for example, within thirty days[137] or three months.[138]

AUTHOR'S OBLIGATIONS

PREPARING FOR PUBLICATION

It will be remembered that the time in which a publisher must perform depends upon the time and quality of the au-

[127] E.P. Dutton contract, *supra* note 120; Horizon Press contract, *supra* note 119; Random House contract, *supra* note 121; Viking Press contract, *supra* note 121.

[128] *Id.*

[129] Ballantine Books contract, *supra* note 6, at cl. 20 ("Termination and Reversion of Rights").

[130] Random House contract, *supra* note 121.

[131] Ballantine Books contract, *supra* note 129; Random House contract, *supra* note 121.

[132] E.P. Dutton contract, *supra* note 120; Hill & Wang contract, *supra* note 126; Horizon Press contract, *supra* note 119; Viking Press contract, *supra* note 121.

[133] *Id.* [134] Horizon Press contract, *supra* note 119.

[135] Viking Press contract, *supra* note 121; Society of Authors' Representatives contract, *supra* note 122, at cl. 13(d).

[136] Random House contract, *supra* note 121.

[137] *Id.*; J.B. Lippincott contract, *supra* note 6, at cl. Sixth (4).

[138] Horizon Press contract, *supra* note 119.

thor's performance.[139] While the publisher's obligations are generally drafted in terms of convenience and discretion, the time and form of the author's performance are *of the essence* of the contract—that is, expressly *material* terms, for the breach of which, the publisher can immediately terminate the contract.[140] If the draftsman has done his job conscientiously, the present clause will impose a detailed schedule of duties, penalties, and rights upon the process of publication. Each step in the process should be drafted to include both what the author *must do* and what the publisher *may do* should the author fail.

Step One (delivery of the manuscript): By a fixed date, the author should submit *two, complete, finally revised, legible, typewritten, double-spaced* copies of the manuscript *in English.*[141] The copies must be *satisfactory to the publisher* in form and content[142] and ready for type composition.[143] Accompanying the copies should be all necessary illustrations, photographs, tables, and maps;[144] if the work is of a

[139] *See* text *supra* at p. 161.

[140] Doubleday contract, *supra* note 6, at cl. 25(d) (Manuscript: Character Due Date Author's Alterations"); Harper & Row contract, *supra* note 6, at cl. 9 ("Time limit for publication"); Hill & Wang contract, *supra* note 6, at cl. V(A); Holt, Rinehart & Winston contract, *supra* note 28, at cl. 4 ("Delivery of Complete Manuscript"); World Publishing contract, *supra* note 6, at cl. V(A).

[141] *See,* Ballantine Books contract, *supra* note 6, at cl. 4 ("Copy for Printing"); Doubleday contract, *supra* note 140; Bobbs-Merrill contract, *supra* note 6, at cl. 4 ("Delivery of Manuscript"); E.P. Dutton contract, *supra* note 6, at cl. 3 ("Delivery of Complete Manuscript"); Grove Press contract, *supra* note 6, at cl. 3; Houghton Mifflin contract, *supra* note 13, at cl. 4 ("Copy for Printing").

[142] *See, e.g.,* Bantam Books contract, *supra* note 6, at cl. 3(a); Doubleday contract, *supra* note 140, at cl. 25(a); Pergamon Press contract, *supra* note 6, at cl. 1.

[143] *See, e.g.,* Ballantine Books contract, *supra* note 141; Bobbs-Merrill contract, *supra* note 141; Doubleday contract, *supra* note 142; E.P. Dutton contract, *supra* note 141 ("in perfect order for printing"); Harper & Row contract, *supra* note 6, at cl. 7 ("Copy for Printing") (parties share penalty charge on composition of heavily corrected copy); J.B. Lippincott contract, *supra* note 6, at cl. Third; Pergamon Press contract, *supra* note 142.

[144] *See, e.g.,* Bobbs-Merrill contract, supra note 6, at cl. 5 ("Matter Supplied by Author; Index"); Doubleday contract, *supra* note 140, at cl. 25(b) ("and

special nature, it is wise to enumerate those materials which must be submitted by the author.[145]

Step Two (treatment of materials submitted): The clause should be drafted so as to specify the publisher's alternative rights where the author's performance is unsatisfactory. Assuming the work is timely submitted, the publisher may reserve the right to "add to, edit or omit any part of [it]," [146] "provided, however, that such editing or alteration shall not materially change the meaning or otherwise materially alter the text of the Work." [147] One contract provides that any "special editing," which *the Publisher deems* necessary, shall be charged to the author—after his consent in writing.[148]

If the work is late or incomplete, the publisher may have two alternatives: (1) It may terminate the agreement, in which case the author must return any advances,[149] and the author cannot have his work published elsewhere, until he first reoffers it to the publisher under the terms of the original contract.[150] Only the Society of Authors' Representatives and one of the trade contracts surveyed provide a three-month grace period, after the date for delivery, before the publisher can terminate the contract.[151] (2) Where the work is incom-

other graphic material ready for reproduction"); Viking Press contract, *supra* note 25, at cl. 2A. ("Final copy, index, illustrations, etc.") ("or other illustrative matter . . . deemed necessary by both parties").

[145] Holt, Rinehart & Winston, in its *special contract for schoolbooks* requires the submission of a "teacher's manual and answer book, tests and keys," cl. 3 ("Delivery of Material"). Pergamon Press, likewise, has a separate form contract for its "United Engineering Series," which requires that illustrations be "in suitable form for redrafting for the Publisher's art department," cl. 1.

[146] Bantam Books contract, *supra* note 6, at cl. 3(e).

[147] Bobbs-Merrill contract, *supra* note 6, at cl. 8 ("Editing by Publisher").

[148] E.P. Dutton contract, *supra* note 141.

[149] *Id.*; Hill & Wang contract, *supra* note 140; Holt, Rinehart & Winston contract, *supra* note 140; Horizon Press contract, *supra* note 23, at cl. IV ("Delivery of Complete Manuscript"); World Publishing contract, *supra* note 140.

[150] E.P. Dutton contract, *supra* note 141; Hill & Wang contract, *supra* note 140; World Publishing contract, *supra* note 140.

[151] Society of Authors' Representatives contract, *supra* note 115, at cl. 3 ("The Manuscript"); Harper & Row contract, *supra* note 140.

plete, the publisher may furnish the missing parts and charge the author at cost.[152] The Horizon Press contract gives the author a last clear chance:

> If in the opinion of the Publisher the manuscript when delivered to it is not properly prepared and in final form for the press, the Author shall, upon receipt of notice to such effect from the Publisher, either *revise the Work* and place it in final form *within an additional period of thirty days* or commission the Publisher to put the manuscript in final form at the Author's expense.[153]

Step Three (proofreading and corrections): The author should be obligated to read and correct the proofs and return them, for example, promptly [154] or within three weeks [155] or thirty days [156] or a reasonable time [157] or "in such time and manner as will not delay the printer." [158] Generally, the author must pay for the cost of correction—except for printer's errors—in excess of 10 percent of the original cost of composition,[159] although the Society of Authors' Representatives proposes a 15 percent threshold.[160]

While the author is proofreading, he is in the best position to produce an index. Since this is a most important detail in the production schedule, it should be covered by express language:

> If requested by the Publisher, the Author shall deliver an index within fourteen (14) days after proof is available for the making

[152] Bobbs-Merrill contract, *supra* note 144; Holt, Rinehart & Winston contract, *supra* note 145; Houghton Mifflin contract, *supra* note 141; Random House contract, *supra* note 6, at cl. 2 ("Delivery of Satisfactory Copy").

[153] Horizon Press contract, *supra* note 149.

[154] Bantam Books contract, *supra* note 146; Holt, Rinehart & Winston contract, *supra* note 28, at cl. 5 ("Author's Alterations"); Horizon Press contract, *supra* note 23, at cl. V ("Revision of Manuscript and Proofreading").

[155] Ballantine Books contract, *supra* note 6, at cl. 19 ("Corrections and Revisions: Publication Date").

[156] Society of Authors' Representatives contract, *supra* note 115, at cl. 6 ("Printer's Proofs").

[157] E.P. Dutton contract, *supra* note 6, at cl. 4 ("Proprietor's Alterations").

[158] Bantam Books contract, *supra* note 146.

[159] Ballantine Books contract, *supra* note 155; Holt, Rinehart & Winston contract, *supra* note 154; Horizon Press contract, *supra* note 153.

[160] Society of Authors' Representatives contract, *supra* note 156.

of such index. If the author fails to deliver the index within the time specified and in satisfactory form, the Publisher may have it made and charge the expense thereof to the Author.[161]

COPYRIGHT

Although it is generally the publisher's duty to take out copyright,[162] the larger number of duties fall upon the author. It is possible to draft a clause which obligates the author to take all steps to protect the copyright, without specifying in advance what these steps may entail.[163] There are, however, some steps which deserve enumeration.

Procurement of permission to use other copyrighted works should occur in *Step One* of the production schedule outlined above.[164] If the author intends to incorporate copyrighted material in his work, it is his duty to get a written permission to reprint, which he submits to the publisher.[165] Permission is obtained at the author's expense and submitted on the date specified for delivery of the work.[166]

The draftsman should provide for the situation in which the author publishes part of his work serially—or in any other form—*prior to* the publication date set by contract. Since the publisher must know of such publication in order to fulfill his duty of securing copyright, the contract ought to require the author to inform the publisher *promptly* of any such prior

[161] Hill & Wang contract, *supra* note 140; *cf.*, Doubleday contract, *supra* note 144.

[162] *See, e.g.*, Ballantine Books contract, *supra* note 6, at cl. 2 ("Copyright") (publisher authorized to take out copyright in author's name); Bantam Books contract, *supra* note 6, at cl. 4 (publisher shall copyright work in its own name); Bobbs-Merrill contract, *supra* note 6, at cl. 3 ("Copyright") (publisher shall apply for copyright in name to be supplied).

[163] *See*, Bobbs-Merrill contract, *supra* note 162; J.B. Lippincott contract, *supra* note 143.

[164] *See* text *supra* at 166.

[165] Bobbs-Merrill contract, *supra* note 6, at cl. 6 ("Copyrighted Material").

[166] Doubleday contract, *supra* note 140, at cl. 25(c); Harper & Row contract, *supra* note 6, at cl. 8(b) ("Permissions"); Random House contract, *supra* note 152.

publication.[167] The Authors Guild favors supplying such information so as to insure correct copyright notice.[168]

If the copyright is to be taken out in the name of the author, the publisher will want to be certain that the copyright is renewed at the proper time. The contract should require the author to apply for renewal whenever due.[169] In case the author fails to perform his duty, the publisher may, if it has been appointed the author's attorney for that purpose in the contract.[170] The World Publishing contract requires the author to direct his executor to fulfill the author's duty of timely renewal.[171]

WARRANTY AND INDEMNITY

In the warranty and indemnity clauses, the author underwrites what amounts to the publisher's insurance policy against the cost of adverse litigation occasioned by the work. As a warrantor, the author guarantees the legality of his work on practically all fronts; as indemnitor, the author agrees to reimburse the publisher for costs incurred due to breach of warranty.

Every contract surveyed contains warranty and indemnity clauses. The author warrants that he is the sole owner of the work, which is unencumbered, and that he has full power to make the grants in the contract. The author further represents that the work does not violate any statutory or common-law copyright or the law of defamation or the right of privacy.[172] Beyond these general designations, catch-all lan-

[167] *See, e.g.*, Harper & Row contract, *supra* note 6, at cl. 2 ("Prior Publication"); Random House contract, *supra* note 6, at cl. 8 ("Copyright").

[168] AUTHOR'S GUILD BULL. 5 n.(A) (Feb.–Mar. 1964).

[169] Ballantine Books contract, *supra* note 162; Doubleday contract, *supra* note 6, at cl. 24(a) ("Copyright").

[170] Holt, Rinehart & Winston contract, *supra* note 28, at cl. 3 ("Copyright").

[171] World Publishing contract, *supra* note 6, at cl. II(B) ("Copyright")

[172] *See, e.g.*, Doubleday contract, *supra* note 6, at cl. 21 ("Warranty"); Houghton Mifflin contract, *supra* note 25, at cl. 2 ("Author's Warranty");

guage abounds. The author may have to warrant that the work is *innocent* [173] or that it is not *scandalous* [174] or *obscene* [175] or *otherwise unlawful*,[176] and that it does not violate *any penal law* [177] or *any proprietary right* [178] or *any other right whatsoever*.[179]

There are also some uncommon specific warranties. One house dealing with scientific and technical publications, requires its authors to warrant that the work does not violate "any governmental security requirement." [180] A Random House author may be asked to warrant that his work contains no recipes or formulae which would be injurious to the user.[181]

Regarding the indemnity provisions, the Doubleday contract is fairly representative of trade practices.[182] The author must indemnify the publisher not only against final judgments and litigation expenses [183] but also against the cost of *any claim asserted* due to breach of warranty.[184] Doubleday has the right to defend by *its own counsel* any action brought *or any claim* asserted.[185] Although the author must consent to any settlement,[186] he is still obligated to pay Doubleday

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Random House contract, *supra* note 6, at cl. 4.a. ("Author's Warranties and Indemnities"); World Publishing contract, *supra* note 6, at cl. III ("Warranty").

[173] Doubleday contract, *supra* note 172, at cl. 21(e); World Publishing contract, *supra* note 172.

[174] Houghton Mifflin contract, *supra* note 172.

[175] Doubleday contract, *supra* note 173; Random House contract, *supra* note 172.

[176] Houghton Mifflin contract, *supra* note 172; World Publishing contract, *supra* note 172.

[177] World Publishing contract, *supra* note 172.

[178] Houghton Mifflin contract, *supra* note 172; World Publishing contract, *supra* note 172.

[179] Doubleday contract, *supra* note 172, at cl. 21(d).

[180] Pergamon Press (Unified Engineering Series) contract, *supra* note 145, at cl. 2.

[181] Random House contract, *supra* note 172.

[182] Doubleday contract, *supra* note 6, at cl. 22 ("Indemnity").

[183] *Id.* at cl. 22(c). [184] *Id.* at cl. 22(a). [185] *Id.* at cl. 22(b).

[186] *Id.*

50 percent of both the settlement and any counsel fees or other expenses.[187]

CONCLUSION

This study has been devoted to the division between author and publisher of only the most basic publishing rights and duties. Space does not permit the inclusion of many other important provisions. It is obvious that within those clauses discussed there is room for variation and negotiation. Some of the variation has been presented, but the negotiation must of needs be left to each individual case.

One word of advice is in order. Before a standard author contract is drawn up, the draftsman would be wise to collect a series of forms currently in use by the industry. He might also confer with some literary agents in order to expose himself to the author's viewpoint. If the draftsman does not conduct such a survey, it is quite possible that his standard contract will be, in the words of Little, Brown's managing editor, "really not of much significance."

[187] *Id.* at cl. 22(d).

NATIONAL FIFTH PRIZE, 1968

Copyright Protection for Motion Pictures: Limited or Perpetual?

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THE CONCEPT OF PUBLICATION, while critical to the protection of literary property in this country, is one of the most complex areas in United States copyright law. Publication, as a copyright term, developed from the historical Anglo-American dichotomy between common law and statutory copyright. (Generally, when a work is first published, the common-law protection of the work is lost [1] and, if certain requirements are satisfied, statutory copyright is secured.[2]) But primarily because the statutory language concerning publication is unclear, the case law on this issue is replete with inconsistencies and with decisions in direct conflict with each other.[3] It is my purpose, applying this confusing body of case law, to determine if or when there is, in the copyright sense, a publication of a motion picture.[4]

[1] Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834); *accord*, Universal Film Mfg. Co. v. Copperman, 218 F. 577 (2d Cir.), *cert. denied*, 235 U.S. 704 (1914). *But cf.* Capitol Records, Inc. v. Mercury Records Corp., 221 F.2d 657 (2d Cir. 1955).

[2] 17 U.S.C. § 10 (1964).

[3] *Compare, e.g.*, Pierce & Bushnell Mfg. Co. v. Werckmeister, 72 F. 54 (1st Cir. 1896) (exhibition of a painting in a public art gallery held to be publication) *with* Werckmeister v. American Lithographing Co., 134 F. 321 (2d Cir. 1904) (exhibition of a painting in a public art gallery held not to be a publication).

[4] I take no position on whether the sound track of a particular film consti-

BACKGROUND

The Copyright Act does not directly define the term *publication,* but section 26 of the Act does refer to the "date of publication" as "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed." [5] As a result, the courts, while staying within the framework of the definition stated in section 26, have generally defined "publication" as:

> when by the consent of the copyright owner the original or tangible copies of a work are sold, leased, loaned, or given away, or otherwise made available to the general public, or when an authorized offer is made to dispose of the work in any such manner even if a sale or other such disposition does not in fact occur.[6]

However, when courts are faced with specific cases having parties with conflicting equities, the courts are reluctant to apply such an abstract definition of publication. An examination of the cases suggests that the courts will require open dissemination of the work considerably more where common-law protection is sought than where the plaintiff is claiming suffi-

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tutes an integral part of the motion picture so that the sound track would be covered by the copyright in the motion picture. *But see* Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949). *See generally* M. Nimmer, *Copyright Publication,* 56 COLUM. L. REV. 185, 186 (1956).

[5] 17 U.S.C. § 26 (1964). The drafters of the 1909 Copyright Act never intended the definition of the date of publication to be an all-inclusive description of how publication itself could take place. There was a fear among the drafters that new methods of exploitation of writings, especially works not reproduced for sale, would be developed which would not be considered acts of publication because such methods did not come within the requirements of a specific definition of publication. It was, therefore, resolved that no definition of publication would be present in the Act. *Arguments before the Committees on Patents on the Bills S. 6330 and H.R. 19853,* 59th Cong., 2d Sess., at 71 (June 6, 7, 8, and 9, 1906); *accord,* Cardinal Film Corp. v. Beck, 248 F. 368 (S.D.N.Y. 1918) (L. Hand, J.). *See also* W. Strauss, *Protection of Unpublished Works-Study No. 29.,* STUDIES PREPARED FOR THE SUB-COMMITTEE ON PATENTS, TRADEMARKS AND COPYRIGHTS OF THE SENATE COMMITTEE ON THE JUDICIARY PURSUANT TO S. RES. 240, 86TH CONG., 2D SESS. 8–9 (1961).

[6] M. Nimmer, *Copyright Publication,* 56 COLUM. L. REV. 185, 187 (1956) (emphasis and footnotes omitted).

cient publication to maintain an action based on the federal statute.[7]

To rationalize the difference in burdens of proof, the courts have evolved a distinction between *general publication* and *limited publication.*[8] A *limited publication* is one "which communicates the contents of a manuscript to a definitely selected group and for a limited purpose, and without the right of diffusion, reproduction, distribution, or sale." [9] Thus, if an author distributes his work (1) for a limited purpose and (2) to a limited group of persons, only a limited publication would be held to have taken place. However, in the absence of either a limited purpose or a limited group of persons, the courts will, or at least theoretically should, hold that there has been a general publication and that common-law protection is thereby divested.

As the result of the above distinctions made by the courts, cases decided under the statutory requirement of publication are not reliable precedents on which to determine whether a forfeiture of common-law rights has occurred.[10] Therefore, I apply only divestiture cases where the publication of a work is alleged to have divested common-law rights and, alternatively, apply only investiture cases to situations where federal statutory protection is contested.

[7] American Visuals Corp. v. Holland, 239 F.2d 740, 743 (2d Cir 1956) (dictum). *See also* R. DEWOLF, AN OUTLINE OF COPYRIGHT LAW 32 (1925).

[8] The distinction between *limited* and *general* publication does have some basis in the legislative history of the 1909 Copyright Act. *See Arguments before the Committee on Patents on the Bills S. 6330 and H.R. 19853,* 59th Cong., 2d Sess., at 101–102 (December 7, 8, 10, and 11, 1906).

[9] White v. Kimmell, 193 F.2d 744, 746 (9th Cir.), *cert. denied,* 343 U.S. 957 (1952). *See generally,* R. Schlattman, *The Doctrine of Limited Publication in the Law of Literary Property Compared with the Doctrine of Experimental Use in the Law of Patents,* ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER FIVE 37 (1954).

[10] Continental Casualty Co. v. Beardsley, 253 F.2d 702, 707 (2d Cir.), *cert. denied,* 358 U.S. 816 (1958).

MOTION-PICTURE DISTRIBUTION TRADE PRACTICES

Before applying the above concepts to the distribution of motion pictures,[11] a description of those practices is in order.

A theatrical motion picture is normally produced (photographed and manufactured) by an independent producing company and then distributed by yet another company, usually one of the major distributors. This is certainly not the exclusive arrangement for the production of motion pictures, but it is presently being used more frequently than any other method. Prior to 1949 the majority of motion pictures in the United States were produced by one of seven major companies,[12] but following an antitrust decree in that year a trend toward independent production developed.[13] This earlier method of production is now only infrequently used.[14]

[11] A *motion picture* is defined as "a series of pictures (as photographs taken with a special camera) presented to the eye in very rapid succession with some or all of the objects in the scene represented in successive positions slightly changed so as to produce because of the persistence of vision the optical effect of a continuous picture in which the objects move." MERRIAM-WEBSTER THIRD NEW INTERNATIONAL DICTIONARY 1475 (3d ed. 1961).

[12] Prior to 1949 five of the major companies not only had extensive distribution systems but also possessed their own production units and theater chains (Paramount Pictures, Inc.; Loews, Inc.; Radio-Keith-Orpheum Corp.; Warner Bros. Pictures, Inc.; and Twentieth Century-Fox Corp.). Two of the major producing companies did not own a distribution system, but did possess theatre chains (Columbia Pictures Corp. and Universal Pictures Company, Inc.). An eighth major company, United Artists Corp., was exclusively a distributor and operated neither a production unit nor a theater chain.

[13] The antitrust suit was brought against the eight major motion picture companies (see note *supra*) as the result of which each major producer was compelled to divest itself of its chain of theaters. United States v. Paramount Pictures, Inc., 344 U.S. 131 (1948), *remanded* 85 F. Supp. 881 (S.D.N.Y. 1949). No longer able to find easy access into the theaters for exhibition of their pictures, the major producers found it unprofitable to maintain their vast studio facilities. They thereupon began either to sell these facilities outright or to lease them out to various independent producers. As a result, the independent producer soon became the dominant source of motion pictures. *See generally*, M. CONANT, ANTITRUST IN THE MOTION PICTURE INDUSTRY (1960).

[14] There are basically two other methods by which motion-picture producers

Once the motion picture is produced, prints of the film are transferred to the distributor, who, in turn, sends approximately 300 to 400 copies of the motion picture to his branch offices. The branch offices of each film distributor are known as *exchanges,* and it is at these exchanges that trade screenings are given and the final contracts with the exhibitors are negotiated.[15] However, the national office of each film distributor determines the date when a particular film will be available on a nationwide basis to the exhibitors.[16]

The actual shipping and handling of the prints are generally

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in the United States acquire rights to films. One method is to coproduce a motion picture with another, usually a foreign producer. Each producer contributes part of the necessary money, and the rights of distribution are then divided up. Another method is for a producer in the United States to purchase distribution rights of an already completed film. Interview with Kenneth A. Clark, Executive Vice-President of the Motion Picture Association of America, in Washington, D.C., February 6, 1968.

[15] There are normally thirty-two exchanges (branch offices) for each film distributor. Each film exchange has no affiliation with any other film distributor and is a wholly owned office of the national film distributor. The film distributors have generally split up their exchange regions exactly alike and have exchanges in the same city—often on the same avenue. Testimony of Alfred R. Taylor, Paramount Film Distributing Corp., Los Angeles, Calif. *Hearings on Motion Picture Trade Practices Before a Senate Subcommittee of the Select Committee on Small Business,* 83d Cong., 1st Sess. 258–59 (1953).

[16] Some pictures are released ahead of the national availability date ("prerelease"). Pictures regarded by the distributor as having exceptional merit or involving unusually high production costs are licensed for an exclusive run in a limited number of communities. When this restricted run is finished, the picture is withdrawn for an indefinite period. After a lapse of about two or three months the distributor makes the picture available to exhibitors on a general release basis, the customary method of distributing motion pictures.

In addition to this prerelease practice, a company may initially exhibit a limited number of prints of a film by means of a "sneak preview." (This is normally done only by companies which possess both production and distribution divisions.) The purpose of the sneak preview is to determine audience reaction to particular scenes in the motion picture which has theretofore not been finally edited. Sneak previews are presently used only on rare occasions. *Hearings on Motion Picture Distribution Practices (1956) Before a Senate Subcommittee of the Select Committee on Small Business,* 84th Cong., 2d Sess. 27–28 (1956); Interview with Kenneth A. Clark, Executive Vice-President of the Motion Picture Association of America, in Washington, D.C., February 6, 1968.

performed by local "transfer companies." One transfer company may perform these services for one or more distributors in a particular region. The transfer companies daily inspect each film for the branch offices and ship the prints from one theater to another. However, all the leasing arrangements are negotiated with the exhibitors by the personnel of the distributor in the branch office and not by the transfer companies.

The 300 to 400 prints of each film are distributed to between 3,000 to 12,000 exhibitors for public showings in theaters. In addition, copies of the motion pictures are distributed on a nonfee basis to various producers, directors, and movie stars, and on a fee basis to the Army-Air Force Motion Picture Service, the Navy Motion Picture Service, the Veterans Administration, and the Red Cross.

The distributor never sells prints of a film to a theatrical exhibitor, but instead grants to the exhibitors a performing license under the copyright in the motion picture, a license which is strictly limited as to the place of performance and as to the dates upon which the film may be exhibited. A positive print of the motion picture is loaned to the licensee-exhibitor, to be cared for properly and returned immediately after the last licensed performance.[17]

After the theatrical distribution of a motion picture has been completed, the film normally becomes available for exhibition over television to the television networks or independent television stations or both. Sometime thereafter, prints of the film are often distributed to numerous local 16mm film libraries with which the distributor normally makes a virtually perpetual rental agreement. These film libraries, in turn, lease copies of the motion picture to nontheatrical private organizations for showing.[18]

[17] *Hearings Before Subcommittee No. 3 of the Committee on the Judiciary on H.R. 4347, H.R. 5680, H.R. 6831 and H.R. 6835*, 89th Cong., 1st Sess. 990, 1000–1 (1966).

[18] Interview with Sidney Schreiber, General Counsel of the Motion Picture Association of America, in Washington, D.C., March 7, 1968.

Films made for television have a different distribution procedure. For films shown by the networks four prints of the motion picture are normally procured and transmission of the motion picture by coaxial cable takes place at only two places, New York and Los Angeles. Each transmission center normally has two copies of the film. Only infrequently do the networks find it necessary to ship copies of the film to wholly owned or affiliated television stations (there are approximately 150 stations affiliated with each of the three major networks) and this occurs only when there is a necessity for a delayed showing.

Distribution of television films to independent television stations, that is, syndication, is done in approximately the same manner as distribution of prints to theater exhibitors. Almost all prints are leased to these television stations for particular showings.

Copies of motion pictures made primarily for educational and other related purposes are either leased or actually sold by the producers or distributors to the exhibitors. This differs from distribution of prints for theatrical or television exhibition, which is almost exclusively done under a lease arrangement.[19]

PUBLICATION AS APPLIED TO MOTION-PICTURE DISTRIBUTION

For purposes of analysis, let us examine the three major steps in the motion-picture distribution process (production, distribution, and exhibition) and attempt to determine at what point, if any, a divestive or an investive publication of a motion picture occurs. Special emphasis will be placed on the different methods used to distribute copies of a film.

[19] Joint Interview with Ronald Kaiser, Attorney for Columbia Broadcasting System; Harry R. Olssen, Attorney for American Broadcasting Company; and Myron Roth, Attorney for National Broadcasting Company, in New York City, March 8, 1968.

The actual production of a motion picture is clearly not a publication for either investiture or divestiture purposes, since copies of the motion picture never transfer possession.[20] Also, because the courts have mechanically stated that public performance of a writing is not an abandonment of common-law protection,[21] no divestive publication has been deemed to occur upon the screening of a motion picture in a public theater [22] or over television.[23] Presumably, therefore, the screening of a motion picture either in a public motion-picture theater or over television would not invest statutory protection.

Under the circumstances mentioned above, prints of certain types of motion pictures (usually educational) are sold outright. And a sale of but one print of a motion picture, even if only a "fanciful" sale, plus deposit of copies at the Copyright Office will invest statutory protection.[24] Additionally, the sale of prints of a motion picture will constitute a divestive

[20] Professor Nimmer suggests that a *sine qua non* of publication is the acquisition by members of the public of a possessory interest in tangible copies of the literary work. M. Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185, 197 (1956); *accord*, King v. Mister Maestro, Inc., 224 F. Supp. 101, 107 (S.D.N.Y. 1963).

[21] Ferris v. Frohman, 223 U.S. 424, 435 (1912); *accord*, Waring v. Dunlea, 26 F. Supp. 338, 340 (E.D.N.C. 1939); French v. Maguire, 55 How. Pr. 471, 479 (Sup. Ct. 1878). *But see* Selvin, *Should Performance Dedicate?*, 42 CALIF. L. REV. 40 (1940) (Mr. Selvin, while advocating that public performance should dedicate a work to the public domain, admits that this is not the present state of the law).

[22] Metro-Goldwyn-Mayer Distributing Corp. v. Wyatt, 21 Copyright Office Bull. 203 (D. Md. 1932); *accord*, DeMille Co. v. Casey, 121 Misc. 78, 201 N.Y.S. 20 (Sup. Ct. 1923).

[23] *See* King v. Mister Maestro, Inc., 224 F. Supp. 101 (S.D.N.Y. 1963) (giving a speech over national television held not to be a divestive publication); Columbia Broadcasting Sys., Inc. v. Documentaries Unlimited, Inc., 42 Misc. 2d 723, 727, 248 N.Y.S.2d 809, 812–13 (Sup. Ct. 1964) (dictum). *See also* Uproar Co. v. National Broadcasting Co., 8 F. Supp. 358, 362 (D. Mass. 1934), *aff'd and modified*, 81 F.2d 373 (1st Cir.), *cert. denied*, 298 U.S. 670 (1936) (reading text over radio held not to constitute a divestive publication).

[24] Stern v. Jerome H. Remick & Co., 175 F. 282 (S.D.N.Y. 1910); *see* Joe Mittenthal, Inc. v. Irving Berlin, Inc., 291 F. 714 (S.D.N.Y. 1923). *See also* Atlantic Monthly Co. v. Post Publishing Co., 27 F.2d 556 (D. Mass. 1928); H. HOWELL, THE COPYRIGHT LAW 64 (3d ed. 1962).

publication, resulting in the loss of common-law protection.[25] Probably, even the "exposure" of prints of a motion picture for sale will constitute a divestive publication.[26]

The deposit of two copies of a motion picture at the Copyright Office, without any further distribution, is not considered an act of publication for either investiture[27] or divestiture[28] purposes.

However, by far the most extensive method used to distribute a motion picture is to lease copies of the film to exhibitors. To determine whether such a distribution of prints is a publication constitutes the major focus of the remainder of this essay.

For investiture purposes, publication of a motion picture takes place when prints of the film are distributed to the branch offices of the distributor under a lease or similar arrangement.[29]

However, it has been held that there is no divestive publication of a motion picture if the distribution of prints is made on a noncommercial license basis. In *Patterson v. Century Prod., Inc.*,[30] the plaintiff had several copies of his motion picture made and shown without charge to some of his em-

[25] Universal Film Mfg. Co. v. Copperman, 212 F. 301 (S.D.N.Y.). *aff'd*, 218 F. 577 (2d Cir.), *cert. denied*, 235 U.S. 704 (1914); *see* Larrowe-Loisette v. O'Laughlin, 88 F. 896 (S.D.N.Y. 1898); Parton v. Prang, 18 F. Cas. 1273 (C.C. Mass 1872).

[26] *See* Varconi v. Unity Television Corp., 11 Misc. 2d 191, 173 N.Y.S.2d 201 (Sup. Ct. 1958) (lease of motion-picture rights of an underlying work held to be so broad as to expose those rights for sale and thereby to publish that underlying work).

[27] American Visuals Corp. v. Holland, 239 F.2d 740 (2d Cir. 1956) (dictum); *see* 17 U.S.C. § 13 (1964). *Contra*, Cardinal Film Corp. v. Beck, 248 F. 368 (S.D.N.Y. 1918). *See generally* M. NIMMER, COPYRIGHT LAW 214 (1967).

[28] *See* Heim v. Universal Pictures Co., Inc., 154 F.2d 480, 486 (2d Cir. 1946) (sheet music); Joe Mittenthal, Inc. v. Irving Berlin, Inc., 291 F. 714, 715 (S.D.N.Y. 1923) (scenario). *See also* Edgar H. Wood Associates, Inc. v. Skene, 347 Mass. 351, 197 N.E.2d 886 (1964).

[29] *See* Ladd v. Oxnard, 75 F. 703 (C.C.D. Mass. 1896) (leasing of books to 179 subscribers with restrictions as to further use held to be a publication investing statutory copyright).

[30] 93 F.2d 489 (2d Cir. 1937), *cert. denied*, 303 U.S. 655 (1938).

ployees and their families. In addition, the plaintiff arranged through the Y.M.C.A. to have copies of his motion picture shown to many religious, educational, and social organizations. But the film was to be shown to these organizations only upon the express restriction that no charge should be made to the exhibitors of the film, except the actual cost of transportation, and that no charge should be made by the exhibitors to the people observing the screenings of the film. Although through this Y.M.C.A. arrangement thousands saw the film, the court, placing special emphasis on the noncommercial nature of the distribution, held that the motion picture was not published.

> This motion picture was not distributed except for exhibition in the strictly limited non-commercial way above described. As the distribution was limited to exhibition of the picture without charge, no one was given the right to use the copies sent out for any other purpose whatsoever. The positive films were merely loaned for that purpose which did not permit copying. There was, therefore, no publication before the registration under section [12] or before this suit was brought.[31]

There is more difficulty in determining whether or not there is a divestive publication when the motion picture is distributed under a leasing arrangement which is commercial in nature. The Copyright Bar generally takes the position that the commercial leasing of copies of a motion picture does constitute a divestive publication.[32] However, any conclusion made on this issue must necessarily be based on only a meager amount of case law.

[31] *Id.* at 492.

[32] R. DeWolf, An Outline of Copyright Law 29 (1925); F. Skone James, Copinger and Skone James on the Law of Copyright Law 66 (3d ed. 1952); H. Howell, Copyright Law 64 (4th ed., A. Latman, 1962); M. Nimmer, *Copyright Publication*, 56 Colum. L. Rev. 185, 197–98 (1956). *Contra*, M. Aronson, *The Development of Motion Picture Copyright*, ASCAP Copyright Law Symposium Number Three 339, 353 (1940); S. Rothenberg, Copyright and Public Performance of Music 16 (1954) (distinguishing the *Patterson* case as only dictum when applied to the commercial distribution of a film).

In *O'Neill v. General Film Co.*,[33] plaintiff sued for infringement of his alleged common-law copyright in the book *Count of Monte Cristo*. The defendant alleged that the plaintiff had published his work through the commercial distribution of a motion picture based on plaintiff's work and that, therefore, the state court had no jurisdiction to grant any relief. The court agreed that if the work had been published, the state court would have no jurisdiction. But the court also stated that the work was

> . . . released for distribution and circulation among exhibitors and motion picture theatres on the 1st of November, 1912; that with the consent of the plaintiff said company [Famous Players' Film Co.] secured copyright in said films . . . on the 10th day of December, 1912. . . .
>
> By these steps taken by plaintiff and by the Famous Players' Company . . . it is quite clear, I think, that the plaintiff parted with any common law motion picture rights he had in the play, to the extent, at least, represented by the motion pictures thus taken and copyrighted.[34]

The court granted relief for the plaintiff up to the time he allegedly secured federal copyright protection [35] on December 10, 1912.[36] By granting this relief the court implicitly held that the "distribution and circulation among exhibitors and motion picture theatres" which took place on the first of November, 1912, did not divest plaintiff's common-law rights to his book and that, therefore, no divestive publication took

[33] 171 App. Div. 854, 157 N.Y.S. 1028 (1916).

[34] *Id.* at 866, 157 N.Y.S. at 1037–38 (1916).

[35] This court apparently based its conclusion on the incorrect assumption that investive publication took place at the time of the deposit of two copies of a motion picture with the Copyright Office. At the time of this decision there was some authority for this assumption. *See* Stern v. Jerome H. Remick & Co., 175 F. 282 (S.D.N.Y. 1910) (L. Hand, J.). Subsequently, the *Stern* case was clarified by Judge Hand to stand for the proposition that deposit plus a "fanciful" sale constituted investive publication. Joe Mittenthal, Inc. v. Irving Berlin, Inc., 291 F. 714, 715 (S.D.N.Y. 1923) (L. Hand, J.).

[36] The Application for Copyright Registration (LP 188–1912) states that the date of publication of the film *Count of Monte Cristo* occurred on December 10, 1912.

place at that time; otherwise, the court could not have granted relief based upon common-law protection for the period of time between the first of November and the tenth of December.[37]

In the second case involving a divestive publication of a motion picture, *Blanc v. Lantz*,[38] the plaintiff sought damages for the alleged infringement of his common-law rights to a musical laugh on the sound tracks of Woody Woodpecker cartoon films. The defendants contended that the common-law rights to plaintiff's musical laugh in the cartoons had been divested by the publication of the cartoon films. The defendants averred that the publication had taken place when the films were commercially distributed to theaters throughout the world. Distinguishing the *Patterson* [39] decision on the grounds that that case involved a noncommercial distribution, the California Superior Court granted the defendant's motion for judgment on the pleadings and said:

> I am unable to concur in plaintiff's contention that the distribution of the Woody Woodpecker cartoons at most amounted to a "limited" as distinguished from a "general" publication. The distribution and exhibition in commercial theatres throughout the world in my opinion constitutes so general a publication of the contents of the film and its sound track as to result in the loss of the common law copyright. The fact that the copies of the film were leased rather than sold does not prevent the distribution from constituting a "publication" resulting in the termination of the common law right.[40]

However, the *Blanc* case has been distinguished by commentators [41] on the grounds that the court's decision was

[37] O'Neill v. General Film Co., 171 App. Div. 854, 869, 157 N.Y.S. 1028, 1040 (1916).

[38] 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

[39] Patterson v. Century Prods., Inc., 93 F.2d 489 (2d Cir. 1937), *cert. denied*, 303 U.S. 655 (1938).

[40] Blanc v. Lantz, *supra* note 38, at 142.

[41] B. Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, at 486 n.75 (1955); M. NIMMER, COPYRIGHT LAW 217 n.169 (1967); W. Strauss, *Protection of Unpublished Works Study*

based on a subsequently repealed California statute which stated: "If the owner of a product of the mind intentionally *makes it public*, a copy or reproduction may be made public by any person, without responsibility to the owner, so far as this state is concerned." [42]

By the words, "makes it public," the statute appears to have included the public performance of a writing in California's definition of *publication*, a definition broader than that existing at common law.[43] This position is supported by the *Blanc* court's use of the words "and exhibition" after the word "distribution," [44] in finding that the motion picture in question had been published. Since this statutory definition of publication is broader than the common-law definition, the *Blanc* case is said to have little precedent for cases not coming under the statute.

However, it is submitted that the *Blanc* decision stands for more than a court merely construing a repealed California statute. In the written opinion the court referred to the basic arguments that could have been made by each party to the suit. Defendant could have urged, the court stated, that to allow the proprietor to exhibit his motion picture without a divestiture of common-law protection, no matter how widespread and commercially his performances may have extended, would be to allow an exploitation of copyrightable material by way of a perpetual monopoly inconsistent with the public good and the United States Constitution. Therefore, defendant could have urged that a public performance under the statute was a publication. The court went on and stated that the plaintiff could have urged that publication requires a

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No. 29. STUDIES PREPARED FOR THE SUB-COMMITTEE ON PATENTS, TRADEMARKS AND COPYRIGHTS OF THE SENATE COMMITTEE ON THE JUDICIARY PURSUANT TO S. RES. 240, 86th Cong., 2d Sess. at 11 (1961).

[43] CAL. CIV. CODE (ANN.) § 983 (1954), *formerly* CAL. CIV. CODE § 983 (1872) (emphasis added).

[43] Cases cited notes 22 and 23 *supra*.

[44] Blanc v. Lantz, *supra* note 40 (emphasis added).

distribution of some tangible "copy" and that performance of copyrightable material does not fall within this requirement. Therefore, plaintiff could have urged that his work was not published by its exhibition in commercial theaters.[45]

The court, while conditionally agreeing with the argument that public performance did not dedicate the cartoon film to the public domain either under the statute or under common law, held that the distribution and exhibition of copies of a motion picture was a publication, divesting common-law rights.

> But even if plaintiff's performances have not resulted in a legal dedication . . . , I nevertheless am of the opinion that the recordation of that laugh on a motion picture sound track for the purpose of distribution for reproduction in commercial theatres throughout the world *and the actual distribution of such prints and playing of the sound tracks in such theatres* constituted a "publication" of plaintiff's composition.[46]

Not only did the court not rely on the broad language of the statute to reach its holding, but the court supported its conclusion only on cases construing the common-law definition of *publication.*[47]

In a third case, *Brandon Films, Inc. v. Arjay Enterprises, Inc.*,[48] the plaintiff sued for infringement of its alleged common-law rights to two motion pictures it had leased commercially for over thirty-five years to exhibitors. The defendant motioned for summary judgment to dismiss the complaint on

[45] Blanc v. Lantz, *supra* note 38, at 139–40.

[46] *Id.* at 140 (emphasis added).

[47] *Id.* at 142. Support for this author's interpretation of the *Blanc* case is found in a later California district court case. In McIntyre v. Double-A Music Corp., 119 U.S.P.Q. 106, at 107 (Cal. Dist. Ct. 1958), a case not coming under the broad publication statute found in the *Blanc* case, the court cited *Blanc* for the proposition that the "*general* publication" of a work destroyed any common-law protection the author may have theretofore had. By using the *Blanc* case as precedent for such a proposition, the California court was apparently of the opinion that the *Blanc* case stood for more than the narrow statutory construction interpretation.

[48] 33 Misc. 2d 794, 230 N.Y.S.2d 56 (Sup. Ct. 1962).

the grounds that plaintiff's motion pictures were published without notice and were, therefore, in the public domain. The court granted plaintiff's motion for summary judgment holding that the commercial leasing of the motion pictures was not a publication. The court's sole precedent for its conclusion was the case of *DeMille Co. v. Casey*,[49] another New York Supreme Court decision. The court distinguished the *Blanc* [50] case by stating that the California court was involved in the construction of a particular California statute defining publication, and was, therefore, no authority for defendant's position.[51]

However, it is submitted that the precedent relied on by the *Brandon* court does not support the decision reached in the case. In the *DeMille* case the plaintiff sued both for damages under a license and for copyright infringement. Plaintiff, the owner of certain stories, had licensed the defendant to make and distribute a motion picture based on the underlying work belonging to plaintiff. After the motion picture was made, leased, and exhibited, the defendant defaulted on payments required under the license arrangement with the plaintiff. The plaintiff thereupon gave notice of rescission to the defendant, but the latter continued to lease the motion picture for commercial exhibition. The *DeMille* court found little trouble in granting damages prior to the notice of rescission, since the damages were based on the lease contract. However, because the contract was a nullity after the rescission, the plaintiff thereafter had to base its claim for relief on protection outside the contract, that is, on copyright. Plaintiff, therefore, contended that its rights were protected under common law. The defendant, in turn, argued that plaintiff's underlying work was in the public domain because the motion picture was published by the distribution of copies of the film through a commercial lease arrangement.

[49] 121 Misc. 78, 201 N.Y.S. 20 (Sup. Ct. 1923).
[50] Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).
[51] *But see* text accompanying notes 41 through 47 *supra*.

The court in attempting to answer defendant's argument 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. Furthermore, as defendants conceded, the question of publication is largely one of intention. The court, in *American Press Assn. v. Daily Story Publ. Co.*, 120 Fed. 766, 57 C.C.A. 70, 66 L.R.A. 444, held that where one is licensed to publish a work he may not be an agent of the licensor with power to dedicate such work to the public, and that the publication of such copyright work only has such effect where it is done with the consent of the proprietor, and is actually so intended, the licensee acquiring the privilege of publishing but no proprietary rights in the copyright.[52]

By granting damages for the period after rescission, the *DeMille* court held that plaintiff's work was still protected at common law. However, the exact reason for this holding is unclear, as seen from the court's wording above. A careful reading of the opinion will disclose that the statement made by the court (that the "leasing" or "furnishing of the film" was not a publication of the film) was only dictum. It is submitted the true holding of the *DeMille* case was that *even if* the motion picture was published, the underlying work was not published when such a dedication occurred as the result of the acts of a licensee who was not authorized to publish the work.[53] There was, therefore, no need for the supposition that the motion picture was, in fact, published.

As a consequence of the analysis of the above three major cases, the following conclusions may be drawn. The *Brandon* case [54] held that the commercial distribution of copies of a film by a lease arrangement is *not* a publication of the film. However, because the sole precedent for the court's decision represented only dictum, the case carries small persuasive

[52] *DeMille Co. v. Casey*, *supra* note 49, at 88, 201 N.Y.S. at 28.
[53] *Accord*, M. NIMMER, COPYRIGHT LAW 222 (1967).
[54] Brandon Films, Inc. v. Arjay Enterprises, Inc., *supra* note 48.

weight. The *Blanc case* [55] stated that the commercial distribution of prints of a motion picture under a lease arrangement, coupled with the exhibition of the film, constitutes a divestive publication of the motion picture. Nevertheless, the commentators have cast considerable doubt on the scope of the case's holding; and even if this doubt is not justified,[56] it substantially reduces the value of the case as precedent. And lastly, the *O'Neill* court [57] implicitly held that the distribution of a film under a commercial lease arrangement does not divest common-law protection. This case is probably the most persuasive of the three, but I am unsure whether the issue of publication was properly brought before the court, that is, whether the defendant forcefully averred that publication occurred on November 1, 1912, when copies of the motion picture were commercially leased and exhibited and that, therefore, the court had no jurisdiction to grant relief for any infringement after that date. The issue was probably not so presented because the defendant would have been liable also under the federal statute, since the federal requirements were apparently met by the plaintiff at the time he leased the prints. If such is the case, the *O'Neill* decision is less controlling than would at first appear.

Given the lack of substantial cases directly deciding the issue of whether the distribution of a motion picture under a commercial lease arrangement divests common-law protection, arguments based on cases with factual situations analogous to motion-picture distribution practices [58] and an argu-

[55] Blanc v. Lantz, *supra* note 38.

[56] *See* text accompanying notes 41 through 47 *supra.*

[57] O'Neill v. General Film Co., *supra* note 33.

[58] Theoretically, a limitation on the number of persons having access to copies of a work must be present to maintain common-law protection. *See* note 9 *supra.* However, a study attempting to determine the scope of that limitation quantitatively has proved unsatisfactory. *Compare* American Visuals Corp. v. Holland, 239 F.2d 740 (2d Cir. 1956) (free distribution of 100 proof copies of a safety booklet held to be a publication) and Continental Casualty Co. v. Beardsley, 253 F.2d 702 (2d. Cir. 1956), *cert. denied,* 358 U.S. 816 (1958) (free distribution of 100 copies of an insurance plan held to be a publication)

ment based on the Patent-Copyright Clause of the Constitution are discussed.

The first group of analogous cases discussed deal with the leasing of books by the author.[59] In probably the most important of the cases, *Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Publ. Co.*,[60] the plaintiff distributed a semi-annual reference book which gave current information concerning the jewelers' industry. The books were leased only to subscribers who agreed that the material in the reference book was to remain completely confidential. The defendant contended that the book had been published and that the state court had, therefore, no jurisdiction to grant relief. The New York Court of Appeals found that there was little, if no, selection of persons to whom the leasing arrangement was available [61] and thereupon decided that a publication of the reference book had taken place.

> But our examination leads us to the conclusion that the present state of the law is that, if a book be put within the reach of the general public, so that all may have access to it, no matter what limitations be put upon the use of it by the individual subscriber or lessee, it is published, and what is known as the common law copyright, or right of first publication, is gone.[62]

In two cases involving the leasing of books which followed the *Jewelers'* case, the courts chose to construe narrowly the

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with Hirshon v. United Artists Corp., 100 U.S. App. D.C. 217, 243 F.2d 640 (1957) (free distribution of 2,000 copies of sheet music held not to be a publication) and King v. Mister Maestro, Inc., 224 F. Supp. 101 (S.D.N.Y. 1963) (free distribution of text copies of speech to national press personnel held not to be a publication).

[59] The distinction between a distribution of copies of a work under a lease arrangement or a loan agreement appears to make a definite difference in the outcome of this group of cases. Allen v. Walt Disney Prods., 41 F. Supp. 134 (S.D.N.Y. 1941) (*loan* of sheet music to a limited number of piano players and orchestra conductors held not to be a publication); *accord*, Burnett v Lambino, 204 F. Supp. 327 (S.D.N.Y. 1962); McCarthy & Fischer, Inc. v White, 259 F. 364 (S.D.N.Y. 1919).

[60] 155 N.Y. 241, 49 N.E. 872 (1898).

[61] The court found that anyone willing to pay the price of the subscription to the reference book could become a lessee. *Id.* at 251, 49 N.E. at 874–75.

[62] *Id.* at 254, 49 N.E. at 876.

New York Court of Appeals' decision and thereby to weaken its holding. In *F.W. Dodge Co. v. Construction Information Co.*,[63] the plaintiff leased reference books to subscribers in the construction business who agreed not to divulge the book's contents. The content of the reference books was changed periodically, sometimes daily, by a series of information slips to be placed in the book as the slips were received by the subscribers. The defendant contended that by such a distribution the work had been published and that the Massachusetts court did not have jurisdiction. The Massachusetts Supreme Judicial Court found the work had not been published and distinguished the *Jewelers'* case by saying:

> The thing sent out in . . . [the *Jewelers'* case] was a book designed to be preserved and used for a considerable time. It was in a convenient form for transfer from hand to hand, and for use from time to time by different persons. We do not think [the *Jewelers'* case] very much resembles the case before us. The information given by the plaintiff in this case . . . is of specific facts for particular persons or classes of persons, adapted to their interests, and furnished from time to time as the facts are ascertained. It seems very unlike the sale or loan of a large printed book, to be printed among a large class of persons.[64]

The distinction made by this Massachusetts court was followed by a New York Supreme Court in a case involving the same reference book company and almost the same facts. In *F.W. Dodge Corporation v. Comstock*,[65] the plaintiff again based its suit on alleged common-law rights in the work. The defendant, in turn, contended that the work, the "Dodge Reports," had been published when copies were distributed to subscribers of the plaintiff's service. This New York court followed the earlier Massachusetts *Dodge* case [66] and found that the distribution of copies did not amount to a general publication. Although the defendant relied on the *Jewelers'* case, the

[63] 183 Mass. 62, 66 N.E. 204 (1903).
[64] *Id.* at 65, 66 N.E. at 206.
[65] 140 Misc. 105, 251 N.Y.S. 172 (1931).
[66] F. W. Dodge Co. v. Construction Information Co., *supra* note 63.

court distinguished its own decision from that holding and stated:

> The [*Jewelers'*] case simply holds, if a book is put within the reach of the general public so that all have access to it, no matter what limitations be put upon the use of it by individual subscribers or lessees, it is published, and what is known as the common law copyright, or right of first publication, is gone. In the present case, however, the Dodge Reports were never put within the reach of the general public so it could have access to them.[67]

However, it is submitted that the *Jewelers'* case was not adequately distinguished and that the two *Dodge* cases and the *Jewelers'* case stand for opposite holdings on essentially the same facts. In the New York *Dodge* case,[68] the defendant obtained copies of the report through an attorney. The attorney subscribed to the report to which, the court had contended, the public (other than those in the construction industry) had no access. Also, although the decision fails to so disclose, the lease arrangement in the Massachusetts *Dodge* case [69] was probably available to all who could pay the subscription charges. Hence, because the general public did, in fact, have access to the reference books in both the *Dodge* cases, the distinction between the *Jewelers'* case and the *Dodge* cases is illusory.

The second part of the discussion of analogous cases deals with the distribution of copyrightable market quotations. In *Board of Trade of Chicago v. Hadden-Krull Co.*,[70] the plaintiff transmitted its stock market quotations over ticker-tape machines which were leased by brokers, who exhibited the quotations obtained from the ticker tape on a blackboard in their offices to the brokers' customers. All brokers who could pay for the service were allowed to lease the ticker-tape machines from the plaintiff, and only customers of the plaintiff

[67] F. W. Dodge Corp. v. Comstock, *supra* note 65, at 110, 251 N.Y.S. at 178.
[68] *Id.* at 106, 251 N.Y.S. at 174.
[69] F. W. Dodge Co. v. Construction Information Co., *supra* note 63.
[70] 109 F. 705 (E.D. Wis. 1901).

could receive the quotations. The defendant contended that publication of the quotations occurred when they were transmitted by the plaintiff over the leased ticker-tape machines. However, the court found that no publication had occurred by such a transmission because only the customers of the plaintiff and not the general public had access to the ticker tape on which the quotations were typed.

> In recent cases . . . it appears to have been held in reference to printed matter that the fact that a limitation was placed upon the nature of the use of the copies delivered would not prevent the delivery from constituting a publication, if access by the public was open, and there was no restriction on the extent or number of persons having such access or use.[71]

On the same facts, the U.S. Court of Appeals for the Second Circuit in *Board of Trade of Chicago v. Tucker* [72] followed the reasoning of the above decision by finding that publication of the market quotations did not occur when the ticker tape reached the brokers' offices or when exhibited on the blackboard before the brokers' customers.

The applicability of these two cases to the distribution of a motion picture is clear. If the courts hold (as they did in the two above-mentioned cases) that no divestive publication occurs when copies of copyrightable material are transferred under a lease arrangement to customers of the copyright owner and when the contents of the copies so transferred may only be exhibited by the lessee, the distribution of copies of a motion picture under a similar arrangement should also not constitute a publication.

Summarizing the discussion of analogous cases, it is submitted that the cases are not conclusive on the major issue of this essay. The *Jewelers'* case,[73] upon which many commen-

[71] *Id.* at 706.

[72] 221 F. 305 (2d Cir. 1915). *But see* Board of Trade v. Christie Grain & Stock Co., 198 U.S. 236 (1905).

[73] Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Publ. Co., 155 N.Y. 241, 49 N.E. 872 (1898).

tators have often relied to substantiate the conclusion that publication does occur when a motion picture is commercially leased to exhibitors,[74] does not support by itself that conclusion in light of the two *Dodge* cases.[75] In addition, the "ticker tape" cases [76] are of only persuasive value and are certainly not controlling on the issue of this essay.

My third and last discussion involving the issue of divestive publication of a commercially leased motion picture is based on the Patent-Copyright Clause of the United States Constitution which states: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings." [77]

With this particular Clause, the Founding Fathers of the United States gave the federal legislature the power to create a federal system of copyright protection, which protection had theretofore been a power in the hands of the several Colonies. Prior to the adoption of the U.S. Constitution nearly every Colony had some copyright protection for its own citizens,[78] and it was felt that uniformity of protection on the federal level was needed to solve the chaotic situation which had developed as the result of the differences in copyright protection in each of the Colonies.[79]

[74] *See e.g.*, H. HOWELL, COPYRIGHT LAW 64 (4th ed., A. Latman, 1962); M. NIMMER, COPYRIGHT LAW 217 (1967).

[75] F. W. Dodge Co. v. Construction Information Co., 183 Mass. 62, 66 N.E. 204 (1903); F. W. Dodge Corp. v. Comstock, 140 Misc. 105, 251 N.Y.S. 172 (1931).

[76] Board of Trade of Chicago v. Hadden-Krull Co., 109 F. 705 (E.D. Wis. 1901); Board of Trade of Chicago v. Tucker, 221 F. 305 (2d Cir. 1915).

[77] U.S. CONST. art I, § 8, cl. 8.

[78] Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theatre Co., 59 F.2d 70, 72 (1st Cir. 1932) (dictum).

[79] THE FEDERALIST No. 43 (J. Madison) says that the States could not separately make effective provision for copyright protection and that the "public good" demanded uniform protection of literary property; *accord;* 28 U.S.C. § 1338(a) (1948) (statute vests exclusive jurisdiction to hear copyright cases coming under the federal copyright statute in federal courts). *See also* S. Bricker, *Thirty Months After Sears and Compco,* 14 BULL COPY-

However, Congress was not vested by this Clause with anything akin to the royal prerogative in the creation and bestowal of monopolistic privileges as found in early England. The congressional powers were limited as to subject matter, as to the purpose of the power, and, especially, as to the duration of the rights granted under the power. Only the writings of authors could be protected, and then only for the end of promoting science. In addition, the Founding Fathers continually emphasized that the copyright monopoly could be granted for only "limited Times" and that Congress should be prevented from enacting legislation under which a perpetual copyright could be granted.[80]

Congress has chosen to exercise the power enunciated in the Patent-Copyright Clause by enacting federal legislation, which grants protection for certain writings for a maximum of fifty-six years in accordance with the "limited Times" provision of the Patent-Copyright Clause.

This federal copyright statute,[81] like other laws of the United States enacted pursuant to constitutional authority, excludes the States under the Supremacy Clause of the Constitution [82] from interfering with the policy of and protection granted by the federal statute.[83] And, as seen above,

RIGHT Soc'y 293, at 301 (1967) (author states that the need for uniformity of copyright protection is today even more critically required because of the present day complex communications media).

[80] In every resolution considered by the Committee of the Constitutional Convention in charge of drafting the Patent-Copyright Clause there appeared a "limited Times" provision. The Constitutional Convention itself when the final draft of the Clause was submitted adopted the Clause without any debate and without any change. Fenning, *The Origin of the Patent and Copyright Clause of the Constitution*, 17 GEO. L.J. 109, 112–13 (1929); *see* Marx v. United States, 96 F.2d 204, 206 (9th Cir. 1938) (a federal statute granting copyright protection in perpetuity would be unconstitutional).

[81] Title 17, U.S.C. (1964).

[82] U.S. CONST. art. VI.

[83] Sola Elec. Co. v. Jefferson Elec. Co., 317 U.S. 172, 176 (1942). The Copyright Act has preempted state protection of literary property at least insofar as all published works covered by the federal statute are concerned. Thompson v. Hubbard, 131 U.S. 123, 151 (1889); Banks v. Manchester, 128 U.S. 244, 251–52 (1888); Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 663–64 (1834);

by adopting the Patent-Copyright Clause the Founding Fathers intended to create uniformity in the law of copyright and to limit in some way the duration of the monopoly granted authors. As a consequence, any state statute or decision which interferes with either of these two policies underlying the federal legislation would violate the Supremacy Clause of the Constitution.

Numerous members of the Judiciary [84] and the Copyright Bar,[85] following upon the above reasoning, point out that a state court through the concept of "limited publication" may subvert the policies which underly the Patent-Copyright Clause by granting to an author copyright protection in perpetuity. Therefore, it is suggested by them that the issue of publication is a federal question, that is, the issue of publication should be decided in light of the constitutional mandate for uniformity of decision and against perpetual protection of literary property.

Perhaps the most eloquent of the spokesmen in favor of applying federal standards to the issue of publication was the late Judge Learned Hand. In a dissenting opinion in *Capitol Records, Inc. v. Mercury Records Corp.*,[86] Judge Hand stated that if the states could decide whether a work was published,

> it would then follow that they could grant to an author a perpetual monopoly, although he exploited the "work" with all the freedom

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accord, Metro-Goldwyn-Mayer Distribution Corp. v. Bijou Theatre Co., 59 F.2d 70, 74 (1st Cir. 1932).

[84] International News Serv. v. Associated Press, 248 U.S. 215, 250 (1918) (dissenting opinion by Mr. Justice Brandeis); Shapiro, Bernstein & Co., Inc. v. Miracle Record Co., Inc., 91 F. Supp. 473, 475 (N.D. Ill. 1950); *accord*, Blanc v. Lantz, 83 U.S.P.Q. 137, 139 (Cal. Super. Ct. 1949).

[85] *See* S. Bricker, *Thirty Months After Sears and Compco*, 14 BULL. COPYRIGHT SOC'Y 293, 301 (1967); B. Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 479 (1955); M. NIMMER, COPYRIGHT LAW 230 (1967). *Contra*, H. Kalodner and V. Vance, *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1094 (1959).

[86] 221 F.2d 657 (2d Cir. 1955).

he would have enjoyed, had it been copyrighted [under the federal statute]. . . . 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. . . . I would hold that the [Copyright] clause has that much effect ex proprio vigore; and that the states are not free to follow their own motions as to when an author's right shall be unlimited . . . in duration. . . . I submit that, once it is settled that a work is . . . [a "Writing"], the Clause inforces upon the author the choice I have just mentioned; and, if so, *it must follow that it is a federal question whether he has published the "work."* [87]

In two recent cases the Supreme Court has given substantial support to the proposition that publication is a federal, and not a state, question. In the first case, *Sears, Roebuck & Co. v. Stiffel Co.*,[88] the plaintiff based his relief on two counts: (1) infringement of a design patent and a utility patent granted under federal law and (2) unfair competition under Illinois law. The lower federal courts found that plaintiff's two patents were invalid, but granted the plaintiff relief in the form of an injunction based upon Illinois unfair competition law. The Supreme Court reversed the decision holding that a state could not, consistent with the Supremacy Clause of the Federal Constitution, give protection of a kind that clashes with the objectives of federal policy, whether by state unfair competition law or any other state law. Although referring to patent law, Mr. Justice Black's statements in the case are equally applicable to copyright.

To allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public. The result would be that while federal law grants only 14 or 17

[87] *Id.* at 667 (emphasis added). *See* R.C.A. Manufacturing Co. v. Whiteman, 114 F.2d 86, 89 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940); Cheney Bros. v. Doris Silk Corp., 35 F.2d 279, 280 (2d Cir. 1929), *cert. denied*, 281 U.S. 728 (1930).

[88] 376 U.S. 225 (1964).

years' protection to genuine inventions . . . , States could allow perpetual protection to articles too lacking in novelty to merit any patent at all under federal constitutional standards. This would be too great an encroachment on the federal patent system to be tolerated.[89]

In a sister patent case, *Compco Corp. v. Day-Brite Lighting, Inc.*,[90] upon essentially the same facts as the *Sears* case, Mr. Justice Black more directly applied the *Sears* holding to copyright law.

> Today we have held in Sears . . . that when an article is unprotected by a patent or *copyright*, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I, § 8, Cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and *copyright* laws leave in the public domain.[91]

While most of the copyright decisions following upon the *Sears* and *Compco* cases either have attempted to construe narrowly the broad language of the Supreme Court [92] or have sought to distinguish the cases' application to copyright as dictum,[93] the United States Court of Appeals for the Ninth

[89] *Id.* at 232. In a footnote in the written decision of this case Mr. Justice Black emphasized the federal policy of achieving national uniformity in the law of copyright, implying that federal, that is, constitutional, standards should be used to determine whether a "Writing" may be protected by either state or federal law consistent with federal policies. *Id.* at 231 n.7.

[90] 376 U.S. 234 (1964).

[91] *Id.* at 237 (emphasis added).

[93] *See* Edgar H. Wood Associates, Inc. v. Skene, 347 Mass. 351, 356, 197 N.E.2d 886, 890 (1964); Capitol Records, Inc. v. Greatest Records, Inc., 43 Misc. 2d 878, 880–81, 252 N.Y.S.2d 553, 557 (1964) (court reaffirmed the majority opinion in Capitol Records, Inc. v. Mercury Records Corp., note 86 *supra*, and thereby refused to support Judge Hand's argument in favor of applying constitutional standards to the issue of divestive publication); Columbia Broadcasting Sys., Inc. v. Documentaries Unlimited, Inc., 42 Misc. 2d 723, 726–27, 248 N.Y.S.2d 809, 812 (1964); Flamingo Telefilm Sales, Inc. v. United Artists Corp., 141 U.S.P.Q. 461 (N.Y. Sup. Ct. 1964), *remand to amend complaint*, 22 App. Div. 2d 778, 254 N.Y.S.2d 36 (1964), *aff'd*, 24 App. Div. 953, 265 N.Y.S.2d 444 (1965) (plaintiff changed his original pleading from one based on copyright "misappropriation" to a cause of action based on common-law conversion).

[93] Pottstown Daily News Publishing Co. v. Pottstown Broadcasting Co., 247 F. Supp. 578, 580–81 (E.D. Pa. 1965).

Circuit in *Cable Vision, Inc. v. KUTV, Inc.*[94] indicated its willingness to apply the broad language of *Sears* and *Compco* to the copyright field.

> As we read Sears and Compco . . . only actions for copyright infringement *or such common-law actions as are consistent with the primary right of public access to all in the public domain will lie.*
>
> In Compco, the court emphasized that the federal policy found in Art. I, § 8, Cl. 8 of the Constitution and in the implementing federal statutes is to allow ". . . free access to copy whatever the federal patent and copyright laws leave in the public domain. . . ." The public domain was broadly delineated in Sears: that which is either not copyrighted [under the federal statute], not copyrightable or on which the copyright has expired is in the public domain. . . . Thus when an article is unprotected by a patent or copyright, state law may not forbid a person not the originator to merely copy and commercially exploit that article, for such a law would enable the originator to accomplish with the left hand of state authority what he was unable to accomplish with the right hand bearing the authority of the primary federal interest. . . . No state intrusion of the federal field is permissible unless the law of the state meshes in purpose and effect with the announced objectives of federal copyright law. . . . *A limited ambit of operation is accorded state law but it may be exercised only insofar as consistent with the paramount federal interest.*[95]

From the discussion above, it is probable that the United States Supreme Court would favor the proposition that the issue of publication should be determined only by application of the constitutional standard of limiting the duration of protection of a writing protected by the federal statute. If such is the case, motion pictures, which are specifically protected under the federal statute,[96] could not be granted copyright

[94] 335 F.2d 348 (9th Cir. 1964), *cert. denied*, 379 U.S. 989 (1965).

[95] *Id.* at 350–51 (citations omitted and emphasis added); *accord*, Columbia Broadcasting Sys., Inc. v. De Costa, 377 F.2d 315, 319 (1st Cir. 1967), *cert. denied*, 389 U.S. 1007 (1968) (court cited with approval Judge Hand's argument in applying constitutional standards to the field of copyright protection in Capitol Records, Inc. v. Mercury Records Corp., note 81 *supra*).

[96] The motion picture is specifically covered both as a published work [17 U.S.C. § 10 (1964)] and as an unpublished work [17 U.S.C. § 12 (1964)]. Motion pictures were not mentioned in the Copyright Act until three years

protection in perpetuity under either state or federal law. The courts would be forced, under the constitutional mandate, to find a divestive publication at some point in the distribution chain of a commercially leased motion picture; otherwise, the majority of motion pictures, intended by Congress to be protected for only "limited Times," could avoid that constitutional limitation.

Assuming the correctness of this analysis, the courts would be confronted with the problem of finding the point in time along the distribution chain of a commercially leased motion picture that would be most appropriate to divest common-law protection. Because of the long line of cases mechanically holding that public performance does not constitute a general publication,[97] the courts would probably not find that the exhibition of a motion picture would constitute a divestive publication. The courts could more easily find a divestive publication of a motion picture when the film is actually leased by the distributor, since there is considerable doubt whether a divestiture does not take place at that point in the distribution chain.[98]

MOTION-PICTURE PUBLICATION UNDER THE REVISION BILL

The concept of publication remains important to the duration of protection of motion pictures under the Revision Bill.[99] Under the Bill motion pictures are again specifically covered by federal copyright protection,[100] but the scope of

after the Act's original enactment in 1909. 37 Stat. 488 (1912). A claim to copyright for a motion-picture photoplay is registered under Class *L* (Class *LP* for published and Class *LU* for unpublished motion-picture photoplays), and a claim to copyright for a motion picture other than a photoplay is registered under Class *M* (Class *MP* for published and Class *MU* for unpublished nonphotoplay motion pictures). 17 U.S.C. §§ 5(1) and 5(m) (1964).

[97] *See* cases cited notes 21, 22, and 23 *supra*.

[98] *See* note 32 *supra*.

[99] H.R. 2512, 90th Cong., 1st Sess. (1967); S. 597, 90th Cong., 1st Sess. (1967) [hereinafter cited as Bill].

[100] Bill § 102 (6).

the term, *motion picture,* was broadened to include certain related communication devices.[101]

Generally, a work covered under the Bill created on or after the effective date of the Bill would be granted federal copyright protection from the time the work was created to fifty years after the author's death.[102] However, for works made for hire [103] the protection would endure for a term of seventy-five years from the year of the work's first publication, or for a term of one hundred years from the year of its creation, whichever expired first.[104] Since a motion picture is generally considered a work made for hire,[105] the motion-picture industry will still be haunted by the concept of publication under the Bill.

The term *publication,* a definition of which is not in the present Copyright Act,[106] is specifically defined in the Bill. " 'Publication' is the distribution of copies or phonorecords of a work to the public by sale or other transfer of ownership, or by rental, lease, or lending." [107]

Although the drafters of the Bill had originally attempted to include the public performance of a work as an action divesting common-law protection,[108] there were sufficient

[101] *See* HOUSE COMM. ON THE JUDICIARY, 89TH CONG., 1ST SESS., COPYRIGHT LAW REVISION—PART 6, at 5 (Comm. Print 1965) [hereinafter cited as COPYRIGHT LAW REVISION—PART 6]; H.R. REP. NO. 83, 90th Cong., 1st Sess., at 16 (1967).

[102] Bill § 302 (a).

[103] A "work made for hire" is defined as "(1) a work prepared by an employee within the scope of his employment; or (2) a work specially ordered or commissioned for use as a contribution to a collective work, *as a part of a motion picture* . . . , if the parties expressly agree in a written instrument signed by them that the work shall be considered a work for hire." Bill § 101 (emphasis added). *See also* COPYRIGHT LAW REVISION—PART 6, at 67–68 (1965).

[104] Bill § 302 (c).

[105] Zahler v. Columbia Pictures Corp., 180 Cal. App. 2d 582, 589, 4 Cal. Rptr. 612, 617 (1960); Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theatre Co., 59 F.2d 70, 77 (1st Cir. 1932).

[106] *See* note 5 *supra.* [107] Bill § 101.

[108] HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS., REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 40 (Comm. Print 1961).

objections lodged against the use of *public dissemination* as a substitute for *publication*[109] that the words were dropped.[110] As a consequence, the mere public performance or exhibition of a motion picture is not a publication under the Bill.[111]

The biggest problem with the new definition of *publication* in the Bill revolves around the words *to the public*. Under the definition, in order for there to be a publication of a motion picture, the film must be sold, had its ownership transferred, be rented, leased, or loaned *to the public*. However, as stated above, motion pictures are normally leased only and then only to exhibitors who may not be considered the "public."

Abraham L. Kaminstein, Register of Copyrights, in his report on the Bill stated that the *public* referred to in the definition

> is intended, very generally, to refer to persons who are under no express or implied restrictions with respect to the disclosure of a work's contents, but we believe that the situations here are so variable that this particular concept of "the public" is better left undefined in the statute.[112]

It might appear from this statement of Mr. Kaminstein that the concept of limited publication in relation to motion pictures would still have considerable life under the Bill and

[109] See HOUSE COMM. ON THE JUDICIARY, 88TH CONG., 1ST SESS., DISCUSSION AND COMMENTS ON REPORT OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW, COPYRIGHT LAW REVISION, PART 2, at 74–75, 229, 261 (Comm. Print 1963).

[110] HOUSE COMM. ON THE JUDICIARY, 89TH CONG., 1ST SESS. COPYRIGHT LAW REVISION, PART 6, at 82–83 (Comm. Print 1965).

[111] H.R. Rep. No. 83, 90th Cong., 1st Sess., at 105 (1967); *see* COPYRIGHT LAW REVISION, PART 6, *supra* note 110, at 91. HOUSE COMM. ON THE JUDICIARY, 88TH CONG., 2D SESS., PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW AND DISCUSSIONS AND COMMENTS ON THE DRAFT, COPYRIGHT LAW REVISION, PART 3, n.14 at 18 (Comm. Print 1964). *See also* HOUSE COMM. ON THE JUDICIARY, 88TH CONG., 2D SESS. COPYRIGHT LAW REVISION, PART 4, FURTHER DISCUSSIONS AND COMMENTS ON PRELIMINARY DRAFT FOR REVISED U.S. COPYRIGHT LAW [hereinafter cited as COPYRIGHT LAW REVISION, PART 4], at 22 (1964) (exhibition by television broadcast intended not to be a publication).

[112] COPYRIGHT LAW REVISION, PART 6, at 91 (1965).

that there would be no resolution of the indefiniteness that presently plagues this area of the law.

However, Mr. Kaminstein, in a statement made prior to the one cited above, specifically applied the definition of *publication* under the Bill to motion pictures and testified that the word *rental* in the definition was intended to include the rental of motion pictures as an action constituting publication under the Bill.[113] Based on this expressed intention of the drafters of the Bill, the courts would probably find that a sale, a change of ownership, a rental, a lease, or a loan of a motion picture to exhibitors would be a publication under the section 101 definition of the Bill.

CONCLUSION

In summary, none of the three arguments under the existing case law alone is conclusive on whether a commercial leasing of a motion picture would constitute a divestive publication. But it is submitted that the three arguments taken together would lead courts to find that there is no divestiture of common-law rights to a motion picture when a film is commercially leased to exhibitors. The *O'Neill*[114] and *Brandon*[115] cases directly support this conclusion; and while the *Blanc* case[116] appears to support a contrary position, its holding will probably not be followed because of the doubt surrounding the case (even in light of the discussion above[117]).

The *Jewelers'* case,[118] although cited frequently for the proposition that publication of a motion picture takes place

[113] COPYRIGHT LAW REVISION, PART 4, at 24 (1964). *See also* H.R. REP. No 83, 90th Cong., 1st Sess., at 105 (1967).

[114] O'Neill v. General Film Co., 171 App. Div. 854, 157 N.Y.S. 1028 (1916).

[115] Brandon Films, Inc. v. Arjay Enterprises, Inc., 33 Misc. 2d 794, 230 N.Y.S.2d 56 (Sup. Ct. 1962).

[116] Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

[117] *See* text accompanying notes 41 through 47 *supra.*

[118] Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Pub. Co., 155 N.Y. 241, 49 N.E. 872 (1898).

when prints are commercially leased, is insufficient to support that proposition because the *Dodge* cases,[119] on approximately the same facts, came to a contrary conclusion. The "ticker tape" cases,[120] on the other hand, although not controlling on the issue, are certainly persuasive support for this author's conclusion.

It is submitted, however, that the reasoning used by the Supreme Court in the *Sears* [121] and *Compco* [122] cases will eventually prevail on the publication issue. This opinion is based on the assumption that the Supreme Court fully intended to use the broad language that it, in fact, did use. And although no precedent directly supports this contention, the Ninth Circuit Court of Appeals in the *Cable Vision* case [123] indicated a trend in that direction. Nevertheless, courts have presently been unwilling to apply fully the *Sears* and *Compco* language, and therefore, it cannot be stated at this time that an argument based on the constitutional aversion to perpetual copyrights would prevail.

As stated earlier, the Revision Bill may resolve the legal ambiguity presently surrounding the issue of publication as applied to motion pictures.[124] However, because the testimony regarding the expressed intention of Congress on this issue is so meager, it is suggested that Congress in future hearings on a copyright bill should attempt to delineate more specifically if or when a commercially based motion picture is published.

[119] F.W. Dodge Co. v. Construction Information Co., 183 Mass. 62, 66 N.E. 204 (1903); F.W. Dodge Corp. v. Comstock, 140 Misc. 105, 251 N.Y.S. 172 (1931).

[120] Board of Trade of Chicago v. Hadden-Krull Co., 109 F. 705 (E.D. Wis. 1905); Board of Trade of Chicago v. Tucker, 221 F. 305 (2d Cir. 1915).

[121] Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964).

[122] Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964).

[123] Cable Vision, Inc. v. KUTV, Inc., 335 F.2d 348 (9th Cir. 1964), *cert. denied*, 379 U.S. 989 (1965).

[124] *See* note 113 *supra*.

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Number Twenty-Four

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MEMORIAL COMPETITION

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Foreword

LAWYERS HAVE always been viewed by the general public with some suspicion, even hostility. The legal system, as constructed by lawyers in the interest of a stable social order, has come under equal attack. Campus dissent, Vietnam protest, and concern about ever-rising crime rates have triggered new dissatisfactions with the inability of lawyers to bring order out of seeming chaos.

In a period when the social order seems particularly tangled and rootless for lack of agreed-upon values, it is a special pleasure to read the excellent papers submitted for the Nathan Burkan Memorial Competition in the thirty-sixth year of sponsorship by the American Society of Composers, Authors and Publishers. The opportunity to review the submissions offers satisfaction of at least two kinds.

First it is comforting to know that the law of copyright, while of course subject to many of the same pressures and vicissitudes of the turbulent world outside, nonetheless manages to preserve an element of balance and stability. The efforts of the great world powers to achieve détente and more are reflected in the arena of copyright by concern about the consequences of adherence by the USSR to the Universal Copyright Convention; but there is a sanity and a logic in the debate about issues that are clearly set forth in two of this year's winning papers. Similarly, copyright problems created

by the explosion in technology in the media and in reprography can be dealt with in orderly manner in courts and legislatures. These issues are explored in other winning papers.

Second, it is particularly gratifying for legal educators, as are all this year's judges, to have the privilege of reading so many fine papers from almost half the law schools in the country. To read these papers is to know that the law schools must be doing something right. The next generation of clients will be well represented if the authors of these papers are at all representative of their colleagues, which we hope and believe is the case.

Among the many fine submissions for the competition, we were pleasantly surprised to find that we could readily agree on these five, even on the order of their merit.

All five of the prizewinning papers provide useful insights into matters of topical significance. Interestingly, both the first- and third-place winners deal with the Soviet adherence to the Universal Copyright Convention. Michael A. Newcity of George Washington University, whose paper we consider the best, wrote on *The Universal Copyright Convention as an Instrument of Repression: The Soviet Experiment.** The third prize goes to Robert J. Jinnett of the Cornell Law School for his paper entitled *Adherence of the USSR to the Universal Copyright Convention: Defenses Under U.S. Law to Possible Soviet Attempts at Achieving International Censorship.*

As second-place winner we selected a careful study of the problems of state freedom to regulate versus federal preemption, the issue most sharply raised by the *Goldstein* case. The author, Edward Samuels of the Columbia Law School, calls his paper *Goldstein v. California: Breaking Up Federal Copyright Preemption.*

* It is pleasant to report that his instructor in copyright law was George D. Cary, former Register of Copyrights, now a Professorial Lecturer at George Washington Law Center.

The fourth-place winner, Val D. Greenwood of the University of Idaho, wrote on *Fair Use and Photocopy*, a fine comment on the problems raised by *Williams & Wilkins*. Although the matter is before the Supreme Court at this writing, we concluded that this paper has a value independent of the ultimate decision.

Finally, for the fifth prize we were particularly attracted by the contribution of Timothy M. Sheehan, *Why Don't Fine Artists Use Statutory Copyright?—An Empirical and Legal Survey*. It is a particularly lively treatment of a fresh subject, which, like all the others, we commend to the careful attention of all friends of copyright.

JEFFERSON B. FORDHAM
PROFESSOR OF LAW, UNIVERSITY OF UTAH

W. PAGE KEETON
PROFESSOR OF LAW, UNIVERSITY OF TEXAS

ROBERT B. MCKAY
DEAN, NEW YORK UNIVERSITY SCHOOL OF LAW

Preface and Dedication

FROM ITS inception in 1938, the Nathan Burkan Memorial Competition has had much encouragement and enthusiastic support from law school deans throughout the country. To insure impartiality in the conduct of the Competition at each law school, its administration is placed completely in the dean's hands.

After the winning papers are chosen at each law school, the five best papers are selected by a panel of outstanding participants in the judicial, educational, legislative or administrative life of our nation. For this volume, the Competition was fortunate to have the papers judged by three professors of law who had made outstanding records as law school deans; and it is most fitting that this volume be dedicated to them and their fellow deans who have encouraged students to participate in the Competition, have supervised the judging of the papers submitted, and have made the Nathan Burkan Competition a vital force in developing the law of copyright in America.

Jefferson B. Fordham, a graduate of the Yale Law School, has had a long and distinguished career as a law school professor and dean. After serving as Dean of Ohio State University Law School, he became Dean of the University of Pennsylvania Law School, a post he held with distinction for eighteen years until 1972, when he was named Dean

Emeritus. He has continued teaching at the University of Utah.

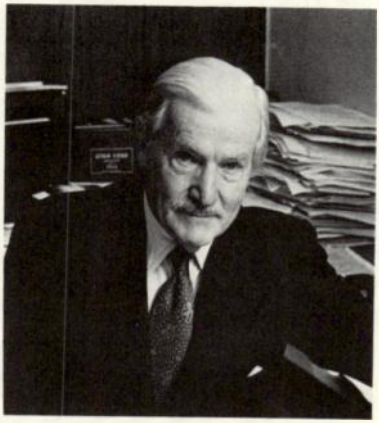
Page Keeton, a graduate of the University of Texas School of Law, also has a long history of public service and commitment to legal education. After serving as Dean of the University of Oklahoma Law School, he returned to his alma mater, where he held the deanship for twenty-five years, becoming Dean Emeritus in 1975. His contributions to the law are summarized in tributes appearing in Volume 52 of the University of Texas Law Review which was dedicated to him. The students at the University of Texas law school continue to have the benefit of his instruction.

Robert B. McKay is a graduate of the Yale Law School. In addition to his legal teaching, he has had a distinguished career of public service, chairing many governmental commissions. He served as Dean of the New York University School of Law for eight years, and retired to become Director of the Program on Justice, Society and the Individual for the Aspen Institute for Humanistic Studies, a post which he now holds.

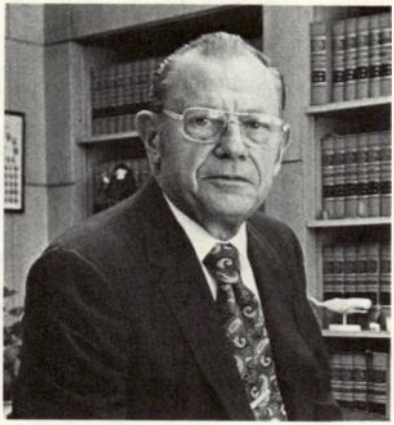
All three members of the panel have been active in the Association of American Law Schools, Deans Keeton and Fordham having served as Presidents of the Association and Dean McKay as a member of the Executive Committee.

The Competition is honored to have had three such distinguished law school deans serve as judges of the papers selected for Volume 24. We salute them as representative law school deans in dedicating this volume to all the deans of our country's law schools.

HERMAN FINKELSTEIN



JEFFERSON B. FORDHAM



W. PAGE KEETON



ROBERT B. MCKAY

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Rules Governing the Competition

1. *Participating Law Schools:* All accredited law schools are invited to participate in the Competition.
2. *Eligible Students:* Third-year students. In the discretion of the dean, second-year students also may be eligible.
3. *Subject Matter:* Any phase of *copyright law.*
4. *Determination of Awards:* The prizes will be awarded to the students who shall, in the sole judgment of the dean—or such other person or committee as he may delegate—prepare the two best papers. The dean may in his discretion withhold the awards entirely, if in his opinion no worthy paper is submitted, or may award only the first or second prize.
5. *Prizes: A first prize of $250* and a *second prize of $100*, to be paid through the dean, upon his written certification.
6. *Formal Requirements, Right of Publication, etc.:*
   (a) Manuscript must be typewritten (double-spaced on 8½″ × 11″ paper, 1″ margin all around; indent and single space all quotations exceeding four lines.
   (b) Manuscript must not exceed 50 pages.
   (c) Citations must be in approved law review form.
   (d) Submit *two* copies of manuscript.
   (e) Cover for manuscript: any standard form stiff cover with label on outside showing title of paper, your name, and permanent *home address.*
   (f) Two copies of winning papers will be forwarded by the dean to the Society, which may authorize publication.
   (g) Papers may appear in law review, provided their entry in the Nathan Burkan Memorial Competition is duly noted.
7. As papers are presumed to represent individual study, collaboration with others in their preparation is not permitted.
8. *Closing Date:* August 15th—or any earlier date the dean may specify. Winning papers must be certified to the Society not later than August 31st.
9. *National Awards:* The best papers certified to the Society will be selected for National Awards of *$1,500, $1,000, $750, $500* and

$250, respectively. The award papers selected by the judges will be printed in the form of a "Copyright Law Symposium."

Questions concerning the Competition may be addressed to the Director of the Competition, Herman Finkelstein, One Lincoln Plaza, New York, N.Y. 10023.

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Number Twenty-Four

NATIONAL FIRST PRIZE, 1974

The Universal Copyright Convention as an Instrument of Repression: The Soviet Experiment

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> [A] system of copyright protection expressed in a universal convention . . . will ensure respect for the rights of the individual and encourage the development of literature, the sciences and the arts . . . [and] will facilitate a wider dissemination of works of the human mind and increase international understanding. . . .[1]

THE HOPE expressed by the drafters of the Universal Copyright Convention ["the Convention"]—that an international regime for the protection of copyrights would stimulate the development and exchange of the products of intellectual labor—has until recently gone unchallenged. The notion that a member state could or would use the Convention to suppress rather than promote the dissemination of literary and artistic works would have been regarded as little more than ludicrous. But the adherence to the Convention by the Union of Soviet Socialist Republics in early 1973 has raised in the

[1] Universal Copyright Convention (Preamble), Sept. 6, 1952, [1955] 6 U.S.T. 2731, T.I.A.S. No. 3324, 216 U.N.T.S. 132 (effective Sept. 16, 1954) [hereinafter cited as the Convention].

minds of many observers the possibility that the Convention's provisions could be used for just such a purpose—the suppression of the writings of internal dissidents.[2]

The Soviet government acceded to the Convention on February 27, 1973, when its foreign minister, Andrei Gromyko, deposited the formal documents of adherence to the 1952 Universal Copyright Convention at UNESCO headquarters in Paris.[3] This action caused great consternation in American publishing circles. It was widely feared that Soviet adherence to the Convention was merely a subtle subterfuge to enable the Soviet government to prevent the publication abroad of the works of their internal dissidents.[4] Many people, both in the United States and elsewhere, believe that Soviet adherence to the Convention would entitle Soviet government agencies to enlist the aid of American courts in their attempts at international censorship.[5]

The creation in September 1973 of an All-Union Agency on Copyrights to administer the USSR's new responsibilities under the Convention has done nothing to reassure American observers.[6] Legislation to counteract the feared application

[2] *See, e.g.*, N.Y. Times, Mar. 21, 1973, at 44, col. 1; N.Y. Times, Mar. 22, 1973, at 55, col. 6; Wagner, *Authors, Publishers Deplore Soviet Moves to Curb Dissident Writers by Copyright Laws*, 203 PUBLISHERS WEEKLY, Mar. 26, 1973, at 47; Dawid, *Basic Principles of International Copyright*, 21 BULL. COPYRIGHT SOC'Y 1, 18 (1973); *Bid to Ban "Gulag" in U.S. Is Doubted*, N.Y. Times, Dec. 31, 1973, at 6, col. 4; and *Solzhenitsyn is Safe: How About the Others?* 205 PUBLISHERS WEEKLY, Feb. 25, 1974, at 61.

[3] The official announcement of Soviet adherence to the Convention appears at UNESCO COPYRIGHT BULL., Nos. 2–3 (1973), at 3.

[4] *See* articles cited in *supra* note 2. See also Murarka, *Copyright the Kremlin*, 85 NEW STATESMAN, No. 2186, Feb. 9, 1973, at 189; Louis, . . . *And Its Royalties for the West, Too*, London Evening News, Feb. 23, 1973, at 1, col. 1; Bethell, *Authors' Rights, or Authors Wronged?*, The Times (London), Mar. 2, 1973, at 14, col. 1; Miami Herald, March 17, 1973 § E, at 1, col. 6; N.Y. Times, Mar. 18, 1973, at 5, col. 1; N.Y. Times, Mar. 22, 1973, at 55, col. 6; Astrachan, *Concern Voiced in U.S. at Soviet Copyright Law*, Washington Post, Mar. 23, 1973, § A, at 14, col. 1; Saxon, *U.S. Authors Ask a Bar to Soviet*, N.Y. Times, Mar. 25, 1973, at 17, col. 1; and Wall Street Journal, Mar. 29, 1973, at 14, col. 1.

[5] *See generally* sources cited in *supra* notes 2 and 4.

[6] Pace, *supra* note 2. The creation of the Agency is discussed in N.Y. Times, Sept. 21, 1973, at 3, col. 1. *See also infra* notes 57–59 and accompanying text.

of the Convention has been introduced in both houses of Congress.[7] In addition, American publishing organizations have discussed retaliatory tactics.[8] Thus far, Soviet intentions are unclear. More importantly, there has been little attempt to assess the legal ability of the Soviet government to actually use the Convention to prevent publication in the West of the works of internal dissidents.[9] This study will attempt to answer some of the questions raised by Soviet adherence to the Convention.

I. BACKGROUND

Soviet adherence to the Convention marked the end of a century-long policy of Russian avoidance of international copyright relations.[10] Since the first international agreements protecting copyrights were concluded in the first half of the nineteenth century successive Russian governments—tsarist as well as Communist—have steadfastly refused to align themselves with any of the multinational pacts created to ensure international protection for intellectual property,[11] and, with rare exceptions, the Russians have refused to conclude bilateral copyright treaties. In 1861 the tsarist government concluded [12] such a bilateral agreement with France.[13]

[7] S. 1359, 93d Cong., 1st Sess. (1973), and H.R. 6214, 93d Cong., 1st Sess. (1973). S. 1359 has subsequently been incorporated into S. 1361, 93d Cong., 2d Sess. (1974), the general copyright revision bill.

[8] Astrachan, *supra* note 4. *See also Congress Gets Copyright Bill; Firm U.S. Action Sought*, 203 PUBLISHERS WEEKLY, Apr. 9, 1973, at 42.

[9] The most exhaustive study of the recent changes in Soviet copyright law and their implications for the U.S.—BAUMGARTEN, U.S.-U.S.S.R. COPYRIGHT RELATIONS UNDER THE UNIVERSAL COPYRIGHT CONVENTION (1973)—never discusses the question.

[10] Lacy, *Breaking Faith with the Tsars*, WORLD, May 22, 1973, at 15.

[11] 1 GSOVSKI, SOVIET CIVIL LAW 608 (1948).

[12] At one point the Soviet government's official position concerning this treaty was that it was forced on Russia as a result of their defeat in the Crimean War. 37 BOL'SHAYA SOVYETSKAYA ENTSIKLOPEDIYA [LARGE SOVIET ENCYCLOPEDIA] 211 (1st ed. 1938).

[13] When this treaty's term of 25 years was over it was not extended. *Id.*

But when the other European nations attempted to regularize international copyright protection by agreeing to the Berne Convention of 1886, the Russian government remained aloof and refused to sign.[14]

In the years preceding the outbreak of World War I there was some indication that Russia might end this isolationist attitude. During a three-year period Russia signed four bilateral treaties for mutual copyright protection [France (1912), Germany (1913), Belgium (1915), and Denmark (1915)] and there were hints that she would accede to the Berne Convention.[15] These cautious steps, though, were quickly aborted; the treaties with France, Belgium, and Denmark were allowed to lapse after three years and were not renewed; the Russo-German treaty was abrogated by the Treaty of Versailles; [16] and the advent of World War I and the Revolution of 1917 ended any thought of adherence to the Berne Convention.[17]

The newly formed Soviet government regarded international copyright conventions with distrust; they were thought to be instruments to protect the profits of capitalist publishers, not the rights of authors and the reading public.[18] Thus, the Soviet government refused to participate in any bilateral or multilateral copyright pacts. This self-imposed isolation was maintained for over half a century.

[14] Gsovski, *supra* note 11, at 608.

[15] Levitsky, *Introduction to Soviet Copyright Law*, 8 L. in E. Eur. 1, 28–29 (1964).

[16] The Russo-German copyright treaty became ineffective during World War I but was revived by the Brest-Litovsk Treaty of 1917 ending hostilities between the two nations. The Treaty of Versailles of 1918, though, required that Germany consider all treaties with Russia annulled (art. 292). As of August 1, 1918, Russia was completely free of any international copyright obligations, Gsovski, *supra* note 11, at 608–9.

[17] Levitsky, *supra* note 15, at 28–29.

[18] *Supra* note 12, at 211. More recently the same sentiment was expressed in Mamontov, *O neprisoedinenii Sovetskogo Soyuza k mezhdunarodnym konventsiyam po okhrane avtorskikh prav* [On the non-adherence of the Soviet Union to international conventions on copyright law], Pravovedeniye, No. 4 (1962), at 131.

Though the Soviets rejected any international copyright protection, they developed a body of municipal copyright law that was specially adapted to the unique Russian situation. The cornerstone of this new Soviet theory of copyright was the doctrine of "freedom of translation." Even prior to the Bolshevik Revolution Russian copyright law had recognized the right of anyone to translate the works of foreign authors into Russian or any of the other languages spoken in the Empire.[19] By November 1918 the Soviet government had adopted as its own the principle of "freedom of translation," *i.e.*, that any work may be translated into another language without violating the copyright in that work.[20] The articulated rationale of this doctrine was the scope of the nationality problem in the Soviet Union. The multiplicity of languages spoken in the USSR (89 different languages) means that reservation of the translation right to the copyright proprietor and the requirement of the payment of royalties for any translation would make the dissemination of literature throughout the USSR a difficult and expensive proposition[21]—so much so that both the tsarist and Soviet governments have permitted "freedom of translation" to promote the dissemination of literature among their multilingual citizens. The Soviets claim that this allows the

[19] Gsovski, *supra* note 11, at 609.

[20] Boguslavsky, *Translation Rights in the Copyright Law of the Soviet Union*, 4 Int'l Rev. of Industrial Property and Copyright L. 352, 353 (1973). The doctrine of "freedom of translation" was recognized in all succeeding Russian copyright laws. Art. 4 of the 1925 Principles of the Law of Copyright and art. 9 of the 1928 Principles of the Law of Copyright provided: "Not regarded as a violation of copyright are: (a) translation of the writings of another into a different language. . . ." Kudriavtseva, *The Principle of Freedom of Translation in Soviet Copyright Law*, Vestnik Moskovskogo Universiteta [Bulletin of Moscow University], No. 1 (1970), trans. in 9 Soviet L. & Gov't. 159, 160 (1970), art. 102 of the 1961 Basic Principles of Civil Legislation provided that "every published work may be translated into another language without the consent of the author, provided that he is notified, on condition that the integrity and meaning of the work are preserved." *Id.*

[21] Boguslavsky, *supra* note 20, at 352; Kudriavtseva, *supra* note 20, at 167; and Ulmer, *Copyright Problems in Relations Between East and West*, 1 Int'l Rev. of Industrial Property and Copyright L. 32, 38 (1970).

promulgation of "progressive" culture in the USSR.[22] That the Soviet leaders are firm believers in the principle of "freedom of translation" is evidenced by the fact that since the 1917 Revolution the Soviet Union has become the largest publisher of translated works in the world.[23] Soon after its founding, the Soviet Union became as well the world's leading literary pirate, not only publishing in translation the creations of its own citizens but also publishing large numbers of copies of the works of Western authors both in translation and in the original language.[24]

It was precisely these facts that sparked so much interest in Soviet copyright law in the Western world. Such widespread pirating of the works of Western authors moved many individuals and organizations to try to persuade Soviet officials to adhere to international copyright agreements. Prime Minister Winston Churchill and President Franklin Roosevelt both discussed the matter directly with Joseph Stalin.[25] The International Confederation of Authors' and Composers' Societies,[26] Adlai Stevenson,[27] and Norman Cousins (publisher of *Saturday Review*) [28] all sought normalization of copyright relations between the USSR and the rest of the

[22] *Supra* note 12, at 211.

[23] Citing UNESCO statistics, Boris Stukalin, Chairman of the State Committee on Publishing Houses, Printing, and the Book Trade, made this claim in an interview. *Novoye perspektivy* [New perspectives], LITERATURNAYA GAZETA, No. 11, Mar. 14, 1973, at 3.

[24] Since the 1917 Revolution more than a billion copies of the works of Western authors have been published in the Soviet Union. Nehemkis and Schöllhammer, *International Business Transactions with the Soviet Union and Mainland China: Prospects and Hazards*, 28 THE BUS. LAWYER 17, 39 (1972). Between 1918 and 1960, 96.5 million copies of the works of 239 American authors were published in the Soviet Union. PISAR, COEXISTENCE AND COMMERCE 356–57 (1970).

[25] Levitsky, *supra* note 15, at 243.

[26] Nehemkis and Schöllhammer, *supra* note 24, at 39.

[27] Levitsky, *supra* note 15, at 243. Governor Stevenson's efforts are described in Iseman, *Governor Stevenson's Mission to Secure Payments to American Authors and Playwrights for Use of Their Works in the Soviet Union*, 7 BULL. COPYRIGHT SOC'Y 155 (1960).

[28] Astrachan, *Soviets Join Copyright System*, Washington Post, § H, at 1, col. 4. Cousins' account of his efforts appears in Cousins, *Of Rubles and Royalties*, SATURDAY REV. Sept. 5, 1959, at 26.

world, but their efforts met with little success. Attempts to resort to the Soviet judicial process to obtain payment for the use of Western literary creation in the USSR proved equally fruitless.[29] Throughout its history the Soviet Union had allowed royalties to be paid to various "progressive" Western authors such as Howard Fast, Louis Aragon,[30] Upton Sinclair, Lillian Hellman, and even Art Buchwald;[31] but such payments had been irregular, infrequent, and quite often made in inconvertible rubles.[32] The Soviets remained convinced that their municipal copyright law, with its piratical practices, was unique and fully justified by the dominant Communist ideology[33] and that the international copyright protection pacts were bourgeois creations, unsuitable for Soviet participation.[34] The Soviets were seemingly unalterably opposed to the establishment of any sort of reciprocal copyright relations with Western nations.

The first breach in this policy occurred in 1965 when the

[29] In 1958 Professor Harold J. Berman of Harvard University was retained by Adrian Conan Doyle as trustee of his father's estate to bring an action in Soviet courts to recover royalties for the use of the writings of Arthur Conan Doyle by Soviet publishers. It was claimed that Soviet publishers had published 71 different volumes of the Sherlock Holmes stories with 5 million copies being sold without the payment of any royalties to the Doyle estate. Berman, *Sherlock Holmes in Moscow*, 8 THE LAWYER 53 (1965). Professor Berman, arguing the case himself, contended that such publication without the payment of royalties constituted "unjust enrichment," which was barred by art. 399 of the Russian Soviet Federated Socialist Republic (RSFSR) Civil Code, a translation of which can be found in 2 GSOVSKI, SOVIET CIVIL LAW 206 (1949). The condensed translation of Berman's oral argument to the RSFSR Supreme Court appears in Berman, *infra* note 31. The court rejected this argument, saying that it was merely an attempt to circumvent the copyright statutes. See the English translation of the court's decision in Estate of Arthur Conan Doyle v. Ministry of Culture of the USSR et al. (Sup. Ct. R.S.F.S.R. 1959), in 7 BULL. COPYRIGHT SOC'Y 246 (1960). For a further discussion of the Sherlock Holmes case, see Levitsky, *supra* note 15, at 245–46.

[30] Astrachan, *supra* note 28.

[31] Berman, *Rights of Foreign Authors Under Soviet Law*, 7 BULL. COPYRIGHT SOC'Y 77 (1959).

[32] Astrachan, *supra* note 28.

[33] *See, e.g.*, M. GORDON, SOVETSKOYE AVTORSKOYE PRAVO [Soviet Copyright Law] 9 (1955).

[34] 25 LARGE SOVIET ENCYCLOPEDIA 232 (2d ed. 1954).

USSR, desirous of improving the efficiency with which modern technology was applied to Soviet industry,[35] joined the Paris Convention for the Protection of Industrial Property.[36] Two years later they widened the breach by signing a bilateral copyright protection agreement with Hungary, the first such pact entered into by a Russian government since before World War I.[37] This convention with Hungary was followed in 1972 by a similar agreement with Bulgaria.[38]

Why the Soviets decided to reject their well-established policy of avoiding international copyright obligations is unclear. But regardless of the reason, by the summer of 1972 Soviet officials were amenable to suggestions by Presidential Adviser Henry Kissinger that the USSR establish copyright relations with the United States.[39] Possibly spurred on by the atmosphere of rapprochement and the concomitant desire for greater cultural and economic ties, the Soviets complied and agreed to adhere to the 1952 Universal Copyright Convention.

On February 21, 1973, the Presidium of the Supreme Soviet of the USSR adopted a decree amending Soviet copyright law in order to bring their laws into compliance with the requirements of the Convention.[40] On February 27 they for-

[35] Clesner, *The Coordinated Soviet Effort to Promote and Apply Major Inventions*, 4 PAT., T.M., COPYRIGHT J. OF RESEARCH AND EDUC. 212, 213 (1960).

[36] According to Nehemkis and Schöllhammer this action can be attributed to the high priorities the Soviets have put on the acquisition of Western technology. *See* Nehemkis and Schöllhammer, *supra* note 24, at 37.

[37] An English translation of the USSR-Hungary Convention on the Reciprocal Protection of Copyright appears at 4 COPYRIGHT 63 (1968). The Convention is discussed in Ulmer, *supra* note 21, at 43–45.

[38] An English translation of the USSR-Bulgaria Agreement on the Reciprocal Protection of Copyright appears at 8 COPYRIGHT 163 (1972).

[39] Wagner, *Currents: We Have Things the Russians Want*, 203 PUBLISHERS WEEKLY, Mar. 5, 1973, at 47.

[40] Decree of the Presidium of the USSR Supreme Soviet, On Making Changes in and Additions to the Principles of Civil Legislation of the USSR and the Union Republics, [1973] Ved. Verkh. Sov. S.S.S.R., Item 138 (Supreme Soviet U.S.S.R., No. 9, Feb. 28, 1973). An English translation of the decree appears in *U.S.S.R. Joins Copyright Convention*, 25 THE CURRENT DIGEST OF THE SOVIET PRESS, Apr. 11, 1973, at 7–9. Another translation, by the World Intellectual Property Organization, appears at 9 COPYRIGHT 162–63 (1973).

mally adhered to the Convention; their adherence became effective on May 27, 1973.[41]

II. PROVISIONS OF REVISED SOVIET COPYRIGHT LAW

The legislation promulgated by the Presidium of the Supreme Soviet of the USSR on February 21, 1973—Decree 138—amended the Principles of Civil Legislation of the USSR and the Union Republics as adopted on December 8, 1961.[42] Four basic changes were wrought by this legislation:

[41] Under art. IX of the Universal Copyright Convention the Convention comes into force three months after the ratifying nation deposits its formal documents of adherence with the Director-General of UNESCO, the organization which administers the Convention. Accordingly, on May 27, 1973, Soviet adherence to the Convention became effective. It should be pointed out that adherence to the Convention is not retroactive. Art. VII of the Convention provides that the Convention does not apply to works which are in the public domain in the contracting states at the effective date of the Convention. Thus, works published in the Soviet Union prior to May 27, 1973, can be published and/or translated elsewhere without payment of royalties to the Russian author or observance of the other formalities of the Convention; conversely, books published prior to that date in the West may be similarly published in the Soviet Union.

[42] A generalized review of the provisions and history of Soviet copyright law is beyond the scope of this study. Such a review may be found in Levitsky, *supra* note 15; and Woltmann, *The Author and the State: An Analysis of Soviet Copyright Law*, 14 ASCAP COPYRIGHT L. SYMPOSIUM 1 (1964). Art. 14 of the Soviet Constitution, KONSTITUTSIYA (OSNOVNOI ZAKON) [Constitution (Basic Law)] art. 14(h) (USSR, 1936), as amended in 1956, reserves to the Soviet Union the right to legislate "Principles," or "Fundamentals," of civil law and civil procedure. This provision constitutes the only dilution of the sovereignty of the Union Republics with respect to the initiation of legislation. In effect, Article 14 permits the Soviet Union to prescribe certain detailed standards to which the civil codes of the Union Republics must conform. On December 8, 1961, the Soviet Union through the Supreme Soviet utilized this authority and promulgated the Principles of Civil Legislation of the Soviet Union and the Union Republics. Decree of the Presidium of the USSR Supreme Soviet, On Approval of the Principles of Civil Legislation of the Soviet Union and the Union Republics, [1961] Ved. Verkh. Sov. S.S.S.R., Item 525 (Supreme Soviet USSR, No. 50, Dec. 8, 1961). An English translation of the Principles appears at 7 L. IN E. EUROPE 263–98 (1963). Beginning in 1963 the fifteen Union Republics began to issue new civil codes and codes of civil procedure, replacing those that had been enacted prior to 1940. The codes are identical on all major issues, differing only on minor points. Although the codes do not conform word for word with the Principles of Civil Legislation, they do conform as to the substance of the provisions.

(1) Translation rights. Article V of the Convention states that "copyright shall include the exclusive right of the author to make, publish, and authorize the making and publication of translations of works protected under this Convention." [43] To bring Soviet law into conformance with this broad protection of translation rights, Decree 138 amended article 102 of the Principles of Civil Legislation to provide:

> The translation of a work into a different language for the purpose of publication is permitted only with the consent of the author or his assignees. Competent USSR agencies can, according to a procedure established by USSR legislation, authorize the translation of a work into a different language and the publication of this translation, with the observance, where appropriate, of the terms of international treaties or international agreements to which the USSR is a party.[44]

The Soviet government seems finally to have disposed of the principle of "freedom of translation" and joined the rest of the world in acknowledging the right of an author to control the use of his work.

(2) Royalties. Concomitantly with an acknowledgment that an author has the right to control the translation of his work, the Soviet Union provided, in Decree 138, for the payment of royalties for the republication of works in the Soviet Union. As amended by Decree 138, article 101 of the Principles provides that:

> [U]se of an author's work (including a translation into a different language) by other persons is not permitted except on the basis of a contract with the author or his assignees, except in cases stipulated in the law.[45]

[43] The Convention, art. V, § 1. Section 2 of this article places certain restrictions on the right of translation which are irrelevant to the present inquiry.

[44] Compare this language with that of art. 102 prior to the 1973 amendments. See *supra* note 20 and articles cited therein. The pre-1973 requirement that the "integrity and meaning of the work" being translated be preserved was not carefully observed, as evidenced by the experience of playwright David Rabe. Rabe's controversial play *Sticks and Bones* was produced in an unauthorized Moscow production by the Taganka Theater. The distortions in the play so enraged Rabe that he wrote the producer: "I feel that you and your entire cast and crew spend the two hours of your performance each night spitting in my face." Wall Street Journal, *supra* note 4.

[45] Examples of works excepted: scientific and educational works and speeches to be reprinted in newspapers. See art. 103 of the amended Principles.

Thus, the authors of works published in the Soviet Union must be paid (albeit at standard rates established by the Soviet government) for the use of their works.

(3) Term of protection. In accordance with the requirements of article IV of the Convention the Soviet government extended the term of copyright protection afforded by Soviet legislation from the life of the author to his life and twenty-five years thereafter.[46]

(4) Assignment. Prior to the adoption of Decree 138 Soviet copyright legislation merely provided for the ownership of a copyright by the author and his heirs. Decree 138, though, amended several provisions to include the author's assignees among those who could exercise the rights of copyright proprietorship.

The revisions in Soviet copyright law discussed above were adopted in order to bring Soviet law within the minimum requirements of the 1952 Universal Copyright Convention.[47]

[46] The Convention, art. IV, § 2, provides: "The term of protection for works protected under this Convention shall not be less than the life of the author and 25 years after his death." In accordance with the Convention, art. IV, § 3, decree 138 provides for reduced terms for protection of copyrights on photographic works and works of applied art (art. 105 of the Principles).

[47] It should be pointed out that the Soviet Union acceded to the 1952 Universal Copyright Convention and not the version of the Convention as revised in Paris in 1971. The 1971 revisions provide, *inter alia*, for easier access to translations by developing nations. *See* Ulmer, *International Copyright After the Paris Revisions*, 19 BULL. COPYRIGHT SOC'Y 263 (1972). It is ironic that the Soviet Union should have evaded adhering to the revised Convention, since in acceding to the Convention the Soviet Union declared that art. XIII of the Convention (allowing colonial powers to apply the Convention to their possessions) was "out-dated and contrary to the Declaration of the General Assembly of the United Nations on the granting of independence to colonial countries and peoples . . . which proclaims the necessity of bringing to a speedy and unconditional end colonialism in all its forms and manifestations." *V sootvetsvii s programmoi mira* [In accordance with the program of peace], interview with B. I. Stukalin, NOVOYE VREMYA, No. 11, Mar. 16, 1973, at 14. The Soviet Union, by acceding to the Convention when it did, circumvented the revised version, which has yet to receive enough signatories to enter into force. It is reported, though, that Boris Stukalin, Chairman of the State Committee on Publishing Houses, Printing, and the Book Trade of the USSR, has acknowledged that the Soviet Union would "give the developing nations all possible advantages," including, in some cases, not being asked for royalties. Stukalin claimed that the Soviet Union's adherence to the 1952 version of the Convention was solely motivated by the provisions in the revised version concerning broadcasting

By itself, the Convention is an uncomplicated document which, in essence, requires that citizens of contracting states be accorded the same protection in other contracting states as is accorded that country's nationals. There are four provisions of the Convention which are pertinent to this inquiry.[48]

(1) National treatment. The concept of "national treatment" is the cornerstone of the Universal Copyright Convention. Article II of the Convention requires that both published and unpublished works be given the same measure of protection as the works of nationals of that country (or works first published in the territory of that nation).[49]

(2) Translation rights. The Convention requires minimum protection in only two areas: the duration of the protection (discussed below) and the right of the author with respect to translations of his works. With regard to this latter requirement the Convention is unusually strict. The author is given the exclusive right to "make, publish and authorize the making and publication of translations of works protected under this Convention." [50] Thus, under this provision any translation of a work appearing in a contracting state without the authorization of the copyright proprietor is unlawful (with a few narrow exceptions).[51]

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rights, which are not covered specifically in the 1952 text. Wagner, *Russians and Copyright: A Welcome Move, but a Host of Questions Remain*, 203 PUBLISHERS WEEKLY, No. 11, Mar. 12, 1973, at 32–33.

[48] This article will discuss only those provisions of the Convention which are pertinent to the question at hand. More detailed analyses of the Convention are contained in BOGSCH, THE LAW OF COPYRIGHT UNDER THE UNIVERSAL COPYRIGHT CONVENTION (3d ed. 1968), and UNIVERSAL COPYRIGHT CONVENTION ANALYZED (T. Kupferman and M. Foner ed. 1955).

[49] The Convention, art. II, § 1, provides: "Published works of nationals of any Contracting State and works first published in that State shall enjoy in each other Contracting State the same protection as that other State accords to works of its nationals first published in its own territory." The Convention, art. II, § 2, provides: "Unpublished works of nationals of each Contracting State shall enjoy in each other Contracting State the same protection as that other State accords to unpublished works of its own nationals."

[50] The Convention, art. V, § 1.

[51] BOGSCH, *supra* note 48, at 58.

(3) Formalities. Article III of the Convention provides that works first published outside a particular contracting state shall not be required to comply with formalities such as deposit, registration, notice, publishing, and other requirements before receiving copyright protection if, from the time of first publication, all copies of the work published "with the authority of the author" bear the familiar © symbol accompanied by the name of the copyright proprietor and the year of first publication.[52]

(4) Duration of protection. The Convention provides that the duration of the copyright protection accorded an author will be governed by the law of the contracting state in which protection is claimed, but in no case will the term of protection be less than the life of the author and twenty-five years after his death.[53]

The net impact of these and the other provisions of the Convention is to provide a relatively uniform, uncomplicated system for assuring copyright protection in over 60 countries throughout the world.[54]

The Soviet government's announcement of changes in Soviet copyright law and adherence to the Convention took by surprise many of the officials who would be expected to administer this law. One U.S. publishing industry representative, after touring the Soviet Union and conferring with publishing industry representatives, concluded that ". . . most Russian publishing chiefs were uninformed on, and unprepared for . . ." the decision to join the Convention.[55] Even in late May of 1973, as the Soviet adherence to the Conven-

[52] The Convention, art. III, § 1.

[53] The Convention, art. IV, §§ 1 & 2. Subsequent sections of this article provide certain exceptions to the life-plus-25-years rule, e.g., photographic works or works of applied art are required to be protected for a minimum of only ten years.

[54] At present, 64 nations are party to the Convention. A list appears at 19 C.F.R. § 133.31(c) (1974), with a supplementary list at 38 Fed. Reg. 21396 (1973).

[55] *Russia and UCC: How It Looks from Moscow*, 203 PUBLISHERS WEEKLY, May 14, 1973, at 31.

tion entered into force, few of the administrative problems connected with adherence were solved.[56]

It was not until late September 1973 that it was finally announced how the Soviet government would administer its responsibilities under the Convention. On September 21, 1973, the Soviet press reported the creation of a new government agency—the All-Union Agency on Copyrights (*Vsesoyuznoye agentstvo po avtorskim pravam*, or VAAP)—which would administer Soviet copyright relations both domestically and internationally.[57] The precise functions of this agency were elaborated in a subsequent interview with the chairman of the administrative board of the agency, B. D. Pankin.[58] The VAAP will conduct all negotiations between foreign publishers and/or copyright proprietors for the rights to Soviet works; the agency will calculate, collect, and distribute all royalties due Soviet and foreign artists for the use of their works in the USSR; and the VAAP will receive and distribute to Soviet authors any royalties they may earn for the use of their works abroad.[59]

At approximately the same time the Presidium of the Supreme Soviet of the USSR promulgated new tax legislation

[56] *Soviet Union Joins Copyright Nations*, N.Y. Times, May 28, 1973, at 6, col. 1. A spokesman for the domestic copyright office was quoted as saying that "absolutely nothing is yet decided" with regard to the administration of the Convention in the USSR. Neither the Committee on Publishing Houses, Printing, and the Book Trade, nor the Union of Soviet Writers, nor the Administration for Copyright Protection (the domestic copyright agency) was, as of May 27, 1973, able to answer questions concerning the administration of the Convention-imposed responsibilities. *Id.*

[57] Articles of varying lengths describing the creation of the VAAP appeared in Pravda, Sept. 21, 1973, at 3, col. 1; Izvestiya, Sept. 22, 1973, at 3, col. 6; Komsomolskaya Pravda, Sept. 21, 1973, at 1, col. 4; and Sovyetskaya Rossiya, Sept. 21, 1973, at 3, col. 4. The decision to create the new agency was made at a Sept. 20 meeting at which representatives of the Union of Soviet Writers, five other trade unions, the Academy of Sciences of the USSR, the Novosti Press Agency, and several other government agencies and committees participated.

[58] Pankin is a literary critic and journalist who, until recently, was editor-in-chief of Komsomolskaya Pravda, the official organ of the Soviet youth organization.

[59] *VAAP: tseli i zadachi* [VAAP: goals and tasks], LITERATURNAYA GAZETA, No. 39, Sept. 26, 1973, at 3.

covering income from royalties.[60] In the absence of a treaty obligation,[61] the rather high level of taxation included in this legislation will be applicable to the earnings of foreign authors receiving royalties for the use of their works in the Soviet Union as well as the earnings of Soviet citizens and domiciliaries. Some have taken this exorbitant tax scheme as an indication that the Soviets look on their adherence to the Convention as a relatively painless way to increase their reserves of hard currency.[62] At the very least, it seriously dims the prospects for the windfalls envisioned by many American publishers and authors upon learning of Soviet adherence to the Convention.

III. POLITICAL CONTENT OF SOVIET ADHERENCE

The Soviets have consistently maintained that their adherence to the Convention was motivated by a desire to enable greater segments of the world's population to become acquainted with the products of Soviet culture.[63] Further-

[60] Decree of the Presidium of the USSR Supreme Soviet, On the Income Tax for Sums Paid for the Publication, Performance, or Other Use of Works of Science, Literature, and Art, [1973] Ved. Verkh. Sov. S.S.S.R., Item 497 (Supreme Soviet USSR, No. 37, Sept. 12, 1973). This writer's English translation of the Decree appears at 12 INT'L LEGAL MATERIALS 1517 (1973).

[61] The United States and the USSR have recently negotiated and signed (but not ratified) a bilateral taxation treaty that would establish the principle of reciprocity as the cornerstone of tax relations between the two nations. By the terms of this treaty, American citizens earning royalties in the USSR would be taxed as if the income had been earned in the U.S., and Soviet authors would be taxed as if they had earned their royalties in the USSR. See the Convention, art. II, § 1(a), CONVENTION WITH THE UNION OF SOVIET SOCIALIST REPUBLICS ON MATTERS OF TAXATION, MESSAGE FROM THE PRESIDENT OF THE UNITED STATES, S. EXEC. T, 93d Cong., 1st Sess. (1973), [1973] 2 TAX TREAT. REP. (CCH) ¶¶ 7988–89.

[62] *See Soviet's Authors Facing Stiff Tax*, N.Y. Times, Sept. 28, 1973, at 8, col. 1.

[63] This formulation was repeatedly expressed in official pronouncements concerning Soviet adherence to the Convention. *See, e.g.*, Pravda, Mar. 10, 1973, at 4, col. 6; NOVOYE VREMYA, *supra* note 47; TASS broadcast on Mar. 7, 1973, 3 FOREIGN BROADCAST INFORMATION SERVICE, DAILY REPORT: SOVIET UNION, No. 45, Mar. 7, 1973, at A7; TASS broadcast on Mar. 9, 1973, 3 FOREIGN BROADCAST INFORMATION SERVICE, DAILY REPORT: SOVIET UNION, No. 48, Mar. 12, 1973, at A11; and Pravda, Oct. 2, 1973, at 6, col. 2.

more, they have suggested that this action was the organic product of the "program of peace and international cooperation adopted by the 24th Congress of the Communist Party of the Soviet Union" [64] that was manifested in General Secretary Brezhnev's trips to the United States and other Western nations.[65]

The Western reaction to the announcement of Soviet adherence to the Convention can only be described as skeptical. Initially the announcement was greeted as a long-overdue recognition of the responsibilities owed by the Soviet government to the authors and artists whose works were being published in the USSR without compensation.[66] Western intellectual circles welcomed the move, both because it promised royalties for their handiwork and also because it signified the end of senseless and destructive distortions in Russian translations appearing in the Soviet Union.[67] Not only would authors now receive royalties whenever their works were published or performed in the Soviet Union, but they would have authority over the translations themselves.

But as the details of the Soviet legislation became widely known a backlash in public opinion occurred. Many of those who had previously welcomed the Soviet move criticized it as an attempt to stifle Soviet dissident writers who publish their works in the West.[68] Professional organiza-

[64] Novoye Vremya, *supra* note 47.

[65] Pravda, Mar. 10, 1973, *supra* note 63.

[66] Lacy, *supra* note 10, at 15.

[67] A particularly senseless example of such distortion is reported by Dev Murarka in the New Statesman. The Taganka Theater in Moscow was producing Berthold Brecht's *Galileo Galilei*. Soviet officials deleted the famous and critical scene toward the end of the play when Galileo hands his manuscript over to his young disciple to smuggle out of prison. Murarka, *supra* note 4, at 190.

[68] Witness the rapid turnabout in opinion of Robert W. Straus, president of Farrar, Straus, & Giroux. Straus originally credited Soviet adherence to the Convention to a desire to expand trade with the West. Astrachan, *supra* note 28. Three weeks later he attributed the action to a desire on the part of the Soviet government to control publication abroad of internal dissidents. Wagner, *supra* note 2, at 47.

tions, such as the Authors' League, PEN, and the Association of American Publishers, expressed concern that the UCC might be perverted to extend Soviet censorship worldwide.[69] As discussed above, legislation was introduced and retaliatory actions were discussed.[70] The fears expressed in American publishing circles were echoed by a group of Soviet dissidents who, in a public letter to UNESCO, warned that adherence to the Convention might enable the Soviets to expand their censorship efforts internationally.[71]

The widespread apprehension engendered by the Soviet action centered primarily on one provision of the Soviet law—article 106 of the Basic Principles, which provides for the compulsory purchase by the state of an author's copyright.[72] It was widely suggested that this provision of the law, together with the amendments allowing the author's assignees and legal successors to exercise control over the copyright privileges, could be used by the government to forcibly acquire the copyright of a dissident writer. Then, as the copyright proprietor, the government could refuse to permit translation and/or publication of that writer's works abroad.[73]

The provision in Soviet law permitting the government to compulsorily acquire the copyright of domestic authors and artists is not of recent origin. As early as December 1917 the

[69] Lacy, *supra* note 10, at 15.

[70] *See supra* notes 7 and 8 and accompanying text.

[71] Of the six signers of the letter, Andrei Sakharov, Igor Shafarevich, and Grigory Podyapolsky are members of the Moscow Human Rights Committee. Alexander Galich is a poet and playwright who has been expelled from the Union of Writers. Vladimir Maximov was expelled from the Union of Writers subsequent to the publication of this letter and has since emigrated. Alexander Voronel is a Jewish physicist who applied for and was refused an emigration visa to Israel. An English translation of the letter appears in Wagner, *Congress Gets Copyright Bill: Firm U.S. Action Sought*, 203 PUBLISHERS WEEKLY, Apr. 9, 1973, at 42–43.

[72] Art. 106 provides: "A copyright on the publication, public performance or other use of a work may be compulsorily purchased by the state from the author or his heirs under a procedure established by Union Republic legislation."

[73] *See, e.g.*, Wagner, *Goldman Hails Soviet Move on Copyright—With Reservations*, 203 PUBLISHERS WEEKLY, Apr. 23, 1973, at 49; Lacy, *supra* note 10, at 15.

new Bolshevik government promulgated a decree authorizing the state department of education to declare a government-owned five-year monopoly on the publication of the works of the classic Russian authors.[74] This decree only affected the publishing industry and did not expropriate the copyrights of any living authors. A decree on November 26, 1918, extended the right of the government to declare publishing monopolies to "all works of science, literature, music, or fine arts of any kind, whether published or not, no matter in whose possession they are." [75] Under this decree the works of 17 composers (including Tchaikovsky, Scriabin, Rimsky-Korsakov, and Moussorgsky) and 50 writers were nationalized.[76]

A provision permitting the "compulsory purchase" by the government of a Soviet citizen's copyrights was included in both the 1925 and 1928 copyright statutes,[77] but after the 1928 revisions of the Soviet copyright law this section found little application. Ten years after its passage, the "compulsory purchase" provision had not yet been used.[78] It was not until the late 1950s that a use was finally found for it: to deprive the heirs of popular authors of their large unearned incomes. The government would compulsorily purchase the copyrights on the works of these authors and pay the heirs a small price, thereby preventing them from leading "unproductive," "parasitic" existences.[79] In 1961 article 106 of the

[74] B. Antimonov and E. Fleyskits, *Avtorskoye Pravo* (Copyright Law) 23, note 4 (1957). Subsequent decrees nationalized the works of many Russian composers and authors, such as Rimsky-Korsakov, Tchaikovsky, Gogol, Dostoevsky, and Tolstoy. For the texts of these decrees see L. Azor and S. Shatsillo, *Avtorskoye pravo na literaturnyye Proizredeniya: sbornik ofitsial' nykh materialov* (Copyright in literary works: a collection of official materials) 43–44 (1953).

[75] [1918] *Sob. Uzok. RSFSR*, No. 86, art. 900.

[76] Azor and Shatsillo, *supra* note 74, at 43–44.

[77] Levitsky, *supra* note 15, at 121.

[78] Dubinovsky, *Is the Radical Revision of Copyright Necessary?*, SOVYETSKAYA YUSTITSIA, No. 12, 1937, quoted in 2 WORLD COPYRIGHT: AN ENCYCLOPEDIA, at 125 (H. Pinner ed. 1955).

[79] Woltmann, *supra* note 42, at 20.

Basic Principles of Civil Legislation superseded the compulsory purchase provision of the 1928 statute. There is no evidence that article 106 has been used with any greater frequency than its predecessor. In fact, one Soviet authority cautions Americans against overestimating the right of the Soviet government to expropriate copyrights; in practice, he says, it occurs very rarely.[80]

Now that the Soviet copyright law, through the Convention, has assumed worldwide importance, the possibility that article 106 might be used to suppress the writings of dissident writers has caused consternation in publishing and literary circles both here and abroad. Attempting to answer whether Soviet officials *will* apply article 106 in such a way is a difficult problem. Deducing Soviet intentions is always difficult. But it is easier to determine whether, as a matter of American law, the Soviet government *can* expropriate the copyright of a Russian author and then bring suit in American courts to prevent publication of that writer's works.

There has been a great deal of speculation in the press concerning such a suit. Some publishing officials would welcome a court test, confident that no American court would enforce the "compulsory purchase" of a Soviet citizen's copyright.[81] Others are less sure, fearing that such a "purchase" would have to be enforced by courts in this country.[82] The commonly accepted scenario for a court test would run as follows: an American publisher would acquire a manuscript copy of one of the unpublished works of a Russian dissident writer and would begin preparation to publish it. Prior to

[80] Remarks by Dr. Yuri Matveev, senior lecturer at Kiev University, following his lecture "Copyright Protection in the USSR," sponsored by the Copyright Society of the U.S.A.; quoted in *Soviet Copyright Expert Belittles U.S. Fears*, 203 PUBLISHERS WEEKLY, Apr. 30, 1973, at 36–37.

[81] *See, e.g.*, remarks of Robert Bernstein of Random House, quoted in Dornberg, *Soviet-Western Conflict on Copyright May Intensify*, Washington Star-News, Jan. 6, 1974, at A10, col. 1.

[82] For a discussion of the possibilities of such a suit *see* Smith, *Solzhenitsyn and Soviet's Risks*, N.Y. Times, Dec. 31, 1973, at 6, col. 2, and *Bid to Ban "Gulag" in U.S. is Doubted*, *supra* note 2.

publication, the Soviet government would, under article 106, compulsorily purchase the author's copyright in the work. Then, again prior to publication, the Soviet government agency that purchased the copyright (or its assignee) would enter an American court to enjoin the publication in the United States of the work.[83]

IV. LEGAL CAPACITY OF THE SOVIET GOVERNMENT TO PREVENT FOREIGN PUBLICATIONS OF DISSIDENT WORKS

In estimating the Soviet government's legal capacity to obtain a court order enjoining the publication in the United States of the work of a dissident author, two fundamental questions must be answered. First, would U.S. courts recognize a compulsory purchase of the copyright of a dissident author by the Soviet government under article 106 as a valid and enforceable transfer of title for purposes of litigation in the United States? And second, assuming that the USSR is the legitimate copyright proprietor by virtue of its compulsory purchase, what rights does it have as copyright proprietor?

[83] This scenario assumes that there has been no contact between the Russian author and the American publisher and that the former has not openly authorized the publication of his work in the United States. Any Russian dissident author openly negotiating with an American publisher for the publication of his works abroad would be risking trial and imprisonment in the USSR either for publication of "anti-Soviet slander" or for violation of the state monopoly on foreign trade. *See infra* notes 209–15 and accompanying text. It is further assumed that the Soviet "purchase" would occur prior to the publication of the work in the West. The general practice has been for a Western publisher publishing the works of dissident Soviet authors to register the copyright in its own name. Letter from O. V. Perekrestov, of Possev-Verlag, to M. Newcity, July 27, 1973. Thus, if the work has already been published in the West before the Soviets attempt to purchase the author's interest therein, it is highly likely that the author, at that point, will have no protectable interest in the work. Thus, the copyright will belong to the publisher and it will be beyond the reach of Soviet expropriation.

U.S. RECOGNITION OF SOVIET EXPROPRIATION

Whether or not the acquisition of a copyright by the Soviet government is recognized by American courts as a legitimate and enforceable transfer of title turns on the question of which law is applied. For example, if the law of New York (the probable forum for such a suit) is applied there can be little doubt that a "compulsory purchase" would not be recognized as legitimate. The New York courts have on several occasions held that nationalization decrees of foreign governments are repugnant to the public policy of New York and thus will not be enforced within that state.[84] But all of these decisions have involved foreign-owned property existing within the jurisdiction of the New York courts. Application of the traditional conflict-of-law rule that the law of the domicile of the owner of intangible property must be applied [85] would result in using Soviet law to determine the validity of a "compulsory purchase." The answer to such an inquiry is self-evident: the legitimacy of the purchase would have to be recognized. However, in recent years there has been a movement away from the traditional automatic application of the law of the owner's domicile.[86] In *Capitol Records, Inc. v. Mercury Records Corp.*[87] the Second Circuit held that the law of the "place where the right of property is

[84] Vladikavkazsky Ry. v. New York Trust Co., 263 N.Y. 369, 378, 189 N.E. 456, 460 (1934); Stephen v. Zivnostenska Banka, National Corp., 15 App. Div.2d 111, 222 N.Y.S.2d 128 (Sup. Ct. 1961); Plesch v. Banque Nationale de la Republique D'Haiti, 273 App. Div. 224, 227, 77 N.Y.S.2d 43, 49 (Sup. Ct.), *aff'd*, 298 N.Y. 573, 81 N.E.2d 106 (1948); and Schwartz v. Compania Azucarera Vertientes-Camaguey de Cuba, 28 Misc.2d 355, 208 N.Y.S.2d 833 (Sup. Ct. 1960).

[85] Palmer v. De Witt, 47 N.Y. 532, 538 (1872); *see also* STORY, CONFLICT OF LAWS § 376, at 534 (8th ed. 1883); 1 BEALE, A TREATISE ON THE CONFLICT OF LAWS § 51.1, at 301 (1935); and LALIVE, THE TRANSFER OF CHATTELS IN THE CONFLICT OF LAWS 34–43 (1955).

[86] *See, e.g.*, LALIVE, *supra* note 85, at 52; Note, *Situs of Intangible Property in Conflict of Laws*, 30 ST. JOHN'S L. REV. 224, 231 (1956); and 1 RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 65, at 204 (1971).

[87] 221 F.2d 657 (2d Cir. 1955).

sought to be exercised" will be applied in cases of nonstatutory literary property.[88] Thus, if the New York court applied this more modern, interest-oriented test, the law of the jurisdiction in which the common law right is asserted (New York, in this case) would be applied and the suit would probably be dismissed.

Such a result, though, will occur only if the court hearing the case is free to reach the question of which law applies, and there is every likelihood that the court would be barred from considering this question by the Act of State doctrine. Beginning in the nineteenth century American courts have consistently held that acts of foreign governments carried out within their territorial boundaries will not be questioned by American courts.[89] The Supreme Court gave the Act of State doctrine its classic formulation in *Underhill v. Hernandez* [90] when it said:

[88] *Id.* at 662. See also ST. JOHN'S L. REV., *supra* note 86, at 228.

[89] *See* Banco Nacional de Cuba v. Sabbatino, 376 U.S. 398 (1964); U.S. v. Pink, 315 U.S. 203 (1942); U.S. v. Belmont, 301 U.S. 324 (1937); Ricaud v. American Metal Co., Ltd., 246 U.S. 304 (1918); Oetjen v. Central Leather Co., 246 U.S. 297 (1918); American Banana Co. v. United Fruit Co., 213 U.S. 347 (1909); Underhill v. Hernandez, 168 U.S. 250 (1897); Tabacalera Severiano Jorge, S.A. v. Standard Cigar Co., 392 F.2d 706 (5th Cir.), *cert. denied*, 393 U.S. 924 (1968); Bernstein v. N.V. Nederlandsche-Amerikaansche Stoomvaart Maatschappij, 173 F.2d 71 (2d Cir. 1949); The Navemar, 90 F.2d 673 (2d Cir. 1937), *rev'd on other grounds sub nom.*, Compania Espanola de Navagacion Maritima S.A. v. The Navemar, 303 U.S. 68 (1938); Menendez v. Faber, Coe & Gregg, Inc. 345 F. Supp. 527 (S.D.N.Y. 1972); Carl Zeiss Stiftung v. V.E.B. Carl Zeiss, Jena 293 F. Supp. 892 (S.D.N.Y. 1968), *modified on appeal*, 433 F.2d 686 (2d Cir. 1970); National Institute of Agrarian Reform v. Kane, 153 So.2d 40 (Fla. Ct. App. 1963); French v. Banco Nacional de Cuba, 23 N.Y.2d 46, 242 N.E.2d 704, 295 N.Y.S.2d 433 (1968). The Act of State doctrine is not solely an American creation. English courts, relying in part on Underhill, *supra*, and Oetjen, *supra*, have extended the doctrine to the United Kingdom. See Mighell v. Sultan of Johore, [1894] 1 Q.B. 149 (C.A.); Moscow Fire Ins. Co. v. Bank of N.Y. & Trust Co., 280 N.Y. 286, 20 N.E.2d 758 (1939), *aff'd*, 309 U.S. 624 (1940); M. Salimoff and Co. v. Standard Oil Co. of N.Y., 262 N.Y. 220, 186 N.E. 679 (1933); Banco de Vizcaya v. Don Alfonso de Borbon y Austria, [1935] 1 K.B. 140; Company for Mechanical Woodworking A.M. Luther v. James Sagor & Co., [1921] 3 K.B. 532 (C.A.).

[90] 168 U.S. 250 (1897).

Every sovereign state is bound to respect the independence of every other sovereign state, and the courts of one country will not sit in judgment on the acts of the government of another done within its own territory.[91]

This formulation was expressly reaffirmed by the Supreme Court in 1964 in *Banco Nacional de Cuba v. Sabbatino*,[92] with the Court saying:

[W]e decide only that the Judicial Branch will not examine the validity of a taking of property within its own territory by a foreign sovereign government, extant and recognized by this country at the time of suit, in the absence of a treaty or other unambiguous agreement regarding controlling legal principles, even if the complaint alleges that the taking violates customary international law.[93]

The Court explained that the Act of State doctrine, while not being mandated by the Constitution, did have "constitutional underpinnings."[94] Those underpinnings were found in the separation of powers embodied in the Constitution—specifically, that if the Judiciary passed on the validity of the actions of foreign sovereign governments it would be invading the Legislative and Executive branches' responsibilities in foreign affairs.[95] In this respect, the Court relied on *Oetjen v. Central Leather Co.*,[96] which had held that:

[T]he conduct of the foreign relations of our government is committed by the Constitution to the Executive and Legislative [branches] . . . and the propriety of what may be done in the exercise of this political power is not subject to judicial inquiry or decision.[97]

While quoting this passage with approval the Court qualified it somewhat, noting that not every case or controversy which

[91] *Id.* at 252.
[92] 376 U.S. 398 (1964).
[93] *Id.* at 428.
[94] *Id.* at 423.
[95] *Id.*
[96] 246 U.S. 297 (1918).
[97] *Id.* at 302.

touches foreign relations is beyond judicial cognizance[98] and that the Constitution "does not irrevocably remove from the judiciary the capacity to review the validity of foreign acts of state."[99] The Court made it clear that the Act of State doctrine was not required by international law[100] and could be applied even when international law had been violated.[101]

While it goes without saying that the Act of State doctrine applies only to governmental actions which are bona fide acts of state, defining what constitutes an act of state with any degree of precision is difficult. There has been very little discussion by courts or scholars of just what actions of foreign governments constitute acts of state.[102] A proposed draft of the *Restatement of the Foreign Relations Law of the United States* defined acts of state as:

> executive and legislative measures giving effect to governmental decisions on major issues of policy, such as public versus private ownership of property . . . [and] regulation of business enterprise.[103]

The *Restatement (Second) of the Foreign Relations Law of the United States* declares that the taking of property within its borders by a foreign sovereign is an act of state.[104] The provisions of the Soviet law under which a copyright can be "compulsorily purchased" by the government require a decree of the Republic Council of Ministers—the highest governmental body in each Union Republic—in each indi-

[98] 376 U.S., at 423.
[99] *Id.*
[100] *Id.* at 421–31.
[101] *Id.* at 431.
[102] Note, *Mitigating the Rigors of the Act of State Doctrine: The General Principles of Law Recognized by Civilized Nations*, 20 SYR. L. REV. 705, 715 (1969).
[103] RESTATEMENT OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 41, comment *c* at 130–31 (Proposed Official Draft, 1962).
[104] RESTATEMENT (SECOND) OF THE FOREIGN RELATIONS LAW OF THE UNITED STATES § 41, comment *d* at 127 (1965).

vidual case.[105] Undoubtedly, the articulated reason for the purchase would be that the publication of the dissident work would defame the Soviet state. In such a situation the American court would be faced with an action taken by the highest governmental body of a foreign state for reasons of important public policy, and the court hearing such a suit would be hard pressed to find that the action of the Soviet government in purchasing the author's copyright was not a genuine act of state which must be accorded recognition as such.

There are, however, a number of exceptions to the Act of State doctrine. Once it is decided that the purchase of an author's copyright by the Soviet government is a genuine act of state it must be determined if any of these specific exceptions apply. The first and most significant restriction on the applicability of the Act of State doctrine is that courts are not compelled to give extraterritorial effect to the confiscatory decrees of a foreign government, even if the decree is directed against that government's nationals.[106] This result stems from the requirement imposed by American courts in developing the Act of State doctrine that the *res*, the object affected by the foreign government's decree, be within the territorial control (either in fact or constructively) [107] of that government before a confiscatory decree will be recognized as binding.[108] If the *res* is within the United States at the time of the promulgation of the confiscatory decree, whether or not

[105] Loeber, *Samizdat Under Soviet Law*, 2 INDEX, No. 3 (1973), at 5. See R.S.F.S.R. 1964 Grazh. Kod. (Civil Code) art. 501 (1965).

[106] Maltina Corp. v. Cawy Bottling Co., Inc., 462 F.2d 1021, 1025 (5th Cir.), *cert. denied*, 409 U.S. 1060 (1972).

[107] In The Navemar, 90 F.2d 673 (2d Cir. 1937), *rev'd on other grounds sub nom.*, Compania Espanol de Navagacion Maritima, S.A. v. The Navemar, 303 U.S. 68 (1938), the court held that a ship, located in New York, was constructively in the possession of the Spanish government owing to the special circumtances of an ocean-going ship and its concomitant extraterritoriality. 90 F.2d, at 676–77.

[108] *See* Republic of Iraq v. First National City Bank, 353 F.2d 47, 51 (2d Cir. 1965), *cert. denied*, 382 U.S. 1027 (1966).

the courts give effect to the decree turns upon whether or not it is "consistent with our policy and laws." [109] Not surprisingly, it has been consistently held that decrees which confiscate property without compensation run contrary to "our policy and laws." [110] Therefore, if the property affected by the confiscatory decree of a foreign government is within the United States, the decree will not be enforced by U.S. courts; if it is under the control of the foreign government issuing the decree, the courts will give effect to it.

Such a doctrine is simple to apply when the object affected by a confiscatory decree is a factory, a quantity of grain, tobacco, or sugar, as in previous cases. But when the object expropriated by a foreign government is intangible, as in the case of a copyright, then the doctrine becomes difficult to apply with any precision. As acknowledged by the court in *Tabacalera Severiano Jorge, S.A. v. Standard Cigar Co.*, "[t]he situs of intangible property is about as intangible a concept as is known to the law." [111] But it is obviously necessary to determine the situs of a copyright in order to determine whether the Act of State doctrine can or cannot be applied by American courts.

Case law presents no consistent picture for trying to determine the situs of intangible property. Such property may be in one place for ad valorem tax purposes,[112] in another location for venue purposes,[113] and for taxation purposes it may be in several places at once.[114] And the situs of the property for determining if the Act of State doctrine is applicable may be still different.[115]

[109] 353 F.2d 47, at 51–52 (2d Cir. 1965).

[110] *See also* F. Palicio y Compania, S.A. v. Brush, 256 F. Supp. 481 (S.D.N.Y. 1966), *aff'd*, 375 F.2d 1011 (2d Cir.), *cert. denied sub nom.*, Brush v. Republic of Cuba, 389 U.S. 830 (1967).

[111] 392 F.2d 706, 714 (5th Cir.), *cert. denied*, 393 U.S. 924 (1968).

[112] Farmers Loan and Trust Co. v. State of Minnesota, 280 U.S. 204 (1930).

[113] Chicago, Rock Island & Pacific R.R. v. Sturm, 174 U.S. 710 (1899).

[114] Curry v. McCanless, 307 U.S. 357 (1939).

[115] Tabacalera Severiano Jorge, S.A. v. Standard Cigar Co., 392 F.2d 706, 715 (5th Cir.), *cert. denied* 393 U.S. 924 (1968).

With respect to contracts, the doctrine applies only to agreements whose "center of gravity" is within the territorial dominion of the acting state; [116] the situs of debts is with the debtor, not the creditor; [117] a chose in action claimed by a U.S. resident has been held to have a situs in the United States.[118] But such cases are not of great value in determining the situs of copyrights, since they are easily distinguishable. All of the situations just discussed involve two parties (the parties to the contract, the debtor and the creditor, or the plaintiff and the defendant in the chose in action), one of whom resides in the United States. Thus, the transactions involved are not contained completely within one country; they flow across national boundaries since the parties are of different nationalities. In all three cases the action flows into or out of the United States, from or to the country issuing the confiscatory decree. In none of these cases does the action occur solely in the foreign country. In the hypothetical case under discussion here there would be no American party to the transaction and hence no transnational aspect.

Of possibly more help is the line of cases concerning trademark rights. In several instances foreign nations have expropriated the assets of businessmen operating in their country. Among the disputed assets of these businessmen have been trademarks registered by the concerned corporations in the United States. The courts have uniformly held that trademarks have a situs in the United States by virtue of their registration in this country.[119] But again that very factor dif-

[116] Mann v. Compania Petrolera Trans-Cuba, S.A., 32 Misc.2d 790, 223 N.Y.S.2d 900 (Sup. Ct. 1962).

[117] Tabacalera Severiano Jorge, S.A. v. Standard Cigar Co., 392 F.2d 706, 716 (5th Cir.), *cert. denied* 393 U.S. 924 (1968). *See also* Menendez v. Faber, Coe & Gregg, Inc., 345 F. Supp. 527, 538 (S.D.N.Y. 1972).

[118] Frenkel & Co., Inc. v. L'Urbaine Fire Ins. Co., 251 N.Y. 243, 167 N.E. 430 (1929).

[119] Maltina Corp. v. Cawy Bottling Co., Inc., 462 F.2d 1021, 1027 (5th Cir.), *cert. denied*, 409 U.S. 1060 (1972); Vanity Fair Mills, Inc. v. T. Eaton Co., 234 F.2d 633, 646–47 (2d Cir.), *cert. denied*, 352 U.S. 871 (1956); Carl Zeiss Stiftung v. V.E.B. Carl Zeiss, Jena, 293 F. Supp. 892, 896 (S.D.N.Y. 1968), *modified on appeal*, 433 F.2d 686 (2d Cir. 1970).

ferentiates these cases from the problem of copyrights because the copyrights in unpublished manuscripts are not registered with a central agency as trademarks are.

It has been held that the copyright in an unpublished manuscript follows the person of the owner and is governed by the law of his domicile,[120] implying that the situs of the copyright should be the residence of the author. Such inferences are less than satisfactory, however, since as indicated above, the situs for intangible property varies according to the purpose. There have been no cases squarely on point—that is, none deciding the situs of the copyright in an unpublished manuscript for the purpose of determining the application of the Act of State doctrine. The case which comes closest to addressing this particular question, *Capitol Records, Inc. v. Mercury Records Corp.*,[121] states that the confiscation of intangible property similar to a copyright would not give the confiscating government an enforceable right to stop others from similarly reproducing the material copyrighted when the creating artist resides in another country. *Capitol Records* involved the right to reproduce records from metal matrices acquired by the Czechoslovakian government when it expropriated the property of a domestic company. That company had acquired the matrices under a licensing agreement with their German owner. All German property in Czechoslovakia was seized after the war, and then all of the property of the private record company was nationalized by the Communist government. In deciding whether the assignee of the Czech government or the assignee of the original German owner had the exclusive right to make records from the matrices the court held that the intangible right to reproduce the performances recorded on the matrices was separate from the matrices themselves (in the same way that the copyright to a manuscript is separate from the physical posses-

[120] Palmer v. De Witt, 47 N.Y. 532, 538 (1872).
[121] 109 F. Supp. 330 (S.D.N.Y. 1952), *aff'd*, 221 F.2d 657 (2d Cir. 1955).

sory right to the manuscript itself and that the situs of this intangible right was at the domicile of the original German owner.[122] This decision would indicate that the situs of the right to reproduce copies of an unpublished manuscript [123] would exist at the domicile of the author.[124] Such a holding would be consistent with the conceptualization by the courts of the copyright in an unpublished work, viz., that the author of that work, prior to its publication, owns an incorporeal property, distinct and separate from the physical object itself, which is the right to reproduce the work and control its disposition.[125] Since there is no registration of the copyright in an unpublished work (at least, there is none for most literary works), there is no logical situs for the copyright other than the person of the author; furthermore, it would seem inescapable that any incorporeal right owned wholly by a single person must be located in the person of its owner.

If the courts follow this line of precedent and logic it would seem that their only conclusion would be that as long as the author resides in the USSR the expropriation of his copyrights in unpublished manuscripts would be an act "done within its own territory," and therefore it could not be questioned by American courts under the Act of State doctrine.

[122] 109 F. Supp. 330, at 338–39.

[123] Which is, after all, the definition of the copyright in an unpublished manuscript. *See* Bobbs-Merrill Co. v. Straus, 147 F. 15, 18 (2d Cir. 1906), *aff'd*, 210 U.S. 339 (1908).

[124] It should be stressed, though, that the concept of situs is very malleable, and is frequently bent to the purposes of the court. The court, in *Carl Zeiss Stiftung v. V.E.B. Carl Zeiss* acknowledged that the courts have developed a "willingness to disregard technicalities in favor of equitable considerations" when determining questions related to expropriated property. 293 F. Supp. 892, 898 (S.D.N.Y. 1968), *modified on appeal* 433 F.2d 686 (2d Cir., 1970). *See also* Maltina Corp. v. Cawy Bottling Co., 462 F.2d 1021, 1028 (5th Cir.), *cert. denied*, 409 U.S. 1060 (1972). Thus, it is possible that a court, hearing a case such as that discussed here, would find the situs of the copyright in that locale that would further to the greatest extent the equitable considerations involved in the case.

[125] *See, e.g.*, Werckmeister v. American Litho. Co., 142 F. 827 (S.D.N.Y. 1905), and Schleman v. Guaranty Title Co., 153 Fla. 749, 15 So.2d 754 (1943).

Besides this court-created limitation on the Act of State doctrine there is a legislative limitation as well. In response to the Supreme Court's decision in *Sabbatino* the Congress hurriedly sought to overrule that decision by amending the Foreign Assistance Act of 1964.[126] This legislation, the Hickenlooper Amendment, provides:

> [N]o court in the United States shall decline on the ground of the federal act of state doctrine to make a determination of the merits giving effect to the principles of international law in a case in which a claim of title or other property is asserted by any party including a foreign state . . . based upon . . . a confiscation or other taking after January 1, 1959, by an act of that state in violation of the principles of compensation and the other standards set out in this subsection.[127]

But the Hickenlooper Amendment, too, is of limited applicability to the hypothetical case under consideration because §2370(e)(2) specifically provides that cases "in which an act of a foreign state is not contrary to international law" will be excepted from the general prohibition against application of the Act of State doctrine. The courts, in applying this provision of the amendment, have consistently held that acts of state directed against the acting government's own nationals do not give rise to questions of international law.[128] Thus, when a government expropriates the property of its resident nationals the Hickenlooper Amendment is not applicable and the Act of State doctrine as formulated by the Supreme Court in *Sabbatino* must be applied.[129] It would seem,

[126] Pub. L. No. 88-633, 78 Stat. 1009 (codified in scattered sections of 22 U.S.C.).

[127] Pub. L. No. 88-633, pt. III, ch. 1, § 301(d), 78 Stat. 1013, amending 22 U.S.C. § 2370(e) (1961) [codified at 22 U.S.C. § 2370(e)(2)].

[128] Banco Nacional de Cuba v. Sabbatino, 307 F.2d 845, 861 (2d Cir. 1962), *rev'd on other grounds*, 376 U.S. 398, 84 S.Ct. 23 (1964); Menendez v. Faber, Coe & Gregg, Inc., 345 F. Supp. 527 (S.D.N.Y. 1972); F. Palicio y Compania, S.A. v. Brush, 256 F. Supp. 481, 487 (S.D.N.Y. 1966), *aff'd*, 375 F. 2d 1011 (2d Cir.), *cert. denied sub nom.*, Brush v. Republic of Cuba, 389 U.S. 830 (1967); Present v. United States Life Ins. Co., 96 N.J. Super. 285, 232 A.2d 863 (1967).

[129] F. Palicio y Compania, S.A. v. Brush, 256 F. Supp. 481, 487 (S.D.N.Y. 1966), *aff'd*, 375 F.2d 1011 (2d Cir.), *cert. denied sub nom.*, Brush v. Republic of Cuba, 389 U.S. 830 (1967).

therefore, that the Hickenlooper Amendment, designed as it was to protect the property interests of American nationals, would give little relief to a Russian author residing within the USSR whose copyrights had been expropriated.[180]

The conclusion to be drawn, therefore, is that American courts, by virtue of the Act of State doctrine, would be obligated to respect and give effect to the "compulsory purchase" of a copyright by the Soviet government. Under the terms of the doctrine an American court hearing such a case would be barred from inquiring into the propriety or legitimacy of the Soviet action because the *res* affected by the act of state was within the jurisdiction of the foreign sovereign. Therefore, our hypothetical American court would have to recognize the "compulsory purchase" of the dissident author's copyright as a legitimate transfer of title; the Soviet government, one of its agencies, or its assignee, would have to be regarded as the legitimate copyright proprietor.

RIGHTS OF THE SOVIET UNION AS COPYRIGHT PROPRIETOR

As discussed above,[181] the Convention requires a member nation to accord to the citizens of other member nations the same treatment that it accords to its own nationals. Thus, works published in one contracting state are treated in a second contracting state as "works first published in [the second state's] own territory," [182] and unpublished works are given "the same protection as that [second state] accords to unpublished works of its own nationals." [183] Since in the United States there is a substantial difference in the protection of-

[180] Though American courts might be compelled to recognize Soviet expropriation of a Russian author's copyright, there is some indication that UNESCO officials might regard such an action as a contravention of the Convention. Nicholas Bethell, writing in The Times (London), says that UNESCO officials "would not regard a blanket take-over of such rights by the State as being within the spirit of the convention. Were the Soviet authorities to attempt any such move, UNESCO would probably find them to be in breach." Bethell, *supra* note 4.

[181] *See supra* notes 48–54 and accompanying text.

[182] The Convention, art. II, § 1.

[183] The Convention, art. II, § 2.

fered to published and unpublished works, it is first necessary to determine whether the manuscript of the work of a Russian dissident author would be considered "published" or "unpublished" before it is possible to ascertain the rights a Soviet copyright proprietor would have in the United States.

The sole criterion for "publication" in cases arising from the Convention is the definition of publication contained in article VI:

> "Publication," as used in this Convention, means the reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.

The definition contained in article VI is the sole determinant of whether a work has been published or not—any court determining the status of a work must conform to the definition of "publication" in the Convention.[134] There is no elaboration of the precise application and meaning of this definition other than in scholarly commentary on the Convention. Bogsch has analyzed the definition and has concluded that the word "general" indicates that the drafters of the Convention believed that before publication occurs copies of the work must be available to "any prospective purchaser."[135] This conclusion is reached by examining the phrase in article VI that requires that the distribution of copies be "to the public." Bogsch interprets that phrase as indicating that anyone who wishes to obtain a copy of the work must be able to do so before publication can occur.[136] Finally, the word "distribution" is interpreted as including both gratuitous and nongratuitous dissemination of the work.[137] But Bogsch warns that "any definitive interpretation seems to be impossible. . . . One shall have to look to the facts and circumstances in each particular case."[138]

[134] Bogsch, *supra* note 48, at 12.
[135] *Id.* at 77.
[136] *Id.*
[137] *Id.* at 75–76.
[138] *Id.* at 76–77.

Because the definition of publication is imprecise to begin with, the determination of the published or unpublished status of any work would be difficult. This task is rendered even more complicated by the long-standing Russian institution of *samizdat.*[139] Some of the best prose and poetry works being produced in the Soviet Union are being circulated there via *samizdat, i.e.,* typewritten copies being passed among friends and acquaintances.[140] Yakobson and Allen have described the institution of *samizdat* as follows:

> [I]t often happens that writers wish to discuss topics, to use methods, to mention events which do not fall within the official calendar of the accepted and permitted. As a result they must make their compromises, fall silent, or, if the creative impulse is too strong, write, as the Russian expression has it, "for the drawer," to be filed away against the day when a possible change in circumstances may allow its publication. Both under the imperial regime as under the Soviets especially in recent years, there has also been the method of dissemination known as *samizdat* in which manuscripts of works which could not be published in the regular channels circulate from person to person. This is, of course, a procedure which requires that someone undertake the labor of making copies, which is not easy to do in a country where the authorities require the registration of every mimeograph and duplicating machine and in which the typewriter is rather rare. In spite of this, such manuscripts are read by relatively large numbers of people and may, indeed, become well known in that form.[141]

Samizdat is an underground railroad for the works of dissident writers. These works are read in manuscript form; then each reader makes new copies of the manuscript, and the circle of readers grows ever larger. How many Soviet citizens read works published in *samizdat* is unknown, but indications are that for the better-known writers *samizdat*

[139] *Samizdat* means literally "self-publishing." A. Schwartz, *The State of Publishing, Censorship and Copyright in the Soviet Union,* 203 PUBLISHERS WEEKLY, Jan. 15, 1973, at 34.

[140] BROWN, RUSSIAN LITERATURE SINCE THE REVOLUTION 307–12 (rev. ed. 1969).

[141] S. YAKOBSON & R. ALLEN, ASPECTS OF INTELLECTUAL FERMENT AND DISSENT IN THE SOVIET UNION, S. Doc. No. 106, 90th Cong., 2d Sess. 40–41 (1968).

publication means relatively extensive circulation of their works.[142]

It appears to be a safe assumption that a work of a Russian dissident author sufficiently popular to attract the attention of an American publisher would have appeared in *samizdat*.[143] It must then be determined whether or not the inherently limited (albeit extensive) circulation of *samizdat* publications would be considered "publication" under the article VI definition. The answer is not readily self-evident, nor is it easy to find. Since the Convention in general, and this definition in particular, were drafted with American law as a model,[144] it is only reasonable that a judge would turn to American case law in determining whether circulation of a work in *samizdat* constitutes publication within the meaning of article VI of the Convention.

Unfortunately, reliance on American case law can be a frustrating experience in this regard. There has yet to be a definitive interpretation of the meaning of "publication" by an American court.[145] The copyright statute does not expressly define publication, and its one provision from which

[142] *E.g.*, both THE CANCER WARD and THE FIRST CIRCLE by Alexander Solzhenitsyn were published in samizdat. Samizdat copies made their way to the West and provided American publishers with the manuscripts they published. A. Schwartz, *supra* note 139, at 34–35.

[143] Schwartz, *supra* note 139, at 34–35.

[144] Kaye, *Duration of Copyright Protection and Publication Under the Convention: Articles IV and VI* in UNIVERSAL COPYRIGHT CONVENTION ANALYZED, *supra* note 48, at 47.

[145] The late Judge Frank of the Second Circuit suggested that "the term 'publication' is clouded by semantic confusion where the term is defined for different purposes . . . we have here an illustration of the one-word-one-meaning-only fallacy." American Visuals Corp. v. Holland, 239 F.2d 740, 742 (2d Cir. 1956). He suggested that the confusion engendered when the word "publication" is applied with different meanings in different circumstances "could perhaps be avoided by using different words in the different contexts. . . . Another device is, in some contexts, either to cut off the initial letter of the word (so that we could have 'publication' and 'ublication') or to spell the word backwards (yielding 'publication' and 'noitacilbup')." 239 F.2d at 742 n.2.

a definition could be inferred [146] has been definitively held not to provide such a definition.[147]

However, in order to mitigate the often harsh rule that publication will divest an author of his common law copyright, the courts have created two categories of publication: [148] one, the so-called "general publication," will divest an author of his common law rights; the second, the "limited publication," will not divest the author of his rights.[149]

The most widely accepted definition of general publication is found in *Werckmeister v. American Lithographic Co.*,[150] in which the court concluded that

> . . . a general publication consists in such a disclosure, communication, circulation, exhibition or distribution of the subject of copyright, tendered or given to one or more members of the general public, as implied an abandonment of the right of copyright or its dedication to the public.[151]

The authorities seem to have accepted this definition as the authoritative definition of general publication.[152]

Such general formulations, though, have only limited application to the specific problem at hand. Examples of general publication sufficient to divest the author of his common law copyright are: an author sending twenty-three copies of a book to various individuals, including booksellers; [153] a pub-

[146] Copyright Act, 17 U.S.C. § 26 (1970) defines the date of publication as "the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority. . . ."

[147] *See* Cardinal Film Corp. v. Beck, 248 F. 368 (1918). *See also* M. NIMMER, NIMMER ON COPYRIGHT § 49, at 193 (1963).

[148] NIMMER, *supra* note 147, § 58.1, at 224.

[149] Werckmeister v. American Litho. Co., 134 F. 321, 324 (2d Cir. 1904).

[150] 134 F. 321 (2d Cir. 1904).

[151] *Id.* at 326. *See also* William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F. Supp. 264, 267 (W.D. Pa. 1951).

[152] *See, e.g.*, Yarnell, *Recording Piracy is Everybody's Burden: An Examination of its Causes, Effects and Remedies*, 20 BULL. COPYRIGHT SOC'Y 234, 240 (1973), and NIMMER, *supra* note 147, § 58.11, at 225.

[153] Gottsberger v. Aldine Book Publishing Co., 33 F. 381 (D. Mass. 1887).

lisher maintaining an arrangement whereby he leases his publication to subscribers, subject to an agreement not to further communicate the contents; [154] the speeches of a public figure being made available to the press and interested members of the public; [155] a book being reproduced by mimeograph and sent to all who wrote to the author requesting a copy; [156] a salesman distributing copies of the forms he was selling to prospective customers; [157] and over 200 copies of an author's work being made available to interested persons at a trade convention.[158] In all these cases divestitive general publication was held to have occurred, despite the limited distribution and audience in each case.

What constitutes "limited publication" is not any clearer. Nimmer suggests that to be a limited publication the distribution of a work must be limited both as to the audience which receives the work [159] and as to the purpose of the distribution.[160] Such a formulation of the requirements of limited publication seems to be in accord with the decisions.[161] Specifically, a long line of cases and authorities agree that the author of a work has the right to circulate the work among friends and acquaintances without it constituting a general dedication to the public and abandonment of his common law copyright.[162] Examples of "limited publica-

[154] Jewelers Mercantile Agency, Ltd. v. Jewelers Weekly Publishing Co., 155 N.Y. 241, 49 N.E. 872 (1898).

[155] Public Affairs Associates, Inc. v. Rickover, 284 F.2d 262 (D.C. Cir. 1960), *vacated on other grounds*, 369 U.S. 111 (1962) *(per curiam)*.

[156] White v. Kimmel, 193 F.2d 744 (9th Cir.), *cert. denied*, 343 U.S. 95 (1952).

[157] Continental Gas. Co. v. Beardsley, 253 F.2d 702 (2d Cir.), *cert. denied*, 358 U.S. 816 (1958).

[158] American Visuals Corp. v. Holland, 239 F.2d 740 (2d Cir. 1956).

[159] NIMMER, *supra* note 147, § 58.11, at 225.

[160] *Id.* at 226.

[161] *See, e.g.*, White v. Kimmel, 193 F.2d 744, 746–47 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952), and Patterson v. Century Productions Inc., 93 F.2d 489, 492 (2d Cir. 1937), *cert. denied*, 303 U.S. 655 (1938).

[162] *See* Werckmeister v. American Litho. Co., 134 F. 321 (2d Cir. 1904); Stanley v. Columbia Broadcasting System, Inc., 35 Cal. 2d 653, 221 P.2d 73

tion" are: permitting students to copy an instructor's manuscript;[163] the distribution of a manuscript to a committee for approval;[164] the distribution of 2,500 copies of a song to radio stations and professional musicians;[165] the performance of a radio script at an audition before an audience;[166] the public performance of a dramatic composition;[167] the printing and distribution of etchings to a selected group of friends;[168] and the filing of architectural plans as required by law.[169] Each of these has been held to constitute a limited publication of the works involved, and thus the authors were not deprived of their common law rights.

It appears that before a publication will be held to be "limited" it must meet three criteria: the manuscript must have been communicated (1) to a definitely selected group (2) for a limited purpose (3) without the right of diffusion, distribution, or reproduction.[170] When finding whether or not a publication has occurred which would divest the author of his common law rights, the American courts will generally apply a less stringent standard than if they are merely determining whether sufficient publication had occurred to vest

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(1950); F.W. Dodge Co. v. Construction Information Co., 183 Mass. 62, 66 N.E. 204 (1903); NIMMER, *supra* note 147, § 58.1, at 225; COPINGER & SKONE JAMES, ON COPYRIGHT § 70, at 26 (11th ed. 1971); BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 134 (1944); Pickard, *Common Law Rights Before Publication*, 3 ASCAP COPYRIGHT L. SYMPOSIUM 299, 313–14 (1940); and Roberts, *Publication in the Law of Copyright*, 9 ASCAP COPYRIGHT L. SYMPOSIUM 111, 119 (1958).

[163] Bartlett v. Crittenden, 2 F. Cas. 967, 970–71 (No. 1076) (D. Ohio 1849).

[164] Press Publishing Co. v. Monroe, 73 F. 196 (2d Cir. 1896).

[165] Hirshon v. United Artists Corp., 243 F.2d 640 (D.C. Cir. 1957).

[166] Stanley v. Columbia Broadcasting System, Inc., 35 Cal. 2d 653, 221 P.2d 73 (1950).

[167] Ferris v. Frohman, 223 U.S. 424 (1912).

[168] Prince Albert v. Strange, 64 Eng. Rep. 293 (1849).

[169] Smith v. Paul, 174 Cal. App. 2d 744, 345 P.2d 546 (1959). *Contra,* Kurfiss v. Cowherd, 233 Mo. App. 397, 121 S.W.2d 282 (1938).

[170] White v. Kimmel, 193 F.2d 744, 746–47 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952). *See also* American Visuals Corp. v. Holland, 239 F.2d 740, 744 (2d Cir. 1956).

statutory copyright in the author.[171] In *American Visuals Corp. v. Holland* [172] the court explicitly stated:

> [T]he courts apply different tests of publication depending on whether plaintiff is claiming protection because he did not publish and hence has a common law claim of infringement—in which case the distribution must be quite large to constitute "publication"—or whether he is claiming under the copyright statute—in which case the requirements for publication are quite narrow.[173]

Though this holding has been criticized,[174] the requirement that a limited publication will have to be "quite large" before divesting the author of his common law rights has been frequently followed.[175] However, the applicability of this doctrine to *samizdat* is questionable. There can be little doubt that *samizdat* satisfies the requirements of a limited readership and purpose, but by its very nature *samizdat* does not restrict the right to reproduce the work and disseminate it. Furthermore, it is doubtful that the extent of the distribution would satisfy the "quite large" criterion of *American Visuals;* whether the courts would characterize *samizdat* as a limited publication is unclear.

Though there are no American court decisions addressing the question of whether *samizdat* constitutes publication two foreign courts have approached the problem and reached similar conclusions. Both cases arose out of the publication in the West of Alexander Solzhenitsyn's *August 1914.* In *The Bodley Head Ltd. v. Flegon* [176] an English court held, by way of dictum, that *samizdat* publication did not con-

[171] Burciaga, *Divestive Publication—Two Century Dilemma.* 12 ASCAP COPYRIGHT L. SYMPOSIUM 201, 216 (1962).

[172] 239 F.2d 740 (2d Cir. 1956).

[173] *Id.* at 744.

[174] NIMMER, *supra* note 147, § 58.2, at 227. Nimmer suggests that this holding is not supported by the authorities and is inherently vague in that "quite large" and "quite narrow" are unworkable standards.

[175] American Visuals Corp. v. Holland, 239 F.2d 740, 744 (2d Cir. 1956). *See also* Hirshon v. United Artists Corp., 243 F.2d 640, 645 (D.C. Cir. 1957), and Public Affairs Associates, Inc. v. Rickover, 284 F.2d 262, 271 (D.C. Cir. 1960).

[176] [1972] 1 W.L.R. 680 (Ch.)

stitute sufficient publication to meet the "reasonable requirements of the public" and therefore did not result in the dedication of the work to the public domain.[177] A German court, in *Luchterhand Verlag GmbH. v. Albert Langen-Georg Müller Verlag GmbH.*, reached a similar conclusion in 1972. The court held that *samizdat* publication did not constitute "first publication" within the meaning of the Berne Convention because (1) the author had not authorized circulation through *samizdat*, and (2) a holding that "first publication" had occurred requires that the work be made available to the public in sufficient quantities to satisfy the demand, and this had not occurred.[178]

While it is true that both of these cases can be distinguished because they deal with English statutory copyright law and the Berne Convention, respectively, there is one important lesson they offer: it will be almost impossible to prove the circumstances of the *samizdat* publication. In the *Bodley Head v. Flegon* decision the court held that there was insufficient evidence to prove that actual publication via *samizdat* had occurred. The *Luchterhand* court held that there was no evidence that the author of *August 1914*, Alexander Solzhenitsyn, had authorized publication of his work via *samizdat*. Regardless of which of the two issues it considers, an American court hearing such a case would be con-

[177] *Id.* at 687. It must be stressed that this was merely a finding that *samizdat* did not constitute publication within the meaning of the English copyright statute, which provides that ". . . a publication which is merely colourable, and not intended to satisfy the reasonable requirements of the public shall be disregarded." United Kingdom Copyright Act of 1956, 4 & 5 Eliz. 2, c. 74, § 49(2)(b).

[178] Though the decision by the Landgericht in the *Luchterhand* case was not reported, a discussion of it appears in Loeber, *supra* note 105, at 3, and Loeber, *"Selbstverlage" (Samizdat) in der Sowjetunion* ["Self-Publishing (*Samizdat*) in the Soviet Union], 37 RABELS ZEITSCHRIFT FÜR AUSLANDISCHES UND INTERNATIONALES PRIVATRECHT 515 (1973). The circumstances of the case are discussed in Frankfurt Allgemeine Zeitung, Feb. 22, 1973, at 2, col. 5. A further discussion of the legal status of *samizdat* appears in Feldbrugge, *De auteursrechtelijke positie van russische samizdat literatuur*, 48 NEDERLANDS JURISTENBLAD 667 (1973).

fronted with the difficult task of gathering evidence on *samizdat* publication in the Soviet Union. As the foreign courts have found, this is a very difficult proposition.

One of the most important questions about which evidence will have to be gathered is whether or not the publication in *samizdat* was authorized by the author of the work. Though the Convention does not expressly require consent of the author in its definition of publication, several scholars have suggested that an inference of such a requirement would be appropriate so as to prevent unauthorized infringing activities from affecting the protection of the work.[179] Furthermore, article III (1) of the Convention specifically states that the appropriate copyright notice must appear only on "all copies of the work published with the authority of the author or other copyright proprietor." It is clear that American law requires the consent of the copyright owner before effective publication can occur.[180] In sum, it appears that an American court would have to determine whether or not the original publication in *samizdat* was authorized by the copyright owner; if it was not clearly authorized, the court will probably conclude that the publication was not authorized and therefore the author's common law rights would not divest.[181]

Thus, since there have been no definitive decisions by an American court on the issue of whether publication by *samizdat* is publication under article VI of the Convention, only an impressionistic resolution of the problem can be suggested. But it does appear that the weight of scholarly analysis,[182] what scattered judicial precedents there are, and the very real problems of evidence and proof outlined above lead to the

[179] BAUMGARTEN, *supra* note 9, at 43 n.112 (1973), and Loeber, *supra* note 105, at 13–14.

[180] Yarnell, *supra* note 152, at 240.

[181] *See, e.g.*, BAUMGARTEN, *supra* note 9, at 43, and Loeber, *supra* note 105, at 13–14.

[182] *See* Schwartz, *supra* note 139, at 35; Loeber, *supra* note 105, at 13; and BAUMGARTEN, *supra* note 9, at 43.

conclusion that a court would not find circulation via *samizdat* to be publication within the meaning of the Convention. This conclusion is measurably strengthened when it is remembered that in defining publication article VI of the Convention requires a "general distribution to the public" of the subject work. Even though the number of copies of a particular work circulating in *samizdat* fluctuates greatly depending on public interest in that work or its author,[183] the secretive nature of *samizdat* would certainly lend support to the conclusion that *samizdat* is not a "general distribution to the public" and thus does not constitute publication within the meaning of article VI of the Convention.

Once this threshold question is answered it may be determined with precision what degree of protection will be accorded a Soviet copyright holder in the United States. If the work in question is unpublished, it will be given "the same protection as that other state [in this case the United States] accords to unpublished works of its own nationals."[184] In the United States, before a work is published, it is not protected by statute but is accorded a common law copyright. Such a copyright permits the author to withhold or communicate the work or impose such restrictions as he desires.[185] It should suffice to say that the author of an unpublished work has an absolute right to withhold it from publication.[186] Although not a statutory right, this common law copyright is recognized by federal statute,[187] and by that statute the state is given the choice of protecting or not protecting the com-

[183] Telesin, *Inside "Samizdat,"* 40 ENCOUNTER, No. 2, Feb., 1973, at 27.

[184] The Convention, art. II, § 2.

[185] Wheaton v. Peters, 33 U.S. (8 Pet.) 589, 591 (1834); Bobbs-Merrill v. Straus, 147 F. 15 (2d Cir. 1906), *aff'd*, 210 U.S. 339 (1908); Schleman v. Guaranty Title Co., 153 Fla. 749, 15 So.2d 754, 760 (1943).

[186] Werckmeister v. American Litho. Co., 134 F. 321, 324, 328 (2d Cir. 1904).

[187] Copyright Act, 17 U.S.C. § 2 (1970) provides: "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copyright, publication, or use of such unpublished work without his consent, and to obtain damages therefor."

mon law right. Many states (including New York) [188] have chosen to protect the author's right to an unpublished work.[189] The right to hold such a common law copyright is not restricted to American nationals—a Russian author has a protectable common law copyright in his unpublished works.[190] But as with any other piece of personal property—tangible or intangible—this common law copyright can be alienated.[191] Once such an alienation or assignment occurs the assignee stands in the shoes of the author as copyright proprietor.[192] Thus, even if the work of a Russian dissident writer is unpublished, he has a property right in that work that can be compulsorily purchased by the government and, assuming that that alienation is recognized by American courts, the Soviet government would acquire his right to prevent publication of his unpublished work.[193]

On the other hand, if it is held that *samizdat* publication does constitute "publication" within the meaning of the Convention, the result would be entirely different. Under American law, once publication occurs the author must comply with the formalities of the copyright statute (*i.e.*, affixing the copyright notice to each authorized copy of the work), or else his work will become public property. Once publication has

[188] Pushman v. New York Graphic Soc'y, 287 N.Y. 302, 39 N.E.2d 249 (1942); Palmer v. De Witt, 47 N.Y. 532 (1872).

[189] Miller, *Problems in the Transfer of Interests in a Copyright*, 10 ASCAP COPYRIGHT L. SYMPOSIUM 131, 132 (1959).

[190] Shaye, *Piracy Within the Law: A Consideration of the Copyright Protection Afforded Foreign Authors in the United States and the Soviet Union*, 14 ASCAP COPYRIGHT L. SYMPOSIUM 226, 252 (1964).

[191] Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 661 (1834); Palmer v. De Witt, 47 N.Y. 532, 540 (1872).

[192] Miller, *supra* note 189, at 135.

[193] For some reason several observers of the Soviet Union's adherence to the Convention have claimed that the only way in which the USSR can obtain enforceable rights under the Convention is to first publish the work in the Soviet Union. *See Russia and UCC: How It Looks from Moscow*, 203 PUBLISHERS WEEKLY, May 14, 1973, at 31, and Lacy, *supra* note 10, at 16. Why they have made this claim is a mystery. Art. II of the Convention clearly protects the rights of an author in his unpublished as well as his published works.

occurred the author's common law copyright is destroyed,[194] and unless he is protected by a statutory copyright the work will enter the public domain and anyone will be able to reproduce it.[195] The requirement of meeting the statutory formalities at the time of publication applies to works first published abroad as well; if they do not meet the requirements of the statute (or in this case the formalities specified by the Convention), they will be dedicated to the public and they will enter the public domain.[196] Thus, if the Russian author's work is held to have been published when it appeared in *samizdat* under the Convention provision requiring national treatment, unless that work complied with the statutory formalities[197] when it was published in *samizdat,* it became public property. Though this result will be less than satisfactory to the author, who thereby loses any right to royalties he may have had, it will permit his works to be published without government interference.[198]

Though predictions about what does and does not constitute "publication" within the meaning of American copyright law are dangerous, it does appear that the nature of

[194] American Code Co. v. Bensinger, 282 F. 829, 833 (2d Cir. 1922); Rolland v. Henry Holt & Co., 152 F. Supp. 167, 168 (S.D.N.Y. 1957). *See also* Yarnell, *supra* note 152, at 240.

[195] Public Affairs Associates, Inc. v. Rickover, 284 F.2d 262, 269 (D.C. Cir. 1960), *vacated on other grounds,* 369 U.S. 111 (1962) (*per curiam*). *See also* NIMMER, *supra* note 147, § 59, at 229–30, and Pickard, *Common Law Rights Before Publication,* 3 ASCAP COPYRIGHT L. SYMPOSIUM 299, 309–10 (1940).

[196] G.P. Putnam's Sons v. Lancer Books, Inc., 239 F. Supp. 782, 785 (S.D.N.Y. 1965); Ross Products, Inc. v. New York Merchandise Co., 233 F. Supp. 260, 263 (S.D.N.Y. 1964); Basevi v. Edward O'Toole Co., 26 F. Supp. 41, 46 (S.D.N.Y. 1939). *See also* 37 C.F.R. § 202.2(a)(3) (1973).

[197] *See* Copyright Act, 17 U.S.C. § 19 (1970). The Convention also requires formalities of its own that must appear in any published work before it is protected by the Convention. These formalities would have to appear in the *samizdat* publication before it could be protected. *See* the Convention, art. II.

[198] All such a result means is that his works that are published in *samizdat* are in the public domain. Ironically, works published in the USSR prior to adherence to the Convention are in the public domain. Thus, if it is held that *samizdat* constitutes a publication, the Convention would do little to improve the lot of dissident Russian writers. The status quo ante would merely be maintained.

samizdat—surreptitiously receiving a copy of a work from a friend, reading it in secret, possibly making copies of it, and then passing it along—is such that it would not fall within the meaning of the Convention's definition of "publication." Accordingly, the Soviet copyright proprietor would be accorded the protection in this country afforded unpublished works under American law. What this means is that, as the legal copyright proprietor, the Soviet government agency that has compulsorily purchased the common law copyright of a Soviet citizen would be entitled to prevent any American publisher from publishing the work without its permission.

V. CONCLUSION

It would appear that the Soviet government would be in a good position to prevent the publication of the works of dissident authors in the United States. Under the Supreme Court's ruling in *Sabbatino* [199] it seems that the compulsory purchase by the Soviet government of one of its citizen's copyrights would have to be treated as a legitimate transfer of title. Furthermore, as the rightful copyright proprietor, the Soviet government would be entitled to prevent the publication of that work by an American publisher.

Whether or not the Soviet government will test this apparent ability to prevent publication in the United States of the works of dissident authors is difficult to say. Some observers in this country are certain they will.[200] Others have con-

[199] Banco Nacional de Cuba v. Sabbatino, 376 U.S. 398 (1964). The Court ruled that the "Act of State doctrine" precludes courts of this country from inquiring into the validity of public acts which a recognized foreign sovereign power commits within its own territory.

[200] *See, e.g.*, the editorial *Reverse Copyright*, N.Y. Times, Mar. 21, 1973, at 44, col. 1, or the statements of Robert Bernstein, Chairman of the Association of American Publishers, and Robert W. Straus, Jr., of Farrar, Straus & Giroux, quoted in *Moscow Amends Law on Copyright*, N.Y. Times, Mar. 18, 1973, at 5, col. 1. The Russian émigré journal Possev sees Soviet adherence to the Convention as one element of their plan to achieve "Findlandization" (*findlyandizatsii*) of Western Europe; Possev, Mar. 1973, at 2.

cluded that for a variety of reasons the Soviets have no intention to so apply the Convention.[201] Various Soviet officials have stressed that they have no desire to use the Convention to prevent dissidents from publishing in the West.[202] In the only major opportunity for a clarification of Soviet intentions presented since the USSR adhered to the Convention, *i.e.*, the controversy surrounding the publication of Alexander Solzhenitsyn's *The Gulag Archipelago*, the Soviet officials chose to resort to other methods for dealing with the author, rather than using the UCC to prevent publication of the book.[203] Further evidence of the unlikelihood of the Soviet government's using the Convention to stifle dissident writers is provided by the example of other Eastern Bloc nations who have been long-term members of the Convention. Two émigré journals in Paris, *Kultura*, published in Polish, and *Svedectvi*, published in Czech, have frequently obtained material from dissident authors in their homelands and have published it without incurring the displeasure of the Warsaw and Prague governments. To date they have not been sued in French courts, though that possibility does exist.[204] But a contrary example is provided by Samuel Pisar, who writes that in 1965 the Soviet writer Anatoly Kuznetsov (who sub-

[201] *See* Lacy, *supra* note 10, at 15, and quotations of Curtis Benjamin in 203 PUBLISHERS WEEKLY, *supra* note 193, at 31. One executive with Doubleday predicted that the Soviets would allow Western publication of dissident works after expropriating the authors' copyrights, since the royalties would then accrue to the Soviet government. Washington Post, Mar. 1, 1973, at H8, col. 1.

[202] *See* editorial note at 20 BULL. COPYRIGHT SOC'Y 219, 233 (1973), quoting Dr. Yuri Matveev as stating that his personal belief is that Soviet adherence was not intended to be used, "and would not be used to further limit publication abroad of materials written in the Soviet Union." One U.S. publishing executive has quoted a Soviet publishing official as saying that "they would shrink from any suggestion of going into the courts to challenge a U.S. publisher." *See* 203 PUBLISHERS WEEKLY, No. 17, Apr. 23, 1973, at 49.

[203] Though Solzhenitsyn expressed his fear of arrest for violation of the copyright laws in the USSR (*see Solzhenitsyn Quoted as Saying He Expects Arrest Over Book*, N.Y. Times, Jan. 5, 1974, at 8, col. 4), he was, in fact, arrested and quickly deported after being stripped of Soviet citizenship. *See Russians Make Forcible Arrest of Solzhenitsyn*, N.Y. Times, Feb. 13, 1974, at 1, col. 1.

[204] Bethell, *supra* note 4.

sequently defected to the West) sued in French courts a publisher and a translator for publishing an unauthorized and distorted version of his novel *The Continuation of a Legend.* Kuznetsov won the judgment, but in 1969, after defecting to the West, he petitioned the French Ministry of Justice to set aside the judgment on the grounds that he had been compelled to institute the suit by the Soviet government. The French version, he admitted, caught "the very essence of my novel." [205]

The pressures of the Soviet censorship system have led many Soviet writers to circulate their unpublished manuscripts in *samizdat* or to send them abroad for publication in the West. Two such writers, Yuli Daniel and Andrei Sinyavsky, were tried in February 1966 for disseminating "anti-Soviet" writings. The official charges against Sinyavsky and Daniel included:

> The writings of a so-called Soviet literary underground have been widely distributed in the United States, France, Britain and other capitalist countries. Imperial reaction is on the watch for means of ideological subversion to discredit the Soviet people, their government, the Communist Party of the USSR, and its policies. For this purpose, use is being made of slanderous anti-Soviet works of underground writers that are passed off by hostile propaganda as truthful accounts about life in the Soviet Union.[206]

Events in recent years in the Soviet Union, from the Daniel-Sinyavsky trial to the highly publicized campaign against Sakharov and Solzhenitsyn culminating in the latter's expulsion from the USSR, make clear the precarious situation of the Soviet dissident movement. There can be little question that the Soviet officials would like to prevent the publication of the writings of such dissident authors as Sakharov, Amalrik, and others. The question then becomes whether or not they will avail themselves of this particular method—

[205] PISAR, COEXISTENCE AND COMMERCE 364 (1970). For Kuznetsov's recollections of the case *see* Anatol, *The Two Faces of a Soviet Novel,* Daily Telegraph, Aug. 7, 1969, at 16, col. 2.

[206] Quoted in ON TRIAL: THE SOVIET STATE VERSUS "ABRAM TERTZ" AND "NIKOLAI ARZHAK" 4 (M. Hayward ed. 1966).

whether they will enter an American court to enjoin publishers from publishing the works of these dissidents. The answer to that question, at least in the mind of this writer, is a qualified "no"—the Soviets will not attempt to use the Convention to prevent the publication of the works of dissident writers. Though they may well have the legal capacity to do so, it is unlikely that they will avail themselves of this capacity for two reasons.

First, the harmful publicity generated by such a lawsuit would be disastrous to the present efforts of the Soviet Union to attain a measure of détente with the United States. The spectacle of a trial in the United States to decide whether or not the Soviets could censor their domestic writers would certainly be destructive of any good feelings in the United States for the Soviet Union which recent Soviet initiatives have produced. The image of an American attorney representing an American publisher questioning in open court a Soviet official about the mechanics of *samizdat,* why *samizdat* publication is necessary, why the Soviet government objects to the publication of this particular work, and so on, would give pause to the most ardent neo-Stalinist in the Soviet bureaucracy. Not only would such an action be profoundly embarrassing, but it would generate waves of hostile publicity. At a time when the Soviet Union is anxious to acquire Western technological know-how and assistance it is unlikely that they would consciously encourage such publicity. It should be noted, though, that such publicity would only attend a trial in which the works of a major author were at stake. The Soviet officials might well be able to bring suit to enjoin publication of the works of a lesser-known Soviet writer without incurring such deleterious publicity.

But the second reason why the Soviets will not follow such a course is more persuasive: there is no need for the government of the USSR to rely on the courts of their major capitalist rival to suppress their domestic dissidents. Certainly, bringing suit in American courts is not the most elegant way

of stifling dissident authors. In the past Soviet officials have demonstrated their resourcefulness in finding ways to suppress dissident voices. They can always simply try them on a variety of charges, as with Yakir and Krasin,[207] or they can confine them to a mental institution, as with Pyotr Grigorenko and many others.[208]

Soviet law provides an enterprising prosecutor with several violations for which any author sending his works abroad, or even publishing them in *samizdat*, could be convicted. The foremost of these, article 70 of the Criminal Code of the Russian Soviet Federative Socialist Republic—the Soviet Union Republic which comprises the bulk of the USSR—provides:

> Agitation or propaganda carried on for the purpose of subverting or weakening the Soviet regime or of committing particular, especially dangerous crimes against the state, or the circulation for the same purpose of slanderous fabrications which defame the Soviet state and social system, or the circulation or preparation or keeping for the same purpose, of literature of such content, shall be punished by deprivation of freedom for a term of six months to seven years, with or without additional exile for a term of two to five years, or by exile of two to five years.[209]

This provision, under which Daniel and Sinyavsky, Krasin, Yakir, and many others have been convicted, provides an obvious criminal charge under which any Soviet citizen participating in *samizdat* or helping transfer a manuscript abroad can be convicted.[210] Indeed, article 70 probably con-

[207] *See Two Soviet Dissidents Get Prison and Exile*, Washington Post, Sept. 2, 1973, at A3, col. 1.

[208] *See generally, Hearings on Abuse of Psychiatry for Political Repression in the Soviet Union Before the Subcomm. on Internal Security of the Senate Comm. on the Judiciary*, 92d Cong., 2d Sess. (1972).

[209] R.S.F.S.R. 1960 Ugol. Kod. (Criminal Code) § 70 (1962), in Soviet Criminal Law and Procedure 153 (Berman & Spindler trans., 2d ed., 1972).

[210] It is not necessary that publication of such slanderous writings appear in the West before an offense under art. 70 occurs. Circulation of a manuscript in *samizdat* within the USSR is sufficient to constitute a violation. Burg & Feifer, Solzhenitsyn 273 (1972).

stitutes a greater threat to Soviet dissident writers than the possibility of state acquisition of their copyrights.[211]

In addition to prosecution under article 70 there are a variety of criminal law provisions that could form the basis for prosecutions of Soviet writers who send their manuscripts abroad. Some Soviet dissidents, such as the poet Joseph Brodsky, have been tried and convicted under the "antiparasitism" law of the USSR.[212] There is also the possibility that writers who smuggle their works out of the Soviet Union could be prosecuted under postal legislation or customs regulations.[213]

Beyond criminal law prosecutions there are several techniques by which the Soviet government could economically punish dissident writers. Deprivation of membership in the Union of Soviet Writers would end for these individuals the various economic and political privileges accorded members of the artistic unions as well as their ability to publish their works. A recent article in the Soviet press seemed to threaten writers who smuggle their manuscripts out of the USSR with precisely this sanction.[214] In addition, though it is no longer a criminal offense to violate the laws regarding the state monopoly on foreign trade,[215] an agreement which was

[211] *See* Bethell, *supra* note 4.

[212] *See* Burford, *Getting the Bugs Out of Socialist Legality: The Case of Joseph Brodsky and a Decade of Anti-Parasite Legislation*, 22 AMER. J. COMP. L. 465 (1974).

[213] Maggs, *New Directions in U.S.-USSR Copyright Relations*, 68 AM. J. INT'L L. 391, 394–95 (1974).

[214] Yurchenko, "*Misha Skameykin*" *iz Londona* ["Misha Skameykin" from London], Sovetskaya Rossiya, Jan. 12, 1974, at 4, col. 5. *See also Soviet Threatens to Blacklist Writers Smuggling Out Works*, N.Y. Times, Jan. 13, 1974, at 27, col. 1.

[215] Both the Soviet Constitution and the RSFSR Civil Code provide that only government authorities are empowered to conduct foreign trade. *See* KONSTITUTSIYA (OSNOVNOY ZAKON) [Constitution (Basic Law)] art. 14(h) (USSR, 1936), *and* RSFSR 1964 GRAZH. KOD. (Civil Code) § 45 (1965). Prior to 1959 violations of the state monopoly on foreign trade were considered to be crimes against the state. RSFSR 1926 UGOL. KOD. (Criminal Code) § 59 (1926). But since the revision of the RSFSR Criminal Code in 1959 such actions have not been considered criminal violations.

concluded other than through the VAAP will be deemed invalid and any royalties earned under the contract will be turned over to the Soviet government.[216] But if the author actually receives royalties from his Western publisher he is liable to criminal prosecution under the Soviet law which prohibits private currency transactions.[217]

It should be readily apparent that the Soviet government has sufficient means—judicial or extrajudicial—to suppress a particular Soviet dissident. When the potentially disastrous publicity associated with an American trial is balanced against the relative ease with which the Soviets could prosecute their domestic dissidents under any of the provisions of Soviet law mentioned above, or could simply confine them to an asylum, it seems highly likely that they would choose to follow the path of least resistance, forego the rigors of an American court test, and resort to the time-tested methods they have been using for over half a century.

[216] *See* the resolution of the USSR Council of Ministers of December 1973 extracted in Izvestiya, Dec. 27, 1973, at 2, col. 7. Boris Pankin had alluded to the possible use of these provisions in an earlier interview. *See VAAP: tseli i zadachi*, LITERATURNAYA GAZETA, *supra* note 59.

[217] RSFSR 1960 UGOL. KOD. (Criminal Code) § 88 (1962).

NATIONAL SECOND PRIZE, 1974

Goldstein v. California: Breaking Up Federal Copyright Preemption

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ON JUNE 18, 1973, the Supreme Court, in the case of *Goldstein v. California*,[1] upheld California's "record piracy" statute [2] against preemption either by the United States Constitution or the federal copyright law. That decision represents perhaps the most significant copyright development since the *Sears* and *Compco* cases in 1964,[3] and until passage of the long-pending revision of the entire federal copyright law.[4] The *Goldstein* reasoning, while not guaranteeing state authority in any area other than record piracy, nonetheless indicates a willingness on the part of the Supreme Court to consider preemption separately in other copyright cases; no longer will preemption be presumed under the blunderbuss approach of *Sears* and *Compco*. Although the Copyright Revision Bill would purportedly prescribe exclusive federal law

[1] 412 U.S. 546, *rehearing denied*, 414 U.S. 883 (1973).

[2] Calif. Pen. Code § 653h (a) (1) (Deering, 1971).

[3] Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, *rehearing denied*, 376 U.S. 973 (1964); Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234, *rehearing denied*, 377 U.S. 913 (1964).

[4] The current bill is S.1361, 93d Cong., 1st Sess. (1973) [hereinafter cited as Revision Bill]. [EDITOR'S NOTE: After this article was written, the bill, in modified form, was enacted as Pub. L. No. 94-555 (Oct. 19, 1976).]

in the field of copyrights, the bill as now worded would leave many of the same gaps which exist in the current statute[5] and which accounted for the record piracy decision. The *Goldstein* case should therefore be of ongoing importance in the field of copyright law.

This article will present a brief introduction to the state of copyright law as it existed in 1973, followed by a short analysis of the *Goldstein* case. The second section of the paper analyzes the preemption test proposed in *Goldstein*, by reference mainly to interstate commerce cases, and suggests other, more workable bases for reconciling the *Goldstein* and the *Sears-Compco* decisions. The final section examines some of the areas of copyright law which may be affected by *Goldstein*, anticipating how the Supreme Court is likely to, or should, rule in such cases.

I. THE SIGNIFICANCE OF GOLDSTEIN

PRE-GOLDSTEIN: SEARS AND COMPCO

The 1964 companion cases *Sears, Roebuck & Co. v. Stiffel Co.* and *Compco Corp. v. Day-Brite Lighting, Inc.*, reversing lower court decisions which had allowed state unfair competition protection for articles unprotected by federal patents, produced considerable reaction from the commentators.[6] The relatively short opinions, delivered by Justice Black with no dissents and only one separate concurring opinion, were couched in sweeping terms, even though a narrow holding would have been sufficient to decide the cases. The Court said that a state could require proper labeling "or other precautionary steps" to prevent customer confusion, but could not "prohibit the copying of the article itself

[5] *See* notes 136–41 *infra* and accompanying text.

[6] *See, e.g.*, Leeds, Handler, Derenberg, Brown & Bender, *Product Simulation: A Right or a Wrong?*, 64 COLUM. L. REV. 1178 (1964) [hereinafter cited to the respective authors as *Product Simulation*].

or award damages for such copying." [7] It was clear from the language the Court used that it intended the rule to apply to copyrights as well as patents; a state could not interfere with the right to copy "whatever the federal patent and copyright laws leave in the public domain." [8]

The *Sears-Compco* decisions, at least on their faces, superseded a development of legal theory by which states had previously sought to define for themselves a broader scope of protective authority. It had been almost universally assumed that a theory of unfair competition was valid in its traditional sense upon proof of (1) "appropriation" of a protectable product; (2) "passing off" or "palming off," that is, attempting to confuse customers as to the source of a marketed article; and (3) competition in the product.[9] Such unfair competition was not always provable, so many states—particularly New York and California—developed a new "misappropriation" theory which did not require proof of either passing off or competition in the product.[10] Justice Harlan, concurring in the *Sears-Compco* decisions, apparently would not extend the reach of unfair competition to mere misappropriation.[11] Justice Black, however, was unwilling to rest the cases on that basis, and apparently swept away the old unfair competition along with the newer misappropriation doctrine. Questioning the appellate court's reasoning in abandoning the requirement of passing off, Black says that "[b]ecause of our disposition of these cases we need not decide whether it was correct in doing so." [12]

[7] 376 U.S. at 231–33.

[8] *Id.* at 237.

[9] *See, e.g.*, Ringer, *The Unauthorized Duplication of Sound Recordings*, 1 STUDIES ON COPYRIGHT 117, 135 (1963); Victor Talking Mach. Co. v. Armstrong, 132 F. 711 (S.D.N.Y. 1904).

[10] For a thorough analysis of the old passing-off test, as well as development of the misappropriation doctrine, *see* Note, *Developments in the Law—Competitive Torts*, 77 HARV. L. REV. 888 (1964) [hereinafter cited as *Competitive Torts*].

[11] 376 U.S. at 239.

[12] 376 U.S. at 228, n.2.

In the field of copyrights, the lower courts often refused to give the *Sears-Compco* reasoning its broadest interpretation. One way of denying federal preemption of otherwise valid state theories was to deny that there was a "publication." [13] Since the traditional dividing line between federal and state authority is in the distinction between "published" and "unpublished" works,[14] and since the current statute itself preserves to the states jurisdiction over unpublished works,[15] nonpublication theoretically left a particular work within the realm of state authority. Some commentators argued, however, that as a result of the *Sears-Compco* decisions publication was necessarily a federal issue to be determined under the statute.[16]

The more common ground for preserving state authority was, ironically, the misappropriation doctrine, which even Harlan would have disallowed. The misappropriation loophole was partly due to the Supreme Court's failure to overrule the case of *International News Service v. The Associated Press*,[17] which had allowed common law protection of news without the necessity of passing off. But also, the definition of misappropriation was refined so as to connote physical use of one copy to make another, rather than mere reproduction by one's own efforts, essentially by imitation. In any case, many lower courts used the misappropriation doctrine despite any statements in *Sears-Compco* to the contrary—and especially to condemn record piracy, in which "mis"-appropriated copies were used as the masters from which to physically make other copies.[18]

[13] *See, e.g.*, note 114 *infra* on architectural plans and fashion designs.

[14] *See, e.g.*, Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469 (1955).

[15] 17 U.S.C. § 2.

[16] *See, e.g.*, Goldstein, *Federal System Ordering of the Copyright Interest*, 69 COLUM. L. REV. 49, 52–53 (1969), analyzing Judge Learned Hand's approach.

[17] 248 U.S. 215 (1918).

[18] *See, e.g.*, Tape Indus. Ass'n of America v. Younger, 316 F. Supp. 340 (C.D. Cal. 1970), *appeal dismissed for lack of jurisdiction*, 401 U.S. 902 (1971);

Some writers detected a weakening of the *Sears-Compco* doctrine in the case of *Lear, Inc. v. Adkins.*[19] The doctrine has been further eroded by the recent case of *Kewanee Oil Co. v. Bicron Corp.*,[20] which itself relied heavily on the *Goldstein* precedent. The Supreme Court held, in an opinion by Chief Justice Burger, that state trade secret protection is not preempted by federal patent law.

THE GOLDSTEIN CASE

"Record piracy" and "tape piracy" had become booming enterprises in the United States[21] because until 1972[22] records and tapes were apparently not copyrightable as such under the Federal Copyright Act.[23] Many courts therefore protected against such piracy on state grounds, even in the face of *Sears-Compco* doubts. California, in particular, passed a statute which made it a misdemeanor to transfer "any sounds recorded on a phonograph record . . . tape . . . or other article on which sounds are recorded, with intent to sell or cause to be sold . . . such article on which such sounds are so transferred, without the consent of the

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Liberty/UA, Inc. v. Eastern Tape Corp., 11 N.C. App. 20, 180 S.E.2d 414, *cert. denied*, 278 N.C. 702, 181 S.E.2d 600 (1971); Columbia Broadcasting System, Inc. v. Custom Recording Co., 258 S.C. 465, 189 S.E.2d 305, *cert. denied*, 409 U.S. 1007 (1972) and cases cited therein. *Contra*, International Tape Mfrs. Ass'n v. Gerstein, 344 F. Supp. 38 (S.D. Fla. 1972), *vacated*, 494 F.2d 25 (5th Cir. 1974).

[19] 395 U.S. 653 (1969). *See, e.g.*, Note, *The "Copying Misappropriation" Distinction: A False Step in the Development of the Sears-Compco Pre-Emption Doctrine*, 71 COLUM. L. REV. 1444, 1454–55 (1971); Goldstein, *The Competitive Mandate: From Sears to Lear*, 59 CALIF. L. REV. 873, 883–86 (1971) [hereinafter cited as *Competitive Mandate*].

[20] 416 U.S. 470 (1974). The reasoning of the case is more palatable than that in Goldstein, resting not on a simple "categories" test but on a more thorough weighing of state and federal interests in protection.

[21] *See, e.g.*, Yarnell, *Recording Piracy is Everybody's Burden: An Examination of Its Causes, Effects and Remedies*, 20 BULL. COPYRIGHT SOC'Y 234 (1973).

[22] Protection is available for records cut after 1972 under the Record Piracy Act of 1971, 85 Stat. 391, 17 U.S.C. §§ 1(f), 5(n), 19, 20, 26, 101(e). *See generally* Note, *The Sound Recording Act of 1971: An End to Piracy on the High ©'s?*, 40 GEO. WASH. L. REV. 964 (1972).

[23] 37 C.F.R. § 202.8(b) (1973). 37 C.F.R. § 202.15a was added only in 1972.

owner."[24] Donald Goldstein, Ruth Koven, and Donald Koven pleaded nolo contendere to ten counts under the statute; were given a six-month suspended sentence, a $500 fine, and a three-year injunction against copying without the consent of record owners;[25] and eventually appealed to the United States Supreme Court. In a five to four decision, the Supreme Court upheld the state statute. And although the Court could have affirmed on any of several grounds previously used to ban record piracy,[26] Chief Justice Burger chose the *Goldstein* case to retreat from the *Sears-Compco* implications championed by Justice Black nine years earlier. Justices

[24] Calif. Pen. Code S653h(a)(1) (Deering 1971). Other states which now ban record piracy are Arizona, Arkansas, Connecticut, Florida, Indiana, Kentucky, Louisiana, Maryland, Massachusetts, Minnesota, Mississippi, Nebraska, Nevada, New Hampshire, New Mexico, New York, North Carolina, Ohio, Oregon, Pennsylvania, Tennessee, Texas, Utah, Virginia, and Washington. For a review of the applicable statutes as of June 1974, *see* 21 BULL. COPYRIGHT SOC'Y 303 (1974).

[25] The proceedings in the Municipal Court for Los Angeles County and the Appellate Department are unreported. The Appellate Court had avoided the Constitutional issue by simply citing Tape Indus. Ass'n. of America v. Younger, 316 F. Supp. 340 (C.D. Cal. 1970) and finding that § 653h "is [a] permissible state regulation directed against theft and appropriation of salable products and does not unconstitutionally intrude on federal policies enunciated in the Copyright Clause." *Id.* at 351. The Appellate Court certified transfer to the California Court of Appeals, but transfer was eventually denied. Certiorari was then filed with the United States Court. *See generally: Supreme Court Asked to Forbid State Protection of Sound Recordings Fixed Prior to February 15,* 70 PAT., T.M. & COPYRIGHT J. A-4 (BNA) (Summary of the case and Supreme Court briefs); *Supreme Court to Rule on Status of Uncopyrighted Sound Recordings,* 80 PAT., T.M. & COPYRIGHT J. A-9; *Supreme Court Hears Oral Argument in Sound Recording Piracy Case,* 107 PAT., T.M. & COPYRIGHT J. A-2 (Summary of oral argument (1972).

[26] The Court could have affirmed either on the nonpublication or misappropriation theories, or could have found federal coverage, as in the case of Duchess Music Corp. v. Stern, 458 F.2d 1305 (9th Cir.), *cert. denied.* 409 U.S. 847 (1972). The effect of *Goldstein* on the *Duchess* reasoning is unclear. Finding in favor of the argument that federal protection is available for pre-1972 recording are Edward B. Marks Music Corp. v. Colorado Magnetics, Inc., 497 F.2d 285 (10th Cir. 1974), *cert. denied.* 43 U.S.L.W. 3403 (U.S. Jan. 21, 1975) and Fame Publishing Co., Inc. v. S & S Distributors, Inc., 363 F. Supp. 984 (N.D. Ala. 1973). *But see* Jondora Music Publishing Co. v. Melody Recordings, Inc., 362 F. Supp. 488, 494 (D.N.J. 1973).

Douglas and Marshall filed dissenting opinions, in which Justices Brennan and Blackmun joined.

The most concrete and immediately useful change of emphasis is in a reappraisal of the statutory intention to be ascribed to the phrase "all writings" in section four of the federal statute. In the *Sears-Compco* cases, Justice Black had argued that Congress weighed the anticompetitive effect of patents and copyrights and reached the unique balance which under the supremacy clause was binding upon the states. In the case of copyrights, such an argument presumes that "all writings" brings all constitutionally copyrightable works into the federal realm, except for the section two reservation for unpublished works, and that any omissions in coverage are deliberate.[27] Justice Burger, on the other hand, admits that sixty years of congressional, administrative, and court interpretation has left "all writings" at something less than the full constitutional scope of Congress's power. The implication of Congress's failure to include a particular type of writing in the copyright law is not that it intended to leave the writing in the public domain, but rather that "it has left the area unattended, and no reason exists why the State should not be free to act." [28]

The other definite shift in emphasis is evidenced by Burger's constitutional presumption concerning delineation of state and federal authority. Although the earlier Black decisions had rested mainly on a presumed congressional intent, there was, aside from congressional action, an almost constitutionally compelled argument for absolute preemption.[29]

[27] Marshall's Goldstein dissent would rest upon this presumed statutory construction. Interestingly enough, the Goldstein briefs did not focus on section four. *See* Petitioner's Brief for Rehearing, 137 PAT., T.M. & COPYRIGHT J. A-1, A-2 (1973).

[28] 412 U.S. at 567–70, quote at 570.

[29] *See* Aro Mfg. Co. v. Convertible Top Replacement Co., 377 U.S. 476, 522 (1964) (Black, J., dissenting). Douglas, in his Goldstein dissent, repeats the emphasis on a constitutional basis. *See* 412 U.S. 572.

The requirement of national uniformity, for example, rather than being read as an aid to statutory construction, was read back into the constitutional clause itself.[30] Thus, Madison's assertion in *The Federalist*, No. 43, that states "cannot separately make effectual provision" for either patents or copyrights[31] is interpreted by Black so as to prevent the states from even trying.[32] Burger, on the other hand, easily finds that the constitutional clause neither grants exclusive power to the federal government nor expressly prevents the states from exercising their own power.[33] The presumption, on the constitutional level, is therefore in favor of the states; and Burger seems more willing to allow this presumption to be decisive in the face of congressional silence or ambiguity.

The interesting result is that states may, in one sense, enact broader protection than the federal government. The constitutional provision for copyrights "for limited Times" constrains the power of Congress;[34] but Burger construes the provision, as a reading on its face requires, to apply to federal and not state action.[35] By such reasoning, states could even grant copyrights not limited by the necessity of promoting the progress of science and useful arts. The antidote to the presumed unlimited state power is in the narrowness of effective protection. One state's copyright cannot appreciably affect interstate commerce, according to Burger, precisely because of the natural limitations recognized by Madison in *The Federalist* No. 43.

[30] The copyright clause does not itself mention uniformity, though the word was used when it was intended that federal jurisdiction be exclusive. *See* U.S. CONST., art. 1, § 8, cl. 4, on naturalization and bankruptcy.

[31] A. HAMILTON, THE FEDERALIST No. 43 (Cooke ed. 1961) 288.

[32] 376 U.S. at 228–29.

[33] 412 U.S. at 553, citing the three means of federal preemption described in THE FEDERALIST No. 32 at 241 (B. Wright ed. 1961).

[34] *See generally*, M. NIMMER, NIMMER ON COPYRIGHT § 5 (1976) [hereinafter cited as NIMMER].

[35] 412 U.S. at 560–61.

II. THE PREEMPTION TESTS

PREEMPTION OF SPECIFIC WRITINGS

Analogy to or Application of Interstate Commerce Cases. It is possible to argue that the commerce clause rather than the copyright clause is the more logical source for deriving from a Copyright Act any affirmative requirement that a writing be in the public domain. Copyright is something of a congressional string holding back from free access on the open market certain protected writings—the string itself can't work, or shouldn't work, to push other writings into that market. Congress might well conclude that arts and sciences are promoted by encouraging free access to ideas; but such a conclusion would rest inherently upon its power over interstate commerce generally.[36] If so, it is even arguable that Congress's decision would thus have less "preemptive capability" than a federally protective determination directly pursuant to the copyright clause.[37] In view of this argument, Justice Burger's analysis of several interstate commerce cases [38] to support the proposition that state law is only preempted by necessarily conflicting congressional enactments takes on special significance. In any case, interstate commerce represents the most clearly developed area of pre-

[36] *Cf.* Leeds, *Product Simulation, supra* note 6, at 1179–80, tracing the right to copy to the common law; *Competitive Mandate, supra* note 19, at 875. For possible basis of copyright implications in the Commerce Clause, *see* NIMMER § 9.1. *See also* Kurlantzick, *The Constitutionality of State Law Protection of Sound Recordings*, 5 CONN. L. REV. 204 (1972). "[I]f particular state laws prove to unduly fractionalize the national market or to discriminate in favor of local industries, judges may apply the commerce clause to invalidate such exercises of state power." *Id.* at 222.

[37] *See generally* Engdahl, *Preemptive Capability of Federal Power*, 45 U. COLO. L. REV. 51 (1973).

[38] Hines v. Davidowitz, 312 U.S. 52 (1941); Cooley v. Board of Wardens, 53 U.S. (12 How.) 299 (1851); and Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1 (1824).

emption doctrine, so that an examination of it is essential to a proper understanding of the *Goldstein* case.

Preemption in the regulation of interstate commerce has traditionally been decided either upon "dormant" constitutional grounds or upon congressional exercises of power pursuant to a constitutional grant.[39] The precise measure of the dormant constitutional test, however, was never quite clear. Chief Justice Marshall's emphasis upon the purpose of regulation[40] gave way to an emphasis upon the effect of local actions on interstate commerce.[41] The "mechanistic" distinction between direct and indirect effects was subsequently criticized,[42] but new tests proved just as difficult of application,[43] perhaps because the Constitution, necessarily general in nature, and especially so in the powerfully loaded commerce clause, provides insufficient definition of the scope of federal ordering against which to measure particular state activities.[44] Some writers in fact noted an historical trend away from the dormant constitutional test and toward a reliance upon statutory preemption as a preferred tool of interpretation.[45]

But the new test didn't always solve the problem. There

[39] *See* G. GUNTHER & N. DOWLING, CASES AND MATERIALS ON CONSTITUTIONAL LAW 614 (8th ed. 1970); Sholley, *The Negative Implications of the Commerce Clause*, 3 CHI. L. REV. 556, 559 (1936).

[40] Gibbons v. Ogden, 22 U.S. (9 Wheat.) 1, 199, 203–4 (1824).

[41] *See, e.g.*, Di Santo v. Pennsylvania, 273 U.S. 34 (1927).

[42] *See, e.g.*, Stone's dissent in Di Santo v. Pennsylvania, 273 U.S. 34, 43 (1927); South Carolina State Highway Dept. v. Barnwell Bros., 303 U.S. 177, 187–90 (1938).

[43] *See, e.g.*, Southern Pacific Co. v. Arizona, 325 U.S. 761 (1945), in which C. J. Stone essentially reverts to the old dormant constitutional standards.

[44] This emphasis is not inconsistent with Paul Goldstein's warning that state power should be measured by the constitutional "competitive mandate" instead of federal copyright law. *See Competitive Mandate, supra* note 19. Nevertheless, the federal statute determines which areas are preempted.

[45] *See* Hart, *The Relations Between State and Federal Law*, 54 COLUM. L. REV. 489, 526, n.136 (1954); Note, *Pre-Emption as a Preferential Ground: A New Canon of Construction*, 12 STAN. L. REV. 208 (1959) [hereinafter cited as *Preferential Ground*].

developed an intermediate or hybrid approach to preemption, with standards often indistinguishable from those applied under the dormant constitutional test.[46] Although a constitutional clause might not of itself preempt, it might carry such a constitutional presumption that *any* congressional enactment in the field becomes preemptive, without much regard for specific intent or purpose.[47] The *Sears-Compco* argument represented just such a hybrid approach.[48]

One writer has detected a trend, since 1933, away from such a treatment of preemption problems and toward a more honest reliance upon specific congressional intent to preempt.[49] Such an adoption of the statutory preemption test not as a constitutional decoy but as a genuine tool of analysis should provide a more realistic base against which to compare state actions, and avoid creation of gaps where Congress, for one reason or another, fails to act. The *Goldstein* test would, of course, be part of any such trend away from the hybrid test; but it must be conceded that the policy of looking to Congress for determination of preemption issues did not evolve from the dormant preemption view, or even the hybrid view, but has, since the time of *Gibbons* and *Cooley*, existed side by side with those views.[50] The Supreme Court simply chooses as best it can whether the "nature" of regula-

[46] *See Preferential Ground*, *supra* note 45, at 220.

[47] "Intent" was often seen in terms of "occupying the field" or "taking the particular subject matter in hand." *See generally* Note, *"Occupation of the Field" in Commerce Clause Cases, 1936–1946: Ten Years of Federalism*, 60 HARV. L. REV. 262, 266 (1946) (discussing the "preclusion test").

[48] *Cf.* Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409 (1956). "Copyright, unlike commerce, is a narrow field where the presence of a compendious statute quite naturally invites the inference that rights are not to be created dehors the sattute." *Id.* at 430.

[49] *See* Engdahl, *supra* note 37, at 54–55.

[50] Chief Justice Taney, for example, believed that a constitutional grant of power could not work a preemption without specifically conflicting legislation by Congress. *See* The License Cases, 46 U.S. (5 How.) 504, 578–79 (1847) (Taney, C.J., announcing six concurring opinions). *See also* the *Gibbons* and *Cooley* cases themselves, cited at note 38 *supra*.

tion in the particular area requires one test or another, and then by a necessarily question-begging standard follows that decision for all cases in the same field.[51] Generalizations from one field to another are avoided by referring the decision to statutory interpretation, but rarely does the statute direct whether the constitutional, congressional, or hybrid test should be applied. It can only be assumed that the equities of the record piracy cases weighed heavily enough upon the consciences of the justices to warrant a change from what was presumed for nine years to be the applicable test in the field of copyrights.

Rejection of the hybrid preemption test in favor of the pure statutory test does not necessarily dispose of constitutional considerations. The dormant constitutional test has been used not only to preempt fields which by their nature require that regulation come, if at all, from Congress; there has also been something of an incorporation of fourteenth-amendment standards into the interstate commerce clause. There is, for example, a line of decisions which holds state regulation invalid for discriminating against out-of-state interests.[52] There is even some broad language in the decisions which might be construed to limit a state's ability to regulate the nature of imported goods legitimately produced in other states, except in certain circumstances when matters of public health, safety, or morals are nondiscriminatorily controlled under the police power, or when the regulation is to prevent fraud.[53] In light of these cases some question must be raised to Burger's statement in *Goldstein* that "[t]he

[51] *See, e.g.*, Sholley, *supra* note 39, at 558.

[52] *See, e.g.*, H.P. Hood & Songs v. Du Mond, 336 U.S. 525 (1949) (access of foreign buyers to local resources); South Carolina Highway Dept. v. Barnwell Bros., 303 U.S. 177, 185–90 (1938); Baldwin v. G.A.F. Seelig, Inc., 294 U.S. 511 (1935) (access of foreign sellers to local markets).

[53] *See, e.g.*, Baldwin v. G.A.F. Seelig, Inc., 294 U.S. 511 (1935) and cases cited at 525; South Carolina Highway Dept. v. Barnwell Bros., 303 U.S. 177, 189–90 (1938). *See generally* Kurlantzick, *supra* note 36, at 238–43.

subject matter to which the Copyright Clause is addressed may at times be of purely local concern." [54] What is it, exactly, that gives California a particular interest in protection? What makes a work "not worthy of national attention" and yet of valuable "local importance"? It is only partly in the promotion of other, as yet unwritten works: what really prompted the California legislature was not an altruistic concern for the state of the arts, but a very immediate economic interest in a vital local industry. To the extent that protection of that industry will cut off from the California market a record- and tape-piracy industry in a state that allows it, then California might be said to discriminate in favor of local economic interests, or to unduly regulate imports in interstate commerce.

Burger states that citizens of other states are relatively unaffected by local copyright statutes, because they "remain free to copy within their borders those works which may be protected elsewhere." [55] But Burger doesn't cite the other half of the statute,[56] which holds equally guilty of a misdemeanor a person who "[s]ells any such article with the knowledge that the sounds thereon have been so transferred without the consent of the owner." [57] The statute therefore bars not only outgoing but also incoming pirated works; and prohibiting distribution of tapes in California which

[54] 412 U.S. at 560. The emphasis upon "local concern" is analogous to the emphasis upon community standards in the obscenity cases handed down three days following Goldstein. *See* the Obscenity Cases, beginning with Miller v. California, 413 U.S. 15 (1973).

[55] 412 U.S. at 558.

[56] Burger was aware of the problem, however. *See Supreme Court Hears Oral Argument in Sound Recording "Piracy" Case,* 107 PAT., T.M. & COPYRIGHT J. A-2, A-3 (1972).

[57] Calif. Pen. Code § 653h(a)(2) (West 1970). Sellers would know that the tapes had been pirated, since the piraters labeled their records as having been made without the consent of the original recording companies. *See* 412 U.S. at 549–50, n.4. This labeling was to avoid the "passing off" aspect in those jurisdictions which still allowed traditional unfair competition but not misappropriation causes of action.

were made elsewhere in complete compliance with local law raises arguably more serious interstate commerce questions.[58] In view of the close five to four decision reached even in the appealing *Goldstein* situation, such arguments should not yet be disregarded. Even raising the issue might force the Court into the awkward position of having to admit that state law is tolerable not because it has no appreciable effect upon the interests of other states but because the law coincides with the national interest, partly as the Court wishes it were, and partly as expressed by the "public policy" of the Record Piracy Act of 1971.[59]

Congressional Intent. For whatever reasons of logic or conscience, the Supreme Court in the *Goldstein* case established as law the congressional intent preemption test for copyrights. The appeal of this test is that it should presumably be easy to apply, at least in those cases in which Congress purports to exclude or save state law. But even then, Congress's determination is not necessarily conclusive of each particular case.[60] Section two of the Copyright Act, for instance, reserves to the states common law authority over unpublished works; but it was not clear until the *Goldstein* decision whether publication was itself a state or federal issue.[61] If there is ambiguity in a congressional expression of intent, then it is not surprising that the meaning of congressional silence is even harder to discern.[62] In his dissent to *Gold-*

[58] *See generally* Kurlantzick, *supra* note 36, at 238–48.

[59] *See* Note, *The Supreme Court, 1972 Term*, 87 HARV. L. REV. 1282 (1973). "[F]or the courts to sanction widespread state protection of a particular type of work because of its potential national importance would seem to involve state legislatures in the type of national decision that Congress can best make." *Id.* at 286.

[60] *See, e.g.*, Pennsylvania v. Nelson, 350 U.S. 497 (1956), discussed in *Preferential Ground, supra* note 45, at 208, 212–13.

[61] *See* note 16 *supra*.

[62] *See generally* Cleveland v. United States, 329 U.S. 14, 22 (1946) (Rutledge, J., concurring); Sholley, *supra* note 39, at 583; Bikle, *The Silence of Congress*, 41 HARV. L. REV. 200 (1927).

stein, Marshall concedes that "it is generally difficult to infer from a failure to act any affirmative conclusions," but in the *Sears-Compco* cases, as a rule of construction "the Court determined that with respect to patents and copyrights, the ordinary practice was not to prevail," [63] and intent to preempt would be presumed.

The Copyright Act does not give specific voice to its preemptive intent, except in the reservation for unpublished works, and except as might be inferred from the language of section four on "All Writings of an Author Included." Congressional debate on the Copyright Act is likewise not helpful, since the Act was rushed through Congress almost without debate in an eleventh-hour congressional whirlwind.[64] It should be relatively clear from the committee reports, on the bill which was to become the Copyright Act and its immediate predecessor bill, that there was an intent to make statutory "writings" coextensive with the constitutional scope of power, and thus "attend" to all permissible categories.[65] In the report to the predecessor bill, previous law is criticized for its imperfection in speaking only to specific items, "requiring frequent additions to cover new forms or new processes." [66] The wording is sought which will make most clear that the subject matter is to expand with the Constitution; and it is

[63] 412 U.S. at 577.

[64] 43 CONG. REC., 60th Cong., 2d Sess., 3746–47, 3765–69 (1909).

[65] See H.R. REP. No. 7083, 59th Cong., 2d Sess. (1907) (to accompany H.R. 25133). "Section 4 uses the word 'works' as the equivalent of the constitutional word 'writings'. . . . The word 'works' is used in preference to 'writings' in order to make the provision consistent with the construction which the courts have in a long series of cases given to the word 'writings.'" *Id.* at 10. See also S. REP. No. 6187, 59th Cong., 2d Sess. (1907) (to accompany S. 8190). "As thus interpreted, the word 'writings' would to-day in popular parlance be more nearly represented by the word 'works'. . . . The bill in its general definition substitutes a general term, 'all the works of an author'. . . . Particular subject-matter (*e.g.,* books) is then specified only in connection with registration." *Id.* at 4. In the 1909 Act, the word "writings" was preferred, but the intent was the same. *See* note 67 *infra.*

[66] S. REP. No. 6187, 59th Cong., 2d Sess. (1907) at 4.

decided that the word "writings" can best guarantee that "it is not intended . . . to change in any way the [constitutional] construction which the courts have given it." [67]

It is also obvious, however, that the reason for making statutory writings coextensive with congressional writings was to guarantee immediate copyright coverage for emerging methods of technology. But in fact the courts were unwilling to follow the accordion so as to fulfill this congressional intent, and for one reason or another, sometimes because of prior determinations by the Copyright Office, interpreted the statute so as to leave gaps. Thus it is court interpretations which have thwarted congressional intent. The courts only compound the injury by imputing to Congress the intent to preempt without recognizing the more important intent to protect. A compromise that would come closer to matching the 1909 congressional intent to allow protection for newly developing areas susceptible to copyright is to at least allow the states to give that protection pending a definitive congressional resolution one way or the other.

Beyond the problems of determining original congressional intent are the generally recurring headaches of statutory construction arising from subsequent actions of administrative agencies and Congress itself. For example, the Copyright Office specifically excludes from federal protection words and phrases, titles, typography, and ideas.[68] It can be argued, of course, that administrative determinations of this kind are "incorporated" into Congress's structure by acquiescence over time; or even that the regulations themselves constitute attention on the federal level sufficient to work a preemption. But an administrative preemption would probably require a valid congressional grant of authority with ade-

[67] H.R. REP. No. 2222, 60th Cong., 2d Sess. (1909) (to accompany H.R. 28192). "[I]t was thought better to use the word 'writings,' which is the word found in the Constitution." *Id.* at 10.

[68] *See* 37 C.F.R. § 202.1 (1973).

quately particularized standards;[69] and any acquiescence by Congress in known interpretations of its statutes would also work an acquiescence in state assertions of legislative authority in the same areas.

What is to be made of congressional rejection of a bill which would have given federal protection but was not passed? Several attempts have been made to provide protection for such categories as architectural plans,[70] speech,[71] and choreography,[72] as well as protection against record piracy,[73] photoduplication,[74] and cable television "misappropriation";[75] and attempts have been made to clarify the federal role in trade secret protection.[76] The only safe conclusion is that no conclusions should be based on failure of legislation. Most of the proposals have been in the context of attempted general revisions of the Copyright Act, and nonpassage was likely due to a relatively few of the specific provisions. In any case, it would be perfectly logical to assume that the bills were intended to codify what was assumed to be, or intended to be, existing law.

Justice Marshall, in his *Goldstein* dissent, puts more faith

[69] That the Copyright Office should have such authority to fill interstices in the federal coverage has been periodically recommended by commentators but never adopted. *See, e.g.*, B. KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 110–11 (1967); Chafee, *Reflections on the Law of Copyright II*, 45 COLUM. L. REV. 719, 737–38 (1945).

[70] *See generally* Strauss, *Copyright in Architectural Works*, 1 STUDIES ON COPYRIGHT 87, 93 (1963).

[71] *See* Derenberg, *The Meaning of "Writings" in the Copyright Clause of the Constitution*, 1 STUDIES ON COPYRIGHT 43, 55 (1963).

[72] Choreography is currently copyrightable only as a "dramatic composition" if it tells a "story." *See* 37 C.F.R. § 202.7 (1973). For proposed bills, *see generally* Varmer, *Copyright in Choreographic Works*, 1 STUDIES ON COPYRIGHT 103, 111 (1963).

[73] *See* Ringer, *supra* note 9, at 139.

[74] *See generally* Varmer, *Photoduplication of Copyrighted Material by Libraries*, 2 STUDIES ON COPYRIGHT 813, 820 (1963).

[75] *See generally* Dreher, *Community Antenna Television and Copyright Legislation*, 17 ASCAP COPYRIGHT L. SYMPOSIUM 102, 118 (1969).

[76] *See, e.g.*, Comment, *The Scott Amendment to the Patent Revision Act: Should Trade Secrets Receive Federal Protection?*, 1971 WIS. L. REV. 900.

in Congress than seems warranted. He states that "whenever technological advances made extension of copyright protection seem wise, Congress has acted promptly."[77] But this conclusion is not justified, since the courts have thwarted a congressional attempt to protect by means of broad language; and specific congressional attention has not always been so quick. Even Justice Marshall recognizes that Congress between 1909 and 1971 repeatedly failed to enact legislative protection for sound recordings.[78] And federal response to the needs of cable television and attention to the problems of duplication of library materials, as well as elimination of the controversial "juke-box" exception to the copyright laws,[79] among other "prompt" responses, has bottled up the Copyright Revision Bill for over fifteen years now. Should the courts simply magnify the impact of what may indeed be injustices by blindly presuming the wisdom and promptness of Congress? It was to reply with a resounding no that the Court based its decision in *Goldstein* upon such far-reaching grounds.

Given that "intent" in its simplest sense is difficult to discern in most cases, reliance is usually placed upon the second most cited guide to statutory interpretation, that is, "purpose analysis." Applying the so-called Rule of *Heydon's Case*,[80] a court looks to the evil whose elimination was intended, as well as to the method chosen to effectuate a cure; and then acts so as to promote the cure and impede the evil. Under the reign of *Sears-Compco*, however, focus was placed upon the evil of nonuniformity, and perhaps too much emphasis upon the particular congressional remedy.[81] But the primary purpose of federal copyright law is or should be

[77] 412 U.S. at 578.

[78] 412 U.S. at 578, n.4.

[79] *See, e.g.*, Mooney, *The Juke Box Exemption*, 10 ASCAP COPYRIGHT L. SYMPOSIUM 194 (1959).

[80] Heydon's Case, 8 Co. Rep. 7a, 7b, 76 Eng. Rep. 637, 638 (EX. 1584).

[81] *See, e.g., Competitive Mandate, supra* note 19.

to promote the arts and sciences, and to that end, state and federal protection need not be incompatible.[82] The danger of nonuniformity is no greater in copyright than in other constitutional areas, except that in the early years of the nation nonuniformity usually meant no protection at all, or unwieldy requirements of multiple registration.[83] The *Goldstein* case places the concern for uniformity in its proper perspective, subordinate to the only purpose of the copyright power which is expressed in the text of the Constitution. Nonuniformity among the states can be tolerated, at least to the extent it follows from the presumed nonuniformity of Congress's attention within the federal statute.

To summarize the analysis of the *Goldstein* test, it appears on the one hand that preemption is best referred to specific congressional statements and policies but on the other hand that congressional intent, or even purpose in its special statutory interpretation sense, is difficult if not impossible to determine. The referral of preemption to congressional intent is tolerable nonetheless, in that it at least gives Congress a chance to reverse the Court if it feels the Court has misinterpreted the effect of its statutes. It is also possible that preemption is being used as a rule of construction to avoid what would otherwise be necessarily constitutional issues.[84] Finally, it must be noted that the very difficulty of reading preemption rules from one case to the next leaves the *Court* more maneuvering room to develop future law.[85] It is im-

[82] *Cf.* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470 (1974). "Certainly the patent policy of encouraging invention is not disturbed by the existence of another form of incentive to invention." *Id.* at 484.

[83] For the problems of pre-1790 state attempts at copyright, *see generally* B. Bugbee, Genesis of American Patent and Copyright Law 110 (1967).

[84] *See Preferential Ground, supra* note 45, at 208–9, 217 *et seq.*

[85] *See* Powell, *Supreme Court Decisions on the Commerce Clause and State Police Power, 1910–1914 I, II,* 21 Colum. L. Rev. 737 (1921), 22 Colum. L. Rev. 28 (1922). "[Q]uestions of state power after Congressional action usually depend for their answer upon construction of the federal statute. . . . While this issue is referred to the intention of Congress, it is apparent that as a rule it is the court that is doing the intending" 22 Colum. L. Rev. at 48.

possible to tell whether record piracy is the only "evil" the Court intended to find unattended by Congress or whether the Court indeed meant to follow through on the various implications of *Goldstein.*

BASES FOR RECONCILING THE GOLDSTEIN AND SEARS-COMPCO CASES

Patent-Copyright Distinction. It is possible to argue that the distinction between the *Sears-Compco* and *Goldstein* cases goes little deeper than the fact that whereas *Sears-Compco* dealt with physical objects and possible inconsistency with federal patent law, *Goldstein* means that the same rule will not be applied to copyrights, as a matter of statutory construction and elaborateness of administrative review and standards.[86] *Sears-Compco* itself speaks broadly of the patent and copyright laws—but Justice Marshall, in his *Goldstein* dissent, can only say that "the Court repeatedly referred to the patent and copyright statutes *as if* the same rules of interpretation applied to both." [87] And in speaking of *Sears-Compco,* which Burger "reaffirms," emphasis is placed upon Congress's balancing of interests in granting federal patent protection for "machines" or "mechanical configurations." [88] It is possible that more affirmative conclusions can be drawn from Congress's rigorous patent standards, as specifically implemented by the Patent Office in more detail than is usually warranted for copyrights.

The distinction between copyrights and patents may keep the *Goldstein* reasoning from backwashing into the field of patents,[89] but it doesn't resolve situations totally within the

[86] Paul Goldstein feels the "standards" test is the major distinction between Goldstein and Sears-Compco. *See* Goldstein, *"Inconsistent Premises" and the "Acceptable Middle Ground:" A Comment on Goldstein v. California,* 21 BULL. COPYRIGHT SOC'Y 25, 33 (1973) [hereinafter cited as *Inconsistent Premises*].

[87] 412 U.S. at 578, n.3 (emphasis added).

[88] 412 U.S. at 569.

[89] *But see* the Kewanee case, *supra* note 20.

field of copyrights. It has been suggested that the standards for copyright are in some instances similar enough to those of patents that failure to meet them can be taken as an affirmative indication of noninclusion. For example, the standards for "works of art" might be considered elaborate enough, and enough a balancing of interests, to effect a preemption of all such works.[90] The simple patent-copyright distinction is inadequate unless it incorporates the underlying policy considerations for the distinction.

Copying-Misappropriation Distinction. The *Goldstein* opinion rather summarily concedes that the state Record Piracy Act is tantamount to copyright protection,[91] and rests decision upon noninclusion of the particular subject matter in the federal scheme. But there are differences between the penal law and a copyright statute.[92] The California statute does not purport, for example, to give rise to a private cause of action. It does require knowing and willful transfer, with intent to sell, so that private individuals who tape records for their own use are not even technical violators. There are absolutely no requirements on the merit of the underlying work—it need be neither novel nor even original, and could theoretically itself be an infringing work. The statute is directed at a method of reproduction, rather than the nature of the original creation. Because of this, and the penal character of the statute, there is no requirement of notice, registration, or deposit of works. The burden which so concerned the early advocates of federal copyright protection—that works must be registered and deposited in various places if there is no federal protection[93]—is therefore not an element in the California scheme. As the Court is careful to

[90] *See* Kalodner & Vance, *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1114 (1959).

[91] 412 U.S. at 551.

[92] *See, e.g., Editorial Note* on the *Goldstein* Case, 20 BULL. COPYRIGHT SOC'Y. 345, 346 (1973).

[93] *See* 412 U.S. at 556, n.12.

point out, "[n]o restraint has been placed on the use of an idea or concept" [94]—or really even a mode of expression, except by the natural difficulty of exactly imitating that expression.

The Revision Bill states that it does not purport to preempt regulations directed at certain types of *activity* rather than at the underlying work which may or may not be protected against copying in any form.[95] The Court in *Goldstein* likewise recognizes that "the scope of the proscribed *activities* is narrow." [96] Is it possible that attention should be directed to the scope of the activities, rather than the subject matter of protection, in distinguishing *Goldstein* from *Sears-Compco?*

If one applies such an analysis, he cannot help but return to the copying-misappropriation distinction which other courts have used to allow record piracy regulation in the past.[97] It should be clear that, aside from what was said to describe the cases, or to overstate the cases, *Sears-Compco* essentially found no liability for imitation, whereas *Goldstein* found liability for exact duplication.[98] One can only guess what the Court might have done in 1964 had it found that Sears actually made its molds from the Stiffel lamp, at a great saving of time and expense over mere copying.[99]

To be sure, there has been criticism of the copying-mis-

[94] 412 U.S. at 571.

[95] Revision Bill § 301.

[96] 412 U.S. at 550 (emphasis added).

[97] *See* note 18 *supra* and accompanying text.

[98] *See* Casenote, *Goldstein v. California: A New Outlook for the Misappropriation Doctrine*, 8 U. SAN FRAN. L. REV. 199 (1973), which maintains that Goldstein's major contribution is in its implicit approval of the misappropriation doctrine as it has developed since INS.

[99] *But see* Wolf and Vine, Inc. v. Pioneer Display Fixture Co., 142 U.S.P.Q. 112 (N.Y. Sup. Ct. 1964) (allowing the use of mannequins even as the mold for a new line); Kurlantzick, *supra* note 36, at 215, claiming the outcome in Sears-Compco would be the same, and use of the Stiffel lamp as a master mold might actually have taken place.

appropriation distinction.[100] But both California and Congress have chosen to draw a distinction along these lines, and for good reason. Exact duplication in fact threatens the economic investment of the original recorders, while human duplication, involving a new investment of money in performers and studios, only more narrowly does. The artistic worth of a particular recording may be precisely in the inability of most of us to duplicate by mere imitation. In any case, the net effect of the *Goldstein* case is the same whether the state is allowed to create a new category of protected works or the state protects existing copyrightable works against misappropriation. To the extent that it is the appeal of the distinction which has made so many judges sympathetic to the plight of pirated record companies, we should not be quick to assume that *Goldstein* will be extended to areas in which the distinction is not equally valid.[101]

Other Distinctions. Related to the simple distinction between patents and copyrights and their administration is the Court's emphasis in *Goldstein* both upon the technological and the new. It would be possible to conclude that it is the technological nature of record piracy which makes its regulation so attractive, coupled with the obvious antiquity of our 1909 copyright statute. The implication of this argument is that the *Goldstein* logic would apply to such categories as computer programs, cable television, and photoduplication, but not to titles, characters, fashion designs, or

[100] *See* G. Ricordi & Co. v. Haendler, 194 F.2d 914 (2d Cir. 1952); NIMMER § 35.224; Nimmer, *Copyright and Quasi-Copyright Protection for Characters, Titles and Phonograph Records*, 59 TRADEMARK REP. 63, 74 (1969) [hereinafter cited as *Copyright and Quasi-Copyright*].

[101] The Court has been criticized for not deciding the "real question" in Goldstein, which is the validity of the copying/misappropriation distinction. *See* Editorial Note, *supra* note 92, at 346. Paul Goldstein sees the essential distinction as that between mere copying and consumer deception. *See Inconsistent Premises, supra* note 86, at 31. Under such a test, according to Mr. Goldstein, "*Sears*' and *Compco*'s preemptive thrust applies with even greater force to the facts of *Goldstein* than to its own." *Id.* at 32.

even ideas, which can hardly be said to have developed so fast as to catch Congress unawares. Such reasoning presumes congressional approval, and perhaps even intent to preempt, in Congress's adoption, readoption, or continuation of a statute with known interpretation. The danger of implying from congressional silence an intent to exclude has already been discussed, and would be particularly intensified by adoption of the new Revision Bill. Wouldn't it indeed be easy to assume, since Congress is taking such deliberate time in passing the bill, that it will have considered everything there is to cover, and intend to exclude everything else?

It should also not be forgotten that the record piracy case was especially appealing. The harm to the industry was statistically provable, and Congress had in fact recognized the extent of the problem in its passage of the admittedly compromised Record Piracy Act of 1971.[102] Nimmer had even argued that the best means of attacking record piracy was not in a frontal assault on the *Sears-Compco* doctrine but in the presumption that its reasoning was by implication overruled in the area of recordings by passage of the Record Piracy Act, with its specific disclaimer concerning pre-1971 recordings.[103] When the next *Goldstein*-type case comes to the courts, it is unlikely to be blessed with such strong arguments for protection.

III. POST-*GOLDSTEIN*: APPLYING THE TESTS IN OTHER AREAS OF COPYRIGHT

Just as *Sears-Compco* has been extensively cited in the field of copyright, both for direct analogy and on the more general premise that local solutions to the problems of in-

[102] Mr. Schachter, in oral argument before the Supreme Court, argued that Congress's "piecemeal" and "extraordinary step" of passing the Record Piracy Act showed its belief that recordings deserved protection. *See Supreme Court Hears Oral Argument in Sound Recording Piracy Case, supra* note 25, at A-3 (1972).

[103] *See* NIMMER § 35.225.

tellectual property are to be disfavored, so might it be expected that *Goldstein* will give impetus to local experimentation in such solutions.[104]

WRITINGS NOT INCLUDED IN FEDERAL COPYRIGHT

Following *Sears-Compco*, there was indeed considerable debate concerning specific categories of writing, most authors trying to save from federal preemption what had become an expanding umbrella of state protection. Attention focused particularly on the areas of news,[105] title,[106] and character[107] protection, as well as protection of unwritten speech.[108] The problem is that for these categories there is even less specific statutory statement than in the case of record piracy. And each of these most obviously nonattended

[104] *See* the recommendations for state legislation in Kaul, *And Now State Protection of Intellectual Property?*, 60 A.B.A.J. 198 (1974). Kaul briefly discusses, *inter alia*, computer programs, fashion designs, choreographic works, titles, and "moral rights."

[105] *See generally* NIMMER § 29.5, n.571; Note, *Has the International News Service Case Survived Sears and Compco?*, 24 PAT., T. M. & COPYRIGHT J. C–1 (1971).

[106] *See generally* Comment, *The Misappropriation Doctrine: A Search for Literary Title Protection*, 12 SANTA CLARA LAWYER 142 (1972); *Copyright and Quasi-Copyright*, *supra* note 100; Kalodner & Vance, *supra* note 90, at 1115.

[107] *See generally* Rothenberg, *Some New Problems in Motion Picture Copyright Law*, 21 BULL. COPYRIGHT SOC'Y. 214, 216 (1974) (discussing Goldstein's positive effect); Raskin, *Copyright Protection for Fictional Characters*, 2 PERF. ARTS REV. 587 (1971) (containing a comprehensive bibliography); *Copyright and Quasi-Copyright*, *supra* note 100; Comment, *Copyright Pre-Emption and Character Values: The Paladin Case as an Extension of Sears and Compco*, 66 MICH. L. REV. 1018 (1968) [hereinafter cited as *Character Values*]. For the latest lower court development in the Paladin case, CBS, Inc. v. DeCosta, 377 F.2d 315 (1st Cir. 1967), *see, Court Rules CBS Pirated Paladin from a Cowboy*, N.Y. Times, Apr. 17, 1974, at 1, col. 3. The Magistrate for the U.S. District Court for the District of Rhode Island, relying partly on the Goldstein case, allowed recovery on theories of common law service mark infringement and unfair competition not decided in the original unjust enrichment decision. The conclusions of law are alternatively based on 15 U.S.C. §§ 1121, 1125, and 1127. (See Civil No. 3130, Apr. 15, 1974.) *See also* DeCosta v. Columbia Broadcasting System, Inc., 498 F.2d 1383 (C.C.P.A. 1974).

[108] *See generally* Dunlap, *Copyright Protection for Oral Works—Expansion of the Copyright Law into the Area of Conversations*, 20 BULL. COPYRIGHT SOC'Y. 285 (1973).

categories is not of a new type, so that Congress in 1909 was aware of the possibility of giving protection, and most arguably "chose" not to do so.[109] As for speech, there might be some negative implication from the federal requirement that copyrightable works be in a tangible form. Speech is not only outside the scope of the statute, however, but perhaps even outside the constitutional definition of "writings," so that federal preemption could not come from a congressional exercise of the copyright power alone. In any case, these categories are not as clearly protected by a common law (unpublished works) theory as by contract or idea protection, which should be allowed to the states whether or not the categories are attended under the federal copyright scheme.[110]

STATE PROTECTION BEYOND THE SCOPE OF FEDERAL PROTECTION FOR WORKS WHICH QUALIFY FOR SOME FEDERAL PROTECTION

Fashion designs, architectural plans, and to a certain extent computer programs are technically copyrightable under the federal law, but the protection is of questionable value. Copyright in an architectural plan bars against copying the plan as such, but not necessarily against construction of the building it represents;[111] a copyrighted fashion drawing or photograph can't be duplicated, but the dress it depicts may be made;[112] a computer program may be copyrighted, but the protection does not extend to the substance of the pro-

[109] There has perhaps been a change in the value of protection in these areas, however, as a result of the unanticipated opportunity for exploitation in the broadcast media.

[110] *See* notes 126–35 *infra* and accompanying text.

[111] *See* Comment, *Copyright Protection for the Architect: Leaks in a Legal Lean-To*, 8 CALIF. WEST. L. REV. 458 (1972); Strauss, *supra* note 70; Katz, *Copyright Protection of Architectural Plans, Drawings and Designs*, 19 LAW AND CONTEMP. PROB. 224 (1954).

[112] *See* Note, *Protection for Pirates?—Lack of Statutory and Common Law Safeguards Against Copying in the Fashion Industry*, 5 SUFFOLK U. L. REV. 487 (1971).

gram.[113] More meaningful state protection has been sought by stretching the common law concept of publication to its limits,[114] or via state trade secret law in the case of computer programs.

For each of these categories, *Goldstein* may now be cited for the general presumption in favor of state authority; and an imaginative application of the *Goldstein* test might even conjure up a category of "plan qua building" or "design qua dress" or "program qua ideas." Each of the categories also runs into preemption problems, however, because some items in each category may qualify for federal protection, implying an "intent" to exclude the other items. Thus, it is possible, though rare, for fashion designs to qualify for design patent protection,[115] for architectural plans to qualify as "works of art,"[116] or for computer programs to qualify for patent protection.[117] But since *Goldstein* speaks of copyright preemption only in terms of an entire category or none of it, the case is of little help in the necessary conceptual analysis of competing bases of federal and state authority for these obviously hybrid categories.

[113] Of dozens of articles on the subject, *see generally* Note, *Computer Software: Beyond the Limits of Existing Proprietary Protection Policy*, 40 BROOKLYN L. REV. 116 (1973); Stork, *Legal Protection for Computer Programs: A Practicing Attorney's Approach*, 20 ASCAP COPYRIGHT L. SYMP. 112 (1972); Note, *Copyright Protection for Computer Programs*, 64 COLUM. L. REV. 1274 (1964).

[114] For architectural plans, *see, e.g.*, Nucor Corp. v. Tennessee Forging Steel Service, Inc., 476 F.2d 386 (8th Cir. 1973) and cases cited therein (no publication for distributing to contractors, permitting public inspection, publishing photographs, or even distribution catalogues). For fashion designs, see Elman, *The Limits of State Jurisdiction in Affording Common Law Protection to Clothing Designs*, 11 VAND. L. REV. 501 (1958).

[115] *See* 35 U.S.C. §§ 171–73 (1970).

[116] By the time of the Copyright Office Study No. 27 (1959), no known registrations were on file for architectural "works of art" under § 5(g). *See* Strauss, *supra* note 70, at 93, n.29.

[117] *See* Gottschalk v. Benson, 409 U.S. 63 (1972) (patent protection allowed in theory, but only for extremely rare programs); Note, *Are Computer Programs Ever Patentable? Did the Patent Office Win?*, 124 PAT., T.M. & COPYRIGHT J. C-1 (1973).

NEW METHODS OF DUPLICATION

Cable television and photoduplication are categories most similar to phonograph recordings in that they result in duplication of already existing works rather than in new creations. The problem is that the underlying work, like the musical composition in the case of record piracy, is itself subject to federal copyright, as a video tape in the case of television [118] or as a writing in the case of photoduplication. Since the underlying work has been considered by Congress, it might be inferred that the states are precluded from granting more extensive protection than Congress chose to grant. Since cable rebroadcast does not constitute a "performance" under copyright law,[119] Congress may be deemed to have concluded that "broadcast signals are dedicated to the public" [120] and beyond state protection.

The problem is not insurmountable in the case of photoduplication, since a *Goldstein*-like category of "typography" might allow state protection of the investment cost in setting type, as opposed to the substance of the underlying writing.[121] The problem is more acute in the case of cable television. *Goldstein* is limited to a simple in or out test. State protection is valid for writings not considered in sections

[118] *See* 37 C.F.R. § 202.15(d) (1973).

[119] *See* Teleprompter Corp. v. Columbia Broadcasting System, Inc., 415 U.S. 394 (1974); Fortnightly Corp. v. United Artists Television, Inc., 392 U.S. 390 (1968). *See* Note, *Cable Television and Copyright Royalties*, 83 YALE L. J. 554 (1974).

[120] Midwest Video Corp. v. United States, 441 F.2d 1322, 1326 (8th Cir. 1971), *rev'd on other grounds*, 406 U.S. 649 (1972).

[121] *See, e.g.*, Grove Press, Inc. v. Collectors Publication, Inc., 264 F. Supp. 603 (C.D. Cal. 1967). *But cf.* G. Ricordi & Co. v. Haendler, 194 F.2d 914 (2d Cir. 1952). The relationship between photoduplication and copyright was unfortunately left in doubt by the 4–4 split of the Supreme Court in the case of Williams & Wilkins Co. v. United States, 420 U.S. 376 (1975). *See High Court Leaves Standing Ruling Allowing Copying of Copyrighted Articles*, N.Y. Times, Feb. 26, 1975, at 17 col. 1. The Court of Claims decision reported at 487 F.2d 1345 (Ct. Cl. 1973) was left intact as a result of the tie vote.

four or five of the federal statute, but nothing is said to allow state protection against methods of exploitation not attended to by Congress in section one.[122] But there are clearly some state interests not fully weighed by the federal laws. States should not be foreclosed from applying their general laws of contract and business relations simply because video tapes are subject to federal copyright. Complementary state regulations, or regulations protecting different interests, should be allowed even though a category is undeniably subject to federal regulation.[123]

The problems are perhaps minimized by the exercise of jurisdiction by the Federal Communications Commission,[124] and by the likelihood that, if the Revision Bill is ever passed, secondary transmissions will be subject to a compulsory licensing scheme similar to that currently applicable to recordings.[125] But it is unfortunate that the areas of most urgent concern in an increasingly technological society are little clarified by the limited *Goldstein* writings test.

[122] *Cf.* Kalodner & Vance, *supra* note 90, at 1108 (speaking of "transformation rights").

[123] *See, e.g.*, Florida Lime & Avocado Growers, Inc. v. Paul, 373 U.S. 132 (1963); Hirsch, *Toward a New View of Federal Preemption*, 1972 U. ILL. L. F. 515, 544–49.

[124] *See generally* Barrow, *The New CATV Rules: Proceed on Delayed Yellow*, 25 VAND. L. REV. 681 (1972); Comment, *Regulation of Cable Television: The Federal Communications Commission's 1972 Rules*, 1972 U. ILL. L. F. 608; Note, *Regulation of Community Antenna Television*, 70 COLUM. L. REV. 837 (1970).

[125] *See* Revision Bill §§ 111–12. *See also* Copyright Law Revision, *Hearings on S.1361 Before the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary*, 93d Cong., 1st Sess. 278 *et seq.* (1973). The judicial history of cable television and copyrights is outlined at 295 and 417, and the 1971 "Consensus Agreement" appears at 307. Discussion of the Williams & Wilkins case, cited *supra* at note 121, is contained in a section on photoduplication at 89–180.

STATE THEORIES OF PROTECTION

It has been said that the federal law is interstitial in nature;[126] and this is true even in such "exclusive" areas as copyrights and patents, as evidenced, for example, by federal statutory reference to what can only be the state law of assignment, mortgage, and wills.[127] Aside from the creation of an infringement cause of action, the major role of the federal law is one of characterization, in this case of "property." Transfers of the federal interest and legal relationships concerning it necessarily depend upon the general state law of contracts and business relations. It is a sign of the far-reaching implications of *Sears-Compco* that even these state bases of authority have been brought into question since 1964.[128] And it is a sign of the insufficiency of the *Goldstein* writings test that it solves the problem of delineating federal and state authority in so few cases. Stretching statutory interpretation so as to make phonograph recordings one of the few areas in which Congress had no specific intent was apparently easier than admitting that phonograph recordings in fact represent the much more common type of writing, in which there are both state and federal interests to be protected.

The *Goldstein* case will hopefully presage the development of a two-pronged test of state authority. On the one hand, where Congress has indeed not attended to a particular category of writing, then the states should be absolutely free to regulate, even by copyright-like laws. If the writing is included in the federal law, copyright-like laws should be precluded; but there are peripheral theories of protection completely consistent with inclusion of the specific writing in

[126] *See* H. HART & H. WECHSLER et al., THE FEDERAL COURTS AND THE FEDERAL SYSTEM 470 (2d ed. 1973).

[127] *See* 17 U.S.C. § 28.

[128] *See, e.g.*, Cable Vision, Inc. v. KUTV, Inc., 335 F.2d 348 (9th Cir. 1964), *cert. denied*, 379 U.S. 989 (1965).

the federal scheme.[129] There is still considerable room for state authority to affect intellectual property rights by means of trade secret[130] and trademark[131] law, idea protection via contract theory,[132] unfair competition,[133] interference with contractual relations,[134] defamation and right to privacy,[135] and, of course, protection of unpublished works under the common law. These state doctrines are for the most part not tied to a categories analysis but are regulations of types of conduct, regardless of whether or not an underlying work is patentable or copyrightable under federal law.

COMMON LAW COPYRIGHT: UNPUBLISHED WORKS AND THE REVISION BILL

The *Goldstein* case makes clear that "[a]s to categories of writings which Congress has not"—specifically—"brought within the scope of the federal statute," publication is a state question, of no meaning so far as federal law is concerned.[136]

[129] This two-pronged test is essentially that adopted by the Supreme Court in the area of trade secret protection. *See* the Kewanee case, *supra* note 20 (discussing state protection of both nonpatentable ideas, and ideas patentable but not patented).

[130] *See generally* Note, *Patent Preemption of Trade Secret Protection of Inventions Meeting Judicial Standards of Patentability*, 87 HARV. L. REV. 807 (1974); Wydick, *Trade Secrets: Federal Preemption in Light of Goldstein and Kewanee*, 55 J. PAT. OFF. SOC'Y. 4 (1974); *Competitive Torts*, *supra* note 10, at 947. The question of state trade secret protection and licensing was finally resolved in the Kewanee case. *See* note 20 *supra* and accompanying text.

[131] *See, e.g.*, Flexitized, Inc. v. National Flexitized Corp., 335 F.2d 774 (2d Cir. 1964), *cert. denied*, 380 U.S. 913 (1965).

[132] *See generally* NIMMER § 169; Note, *A Conceptual Analysis of Idea Appropriation*, 2 MEMPHIS ST. U. L. REV. 67 (1971); Nimmer, *The Law of Ideas*, 27 S. CAL. L. REV. 119 (1954).

[133] *See generally Competitive Torts*, *supra* note 10.

[134] *Compare* Cable Vision, Inc. v. KUTV, Inc., 335 F.2d 348 (9th Cir. 1964), *cert. denied*, 379 U.S. 989 (1965) *with* New York World's Fair v. Colourpicture Publishers, Inc., 21 App. Div. 2d 896, 251 N.Y.S.2d 885 (1964). *See generally* Rothenberg, *Actions for Interference with Contract Rights*, 18 AM. JUR. TRIALS 57 (1971); *Competitive Torts*, *supra* note 10, at 959.

[135] *See* Strauss, *The Moral Right of the Author*, 2 STUDIES ON COPYRIGHT 963 (1959); *Character Values*, *supra* note 107, at 1033–39.

[136] 412 U.S. at 570, n.28.

The Revision Bill, if adopted in its present form, would preempt

> all rights in the nature of copyright in works that come within the subject matter of copyright as specified by sections 102 and 103 . . . whether published or unpublished. . . . [N]o person is entitled to copyright, literary property rights, or any equivalent legal or equitable right in any such work under the common law or statutes of any state.[187]

Nothing in the bill would alter state protection of "unpublished material that does not come within the subject matter of copyright as specified by sections 102 and 103."[188] The latter clause should probably be read as if "unpublished" did not qualify "material," since it is clear from section 301(a) and from the *Goldstein* case that publication is not to be the demarcation point for stripping of rights.[189] It would be ironic if a new statute, with new language, unwittingly recreated a limbo for "published" works not within the scope of federal law.

In addition to denying preemption for particular subject matter, the bill denies preemption of state rights of action

> not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106, including breaches of con-

[187] Revision Bill § 301(a).

[188] Revision Bill § 301(b)(1).

[189] *See, e.g.*, H.R. REP. No. 83, 90th Cong., 1st Sess. (1967) (to accompany H.R. 2512, the predecessor to S. 1361). "The intention of section 301 is to preempt and abolish any rights under the common law or statutes of a State that are equivalent to copyright *and* that extend to works coming within the scope of the Federal copyright law." *Id.* at 97 (emphasis added). Citing "unfixed works" as an example of "works . . . not included in the specified 'subject matter of copyright,'" the Report states that "[t]hey are therefore not affected by the preemption of section 301." *Id.* at 98. *But see id.* at 99: "Use of the word 'unpublished' avoids any implication that common law protection equivalent to copyright, for material outside the subject matter of the statute, might continue after 'publication' as that term is defined in section 101." If it is intended that published works, whether or not within the subject matter of the statute, are automatically preempted, this is not accomplished by the provision in § 301(b)(1) that unpublished works are not so preempted.

tract, breaches of trust, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation.[140]

The House Committee indicated that misappropriation was indeed equivalent to copyright protection, and thus preempted.[141] Again, however, the denial of preemption in subsection *b* must be read in conjunction with the assertion of exclusivity in subsection *a*, which is directed only to "such works" as are covered by the bill under sections 102 and 103. That is, the clause should mean that the listed state actions are allowed even for works given federal protection; and not that misappropriation, for example, is barred even for works not specified in the bill. Thus, the two-pronged test should be preserved under the Revision Bill.

It is the attempted clarification of the long-confusing issue of publication which makes analysis of all other bases of state authority so necessary, and which underscores the need for a two-pronged test based upon the *Goldstein* statutory and constitutional arguments. Since, by the reasoning of many courts, only strained interpretations of the concept of publication preserved state protection in such areas as phonograph recordings, fashion designs, architectural plans, and performers' rights, the Revision Bill could otherwise have the unanticipated result of clarifying these categories out of any protection whatsoever. And the *Goldstein* writings test taken alone is insufficient to protect against so far-reaching a consequence.

CONCLUSION

Taken literally, the *Goldstein* case is extensive in its implications; but the preemption doctrine it prescribes is an insufficiently reliable barometer by which to measure its scope.

[140] Revision Bill § 301(b)(3).

[141] H.R. Rep. No. 83, 90th Cong., 1st Sess. 100 (1967) (to accompany H.R. 2512, the predecessor to S. 1361).

It is impossible to predict how future copyright cases will be determined under the new constitutional presumption in favor of state authority, without reference to the particular interests at work. By any standard, however, the *Goldstein* case has turned the tide of *Sears-Compco* and will allow a case by case reappraisal of the state as well as federal interests in protection of artistic and literary materials.

NATIONAL THIRD PRIZE, 1974

Adherence of the USSR to the Universal Copyright Convention: Defenses Under U.S. Law to Possible Soviet Attempts at Achieving International Censorship

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> The decision of the government of the U.S.S.R. to join the International Geneva Convention on Copyright [UCC] can significantly contribute to the reduction of mutual distrust and, in the long view, to cultural rapprochement among nations.
>
> While definitely approving this action on the whole, nevertheless, we consider it our duty to express certain apprehensions. . . . In the particular conditions of our country, the law concerning the monopoly of foreign trade could be put to use for restricting or even for suppressing entirely the international intellectual property rights of Soviet citizens. . . . The Decree of the Presidium of the Supreme Soviet, dated February 21, 1973, and published in the press, not only fails to eliminate the apprehensions we have noted above but instead makes them still more explicit. . . .
>
> —open letter by six prominent Soviet intellectuals [1]

THE SOVIET UNION'S current relations with the West present a Janus-like ambiguity. While encouraging closer trade relationships with the United States, the Soviet leadership seems

[1] *Protests on Soviet Move—From the East*, PUBLISHERS WEEKLY, Apr. 9, 1973, at 42–43.

equally intent on suppressing internal dissent and disabusing the West of the idea that détente will engender a freer flow of ideas between East and West.[2] At the same time that Soviet jamming of the Voice of America has ceased,[3] concerted attacks are under way to silence dissident intellectuals within the Soviet Union.[4] It is against this shifting and uncertain backdrop that the Soviet Union's role as the sixty-fourth member nation of the Universal Copyright Convention [UCC] will be played.

There exists speculation that the Soviet Union will use its newly acquired membership in the UCC[5] as an instrument for tighter domestic and international censorship. Pessimists emphasize the Soviet history of tight domestic censorship and point to the Soviet copyright law which permits the compulsory purchase of any copyright,[6] a governmental privilege

[2] *See Soviet Union Joins Copyright Nations*, N.Y. Times, May 23, 1973, at 6, col. 2. Boris Stukalin, Chairman of the USSR's State Committee on Publishing, confirmed this view, stating that: "The Soviet Union will continue to acquaint its citizens with the best in progressive world culture. Needless to say, writings advocating war and violence, immorality, chauvinism and ways of life alien to us will not be disseminated."

[3] *See Soviet Is Said to Stop Jamming Voice of America*, N.Y. Times, Sept. 13, 1973, at 16, col. 1.

[4] *See* Shabad, *Pressure Only Spurs Soviet Dissidents*, N.Y. Times, Sept. 21, 1973 at 3, col. 4; TIME, Sept. 17, 1973, at 45; *Soviet Is Silent on Action on Solzhenitsyn's Work*, N.Y. Times, Dec. 31, 1973, at 1, col. 1; Smith, *Solzhenitsyn and Soviet's Risks*, N.Y. Times, Dec. 31, 1973, at 6, col. 1.

[5] Universal Copyright Convention, *done* Sept. 16, 1955, [1955] 6 U.S.T. 2731, T.I.A.S. No. 3324, 216 U.N.T.S. 132 [hereinafter cited as UCC]. It should be noted that the UCC is not retroactive and requires USSR protection only for unpublished works and works of U.S. nationals, nationals of other Convention countries, or works first published in a Convention country on or after May 27, 1973. Previously published works are in the public domain of the United States and USSR, UCC art. VII. For an excellent discussion of the UCC and its relation to Soviet and U.S. copyright law in the first major work on this subject since the USSR's adherence, see J. BAUMGARTEN, U.S.-U.S.S.R. COPYRIGHT RELATIONS UNDER THE UNIVERSAL COPYRIGHT CONVENTION (Practising Law Institute Patent, Copyright, Trademark, and Literary Property Practice Handbook No. 3, 1973).

[6] There is no single "Soviet Copyright Law." This note bases its analysis on Chapter IV of the 1961 "Bases of Legislation in Respect of Civil Law in the U.S.S.R. and Federated Republics." BAUMGARTEN, *supra* note 5, at 65–67. Article 106 reads as follows: "The State may compulsorily purchase the copyright to

which has been exercised frequently.[7] Many fear that under article I of the UCC the Soviet Union might enter a United States court as a copyright proprietor to enjoin the unauthorized publication of *samizdat* [8] works by notable dissident Soviet writers. It is also feared that the Soviet Union's laws requiring Western publishers to negotiate with a government literary agency [9] would make it possible for the USSR to: (1) refuse translation rights for anti-Soviet works; (2) request that "correct" translations be made to fit a censored version of the original; (3) insist that propagandistic prefaces be included in certain works; and (4) require that only pro-Soviet editors be allowed to compile anthologies of Soviet works.[10]

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the publication, public performance or other utilisation [*sic*] from the author or his heirs by the procedure laid down in the legislation of the Union Republics." S. LEVITSKY, INTRODUCTION TO SOVIET COPYRIGHT LAW, 274 (Law in Eastern Europe No. 8) (1964). *See* J. BAUMGARTEN, *supra* note 5, at 114 n.317.

[7] *See* Woltmann, *The Author and the State: An Analysis of Soviet Copyright Law*, 14 ASCAP COPYRIGHT L. SYMPOSIUM (1966) Article 106 derives from a 1918 decree empowering the revolutionary government to declare a state monopoly of "all works of science, literature, music, or fine arts of any kind, whether published or not, no matter in whose possession they are." Decree of Nov. 26, 1918, as quoted in Woltmann, *id.* at 18–19. In the 1920s this decree was the basis for the nationalization of works by such great Russians as Moussorgsky, Tchaikovsky, Gogol, Pushkin, Tolstoy, Turgenev, and Chekhov. By a 1925 official decree, the state even nationalized all Russian translations of the works of Upton Sinclair. The decree was formalized as an article in the 1928 Federal Copyright Law but was not frequently exercised again until the late 1950s, when it was turned against "loafing" heirs of popular writers. *But see* Matveev, *Copyright Protection in the U.S.S.R.*, 20 BULL. COPYRIGHT SOC'Y No. 219, 221 (1973), where a Soviet expert on the 1971 Paris Revision of the UCC states that the state monopoly on works not in the public domain was not to last more than five years.

[8] This term, which literally means "self-published," signifies Soviet literary works in typed manuscript form which were rejected for publication by the state publishing houses or were never submitted and are circulated secretly by hand. Solzhenitsyn's *First Circle* and Pasternak's *Dr. Zhivago* are two of the best-known *samizdat* works.

[9] *See* Smith, *supra* note 4. The Soviet Union announced the formation of the All-Union Copyright Agency (VAAP) to act as the authorized representative of the state publishing houses in dealings with Western publishers.

[10] *Slavic Specialists Say Move Is Catastrophic*, PUBLISHERS WEEKLY, May 14, 1973, at 32.

Optimists belittle these fears, citing Soviet reluctance to enter a foreign court to seek international censorship, a manifest desire to ease East-West tension, and the eagerness of Soviet publishing houses to receive works from the West.[11] Despite these assurances, however, the fears remain, and unrest has even made itself felt in the Congress, where possible solutions are under consideration by the House and Senate Subcommittees on Patents, Trademarks, and Copyrights.[12]

This note explores three related questions:

(1) Is fear of Soviet entrance into a United States court as a copyright proprietor in order to enjoin publication of *samizdat* works justified?

(2) Is concern over heightened Soviet administrative censorship through the Soviet All-Union Copyright Agency (VAAP) warranted?

(3) Are there any defenses under United States law to possible Soviet injunctive and administrative censorship? Would a proposed American Publisher's Union solve the problem of administrative censorship without violating United States antitrust laws?

[11] *Id.* at 31; *see also* Benjamin, *Of Copyright and Commissars: A Rejoinder*, THE NEW LEADER, June 21, 1965, at 19.

[12] Carlisle, *The USSR and the UCC*, N.Y. Times, June 3, 1973, § 7, at 39, col. 1; *see also* 119 CONG. REC. 9387–88 (daily ed. Mar. 26, 1973) (Statement by Senator McClellan on introduction of S. 1359, 93d Cong., 1st Sess. [1973]).

The texts of the two companion bills in the House, H.R. 6214 and H.R. 6418, 93d Cong., 1st Sess. (1973), which are identical to the bill in the Senate, read as follows: "In section 9, title 17, of the United States Code, add a subsection (d) to read: '(d) A United States copyright secured by this title to citizens or subjects of foreign states or nations pursuant to subsection (b) or (c), and the right to secure such copyright, shall vest in the author of the work, his executors or administrators, or his voluntary assigns. For the purposes of this title, any such copyright or right to secure copyright shall be deemed to remain the property of the author, his executors or administrators, or his voluntary assigns, regardless of any law, decree or other act of a foreign state or nation which purports to divest the author or said other persons of the United States copyright in his work, or the right to secure it: and no action or proceeding for infringement of any such copyright, or right to secure it, or common law right in such work, may be maintained by any state, nation, or person claiming rights in such copyright, right to secure copyright, or common law rights by virtue of any such law, decree, or other act.'"

I. THE UNIVERSAL COPYRIGHT CONVENTION

The preamble to the UCC states that the member nations are

> moved by the desire to ensure in all countries copyright protection of literary, scientific and artistic works . . . [and are] persuaded that such a universal copyright system will facilitate a wider dissemination of works of the human mind and increase international understanding.[13]

The UCC does not grant one copyright, but rather ensures the granting of copyright protection by each member nation. The convention provides that each UCC member will accord the same protection that it gives to works by its own nationals to the works of citizens of other member nations. The writings of nationals of nonmember countries which are first published in a UCC signatory nation are to be afforded similar safeguards.[14] Thus, in essence, the UCC grants forty-one copyrights of differing quality.[15] Although copyright protection varies from nation to nation, article I requires that "adequate and effective protection of the rights of authors and other copyright proprietors" shall be accorded.[16]

Designed for those nations who felt the Berne Convention requirements were too stringent,[17] the UCC requires a mini-

[13] It should be stressed that the preamble to the 1952 UCC is not legally binding. A. BOGSCH, UNIVERSAL COPYRIGHT CONVENTION: AN ANALYSIS AND COMMENTARY 1 (1958).

[14] UCC, arts. I, II; *see also* BOGSCH, *supra* note 13, at 3–26.

[15] Milgram, *Territoriality of Copyright: An Analysis of Assignability Under the Universal Copyright Convention*, 12 ASCAP COPYRIGHT L. SYMPOSIUM 1, 15–16, 19–22 (1963); *see* Olian, *International Copyright and the Needs of Developing Countries: The Awakening of Stockholm and Paris*, 7 CORN. INT'L L. J., 81, 109 n.116 and accompanying text (1974).

[16] BOGSCH, *supra* note 13, at 3–5. The Chairman of the Geneva Conference indicated that the rights conferred on authors by the UCC should include those given to authors by "civilized" countries. *Inter-Governmental Copyright Conference*, 5 UNESCO COPYRIGHT BULL., Nos. 3–4, at 47 (1952).

[17] Bogsch, *Commentary on the Supplementary Request For Views*, 4 UNESCO COPYRIGHT BULL., Nos. 1–2, at 10 (1951).

mum amending of domestic copyright law; only the provisions relating to the duration of the copyright and the awarding of a compulsory license to translate are explicit. Those who had hoped for Soviet accession to a multilateral treaty saw the UCC as the only possible solution. Nevertheless, the sudden decision of the Soviet Union to adhere to the Universal Copyright Convention came as somewhat of a surprise,[18] and speculation was rife that some hidden reason existed to account for the country's sudden change of position.[19] The theory that the Politburo desired another weapon of censorship in its pitched battle with dissident Soviet intellectuals seemed to provide the answer, and this theory gained support with the publication of the decree amending the Soviet copyright laws as required under article X of the UCC.[20] This decree extends copyright to published, unpublished, and *samizdat* works alike and allows assignment of a Soviet copyright or publication rights to a foreign publisher only "according to the procedure established by U.S.S.R. legislation." [21] Article 106 of the decree, allowing the compulsory purchase of a copyright from the author by the Soviet government, has been retained from the former copyright law. This leaves open the possibility that the USSR could compul-

[18] *Soviet Union Joins Copyright Nations, supra* note 2, at col. 1. The Soviet Government has been notoriously reluctant to sign any multilateral copyright convention in the past, and from 1917 to 1967 rebuffed all invitations to conclude bilateral treaties. In 1967 the Soviet Union signed its first bilateral copyright treaty with Hungary and entered into a similar treaty with Bulgaria in 1972. *See* Shaye, *Piracy Within the Law: A Consideration of the Copyright Protection Afforded Foreign Authors in the United States and the Soviet Union*. 14 ASCAP COPYRIGHT L. SYMPOSIUM at 226, 230–33 (1964). See also BAUMGARTEN, *supra* note 5, at 9 n.16.

[19] *See Soviet Union Joins Copyright Nations, supra* note 2, at col. 1.

[20] Decree of Feb. 28, 1973, On Making Changes in and Additions to the Principles of Civil Legislation of the U.S.S.R. and the Union Republics, [1973] 9 Ved. Verkh. Sov. S.S.S.R. Item 138, at 131–32 (Presidium of the Supreme Soviet USSR) (unofficial English translation in 25 CURRENT DIGEST OF THE SOVIET PRESS, No. 11, at 7 [1973]) [hereinafter cited as Decree of Feb. 28, 1973].

[21] Decree of Feb. 28, 1973, *supra* note 20, at 8.

sorily purchase the copyright to *samizdat* works and utilize its copyright proprietorship to sue in the United States courts for an injunction to halt publication.[22]

Congress has responded to this threat with proposed legislation which would nullify any attempt by a foreign government to exercise eminent domain over an author's copyright in the United States. Two bills have been introduced in the House and one in the Senate with identical texts to amend section 9 of title 17 of the United States Code.[23] The bills add a subsection (d), which allows a copyright to vest in the author, his executors, administrators, or assigns. Under the proposed amendment, assignees could acquire title to the copyright only through the voluntary consent of the author, not through a foreign government's decree, act, or law. It

[22] *Concern Voiced in U.S. at Soviet Copyright Law*, Washington Post, Mar. 23, 1973, at A 14, col. 1; *Soviet Union Joins Copyright Nations*, *supra* note 2. An interesting question arises as to whether the Soviet Union would sue for an injunction in the federal or the state courts. If a *samizdat* publication is considered an unpublished work in the United States, the Soviet Union, as an alleged proprietor of an unpublished work's copyright, would be suing to protect the work's common law copyrights (one for each state) and may sue in a state court. It is unclear at present, however, whether a *samizdat* work would be considered an unpublished work. A British court recently held the *samizdat* distribution of Solzhenitsyn's *August 1914* not to be a publication for copyright purposes; the Bodley Head Ltd. v. Flegon, [1972] 1 W.L.R. 680 (Ch. 1971). Baumgarten feels it is debatable whether *samizdat* would constitute a limited publication in the U.S.; BAUMGARTEN, *supra* note 5, at 43–44. Federal jurisdiction might be obtained, however, on the theory that a construction of the Copyright Act is required to resolve whether the Soviet Union's practice of eminent domain constitutes a valid assignment. *See* T. B. Harms Co. v. Eliscu, 339 F.2d 823, 828 (2d Cir. 1964); Royalty Control Corp. v. Sanco, Inc. 175 U.S.P.Q. 641 (N.D. Cal. 1972). Federal jurisdiction might also be obtained on the theory that the resolution of the issue was closely tied to foreign policy, with a consequent need for nationwide uniformity. *See* Republic of Iraq v. First Nat'l City Bank, 353 F.2d 47, 50–51 (2d Cir. 1965), *cert. denied*, 382 U.S. 1027 (1966). The defendant might also remove from the state court to the federal district court on the separate jurisdictional base of diversity of citizenship; 28 U.S.C. § 1332 (1970). The *Sabbatino* decision held that federal law governs even at the state level, where the Act of State doctrine is involved, but left open the question as to whether the state courts could restrict their scope of review even further than under the Act of State doctrine. Banco Nacional de Cuba v. Sabbatino, 376 U.S. 398, 425 n.23 (1964).

[23] *See supra* note 12 and accompanying text.

appears, however, that passage of these bills is not critically needed, since injunctive censorship is not only politically unlikely,[24] but under United States law virtually impossible.

[24] Soviet authorities already have sufficient internal power to deal with dissidents in other ways, and copyright injunctions in a foreign court would be a "clumsy and exposed tool for suppression." *Russia and UCC: How It Looks from Moscow*, PUBLISHERS WEEKLY, May 14, 1973, at 31. *See also* the translation of The Criminal Code of the R.S.F.S.R., Oct. 27, 1960, *as amended to* Mar. 1, 1972, arts. 69, 70, 78, 190–91 (1966), in H. BERMAN & J. SPINDLER, SOVIET CRIMINAL LAW AND PROCEDURE: THE R.S.F.S.R. CODES 125, 153–54, 155, 180–81 (2d ed. 1972). Art. 70 of the criminal code of the largest Soviet republic prohibits the circulation of "slanderous fabrications which defame the Soviet State and social system." Art. 78 punishes smuggling of "goods or other valuables across the state border of the U.S.S.R." and could conceivably be applied to the smuggling of a *samizdat* novel across the border. Art. 190–91 repeats the prohibition of art. 70, but provides for imprisonment for up to three years. Imprisonment under art. 70 may not exceed seven years. An unauthorized sale of a work by a *samizdat* author might also be punished as a violation of the Soviet laws establishing a state monopoly on foreign trade. N.Y. Times, Dec. 30, 1973, at 1, col. 1, and at 17, col. 5. The stiffest penalties possible might be eight to fifteen years imprisonment, plus from two to five years of exile, under art. 69. This article prohibits acts which, in order to subvert trade, obstruct the normal work of a state organization (*e.g.*, VAAP).

The motivation of the Soviet Union to adhere suddenly to the 1952 UCC may not have been due to a desire for another instrument for internal censorship. Art. IX § 3 of the 1971 Paris Revision of the UCC provides that "after [its] coming into force . . . no state may accede solely to the 1952 Convention"; 1971 Paris Revision of the Universal Copyright Convention, in 2 UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD Item B-1, at 9 (Supp. 1971). The Soviets reportedly were worried about the provisions in the Paris Revision which expressly protect broadcasting and performing rights; PUBLISHERS WEEKLY, Mar. 5, 1973, at 47. The Soviet Union may also have felt that the Paris Revision would prohibit the recent amendment to art. 103 of the Soviet Copyright Law allowing nonprofit reproduction of educational and scientific materials. BAUMGARTEN, *supra* note 5, at 64 n.171. At the time of the Soviet Union's accession, only five nations had signed the Paris Revision: Cameroon, France, Hungary, the United Kingdom, and the United States. By July 10, 1974, however, the required 12 nations had signed and the treaty entered into force on August 10, 1974. 70 DEPT. OF STATE BULL. No. 1823, at 619 (1974). The USSR's haste may have been due to a desire to sign the 1952 UCC before the 1971 Paris Revision superseded it. Art. IX § 4 of the 1971 Paris Revision provides that "relations between states party to [the revised] Convention and states that are party only to the 1952 Convention [Soviet Union], shall be governed by the 1952 Convention." 2 UNESCO, COPYRIGHT LAWS AND TREATIES OF THE WORLD, Item B-1, at 9 (Supp. 1971).

In addition, the Soviet Union disclosed an income tax decree revising a basic 1943 tax law to authorize a royalty tax on Soviet and foreign authors' works of

II. DEFENSES TO A SOVIET ATTEMPT TO ENJOIN A *SAMIZDAT* PUBLICATION UNDER THE UCC

It is well established that copyrights have no extraterritorial effect.[25] Thus, prior to the Soviet Union's signing of the UCC, the grant of a copyright to a Soviet citizen by his government had no significance in the United States.[26] Conversely, the Supreme Court has held that a foreign statute which would have the effect of depriving a foreign citizen of a United States common law copyright also has no automatic legal effect in the United States.[27] The Soviet Union's membership in the UCC has not necessarily changed this situation with regard to *samizdat* works.

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up to 75 percent. Decree of Sept. 4, 1973, concerning the taxation of income derived from royalties, [1973] 37 Ved. Verkh. Sov. S.S.S.R. Item 497, at 587–90. (Presidium of the Supreme Soviet USSR) (unofficial English translation in 12 INT'L LEGAL MAT'L 1517 [1973]). This strongly suggests that the USSR's need for foreign exchange might also have played a role in its adherence to the UCC.

Finally, since the United States has always accorded common law copyright protection to the unpublished works of aliens, the Soviet Union, even before acceding to the UCC, could have compulsorily purchased the common law copyright of any *samizdat* work and sued in the state courts for an injunction of any infringing U.S. publication. No such attempt has ever been made—a strong indication that this was not the reason for the Soviet accession.

[25] Ferris v. Frohman, 223 U.S. 424, 433–34 (1912); Roberts v. Petrova, 126 Misc. 86, 89, 213 N.Y.S. 434, 436 (Sup. Ct. 1925), *aff'd mem.*, 219 App. Div. 772, 219 N.Y.S. 903 (1927), *appeal dismissed,* 245 N.Y. 572, 157 N.E. 862 (1927); Mills Music, Inc. v. Cromwell Music, Inc., 103 U.S.P.Q. 84, 100 (S.D.N.Y. 1954). This principle is also recognized in the Soviet Union. M. BOGUSLAVSKII, VOPROSY AVTORSKOVO PRAVA v. MEZHDUNARODNYKH OTNOSHENIIAKH 17–18 (1973).

[26] *See* Palmer v. De Witt, 47 N.Y. 532, 539 (1872); Ferris v. Frohman, 223 U.S. 424 (1912).

[27] Ferris v. Frohman, 223 U.S. at 433–34. (Public performance of an unpublished play in England was deemed equivalent to publication in England, depriving the authors of their common law rights in England. Performance did not constitute publication in the United States, and since the English copyright law could have no extraterritorial effect, the owners retained their U.S. common law copyright).

Although the United States recognizes the potential right of a foreign government to enter U.S. courts as a copyright proprietor,[28] it is unlikely that the courts would accede to Soviet demands for injunctions of publications of *samizdat* works within the United States. Under the Act of State doctrine, U.S. courts would be barred from examining the Soviet expropriation of the copyright existing within the Soviet Union.[29] The courts, however, would not give automatic

[28] *See* M. WHITEMAN, 7 DIGEST OF INTERNATIONAL LAW (1910) where the UNESCO Report on Penal Actions in Cases of Copyright Infringement, DACP/2/13 (1963) is reported. The right of a UCC government to sue in a foreign court on behalf of one of its nationals is allowed in five countries (Canada, Italy, Norway, Spain, and the United States), while fourteen countries specifically prohibit it (Austria, *Bulgaria*, Cambodia, Finland, France, Federal Republic of Germany, India, Ireland, Luxembourg, Monaco, *Poland*, *Republic of South Africa*, Sweden, and Switzerland) (the italicized nations do not belong to the UCC). The report further notes that even where the country allows another nation to enter its courts as a plaintiff, as in the United States, the plaintiff nation must probably waive its diplomatic immunity and subject itself to cross-examination.

[29] Banco Nacional de Cuba v. Sabbatino, 376 U.S. 398, 416 (1964), quoting Underhill v. Hernandez, 168 U.S. 250, 252 (1897): "Every sovereign State is bound to respect the independence of every other sovereign State, and the courts of one country will not sit in judgment on the acts of the government of another done within its own territory. Redress of grievances by reason of such acts must be obtained through the means open to be availed of by sovereign powers as between themselves." In *Sabbatino*, an American commodity broker agreed to pay for a shipment of sugar expropriated in Cuba from an American-owned Cuban corporation by the Cuban government. After delivery in New York, the broker refused to pay the Cuban government's agent. The district court held that the Act of State doctrine did not bar review of the expropriation, since a violation of international law was involved. The court also took notice of two State Department letters as supposedly encouraging the court to review the expropriation (the "Bernstein" exception to the Act of State doctrine). The Supreme Court reversed the district court's ruling without passing on the issue of the Bernstein exception by finding that the State Department letters expressed merely a neutral executive position.

Neither would the Hickenlooper Amendment to the Foreign Assistance Act of 1964 require judicial inquiry into the expropriation in this situation, since the amendment is limited to cases involving claims of title to American-owned property confiscated in a foreign state in violation of international law and later found within the United States. Menendez v. Saks and Co. 485 F.2d 1355, 1372 (2d Cir. 1973); Banco Nacional de Cuba v. First Nat'l City Bank. 431 F.2d 394 (2d Cir. 1970), *rev'd on other grounds*, 406 U.S. 759, 780 n.5 *rehearing denied*, 409 U.S. 897 (1972). The Hickenlooper Amendment to the Foreign Assistance Act of 1961, 78 Stat. 1013, 22 U.S.C. § 2370(e)(2) (1970) reads in relevant part as follows: "(e) NATIONALIZATION, EXPROPRIATION OR SEIZURE OF

extraterritorial effect to the Soviet confiscatory decree covering property outside the Soviet Union at the time of the decree's passage, even though directed against Soviet citizens.[30]

PROPERTY OF UNITED STATES CITIZENS, OR TAXATION OR OTHER EXACTION HAVING SAME EFFECT: . . . (2) . . . [N]o court in the United States shall decline on the ground of the federal Act of State doctrine to make a determination of the merits giving effect to the principles of international law in a case in which a claim of title or other right to property is asserted by any party including a foreign state (or a party claiming through such state) based upon (or traced through) a confiscation or other taking. . . . by an act of that state in violation of the principles of international law, including the principles of compensation. . . ."

Since there was no majority opinion in the case of First National Bank v. Banco Nacional de Cuba, 406 U.S. 759 (1972), its value as precedent appears to be limited to the facts of the case. Occidental Petroleum Corp. v. Buttes Gas & Oil Co., 461 F.2d 1261 n.1 (1972). It is uncertain, therefore, whether a court would review the Soviet expropriation of its citizen's Soviet copyright if encouraged to do so by the State Department. *Cf.* Note, *International Law—Act of State Doctrine—First National City Bank* v. *Banco Nacional de Cuba*, 49 WASH. L. REV. 213, 216–19 (1973). In any event, the decision of a U.S. court as to the existence or nonexistence of a Soviet citizen's copyright in the USSR would have no extraterritorial effect. *See* note 30, *infra*.

[30] Baglin v. Cusenier Co., 221 U.S. 580 (1911) (the liqueur trademark "Chartreuse" was reserved to the exiled French monks who had registered it despite the confiscation of their vineyards in France); Maltina Corp. v. Cawy Bottling Co., 462 F.2d 1021 (5th Cir.), *cert. denied*, 409 U.S. 1060 (1972) (U.S. trademark of nationalized Cuban company held not affected by nationalization decree): Tabacalera Severiano Jorge, S.A. v. Standard Cigar Co., 392 F.2d 706 (5th Cir.), *cert. denied*, 393 U.S. 924 (1968) (U.S. debt owed to confiscated Cuban corporation held to have a situs in the United States and therefore held not to have been affected by Cuban confiscatory decree); F. Palicio y Compania, S.A. v. Brush, 256 F. Supp. 481, 488, *aff'd mem.*, 375 F.2d 1011 (2d Cir.), *cert. denied*, 389 U.S. 830 (1967) (a Cuban decree confiscating a Cuban tobacco business so as to allow the Cuban intervenors to sue to enjoin infringements in the United States of the U.S. trademarks of the confiscated business was denied effect as in violation of public policy. The Act of State doctrine was held inapplicable since the situs of the trademarks allegedly infringed was in the United States at the time of the confiscation of the Cuban business.); Carl Zeiss Stiftung v. V.E.B. Carl Zeiss, Jena, 293 F. Supp. 892 (S.D.N.Y. 1968) (attempted expropriation of all United States trademarks of nationalized East German company held ineffective in United States as against U.S. anti-expropriation policy); Compania Ron Bacardi, S.A. v. Bank of Nova Scotia, 193 F. Supp. 814 (S.D.N.Y. 1961) (Cuban nationalization decree held ineffective to terminate existence of Cuban corporation in New York); Zwack v. Kraus Bros. & Co., 93 F. Supp. 963 (S.D.N.Y. 1950), *aff'd* 237 F.2d 255 (2d Cir. 1956) (members of a confiscated Hungarian partnership were allowed to sue for infringement of their U.S. registered trademark by the government's assignees).

As Justice White stated in his dissenting opinion in *Sabbatino:* [31]

> [F]oreign confiscatory decrees purporting to divest nationals and corporations of the foreign sovereign of property located in the United States uniformly have been denied effect in our courts, including this court.

To date, the Act of State doctrine has not been applied to attempts at confiscation by a foreign sovereign of property located outside its territory.[32]

As a foreign confiscatory decree attempting to affect property located within the United States (a Soviet citizen's U.S. common law copyright), the Soviet decree would be recognized only if it were consistent with U.S. law and policy.[33] United States courts are likely to regard the determination of public policy as an "unruly horse" and may be tempted to include the vast body of international law on expropriation

[31] 376 U.S. at 447. The *Sabbatino* majority recognized the territorial limitation in its ruling quoting Underhill v. Hernandez, 168 U.S. 250, 252, that "the courts of one country will not sit in judgment on the acts of another done *within its own territory*." *Id.* at 416 (emphasis added). Moreover, the court consistently referred only to United States property confiscated abroad and returned to the United States. *Id.* at 428, 431, 436.

[32] Henkin, *The Foreign Affairs Powers of the Federal Courts: Sabbatino*, 64 COLUM. L. REV. 805, 827–28 (1964).

[33] Republic of Iraq v. First Nat'l City Bank, 353 F.2d 47, 51 (2d Cir. 1965) *cert. denied*, 382 U.S. 1027 (1966); Menendez v. Faber, Coe & Gregg, Inc., 345 F. Supp. 527, 537 (S.D.N.Y. 1972) *modified sub nom.*, Menendez v. Saks & Co., 485 F.2d 1355, 1364 (2d Cir. 1973); RESTATEMENT (SECOND), FOREIGN RELATIONS LAW OF THE UNITED STATES § 43 (1965): "(1) The [Act of State doctrine] does not prevent examination of the validity of an act of a foreign state with respect to a thing located, or an interest localized outside of its territory if the act has not been fully executed in accordance with applicable law. (2) A court in the United States will give effect to an act of a foreign state of the type described in Subsection (1) only if to do so would be consistent with the policy and law of the United States." Comment (a) provides a further illustration of the rule contained in § 43: "State A issues a decree nationalizing property of X, a national of A. The property includes real estate in the United States. In a suit in a court in the United States, X challenges the right of Y, to whom A has assigned the real estate. The Act of State doctrine will not be applied."

in discussing U.S. public policy.[34] No violation of international law will be found, however, owing to the settled doctrine that "acts of a state directed against its own nationals do not give rise to questions of international law."[35] Even so, ample U.S. law exists to indicate that the Soviet decree providing for the compulsory purchase of copyrights violates forum policy. If it is found that the "purchase" provides inadequate compensation to the Soviet author, U.S. courts would find the decree to be confiscatory and a violation of the guarantee of due process embodied in the fifth and fourteenth amendments, and of the specific prohibition of bills of attainder in article I of the Constitution.[36] Only in the case of an expropriation which is part of a "scheme of general social improvement" in which the "paucity of funds" in the government coffers makes it "impossible to carry out large-scale measures in the name of social welfare" would the court hesitate to brand such a confiscatory decree as against public policy.[37] In the present case, enforcement of the Soviet decree would not only lack any bona fide social or economic purpose, but would also violate the first amendment of the Constitution in an attempt to muzzle dissent through suppression of *samizdat* works. Finally, it is hardly likely that the courts

[34] *See* Banco Nacional de Cuba v. Sabbatino, 307 F.2d 845, 859 (2d Cir. 1962), *rev'd on other grounds*, 376 U.S. 398 (1964).

[35] United States v. Belmont, 301 U.S. 324, 332 (1937); M. Salimoff & Co. v. Standard Oil Co., 262 N.Y. 220, 186 N.E. 679 (1933); Zander, *The Act of State Doctrine*, 53 AM. J. INT'L L. 826, 836 (1959). *See* Banco Nacional de Cuba v. Sabbatino, 307 F.2d 845, 861 (2d Cir. 1962), *rev'd on other grounds*, 376 U.S. 398 (1964); Pons v. Republic of Cuba, 294 F.2d 925 (D.C. Cir. 1961), *cert. denied*, 368 U.S. 960 (1962); F. Palicio y Compania, S.A. v. Brush, 256 F. Supp. 481, 487 (S.D.N.Y. 1966), *aff'd mem.*, 375 F.2d 1011 (2d Cir. 1967).

[36] Republic of Iraq v. First Nat'l City Bank, 353 F.2d 47, 51–52 (2d Cir. 1965), *cert. denied*, 382 U.S. 1027 (1966); Habicht, *The Application of Soviet Laws and the Exception of Public Order*, 21 AM. J. INT'L L. 238, 251 (1927). On the adequacy of the state compensation, see Zobel, *Copyrights, Comrades and Capitalists*, 8 BULL. COPYRIGHT SOC'Y 210, 226 (1961).

[37] Banco Nacional de Cuba v. Sabbatino, 307 F.2d 845, 864 (2d Cir. 1962), *rev'd on other grounds*, 376 U.S. 398 (1964).

would allow a foreign government to practice eminent domain on a United States copyright, when the U.S. government itself cannot compulsorily purchase a copyright.[38]

The argument has been raised that if a state measure cannot be applied extraterritorially under normal conflict of law rules, the fact that the measure is contrary to public policy is superfluous. Only if the court is uncertain as to whether the foreign law is applicable under the *res sitae* rule would it be necessary to consider domestic public policy in order to avoid applying the foreign law.[39] Although early cases were decided in this manner, the trend in recent years has been toward basing the denial of relief to the foreign suitor on a finding that the decree was ineffective, owing to its territorial limitation and its conflict with public policy.[40]

[38] 17 U.S.C. § 8 provides that the "publication or republication by the Government . . . of any material in which copyright is subsisting shall not be taken to cause any abridgement or annulment of the copyright. . . ." This clause does not sanction governmental practice of eminent domain, but assumes publication by the government will be with "the consent of the owner of the copyright." H.R. Rep. No. 2222, 60th Cong., 2d Sess. 10 (1909), quoted in BAUMGARTEN, *supra* note 5, at 93–94 n.262.

[39] P. ADRIAANSE, CONFISCATION IN PRIVATE INTERNATIONAL LAW 154 (1956).

[40] In the 1912 copyright case of Ferris v. Frohman, 223 U.S. 424, the English statute which would have negated the plaintiffs' U.S. common law copyright if applied, was deemed strictly limited in effect to the territory of England. *Id.* at 428. In the case of Ingenohl v. Walter E. Olsen & Co., 273 U.S. 541 (1927), the Supreme Court upheld a British court's ruling that the American Alien Property Custodian in Hong Kong lacked jurisdiction to transfer trademark rights secured under the English copyright laws. 273 U.S. at 544. In neither case was any reference made to the public policy of either nation. In Zwack v. Kraus Bros. & Co., 93 F. Supp. 963 (S.D.N.Y. 1950), *aff'd*, 237 F.2d 255, 259 (2d Cir. 1956), a United States case dealing again with trademarks, the court stressed a concern that the public policy against expropriation would be emasculated were the confiscatory Hungarian decree to be given extraterritorial effect.

The two-part defense of territoriality and public policy began to assume a more solid shape in the 1966 trademark case of F. Palicio y Compania, S.A. v. Brush, 256 F. Supp. 481, 492 n.12 (S.D.N.Y. 1966), *aff'd mem.*, 375 F.2d 1011 (2d Cir. 1967), where the court observed: "It has been said that 'a disguised application of public policy may be involved in the court's treatment of an expropriation of intangible property, which has an ascribed rather than a

The recent reliance on this two-pronged attack in order to deny effect to a foreign confiscatory decree probably stems from the growing power of the Act of State doctrine. Mr. Justice White touched on this curious legal development in *Sabbatino* when he noted that foreign penal and revenue laws are denied effect because they are territorially limited in scope—and this without any examination as to their compatibility with public policy.[41] The majority in *Sabbatino* left open the question of whether the doctrine applies to other public laws (*e.g.*, copyright law), since the Act of State doctrine took precedence in *Sabbatino*, where the property was confiscated in the taking country.[42] This question remains unanswered. The Soviet Union might well be denied relief purely on the basis that the copyright decree is a penal law designed to punish dissidents, and is consequently limited territorially and ineffective within the United States regardless of the question of its compatibility with U.S. public policy.[43] Recent trademark cases indicate, however, that the Act of State doctrine analysis has been extended to cases of intellectual and industrial property confiscation, and the two-

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physical situs. In such cases the court may strain to find that the property has a situs outside the taking state, and thus avoid the application of the foreign law, even if the [contacts] with some other jurisdiction are relatively slight.'"

The modern version of the two-part defense of territoriality and public policy can be seen in the recent trademark case of Maltina Corp. v. Cawy Bottling Co., 462 F.2d 1021, 1027 (5th Cir.), *cert. denied*, 409 U.S. 1060 (1972), in which the court ruled that where the foreign decree purports to affect property located within the United States at the time of the decree's passage, the decree will be given effect only if it is compatible with the public policy of the forum.

[41] 376 U.S. at 450 n.11.

[42] *Id.* at 414.

[43] *See* Baglin v. Cusenier Co., 221 U.S. 580, 596 (1911), where the court cites with approval the opinion of Lord Macnaghten in the English companion case of Lecouturier v. Rey, [1910] A.C. 262, 265: "But it is certainly satisfactory to learn from the evidence of experts in French law that the law of Associations is a penal law—a law of police and order—and is not considered to have any extraterritorial effect." On the territoriality of penal laws in general, see SEIDL-HOHENVELDERN, INTERNATIONALES KONFISKATIONS UND ENTEIGNUNGSRECHT 59 (1952); P. ADRIAANSE, *supra* note 39, at 85–86.

pronged attack must be proved in order for the court to deny effect to the foreign decree.[44]

Only in the instance in which the executive branch, under its power to conduct foreign relations, approves by compact or treaty or otherwise ratifies the foreign decree must the court give extraterritorial effect to the act of the foreign state, for the action of the Executive would then be considered to have made the Soviet decree consistent with the law and policy of the United States.[45] In the unlikely event of an executive validation of the Soviet confiscatory decree, Congress, by passage of the proposed bill, could supersede the executive agreement and provide the courts with a legal basis for denying the decree any effect in the United States.

III. THE SOVIET ALL-UNION COPYRIGHT AGENCY (VAAP) AND THE POSSIBILITY OF SOVIET ADMINISTRATIVE CENSORSHIP

While the possibility of Soviet censorship by injunction will concern only the few *samizdat* works smuggled out of the USSR, administrative censorship by the Soviet All-Union Copyright Agency could be applied to the overwhelming majority of books sought by U.S. publishers from the Soviet pub-

[44] *See* note 40, supra. If the Soviet Union should attempt to enter foreign courts seeking injunctions of publications of *samizdat* works, the foreign civil courts would likely reach the same result as American courts, but, unhampered by an Act of State doctrine as rigid as that of the United States, they would probably base their denial of an injunction on the Soviet decree's violation of both national public policy and international law. Banco Nacional de Cuba v. Sabbatino, 376 U.S. at 421 n.21, 449 n.10. P. ADRIAANSE, *supra* note 39, at 78–89. *See especially* Bessel v. Société des Auteurs et Compositeurs Dramatiques, [1932] Trib. civil de la Seine, Judgment of Feb. 14, 1931 in 59 JOURNAL DU DROIT INT'L 114 (Clunet 1932), where a French court refused to give effect to the Soviet decree of Nov. 26, 1918, the forerunner of art. 106, confiscating the French copyrights of Rimsky-Korsakov and Moussorgsky on the grounds that the decree offended French public policy.

[45] United States v. Pink, 315 U.S. 203, 229 (1942); United States v. Belmont, 301 U.S. 324, 327 (1937); Stevenson, *Effect of Recognition on the Application of Private International Law Norms*, 51 COLUM. L. REV. 710, 720 n.54, 724–25 (1951).

lishing houses. Many of these *published* works may be slightly critical of aspects of Soviet life, causing the Soviet copyright agency to consider striking the offensive passages from the proposed American edition. As the sole contracting agent,[46] the All-Union Copyright Agency will not find it necessary to become a copyright proprietor of the work in order to control its publication. It will merely withhold publishing rights from the Western publishers until one agrees to publish a censored version. With many publishers bargaining with a single state agency, the Soviet Union will possess a considerable bargaining advantage. The publisher most eager to gain publishing rights will make the most concessions to the Soviet censors.

If an American publisher attempted at this point to publish an unauthorized edition of the Soviet work, the Soviet author or the VAAP could enter a U.S. court and enjoin the publication. Unlike the case of a *samizdat* work, in which authorization for a U.S. publication would be assumed by a

[46] *Soviet Forms World Copyright Agency*, N.Y. Times, Sept. 21, 1973, at 3, col. 1. When the Soviet Union announced the formation of the All-Union Copyright Agency (VAAP) to act as the authorized representative of the state publishing houses in dealings with the Western publishers, the new head of the VAAP made it clear that "[c]ontacts between authors and those using their works will be concluded through this agency." The following Soviet resolution formalized this procedure:

"The functions of the All-Union Copyright agency include . . . acting as an intermediary during the conclusion of agreements (contracts) with foreign juristic persons and individuals on the use of works by Soviet authors abroad and of works by foreign authors in the U.S.S.R. . . .

"The resolution provides that the right to use (publication, public performance or other type of use) outside the U.S.S.R. of works by Soviet authors previously published in U.S.S.R. territory can be transferred by the author or his assignees to a foreign user only through the All-Union Copyright Agency. . . . Works by a Soviet author that have not been published in U.S.S.R. territory nor abroad can be authorized for use abroad by the author or his assignees only through the All-Union Copyright Agency.

"The violation of the procedures established by this resolution implicitly invalidates the transaction in question and entails other liability in accordance with existing legislation."

Resolution of the USSR Council of Ministers, "On the All-Union Copyright Agency," in *The Copyright Agency's Functions*, 25 CURRENT DIGEST OF THE SOVIET PRESS, No. 52, at 3 (1974) (unofficial translation).

court, since the work had been suppressed in the USSR and smuggled out,[47] in the case of noncontroversial books published in the USSR and offered through the VAAP, no facts would exist to indicate that the Soviet Union by enjoining an unauthorized U.S. edition was not protecting the Soviet author's rights.

The inferior bargaining position of U.S. publishers in negotiations with the Soviet copyright agency poses the central problem with respect to both the buying of publishing rights to Soviet works and the sale of rights to U.S. works. Before accepting a book to be published in the Soviet Union, the Soviet copyright agency might request that the U.S. publisher substitute pro-Soviet editors for anti-Soviet editors, that particular prefaces be inserted, or that "offensive" passages be deleted. In the competition between U.S. publishers to land a Soviet contract, concessions on censorship requests might be the deciding factor.

The French-Soviet copyright experience in the early 1960s illustrates that Soviet administrative censorship is not just an empty fear. The French government unilaterally offered to treat the USSR as if it were a member of the UCC, receiving in turn permission to sell French works in one bookstore in Moscow. As one U.S. editor concluded, France's renunciation of the agreement was inevitable, owing to the continued Soviet use of a French-based copyright agency to achieve effective administrative censorship of Soviet works published in France.[48]

[47] Schwartz, *The State of Publishing, Censorship and Copyright in the Soviet Union*, PUBLISHERS WEEKLY, Jan. 15, 1973, at 32, 36.

[48] Kristol, *Of Copyrights and Commissars*, THE NEW LEADER, Apr. 12, 1965, at 13: "The Russians established a French organization, run by Communists and fellow-travelers, to deal with French publishers. This organization chose the translators and provided "suitable" editorial material: If one French publisher balked there was always another with an eye on the main chance. There was only one French edition of *One Day in the Life of Ivan Denisovich* (the sole country where this was the case) and it contained a preface by Pierre Daix, who—until Khrushchev's Secret Speech—had for years stoutly denied the very

IV. DEFENSES TO SOVIET ADMINISTRATIVE CENSORSHIP

Should the Soviet Union become intractable in an attempt to abuse the UCC in order to enforce their tight domestic censorship on an international level, the UCC itself provides a possible solution. The Soviet Union, in joining the UCC, bound itself in case of dispute with another member nation to accept arbitration before the International Court of Justice.[49] Relying on this condition of membership, the United States could attempt a diplomatic solution with the Soviet Union and, if that fails, charge the USSR with failure to provide U.S. authors with "adequate and effective protection," and with a violation of the spirit of the UCC.[50] No case has ever been brought before the International Court of Justice under this provision, however, and it is unlikely that it provides a feasible solution.

It is also possible to oppose extended Soviet censorship by resort to economic retaliation in the form of boycotts and refusals to deal. Although this type of defense would probably be ineffectual when applied by individual U.S. publish-

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existence of concentration camps in the Soviet Union, and who edits a Communist literary journal. During the six months from January 1964 through June 1964, when "modernism" was under attack by the Soviet authorities, translations of Soviet "modernists" were not delivered to French publishers who had contracted for them. They were mysteriously delayed until the Party line had softened."

Under the French Law on Copyright of March 11, 1957, all foreigners enjoyed full protection with the exception of those rights taken away by special disposition. Tournier, A Reappraisal of the First Seven Years of Application of the French Law on Copyright of March 11, 1957, 11 BULL. COPYRIGHT SOC'Y 295, 300 (1964). Tournier discusses other Soviet abuses which eventually forced the French government to condition its former freely granted protection on reciprocal treatment by the author's country. *Id.* at 301; Decree Conditioning Protection, in UNESCO, I COPYRIGHT LAWS AND TREATIES OF THE WORLD, Item 6A [France] (Supp. 1964).

[49] UCC art. XV.

[50] UCC preamble, art. I.

ers, because of the imbalance in bargaining strength between such publishers acting independently and the All-Union Copyright Agency, it could be highly useful when applied by publishers acting collectively through a publishers' union. Such a union would afford U.S. publishers a more advantageous bargaining position and provide a convenient agent for collecting royalty payments, investigating copyright infringements, and filing suits to enjoin unauthorized publications of U.S. works. However, a publishers' union poses the difficult issue of whether its formation and conduct would violate United States antitrust laws.

PROPOSED PUBLISHERS' UNION AND THE ANTITRUST LAWS

The United States antitrust policy is grounded on three basic statutes: the Sherman Act,[51] the Clayton Act,[52] and the Federal Trade Commission Act.[53] Of these three, only the Sherman Act would apply to the proposed publishers' union.[54] Under the Sherman Act, the courts have applied two tests: (1) the "rule of reason" which holds only undue restraints of trade illegal, and (2) the "per se" rule, which

[51] 15 U.S.C. §§ 1–7 (1973).

[52] 15 U.S.C. §§ 12–27 (1973).

[53] 15 U.S.C. §§ 41–58 (1973).

[54] The courts originally took the position that rights to a copyrighted work could be bought or sold and not constitute "trade and commerce" for purposes of the Sherman Act. 174th St. & St. Nicholas Ave. Amusement Co. v. Maxwell, 169 N.Y.S. 895 (Sup. Ct. 1918). A later Supreme Court case overruled these decisions, holding that the Sherman Act aims at the "restraints" of trade and commerce and not at the "subjects" of trade and commerce. The Sherman Act therefore limits restraints of trade in "rights" as well as in commodities. Standard Sanitary Mfg. Co. v. United States, 226 U.S. 20 (1912). The Clayton Antitrust Act is inapplicable to the sale or purchase of publishing rights, since § 13(a) deals only with commodities and products with tangible existence, such as "goods, wares, merchandise, machinery and supplies." Tri-State Broadcasting Co. v. United Press Int'l, Inc., 369 F.2d 268, 271 (5th Cir. 1966); La Salle Street Press, Inc. v. McCormick & Henderson, Inc., 293 F. Supp. 1004 (N.D. Ill. 1968), *modified*, 445 F.2d 84 (7th Cir. 1971). The Federal Trade Commission Act would not apply to the hypothetical case, since its purpose is to enable the Federal Trade Commission to stop unfair methods of competition in their incipiency, not to prosecute the formation of a monopoly. FTC v. Cement Institute, 333 U.S. 683, 693 (1948).

makes conduct such as price-fixing automatically illegal, without any showing of a restraint of trade.[55]

Section 1 of the Sherman Act.[56] Under the rule of reason,[57] the publishers' union would violate section 1 of the Sherman Act only if ill effects resulted from its operation (*e.g.*, price-fixing, limitation of production, deterioration of quality), and if the union intended to suppress competition. Given the presence of anticompetitive effects, an argument by the union that it was merely attempting to reduce the disastrous effect on business of cutthroat competition would not be accepted as a valid excuse.[58]

The publishers' union should not cause any of the above effects. If the union bargains with the VAAP over the royalties for a particular work, without attempting to earn excessive profits through price differentials on the less competitive works, no price-fixing should be found.[59] By resisting

[55] A. Neale, The Antitrust Laws of the United States of America 24–29 (2d ed. 1970).

[56] 26 Stat. 209 (1890), 15 U.S.C. § 1 (1970), which reads as follows: "Every contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade or commerce among the several states, or with foreign nations, is declared to be illegal."

[57] Chicago Bd. of Trade v. United States, 246 U.S. 231, 238 (1918): "But the legality of an agreement or regulation cannot be determined by so simple a test, as whether it restrains competition. Every agreement concerning trade, every regulation of trade, restrains. To bind, to restrain, is of their very essence. The true test of legality is whether the restraint imposed is such as merely regulates and perhaps thereby promotes competition or whether it is such as may suppress or even destroy competition."

[58] United States v. Topco Associates, Inc., 405 U.S. 596, 610, 611 (1972).

[59] In Buck v. Gallagher, 36 F. Supp. 405 (W.D. Wash. 1940), a state statute prohibited separate copyright owners from pooling copyrights in order to fix prices, collect fees, or issue blanket licenses, except where the licenses were assessing rates on a per-piece basis. The *Buck* court seemed concerned over monopolistic price discrimination where, through price differentials, the monopoly earns excessive profits on its noncompetitive articles. *See also* United States v. United Shoe Machinery Corp., 110 F. Supp. 295 (D. Mass. 1953), *aff'd per curiam*, 347 U.S. 521 (1954). It was a practical necessity for ASCAP to grant blanket licenses for the use of its repertory, and later consent decrees concerning ASCAP recognized this. As one commentator analyzed the situation: "The licensing of individual pieces on individual occasions would be a hopeless

Soviet attempts at censorship, the union would limit deterioration in the quality of the books purchased or sold. Some limitation of production might occur if the union refused to purchase the rights to a heavily censored work, but a court should not find this to be an unreasonable restraint of trade, since this conduct would not affect the domestic U.S. prices on other Soviet works purchased.[60] By forming the union, the American publishers certainly would hope to reduce competition among themselves in order to increase their bargaining power with the Soviets, but the members should continue to compete within the union to determine which of them will win the particular contract negotiated with the Soviet copyright agency.[61]

Although the publishers' union would not violate section 1 of the Sherman Act by bargaining as a unit, no exclusive

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task. The composers would suspect discrimination if this were done and the users would be put to intolerable inconvenience." NEALE, *supra* note 55, at 421–22. No such necessity exists for the publishers' union, and setting one price for all copyright licenses would constitute price discrimination by a monopoly similar to that in United States v. United Shoe Machinery, *supra*.

[60] The publishers' union may not intentionally restrict purchases of Soviet works in order to raise U.S. market prices for them in the United States. United States v. Socony-Vacuum Oil Co., 310 U.S. 150 (1940). The union must also be careful not to agree on a range within which purchases and sales will be made, on scales of prices to be charged within the United States, or on formulas by which to reach such a price. *Id.* at 222. In the absence of an anticompetitive effect on domestic prices, the possible restriction on purchases of Soviet works should not violate section 1 of the Sherman Act: "Certainly the law has always attached predominant importance to restraints of trade which directly influence prices, even to the extent of dealing with other forms of restriction, such as output restriction, largely in terms of their effect on price." NEALE, *supra* note 55, at 33.

[61] The publishers may decide to bid among themselves after the union has negotiated the best possible contract with the VAAP on a particular book, the highest bidder winning the contract. This system would tend to favor the big members of the union at the expense of the smaller publishers. One possible alternative would be to have the publishers bid on the contract before the union negotiates with the VAAP. Again the large firm would bid very high in order to win the contract, while actually expecting to pay the VAAP less when the contract is finally negotiated. This problem could be lessened by requiring the winning publisher to pay the union what it bid, any surplus to be distributed equitably among the union members.

dealing arrangements (where the VAAP is constrained to deal only with the union) would be allowed.[62] The union must be open to all U.S. publishers who wish to enter, since otherwise its superior bargaining power would constitute an illegal restraint of trade injuring independent U.S. publishers competing for Soviet business.[63] A horizontal allocation of markets within the U.S., or agreement on a retail price maintenance system by the union members would constitute per se violations.[64]

Possible collective boycotts by the union in refusing to deal with the VAAP on heavily censored books present a more challenging antitrust problem. Chief Justice Hughes' opinion in *Sugar Institute, Inc. v. United States* [65] indicates that the provisions of the Sherman Act

> do not prevent the adoption of reasonable means to protect interstate commerce from destructive or injurious practices and to promote competition upon a sound basis. Voluntary action to end abuses and to foster fair competitive opportunities in the public interest may be more effective than legal processes.

Justice Black rejected Hughes' position in *Fashion Originators' Guild of America, Inc. v. FTC*,[66] but the facts in that case are distinguishable from those which would probably arise from the operation of a publishers' union. In *Fashion Originators'* the Guild was restraining *interstate commerce* in order to end an "abuse" (design piracy) which was not illegal under U.S. law, and thereby encroached upon the proper functions of the Congress. In the publishers' union situation, Soviet censorship would be a violation of both domestic public policy and international law, and only private action by

[62] *See* Standard Sanitary Mfg. Co. v. United States, 226 U.S. 20 (1912).
[63] *See* Associated Press v. United States, 326 U.S. 1 (1945).
[64] United States v. Topco Associates, Inc., 405 U.S. 596, 612 (1972); Interstate Circuit, Inc. v. United States, 306 U.S. 208 (1939).
[65] 297 U.S. 553, 598 (1936).
[66] 312 U.S. 457, 468 (1941).

the union could conceivably end the abuse. In contrast to the profit motive of the Guild, the union would refuse to deal only in the face of Soviet censorship. Since only commercial boycotts are illegal per se,[67] the noncommercial refusal to deal in the publishers' union case should be treated under a "rule of reason" approach.[68] Although the members of the publishers' union would be constrained from independent bargaining with VAAP, the resulting primary boycott [69] would not be profit motivated and would be consistent with U.S. public policy and the UCC goal of ensuring authors "adequate and effective protection."

Section 2 of the Sherman Act.[70] Section 2 of the Sherman Act proscribes three separate and distinct offenses: (1) attempt to monopolize; (2) conspiracy to monopolize; and (3) monopolization.[71] Although formation of a publishers' union which included all publishers dealing with the Soviet Union could conceivably violate section 2 on all three grounds,[72] unless the union adversely affected competition

[67] United States v. Ins. Bd., 188 F. Supp. 949, 955 (N.D. Ohio 1960); United States v. United States Trotting Ass'n, 1960 Trade Cas. ¶¶ 76,954, 76,955 (S.D. Ohio 1960).

[68] Bird, *Sherman Act Limitations on Noncommercial Concerted Refusals to Deal*, 1970 DUKE L. J. 247, 276–77 (1970). Bird concludes favoring a *per se* approach to noncommercial refusals to deal, with only a minor exception for cases where access to a facility needs to be limited. *Id.* at 283, 287.

[69] A primary boycott is a ". . . trade pattern in which a number of economic actors at one level of the productive or distributive process discontinue economic relations with an actor or actors at another level, or are willing to continue relations only on certain terms." *Id.* at 252.

[70] 26 Stat. 209, 15 U.S.C. § 2 (1970) reads as follows: "Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by fine not exceeding fifty thousand dollars, or by imprisonment not exceeding one year, or by both said punishments, in the discretion of the court."

[71] *Id.*

[72] An agreement between publishers to form a publishers' union satisfies the conspiracy provision and would probably satisfy the attempt provision, since they possess enough power to have a reasonable probability of success. The present test for monopolization found in United States v. Grinnell Corp., 384

within the United States, no violation of sections 1 or 2 would occur. The Justice Department has indicated that it would not view such a monopoly as violating the antitrust laws,[73] and no U.S. citizen could sue for treble damages absent a showing that he was within a sector of the economy threatened by the conspiracy and that he was proximately injured because of the monopoly.[74] Assuming no adverse effects on the U.S. market from the activities of the publishers' union, no proximate injury to a U.S. citizen could be shown.

Since the Soviet Union would sustain the anticompetitive effects, an interesting question arises as to the standing of the Soviet copyright agency to sue for an injunction and treble damages in the U.S. courts. The primary purpose of sections 1 and 2 of the Sherman Act is to protect the public of the United States; the private remedy afforded under section 15 is only incidental.[75] The injury complained of must involve interstate commerce, either in effect or in purpose,[76] and

U.S. 563 (1966), would be satisfied, since the publishers' union would have shown monopoly power, plus the willful acquisition and maintenance of that power. *See* Note, *Monopolizing Under Section 2 of the Sherman Act*, 30 U. PITT. L. REV. 715–16 (1969).

[73] In Comegys, *Antitrust and Foreign Commerce*, 5 TRADE REG. REP. ¶ 50,129, twelve hypothetical cases illustrative of the Justice Department's position are discussed. The third and eighth cases closely parallel the publishers' union situation and are not viewed as antitrust violations by the Justice Department. The position of the Antitrust Division has been substantiated by Donald I. Baker in *Mercantilism and Monopoly—The Alternative to a Competitive America*, an unpublished paper given at a Symposium on Interrelationships Between Multinational Firms and Governments held at the University of California at Los Angeles on Nov. 16, 1973, at 7: "Antitrust does *not* prevent American firms from getting together to sell abroad, where their efforts do not raise prices in our domestic market. Nor does antitrust prevent American firms from getting together to buy abroad where their efforts lower prices in our domestic market" (emphasis in original).

[74] Billy Baxter, Inc. v. Coca-Cola Co., 431 F.2d 183 (2d Cir. 1970), *cert. denied*, 401 U.S. 923, *rehearing denied*, 401 U.S. 1014 (1970).

[75] Glenn Coal Co. v. Dickinson Fuel Co., 72 F.2d 885, 889 (4th Cir. 1934); D.R. Wilder Mfg. Co. v. Corn Products Refining Co., 236 U.S. 165, 174 (1915).

[76] Steele v. Bulova Watch Co., 344 U.S. 280, 288 (1952); United States v. Sisal Corp., 274 U.S. 268, 276 (1927); American Banana Co. v. United Fruit Co., 213 U.S. 347, 357 (1909); Interamerican Refining Corp. v. Texaco Maracaibo, Inc., 307 F. Supp. 1291, 1297 n.13 (D. Del. 1970).

absent a showing of injury to commerce within the United States, even the VAAP, injured by the publishers' union collective boycott, could not sue under the Sherman Act.[77]

POSSIBLE EXEMPTIONS FROM U.S. ANTITRUST LAWS

Although it appears that the publishers' union would not violate the Sherman Act unless an indirect restraint of U.S. commerce resulted, the publishers might wish to secure an exemption from the antitrust laws before forming the union. The Webb-Pomerene Act[78] provides a "carefully guarded exemption" for certain export associations, but it deals only with the export trade in "goods, wares and merchandise," which excludes sales in licenses (right to publish a book).[79] The exclusion of rights to publish from the Webb-Pomerene Act has been explicitly affirmed by the proposed trade bill to amend the Act to include certain "services," but preserving exclusion of trade in "patents, licenses. . . ." [80]

The President lacks the authority to grant the union immunity from the antitrust laws,[81] but the Congress could authorize the union as a regulated monopoly along the lines of COMSAT.[82] Valid legislative action resulting in a restraint

[77] A recent case, State of Kuwait v. Chas. Pfizer & Co., 333 F. Supp. 315 (S.D.N.Y. 1971), held that the sovereign of Kuwait had standing to sue as a "person" within the meaning of the Clayton Act. Since combinations not affecting the domestic commerce of the United States do not violate the antitrust laws, and since the Sherman Act deals only with injuries to interstate commerce, the value to the Soviet Union of the ability to sue under the Sherman Act should be negligible.

[78] 15 U.S.C. §§ 61–65 (1970).

[79] Green-Fulton-Cunningham Co. v. Security Trust Co., 4 F.2d 313, 315 (6th Cir. 1925).

[80] *Text and Section-By-Section Analysis of President Nixon's Proposed Trade Bill Affecting FTC Jurisdiction*, BNA ANTITRUST & TRADE REG. REP. No. 608, F-1 (1973).

[81] Consumers Union, Inc. v. Rogers, 352 F. Supp. 1319, 1323 (D.D.C. 1973) (dictum), *modified and aff'd sub. nom.*, Consumers Union v. Kissinger, 506 F.2d 136 (D.C. Cir. 1974), *cert. denied*, 421 U.S. 1004 (1975).

[82] COMSAT is a nongovernmental for-profit corporation which is subject to the District of Columbia Business Corporation Act to the extent that act is consistent with the Communications Satellite Act, 76 Stat. 423, 47 U.S.C. § 731

of trade or monopolization of trade does not violate the Sherman Act,[83] and the publishers may petition the Congress to authorize the formation of their monopoly.[84]

CONCLUSION

The greatest problem posed by Soviet adherence to the Universal Copyright Convention is the possibility of administrative censorship. The history of the French-Soviet agreement in the 1960s indicates that administrative censorship through a copyright agency is the probable Soviet response to a copyright treaty or convention. Although basically beyond solution until the Soviet leadership's need for internal censorship disappears, the problem may at least be ameliorated. American publishers interested in dealing with the VAAP should form their own agency to bargain on a more equal basis. It has been estimated by one authority that Soviet publishing houses will be busy with the translations of U.S. works published prior to the May 27, 1973 cut-off date for royalty-free translations, and that it may be "as long as one or two years before they will be looking for anything other than very exceptional new works." [85] A similar situation presumably exists for American publishers. This period could best be spent concentrating on the difficult antitrust issues involved

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(1962). In letters to the president pro tempore of the Senate and the Speaker of the House, President Kennedy outlined the need for a commercial communications satellite system to effectively represent U.S. private and governmental interests in forming a global communications satellite system. The President emphasized, however, that COMSAT would be a "government-created monopoly" and should be regulated by government. 1962 U.S. Code Cong. & Ad. News 2288, 2290.

[83] United States v. Rock Royal Co-operative, Inc., 307 U.S. 533, 560 (1939).

[84] The Sherman Act was designed to regulate business conduct, not political activity. To hold otherwise would violate the right to petition guaranteed in the Bill of Rights. United Mine Workers of America v. Pennington, 381 U.S. 657, 669–72 (1965); Eastern R.R. Presidents Conference v. Noerr Motor Freight, Inc., 365 U.S. 127, 136 (1961).

[85] *Russia and UCC: How It Looks from Moscow, supra* note 24.

in the organization of an American publishers' union to deal with possible Soviet administrative censorship. U.S. legal experts [86] have been tilting at the windmill of hypothetical Soviet injunctions of *samizdat* publications far too long.

[86] *Soviet Accession to UCC; Has The Russian Bear Been Tamed?* BNA PATENT, TRADEMARK & COPYRIGHT J., No. 191, AA-4, AA-5 (1974). [Aug. 1974 meeting of the American Bar Association Section of Patent, Trademark and Copyright Law in Honolulu, Hawaii, at which copyright experts still harbored the misconception that the USSR need only confiscate a work to bar its publication in the United States.]

NATIONAL FOURTH PRIZE, 1974

Fair Use and Photocopy

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INTRODUCTION TO THE PROBLEM

A RECENT ISSUE of *Wall Street Journal* quotes an official of McGraw-Hill publishing company to say that though the number of scientists has quadrupled in the past twenty-five years, the average scientific book sells only three-fifths as many copies as it did in 1957—a drop from nearly 5,000 to less than 3,000 copies.[1] One reason for the decline was suggested: that scientists and their books are becoming so specialized that their potential audience is becoming increasingly limited.[2] This may indeed be true, but there are perhaps two additional reasons for the decline: (1) the advent of easy, inexpensive photocopying techniques and (2) the drastic increase in the price of scientific books.[3] The problem is a perplexing one, not so much for book publishers as for publishers of scientific journals; and publishers and copyright owners have, in a very real sense, become entrapped in a

[1] Wall Street Journal, Jan. 31, 1974, at 1, col. 5 (Eastern ed.).

[2] *Id.*

[3] It is reported that books reviewed in SCIENCE as of June 1, 1973, cost 5.0, 5.3, 6.3, 7.2, 7.7, 8.8, 8.9, and 11.0 cents per page to produce. Statement by the Williams & Wilkins Co., *Hearings on S. 1361 Before the Subcomm. on Patents, Trademarks and Copyrights of the Senate Comm. on the Judiciary*, 93d Cong., 1st Sess., at 159–60 (1973) [hereinafter cited as *Hearings on S. 1361*]. The sales price, of course, must reflect these high production costs.

vicious circle from which they cannot escape. Because of specialized subject matter, publications have limited sales;[4] because of low volume, sales prices are high; because of high prices it is cheaper for potential users to make photocopies than to subscribe to the publication; and because of the increasing use of photocopies, sales become even more limited. Thus continues the downward spiral until the independent private publishers must suspend their operation as unprofitable, unless some type of subsidy is provided.[5]

The simple question, of course, is, who should be favored? Should photocopying be outlawed to protect the rights of publishers and copyright owners, or ought we to allow unrestricted copying of copyrighted materials? Obviously neither of these extremes is a proper solution to the problem. Either approach would defeat the constitutional requisite which permits the existence of copyright statutes. The Constitution gives Congress power "to promote the progress of science and useful arts, by securing for limited times to authors . . . the exclusive right to their . . . writings. . . ." [6] A ban on copying machines would hinder "scie-ce and useful arts" by making many important materials practically inaccessible; while, on

[4] The American Chemical Society (ACS) reports that subscriptions for its journal declined from between 16,000 and 17,000 in 1972 to 14,726 in 1973. Testimony of Robert W. Cairns, Exec. Director, ACS, *Hearings on S. 1361, supra* note 3, at 124.

[5] "Concern over maintaining sources of scientific and technical information has already led the federal government to subsidize page costs for journals in the physical sciences. The National Library of Medicine, for example, is currently subsidizing journals that are needed by its patrons. If nothing is done to give them meaningful copyright protection scientific and technical journals seem destined to become solely reliant on government support" (footnotes omitted). *Project: New Technology and the Law of Copyright:* Reprography and Computers, 15 U.C.L.A. L. Rev. 931, 946 (1968) [hereinafter cited as *UCLA Project*]. The American Chemical Society, publisher of twenty chemical journals, charges up to $50 per page to the authors who publish therein to help absorb costs. And publication costs are so high that these "page charges" pay less than one-third of the total costs of 70 percent of the ACS journals. *Hearings on S. 1361, supra* note 3, at 119–23.

[6] U.S. Const. art I § 8 (8).

the other hand, unrestricted use of such machines would dilute the value of the copyright, the monetary reward due to the author and publisher, and discourage the publication of important works.

We can thus answer the simple question, posed above, by saying that we must favor neither extreme—that we must consider carefully the interests on both sides. But that answer, though accurate, provides no procedural guidelines. We are left with the problem of how such an even-handed solution might be implemented, especially difficult when we contemplate the changes which might be wrought through future technological advances.

The federal copyright statute is couched in terms which give the copyright proprietor an absolute monopoly over his work: "Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right: (a) To print, reprint, publish, copy, and vend the copyrighted work. . . ."[7] So far as periodicals and journals are concerned, the statute further provides that:

> The copyright provided by this title shall protect all the copyrightable components of the works copyrighted. . . . The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted.[8]

The courts, however, have never interpreted that right as being totally exclusive. They have allowed what we call "fair use," an undefined privilege which has been called "the most troublesome [issue] in the whole law of copyrighting."[9] Fair use has been allowed as a defense when charges of copyright violation are made, but whether a use is actually fair is

[7] 17 U.S.C. § 1(a).

[8] 17 U.S.C. § 3.

[9] Deller v. Samuel Goldwyn, Inc., 104 F.2d 661, 662 (2d Cir. 1939). *See also,* Time, Inc. v. Bernard Geis Associates, 293 F. Supp. 130, 144 (S.D.N.Y. 1968), which states that the doctrine of fair use is "so flexible as virtually to defy definition."

an issue of fact,[10] and the question of what constitutes sufficient facts to raise the defense depends upon the specific case.

The courts and the commentators have reached something of a consensus on the factors which require consideration in a fair use case; [11] but, for various reasons, they have been unable to mark the precise point at which use of another's work ceases to be lawful.[12] And since photocopy technology is comparatively new (at least in the inexpensive methods which we know today), there are few fair use court cases which are relevant. It is quite a different matter to decide how much of another author's book you can safely transplant into your own without permission than it is to decide how much of that author's work can legally be photocopied.

With the advent of the coin-operated copying machine, anything and everything is being copied with little concern for others' rights. No one knows for sure what violations might exist, or if there is really a trend in the nature of the materials being copied. Apparently, however, the most widely copied materials are periodicals, especially nonprofit scientific journals. A 1967 study of six representative libraries showed that journals were copied at a rate of ten to one over books.[13] The same study also indicated that more than 80 percent of the copying from copyrighted works occurred in

[10] Eisenschimel v. Fawcett Publications, Inc., 246 F.2d 598, 604 (7th Cir. 1957).

[11] "1. The nature and purpose of the respective works; 2. The quantity and importance of the portions taken; 3. The relation of the portions used to the respective works of which they are a part; 4. The impact of the use of these portions upon the demand for the copyrighted publication." Schulman, *Fair Use and the Revision of the Copyright Act*, 53 IOWA L. REV. 832 (1968), and cited with approval in Tennessee Fabricating Co. v. Moultrie Mfg. Co., 421 F.2d 279, 283 (5th Cir. 1970). *See also*, Yankowich, *What is Fair Use?* 22 U. CHI. L. REV. 203, 213 (1954), and citations listed therein at note 53.

[12] M. NIMMER, COPYRIGHT, § 145, at 646 (1973).

[13] THE COMM. TO INVESTIGATE COPYRIGHT PROBLEMS AFFECTING COMMUNICATION IN SCIENCE AND EDUCATION, INC., THE DETERMINATION OF LEGAL FACTS AND ECONOMIC GUIDELINES WITH RESPECT TO THE DISSEMINATION OF SCIENTIFIC AND EDUCATIONAL INFORMATION AS IT IS AFFECTED BY COPYRIGHT—A STATUS REPORT, Prepared as Proj. No. 70793 for the U.S. Dept. of H.E.W., 60 (G. Sophar & L. Heilprin eds. 1967).

the first five years after publication, and that 90 percent was in the first ten years.[14] This means that many of these works are also still available from their publishers.

The scope of the problem was brought into focus when a lawsuit was filed against the United States by the Baltimore publisher Williams & Wilkins Company.[15] The complaint alleged a violation of the publisher's copyrights in eight instances by the department of Health, Education, and Welfare (HEW) through its agencies the National Institutes of Health (NIH) and the National Library of Medicine (NLM), both of Bethesda, Maryland. These agencies supply photocopies to staff researchers and patrons of articles from many journals copyrighted and published by Williams & Wilkins. Only four specific journals, however, were made the subject of the suit.[16]

The copying done by NIH and NLM is admittedly extensive. NIH subscribes to two copies each of the four journals and to about 3,000 others (mostly medical). One copy remains in the agency's library and the other circulates among the agency's researchers. The staff of NIH comprises over 12,000 persons. To meet the research needs of its large staff, NIH maintains an in-house copying service for the purpose of making Xerox and microfilm copies of journal articles which staff members may request. The copying section consists of four full-time persons. In 1970, $86,000 was budgeted for library photocopying, and during that year some 85,744 requests for photocopies of journal articles (about 930,000 pages of 93,000 articles) were processed in behalf of staff members.[17]

[14] *Id.* at 65.

[15] Williams & Wilkins Co. v. United States, 487 F.2d 1345 (Ct. Cl. 1973). The complaint was filed in 1968 and amended in 1970.

[16] The four journals concerned are MEDICINE, JOURNAL OF IMMUNOLOGY, GASTROENTEROLOGY, and PHARMACOLOGICAL REVIEWS. The first is published by the plaintiff for profit, and the other three are published in conjunction with specialty medical societies. Williams & Wilkins Co. publishes thirty-seven medical journals.

[17] Williams & Wilkins Co. v. United States, *supra* note 15, at 1348.

NLM is a repository of much of the world's medical literature. It is often referred to as a "librarians' library." It operates an interlibrary loan service to provide items of limited availability to various libraries, institutions, and individuals. These "loans" usually take the form of photocopies of journal articles. They are supplied free of charge and on a no-return basis. In 1968 NLM received 127,000 requests for interlibrary loans, about 120,000 of which were filled by photocopies of single journal articles (or about 1,200,000 pages). No effort is made by NLM to determine the ultimate use of the copies sent out, and there is no evidence that borrowing libraries keep the "loan" copies in their permanent collections for use by other patrons.[18]

Both NIH and NLM have policies which permit no more than one copy of an article to be made for any one requester; both have rules which permit copying of only forty or fifty pages from any one issue (though some exceptions are made for long articles). Both have rules prohibiting the copying of more than one article per journal for any one patron (but again NIH makes routine exceptions to this rule so long as less than half of the journal is being copied). In 1968 NLM adopted a policy limiting a patron to a copy of one article per issue or three articles per journal volume. There was no specific policy on this matter prior to 1968 except that the library "tried to prevent excessive copying." [19]

In addition, NLM maintains a special list of journals from which it purportedly will not fill copy requests from nongovernment institutions for journal articles published within the past five years. All four journals involved in the litigation are on the list, but apparently there is little observance of the list's restrictions. NLM also has a policy of honoring no more than twenty requests from an individual patron or thirty requests from an institutional patron within a month's time.[20]

[18] *Id.* at 1349.
[19] *Id.*
[20] *Id.*

On February 16, 1972, Commissioner (trial judge) James F. Davis of the United States Court of Claims filed an opinion with the court [21] in which he recommended that the defendant be found guilty of copyright infringement and that the plaintiff be entitled to recover "reasonable and entire compensation" [22] for the infringement. Whether there exists a right to make photocopies, the commissioner said, "is a matter for Congress, not the courts, to consider for it involves questions of public policy aptly suited to the legislative process." [23]

The Court of Claims, however, on November 23, 1973, rejected the recommendations of Commissioner Davis and found that since the existing statute is silent on the matter, it would have to "give the benefit of the doubt—until Congress acts more specifically—to science and the libraries, rather than to the publisher and [copyright] owner." [24] Thus the court declared the activities of NIH and NLM to be fair use.[25]

As the opinion of the Court of Claims indicates, the real problem remains unresolved. The Williams & Wilkins Company has asked the United States Supreme Court to hear its case,[26] but a decision of that Court can actually have little effect on the problem unless the Court holds that *all* photocopying is legally permissible. Such a result seems quite unlikely, and the ultimate solution depends on Congress.

The challenge to Congress will not be easily met, and even the Copyright Revision Bill now before Congress [27] might

[21] Commissioner Davis's report of the case is unofficially reported at 172 U.S.P.Q. 670.

[22] *Id.* at 679.

[23] *Id.* at 683.

[24] Williams & Wilkins Co. v. United States, *supra* note 15 at 1359.

[25] *Id.*

[26] A petition for certiorari was granted by the U.S. Supreme Court on Aug. 13, 1974 (43 U.S.L.W. 3038) (No. 73-1279).

[27] The bill, S. 1361, 93d Cong., 1st Sess. (1973), was introduced by Senator John L. McClellan (D-Ark.), chairman of the Senate Judiciary Subcomm. on Patents, Trademarks and Copyrights, on Mar. 26, 1973, and is similar to legislation which has been before Congress for the past decade.

be a failure where the fair use–photocopy controversy is concerned. The problem is dealt with in the bill, but procedural solutions are neglected, and interests on both sides have voiced criticism of the proposed package. Each camp declares that there is a giveaway to the opposition. On one side groups including the American Association of Publishers (AAP), the Authors League of America, the Information Industry Association (IIA), Educational Media Producers Council (EMPC) and the Association of American University Presses (AAUP) contend that the fair use sections of the bill are so loosely structured that they are "in effect an invitation to undertake unlimited photocopying of copyrighted materials with impunity." [28] These groups do not seek to pull the plugs on the nation's copying machines. They seek, rather, along with Williams & Wilkins, some controls and some compensation for the copies made.

On the other side of the controversy the National Education Association (NEA), the American Chemical Society (ACS), the Association of Research Libraries (ARS), the American Library Association (ALA), the Medical Library Association (MLA), the Special Libraries Association (SLA), and others have massed their forces. These groups oppose passage of the bill unless certain educational exemptions are added and various proposed changes are made. However, they are not totally agreed on what is necessary. An amendment to the bill proposed by the ALA and the ARS [29] is said to be "of no value to a significant number of . . . members of SLA." [30]

[28] Testimony of Arthur J. Rosenthal, Director of Harvard University Press, *Hearings on S. 1361*, *supra* note 3, at 141.

[29] The proposed amendment is to subsection (d) of section 108 (*see* note 144 *infra*) and is designed to remove from libraries and archives all threat of liability for making one copy of any copyrighted work at a patron's request. The amendment would also allow photocopying of an entire copyrighted work if a "reasonable investigation" showed that the work could not be readily obtained from trade sources. The proposed amendment may be found in *Hearings on S. 1361*, *supra* note 3, at 89, 98, and 106.

[30] Proposed SLA Statement on the Copyright Revision Bill, 64 SPECIAL LIBRARIES 158 (1973).

Thus rages the battle, and it is not an inconsequential one. Much is at stake on both sides. Whether Congress can produce a viable solution which will protect both groups is a pressing question. And the need for a solution will continue to become more acute as technology continues to develop the arts of reproducing and disseminating information.

In this article I propose to survey the history of copying as an element of fair use, to look at the current problem in some depth by analyzing the *Williams & Wilkins* case along with the applicable sections of the copyright bill now before Congress, and then to consider possible alternatives in light of current proposals and past history. I shall finally draw a conclusion as to what I feel is the best solution for Congress to consider.

HISTORY OF COPYING BY THE SCHOLAR AS AN ELEMENT OF FAIR USE

Copyright law is basically statutory and has developed contemporaneously with mass production of the printed word. Before Johann Gutenberg invented movable type in the first half of the fifteenth century there was little need for such protection. Certainly no one could copy enough by hand to be a significant threat to the author's rights. In fact, the author himself was in little better position. He could derive but limited monetary profit from his literary works until the advent of the mass-produced book.

Books were the first works to which copyright protection was given,[31] and the first English laws on the subject were merely statutes which required all books and printers to be licensed.[32] These laws were primarily to protect the interests of the crown in controlling materials which were considered subversive and also to bring in revenue,[33] and until 1641

[31] J. COPINGER, LAW OF COPYRIGHT 1 (7th ed. F. James 1936).
[32] *Id.* at 5–6.
[33] *Id.*

Star Chamber proved an effective tool for enforcement.[34] After the demise of Star Chamber, Parliament soon passed an ordinance which prohibited all printing of books unless they were licensed first and consent of the owner was obtained.[35] Another such ordinance was passed in 1649; and in 1662, following the overthrow of Oliver Cromwell's Commonwealth government, a strict Licensing Act[36] was passed which:

> prohibited the publication of unlicensed books, prescribed regulations as to printing and empowered the King's messengers, and the Master and wardens of the Stationers' Company, to seize books suspected of containing matters hostile to the Church or Government.[37]

Through the remainder of the seventeenth century, protection was variable and somewhat inconsistent, but some common law property rights in literary property, published and unpublished, were recognized.[38] During this period, however, it was the crown, the Stationers' Company, and the bookseller, and not the author, who derived any material benefit from a published work.[39]

After much dissatisfaction with common law remedies, England's first bona fide copyright statute[40] was passed in 1709.[41] The statute offered the author protection of his rights for fourteen years, renewable for another fourteen.[42]

In America the first copyright statutes were adopted by the states of Connecticut and Massachusetts early in 1783,[43] and

[34] E. Drone, The Law of Property in Intellectual Productions 57 (1879).
[35] Copinger, *supra* note 31, at 6.
[36] 13 & 14 Car. 2, c.33.
[37] Copinger, *supra* note 31, at 7.
[38] *Id.* at 8.
[39] With the publishing monopoly of the Stationers' Company prior to 1700, the author was in a very weak position. If he wanted to publish, he was compelled to take the price offered him for his work and with virtually no chance of receiving a royalty if his work was successful. All rights of the author were purchased outright—at buyer's price. G. Gipe, Nearer to the Dust, 27–28 (1967).
[40] 8 Anne, c.9 (1709).
[41] Copinger, *supra* note 31, at 9.
[42] 8 Anne, c.19, § 1 (1709).
[43] Drone, *supra* note 34, at 87.

later that same year the Continental Congress adopted a resolution recommending that each of the several states adopt "such laws and restrictions relating to copyright protection as . . . may seem proper." [44] Within a few years many of the states had adopted copyright statutes, but in May 1790, pursuant to the directions of the new federal constitution,[45] Congress enacted the first national copyright statute,[46] thereby preempting the field.[47]

Under English practice, a common law property right was recognized in all published books until 1774, when the House of Lords overruled previous decisions and interpreted the 1709 statute to extinguish all common law copyright protection *after* publication.[48] Since that time the only common-law copyright protection which has been recognized in England and the United States is the protection of unpublished works. The author's claim to rights in his own literary property is still recognized and defended by the courts. The only protection for published works, however, is statutory.

The language of the 1790 federal copyright statute is instructive. Section 1 reads, in part:

> Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, that from and after the passing of this act, the author and authors of any map, chart, book or books . . . within these United States, being a citizen or citizens thereof, or resident within the same . . . , and any other person or persons who hath or have purchased or legally acquired the copyright

[44] 8 J. OF THE CONT. CONG. 189 (1783).

[45] *See* note 6, *supra*.

[46] Entitled: An Act for the Encouragement of Learning, by Securing Copies, of Maps, Charts, and Books to the Authors and Proprietors of Such Copies, During the Times Therein Mentioned, 1 Stat. 124.

[47] In 1973 the Supreme Court departed from prior thinking, and, by a five to four majority, held that a state can provide protection for intellectual properties not specifically covered by federal legislation. Goldstein v. California, 412 U.S. 546 (1973). For a discussion of some areas where states might now be free to legislate see Kaul, *And Now, State Protection of Intellectual Property*, 60 A.B.A. J. 198 (1974).

[48] Donaldson v. Becket, 4 Burr. 2408 (1774).

of any such map, chart, book or books . . . , shall have the *sole right and liberty of printing, reprinting, publishing and vending* such map, chart, book or books, for the term of fourteen years from the recording the title thereof in the clerk's office, as herein after directed. . . . [Emphasis added.] [49]

The statute, in effect, created a monopoly in the copyright owner so far as the distribution of his work was concerned, but the language of that early statute gave no protection against those who might wish to "borrow" a portion of the work—even a large portion. This remained the law until 1870, when legislation offered the copyright owner "the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending" his work, as well as the right to dramatize and translate.[50] Even under this statute, however, maps and charts within a book had to be copyrighted separately or they were not protected.[51]

The modern statute [52] guarantees the copyright owner a total monopoly with no express recognition of any right in anyone else under any circumstance, but the courts have not felt bound to give that construction to the law. Others have been able to impinge upon the owner's monopoly within the uncharted limits of fair use. This doctrine allows others the right to legally copy the protected work to the extent that the owner of the copyright is not injured. The cases, of course, differ on the extent,[53] and even the nature, of fair use. Some courts have viewed fair use as a privilege to use the copyrighted material without the owner's consent,[54] while others follow the theory that the privilege is actually the implied consent of the copyright proprietor.[55] Regardless of the the-

[49] 1 Stat. 124 (1790).
[50] Act of July 18, 1870, § 86, 16 Stat. 212.
[51] Bennett v. Boston Traveler Co., 101 F. 445 (1st Cir. 1900).
[52] U.S.C., Title 17 (originally passed as 35 Stat. 1075–1087 [1909]).
[53] *See* note 9, *supra*.
[54] *See, e.g.*, Toksig v. Bruce Pub. Co., 181 F.2d 664, 666 (7th Cir. 1950).
[55] *See* Towle v. Ross, 32 F. Supp. 125, 127 n.4 (D. Ore. 1940); *cf.* Stone & McClarrick v. Dugan Piano Co., 210 F. 399 (E.D. La. 1914).

ory one espouses, however, the application and bounds of fair use are ascertainable only on a case-by-case basis.

It can scarcely be argued that the doctrine of fair use does not make sense. In the first place, if no copying were allowed the very purpose of copyright would be thwarted because the advancement of science and art would be hindered rather than promoted.[56] Since the fundamental justification for the copyright privilege is "to promote the progress of science and useful art," [57] the rights of the copyright owner to financial rewards must occasionally be subordinated to the greater public interest of developing art, science, and industry.[58]

Second, every author hopes to be copied to some extent. Does the motion picture, for example, decrease the market for the book? Some copying actually helps stimulate the market for the author's work; but regardless of this, the law cannot approve piracy. There is always a limit to what is fair.

Fair use has been widely recognized by the courts in cases where the copying was of the theme and the idea of the original work but not its actual expression,[59] and the doctrine has been recognized universally where the original is copied for purposes of review and criticism.[60] Fair use has also been recognized in connection with parody and burlesque, but the question is more difficult and there is disagreement among the courts.[61] When the use is purely incidental and the purpose

[56] *Cf.* Ginn v. Apollo Pub. Co., 215 F. 772, 776 (E.D. Pa. 1914).

[57] U.S. CONST., *supra* note 6.

[58] Rosemont Enterprises v. Random House, 366 F.2d 303, 307 (2d Cir. 1966); Berlin v. E. C. Publications, Inc., 329 F.2d 541, 544 (2d Cir. 1964). *See also*, United States v. Paramount Pictures, Inc., 334 U.S. 131, 158 (1948), where Mr. Justice Douglas, speaking for the Court, noted that "[t]he copyright law, like the patent statutes, makes reward to the owner a secondary consideration."

[59] Shipman v. R.K.O. Pictures, Inc., 100 F.2d 533, 537 (2d Cir. 1938).

[60] Latman, *Fair Use of Copyrighted Works* (Study No. 14 dated Mar. 1958) in 2 STUDIES ON COPYRIGHT, 781, 786 (A. Fisher Mem. ed. 1963).

[61] Latman, *supra* note 60, at 786. The courts disagree on the acceptability of a humorous parody or burlesque of another's work, but more extensive use of copyrighted works seems to be permitted here "than in the creation of other fictional or dramatic works not intended as a burlesque," Columbia Pictures Corp. v. Nat'l Broadcasting Co., 137 F. Supp. 348, 354 (S.D. Cal. 1955), espe-

of the copying work is such that there is no competition with the original work, the courts usually have no difficulty finding fair use,[62] but there are limits to what is permissible.

The more difficult question of fair use, and the one with which we are here concerned, deals with the copying of another's work by the scholar or educator to further his purposes in research or teaching. Unquestionably the purpose of American copyright law per se is to further the very interests which these people represent. That being true, how is this copying to be interpreted in relation to the doctrine of fair use? If all such copying were denominated fair use, the private publishing of many important works would become unprofitable, and the interest sought to be furthered by allowing permissive photocopying would actually be disserved.

There was no problem until recent years, because all copying by scholars in connection with their research was done by hand and was no threat to the rights of copyright owners. We are not sure that a handwritten copy is not a copyright violation because the courts have never ruled directly on that question, but it has generally been accepted that this is a fair use.[63] This position is strengthened because (1) there is little or no purpose of personal gain involved and (2) the hand-copying method has such inherent limitations that there can scarcely be injury to the copyright owner. A typescript copy prepared by a scholar's secretary has been presumed to inherit the same protection.[64]

There was somewhat more threat of injury by copying with the development of mimeo and ditto duplicating techniques,

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cially where no injury to the original can be shown. The Supreme Court has faced the parody-burlesque issue only once, and a divided Court affirmed without opinion an injunction against a burlesque television presentation of the copyrighted movie "Gas Light." CBS, Inc. v. Loew's, Inc., 356 U.S. 43 (1958).

[62] Latman, *supra* note 60, at 786.

[63] Petre, *Statutory Copyright Protection for Books and Magazines Against Machine Copying*, 14 ASCAP COPYRIGHT L. SYMPOSIUM 180, 193–94 (1966), citing KAPLAN & BROWN, COPYRIGHT 314 (1960).

[64] Williams & Wilkins Co. v. United States, *supra* note 15, at 1350.

but copying by these processes was uneconomical, owing to the expense of preparing a master, unless copies were made in volume. Violations of copyrights did (and still do) occur as a result of these techniques, however. Typical of those who offend are educators who copy the works of others and distribute them to their classes. One author attributes this problem to the under-forty generation of college professors who think that students ought not to pay for anything.[65] He suggests that this same group that is so freely violating authors' rights has yet to publish "and learn that hard work deserves some return." [66]

Photocopying machines have increased the potential for copying to astronomical proportions as compared with earlier methods. Anything can be copied now, and one page can be copied as economically, on a cost-per-page basis, as can 100 pages. The problem is complicated by the likes of NIH and NLM who provide copies of anything to anyone, almost for the asking. This type of copying has little similarity to the handwritten copy made by the individual scholar performing the task of reproduction for himself. Nimmer points out that "there would appear to be a qualitative difference between each individual scholar performing the task of reproduction for himself, and a library or other institution performing the task on a wholesale basis for all scholars." [67]

Photocopying machines have also increased the potential for violations by ditto-mimeo because master sheets can also be prepared photographically, and educators are running off whole chapters from books and entire journal articles for their classes with practically no investment of time and for little more than the cost of the paper. This is the type of infringement which educators seek to have declared an educa-

[65] Higham, *Copyright Erosion on Campus*, 201 PUBLISHERS WEEKLY, Jan. 24, 1972, at 41.

[66] *Id.*

[67] NIMMER, *supra* note 12, at 656.2.

tional exemption to copyright laws, because it is "in the public interest." But, we might ask, how much of an educational book's market remains after these "limited" copies for class use are made in an unlimited number of schools? [68]

There have been many recent innovations in photocopying hardware. The earliest machines, and some of those now in use, required sensitized paper. This tended to make copying quite expensive, especially before those special papers were produced in massive quantities. The great breakthrough in photocopying technology came with the development and marketing by Xerox Corporation in 1960 of a copier which could print on plain paper.[69] Other companies have since boarded the bandwagon and are invading Xerox territory.[70] International Business Machines (IBM) has had a plain-paper copier on the market since early 1970 and now has a new model, the Copier II, available. Litton Industries has a unit called the Royal Bond Copier; the Van Dyk 4000 and Addressograph-Multigraph plain-paper copiers are pending. In August of this year [1974] the Xerox 4500 will be available in the United States and Canada. This machine is designed to automatically copy on both sides of plain paper and to collate the sheets, at the rate of 2,700 sheets per hour.[71]

[68] *Scholarship, Piracy and the Copying Machine*, 199 PUBLISHERS WEEKLY, June 14, 1971, at 34.

[69] The plain-paper-copying process first patented by Xerox Corporation on its Model 914 operates with static electricity. The image of the original is projected onto a positively charged selenium-coated aluminum drum as it rotates. A negatively charged powder is sprinkled on the drum and the static electricity of the two forces causes the powder to adhere to the drum as a mirror-image of the original copy. The image is then transferred to a positively charged paper and fused by heat. GIPE, *supra* note 39, at 46.

[70] Patent infringement suits are common in this area. Perhaps the most notable suit is the Xerox suit filed against IBM Corp. in 1970. That suit was filed in U.S. District Court before IBM even had a chance to announce its new "copier." At the time this paper is written, the suit is as yet unsettled, but IBM maintains there is no infringement. An "organic photoconductor" which was patented in 1965 is used rather than a selenium-coated drum. *A Giant Rival for the Top Copier Cat*, BUS. WEEK, Apr. 25, 1970, at 33.

[71] Wall Street J., Apr. 16, 1974, at 6, col. 3 (Pac. Coast ed.).

Laser copying machines are now being developed by Xerox, IBM, Singer, Canon, Minolta, and others.[72] All these should add to the excitement.[73]

Photocopying has become a multi-million-dollar industry, and the appetite for photocopies seems totally insatiable. As an example, in 1964 roughly 9½ million photocopies were made in the United States.[74] By 1967 the total volume of photocopies in this country was estimated at about 12 billion pages,[75] and since then no one is even guessing. In 1970 there was a 1.3 billion dollar market,[76] however, and there is no real sign of a plateau. Another indication of the size of the photocopying industry is found in the fact that in 1966 the federal government itself installed 55,000 photocopying machines at a cost of 80 million dollars.[77]

As conflicts have been encountered there have been attempts to deal with them. When photocopying was very new—in 1935 to be precise—a "Gentlemen's Agreement" was drawn between a coalition of library interests (calling itself the Joint Committee on Materials for Research) and the National Association of Book Publishers. This was an effort to "protect the rights of authors and research workers." The agreement

[72] Speitzer, *Developments in Copying, Micrographics, and Graphic Communications, 1972*, 17 LIBRARY RESOURCES & TECHNICAL SERVICES 144, at 148 (1973).

[73] Litton Industries has also developed a paper with a coating which prevents photocopying. Sullivan, *Developments in Photo Reproduction of Library Materials, 1970*, 15 LIBRARY RESOURCES & TECHNICAL SERVICES 158, at 177 (1971). Xerox has a new aerosol spray that also makes paper uncopiable. *Blinding Xerox's Eye*, TIME, Apr. 15, 1974, at 87–88.

[74] Statement of C. Peter McColough, Exec. Vice President of Operations for Xerox Corp. quoted by Bella Linden in hearings on H.R. 6853 before Subcomm. No. 3 of the House Comm. on the Judiciary, 89th Cong., 1st Sess., Ser. 8, pt. 3 at 1430 (1965); *U.C.L.A. Project, supra* note 5, at 943.

[75] GIPE, *supra* note 39, at 249–50, quoting Lyle Lodwick, Director of Marketing, Williams & Wilkins Co. A more conservative estimate for 1967 was placed at about 3 billion pages of published matter. COMM. TO INVESTIGATE COPYRIGHT PROBLEMS, *supra* note 13, at 71.

[76] *A Giant Rival for the Top Copier Cat, supra* note 70, at 33.

[77] Plaintiff's brief in Williams & Wilkins Co. v. United States (No. 73–78) in the United States Court of Claims, 30n.

provided that libraries, archives, and similar institutions could:

> make and deliver a single photographic reproduction or reduction of a part [of a book or periodical] to a scholar representing in writing that he desires such reproduction in lieu of loan of such publication or in place of manual transcription and solely for the purposes of research; provided
>
> (1) That the person receiving it is given due notice in writing that he is not exempt from liability to the copyright proprietor for any infringement of copyright by misuse of the reproduction constituting an infringement under the copyright law;
>
> (2) That such reproduction is made and furnished without profit to itself by the institution making it. . . .[78]

The Gentlemen's Agreement expressed the conclusion that "mechanical reproductions from copyrighted material are presumably intended to take the place of hand transcriptions, and to be governed by the same principles governing hand transcription," but to guard against infringement of copyright the agreement required each applicant for photocopy "to assume full responsibility for such copying, and by his signature to a form printed for the purpose assure the institution that the duplicate . . . is for his personal use only and is to relieve him of the task of transcription." [79] Finally, the agreement made it clear that it was not within its spirit to "substitute . . . photostats for the purchase of a copy of the book itself either for an individual library or for any permanent collection in a public or research library." [80]

This arrangement proved quite satisfactory for a long time —until the business of photocopying grew up—and it was relied upon heavily, especially by library interests. In fact, there seemed to be considerable shock in 1972 following Commissioner Davis's report in the *Williams & Wilkins* case

[78] From a copy of the "Gentlemen's Agreement" as reproduced in 2 J. OF DOCUMENTARY REPRODUCTION 31–33 (1939).

[79] *Id.*

[80] *Id.* at 33.

because of the commissioner's intimation that the Gentlemen's Agreement could no longer be relied upon.[81] The commissioner pointed out that "the 'Gentlemen's Agreement' does not have, nor has it ever had, the force of law with respect to what constitutes copyright infringement or 'fair use' "; and that it bears little relation to most modern problems because the publishers' organization which made the agreement is now defunct and no periodicals publishers were represented in the organization when the agreement was drafted.[82]

In 1940 and 1941 an attempt was made, by the American Library Association, to enunciate a standard policy relating to fair use and the reproduction of library materials. That effort resulted in the adoption of a "Reproduction of Materials Code" in 1941 as a policy statement to be observed by member libraries. The Code accepted and restated the principles of the Gentlemen's Agreement and added some precautionary warnings in areas not covered by the earlier document. The main area where libraries were to exercise additional caution was in the duplication of materials, such as illustrations in books and periodicals, which were subject to special copyrights in addition to the general copyright on the entire work. As to these items the Code warned that "a publisher's permission is not legal protection to the library unless the publisher is either the copyright owner or the agent of owner duly authorized to grant such permission." [83]

Obviously both the Gentlemen's Agreement and the Reproduction of Materials Code were thoughtful attempts to deal with a problem not covered by statute. Both were useful, but neither had the force of law, and neither was suited to give

[81] *See, e.g.*, North, *Williams & Wilkins—the Great Leap Backward*, 3 AM. LIBRARIES, May 1972, at 528.

[82] Williams & Wilkins Co. v. United States, 172 U.S.P.Q. 670, at 680–681 (1972).

[83] The "Reproduction of Materials Code" is printed in preliminary form as it was submitted by member libraries to the Council of the ALA and the Association of Research Libraries (ARL) in December 1940 in 3 J. OF DOCUMENTARY REPRODUCTION 244–46 (1940) and as it was finally adopted by the ALA in 35 A.L.A. BULL. 84 (1941).

answers to the more complex questions which face us today with the advanced state of reproduction technology with which we must deal.

There is a noticeable absence of legal guidance in this area as acquiescence by publishers to this type of use was almost total until the *Williams & Wilkins* case. The agreement and the Code mentioned were indicative of the problem, however, and the acquiescence may have been due more to lack of substantial offenders than lack of grievances. A copyright owner cannot afford to bring suit against most infractions. The limited damages available will not cover the costs of litigation.[84]

The matter of fair use was intentionally avoided by Congress in the current (1909) statute,[85] but in the copyright reform measures introduced in Congress since that time it has had increasing emphasis. In the most recent copyright bills it has been an important feature.

Much of the legislation introduced between 1924 and 1944 was designed primarily to bring the United States law into conformity with provisions of the Berne Convention of 1886, the major international copyright convention,[86] but there were varying attempts to achieve a statutory fair use doctrine in the process.

In 1924 Congressman Frederick W. Dallinger (R-Mass.)

[84] Damages available under chapter 2 of the Copyright Act offer an alternative between actual damages plus the infringer's profits and "such damages as to the court shall appear to be just." 17 U.S.C. 101(b). The limits set by the statute for such "just" damages are that they "shall not exceed the sum of $5,000 nor be less than the sum of $250." *Id.* The same section also provides that so far as actual damages are concerned, the copyright owner is entitled to $1 for every infringing copy, but it is not clear whether, as in the *Williams & Wilkins* case, that would be $1 for an entire journal article or $1 for each page copied. It would probably be the former. The statute also provides that the prevailing party will be awarded a reasonable attorney's fee, except when the action is against the U.S. government. 17 U.S.C. 116. Even very extensive photocopying infringements offer little incentive for a damage suit, and there is little value in an injunction after the copy is already made.

[85] Latman, *supra* note 60, at 796.

[86] CONGRESS AND THE NATION, 1945–1964, 658 (1965).

introduced a bill which would have recognized "[a] fair use of any work for the purpose of study, research, criticism, or review." [87] A bill introduced in 1931 by Congressman Albert H. Vestal (R-Ind.) also provided for fair use, as did its companion measure, sponsored by Senator Felix Hebert (R-R.I.).[88] Congressman William I. Sirovich (D-N.Y.), a former editor and playwright as well as a medical doctor, introduced bills in 1932 which would have allowed fair use upon condition that credit was given to the owner of the copyright.[89]

The bill introduced by Senator Clarence C. Dill (D-Wash.) in 1932 provided that fair use could be made of copyrighted works unless the copyright owner prohibited such use by notice.[90] Senator Francis R. Duffy (D-Wis.) introduced a bill in 1935 with a fair use provision, similar to those of the Sirovich bills, requiring "due credit" for use of quotations.[91] Later Duffy bills permitted fair use in the performance of copyrighted musical works for charitable, religious, and educational purposes but deleted the provision allowing use of quotations.[92]

In 1936 Congressman Sirovich introduced another bill with fair use language the same as in his previous entries,[93] and in 1940 Senator Elbert D. Thomas (D-Utah) put forward as legislation the results of a special study by a group called the Shotwell Committee.[94] That bill would have permitted as fair use "the making of single copies of an unpublished

[87] H.R. 8177 and H.R. 9137, 68th Cong., 1st Sess. (1924).

[88] H.R. 139, S. 176, 72d Cong., 1st Sess. (1931).

[89] H.R. 12425, H.R. 12094, H.R. 10976, H.R. 10740, H.R. 10364, 72d Cong., 1st Sess. (1932). The latter three bills extended the fair use provisions slightly and made credit to the work quoted sufficient basis for fair use.

[90] S. 3985, 72d Cong., 1st Sess. (1932).

[91] S. 2465, 74th Cong., 1st Sess. (1935).

[92] S. 7, H.R. 3004, H.R. 2695, 75th Cong., 1st Sess. (1937); S. 3047, H.R. 8557, 74th Cong., 1st Sess. (1935).

[93] H.R. 11420, 74th Cong., 2d Sess. (1936).

[94] Latman, *supra* note 60, at 799.

work. . . . for study and research . . . [and] [t]he making . . . of one copy of a published work for research purposes. . . ." [95]

In 1944 the Lucas Bill [96] provided for copying of copyrighted works for "private study, research, criticism, review, demonstration, litigation, comment, newspaper summary, or fair use as recognized by the courts" upon certification that the material could not be otherwise obtained.[97]

Neither the Thomas-Shotwell nor Lucas bills nor any of their predecessors in this 1924 to 1944 period was ever passed. Only two of these bills went so far as to pass one house of Congress.[98]

In the 1950s need for revision of the 1909 Act became even more apparent, and the reform movement was rekindled. First the Copyright Society of the U.S.A., under the leadership of Arthur Fisher, Register of Copyrights, instituted study on the problems of the statute and solutions to those problems.[99] This study was utilized (and, in essence, continued) by a panel of twenty-nine consultants appointed by the Librarian of Congress in 1955 to work under the direction of Fisher in making recommendations for revision of the copyright law. After Fisher's death in 1960, work continued under Abraham L. Kaminstein, the new Register. In 1961 he submitted his report to Congress recommending some sweeping changes in the statutory approach to fair use.[100]

[95] S. 3043, 76th Cong., 3d Sess., § 12(g) and (h) (1940).

[96] S. 2039, 78th Cong., 2d Sess. (1944).

[97] Bills introduced in Congress during this period which contained no fair use provisions included H.R. 10632, 74th Cong., 2d Sess. (1936); H.R. 12549, H.R. 2990, 71st Cong., 2d Sess. (1929, 1930); H.R. 8912, 70th Cong., 1st Sess. (1928); H.R. 10434, 69th Cong., 1st Sess. (1926); H.R. 5841, 69th Cong., 1st Sess. (1925); H.R. 5841, 69th Cong., 1st Sess. (1925); H.R. 11258, 68th Cong., 2d Sess. (1925).

[98] An amendment to the Copyright Act was passed in 1949 (63 Stat. 153–54), but it bore no relevance to the matter of fair use. It was, rather, a relaxation of provisions governing the copyrighting of foreign works.

[99] The results of the study were published in STUDIES ON COPYRIGHT (Arthur Fisher mem. ed. 1963), 2 vols.

[100] *Copyright Law Revision Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*, 87th Cong., 1st Sess. (1961). This is a

Those recommendations were quite specific:

> The statute should permit a library, whose collections are available to the public without charge, to supply a single photocopy of copyrighted material in its collections to any applicant under the following conditions:
>
> (a) A single photocopy of one article in any issue of a periodical, or of a reasonable part of any other publication, may be supplied when the applicant states in writing that he needs and will use such material solely for his own research.
>
> (b) A single copy of an entire publication may be supplied when the applicant also states in writing, and the library is not otherwise informed, that a copy is not available from the publisher.
>
> (c) Where the work bears a copyright notice, the library should be required to affix to the photocopy a warning that the material appears to be copyrighted.[101]

The report further recommended that multiple photocopying by industrial concerns for staff use (the type of use made by NIH which Williams & Wilkins attacked in its suit) should not be permitted, and that commercial copying services whose work would compete with the publisher would also be in violation.[102]

Preliminary drafts of the legislation proposed by this study group were introduced in the Eighty-eighth Congress,[103] but no action was taken at that time.

In the Eighty-ninth Congress identical bills[104] were introduced in both houses of Congress.[105] Section 107 of those bills did little more than mention fair use, however—a very timid

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report of studies made by the Copyright Office and contains the tentative recommendations of that office for revision of the law. It was published by the House Comm. of the Judiciary for information purposes, but no bill was introduced at that time.

[101] *Id.* at 26.

[102] *Id.*

[103] S. 3008, H.R. 11947, 88th Cong., 2d Sess. (1964).

[104] They were identical to each other, not to the earlier bills.

[105] S. 1006, H.R. 4347, H.R. 5680, H.R. 6831, H.R. 6835, 89th Cong., 1st Sess. (1965).

approach as compared to the recommendations of the Register of Copyrights' 1961 report.[106] Section 107 of the bill read as follows: "Notwithstanding the provisions of section 106,[107] the fair use of a copyrighted work is not an infringement of copyright." [108]

The 1965 bill failed to pass either house of Congress because of various unresolved difficulties, and among those who lobbied in opposition to passage was a group called the *Ad Hoc* Committee on Copyright Revision. That committee (still in existence), representing twenty-five educational organizations, claimed that fair use provisions of the bill were too restrictive on their face. These people sought expansion of the fair use language to permit any educational use of copyrighted materials.[109] Publishing interests generally supported the bill.[110]

In 1967 the same basic package was amended and introduced in the House by Congressman Emanuel Cellar (D-N.Y.) [111] in February. It was reported out of committee in March and passed the House in April by a 379–29 roll call vote after deletion of the controversial Community Antenna Television (CATV) provisions. The bill was never acted upon by the Senate,[112] primarily because of the CATV controversy; but neither educators (who got most of what they sought) [113] nor authors and publishers offered any serious

[106] *See* text accompanying notes 87 and 88, *supra*.

[107] Section 106 of the 1965 bill gave exclusive rights to the copyright owner, subject to the limitations of §§ 107–14.

[108] S. 1006, 89th Cong., 1st Sess., § 107 (1965).

[109] CONGRESS AND THE NATION, 1945–1964, *supra* note 86, at 660.

[110] *Id.* at 661.

[111] H.R. 2512, 90th Cong., 1st Sess. (1967).

[112] The Senate version of the bill was S. 597, 90th Cong., 1st Sess. (1967).

[113] H.R. 2512, 90th Cong., 1st Sess. § 504(c)(2): ". . . In a case where an instructor in a non-profit educational institution, who infringed by reproducing a copyrighted work in copies . . . for use in the course of face-to-face teaching activities in a classroom or similar place normally devoted to instruction, sustains the burden of proving that he believed and had reasonable grounds for believing that the reproduction was a fair use under section 107, the court in its discretion may remit statutory damages in whole or in part.

objections. Even Xerox Corporation expressed total support for the bill.[114]

The fair use provisions of the bill were expanded appreciably in this new version, along lines recommended by the study committee.[115] Section 107 read:

> Notwithstanding the provisions of section 106,[116] the fair use of a copyrighted work, including such use by reproduction in copies . . . for purposes such as criticism, comment, news reporting, teaching, scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include:
>
> (1) the purpose and character of the use;
> (2) the nature of the copyrighted work;
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
> (4) the effect of the use upon the potential market for or value of the copyrighted work.[117]

These may seem like small advances, but at least the elements of fair use were defined, and there were many pages of committee reports published explaining legislative intent on the fair use question. In addition to these direct provisions for fair use, the bill would also have allowed the courts to remit damages brought against a teacher who was forced to bear the cost of proving that he believed his infringement was within the scope of fair use.[118]

Thus is the history of copyright and copyright reform in America as it relates to fair use. This history, when considered in perspective, represents very little legal progress. Reprographic technology has made giant strides, but the law remains much as it was sixty-five years ago. Within this framework let us look at the problem as it stands today.

[114] 2 CONGRESS AND THE NATION, 1965–1968 (1969).
[115] *See* text accompanying notes 101 and 102, *supra*.
[116] *See* note 107, *supra*.
[117] H.R. 2512, S. 597, 90th Cong., 1st Sess., § 107 (1967).
[118] *See* note 113, *supra*.

THE CURRENT PROBLEM

It is perhaps useful at this juncture to point out that the real problem is not which competing interest should prevail—authors and publishers on the one hand as opposed to libraries and educators on the other. It must become obvious to all concerned that the interests of both groups must be protected —a balance must be struck. The real problem which must be solved is the proper means of balancing those interests. Neither side is going to come out unscathed; both must pay some price for an equitable solution.

Some perspective may be given to the problem and the urgency of finding an adequate solution by examining in some detail the two most recent developments in the area and determining how these developments are viewed by the interested parties. We shall look first at the *Williams & Wilkins* case [119] and then at the new omnibus copyright bill before the Ninety-third Congress [120] and its fair use/photocopy provisions.

THE WILLIAMS & WILKINS CASE

We have already considered the facts of the *Williams & Wilkins* case sufficiently, so we will spend no more time with them. What we have not considered is the reasoning of the United States Court of Claims in reaching its decision that the government's practices did not constitute a violation of the publisher's copyright. The court indeed admitted that there were no prior decisions relevant to the matter which it was called upon to decide,[121] and thus approached the problem by analyzing the factors which it considered important to a fair use determination. These factors are not new to

[119] Williams & Wilkins Co. v. United States, *supra*, note 15.
[120] H.R. 8186, S. 1361, 93d Cong., 1st Sess. (1973).
[121] Williams & Wilkins Co. v. United States, *supra* note 15, at 1353.

our discussion here. They have been suggested by courts,[122] commentators,[123] and by proposed legislation.[124] The court, in fact, enumerates the same considerations enunciated by Congress in the 1967 bill: [125]

(1) the purpose and character of the use;
(2) the nature of the copyrighted work;
(3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
(4) the effect of the use upon the potential market for or value of the copyrighted work.[126]

In its analysis of these considerations the court noted eight main points:

1. NIH and NLM seek no profit by their photocopying; those requesting copies had no purpose apart from scientific and medical research and no intent to reduplicate for general distribution; and the copies were used for "scientific progress, untainted by commercial gain from the reproduction." [127]

2. Because of the large numbers of scientific personnel served and the size of the libraries, the amount of copying was not excessive, especially when considered in light of the libraries' policies of limitation.[128]

3. Library photocopying has been going on, to some extent, ever since the 1909 Act, and there is other evidence, such as the "Gentlemen's Agreement" of 1935, that "until recently, library photocopying was carried on with apparent general acceptance," at least "until the proliferation of inexpensive and improved copying machines . . . led to the surge in such duplication." [129]

[122] *See* note 11, *supra*.
[123] *Id.*
[124] *See* note 117 and accompanying text, *supra*.
[125] H.R. 2512, 90th Cong., 1st Sess. (1967).
[126] Williams & Wilkins Co. v. United States, *supra* note 15, at 1352.
[127] *Id.* at 1354.
[128] *Id.* at 1354–55.
[129] *Id.* at 1355–56.

4. "[M]edical science would be seriously hurt if such library photocopying were stopped," since it would have the effect of causing medical and scientific researchers to "simply do without, and have to do without, many of the articles they now desire, need, and use in their work." Libraries, generally, and individuals simply cannot "purchase extensive numbers of whole subscriptions to all medical journals on a chance that an indeterminate number of articles in an indeterminate number of issues" will be useful to them.[130]

5. The plaintiff failed to make an adequate showing that it was financially injured by the defendant's photocopying practices, or that any other publisher of medical journals has suffered economic harm by these practices.[131]

6. The photocopying problem, though not anticipated by Congress when the 1909 Act was written, must be interpreted and evaluated under that act. This being true, science and libraries, rather than publishers and copyright owners, should be given the benefit of the doubt until Congress decides to clarify the law and pass specific legislation on the subject.[132] The court said:

> The truth is that this is now predominantly a problem for Congress: to decide the extent photocopying should be allowed, the questions of compulsory license and the payments (if any) to the copyright owners, the system of collecting those payments (lump-sum, clearinghouse, etc.), the special status (if any) of scientific and educational needs. The choices involve economic, social and policy factors which are far better sifted by a legislature. The possible intermediate solutions are also of the pragmatic kind legislatures, not courts, can and should fashion . . . [O]n balance and on this record, thumb's up seems to us less dangerous to the varying interests at stake during the period which remains before Congress definitely takes hold of the subject.[133]

7. Congressional reports on the unsuccessful 1967 bill [134]

[130] *Id.* at 1356–57.
[131] *Id.* at 1357–59.
[132] *Id.* at 1359.
[133] *Id.* at 1360–61.
[134] H.R. 2512, 90th Cong., 1st Sess. (1967).

indicate a congressional intent to make library photocopying fair use in proper circumstances—looking at the facts of the particular case. Those reports especially contradict the plaintiff's claim that photocopying an entire article is an infringement.[135]

8. It is also significant, according to the court, that copyright legislation in other countries—specifically the United Kingdom, New Zealand, Denmark, Finland, Italy, Norway, Sweden, France, the German Federal Republic, Lichtenstein, Mexico, the Netherlands, and the USSR—allows the type of photocopying activities in which NIH and NLM are engaged. Also, Canada, India, Ireland, and South Africa have more general provisions which provide that "fair dealing" for purposes of private study is not a copyright infringement.[136]

The court emphasized that it was a combination of these eight points which made the government's practices fair use. It concluded by emphasizing the four interrelated aspects of the holding:

a. The coalescence of all eight points is what constitutes fair use. No decision was made as to whether less would suffice.

b. The holding of the case was restricted to its own facts. What other uses under other circumstances might be fair was not decided.

c. The holding rested upon a record which showed no significant injury to the plaintiff and significant potential injury to medical and scientific research if the NIH and NLM photocopying practices were unlawful. The result if the plaintiff could have shown substantial detriment was not determined.

d. The court also felt that the need for a congressional solution to the problem is critical since:

[t]he 1909 Act gives almost nothing by way of directives, the judicial doctrine of "fair use" is amorphous and open-ended, and the courts are

[135] Williams & Wilkins Co. v. United States, *supra* note 15 at 1361.
[136] *Id.* at 1361 and 1362.

now precluded, both by the Act and by the nature of the judicial process, from contriving pragmatic or compromise solutions.[137]

The design of the court was apparently to retain the status quo, "a 'holding operation,' " until "Congress enacts its preferred solution." [138]

Regardless of the court's intent and its carefully drawn limitations, there can be little doubt that the public and those who operate copying services will read the decision as giving a green light to unrestricted photocopying. If those activities are not a violation of copyright it will be hard for most of us to recognize any photocopying as not being lawful. The case, in essence, represents a "holding operation" with all of the stops wide open.

The court was narrowly divided (four to three) on the case, the dissent agreeing with the majority in its determination that the final decision is one for Congress but disagreeing that the court had power to grant "what amounts to a blanket exemption [to the provisions of the copyright statute] to the defendant's libraries." [139] The dissent is strong and well reasoned. It is based largely upon (and, in fact, adopts much of) the February 1972 opinion of Commissioner James L. Davis.

There are strong arguments which can be made on both sides, and many of the arguments of the majority are weakened considerably when we realize that the plaintiff was not seeking to enjoin the government's photocopying practices or to cut off the access of scientists and researchers to its journals in any way but, rather, to be compensated at a reasonable rate for the copies made.

The final result awaits determination, however, as the Williams & Wilkins Company has asked the U.S. Supreme Court to hear its case.[140] But note, again, that the real problem

[137] *Id.* at 1363.
[138] *Id.*
[139] *Id.* at 1372.
[140] *See* note 26, *supra*, and text accompanying.

cannot be solved by the Court. As both the majority and the dissent in the Court of Claims indicated, the final solution is one for Congress.

CURRENT LEGISLATIVE PROPOSALS

What is Congress doing, or planning to do, about the problem? Let us look at the fair use provisions of pending legislation. Section 107 of the proposed bill is unchanged from the 1967 bill.[141] That section statutorily establishes a fair use defense for those whose purposes are "criticism, comment, news reporting, teaching, scholarship or research" and lists the factors by which fair use is to be determined.[142]

Section 108, however, is greatly expanded from the 1967 version [143] and provides considerable latitude for copying copyrighted works by libraries.[144] The section permits li-

[141] *See* text accompanying note 117, *supra*.

[142] S. 1361, 93d Cong., 1st Sess., § 107 (1973).

[143] I did not discuss § 108 of the 1967 bill because that section related only to the fair use aspects of duplicating works in archival collections "for purposes of preservation and security, or for deposit for research use" in other such institutions.

[144] § 108. *Limitations on exclusive rights: Reproduction by libraries and archives.*

(a) Notwithstanding the provisions of section 106, it is not an infringement of copyright for a library or archives, or any of its employees acting within the scope of their employment, to reproduce no more than one copy . . . of a work, or distribute such copy . . . , under the conditions specified by this section and if:

(1) The reproduction or distribution is made without any purpose of direct or indirect commercial advantage; and

(2) The collections of the library or archives are (i) open to the public, or (ii) available not only to researchers affiliated with the library or archives or with the institution of which it is a part, but also to other persons doing research in a specialized field. . . .

(d) The rights of reproduction and distribution under this section apply to a copy of a work . . . made at the request of a user of the collections of the library or archives, including a user who makes his request through another library or archives, if:

(1) The user has established to the satisfaction of the library or archives that an unused copy cannot be obtained at a normal price from commonly known trade sources in the United States, including authorized reproducing services;

(2) The copy becomes the property of the user, and the library or

braries and archives to make "no more than one copy" of a copyrighted work, so long as no commercial advantage is sought, the person making the request can show that "an unused copy cannot be obtained at a normal price from commonly known trade sources" or authorized reproducing services, and the copy is used for the purpose of "private study, scholarship, or research." This section also would hold the library blameless for "unsupervised use of reproducing equipment on its premises" if it displayed a notice that copying may be subject to the copyright law, and would hold those who make copies in excess of fair use liable for doing so.[145]

All of section 108 is significant but subsection (d) is the subject of most of the present controversy, apparently because

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archives has had no notice that the copy would be used for any purpose other than private study, scholarship, or research; and

(3) The library or archives displays prominently, at the place where orders are accepted, and includes on its order form, a warning of copyright in accordance with requirements that the Register of Copyrights shall prescribe by regulation.

(e) Nothing in this section—

(1) shall be construed to impose liability for copyright infringement upon a library or archives or its employees for the unsupervised use of reproducing equipment located on its premises, provided that such equipment displays a notice that the making of a copy may be subject to the copyright law;

(2) excuses a person who uses such reproducing equipment or who requests a copy under subsection (d) from liability for copyright infringement for any such act, or for any later use of such copy, if it exceeds fair use as provided by section 107;

(3) in any way affects the right of fair use as provided by section 107, or any contractual obligations assumed by the library or archives when it obtained a copy . . . of the work for its collections.

(f) The rights of reproducing or distributing "no more than one copy . . ." in accordance with this section extend to the isolated and unrelated reproduction or distribution of a single copy . . . of the same work on separate occasions, but do not extend to cases where the library or archives, or its employee, is aware or has substantial reason to believe that it is engaged in the related or concerted reproduction or distribution of multiple copies . . . of the same work, whether on one occasion or over a period of time, and whether intended for aggregate use by one individual or for separate use by the individual members of a group.

[145] S. 1361, 93d Cong., 1st Sess., § 108 (1973). *See* note 144, *supra*.

it deals with the precise issues of the *Williams & Wilkins* case. The problem is that library and education interests, on the one hand, do not feel they are adequately protected—that the bill, as written, is so vague on what is allowable that every copy made is subject to possible suit [146]—and that "strict interpretation of the technical language of section 108(d)(1) would present serious operational problems" in the "costly and time-consuming intermediate steps of determining the availability of an unused copy." [147]

Publishing interests, on the other hand, complain of the same vagueness in section 108(d). What, for example, they ask, does 108(d)(1) mean when it refers to a "normal price"? Or a "commonly known trade source"? Who is to decide whether a price is normal? A library might easily decide that the regular market price is not normal if the cost of photocopying is substantially less. And to whom must the trade source be "commonly known"? The library, the requester, the trade, the publisher, or the courts? [148]

The issues at stake and the battle lines are clearly delineated by the Authors League of America:

> Copyright owners agree that certain copying of copyrighted works can be done by libraries without permission or compensation—i.e., copying which falls within the scope of fair use. And librarians agree that some library reproduction of copyrighted works is, and should be, copyright infringement.
>
> But there is sharp disagreement over library reproduction of entire articles, and similar portions of entire books. Library spokesmen demand that libraries be permitted to reproduce copies of any article

[146] *See* the statement by Edmon Low, Chairman of Copyright Subcomm., ALA, *Hearings on S. 1361, supra* note 3, at 106.

[147] Statement by Jaqueline W. Felter, Director, Medical Library Center of New York, for the Medical Library Association, *id.* at 111–12. For a summary of the amendment to § 108(d) which library interests have proposed as a remedy for these alleged shortcomings, see note 29, *supra.*

[148] On the controversy engendered by the issue, *see* statement prepared for Harcourt Brace Jovanovich, Inc., and Macmillan, Inc., by Mrs. Bella Linden, copyright counsel, *Hearings on S. 1361, supra* note 3; statement submitted to the Subcomm. by the Authors League of America, *id.* at 175.

and distribute them, one-at-a-time, to persons who order them, without the copyright owner's permission or compensation. While library spokesmen have focussed their demand on scientific, technical and scholarly articles, their proposed exemption would give libraries the power to reproduce copies of any article or "similarly" sized portion of any book or other work.

Libraries seek power to reproduce these copies without compensation to the copyright owner—even though (1) copies are available from the copyright owner, directly or through its licensed reproduction service, or/and (2) the copyright owner will authorize the libraries to make the copies, provided reasonable compensation is paid to the copyright owner under "workable clearance and licensing conditions."

Copyright owners contended that such unauthorized, uncompensated library reproduction of entire articles and "similarly" sized portions of entire books and other works is not permitted, and should not be permitted, under the Copyright Act. They have made it clear that the only real issue is reasonable compensation to copyright owners for library one-at-a-time reprinting of their articles and other works.[149]

The feelings on these issues are strong and persistent, but as the bill is now written, it fails to provide the needed solution—it is too vague and makes no attempt to come to grips with procedural problems. Congress must either clearly permit extensive photocopying within the meaning of fair use or it must provide procedural guidelines for administration of a royalty/licensing system. Perhaps both will be required.

PROSPECTS FOR THE FUTURE: SOME ALTERNATIVES

The problem becomes even more complex when we realize that the technology in this area is on the threshold of even greater advances. For example, computer-controlled information storage and retrieval systems, microphotography, and facsimile transmission systems (which industry now uses to transmit business documents electronically) have unique pos-

[149] Statement by the Authors League of America, *id.* at 174.

sibilities. The University of California and others have already conducted experiments with microwave equipment which have established the feasibility of using Long Distance Xeroxography (LDX) for interlibrary loans.[150]

Consider the potential of a computer-controlled storage and retrieval system of a library collection on microfiche.[151] Combine this with a sophisticated facsimile transmission system and receiver/copiers in libraries (or even homes and offices) across the country. Such possibilities [152] illustrate the challenge which Congress faces in its efforts to give the type of protection necessary to "promote science and useful arts": If such systems become common, as well they might, copyright owners may need much more protection than the proposed legislation can provide with its approach to fair use.[153]

Different solutions have been suggested, but whichever alternative is chosen, it will have to be adopted by Congress. Both the majority and the dissent in the *Williams & Wilkins* case agreed upon that point.[154] Some suggested methods of handling the matter are listed below:

[150] *UCLA project, supra* note 5, at 946–47.

[151] The microfiche process is one of reproducing the printed page onto photographic cards. The ordinary 4″ × 6″ card can contain up to 72 pages from the average book. A new process of ultra microfiche (UMF) is being employed by such organizations as National Cash Register and Encyclopedia Britannica which permits up to 3,200 pages (or seven to ten volumes) to be reproduced on one 4″ × 6″ transparency. Sullivan, *supra* note 73, at 155.

[152] Technical capabilities already exist for computer-controlled storage and retrieval devices coupled with short-distance transmission, but the demand for their implementation has been slow because of, so far, limited acceptance of microphotographed materials. *Comments and News: Micromaterials in the Library: Some Unanswered Questions,* 3 MICROFORM REV., Jan. 1974, at 5–6. Technology is also in the developmental stages for a process which would marry computer and photocopying processes. This would enable, among other things, items from the computer-controlled storage bank to be photocopied instantaneously upon demand at remote receiving centers. *The Great IBM-Xerox Race,* 100 TIME, Sept. 4, 1972, at 50.

[153] Reitz, *Williams & Wilkins: The Impact of Technology on Copyright,* 48 L.A. BAR BULL. 445 (1973).

[154] *See* text accompanying notes 132, 133, and 139, *supra.*

1. It has been suggested by some that, as a partial solution to the problem, an agency should be established whose task it would be, upon request, to determine whether an original of the sought-after work is available.[155] If it were determined that the original was not available then the making of one copy would be considered fair use. If a copy were available there would be two alternatives: (*a*) a royalty fee could be charged for the copy, or (*b*) no copy would be allowed.

2. Another means of dealing with the problem is in the method utilized by the proposed statute and by the majority of the Court of Claims in the *Williams & Wilkins* case. This method would merely broaden the scope of permissible copying under the concept of fair use without considering how to handle any copying done beyond that nebulous limit. This has its obvious weaknesses.

3. Another alternative would be the establishment of a flat, per-page fee to be collected by the copying agency and administered by an independent royalty tribunal such as the Library of Congress.[156] This system would operate either (*a*) without regard to the availability of the original work or (*b*) after recognition of a limited fair use concept. The first alternative would allow no fair use in photocopying copyrighted works and would require a fee for every copy made, as proposed by the American Chemical Society.[157] The second alternative would allow one copy to be made as a fair use (so long as there was a limit based on the number of pages copied in relation to the size of the copyrighted work). This system would put the burden on the copying agency to keep a detailed record of every copy made so that proper accounting could be made to the copyright proprietors.

4. Another suggested system would be like number three,

[155] Statement of Dr. Frank E. McKenna, Executive Director, SLA, *Hearings on S. 1361*, *supra* note 3, at 110.

[156] *Id.*

[157] Testimony of Robert W. Cairns, Exec. Director, American Chemical Society, *id.* at 119–21.

above, except that the publishers, those who would benefit from the royalty payments, would be required to establish and finance the agency which administered the program (much like the system used by the American Society of Composers, Authors and Publishers and Broadcast Music, Incorporated.[158] This system would work on a pro rata basis, and the libraries involved would not be required to separately identify and account for each photocopy.[159]

5. Another alternative solution is being proposed by the Williams & Wilkins Company. This plan would allow for the granting of a blanket copying license (for making single copies) to a library, payable as part of the library's subscription price for the copyrighted work. This licensing fee, the amount of which would depend on the specific scientific journal involved, would remove the procedural and bookkeeping problems of identifying and accounting for copies.[160] This approach presupposes that *no* mechanical copying is fair use and, in that respect, is contrary to the approach of both the copyright revision bill and the *Williams & Wilkins* case.

The proposal has the traditional elements of the free market implicit within it, and also offers simplicity of administration. There are, however, three major difficulties which would have to be overcome: (*a*) Many libraries which would ordinarily have a work within their collections would not subscribe because of the increased cost; and though they might still be able to serve their patrons with copies from

[158] These organizations license performing rights only, with royalties being based on total performances. The organization distributes royalties (after administrative costs) based upon a regular monthly sampling. BMI samples one-fortieth of the radio stations each month to determine its distribution base. Testimony of Sidney M. Kay, Chairman of the Board and general counsel, BMI, *Hearings on H.R. 4347 and other bills before Subcomm. No. 3, House Comm. on the Judiciary*, 84th Cong., 1st Sess., at 209 (1965).

[159] For an interesting variation of this plan, see the proposal of Washington, D.C., attorney Norton Goodwin. His proposal is outlined in some detail in GIPE, *supra* note 39, at 251–58.

[160] Statement submitted on behalf of Williams & Wilkins Co., *Hearings on S. 1361, supra* note 3, at 155–60.

other libraries, the service would be inferior. (*b*) There would be difficulty in establishing and regulating licensing fees so that they would be equitably related to their value. (*c*) There would also be difficulty in limiting license sales to those publications which have need of them and would be entitled thereto.

6. Another method of overcoming the procedural problems of a detailed accounting system has been suggested by Rutgers University law professor, Albert P. Blaustein. He has put forth a three-phase program which he says is designed for easy collection, administration, and distribution of royalty payments: [161]

(*a*) To collect royalties he suggests that a 10 percent surcharge be added to the selling price or rental price of all photocopy machines.[162]

(*b*) To administer his royalty plan, Professor Blaustein suggests that a quasi-governmental clearinghouse be established by the statute with membership consisting of all participating publishers through which all royalties would be paid. The quasi-governmental status would make sanctions for nonpayment of royalties criminal rather than civil. Antitrust problems would be avoided, it would be more difficult for any particular groups to gain control, and it would—because of the statute—discourage splinter groups and alternative clearing houses.

(*c*) Royalties under the Blaustein plan would be distributed by dividing all copyrighted books, periodicals and other publications into five groups based on the extent to which they are usually photocopied. Those in the "most frequently copied" category would divide 50 percent of all royalties collected, while the fifth category (including such

[161] Statement submitted on S. 1361 by Prof. Blaustein, *id.* at 573–75.

[162] Art. 53 of the German Copyright Act of 1965 provides for this type of flat fee on the sale of visual and sound recorders. Statement of Prof. Blaustein, *id.* at 579.

works as novels) might receive as little as 2 percent of the royalties.

The details of the Blaustein plan are discussed in his statement to the Senate Subcommittee on Patents, Trademarks, and Copyrights in its hearings on S. 1361 in 1973.[163] It is not entirely clear, however, how the plan would work as future technological advances become operative. For example, who would pay royalty when we combine the computer-controlled data storage and retrieval system with a microphotographic library collection and a facsimile transmission and reception system, as we discussed earlier? [164]

6. Still another approach would be to adapt Blaustein's plan to fit a direct-royalty system. Every library and institution would be required to make an accounting for the total number of pages copied from copyrighted works and pay a flat, per-copy fee to the clearing house without a detailed breakdown. The clearing house, in turn, would use the Blaustein formula for distributing royalties based on the extent to which the works are usually copied.[165] This would be a workable plan and would look to preserve the interests of all concerned. It is not unlike the "intermediate position of accommodation" proposed by the Special Library Association: [166]

> As a starting point, one potential solution might be the making of provision for the payment of a per-page royalty on photocopies of copyrighted works. Such an arrangement has precedence already in

[163] *Id.* at 573–75.

[164] Note that this proposal is very similar to that of Lyle Lodwick, Director of Marketing, Williams & Wilkins Co., as cited in *UCLA Project*, *supra* note 5, at 971. Under Lodwick's system the publisher would have the option of whether he wanted to participate in the system. *See also*, GIPE, *supra* note 39, at 249–51.

[165] *See* text accompanying notes 162–64, *supra*.

[166] *Proposed SLA Statement on the Copyright Revision Bill*, 64 SPECIAL LIBRARIES 158 (1973). The proposal is explained in detail in a statement by Dr. Frank E. McKenna, Exec. Director, SLA, *Hearings on S. 1361*, *supra* note 3, at 108–110.

the proposed Copyright Act in § 111 (relating to cable transmissions), § 114 (relating to sound recordings), § 115 (relating to phone records), and § 116 (relating to coin operated phono record players).

A Royalty Tribunal of the type proposed in Chapter 8 of the Copyright Revision Bill, but with a different membership composition could assure that the per-page royalty rate is reasonable.

Any legislative proposal should assure that libraries are not required to separately identify and account for each photocopy which they prepare or to determine the allocation of the royalties or to distribute the royalties for which they are liable among the copyright proprietors.[167]

7. If Congress, in its efforts to protect copyright owners, decides to set up a royalty system based upon a strict accounting for all copies made, manufacturers may be forced to design their machines to meet that challenge. Perhaps the simplest way is to equip each copying machine with an apparatus which can use a key-punched data-processing card, prepared for each copyrighted work, to key the copying machine and make a record of the work being copied with all its essential data.[168] The printout list of works copied would be forwarded periodically, together with collected royalty payments, to the designated clearinghouse, and all distributions of royalties would be made from that point.

The main disadvantage of such a plan would be in getting the proper cards for all the copyrighted works now housed in libraries across the country. If a card were required for every separate copyrighted work the plan could work only prospectively, and publishers would be required to provide the proper data-processing card with every copy of each new work sold. On the other hand, this problem could be overcome by the administrative authority or clearinghouse providing

[167] Statement by Dr. Frank E. McKenna, Exec. Director, SLA, *Hearings on S. 1361*, *supra* note 3, at 110.

[168] Similar systems are used by many library circulation departments to check out books to the patron. These machines are keyed with a data-processing card containing data about the book and a card (such as a library card or student activity card which has been laminated and key punched) held by the borrower.

each library with a set of cards, one for each publisher, and the publishers would be responsible, where necessary, for determining the proper distribution of royalties among their various authors. This secondary distribution could be handled by publishers in any equitable manner, perhaps by a Blaustein-type or ASCAP-type classification.[169] This publisher-card system, as opposed to an author-card system, might be used only for copyrighted works already in print or could provide the basis for determining royalty payments for both old and new works.

CONCLUSION

Obviously the approach taken by Congress in the proposed Copyright Revision Bill is inadequate. It leaves too many questions unanswered by its vague language, its avoidance of procedural matters, and its failure to allow for the effects of future technological development. I believe that a comprehensive royalty collection system of some type must be implemented, and that such a system must not limit itself to photocopying only. It should cover *all* duplication by present and future methods.[170]

It is hoped that Congress will cut back from the position taken by the Court of Claims in the *Williams & Wilkins* case, as the court's opinion indeed invites.[171] Such a sweeping extension of the fair use concept endangers the very interests which it seeks to promote, and will do so even more as technological advances make publication continually less profit-

[169] *See* note 159, *supra*, and text accompanying notes 162–164, *supra*.

[170] Reitz, *supra* note 153, at 472; *but see, UCLA Project, supra* note 5, at 973–75.

[171] Williams & Wilkins Co. v. United States, *supra* note 15, at 1363. *See also,* Comm. Davis' opinion in the trial court as cited in the text accompanying note 23, *supra*. *Cf.* portions of the court's opinion in the text accompanying notes 133 and 138, *supra*.

able and copying less costly than subscription.[172] Congress, in meeting these challenges, should reconsider its handling of fair use in the area of photocopying as well as its grants of special exemptions to education.[173]

The type of royalty collection system which Congress ought to implement should be carefully considered, but in the best interests of all concerned, the decision must be made and acted upon soon.[174] Another decade of controversy could be disastrous. My recommendation, after careful consideration of the alternatives, would be to opt for a system which would be fair to all and yet would avoid the boondoggle of excessive governmental administration. This problem of excessive administration is the chief impediment to proposals like that of Blaustein. There is also considerable difficulty with any system which would require either that copying institutions pay royalties directly to copyright owners or that publishers operate a clearinghouse for that purpose. These would be too difficult to administer, especially when one considers the number of publishers and the number of copyrighted works involved. Couple this with the severe opposition to such systems which these groups have expressed, and one must realize that such an approach is unrealistic.

After eliminating what I feel are the most objectionable and unworkable proposals, I am left with the conclusion that

[172] Williams & Wilkins Co. v. United States, *supra* note 15, at 1378, dissenting opinion of Chief Judge Cowen.

[173] The reach of § 504(c)(2) (see note 113, *supra*) is expanded in the 1973 version of the bill. The right to have damages remitted when there were reasonable grounds to believe that the copying was fair use extends to librarians and archivists as well as to instructors, and it is no longer necessary that the copies be made "for use in the course of face-to-face teaching activities in a classroom or similar place," as it was in the 1967 bill.

[174] According to Thomas C. Brennan, chief counsel for the Senate Subcomm. on Patents, Trademarks, and Copyrights, Senate passage of the bill in 1974 is not likely. *In the News: Copyright Revision Delay*, 5 AM. LIBRARIES, Jan. 1974, at 10. And the House, which passed the 1967 copyright bill, will not act again on the matter until it has a Senate-passed bill to consider. *Personalities: Rep. Robert W. Kastenmeier*, 5 AM. LIBRARIES, Jan. 1974, at 19.

a licensing system similar to that proposed by the Williams & Wilkins Company is the most feasible alternative. The system I propose would operate as follows:

1. The licensing fee would be paid as part of the subscription price directly to the publisher by the institutional subscriber. No other fees or permissions would be required to license reasonable copying.

2. Making more than one copy or copying an excessive portion of a copyrighted work would be a violation of copyright law unless it could be adequately demonstrated that no original was available from the publisher or through normal trade channels. The burden of making a reasonable determination of this fact would rest upon the person requesting the copy.

3. A review panel with representatives from both publishing/author groups and library/education groups would set up a reasonable licensing-fee schedule based on: (*a*) the nature of the various copyrighted works, and (*b*) the nature and size of the licensee institution.

4. The review panel would be required to give its approval before a licensing fee could be charged for any given copyrighted work, and the board would determine appropriate licensing fees for each work.

5. The review panel would also consider petitions to increase licensing fees and would grant such increases upon a proper showing that they were justified.

6. All decisions of the review panel would be subject to de novo court review, but the applicant would have the burden of proof in all cases. The review panel would have immunity from actions for damages.

7. Participation in this licensing system would not be mandatory, but no competing system or systems of licensing would be permitted.

8. The making of one copy of an unlicensed work for appropriate purposes, within reasonable page limitations (based

on the size of the copyrighted work), would be considered fair use. Copying unlicensed works in excess of this would be governed by the guidelines set out in item 2.

With the operation of such a system, the cost of licensing could be easily passed on to those persons who request copies. Each copy would cost only pennies more than it now does, and the continued life of endangered, valuable publications would be ensured. Also ensured would be the continuance of independent private publishing of these important works.

NATIONAL FIFTH PRIZE, 1974

Why Don't Fine Artists Use Statutory Copyright?— An Empirical and Legal Survey

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VISUAL ARTISTS seldom take advantage of the legal protection offered by the Copyright Statute. For the analytical purposes of this article, the term visual art is subdivided into applied art and fine art. Applied art, a term including commercial art, is defined [1] as "art that is employed in design or decoration of useful objects," while fine art is defined [2] as "art created primarily as an aesthetic expression to be contemplated or enjoyed for its own sake." A study of the Copyright Office Catalogue of Entries for the class [3] that includes all visual artists shows that many applied artists (e.g., designers of greeting cards, scarves, wallpaper) have taken the necessary legal steps to secure a statutory copyright, while very few fine artists (e.g., painters, sculptors) have taken these steps. The focus of this article is the fine artist and the reasons why most fine artists do not use statutory copyright.

[1] R. MAYER, A DICTIONARY OF ART TERMS AND TECHNIQUES 17 (1969).

[2] *Id.* at 145. The reader should keep in mind that the distinction between applied art and fine art is arbitrary at best.

[3] U.S. COPYRIGHT OFFICE, CATALOGUE OF ENTRIES, Part 7–11A, *Work of Art*, Vol. 24, 1970.

Thomas L. Creel, in a chapter on statutory copyright in *The Visual Artist and the Law*,[4] considered the problem and outlined the procedure for obtaining a statutory copyright for original works of art. Several other books [5] directed to fine artists and a recent law review article [6] have also urged artists to retain reproduction rights in their works by securing statutory copyright. As improved reproduction techniques permit greater commercial application [7] of original fine art, the possible financial benefits to artists who retain reproduction rights increases. The continuing nonuse by fine artists of a statutory scheme for their benefit merits further inquiry.

An assumption made by most commentators is that the reason fine artists fail to use statutory copyright is that they are unaware of its benefits and the procedures involved in obtaining a copyright. A complementary assumption is that the way to alleviate the problem of nonuse is to demonstrate to fine artists the virtues of statutory copyright and the ease with which it may be obtained. It would seem that once shown the ways of copyright fine artists might begin to preserve their legal rights.

An examination of these assumptions will be a major purpose of this article. Three other hypotheses will be set forth and considered: first, the possibility that fine artists believe the statutory requirement of a visible notice of copyright defaces or unduly commercializes their work; second, that fine art, a personal expression of the artist, is not intended at the time of creation to be a subject of commercial reproduction;

[4] Associated Councils of the Arts, et. al., The Visual Artist and the Law 3–15 (1971).

[5] J. Cahn, Copyright in Works of Art (1956); S. Hodes, The Law of Art and Antiques (1966); H. Wallis, The Copyright Handbook for Fine and Applied Arts (1963).

[6] Carroll, *Statutory Copyright—A Valuable Right for the Visual Artist*, 7 Georgia L. Rev. 134 (1972).

[7] One need only visit a department store or card shop to witness the proliferation of products inspired by original art, for example Christmas cards, decorative plates, paperweights, posters, and calendars.

third, that collectors are less willing to buy, and thus dealers are less willing to handle, a work which has a copyright notice attached.

The results of two empirical surveys will be used to test the validity of the four hypotheses. Fine artists' attitudes and knowledge of statutory copyright were measured by the compilation of questionnaires [8] answered by 206 artists. Gallery directors' views were gauged by the combined response of 45 directors to a related questionnaire.[9] Different techniques were employed in the two surveys. The survey of artists was conducted in person [10] at three juried art fairs [11] during the summer of 1973. The survey of gallery directors was conducted by mail [12] in August and September of 1973. The artists surveyed were selected [13] on the basis of availability from the participants at the three art fairs. The gallery survey was a stratified sample [14] of retail art galleries throughout the United States.

[8] See appendix A for a copy of this questionnaire.

[9] See appendix B for a copy of this questionnaire.

[10] The general practice was to introduce the subject and the purpose of the survey, leave a copy of the questionnaire and pick it up later in the day.

[11] Juried art fairs were chosen so as to eliminate most amateur artists from the sample. The three fairs surveyed were the New Mexico Arts and Crafts Fair, Albuquerque, New Mexico, June 29 through July 1 (the author is indebted to Robert L. Nelson, UNM Law '75 and Gerald Richardson, UNM Law '75, who conducted the survey in Albuquerque); Ann Arbor Art Fair, Ann Arbor, Michigan, July 18 through 21; Old Orchard Art Festival, Winnetka, Illinois, September 8 and 9. (The author owes a special debt of gratitude to his wife Bonnie Ann for her invaluable assistance at the Ann Arbor and Winnetka fairs.)

[12] Art galleries were selected from the Yellow Pages of telephone books of cities from all parts of the United States. The questionnaires were mailed along with a cover letter explaining the survey and with a stamped self-addressed envelope.

[13] The main factor in selecting an artist to be surveyed was the availability of the artist. Those artists who were unavailable at the first contact were revisited throughout the day. In this manner the majority of the artists at each fair were surveyed.

[14] *See* C. MOSTER, SURVEY METHODS IN SOCIAL INVESTIGATION 85 (1971). The cities were weighted somewhat arbitrarily, according to the size and importance of their art market. This process yielded the following mix: 50 percent to the New York City area, 5 percent to the Boston area, 5 percent to the Chicago

While empirical surveys are well suited to the sampling of individuals' experiences and attitudes, they have built-in limitations. Different respondents will interpret even the most carefully drafted questions differently. Certain of the questions, for example income or education, present a possibility for self-serving answers.[15] The validity of the survey results depends to a great extent on the character of the sample group.[16] Given the inherent limitations of quantitative social research, care must be taken to avoid absolute conclusions being drawn from the data. However, with a survey of this size, certain trends can be discerned that reveal present-day thinking in the art world. These trends suggest additional reasons for fine artists' wholesale avoidance of statutory copyright.

If one of the major problems is in fact the fine artists' ignorance of the provisions of statutory copyright, the obvious solution is more education. If defacement is the problem, a statutory modification seems in order. If collector and dealer opinion is found to be a major impediment, more education is necessary. If the time immediately after completion of the

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area, 5 percent to the Los Angeles area, 5 percent to the San Francisco area and 30 percent to other cities, none of which had more than one gallery surveyed.

[15] The anonymous nature of the survey was stressed in presenting the surveys to both the artists and the gallery directors in an attempt to mitigate this effect.

[16] Surveying only art fair fine artists tends to limit the sample somewhat. A mail survey of fine artists was considered but the author was unable to obtain a reliable list of professional artists across the country. Although the makeup of the gallery director survey is probably more representative of all gallery directors than is the artist survey of all artists, the gallery survey was limited by its poor response ratio. Of the 100 surveys mailed out, 10 were returned blank owing to improper addresses or because the gallery surveyed did not deal in living artists' work. Of the remaining 90, only 45 were completed and returned. We are faced with the question of whether the unreturned surveys would have differed markedly from the ones that were returned. I have decided to analyze the 45 returned surveys as a unit, but ever mindful that the results are a bit soft because of the response ratio. I believe that the completed gallery director surveys at least stand for the opinions and experiences of 45 galleries, which is much more data than was available prior to the data gathering.

work is the time when an artist must take steps to obtain statutory copyright and yet is the time he is least likely to be conscious of commercial considerations, a judicial reinterpretation of the time of divestitive publication [17] might be desirable.

The argument for artists' retaining future rights in their works is an equitable one: but for the artist's efforts, the work would not exist. It seems only fair that the artist retain some degree of control over the exploitation of that which he has created. The fine artists' continuing interest in a work is not solely economic. Preserving the integrity [18] of a work is an equally important concern. Statutory copyright, pursuant to the constitutional mandate [19] to encourage the progress of arts and sciences, offers the fine artist at least a measure of such control. Yet these surveys show that an overwhelming majority of fine artists do not use statutory copyright. This article explores some of the causes and suggests some remedies.

FINE ARTISTS' KNOWLEDGE OF STATUTORY COPYRIGHT

Few of the fine artists surveyed use statutory copyright; fewer still think they know enough about it. Of the 206 artists questioned, 71.8 percent answered that they never placed a copyright notice on any of their works; 83.5 percent felt

[17] Divestitive publication is that publication which causes an artist to lose a common law copyright. *See* Judge Frank's opinion in American Visuals Corp. v. Holland, 239 F.2d 740 (2d Cir. 1956).

[18] Many fine artists are concerned about supervising the color faithfulness of a reproduction to the original. Artists also like to retain a voice in the appropriateness of the commercial adaptation of their work; for example, many artists would like to be able to deny their permission to a shower curtain manufacturer who wanted to use a work of art to grace his latest creation.

[19] U.S. CONST. art. I § 8 (B); *see also* "A Bill to promote the development within the United States and foreign countries of American arts and handicrafts," H.R. 16792, 92d Cong., 2d Sess. (1972) for a recent application of the national commitment to the promotion of the arts.

that they did not have enough information concerning copyright protection to make an informed judgment about its use. Of the 14.6 percent of the artists who felt that they had enough information about copyright, two-thirds had placed a copyright notice on their work at some time. Table 1 tends to establish that more fine artists would use the provisions of the copyright statute if they knew more about it.[20]

Table 1. Relationship Between Statutory Copyright Knowledge and Use

Q—Do you personally place a copyright notice on any of the work you produce?	*Q—Do you feel that you have enough information concerning copyright protection to make an informed judgement as to its use?*	
	Yes (14.6%)	*No (83.5%)*
Never	33% (10)	81% (138)
Very Infrequently	33% (10)	10% (18)
Only on Major Works	13% (4)	3% (5)
Only on Commissioned Works	—	2% (4)
Usually	3% (1)	2% (4)
Always	17% (5)	3% (5)

If the goal of artists' retaining some future control in their work is best attained by the use of statutory copyright, and if, as the preceding statistics show, the more knowledgeable artists are or feel they are, the more likely they are to use it, then an examination of how fine artists learn of copyright is important. Fine artists may learn of statutory copyright through formal education, professional experience, national artists' organizations, or attorneys. These sources of information will be discussed in the paragraphs that follow.

The typical description of a Bachelor of Fine Arts (BFA) or a Master of Fine Arts (MFA) degree is that it is a course of study designed to prepare the student for a career as a professional artist.[21] This preparation includes instruction in

[20] The table compares responses to questions 2 and 3 of the Artist Survey, given here as appendix A.

[21] For example, Michigan State University: "Students who anticipate careers in the fine arts field"; University of North Carolina: "For those considering professional careers"; University of Wisconsin: "The program is planned for the prospective professional artist."

technical skills and art history. Ideally, the instruction should also include some reference to those provisions of the copyright statute intended to benefit fine artists. Apparently this is not presently the case, since most university art departments offer no courses covering statutory copyright.[22]

That most university art departments fail to teach about statutory copyright is demonstrated by the results of the artist survey. Of the 206 artists surveyed, 29.1 percent (60) had a BFA and 22.3 percent (46) had an MFA. Table 2 represents the responses of those artists having a BFA or an MFA to questions concerning the need for and the knowledge and use of copyright.

Table 2. Effect of BFA or MFA Degree on Certain Responses

Questions from Artist Survey:	*BFA* (60)	*MFA* (46)	*Entire Sample* (206)
1. Thinks visual artists need copyright protection			
Yes	88.3% (53)	89.1% (41)	88.9% (183)
No	11.7% (7)	10.9% (5)	6.8% (14)
No response	—	—	4.3% (9)
2. Uses a copyright notice			
Never	71.7% (43)	71.7% (33)	71.8% (148)
Very Infrequently	18.3% (11)	8.7% (4)	13.6% (28)
Only on Major Works	1.7% (1)	4.4% (2)	4.4% (9)
Only on Commissioned Works	1.7% (1)	2.2% (1)	1.9% (4)
Usually	1.7% (1)	2.2% (1)	2.4% (5)
Always	5.0% (3)	10.9% (5)	4.8% (10)
13. Has enough knowledge concerning copyright			
Yes	11.7% (7)	10.9% (5)	14.6% (30)
No	85.0% (51)	84.9% (39)	83.5% (172)
No response	3.3% (2)	4.3% (2)	1.9% (4)

It is significant that the responses of those with degrees in fine art do not differ greatly from the sample as a whole. Holders of fine art degrees are just as unaware of the pro-

[22] The author was unable to find any such course being offered by a university art department. Several dozen university catalogs were consulted. The possibility that the subject is covered in other courses remains.

visions and intended benefits of statutory copyright as those artists who were not educated in university art departments. The remedy is obvious. Art departments should add courses to their curricula that cover statutory copyright. Instruction should be offered to teach fine art students how to retain some control over their work.

But beyond merely stating that new courses are necessary, there is the additional problem of training qualified teachers. Since 88 percent of the teachers of college age students felt that they did not know enough about copyright (table 3), it cannot reasonably be expected that their students will learn about the provisions and benefits of the copyright statute.

Table 3. Responses of Teachers of College Age Students to Selected Questions

Questions from Artist Survey:	*Teachers* (72)	*Entire Sample* (206)
2. Uses a copyright notice		
Never	69.4% (50)	71.8% (148)
Very Infrequently	13.9% (10)	13.6% (28)
Only on Major Works	4.2% (3)	4.4% (9)
Only on Commissioned Works	5.6% (4)	1.9% (4)
Usually	4.2% (3)	2.4% (5)
Always	2.8% (2)	4.8% (10)
13. Has enough knowledge concerning copyright		
Yes	11.1% (8)	14.6% (30)
No	87.5% (63)	83.5% (172)
No response	1.4% (1)	1.9% (4)

Many fine artists learn of copyright through contacts with other artists or by repeated dealings with the public. In order to measure the degree to which the professional experience of fine artists affects their knowledge of statutory copyright, the responses of those who had participated in more than fifty juried [23] art exhibitions were analyzed separately. The responses of those artists who had more than ten one-person

[23] Juried art fairs qualified as juried art exhibitions.

shows were also studied separately. Table 4 shows the more experienced fine artists' responses to selected questions.

Table 4. Experienced Artists' Responses to Certain Questions

Questions from Artist Survey:	*More than 50 Juried Exhibitions* (39)	*More than 10 One-Person Shows* (41)	*Entire Sample* (206)
2. Uses a copyright notice			
Never	64.1% (25)	56.1% (23)	71.8% (148)
Very Infrequently	17.9% (7)	14.6% (6)	13.6% (28)
Only on Major Works	2.6% (1)	12.2% (5)	4.4% (9)
Only on Commissioned Works	2.6% (1)	4.9% (2)	1.9% (4)
Usually	5.1% (2)	4.9% (2)	2.4% (5)
Always	7.7% (3)	7.3% (3)	4.8% (10)
10. Relies on sale of art as main source of income.	66.7% (26)	58.6% (24)	37.9% (78)
13. Has enough knowledge concerning copyright			
Yes	15.4% (6)	19.5% (8)	14.6% (30)
No	84.6% (33)	75.6% (31)	83.5% (172)
No response	—	4.9% (2)	1.9% (4)
17. Has had some art work reproduced	76.9% (30)	78.1% (32)	55.3% (114)
21. Has personally felt the need for copyright protection	46.2% (18)	34.2% (14)	28.6% (59)

These data suggest that more experienced artists are more likely to use copyright than the neophyte. This might be because they have had more of their work reproduced, and more of them rely on the sale of their art as a main source of income. As compared to the whole sample, the more experienced fine artists more often felt a personal need for copyright protection. And yet the overwhelming majority of these more experienced artists stated that they did not have enough information concerning copyright protection to make an informed judgment about its use. Further, 31 of the 56 (55.4%) artists who used a copyright notice at times felt that they did not have enough information on copyright. Clearly fine artists should be offered more opportunities to

learn about the procedures and benefits of statutory copyright.

Many fine artists, notably the more successful ones, sell their art primarily through a retail art gallery. Artists often look to art gallery directors for information concerning legal rights. Of the art gallery directors responding to the survey, 82 percent (37) stated that they advised their artists on business and legal matters. Significantly, of the 82 percent who did advise artists, 78.4 percent (29 of the 37) did not feel that they had enough information concerning copyright. Since 1966 New York State has had a statute [24] enacted specifically to make it easier for fine artists to retain reproduction rights. Of the 19 New York galleries replying to the gallery director survey, only one was familiar with the law.[25] These figures suggest that contact with most gallery directors does not provide a realistic opportunity for fine artists to learn of statutory copyright.

For many fine artists the art gallery director might be the only source of information. Of the replying art gallery directors, 80 percent (36) stated that they represented some artists on an exclusive basis.[26] Those directors felt somewhat more confident about their knowledge of artists' rights. Still, 72.2 percent (26 of the 36) admitted insufficient knowledge of copyright on which to base an informed judgment. The gallery directors were also asked whether they felt that the fine artists they represented had enough information about copyright to make a judgment for themselves; 75.5 percent (34) of the directors felt that the artists they deal with lacked such knowledge. These 34 directors represented a total of 260 artists on an exclusive basis. Trade associations such as

[24] N.Y. Gen. Bus. L., Art. 12-E.

[25] A question specifically inquiring about the law was not included on the survey; the answer came to question 12 of the gallery survey (*see* appendix B).

[26] A typical clause in a gallery contract serves as a good definition of exclusive representation, "During the term hereof, you agree that you shall not contract with, or make any arrangements whatsoever for any other sales representation. . . ."

the Art Dealers Association could provide their members with a needed service by initiating a program of copyright education for art gallery employees and owners.

As an artist's fame and following increase, the price of his or her work and the amount of income derived from it generally rise as well. The possibility that an artist will experience copyright problems appears to increase with renown. As an artist's economic position improves, it is likely that the artist will seek legal advice concerning reproduction rights. While a question about lawyers was not included in the artist survey, several artists indicated that they had sought legal advice concerning copyright. In order to see what patterns there might be, responses of the financially more successful artists were sifted out for separate study (see table 5).

Table 5. Selected Responses of the More Financially Successful Artists

Questions from Artist Survey:	*Paintings Sell for More than $500* (30)	*More than $10,000 in Yearly Art Income* (19)	*Entire Sample* (206)
2. Uses a copyright notice			
Never	43.3% (13)	57.8% (11)	71.8% (148)
Very Infrequently	26.7% (8)	10.5% (2)	13.6% (28)
Only on Major Works	3.3% (1)	10.5% (2)	4.4% (9)
Only on Commissioned Works	6.7% (2)	—	1.9% (4)
Usually	6.7% (2)	10.5% (2)	2.4% (5)
Always	13.3% (4)	10.5% (2)	4.8% (10)
13. Has enough knowledge concerning copyright			
Yes	23.3% (7)	10.5% (2)	14.6% (30)
No	76.7% (23)	89.5% (17)	83.5% (172)
No response	—	—	1.9% (4)
17. Has had some art work reproduced	70.0% (21)	73.7% (14)	55.3% (114)

While the data are not conclusive, they do seem to establish that the financially successful fine artist is more likely to take advantage of the benefits of copyright. This may be due to greater experience with commercial reproduction of

their work—some 70 percent of this group answered that at least one of their works had been reproduced. But even this group complained of a general lack of information about copyright, although their average was somewhat better than the sample as a whole. Those 68.8 percent (31 of the 45) art gallery directors who sold paintings priced at more than $2,000 demonstrated a knowledgeableness about copyright similar to that of the financially successful artists. Only 25.8 percent (8 of 31) of the directors of galleries selling higher-priced works felt that they had sufficient knowledge of copyright. While relative financial success would allow artists and gallery directors to seek legal advice from an attorney, it appears that most have not. And with the rising price of legal services this may not be a practical solution.[27]

Perhaps the best opportunity for many fine artists to learn about statutory copyright is that which could be provided by the national artists' organizations and the periodicals directed to fine artists. Artists' Equity Association has developed a campaign to educate fine artists about the benefits of statutory copyright.[28] Artists' Equity Association, unfortunately, seems to be the exception rather than the rule. Most artists' groups have made no such attempts. The responses of those 47 artists who belong to a national artist group do not differ much from the sample as a whole. More do use a copyright notice; 31.9 percent (15 of 47) stated that they used a copyright notice sometimes. Ironically, the artists who belong to such national organizations felt less sure about their knowledge of copyright than the sample as a whole; 87 percent (41 of 47) felt they had too little information as compared with 83.5 percent for the entire sample.

[27] Several of our bigger cities have organizations that offer free legal advice to artists. Volunteer Lawyers for the Arts in New York City is but one example.

[28] A copy of J. B. Cahn's Copyright in Works of Art has been distributed to Artists' Equity members.

The survey suggests that most fine artists belong to some artists' organization, whether local, regional, or national.[29] These organizations present a good opportunity to remedy the problem of ignorance of statutory copyright among those artists who have completed their formal education. Another good method of educating this group of artists is by means of those art journals, widely read in the artists' community, which have become interested in the general area of "artists' rights." Subjects like "droit de suite," [30] artists' royalties,[31] and contract rights [32] seem to have attracted the most attention, but a few articles have touched on the general area of statutory copyright.[33]

In a field that so very much needs reliable information about copyright, the literature directed to fine artists has some notable sources of possible misinformation. Some confusion exists about the significance of an unrestricted sale. Kenneth Harris states that "when a painting is sold, the reproduction right remains the property of the artist unless specifically conveyed to the purchaser in the bill of sale." [34] The opposite presumption may well be true. *Pushman v. New York Graphic Society* [35] held that the artists' common law copy-

[29] 134 artists (65% of the 206) answered that they belonged to at least one artists' group.

[30] "Droit de suite" or follow-up rights allow the artist to participate in the financial appreciation of a work of art. France has had such a law since 1920; since 1957 the artist has a right to 3 percent of the total sales price of all future sales. *See* note 71 *infra*. *See also* M.E. and A.B. Price, *Rights of Artists: The Case of the Droit de Suite*, 31 ART JOURNAL, 144–49, and M. Price, *Government Policy and Economic Security for Artists: The Case of Droit de Suite* 77 YALE L. J. 1333 (1968).

[31] Baldwin, *Art & Money: The Artist's Royalty Problem*, ART IN AMERICA, March–April 1974, at 20.

[32] Sieglub, *Artists Reserved Rights and Sales Agreement*, 181 STUDIO, at 142–44, April 1971; Weiner, *The Artist and His Gallery: Legal Agreements that Work*, AMERICAN ARTIST, January 1974, at 22–27.

[33] Rie, *Legal Rights of Artists*, 30 ART JOURNAL 46 (1970).

[34] K. Harris, HOW TO MAKE A LIVING AS A PAINTER 126 (1966).

[35] 287 N.Y. 302, 306, 39 N.E.2d 249, 251 (1942). *See infra* notes 85, 86 and 87.

right passed to the buyer in an unrestricted sale of an uncopyrighted work of art. New York State in 1966 attempted to overrule *Pushman* by legislating a presumption favoring the artist,[36] but of course this statute applies only in New York. The editors of a recent Practising Law Institute handbook [37] on the subject of the fine arts and the law stated that the *Pushman* holding was representative of the law in those jurisdictions without a statute like that in New York.

Harris goes on to state that to be safe an artist should place the following notice on the back of every painting: "Reproduction Rights Reserved. This Painting may not be reproduced in any form without the written permission of the artist." [38] Another author recommends that fine artists should "insist on labeling the back of every painting 'All reproduction rights reserved.' " [39] While such notices no doubt would have substantial *in terrorem* effect, it is unclear what their legal impact would be. If such notices are meant to be a clause in the sales agreement, it is advisable that they be included in the bill of sale. If such notices are meant to trigger the protections of the copyright statute, they might be found to be unacceptable deviations from the prescribed notice form.[40] The possibility that these authors might confuse fine artist readers concerning reproduction rights is heightened by the fact that nowhere in either book is the availability of statutory copyright protection mentioned. *The Visual Artist and the Law* [41] stands out as the most authoritative legal guide for fine artists. In addition to information about copyright, the book covers the entire spectrum of fine artists' potential legal problems.

[36] N.Y. Gen. Bus. L., Art. 12-E, *see supra* note 24 and *infra* p. 186.

[37] LEGAL AND BUSINESS PROBLEMS OF ARTISTS, ART GALLERIES AND MUSEUMS, 333 (F. FELDMAN & S. WEIL EDS. 1973).

[38] HARRIS *supra* note 34, at 126.

[39] B. CHAMBERLAIN THE ARTISTS' GUIDE TO HIS MARKET 63 (1970).

[40] *See* REGISTER OF COPYRIGHTS, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES, at part 4.2.2 (1970). [Hereinafter cited as COMPENDIUM.]

[41] *See supra* note 4.

In conducting the surveys I found many artists and gallery directors who expressed a strong desire to learn about the procedures for obtaining a statutory copyright. Many questions were asked concerning the legal effect of certain notice forms. The problem is not one of indifference but of a lack of reliable sources of information.

The potential sources of reliable information are three: university art departments, art associations, and art journals. Considering their academic and financial resources, university art departments are probably best equipped to provide this needed service to artists. The various university art departments should begin to offer courses to fine art students interested in their legal rights. University art departments should also initiate programs in continuing education for those artists who have completed their formal education. This task of presenting the benefits and provisions of statutory copyright to artists out of school should be a joint effort of university art departments, art associations, and art journals. A major reason why more fine artists do not use statutory copyright is that they do not know enough about it. These three sources could greatly reduce the problem of nonuse of statutory copyright by providing fine artists with the information they need.

DO FINE ARTISTS FEEL THAT A COPYRIGHT NOTICE DEFACES A WORK OF ART?

The surveys show that there are additional reasons for fine artists' not using statutory copyright, so that even if every fine artist knew of the procedures and benefits of statutory copyright, many would not use it. The first of these considerations is that the notice requirement might be thought to deface a work of art.

Thomas L. Creel recommends that fine artists place the copyright notice "in the most conspicuous place possible to

give the public adequate notice that a copyright is claimed." [42] The same author goes on to suggest that for paintings and drawings a notation in the lower righthand corner would be proper. A recent law review commentator states that "the only requirement for copyright notice on the face of a work of art in the United States is the symbol © plus the artists initials or mark." [43] This commentator proceeds to recommend this form of notice placement. But it is doubtful that many artists or gallery directors would welcome the frontal notice form.

Daniel-Henry Kahnweiler was Picasso's lifelong dealer and one of the major gallery owners of the century. He opened his first gallery in 1907, and was the first to sell the work of Braque, Derain, Picasso, and Vlaminck. Kahnweiler chronicles his memories of his early years as an art dealer in a published interview [44] with the French journalist Francis Cremieux. The following question and answer reveal a strong feeling about the integrity of the face of the canvas.

Q: You mention Ceret. Wasn't it at Ceret that, in the course of a rather long period of cohabitation, Braque and Picasso painted side by side and decided to stop signing their canvases? What's the truth about this?

A: On this point there is absolute confusion.[45] They never painted side by side, and they never wanted their canvases to be confused; the proof of this is that they are always signed. However, they are signed in back instead of in front, because all the painters with whom I collaborated felt that a signature on the canvas could, in fact, neces-

[42] THE VISUAL ARTIST AND THE LAW, at 9.

[43] Carroll, *supra* note 6, at 149.

[44] D. KAHNWEILER with F. CREMIEUX, MY GALLERIES AND PAINTERS (1971).

[45] L. WERTENBAKER, THE WORLD OF PICASSO, 92–93 (1967) adds to this rumor in the following passage: "By 1911, Picasso and Braque had worked so closely together that their pictures . . . are almost impossible to tell apart . . . the two men also periodically stopped signing their names on the fronts of their canvases during this period, as evidence of their complete and selfless dedication to a common goal."

sarily must, disturb the construction, the architecture of the painting, which they wanted to be so strong and solid that even a signature would disturb it.[46]

This feeling of the inviolability of the front of the canvas is held by many artists and dealers. Several of the artists interviewed stated that they signed their paintings only on the back of the canvas. Among those artists who feel that a signature "disturbs the statement" there is little hope that such artists would place the symbol © on the face of a work. Many artists however, do sign their paintings on the face of the work. This group of fine artists would seem to be more receptive to the suggestion that they integrate the symbol © with their signature.

Nonetheless 25.2 percent (52) of the fine artists surveyed felt that a copyright notice defaces a work of art. This question produced a very high rate of no response (20.9 percent or 43), so that only a slight majority (53.9 percent or 111) of the fine artists felt that a copyright notice did not deface a work of art. The art gallery directors' response to a similar question[47] produced quite different results: 57.5 percent (26) of the gallery directors, more than twice the percentage of the artists, felt that a copyright notice did deface a work of art. Table 6 breaks down the artists' answers to the defacement question by categories.

Except for the sculptors, 55.6 percent of whom thought a copyright notice would deface their work, the breakdown of the data shows a fairly consistent 20 to 30 percent span of responses supporting the defacement hypothesis. These artists' reasons for not using a copyright notice include that "the implication is commercial; fine art is one of a kind," that it "seems to have an awfully commercial slick connotation,"

[46] KAHNWEILER, *supra* note 44, at 45–46.

[47] "Do you personally feel that a copyright notice defaces a work of art?" was question 15 in the Art Gallery Director Survey.

Table 6. Responses to Defacement Question by Categories

	Thinks Notice Defaces Work		
	Yes	*No*	*No Response*
Sample as a whole (206)	25.2% (52)	53.9% (111)	20.9% (43)
Holders of BFA Degrees (60)	25.0% (15)	61.7% (37)	13.3% (8)
Holders of MFA Degrees (46)	23.9% (11)	50.0% (23)	26.1% (12)
More than 10 one-person shows	26.8% (11)	58.5% (24)	14.6% (6)
More than 50 juried exhibits	23.1% (9)	61.5% (24)	15.4% (6)
Sculptors (9)	55.6% (5)	44.4% (4)	—
Craftsmen (24)	20.8% (5)	45.8% (11)	33.3% (8)
Painters, Printers, Photographers and Drawers (173)	24.3% (42)	55.5% (96)	20.2% (35)
Teachers of College Age Students (72)	30.6% (22)	52.8% (38)	16.7% (12)
Paintings more than $500 (30)	23.3% (7)	56.7% (17)	20.0% (6)
Members of National Art Organizations (47)	21.3% (10)	63.9% (30)	14.9% (7)

that "it's somewhat pretentious," and that "people tend to think the work is a print or something commercial." [48] Art gallery directors also refer to the "commercial implication of copyright" and that "the © symbol would debase an excellent artist." [49]

Without solicitation, dozens of the artists and art gallery directors surveyed offered one obvious solution to the defacement problem: put the notice on the back. If this were to be done, would it constitute sufficient notice? [50] The Copyright Act [51] deals with the matter of notice in sections 10, 19, and 20. Section 10 provides that a "notice shall be affixed." Section 19 prescribes that the general form of notice "shall consist either of the word 'Copyright,' the abbreviation 'Copr.,' or the symbol © accompanied by the name of the copyright proprietor." In the case of a work of art section 19 authorizes a short form notice consisting of the symbol "©, accompanied by the initials, monogram, mark, or sym-

[48] Derived from comments to question 11 of the Artist Survey.

[49] Derived from comments to question 12 of the Gallery Directors' Survey.

[50] A general discussion of the sufficiency of notice can be found in M. NIMMER, NIMMER ON COPYRIGHT § 8 7.7 (1976).

[51] 17 U.S.C. §§ 1 *et seq.*

bol of the copyright proprietor: Provided, that on some accessible portion of such copies or of the margin, back, permanent base, or pedestal, or of the substance on which such copies shall be mounted, his name shall appear." Section 20 prescribes the particular placement requirements for notice in the case of books, periodicals, and musical compositions. Section 20 sets up no particular requirements for the placement of notice in the case of works of art.

It can be argued that for works of art section 19 prescribes the form of notice and section 10 prescribes the placement of notice, that is to say that proper notice could be the symbol © and the artist's name "affixed" on the back of the work of art. A contrary argument can be made to the effect that in order to read vitality into the section 19 authorization of short form notice, the statute should be construed as requiring some form of notice on the face of a work of art.

This very question of what constitutes proper notice in the case of a work of art was the subject of *Coventry Ware, Inc. v. Reliance Picture Frame Co.*[52] The case was one of an admitted copyist of the plaintiff's three-dimensional wall plaques. The defendant copyist attacked the sufficiency of the plaintiff's copyright notice, the defendant's position being that the notice of copyright must appear on the front of a work of art and that a notice appearing on the back was insufficient. A federal district court accepted this argument and granted a summary judgment for defendant.[53] Plaintiff appealed and the Second Circuit reversed.[54] Circuit Judge Clark, tracing the legislative history of the Copyright Acts, noted that "§ 20 is the culmination of a long history of increasing liberalization of restrictions on the placement of notice." [55] Clark referred to the harshly restrictive require-

[52] 186 F. Supp. 798 (S.D.N.Y. 1960), *rev'd* 288 F.2d 193 (2d Cir. 1961).
[53] 186 F. Supp. 798 (S.D.N.Y. 1960).
[54] 288 F.2d 193 (2d Cir. 1961).
[55] *Id.* at 194.

ment of the Acts of 1802 [56] and 1831 [57] which prescribed notice to be "on the face" of nonbook and nonliterary items. This specific requirement of frontal notice was gradually eroded, and the Act of 1874 [58] has no reference to face or front. The present act [59] as passed retained specific placement requirements only for books or other printed publications, musical compositions, and periodicals. All other items are subject only to the general requirement of section 10, that the notice should be affixed to each copy. Clark concludes his recital of the progression of the copyright notice requirement for works of art by stating that "§ 19 should not be read to impose a restriction on placement, which, had it been intended by Congress, would certainly have been expressly stated." [60]

The reasoning employed in the *Coventry* appeal is supported by a Second Circuit case of the preceding year. In *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*[61] Judge Hand found that a copyright notice in the selvage of printed cloth was sufficient even though the notice was cut off or concealed. Hand put the burden on the defendant infringer who was attacking the sufficiency of the notice "to show that notice could have been embodied in the design without impairing its market value." [62]

Clark's reading of the ambiguity presented by section 19 is supported by other decisions. In *Prestige Floral v. Artificial Flower Co.*[63] a notice on the underside of a leaf was found to be sufficient notice to give copyright protection to a molded polyethelyne flower in the form of a lilac. A notice

[56] 2 Stat. 171 (1802).
[57] 4 Stat. 436, 437 (1831).
[58] 18 Stat. 965, 967 (1874).
[59] 35 Stat. 1075, 1079 (1909).
[60] 288 F.2d 193 at 195.
[61] 274 F.2d 487 (2d Cir. 1960).
[62] 274 F.2d 487 at 490.
[63] 201 F. Supp. 287 (S.D.N.Y. 1962).

of copyright on a simulated antique telephone was found to satisfy the statute although "some scrutiny is required to locate it and it is in small type." [64]

But there is a limit to how inaccessible a proper notice can be. A notice which is permanently covered is inadequate.[65] A notice of copyright on the back of a statue twenty-two feet above the ground which could not be seen by one standing on the ground was also held to be inadequate.[66]

The Compendium of Copyright Office Practices exhibits a similar attempt at drawing the line between adequate and inadequate notice for works of art. The Copyright Office will not accept a concealed notice, the stated example being, "A notice which the Office is told is on the margin or back of a painting but which is concealed under a permanent frame or mat." [67] However, the *Compendium* states that for a work of art "a notice on any accessible portion is acceptable . . . a notice on either the front or the back of the work may be accepted." [68] One final caveat is offered by *Ross Products Inc. v. New York Merchandise Co.*[69] which registered real doubt as to the sufficiency of a notice of copyright on a hanging tag, which could easily be removed.

By bringing together the language of the statute, the cases, and the Copyright Office practices, some general suggestions can be made for the fine artist who wants to retain future rights in a work but who is offended by frontal notice. For oil or acrylic paintings, the placement of the copyright notice on the back of the canvas or board will almost certainly constitute sufficient notice provided that the artist is careful to see that the notice is not permanently covered.

Drawings, photographs, prints, and watercolors present

[64] Ted Arnold Ltd. v. Silvercraft, Inc., 259 F. Supp. 733, 734 (S.D.N.Y. 1966).
[65] White v. Cornell, 353 F. Supp. 1170, 1174 (E.D.N.Y. 1972).
[66] Scherr v. Universal Match Corp., 297 F. Supp. 107. 111 (S.D.N.Y. 1967).
[67] COMPENDIUM, *supra* note 40, part 4.4.2, III a(1).
[68] *Id.*, part 4.3.6, I.
[69] 233 F. Supp. 260, 262 (S.D.N.Y. 1964).

further problems, since the back of these works of art are generally covered in the framing process. Notice on the back of the work would be permanently covered and hence inadequate; notice on the back of the frame could become separated if the work was reframed, and a subsequent purchaser would have no notice of the copyright. A reasonable solution to this quandary would be to use two notices, one permanently affixed to the back of the frame and one on the reverse side of the work. This would give notice to all but a purchaser of a reframed work, who decided to reproduce the work while it was still framed. In the case of sculpture or pottery, a copyright notice on the underside of the work would probably satisfy the statutory requirements, at least for smaller works which could easily be picked up and examined. For large works of sculpture, the artist must make sure that the copyright notice is accessible to the viewer.

But some would dispute the necessity of any notice requirement, arguing that an artist's signature alone ought to be enough to secure continuing rights in a work of art. Such is the law in Canada, where the statutory scheme provides for automatic copyright. It is not necessary for an artist in Canada to take any formal steps to secure future rights in a work; it "is a proprietary right which arises from authorship alone." [70] France has a similar provision in its copyright law, where a copyright in a work of art inheres to the artist "by the mere fact of its creation." [71] But such is not the law in the United States. The traditional U.S. view of the notice requirement is well stated by the following statement of Judge Friendly: "The notice requirement serves an important public purpose; the copyright proprietor is protected so long and only so long as he gives effective warning to trespassers that they are entering on forbidden ground." [72]

[70] H. Fox, The Canadian Law of Copyright and Industrial Design 6 (1967).

[71] *France: Copyright Statute*, Law No. 57-296, art. I.

[72] Friendly in dissent to Peter Pan Fabrics v. Martin Weiner Corp., 274 F.2d 487, 491 (2d Cir. 1960).

The data reveal that many fine artists find the current notice requirements objectionable. The inherent strengths of the notice requirement argue for its retention in some form. On the other hand, fine artists should not have to choose between defacing their works of art or losing copyright protection.[73] The language of the 1971 Copyright Revision Bill seems to offer a reasonable solution to this dilemma. Section 401(c) prescribes that "The notice shall be affixed to the copies in such a manner and location as to give reasonable notice of the claim of copyright."[74] Section 401(c) seems to be a natural extension of the long history of increasing liberalization of restrictions on the placement of copyright notice for works of art.[75] By adopting this "reasonable notice" requirement, Congress would make it easier for many fine artists to avail themselves of the benefits of statutory copyright.

DOES JUDICIAL INTERPRETATION OF THE CONCEPT OF PUBLICATION DENY COPYRIGHT PROTECTION TO FINE ARTISTS?

Fine artists' seeming indifference to statutory copyright may very well stem from the effect of certain formalities of the Copyright Act. As was just discussed, proper notice is necessary in order to bring a work of art within the protections of the statute. A very harsh sanction results from a finding that publication has taken place without notice or with improper notice: the work passes into the public domain. One of the crucial factors in fine art copyright analysis is the timing of publication. For if an artist acts too late in attempting to secure future rights in a work, the result will be

[73] *See* Friendly's dissent to Scherr v. Universal Match Corp., 417 F.2d 497, 502 (2d Cir. 1969).

[74] Senate Bill 644, 92d Cong., 1st Sess. (1971).

[75] Completing the historical progression which Judge Clark traced in Coventry Ware, Inc. v. Reliance Picture Frame Co., 288 F.2d 193 (2d Cir. 1961).

a total loss of his common law copyright and an inability to obtain a statutory copyright.

A great deal has been written about what constitutes publication for a copyrightable work. One of the most useful dissertations on the subject is by Judge Jerome Frank in *American Visuals Corp. v. Holland.*[76] Frank begins with the statement that "the word publication does not have the same legal meaning in all contexts," [77] contrasting publication in copyright, torts, and privacy. He draws a distinction between the publication necessary to divest an author of his common law copyright and the publication necessary to invest the author with statutory copyright protection. Frank concludes that a publication must be "quite large" in order for an author to lose his common law copyright, yet a publication can be "quite narow" and still bring an author within the copyright statute.

It is important to determine under what conditions a fine artist will lose common law copyright. At the outset it is necessary to draw a distinction between a loss of common law copyright by abandonment or dedication to the public and a loss of common law copyright by expressed or implied transfer to the purchaser of the work. Dedication to the public means that no one is able to obtain a statutory copyright in the work, while transfer of the common law copyright allows the transferee to secure a statutory copyright. The subject of loss of common law copyright by dedication to the public, i.e., general or divestitive publication, will be first discussed.

The two points most relied on in determining whether a work of art has been divestitively published are the time of exhibition and the time of sale. Mere exhibition of a work of

[76] 239 F.2d 740 (2d Cir. 1956).
[77] *Id.*, at 743.

art has been found to be a divestitive publication.[78] A more recent analysis of the effect of exhibiting a work of art is provided by Randolph Jonakait in "Do Art Exhibitions Destroy Common Law Copyright in Works of Art?" [79] Jonakait traces the meager and somewhat conflicting precedents and advises fine artists not to show unless there are express restraints against copying at the place of exhibition. What the form of prohibition ought to be, and where the notice must be placed, were unresolved questions.

A 1970 case [80] involving Pablo Picasso's monumental Chicago sculpture provides further insight into what constitutes divestitive publication of a work of art. As part of a campaign to publicize the not-completed sculpture, the Public Building Commission of Chicago held some press showings of the maquette of the sculpture at the Chicago Art Institute. A notice of copyright [81] was in the exhibition room, but it was not affixed to the model. Photographers for several national magazines attended these press showings and photographs of the maquette were published in many of these magazines without any copyright notices. The court held that "the display of the maquette constituted general publication," [82] remarking that there were no restrictions placed on the press photographers and that the notice was improper.

The result in the Picasso case is justifiable on several special grounds. Among these are that Picasso intended to give

[78] Pierce & Bushnell Mfg. Co. v. Werckeister, 72 F.54, 58 (1st Cir. 1896); *see also,* American Tobacco Company v. Werckeister, 207 U.S. 284, where the U.S. Supreme Court found that an exhibition at a gallery that expressly reserved copyright for the artist and enforced a ban on copying was not a general or divestitive publication. 207 U.S. at 299.

[79] 19 ASCAP COPYRIGHT L. SYMPOSIUM 81 (1971).

[80] Letter Edged in Black Press v. Public Building Commission of Chicago, 320 F. Supp. 1303 (N.D. Ill. 1970).

[81] The notice read "The rights of reproduction are the property of the Public Building Commission of Chicago. © 1966 All Rights Reserved." 320 F. Supp. at 1306.

[82] 320 F. Supp. at 1311.

the work to the people of Chicago and that the sculpture was meant to be a public work, like the Statue of Liberty. But the stated reason of the court in deciding that the work passed into the public domain was that it was generally published by exhibition. Thus the court's discussion of notice and the enforcement of notice will have some precedential value.

In light of the Picasso case, artists must make sure that their common law copyright is not lost by exhibition. In order to be sure that common law copyright is not lost, an artist should show work only at galleries that have and enforce restrictions against copying (or taking photographs). In addition a notice of copyright reservation should be included in gallery brochures promoting the artist. This same notice of copyright reservation should be physically present in the exhibition area. To be absolutely sure, an artist might insist that individual notices be attached to each work on exhibit.[83] However, one general notice in the exhibition area would probably be adequate, as long as the place of exhibition enforced the above restrictions.

The point of sale is the other time at which some feel a work of art is divestitively published. Melville Nimmer in his treatise, states that "the unrestricted sale . . . of a work of art . . . results in its publication." [84] Three cases are often cited for this proposition. The first is *Pushman v. New York Graphic Society,* [85] which would serve as direct authority for sales being characterized as divestitive publications were it not for Pushman's appeal. The New York Court of Appeals, in affirming the lower court's dismissal of Pushman's prayer for an injunction, expressly rejected the lower court's language about publication.[86] The Court of Appeals decided the

[83] This suggestion is given with the assumption that the artist has chosen not to place the symbol © on the front of the work.

[84] NIMMER, *supra* note 50, at § 54.

[85] 25 N.Y.S. 2d 32 (Sup. Ct. 1941).

[86] "We are not entering into a separate discussion as to whether by the sale and the public exhibition the artist is to be held to have 'published' the work so that his common law right is lost." 287 N.Y. 302 at 308.

case on the ground that an "unconditional sale carried with it the transfer of the common law copyright and the right to reproduce." [87] This holding proved to be equally troublesome to fine artists, and it will be discussed at a later point. But its significance for the law of publication is that it does not stand for the proposition that a sale is a divestitive publication.

A more recent case cited as holding that a sale is equivalent to a divestive publication is the case of *Grandma Moses Properties, Inc. v. This Week Magazine.* [88] Here the court, in denying the artist's request for a preliminary injunction, states inter alia [89] that "the unrestricted sale of No. 563 (The painting 'Over the River to Grandma's House') carried to its purchaser and his successors . . . the untramelled right to reproduce . . . No. 563." [90] This language seems more analagous to the transfer analysis than to a reading that an unrestricted sale resulted in a dedication of the work to the public. There would have been no need to speak of successors in ownership of the right to reproduce if the work had fallen into the public domain, since all have equal reproduction rights to a work in the public domain.

The third case is *Van Veen v. Franklin Knitting Mills.* [91] In this case the artist Peter Van Veen allowed an art magazine to publish and distribute a reproduction of one of his paintings. Van Veen claimed no statutory copyright in the work at the time it was reproduced. Subsequently Van Veen sold the painting to a third party. Later still, the defendant attempted

[87] *Id.*

[88] 117 F. Supp. 348, 350 (S.D.N.Y. 1953).

[89] The court also quotes the following language from a Second Circuit case involving the sale of copies of a book without notice: "the common law right is lost by the general publication or unrestricted sale of a single copy." Bobbs-Merrill v. Strauss, 147 F. 15, 19 (2d Cir. 1906); 117 F. Supp. at 350. This seems to be a questionable precedent for the proposition that the sale of an original work of art causes its general publication.

[90] 117 F. Supp. 348 at 351.

[91] 145 Misc. 451, 260 N.Y.S. 163 (Sup. Ct. 1932).

to reproduce the reproduction. Van Veen was held to have no common law right to prevent the alleged infringer from making copies of the reproduction. The court in directing a verdict for the defendant placed more emphasis on the fact that the painting had been reproduced in the art magazine than on the fact that there had been a later sale. These three cases suggest that the issue is anything but clear. The precedents are few and ambiguous. It is hoped that a clear judicial statement will be forthcoming on the relationship between an unrestricted sale of a work of art and a divestitive publication.

Ideally, the time for divestive publication ought to be when an artist is most aware of his legal rights in order that the artist might make the decision by his actions instead of by his inaction. The timing of publication should be geared to take account of the intent of the artist. Simply put, did the artist intend to dedicate his work to the public? Absent an express dedication to the public, most artists do not intend for their works to fall into the public domain and should not be deemed to have lost their common law copyright by inaction. This however, is not the general approach of the case law on divestitive publication.[92] The proffered reason for not measuring the subjective intent of the artist when determining whether a divestitive publication has occurred is that once subjective intent is the determinative factor, then fine artists (and other seekers of copyrights) will be able to manipulate their actions so as to perpetuate the statutory monopoly. One solution to this problem is to modify the copyright statute so that an artist can obtain a statutory copyright for his life plus a set number of years.[93]

[92] Nimmer states that looking to the artists' intent "is clearly contrary to the prevailing rule which holds that the forfeiture resulting from publication occurs as a matter of law regardless of intent"; NIMMER *supra* note 50 at § 58.3.

[93] The current term is for 28 years with a right to renew the copyright for a second term of 28 years. *See:* 17 U.S.C.A. § 24.

Section 302 (a) of the 1971 Copyright Revision Bill [94] proposes "a term consisting of the life of the author and fifty years after his death." The adoption of this proposed amendment to the Copyright Act would be desirable, since it would make unnecessary most of the tedious line drawing associated with the concept of divestitive publication. If the term of a copyright were set at the life of the artist plus fifty years, there would be no reason for any artist to lose a common law copyright unless the artist chose to do so. An artist might choose to relinquish his common law copyright in a work if he expressly dedicated the work to the public [95] or if he desired a statutory copyright.[96]

A related but different question is whether an unrestricted sale of a work should be characterized as a transfer or assignment of the artist's common law copyright to the purchaser. *Pushman v. New York Graphic Society* [97] held that an "unconditional sale carried with it the transfer of the common law copyright and the right to reproduce." [98] After *Pushman*, the presumption ran against the fine artist, so that unless an artist expressly retained the common law copyright in a work, it was assigned upon sale. A section of the New York General Business Law, enacted in 1966, reversed the presumption. Section 224 of article 12-E provides that:

> Whenever a work of fine art is sold or otherwise transferred by or on behalf of the artist who created it, or his heirs or personal representatives, the right of reproduction thereof is reserved to the grantor until it passes into the public domain by act or operation of law unless such right is sooner expressly transferred by an instrument, note or memorandum in writing signed by the owner of the rights conveyed

[94] 644, 92d Cong., 1st Sess. (1971).

[95] As Picasso did with the Chicago sculpture; *see supra* at 181.

[96] If an artist decides to commercially reproduce an original work of art, he should obtain a statutory copyright for the reproductions.

[97] 287 N.Y. 302 (1942).

[98] *Id.*, at 308.

or his duly authorized agent. Nothing herein contained, however, shall be construed to prohibit the fair use of such work of art.

This law may prove to be quite helpful to fine artists, but its effect depends on the resolution of the previous questions about divestitive publication. If either the time of exhibition or the time of sale is deemed to place a work of fine art in the public domain, section 224 loses its force, since it will have set up a presumption that the artist retains a nonexistent right.

The vitality of the various state court decisions and state legislative pronouncements in this area of common law copyright is put into question by two 1964 U.S. Supreme Court decisions. Federal preemption of the fields of copyright and patent law was the subject of *Sears, Roebuck & Co. v. Stiffel*[99] and *Compco Corp. v. Day-Brite Lighting, Inc.*[100] Justice Black wrote that "because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying."[101] It could be argued on the basis of this language that a state may not dictate the conditions upon which a fine artist loses a common law copyright, since the loss of a common law copyright necessarily precludes the artist from obtaining a federal statutory copyright. The idea of federal supremacy would suggest that we look to the federal courts and statutes for the resolution of these questions.

A more recent U.S. Supreme Court decision, *Goldstein v. California*,[102] retreats somewhat from the rigid federal supremacy analysis of *Sears* and *Compco*. In a decision upholding the constitutionality of California's anti–tape piracy statute, Justice Burger wrote:

[99] 376 U.S. 225 (1964).
[100] 376 U.S. 234 (1964).
[101] 376 U.S. 225 at 232–33 (1964).
[102] 412 U.S. 546 (1973).

The clause of the Constitution granting to Congress the power to issue copyrights does not provide that such power shall vest exclusively in the Federal Government. Nor does the Constitution expressly provide that such power shall not be exercised by the States.[103]

Goldstein seems to open the door for state protection of areas of intellectual property which the Federal Copyright Act does not protect.[104] It could be argued that since the federal law does not adequately protect the work of fine artists, states which have a special interest in protecting and promoting the fine arts can adopt legislation like the New York statute. Whether they be federal or state questions, the questions surrounding the problems of divestitive publication and the transfer of common law copyright need solutions. Those who answer the questions of when divestive publication takes place, and whether a fine artist is presumed to retain a common law copyright in a work of art after its sale, should remember the constitutional mandate to promote the arts.

The uncertainty surrounding the above questions makes it difficult for fine artists to avail themselves of the protections of statutory copyright. In resolving these two questions, the fine arts would be best promoted by the statutory adoption of the following propositions:

1. That two distinct and separable property rights exist in a work of fine art. They are the right to possess the original and the right to reproduce the original.[105]

2. That the term of statutory copyright should be modified along the lines of section 302(a) of the 1971 Copyright Revision Bill, so that the term would be for the artist's life plus a certain number of years.

3. That the concept of divestitive publication should no longer be

[103] *Id.*, at 553.

[104] *See* Kaul, *And Now, State Protection of Intellectual Property*, 60 A.B.A.J. 198 (1974).

[105] Other future rights in a work of art, such as the right to use a work in future exhibitions, might also be included in the right to reproduce the original.

applied to a sale or exhibition of a work of art, absent an expressed dedication [106] of the work to the public.

4. That in order for there to be a transfer of an artist's copyright (common law or statutory), there must be a bargained-for contract evidenced by a writing.[107]

If this sort of legislative suggestion is impracticable, the courts can achieve similar results by a few reinterpretations. Neither an exhibition nor a sale should be construed as a general or divestitive publication; rather, using intent as the test, they should be construed as limited publications. Intent should also serve as the criterion for determining if an artist's common law copyright is transferred to a purchaser of a work. Absent an express provision in the bill of sale, there should be a presumption that the artist intends to retain a common law copyright.

TO WHAT EXTENT IS COLLECTOR AND ART GALLERY DIRECTOR OPINION AN IMPEDIMENT TO FINE ARTISTS' USING STATUTORY COPYRIGHT?

Discussions with art collectors and written comments on the two questionnaires reveal that most art collectors are at least uncertain about the concept of copyright in a work of art, and some collectors are affronted by fine art copyright. A sociological survey [108] suggests that in some of the larger art markets, a few very influential art collectors determine

[106] Pablo Picasso's express desire to give his monumental sculpture to the people of Chicago serves as a good example of an expressed dedication.

[107] In the case of a commissioned work of art, the contract of employment ought to suffice as evidence of a transfer of both property rights in a work of art. This would leave intact a fairly consistent line of precedent holding that the employer is presumed to own a copyright in the case of a commission. See Van Cleef & Arpels, Inc. v. Schaeter, 308 F. Supp. 674 (S.D.N.Y. 1969) for a recent application of this rule.

[108] Levine, *Chicago's Art World: The Influence of Status Interests on Its Social and Distribution Systems*, URBAN LIFE AND CULTURE, October 1972, at 293.

the financial success or failure of a new artist. A management study [109] of a large New York art gallery indicates that the typical art gallery is often only marginally successful financially. These three factors taken together add up to an art market in which the fine artist is left with very little bargaining power with which to assert legal rights.

Many collectors of fine art have an idealized conceptualization of the creative spirit of an artist. To many collectors (as well as some artists) the coexistence of the ideal and real facets of the art world is problematic. Many of today's collectors are likely to think that a fine artist who uses copyright is too business oriented. Much collector hesitancy concerning fine art copyright stems from the problems of frontal notice and defacement, which have been discussed previously [110] from the artists' perspective. Some of the fine artists surveyed also observed that the "public tends to be confused by and put off by notice." [111]

The art gallery directors were much more concerned than the artists about this matter. But then it should be kept in mind that the majority of the art gallery directors (57.7 percent) personally felt that a copyright notice defaced a work of art, while only one-fourth (25.2 percent) of the artists surveyed did. The art gallery directors were asked: "Do you think that a painting by an artist who placed a copyright notice (©) after his or her signature would be more difficult to sell than a painting by an artist who did not use a copyright notice?" [112] Of those responding 55 percent (25 of 45) answered yes. The directors were also asked to elaborate on this answer and some of their comments are enlightening. Many felt that a notice "makes the work of a fine artist look

[109] GOLDSMITH and GOODMAN, A MANAGEMENT STUDY OF AN ART GALLERY, ITS STRUCTURE, SALES AND PERSONNEL (1967).

[110] See text accompanying notes 42–49, *supra*.

[111] Comment to question 11 of the Artist Questionnaire: "If you DO NOT use the copyright notice on your works of art, is it due to any particular reason?"

[112] Question 16 of the Art Gallery Directors' Questionnaire.

like it was made purely for commercial reasons," that it "creates a commercial feeling." Several thought it would be an especially bad practice for beginners, that "young artists would find it impossible to get galleries to show their work or collectors to purchase it." Some felt that "buyers might think it was less theirs," that "it's like putting a restriction on the purchaser." The stronger comments against notice varied from "we don't go out of our way to make sales more difficult" to "I would not sell a painting when an artist reserves copyright." The strongest statement in favor of copyright notice was that a notice "would be better, not worse, for it authenticates original work." [113]

If the results of this survey are a fair indication of gallery directors' opinions concerning copyright, then modifications of the notice requirement and of the concept of publication will not be sufficient to encourage fine artists to use statutory copyright. Any sort of copyright education program must include art gallery directors as well as artists. These education programs should not deal only with the procedures and benefits to the fine artist of statutory copyright, but should also examine the statutory implementation of the constitutional mandate to promote the arts. If the statutory grant of copyright is viewed as a method of promoting the economic security of fine artists, then a strong case can be made for the desirability of such statutory protections. The limited protection of the Copyright Act is meant to serve as a stimulus for artists, and hence both gallery directors and fine artists emerge as beneficiaries of the copyright protections.

The importance and effect of collectors' opinion cannot be ignored. While there is virtually no empirical data concerning collectors' opinions about copyright, there is a recent study [114] which discusses the great degree of influence that

[113] Selected comments to Questions 12 and 16 of the Art Gallery Directors' Survey. See appendix B for the complete questions.

[114] Levine *supra*, note 108.

certain collectors have on the art world in general. One artist questioned by Levine remarked that,

> it's a mark of prestige if you have a painting in famous Chicago collectors' collections. This really carries weight. If one of them buys a painting—he knows, he has a good taste. It's like a lot of other things, like fashions—people don't trust themselves, but they do trust an expert. So they're impressed if he purchased something of an artist's.[115]

If some of these leading collectors are uncertain about or affronted by an artist who attempts to retain future rights, then it is possible that an artist on the rise has more to lose than to gain by using a copyright notice.

The well-respected collectors assert their art world influence in more ways than just purchasing art works. They serve as jurors for prestigious exhibitions and sit on the acquisition committees of major museums. If such a prominent collector denigrated an artist for employing a © symbol with his signature, there would be several forums for the collector's negative opinions about the artist. It may seem facile to suggest that, here too, the remedy is education. If one believes that it is desirable for artists to retain some future control in their works, it is not enough to convince only artists and dealers. Collectors must also be persuaded that the authors of the Constitution and the Copyright Act shared the collector's goal of promoting the fine arts.

An art gallery's ability to assert fine artists' legal rights in the face of negative collector opinion is dependent on the gallery's financial stability. If retaining reproduction rights in works makes them less easy to sell, art gallery directors will be quick to question the worth of copyright protection. A gallery might be willing to lose some sales as a cost of retaining copyright, but how many sales can a gallery lose and still stay in business?

In 1966 the Tamarind Institute, a nonprofit organization

[115] *Id.*

devoted to the stimulation and preservation of the art of the lithograph, commissioned a management study of a large New York art gallery. The purpose of the study was to gain insights into the financial and structural interworkings of a gallery in order to better assess the possible market for original prints. The resulting 110-page report [116] delves into many areas; for our purposes the analysis of the marketing function of the gallery is instructive.

The Blue Gallery [117] is presented as "prototypical." At the time of the study it had 11 full-time employees and 4 part-time employees. Blue annually placed approximately 10 artists under exclusive contract. In 1966 the gallery's total sales volume was more than $400,000, and sales for 1967 were expected to exceed $450,000. Blue was said to "rank among New York's ten leading galleries." And yet the net profit was 0.2 percent or approximately $800.[118] The management study concludes that the profit is "too small to warrant the cost and risk of capital." [119]

On a day-to-day basis, the Blue Gallery could not afford to lose sales. The gallery's breakeven point was such that if it had sold one less major work in the year studied, it would have shown a loss. This is probably not typical of all galleries, but it does point out the precariousness of the retail art market.

The demand for original art is somewhat elastic, and several factors influence the success of a gallery. The price of works vis-à-vis the state of the economy is one. Another factor is best described as image building. The Blue Gallery in 1966 expended more than $30,000 on advertising, public relations, and brochure printing. Galleries attempt to create an aesthetic mystique about their business, and to many gallery

[116] GOLDSMITH AND GOODMAN, *supra* note 109.
[117] A pseudonym used to protect the identity of the gallery.
[118] GOLDSMITH and GOODMAN, *supra* note 109, at 40.
[119] *Id.*, at 48.

directors the concept of copyright seems inappropriate to their image. Many gallery directors might consider the retention of copyright in works they sell to be counterproductive.

Thus the fine artist might be left with a bundle of rights that cannot be asserted. A massive education program is called for to remedy this problem. Fine artists probably would retain future rights in their works if collectors and dealers were convinced that the use of copyright would make for a stronger art market. Whether the immediate effect of more fine artists' asserting their legal rights would be to bolster or depress the art market is speculation. I am convinced that in the long run, the retention of future rights by fine artists in their works will bring about a healthier art market.

CONCLUSION

The purposes of this research project were to test the prevailing hypothesis and to discover some additional hypotheses to answer the question of why fine artists don't use statutory copyright. While I do not purport to have discovered any easy solutions, I hope that readers of this article will gain a wider perspective of the issues surrounding fine art copyright. Even though these empirical studies establish that many fine artists lack sufficient knowledge of statutory copyright, it is not enough to conclude that the only remedy called for is education.

Even the most effective education program will probably not convince fine artists who believe that a visible notice defaces a work of art that they should use statutory copyright. This paper posits that the present state of the law would allow an accessible but normally hidden notice of copyright to satisfy the statutory requirements. This position should be clarified by a statutory enactment.

The rigidity of the concept of divestitive publication causes

many fine artists to lose statutory copyright. The concept of limited publication should be expanded so as to include exhibitions and sales of art works. Divestitive publication should only be found when a fine artist intends to part with common law copyright. In order not to provide any incentive to the fine artist to put off obtaining a statutory copyright, the Congress should redefine the term of copyright protection to be the life of the creator plus a fixed number of years. Section 302(a) of the 1971 Copyright Revision Bill should serve as a good model. The defacement problem and the divestitive publication problem are interrelated, so that the adoption of section 302(a) would probably solve both these problems.

Ultimately, the remedy must be education, but this should include the education of art gallery directors and collectors in addition to the education of fine artists. Those who sell and those who buy the works of fine artists must be convinced that statutory copyright for fine art benefits all parties concerned. For fine artists, copyright means a measure of economic security and an impetus to create. For dealers and collectors, copyright means a healthier and more productive art world. More will be known about copyright when university art departments inform fine art students, when national artists' organizations and art journals inform practicing fine artists, when dealer groups inform art gallery directors, and when art museums and collectors groups inform collectors.

It is hoped that the various suggested remedies will have a synergistic effect in solving the problem. That is, collectors might more readily accept fine art copyright if the notice was not on the face of the work. And art gallery directors might be more inclined to handle an artist who used copyright if nearly all fine artists did. Laws need to be passed and classes need to be taught. The time has come to act so that more fine artists will be able to preserve their legal rights.

APPENDIX A
ARTIST OPINION SURVEY
UNIVERSITY OF MICHIGAN LAW SCHOOL

1. Do you think that visual artists need copyright protection?———
   If so for
   (check one or both)
   ———protection from plagiarizers.
   ———retention of reproduction rights (posters, calendars, prints, etc.).
2. Do you personally place a copyright notice on any of the work you produce?
   (check only one)
   ———never.
   ———very infrequently.
   ———only on major works.
   ———only on commissioned works when the client requests it.
   ———usually.
   ———always.
3. Of the following artistic media, please indicate those that you use in the order of frequency that you use them.
   (use the numeral 1 for the most frequently used medium, then 2, 3. . . , but do not enter a number next to a medium not used)
   ———painting.
   ———printmaking.
   ———sculpture.
   ———jewelry.
   ———pottery.
   ———(others)———————————————
4. What is your educational background?
   (check as many as apply)
   ———college degree from 4 year college or university.
   ———Bachelor of Fine Arts.
   ———Master of Fine Arts.
   ———other formal instruction in art. If so for how many years?
   _____

5. Do you teach art classes?———if you do, what ages are your students?
   (enter a percentage next to each group; should add to 100%)
   ———12 years old or younger.
   ———13 to 17.
   ———18 to 25.
   ———26 years old or older.
6. Please list any local, regional, or national artists' associations that you belong to.———
   ———
7. How many one person shows have you had?———
8. In how many juried exhibitions (including juried art fairs) has your work been included?———
9. Do you sell most (dollar value) of your work:
   (check only one)
   ———directly to the public (including art fairs).
   ———through a gallery.
   ———in your own gallery.
   ———by commission.
   ———(other)———
10. Is your main source of income derived from the sale of the art you produce?———If so, for how many years have you relied on the sale of your art as your main source of income?———
    Present age?———
11. If you DO NOT use the copyright notice on your works of art, is it due to any particular reason? (be as specific as you can)
    ———
    ———
12. Do you feel that a copyright notice defaces a work of art?———
13. Do you feel that you have enough information concerning copyright protection to make an informed judgement as to its use?
    ———
14. If you DO NOT use the copyright notice, do you reserve any future rights in the art you produce when you sell the work?
    ———If so, please indicate the method by which you reserve future rights.———
    ———
15. If you DO use the copyright notice, do you in addition register

any works with the Register of Copyrights in Washington, D.C.?
(check only one)
———never.
———only upon sale.
———only upon request of the client in the case of a commission sale.
———usually.
———always.

16. In the artistic medium you use most frequently, please indicate by percentages which of the following ranges of prices your work is priced.
(should add to 100%)
———less than $50.
———$50 to $100.
———$100 to $500.
———$500 to $2000.
———more than $2000.
17. Has any of your art work been reproduced?———If so, how many different works have been reproduced?———
18. If you have had some of your work reproduced, was it ever done without your consent?———If so how many times?———
19. If you have had some of your work reproduced, were you paid each time a work was reproduced?———If you have ever been paid when one of your works was reproduced, was it (check one or both)———a lump sum payment, or———a royalty arrangement, whereby you were paid on the basis of the number of reproductions sold.
20. How much of your last year's income (1972) do you attribute to the sale of your art?
(check only one)
———less than $2000.
———$2000 to $4000.
———$4000 to $10,000.
———$10,000 to $25,000.
———$25,000 to $50,000.
———more than $50,000.
21. Have you ever personally felt the need for copyright protection with reference to one of your works?———If so, please explain.
_____
_____

APPENDIX B
ART GALLERY DIRECTOR OPINION SURVEY

1. Do you think that visual artists need copyright protection?———
   If so for:
   (check one or both)
   ———protection from plagiarizers.
   ———retention of reproduction rights (posters, calendars, "prints," etc.).
2. In 1972, for how many living artists did your gallery attempt to sell works?———
3. Of this number, how many did you represent exclusively?———
4. What sort of agreement (concerning commissions, exclusivity, etc.) does your gallery enter into with a living artist for whom you sell works?
   (check the category which describes your normal course of dealing with artists; check only one)
   ———oral agreement.
   ———written contract. (If you normally use a written contract, I would appreciate a copy of a sample contract.)
5. Does your gallery advise the artists you represent concerning business and legal matters?
   (check only one)
   ———frequently.
   ———seldom.
   ———never.
6. Of the artistic media (excluding reproductions) by living artists that your gallery sells, please indicate what percentage of total items sold each of the following represents:
   (should add to 100%).
   ———paintings.
   ———original prints.
   ———sculpture.
   ———jewelry.
   ———pottery.
   ———(others)———————————————
7. Does your gallery sell reproductions of original art works?———

If so, what percentage of total dollar volume sales does the sale of these reproductions represent to your gallery?———

8. What percentage of your total dollar volume sales is the sale of art by living artists?———
9. Of paintings by living artists that you sell, please indicate what percentage of total paintings sold are in the following ranges of prices:

(should add to 100%)

———less than $50.
———$50 to $100.
———$100 to $500.
———$500 to $2000.
———more than $2000.

10. When you sell a work of art for a living artist, do you reserve for the artist any future rights in the work of art?

(check only one)

———always.
———usually.
———very infrequently.
———never.

11. If you always or usually reserve future rights for a living artist, please describe the nature of the right and the manner in which you reserve such rights. ———

12. If you very infrequently or never reserve future rights for a living artist, please explain why not (as specifically as you can).———

13. Do you feel that the artists you represent have enough information concerning copyright protection to make an informed judgement as to its use?———
14. Do you feel that you have enough information concerning copyright to make an informed judgement as to its use?———If you feel that you do have enough information concerning copyright, where did you learn about copyright?

(check as many as apply)

———in college.
———by reading a book on the subject.
———from a trade association (like the Art Dealers Association).
———other (please list).———

15. Do you personally feel that a copyright notice defaces a work of art?———

16. Do you think that a painting by an artist who placed a copyright notice (©) after his or her signature would be more difficult to sell than a painting by an artist who did not use a copyright notice?———Please elaborate———————————————

_____

_____

Appendixes

Panels of Judges

SYMPOSIUM NUMBER ONE (1939)

Edward A. Sargoy, Stephen P. Ladas, Edward S. Rogers, Dr. Louis Charles Smith, John H. Wigmore, members of a Committee of the American Bar Association appointed by Thomas E. Robertson, Chairman of the Section of Patent, Trade-Mark and Copyright Law.

SYMPOSIUM NUMBER TWO (1940)

Herman Finkelstein, General Counsel, American Society of Composers, Authors and Publishers

SYMPOSIUM NUMBER THREE (1940)

John H. Wigmore, Dean of Northwestern University School of Law

SYMPOSIUM NUMBER FOUR (1952)

Judge Herbert F. Goodrich, United States Court of Appeals for the Third Circuit

Justice Roger J. Traynor, Supreme Court of the State of California

Judge George T. Washington, Court of Appeals for the District of Columbia Circuit

SYMPOSIUM NUMBER FIVE (1954)

Judge Stanley H. Fuld, Court of Appeals of the State of New York

Chief Judge Leon R. Yankwich, United States District Court for the Southern District of California

SYMPOSIUM NUMBER SIX (1955)

Chief Judge Sam Driver, United States District Court for the Eastern District of Washington

Dean Wesley A. Sturges, President of the American Association of Law Schools

SYMPOSIUM NUMBER SEVEN (1956)

Justice George Rossman, of the Supreme Court of Oregon

Lloyd Wright, President of the American Bar Association

Edward A. Sargoy, Louis E. Swarts, former Chairmen of the Copyright Subsection of the Patent, Trade-Mark and Copyright Section of the American Bar Association

SYMPOSIUM NUMBER EIGHT (1957)

Chief Judge Charles E. Clark, United States Court of Appeals for the Second Circuit

Chief Justice A. Cecil Snyder, Supreme Court of Puerto Rico

SYMPOSIUM NUMBER NINE (1958)

Chief Judge John Biggs, Jr., United States Court of Appeals for the Third Circuit

Chief Judge Simon E. Sobeloff, United States Court of Appeals for the Fourth Circuit

Judge William H. Hastie, United States Court of Appeals for the Third Circuit

SYMPOSIUM NUMBER TEN (1959)

Chief Justice Frank R. Kenison, Supreme Court of New Hampshire

Chief Judge Alfred P. Murrah, United States Court of Appeals for the Tenth Circuit

SYMPOSIUM NUMBER ELEVEN (1962)

Panel for 1959 National Competition

Chief Judge Charles S. Desmond, New York Court of Appeals

Judge David T. Lewis, United States Court of Appeals for the Tenth Circuit

Panel for 1960 National Competition

Justice Tom C. Clark, United States Supreme Court

Chief Justice Paul Reardon, Superior Court of Massachusetts

Judge Elbert P. Tuttle, United States Court of Appeals for the Fifth Circuit

SYMPOSIUM NUMBER TWELVE (1963)

Panel for 1961 National Competition

Justice Walter V. Schaefer, Illinois Supreme Court

Judge Sterry R. Waterman, United States Court of Appeals for the Second Circuit

Panel for 1962 National Competition

Judge Frederick G. Hamley, United States Court of Appeals for the Ninth Circuit

Judge John Minor Wisdom, United States Court of Appeals for the Fifth Circuit

SYMPOSIUM NUMBER THIRTEEN (1964)

Justice Leonard v. B. Sutton, Supreme Court of Colorado

Justice Samuel Freedman, Court of Appeal of Manitoba

Justice James L. McLennan, Supreme Court of Ontario

SYMPOSIUM NUMBER FOURTEEN (1966)

Judge Carl McGowan, Court of Appeals for the District of Columbia Circuit

Judge Charles M. Merrill, United States Court of Appeals for the Ninth Circuit
Justice Haydn Proctor, Supreme Court of New Jersey

SYMPOSIUM NUMBER FIFTEEN (1967)
Judge Roger J. Kiley, United States Court of Appeals for the Seventh Circuit
Judge Francis Bergan, New York Court of Appeals

SYMPOSIUM NUMBER SIXTEEN (1968)
Justice Byron R. White, United States Supreme Court
Congressman Theodore R. Kupferman, of New York
Congressman Robert G. Stephens, of Georgia
Congressman Wendell Wyatt, of Oregon

SYMPOSIUM NUMBER SEVENTEEN (1969)
Chief Judge Stanley H. Fuld, Court of Appeals of the State of New York

SYMPOSIUM NUMBER EIGHTEEN (1970)
Judge Shirley M. Hufstedler, United States Court of Appeals for the Ninth Circuit
Judge Luther M. Swygert, United States Court of Appeals for the Seventh Circuit
Justice Samuel J. Roberts, Supreme Court of Pennsylvania

SYMPOSIUM NUMBER NINETEEN (1971)
Chief Judge Alfred P. Murrah, United States Court of Appeals for the Tenth Circuit and Director, Federal Judicial Center
Chief Justice Robert B. Williamson, Supreme Judicial Court of Maine
Justice Harry A. Spencer, Supreme Court of Nebraska

SYMPOSIUM NUMBER TWENTY (1972)
Lord Richard Wilberforce, Lord of Appeal in Ordinary of England
Justice Paul C. Reardon, Massachusetts Supreme Judicial Court

SYMPOSIUM NUMBER TWENTY-ONE (1973)
Chief Justice Samuel Freedman, Court of Appeal of Manitoba
Justice George Rose Smith, Supreme Court of Arkansas
Justice William M. McAllister, Supreme Court of Oregon

SYMPOSIUM NUMBER TWENTY-TWO (1977)
Walter Derenberg, Professor of Law, New York University School of Law.
Edward A. Sargoy, Former Chairman of the Copyright Subsection of the Patent, Trade-Mark and Copyright Section of the American Bar Association

SYMPOSIUM NUMBER TWENTY-THREE (1977)

Chief Judge Stanley H. Fuld, Court of Appeals of the State of New York and Chairman, National Commission on New Technological Uses of Copyrighted Works

Chief Justice Robert B. Williamson, Supreme Judicial Court of the State of Maine

SYMPOSIUM NUMBER TWENTY-FOUR (1980)

Jefferson B. Fordham, Dean Emeritus, University of Pennsylvania Law School

Page Keeton, Dean Emeritus, University of Texas School of Law

Robert B. McKay, former Dean of the New York University School of Law and Director, Program on Justice, Society, and the Individual, Aspen Institute for Humanistic Studies

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George W. Botsford, UNIVERSITY OF ARIZONA COLLEGE OF LAW
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NATHAN BURKAN
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Preface

PUBLICATION of this, the thirteenth volume in the ASCAP Copyright Law Symposium Series, marks several important milestones in the growing history of the Nathan Burkan Memorial Competition.

For the past twenty-five years this Competition has served as a living tribute to the memory of the first General Counsel of the Society, a leading figure in the law of intellectual property. Every year since 1939 the Society has been awarding local prizes to students who submit the best essays on copyright law in each participating law school. In addition, substantial National Awards have been provided and opportunity afforded for publication in a symposium.

During the past quarter century, winners of the Competition have taken their places as leading citizens in the community, distinguishing themselves in all phases of the law—in government and politics, in legal education, at the bar, and on the bench. It is gratifying to know that these people have taken with them an understanding and appreciation of the copyright laws and their role in encouraging and rewarding the creations of musical, literary, and artistic works which reflect the cultural life of our nation.

It was thought fitting to mark the twenty-fifth anniversary by having a former winner of the Competition serve on the Panel of Judges for the National Competition. Mr. Justice Leonard von Bibra Sutton, a winner of the 1941 Nathan Burkan Memorial Competition at the University of Denver School of Law and now a Justice of the Supreme Court of Colorado, was chosen to head the Panel. It was also deemed appropriate, in view of the universal appeal of literary and musical works,

to supply an international flavor to the Competition, in the person of two distinguished Canadian judges, Mr. Justice Samuel Freedman of the Manitoba Court of Appeal and Mr. Justice James L. McLennan of the Supreme Court of Ontario.

Before assuming his present position in 1960, Mr. Justice Freedman was a Justice of the Court of Queen's Bench in Manitoba. His interests extend beyond the law, especially in the field of education. In addition to being Chancellor of the University of Manitoba since 1959, he is a member of the Board of Governors of the Hebrew University in Jerusalem and has held many offcial positions in the Canadian and Manitoba Bar Associations, having served as President of the latter association before his elevation to the Court of Queens Bench. He has been a leader in community projects such as the League of Nations Society of Winnipeg, the Civil Liberties Association of Manitoba, the Family Bureau, and the Community Chest, and received the Human Relations Award from the Canadian Council of Christians and Jews in 1956. Mr. Justice Freedman holds honorary degrees from the University of Windsor, Ontario, and the Hebrew University of Jerusalem.

Mr. Justice McLennan received the degree of Master of Arts in Economics and History from Queens University in 1929, and his law degree in 1932, after three years of study at Osgoode Hall. He was called to the bar in 1932, and was appointed King's Counsel in 1944. After serving as a Judge of the Trial Division of the Supreme Court of Ontario from 1951 to 1961, Mr. Justice McLennan assumed the Justiceship of the Appellate Division of the Supreme Court of Ontario in 1961. An ardent worker in bar and civic activities throughout his career, and dedicated to the true administration of justice on all levels, Justice McLennan has been director of the John Howard Society, for the rehabilitation of prisoners and prison reform, since 1936.

Interrupted only by a four-year tour of active duty with the

U.S. Army during World War II, Justice Sutton had been engaged in the active practice of law before becoming an Associate Justice of the Supreme Court of Colorado in 1956. He served as Chief Justice in 1960 and made a nationally recognized record in reorganizing his court's administrative procedures so that it substantially increased its productivity to become one of the top courts of the nation. He is presently a member of the Institute of Judicial Administration at New York University, the American Judicature Society, and the American Society of International Law, as well as local, national, and international bar associations. Justice Sutton has been the Chairman of the State Committee on the Uniform Commercial Code and until recently served as Chairman of the Colorado Bar Committee on World Peace through Law. He is a member of the National Committee for Effective Use of The World Court and is Chairman of the American Bar Association Committee on Effective Use of The International Court of Justice. Like Justices Freedman and McLennan, he has many published articles to his credit and has been a frequent guest lecturer at law schools, bar associations and judicial conferences.

This distinguished Panel selected the six papers which appear here from among forty-seven papers submitted at thirty-five law schools throughout the nation. It is a great source of pride to the Society and a great tribute to these eminent Judges that they undertook the task of selection with the same consciousness of duty with which they necessarily must approach their judicial obligations.

On behalf of the more than nine thousand members of the American Society of Composers, Authors, and Publishers, we wish to express sincere gratitude to the Panel for having taken time from busy schedules to read and evaluate the essays. To the deans and faculty members of the participating law schools we likewise extend our appreciation, for their many kind words of praise and encouragement and for supervising the

Competition on the local level. We take pride in the role this Competition has had in exposing future lawyers to a branch of law which they might otherwise have missed, in kindling the spirit of original research and in encouraging an interest in legal writing.

STANLEY ADAMS,
PRESIDENT

HERMAN FINKELSTEIN,
GENERAL COUNSEL

AMERICAN SOCIETY OF COMPOSERS,
AUTHORS AND PUBLISHERS

Foreword

IT WAS SAID of a certain judge that "he was often in error but never in doubt." The judges of the 1963 Nathan Burkan Memorial Competition should perhaps acknowledge that, as they trod the path to their objective, doubt was their frequent companion. In the same mad moment of humility they might just as well acknowledge the possibility of error on their part too; although their unanimity upon the final result renders this somewhat less likely—at least so they hope.

Perhaps it would be well to indicate the standards which the judges employed in the discharge of their task. An essay on a legal subject, particularly on one that is off the beaten path (as, to most of us, copyright law assuredly is) peculiarly challenges one's powers of communication. Hence the judges set a high premium on clarity—in expression, in structure, and in arrangement of ideas. It is good to encounter writing that reveals an appreciation of the integrity of words and of the cadences of English prose. Happily now and then the judges of this competition had this very experience; when it occurred it lifted their task from the level of routine to one of high enjoyment and inspiration.

But every good essay must have something worth saying. So the judges necessarily had regard to the subject matter of what was displayed before them—its accuracy, the research that it revealed, and the originality of thinking that it reflected. Sometimes a candidate ranked high on subject matter, only to fall down on form. Sometimes, on the other hand, an essay exhibited a grace of style, but had relatively little to say. The combination of excellence in both form and substance was the elusive quality sought by the judges. They hope that in a sub-

stantial measure the winning entries succeeded in capturing this quality.

A word about the winners. The essay of Elizabeth Heazlett Kury of the University of Pittsburgh School of Law on "Protection for Creators in the United States and Abroad" was clearly the product of arduous labor intelligently applied. The mark of research and a mind cultivated by the humanities were apparent upon its every page. It is a meritorious contribution to the study of comparative law in the copyright field.

Charles S. McGuire of Suffolk University Law School submitted a very useful paper on "Common-Law Overtones of Statutory Copyright: An Inquiry into the Status of a Federal Common Law of Unfair Competition." An indication of the esteem in which Mr. McGuire's contribution was held by the judges may be gathered from the fact that they adjourned their deliberations over night for the sole purpose of determining whether Mrs. Kury or Mr. McGuire should receive the first prize.

Joseph G. Cook of the University of Alabama School of Law dealt with "The Fine Arts: What Constitutes Infringement." Although it is not an essay designed particularly for the specialist in the copyright field, its message was so luminously presented and the fundamentals of the subject so well stated that in the view of the judges it merited the third prize.

Noteworthy contributions were made by Bruce E. Fritch of Yale University Law School, writing on "Some Copyright Implications of Videotapes (Suggesting The Need for Statutory Revision)"; Robert Stephen Savelson of Columbia University School of Law, whose topic was "Electronic Music and The Copyright Law"; and John M. Moellenberg of St. Louis University School of Law, on the theme "The Question of Choice Between Copyrighting or Patenting a Design."

The judges would like to record their deep sense of privilege in having been selected for the panel for the Twenty-

Fifth Annual Nathan Burkan Memorial Competition. This was the first time that Canadian judges have been invited to participate as judges of the essays submitted in the competition, and the Canadian members feel particularly proud and gratified in being asked to serve.

MR. JUSTICE LEONARD V. B. SUTTON,
SUPREME COURT OF COLORADO

MR. JUSTICE JAMES L. MCLENNAN,
SUPREME COURT OF ONTARIO

MR. JUSTICE SAMUEL FREEDMAN,
MANITOBA COURT OF APPEAL

Report of Panel of Judges on National 1963 Nathan Burkan Memorial Competition

The following results are respectfully submitted:

Winners

FIRST PRIZE: Elizabeth Heazlett Kury, 124 Market Street, Sunbury, Pa. University of Pittsburgh
Protection for Creators in the United States and Abroad

SECOND PRIZE: Charles S. McGuire, 7 James Street, Holbrook, Mass. Suffolk University
Common Law Overtones of Statutory Copyright: An Inquiry into the Status of a Federal Common Law of Unfair Competition

THIRD PRIZE: Joseph G. Cook, 415 Second Street, Gulfport, Miss. University of Alabama
The Fine Arts: What Constitutes Infringement

Honorable Mention

Bruce E. Fritch, 16466 Sunset Boulevard, Pacific Palisades, Calif. Yale University
Some Copyright Implications of Videotapes (Suggesting the Need for Statutory Revision)

Robert Stephen Savelson, 2700 Henry Hudson Parkway, New York, N.Y.
Columbia University
Electronic Music and The Copyright Law

John M. Moellenberg, 5045a Oleatha, St. Louis, Mo. St. Louis University
The Question of Choice Between Copyrighting or Patenting a Design

Also considered excellent and close contenders, the following (not necessarily in order of merit):

Edward J. Martin. Albany Law School
Indivisibility of Copyright

John E. Allen. Indiana University
Entertainment Title Duplication Cases: A Process of Evolution

Morton Anekstein. Rutgers University
What is a "Publication of the United States Government"?

Seymour Edward Katz. New York University
The Remedies Available Against the Disklegger

Ineligible for competition (because graduate student) but recommended for special publication elsewhere:

William N. Anastos. Suffolk University
The Problem of Reproduction

Your Committee,

MR. JUSTICE LEONARD V. B. SUTTON,
SUPREME COURT OF COLORADO

MR. JUSTICE JAMES L. MCLENNAN,
SUPREME COURT OF ONTARIO

MR. JUSTICE SAMUEL FREEDMAN,
MANITOBA COURT OF APPEAL

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NATIONAL FIRST PRIZE, 1963

Protection for Creators in the United States and Abroad

By ELIZABETH HEAZLETT KURY

UNIVERSITY OF PITTSBURGH SCHOOL OF LAW

NEARLY EVERY CIVILIZED COUNTRY recognizes rights of creators in their works.[1] However, the scope of protection varies in different countries. Comparative copyright law is today an important area of study. A writing, a musical composition, or a painting or sculpture can be copied anywhere. The technological advances which have given us Telstar present great opportunity for economic exploitation and infringement in foreign countries. Many countries are extremely reluctant to afford any protection to foreign publishers, and under the Universal Copyright Convention (UCC) protection is afforded only on the basis of national copyright law. It is imperative that the nations of the world cooperate in protecting the rights of creators, who cannot prevent the infringement of their works in foreign countries and are at the mercy of foreign laws when seeking reparation.

A comparative study of the rights of creators affords a basis for authors to determine the extent of protection available in other countries. It also provides a yardstick to evaluate the protection given in the United States and in foreign countries which, it is to be hoped, will lead to extended protection through revision of the present federal law and future international agreements.

[1] See generally UNESCO, *Study of Comparative Copyright Law*, 2–3 UNESCO COPYRIGHT BULLETIN 2–148 (1949) [hereinafter cited as UNESCO].

The purpose of this essay is to find an explanation for the great variance in the protection afforded authors and other creators under civil law and common-law doctrines. The writer will attempt to demonstrate that the concept of property in intellectual rights which dominates common-law thinking has had a profound and disappointing influence on the law which fosters creativity and cultural continuity in the United States. The essay will be presented in three parts: first, a comparison of the protection afforded under the civil-law doctrines of *droit moral* and *droit de suite* and the common law; second, a short statement of the extent of protection under the major multilateral treaties; and, third, a discussion of the effect of traditional property concepts on the common law.

COMPARATIVE PROTECTION

DROIT MORAL

The Anglo-American doctrine of "copyright" has no exact counterpart in civil law, which refers only to the "author's right," or *droit d'auteur*.[2] Virtually all countries other than the common-law nations recognize the copyright to be only one of many rights owing to the author. Under Anglo-American doctrine all legally protected rights are squeezed under the label of "copyright" and many rights recognized under the civil law are disregarded because they do not fit easily under "copyright." The Federal Copyright Act [3] is directed at securing economic protection for creators by granting a monopoly on the reproduction of creative works. The interest of the author or artist in the integrity of his work and in preventing uses inconsistent with his standards or reputation are not recognized by the federal statute, which was enacted to imple-

[2] Thus the periodical published in French and English by UNESCO on comparative copyright law has two titles: COPYRIGHT BULLETIN and BULLETIN DU DROIT D'AUTEUR.

[3] 17 U.S.C. §§ 1–216 (1958).

ment the constitutional mandate "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." [4] In the words of Lord Mansfield, once the author sells his copyright:

> He is no more master of the use of his own name. He has no control over the correctness of his own work. He cannot retract errors. He cannot amend, or cancel a faulty edition. Anyone may print, pirate and perpetuate the imperfections, to the disgrace and against the will of the author; may propagate sentiments under his name, which he disapproves, repents and is ashamed of. He can exercise no discretion as to the manner in which, or the persons by whom his work shall be published.[5]

The moral right, or *droit moral*, is a compound of all the personal rights which an author has in his work. While the extent of the moral right varies in different countries, in all countries it envisages the protection of a multitude of diverse rights which have in common the artist's personal, as opposed to his pecuniary, interests.

> The moral right is the right of the author to create or not to create, to present the creation to the public in a form of his choice, or to withhold it, to dispose of this form as he alone desires, and to demand that his personality be respected insofar as it relates to his status as an author.[6]

Implicit in this definition is the right to determine when and how an author's work may be divulged, the right to modify and correct, the right to protest unauthorized modifications by others, the right to protect such unjustified criticism of the work as is injurious to the personality of the author by affecting his honor or reputation, and the rights to assert authorship of a work and not to have the works of others falsely attributed to him. The right remains the author's even after the alienation of the work or the copyright; it attaches to the

[4] U.S. CONST. art. I, § 8.

[5] Millar v. Taylor, 4 Burr. 2303, 2398, 98 Eng. Rep. 201, 252 (K.B. 1709).

[6] Katz, *The Doctrine of Moral Right and American Copyright Law: A Proposal*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER FOUR 79, 102 (1952).

person of the author.[7] In some countries, such as France, it is perpetually protected; [8] in others it is limited, as in Germany, where the property rights and moral right terminate fifty years after the author's death.[9] The positive components of the right —the right to create, to publish, to change, and to withdraw from circulation or destroy—die with the author or artist. However, the right to prevent others from making changes or committing acts detrimental to the author's reputation are considered negative components that require no personal act by the author and may, therefore, be transmitted to the heirs,[10] or enforced by the government or a cultural society.[11] In most countries the moral right is inalienable; [12] in others there is reason to believe that it may be waived or disposed of.[13]

For purposes of this essay the moral right will be considered in its basic groupings of rights: the right of secrecy, the paternity right, the integrity right, and the right of the author against other violations of his personality.

THE RIGHT OF SECRECY

This right contemplates that the author shall have the exclusive right to publish or to withhold his work from publication. Thus, in the famous case of *Eden v. Whistler*,[14] the court refused to order the artist-defendant Whistler to deliver to Lord Eden a portrait of Lady Eden. Whistler, who had been commissioned to do the portrait, had exhibited it at his salon. He became dissatisfied with the price, however, and painted out the head and refused to deliver the picture. In *Rouault v. Vollard Heirs* [15] the French court upheld Rouault's right not

[7] UNESCO 58. [8] *Ibid.*

[9] Strauss, *The Moral Right of the Author*, 4 Am. J. Comp. L. 506 (1955).

[10] *Id.* at 518.

[11] UNESCO 60. Strauss notes that in France in one instance the moral right of the heirs has been recognized after the expiration of the copyright, and the integrity of the work defended against the heirs in another. Strauss, *supra* note 9, at 518.

[12] UNESCO 60. [13] Katz, *supra* note 6, at 127.

[14] Cited in Strauss, *supra* note 9, at 511, n. 25. [15] *Id.* at 512, n. 27.

to publish several paintings which he claimed were unfinished, and which were in the possession of his dealer's heirs.

It is the law of several countries that publication cannot be forced by a levy of execution.[16] In France the same cases are cited in support of both the right to create and the right to publish. Decisions of the German courts on the right to publish are based on contract provisions of the civil code and the law governing publishing contracts.[17] However, the German draft copyright law considers the right to publish one of the most important aspects of the moral right.[18]

Incidental to the author's right to refuse to publish is the right to rescind a contract of publication for such personal reasons as a change of conviction at any time before actual publication has taken place. This right has been recognized by statute in Germany and Czechoslovakia.[19] Another aspect of this right is illustrated by the French case of *Anatole France v. Lemerre.*[20] The celebrated author sought the return of a manuscript of a history of France which he had sold to the publisher twenty-five years earlier, protesting that so many eventful changes had occurred since the writing of the book that to publish it would greatly damage his literary reputation. The court decreed rescission.

A corollary to the right to rescind the contract of publication is the right to withdraw the work. This doctrine has been developed in continental law to give the creator the right to purchase at wholesale price all outstanding copies of the work still in the hands of a person to whom he has sold the copyright or given a license.[21] This right may be exercised where the convictions of the creator have undergone a radical change, or where new discoveries have made the work obsolete. Where the publisher or other transferee of the work has infringed

[16] UNESCO 62. [17] Strauss, *supra* note 9, at 513. [18] *Ibid.*

[19] Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554, 560 (1940).

[20] Cited in Roeder, *supra* note 19, at 560, n. 36. [21] *Id.* at 561.

upon the *droit moral* of the creator, the creator may be granted the right to destroy the work.[22]

THE PATERNITY RIGHT

Roeder has stated: "The right to paternity is simply the right of the creator of a work to present himself before the public as such, to require others so to represent him, and to prevent others from attributing works to him which he has not devised." [23] The comparative survey of copyright law made by UNESCO cites eight rights which belong to this category:

(a) if the authorship of a work is contested, or if the work is attributed to another person than its true author, the latter has the right to assert that he is the author;
(b) the author has the right to require that his name appear on each copy of his work, and that his name be announced at each presentation, performance, recitation, broadcast, etc., of his work;
(c) the author has the right to protest the application of his name to the work of another, or the representation of a copy of his work as the original work;
(d) the author has the right to protest the substitution of another's name for his own on his work;
(e) the author may require that his anonymity or his nom de plume be respected;
(f) the author may require that his name appear on the work in the form which he chose;
(g) authors of films may require that their names appear at showings of the film;
(h) the author may require that when excepts [excerpts] from his work are used, the source, with mention of his name, be indicated.[24]

The survey notes forty-four countries which have legislatively or judicially affirmed one or more of these principles and states that the majority of countries have made provision relative to the first three categories in their copyright laws.[25] In France, statutory protection exists only against the wrongful use of an author's name on a work of music or art and the

[22] Camoin v. Carco, cited in Roeder, *supra* note 19, at 561.
[23] Roeder, *supra* note 19, at 562. [24] UNESCO 62. [25] *Id.* at 58.

fraudulent imitation of his signature on the sale of such works.[26] The French courts have extended the scope of the paternity right to books [27] and have held an author entitled to prevent the fixing of his name to a disfigured work.[28] Under the German law, which grants fairly inclusive statutory protection, the name of an author may not be omitted from his work without his consent, or unless he cannot in good faith raise objections to its omission.[29] No one may quote from another's work without indicating the source under the German law.[30]

THE INTEGRITY RIGHT

This right is perhaps the best known. Often it is deemed to constitute the whole doctrine of *droit moral.* Of the moral rights, it is the most sharply differentiated from the exploitive right. It consists essentially of the right to modify and to prevent the deformation of a creation by others. Unquestionably, it is this moral right that has aroused the most bitter antagonism in the United States.[31] The writers of the UNESCO survey list four separate rights as constituting the integrity right and state that thirty-nine countries, including the European nations, subscribe to one or more of them:

(1) No one, without the consent of the author, has the right to modify either the form, or the contents, or the title of the work. Particularly, this denies the right to alter, to abridge, to delete, to deform, to mutilate, or to distort the work whether in reproducing it, or in presenting, performing or broadcasting it, or in translating or adapting it, including adaptation for films or sound recording.
(2) A person or organization authorized to present or perform a work, etc., may not transfer this right to another enterprise nor cause it to be performed by incompetent artists.
(3) A work may not be presented in a form obviously inappropriate to it. Neither can it be inserted in an anthology or exhibited as

[26] Strauss, *supra* note 9, at 508. [27] Katz, *supra* note 6, at 110, n. 14.
[28] Strauss, *supra* note 9, at 508. [29] *Id.* at 509. [30] *Ibid.*
[31] See *Hearings Before a Subcommittee of the Committee on Foreign Relations on Executive E,* 75th Cong., 2d Sess. 19, 29 (1938).

part of a collection, etc., if the author does not want his work to appear in the company of that of the other authors represented.
(4) Any interpolation must be clearly indicated.[32]

The UNESCO survey lists the "right to correct" before publication of new editions in a miscellaneous category. Other authorities include it as a right of integrity but define it more broadly as a right to modify. Roeder describes it as "the right to make any additions, suppressions, and other modifications which the author may deem necessary in order to make the work conform to the state of his intellectual convictions." [33]

The French courts have held that the user of a work by way of reproduction or performance must adhere strictly to the form and contents given the work by the author, and that the publisher and the theatrical producer may not make changes without the author's consent.[34] Similarly, the German copyright statute provides that the assignee of a copyright cannot, without the author's permission, make changes in the work, its title, or in the author's statement.[35] The courts do construe the terms of a contract liberally, inferring consent whenever possible to protect the investments which have been made in industries which utilize and necessarily must alter the form of some works. Adaptation rights acquired by a motion picture producer are construed to permit substantial changes on the theory that a motion picture is a work of art itself and an author who grants adaptation rights should expect changes. Reasonable limitations on producers' rights under adaptation clauses do exist, however. In the recent case of *Widow of Pierre Fondaie v. Producer "Le Lieutenant de Gibralter,"* the court held that the moral rights of the author had been disregarded in making a mere spy story out of a "beautiful love story." [36]

[32] UNESCO 64. [33] Roeder, *supra* note 19, at 565.
[34] Strauss, *supra* note 9, at 509, n. 20. [35] *Id.* at 510, n. 22.
[36] Monta, *The Concept of "Copyright" Versus the "Droit D'Auteur,"* 32 So. CAL. L. REV. 177, 182 (1959), citing decision of the Tribunal Civil of Paris, January 12, 1955, as cited in VIII REVUE INTERNATIONALE DU DROIT D'AUTEUR 204 (July 1955).

The right to prevent deformation does not include the right to prevent the destruction of a work since the protection is based on the need of the creator for the protection of his honor and reputation. Thus, in France, the birthplace of the concept of the *droit moral*, it was held that the artist could not recover when murals painted by him on the walls of a church were destroyed, without notice, by the *abbé*.[37] In the "*Rocky Island with Sirens*" case, the German Supreme Court held that the defendant might not paint dresses on nude sirens in a mural which he had commissioned the plaintiff to paint in the stairway of his home, but permitted the defendant to destroy the mural.[38]

THE AUTHOR'S RIGHT AGAINST INVASIONS OF HIS PERSONALITY

This right allegedly protects the honor and reputation of the author against the unfair use of his name or work. For example, without his consent it would be a violation of this right to quote the author of a scientific book as advocating the purchase of commercial products in advertising by virtue of statements made in a different context. French cases have held that this right is violated by using a work of art in commercial advertising, by the unjustified interruption of publication of a novel in a newspaper, and even by playing a serious composition by Stravinsky in a film sequence with the Viennese Waltz.[39] In France special legislation protects a creator against abusive and malicious criticism of his works, and gives him a right to reply to such criticism.[40]

DROIT DE SUITE

The *droit de suite* is the right of an artist "to share in the money which changes hands upon sales in his work subsequent to the one by which he parted with it." [41] The right is recognized in France, Belgium, Uruguay, and Italy,[42] and in the

[37] Lacasse et Welcome c. Abbe Quenard, cited in Roeder, *supra* note 19, at 569.

[38] Strauss, *supra* note 9, at 510, n. 22. [39] *Id.* at 514, n. 371.

[40] Roeder, *supra* note 19, at 572. [41] UNESCO 136. [42] *Ibid.*

proposed German law.[43] Under the Berne Convention it is protected on a reciprocal basis.[44] Protection will probably be afforded to American artists in the countries which recognize the *droit de suite* and which are members of the Universal Copyright Convention, which provides for protection of the rights of foreign artists and authors on a national basis.

The writer or composer whose creation is reproduced usually reserves pecuniary benefits in the form of royalties when he alienates the rights of reproduction and performance which are protected by the copyright. Generally, the painting or sculpture of the artist is not reproduced for common consumption; the subsequent realization of value from the work comes from sales by art dealers of the work itself. In effect, the artist is stripped of all rights and interests in his product by the alienation of his work. His pecuniary interest is determined conclusively at the moment of the contract of sale in the United States and other countries which do not recognize the *droit de suite*. The purpose of the *droit de suite* is to secure to the artist the same pecuniary advantages that the writer and composer enjoy in royalties or a percentage of the profits reaped from the exploitation of their works.

English literature on the *droit de suite* is nearly nonexistent. The most comprehensive analysis is by Rita Hauser.[45] According to Miss Hauser, under the French statute artists may claim a percentage of the gross sales price received on each sale of an original work. The term "original" is not defined by the statute. In theory the law extends to all works of the plastic arts including lithographs, engravings, woodcuts, models, jewelry, and other artistic objects generally reproduced in quantity for sale. It is not believed that the *droit de suite* applies to these works, however, since the artist can protect his economic interests by way of contract under the copyright law. Conservative opinion regards only the cut as an "original." Miss Hauser

[43] Hauser, *The French* Droit de Suite: *The Problem of Protection for the Underprivileged Artist Under the Copyright Law*, ASCAP Copyright Law Symposium Number Eleven 1 (1962).

[44] *Id.* at 17–19. [45] See note 43 *supra*.

notes that only rarely have copies sold for a price high enough to bring them within the protection of the statute and for that reason there are no decisions.

Under the French law the *droit de suite* applies only to sales over twenty dollars, and a uniform rate of 3 per cent is taxed to the artist on all gross profits.[46] Under the proposed German law the artist would participate only in the seller's profit which represented increased value, but in the increased value he would receive a one-fourth share.[47] The Italian law imposes a tariff ranging proportionally from 2 to 10 per cent in the added value.[48] Participation under the German and Italian laws is based on the "theory of intrinsic value." According to this theory the profit realized on the sale of a work of art by a transferee merely recognizes the intrinsic value of the creation which has existed in latent form since the time of its creation. The greater value recognized on the sale is deemed to be due solely to the artist's labors, and therefore the artist should participate in the gain accruing from his labor. By contrast, the French theory justifies the *droit de suite* as compensation for the exploitation of the work. The protection offered by this theory is an endeavor to parallel the gains which the writer and composer enjoy through royalty contracts. Either theory derogates from traditional property concepts; consequently the advocates of the *droit de suite* face a formidable barrier to its reception in the United States.

The *droit de suite* has functioned most effectively in France and Belgium.[49] In France, in contrast to the other countries which recognize the *droit de suite*, the artist must meet certain formalities before he is entitled to the protection of this right. He must publish in the *Journal Official* a special declaration of his claim to the *droit de suite* in an artistic work. Curiously, the declaration may be made at any time by the artist, his heirs or assigns, or his agent, any of whom may receive the sums due. The functioning of the right is dependent on an asso-

[46] *Id.* at 7. [47] *Id.* at 17. [48] UNESCO 138.
[49] HAUSER, *supra* note 43, at 17.

ciation of artists which protects its members' interests. In France, the Union of Artistic Property is the sole organ of collection. Until 1957 the *droit de suite* applied only to public sales, presumably because the legislature felt that control over private sales was unpracticable. In large measure due to the successful operation of the *droit de suite* under the original statute, a new law enacted in 1957 extends protection to all sales made "through the intermediary of a merchant." [50] The public auction officers under the original law were responsible for collecting the sums due and turning the monies over to the Union, and for keeping a special register noting sales and prices received. The Union of Artistic Property uses this register and the auctioneer's catalog as a basis for supervising the collection of sums due. Under the 1957 law the public officer or merchant discharges his duty by sending the sums to the Union, together with statements of the sale and price. It is the Union which sues, or is sued by, uncooperative sellers in the enforcement process.

The *droit de suite* is not a moral right directed at protecting the personality of the artist. Its purpose is to protect the artist's pocketbook and thereby alleviate a distressing social problem —the predicament of the destitute artist. The French Parliament enacted the first statute giving recognition to this right in 1920 after hearing a lengthy description of the plight of such artists as Millet, Cezanne, and Gauguin, who died in miserable poverty at a time when their paintings were selling for enormous sums. Thus the *droit de suite* is a unique pecuniary right which bears none of the usual incidents of property, such as the right to control or to possess.

PROTECTION IN THE UNITED STATES

Neither the *droit de suite* nor the *droit moral* has been accepted in the case law or statutes of the United States. There

[50] *Id.* at 11.

have been several instances in which the personal rights of artists were protected on common-law doctrines of tort or contract. Attempts to incorporate the *droit moral* into copyright legislation have failed, and the courts continue to deny the doctrine. In comparison to the large body of continental jurisprudence on the personal rights of artists in their works, there is a paucity of cases in the common-law countries, and only a few which even mention the *droit moral.*

In *Vargas v. Esquire, Inc.*,[51] a federal court refused to recognize the paternity right. Vargas had sold some paintings of nudes to *Esquire* magazine which published them without his name. In a unanimous decision the court declared:

> Plaintiff advances another theory which needs little discussion. It is predicated upon the contention that there is a distinction between the economic rights of an author capable of assignment and what are called "moral rights" of the author, said to be those necessary for the protection of his honor or integrity. These so called "moral rights," so we are informed, are recognized by the civil law of certain countries. . . .
>
> What plaintiff in reality seeks is a change in the law in this country to conform to that of certain other countries. We need not stop to inquire whether such a change, if desirable, is a matter for the legislative or judicial branch of the government; in any event, we are not disposed to make any new law in this respect.[52]

Most of the important state court pronouncements have come from New York, where the courts have avoided the issue whenever possible. In *Shostakovich v. Twentieth Century-Fox Film Corp.*[53] the plaintiffs sought an injunction to prevent the use of their names and portions of their musical scores in connection with a film exposing the intrigues of Soviet agents in foreign countries. Inasmuch as there was no copyright treaty with the Soviet Union, the works were in the public domain and not entitled to protection under existing law. The court refused to grant relief on a theory of moral right:

[51] 164 F.2d 522 (7th Cir. 1947). [52] *Id.* at 526.

[53] 196 Misc. 67, 80 N.Y.S.2d 575 (Sup. Ct. 1948), *aff'd mem.*, 275 App. Div. 692, 87 N.Y.S.2d 430 (1949).

There is no charge of distortion of the compositions nor any claim that they have not been faithfully reproduced. Conceivably, under the doctrine of Moral Right the court could in a proper case, prevent the use of a composition or work, in the public domain, in such a manner as would be violative of the author's right. The application of the doctrine presents much difficulty however. With reference to that which is in the public domain there arises a conflict between the moral right and the well established rights of others to use such works. . . . In the present state of our law the very existence of the right is not clear, the relative position of the rights thereunder with reference to the rights of others is not defined nor has the nature of the proper remedy been determined. Quite obviously therefore, in the absence of any clear showing of the inflection of a wilful injury or of any invasion of a moral right, this court should not consider granting the drastic relief asked on either theory.[54]

The New York courts have not since indicated a disposition to recognize the moral right. In the recent case of *Seroff v. Simon & Schuster, Inc.*[55] the court declared that in the United States the moral rights of artists depend on the law of contracts for protection. Finding no breach of contract, the court denied the relief requested. It is to be noted that this was not a proper case for the application of the doctrine of moral right. Suit was brought by an author against his publisher, who had sold foreign publishing and translation rights to a French company which subsequently abused the plaintiff's rights by publishing a distorted translation of his work. The court found that the defendant had contractual permission to sell the foreign rights and that the defendant publisher had neither violated his contract with the plaintiff nor been negligent in selling the foreign rights or in failing to inspect the translation before publication. These facts presented no violation by the defendant of the plaintiff's moral rights—even by civil-law standards. Thus it is unclear what position the New York courts would adopt

[54] *Id.* at 70–71, 80 N.Y.S.2d at 578–79.

[55] 6 Misc. 2d 383, 162 N.Y.S.2d 770 (Sup. Ct. 1957), *aff'd mem.*, 12 App. Div. 2d 475, 210 N.Y.S.2d 479 (1960), *motion for leave to appeal denied mem.*, 12 App. Div. 2d 755, 210 N.Y.S.2d 1000 (1961).

in a case involving a clear violation of the artist's moral right. It seems reasonable to assume that relief, if granted, would be given on a somewhat tortured theory of tort or contract.

The extent of protection of moral or personal rights on common-law theories or in the exercise of the equitable powers of the court has been both interesting and revealing. Equity will not decree the creation of a work,[56] or the publication of a created work.[57] Neither a creditor [58] nor the purchaser of a work at a bankruptcy sale [59] may execute against, and subsequently publish, a previously unpublished manuscript. In *Caliga v. Inter Ocean Newspaper Co.*[60] it was held that until publication by the author, he is protected by a common-law copyright against anyone who publishes his manuscript without authority. No cases have been found in the United States concerning either the right of recission or the right to withdraw the work from the market.

The creator's interest in having his name associated with his work and no other has been protected under a variety of theories. In *Clemens v. Press Publishing Co.*[61] it was held to be a violation of the publishing contract to publish a story anonymously when the manuscript submitted to the publisher and the galley proofs contained the author's name. The court stated, "[T]heir intent was that . . . the defendant should publish . . . under the author's name." [62] An injunction has been granted against the publication of an uncopyrighted work with the unauthorized use of the author's name on a theory of invasion of privacy,[63] and the publication of a false attribution

[56] Boller v. Weigle, 261 Fed. 250 (D.C. Cir. 1919).

[57] Duke of Queensbury v. Shebbeare, 2 Eden 329 (1758); Palmer v. DeWitt, 47 N.Y. 532 (1872); Gee v. Pritchard, 2 Swanst. 402, 36 Eng. Rep. 670 (1818).

[58] Bartlett v. Crittenden, 2 Fed. Cas. 967, No. 1076 (C.C.D. Ohio 1849).

[59] Berry v. Hoffmann, 125 Pa. Super. 261, 189 Atl. 516 (1937).

[60] 215 U.S. 182 (1909).

[61] 67 Misc. 183, 122 N.Y. Supp. 206 (Sup. Ct. 1910).

[62] *Id.* at 184, 122 N.Y. Supp. at 208.

[63] Ellis v. Hurst, 66 Misc. 235, 121 N.Y. Supp. 438 (Sup. Ct. 1910).

of paternity has been enjoined on theories of unfair competition [64] and libel.[65] The use of the artist's name in a distorted version of his work—the crude reproduction of a painting on an embroidery pattern,[66] or a distorted screen version of his story [67]—has been held to be an invasion of the right of privacy under the New York statute.

Plagiarism, the most common usurpation of the paternity right, however, is protected only by the copyright, which expires within a limited term of years and protects only the economic interests of the holder of the copyright. The creator who assigns his statutory copyright is not protected against plagiarism even during the term of the copyright. The moral right remains in the author after the copyright has been assigned.

The right of the creator to modify his work has never appeared in the common law. The right to prevent deformation, however, is upheld to some extent under the laws of libel or unfair competition.[68] Such protection covers the body of the work, its title, and probably such incidentals as index, preface, etc. In *De Bekker v. Frederick A. Stokes Co.*[69] the publisher printed the author's book as two volumes of a ten-volume series, thereby increasing its sales. Granting relief, the court said:

> It appears . . . that . . . the sales have been accelerated, but the tenor of the agreement with the plaintiff has not been kept. He has the right to insist that the Stokes Company publish the book under the name of the Stokes Encyclopedia of Music, however advantageous to him some other form of presentation to the public may be. . . .

[64] Fisher v. Star Co., 231 N.Y. 414, 132 N.E. 133 (1921).

[65] Ben-Oliel v. Press Publishing Co., 251 N.Y. 250, 167 N.E. 432 (1929); D'Altemonte v. N.Y. Herald Co., 154 App. Div. 453, 139 N.Y. Supp. 200 *aff'd*, 218 N.Y. 596, 102 N.E. 1101 (1913); Gershwin v. Ethical Publishing Co., 166 Misc. 39, 1 N.Y.S.2d 904 (City Ct. 1937).

[66] Neyland v. Home Pattern Co., 65 F.2d 363 (2d Cir. 1933).

[67] Curwood v. Affiliated Distribs., 283 Fed. 219 (S.D.N.Y. 1922).

[68] Roeder, *supra* note 19, at 565, n. 57.

[69] 168 App. Div. 452, 153 N.Y. Supp. 1066 *aff'd*, 219 N.Y. 573, 114 N.E. 1064 (1915).

The plaintiff . . . has the strict right to preserve the identity of his creation.[70]

Unauthorized abbreviations of the plaintiff's musical performance by a recording company coupled with the use of plaintiff's name was held to constitute a breach of contract and unfair competition in *Granz v. Harris*,[71] where an injunction was granted. The court said:

We think that the purchaser of the master discs could lawfully use them to produce the abbreviated record . . . provided he did not describe it as a recording of music presented by the plaintiff. If he did so describe it, he would commit the tort of unfair competition. But the contract required the defendant to use the legend "Presented by Norman Granz." . . . This contractual duty carries by implication, without the necessity of an express prohibition, the duty not to sell records which make the required legend a false representation.[72]

It is to be noted that the federal court, sitting in New York, expressly recognized the right of a recorder to make unauthorized abbreviations in other circumstances. An earlier New York case appears to be contrary to this dictum, although it is concerned with artists' rights in a different medium. In *Royle v. Dillingham* [73] the plaintiff successfully protested the production of his play with unauthorized changes in the text and structural arrangement. The court stated: "The defendant by his letter . . . explicitly states that he has accepted plaintiff's play. All subsequent changes are dependent on the will of the plaintiff, whether its exercise be arbitrary or otherwise." [74] In accord is an early federal case which holds that the unauthorized representation of part of a work as the entire work violates the artist's rights.[75]

It has been stated by one authority that the protection afforded the artist's personal rights under common-law doctrines is practically as broad as protection in the civil-law

[70] *Id.* at 454, 153 N.Y. Supp. at 1068. [71] 198 F.2d 585 (2d Cir. 1952).
[72] *Id.* at 588. [73] 53 Misc. 383, 104 N.Y. Supp. 783 (Sup. Ct. 1907).
[74] *Id.* at 384, 104 N.Y. Supp. at 784.
[75] Drummond v. Altemus, 60 Fed. 338 (1894).

countries, and, therefore, that there is no real need for the adoption of the doctrine of *droit moral* in the United States.[76]

This assertion appears ill-considered. The requirement of proving economic injury and damages makes recovery on common-law theories extremely limited, as is indicated by the dearth of cases on point. Furthermore, recovery on the common-law theories usually requires a distortion of tort theory or a highly imaginative construction of a contract. Where recovery is granted on grounds of unfair competition the element of competition is most often absent.[77] The law of libel seems properly applicable only in the false attribution of paternity cases. Libel law developed from situations in which the defendant made an untrue statement reflecting on the plaintiff in a damaging manner and is inappropriate in situations where the defendant misquotes or publishes incompletely the plaintiff's work. As the cases set forth have shown, relief in contract law nearly always depends on a condition conveniently implied in order to prevent an injustice. The invasion of privacy doctrine is not properly applicable in the false attribution of paternity cases where the gravamen is injury to the plaintiff's reputation by association with another artist's work. It seems totally inappropriate in the cases in which it has been the basis for relief, usually as a result of the publication of a distorted version of the plaintiff's work. Only where the plaintiff's artistic work has been published by the defendant without his consent does this doctrine appear to be appropriate.

The common-law doctrines provide inadequate protection for artists, because they are directed at the economic injury to the artist rather than at the injury to personal interests of an intangible nature. The basis of the moral right is unique—the protection of the artist's personality. Vaunois predicates the doctrine on the premise that "Each of us has the right to

[76] See note 9 *supra*.

[77] Prouty v. National Broadcasting Co., 26 F. Supp. 265 (D. Mass. 1939).

defend his ideas, against all manner of attack, as he has the right to defend his person against such attacks. . . . This right is absolutely personal." [78] Regarding the paternity right, the French authority M. Harmand has written:

> I envisage through the moral right . . . the consecration of the person. I explain it as follows: I take the responsibility of saying that the work is mine, I perpetuate this responsibility by my signature, my signature attaches itself to my work, consequently my signature and my work are, taken together, my personality; I defend them as my person. Thus respect for [my] signature is the corollary of the moral right.[79]

With regard to the integrity right, the German legal scholar, Joseph Kohler, who was one of the earliest exponents of the moral right, stated:

> [T]he writer cannot only demand that no stranger's work be presented as his, but that his own work not be presented in a changed form. The author can make this demand even when he has given up his copyright. This demand is not so much an exercise of dominion over my own work, as it is of dominion *over my being, over my personality* which thus gives me the right to demand that no one shall share in my personality and have me say things which I have not said. [Emphasis added.]
>
> This connection with the right of personality is herewith found and its existence by the side of copyright is demonstrated. Or will one not permit me the power to avail myself of my right of personality when new scenes are inserted in a drama whose copyright I have given up, and the entire production presented under my name? [80]

Many of the rights comprising the moral right which have been recognized under continental doctrine have not been protected in the common-law countries. However, these rights are capable of the same preciseness of definition as are rights of personality under the law of assault and battery and negligence. They should be as inviolate. The cases in the United States show an appreciation of the need to protect the creator, but also a failure to analyze the basic problems confronting artists and the unique nature of their rights.

[78] As quoted in Katz, *supra* note 6, at 120–21. [79] *Id.* at 121.
[80] *Id.* at 121, 22.

PROTECTION UNDER TREATY

Although foreign artists are denied the protection of the *droit moral* and the *droit de suite* in the United States, American artists may be offered the protection of these rights in other countries under the multilateral treaty provisions of the Berne Convention of 1886 and the Universal Copyright Convention (UCC) which came into effect in 1955.

The Berne Convention, to which the United States is not a signatory, is a substantive code of international copyright law. The author of a work first published in a Berne Union country is protected in all member countries to the same extent as nationals of those countries. American authors enjoy "back door" protection under Article Six of the Berlin Revision which extends automatic protection to the authors of works published simultaneously in a Berne Union country and a nonmember country. American authors, whose works must be manufactured in the United States to qualify for domestic protection,[81] qualify for Berne Union protection by issuing identical release dates for publication in the United States and one of the thirty-six member nations.[82] Until the passage of the UCC no real protection was afforded foreign authors by American courts,[83] and the United States was notorious for the pirating of foreign works. The dissatisfaction of Berne Union nations culminated in a provision in the Rome Revision of 1928 authorizing member countries to limit Berne protection when a non-Union country did not adequately protect the

[81] 17 U.S.C. § 16 (1958).

[82] See HOWELL, THE COPYRIGHT LAW 311 (3d ed. 1952) for list of countries.

[83] Act of March 3, 1891, 26 Stat. 1106, ch. 565 extended federal statutory protection to nonresident aliens provided that certain reciprocal conditions were met by the alien's country. For a statement of reciprocal conditions see Colino, *Copyright Protection Abroad for United States Cultural Exports*, 1962 DUKE L.J. 219, 222, n. 9. Prior to this date re-publication in this country of works copyrighted abroad was freely permitted. Scribner v. Stoddard, 21 Fed. 876 (E.D. Pa. 1879). However, a foreigner, resident in the United States, could secure copyright here on the same basis as a citizen. 17 U.S.C. § 10 (1958).

works of their nationals. There never has been any real retaliation, although there has been some dispute over the "genuineness" of the alleged simultaneous publication.[84] The problem of retaliation no longer exists in countries whose nationals are entitled to protection in the United States under the UCC without complying with the formal registration requirements of the Copyright Act.

Substantive provisions of the Berne Convention specify the types of works which must be protected in all countries and provide that the exercise of rights shall not be subject to any formalities of registration. It defines technical terms such as "published" and sets forth a minimum list of rights which must be protected. The *droit moral* is one such right. The Berne Convention, however, protects the unpublished works of nationals of member countries only. Thus the unpublished manuscript of an American author may be pirated abroad without protection in the absence of United States bilateral treaty relations or UCC protection.

The UCC, to which the United States is a signatory, protects both published and unpublished works and achieves a compromise between principles of the Berne Union countries and the United States. Bills proposing the entry of the United States into the Berne Union have been defeated over the years in large measure by opposition to the necessary acceptance of the doctrine of *droit moral* and the requirement of automatic protection without registration. The UCC provides in Article II that "Published works of nationals of any Contracting State and works first published in that State shall enjoy in each other Contracting State *the same protection as that other State accords to works of nationals published in its own territory.*" (Emphasis added.) and that "Unpublished works of nationals of each Contracting State shall enjoy in each other Contracting State *the same protection as that other state accords to unpublished works of its own nationals.*" (Emphasis added.)

[84] Colino, *supra* note 83, at 224.

This provision thus leaves the determination of substantive law to the member states. Article III adopts the notice requirement of the federal Copyright Act for published works. To be entitled to UCC protection a published work must bear copyright notice consisting of: the symbol ©; the name of the copyright proprietor; and the year of first publication.

It is to be noted that under Article II the works of nationals of member states, regardless of where published, and also the works of any person published in a member state, regardless of the artist's nationality, receive UCC protection. The treaty permits member states to pass legislation "assimilating to its own nationals any person domiciled in that state." (Article II.) An exception to this statement of general protection permits any nation to exclude from UCC protection any works first published within its territory, or works of its own nationals published anywhere.[85] The United States has exercised this right and all works published in the United States, or by nationals abroad, are protected within the United States only if the provisions of the Copyright Act are strictly complied with.[86]

The UCC does not impair conventions, treaties, or systems presently in force. Thus protection may be afforded under the Berne Convention or bilateral treaties to authors who do not comply with the UCC notice requirements. It is apparent that under the Berne Convention or the UCC a United States national may receive greater protection abroad than in the United States, especially in those countries which recognize the *droit moral* and the *droit de suite.*

PROPERTY CONCEPTUALISM AND THE COMMON LAW

Sovereignty, Seneca said, belongs to princes and property to individuals.[87] To Bentham property was a "basis of expectation . . . metaphysical" born with the law.[88] To Black-

[85] Universal Copyright Convention Art. III (2). [86] 17 U.S.C. § 10 (1958).
[87] II Grotius, War and Peace Ch. 3, § 11.
[88] I Bentham, Principles of the Civil Code 111–13 (1931).

stone it was "that sole and despotic dominion which one man claims and exercises over the external things of the world." [89] Ely said, "By property we mean an exclusive right to control an economic good," [90] and Morris Raphael Cohen defines it as a "sovereign power compelling service and obedience." [91] Philosophers have never been able to define "property" to the general satisfaction of legal scholars, and the Restatement of Property, which adopts the Hofeldian scheme of legal relations, omits any definition of "property" as such: an "interest" is a right, privilege, power or immunity, and an "owner" is a person who has one or more interests.

The Restatement, which brings all law under the rubric of property, does not seem to be an improvement over past attempts at definition. Despite academic dissension over definitions, "property" is a meaningful concept in most people's lives and the average person has little cause to ponder its philosophic origins. A serviceable meaning assigned to the word "property" by most law students, which most laymen would approve, is that property consists of a bundle of rights *in land or a thing.*

Regardless of whether property consists entirely in the power relationships between people, or whether the object to which rights, privileges, powers, and immunities relate is a necessary element of property, the word property has connotations of "thingness"—of expression in a specific, material, tangible, visible form. Although the Restatement implies that "property" is an outmoded term, courts and lawyers continue to talk in terms of "property" in most areas of law involving man's relationship to land or chattels. There is complete agreement that the property in a thing consists entirely in the rights governing relationships among men with respect to it, yet everyone refers to things themselves as being property. For

[89] II Blackstone, Commentaries on the Laws of England 2 (15th ed. 1809).

[90] I Ely, Property and Contract in Their Relation to the Distribution of Wealth 101 (1914).

[91] Cohen, *Property and Sovereignty*, 13 Corn. L.Q. 8, 9 (1927).

example, "The book is *mine*. It is *my property*." Significantly, rights of personality, which do not involve land or chattels and are protected by the law of torts, usually are referred to as "rights" and not as "property rights." Likewise, the right stemming from a contract, which is usually a right to have the other party to the contract perform an act, is not thought of as "property" except when it falls into an estate or the hands of a trustee in bankruptcy.

The law of remedies has been hampered severely by conceptualistic property thinking. In the last half-century individuals who have suffered an economic loss due to the business activity of another have complained frequently to the courts. In nearly every case in which the courts have granted recovery the rationale has been that a *property* right was violated. The courts have strained to demonstrate that "property," heretofore associated with tangible things capable of control and possession, is a concept broad enough to afford the basis for legal protection of interests not embodied in tangible form, capable of being possessed. To recover, the plaintiff has been required to prove that he had a "property interest" in something that no one ever considered to be property. Thus, in the celebrated case of *International News Serv. v. Associated Press*,[92] Mr. Justice Pitney in effect created a new property interest by decreeing legal protection for the plaintiff news service which protested its competitor, the defendant, using it as a source of news:

> Regarding the news, therefore, as but the material out of which both parties are seeking to make profits at the same time and in the same field, we hardly can fail to recognize that for this purpose, and as between them, it must be regarded as *quasi* property, irrespective of the rights of either as against the public.[93]

Later in the case Mr. Justice Pitney stated the real reason for granting the relief sought:

> Stripped of all disguises, the process [pirating of news by one news service from the bulletin board and early releases of a competitor news

[92] 248 U.S. 215 (1918). [93] *Id.* at 236.

service] amounts to an unauthorized interference with the normal operation of complainant's legitimate business precisely at the point where the profit is to be reaped, in order to divert a material portion of the profit from those who have earned it to those who have not; with special advantage to defendant in the competition because of the fact that it is not burdened with any part of the expense of gathering the news. The transaction speaks for itself, and a court of equity ought not to hesitate long in characterizing it as unfair competition in business.[94]

Is a person's legitimate interest never to be protected unless it is somehow regarded as "property"? Is it really true that equity protects only property interests? [95] In any case, would it not have been better to extend the jurisdiction of equitable protection than to label arbitrarily the interest of the plaintiff "property" in order to decree equitable protection? Some other instance of the hypostatization of "property rights" should be noted. The protection of trade secrets or trade symbols is predicated on the existence of property in these economically valuable sales devices.[96] The discoveror of a medical preparation or formula is said to have "a property right in the product of his mental labors." [97] More often the justification is that the plaintiff, by the use of his imagination, has created a thing of economic value, which in our culture is practically synonymous with property.[98]

[94] *Id.* at 240.

[95] See American Washboard Co. v. Saginaw Mfg. Co., 103 Fed. 281, 285 (6th Cir. 1900); Cohen, *Transcendental Nonsense and the Functional Approach*, 35 COLUM. L. REV. 809, 815 (1935).

[96] Stewart v. Hook, 118 Ga. 445, 45 S.E. 369 (1903).

[97] See authorities cited note 91 *supra*.

[98] The thinking in the area of intangible interests is hopelessly confused at present. This is demonstrated by the laws protecting industrial designs. The purpose of copyright law is to foster and develop artistic creativity. Thus aesthetic qualities and originality are the prime requisites for copyright protection. The purpose of the patent law is economic: a patent is a legal monopoly on the exploitation of a commercially valuable idea. Here novelty is the primary requisite. Should a design intended for useful purposes be entitled to protection? If so, should it be protected on copyright principles emphasizing originality, or on patent principles requiring novelty?

In some countries such as Luxemburg and the Netherlands no protection is given to industrial designs. In Belgium and France the design is entitled to

For the purposes of this essay the most important instances of conceptualism in the protection of rights in intangibles are the common-law copyright cases. In the case of *Gee v. Pritchard*,[99] the plaintiff sought an injunction against the publication of letters written by her to the foster son of her late husband. The court issued the injunction, being of the opinion "that the plaintiff has a sufficient property in the original letters to authorize an injunction."[100] In 1912, in *Baker v. Libbie*,[101] the Supreme Court of Massachusetts granted an injunction sought by the executor of the estate of Mary Baker Eddy enjoining an auctioneer of manuscripts from publishing

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copyright protection if the design is sufficiently artistic, and also to protection under a special design statute embodying copyright principles in the requirement of originality. In Germany the design is entitled to copyright protection if artistic and original and to protection under a design statute if sufficiently novel to merit protection on patent principles. Likewise, in Italy it may be protected under a design statute based on patent principles, or under copyright law. But in Italy copyright protection is afforded only if the design is conceptually separable from the product, and the author is not entitled to both types of protection. 1 STEIN & NICHOLSON, AMERICAN ENTERPRISE IN THE COMMON MARKET 257–60 (1960). The creator may obtain protection for artistic designs in the United States under the Copyright Act, and protection for novel ornamental designs under the Design Patent Law.

What is the difference between an "artistic" and a merely "ornamental" work? By what virtue is an artistic work entitled to greater protection than a purely utilitarian nonartistic but nonetheless inventive work?

It should be noted parenthetically that the recent protection of "know how" by the Common Market countries shows the mental agility of the courts of these countries in extending traditional contract and property-law protection to something heretofore never thought of as "property," but which is an interest that in fairness should be entitled to the protection of the law. "Know how" is the practical, technical, and organizational knowledge developed from research and experimentation which enables the exploitation of inventions and scientific advances. In the European countries it is the subject of license agreements. It is distinguishable from patented knowledge and trade secrets which are protected apart from contract. While protection differs under domestic laws, in general it may be said that the licensor of "know how" may control its use by agreement. He may restrict to a given territory sales of products made by the use of licensed "know how," and restrict its use to products made with materials supplied by him or to a certain type of product. He may prohibit its communication to branches or subsidiaries, and he may require the licensee to use his trademark. There is some authority to the effect that a third party to whom it is unlawfully communicated is liable on a theory of conversion if he uses it. See *id.* at 277–82.

[99] 2 Swanst. 402, 36 Eng. Rep. 670 (1818).

[100] *Id.* at 474, 36 Eng. Rep. at 678. [101] 210 Mass. 599, 97 N.E. 109 (1912).

for advertising purposes certain letters written by Mrs. Eddy. The court called Mrs. Eddy's interest "property," saying,

> Property in literary productions, before publication and while they rest in manuscript, is as plain as property in the game of the hunter or in the grain of the husbandman. The labor of composing letters for private and familiar correspondence may be trifling, or it may be severe, but it is none the less the result of an expenditure of thought and time. The market value of such an effort may be measured by the opinions of others, but the fact of property is not created thereby. A canvas upon which an obscure or unskillful painter has toiled does not cease to be property merely because by conventional standards it is valueless as a work of art. Few products of the intellect reveal individual characteristics more surely than familiar correspondence, entries in diaries or other unambitious writings. No sound distinction in this regard can be made between that which has literary merit and that which is without it. . . . The basic principle on which the right of the author is sustained even as to writings confessedly literature is not their literary quality, but the fact that they are the product of labor.[102]

The "property" said to be retained by the author is completely separate from the right to possession or repossession of the letters:

> The property right of the author has been described "as an incorporeal right to print [and it should be added to prevent the printing of, if he desires] a set of intellectual ideas or modes of thinking communicated in a set of words and sentences or modes of expression. It is equally detached from the manuscript or any other physical existence whatsoever." . . . The author parts with the physical and material elements which are conveyed by and in the enevelope. These are given to the receiver. The paper upon which the letter is written belongs to the receiver.[103]

The protection of intangible interests in the fruits of one's labor is quite justifiable. However, to base protection on the rationalization that such interests are property interests and therefore entitled to protection warrants two criticisms. To recognize property in such things as trademarks or created works or news because of economic value to the plaintiff is a

[102] *Id.* at 111. [103] *Id.* at 111–12 (citations omitted).

fallacy. The reasoning is circular. With regard to the unfair competition cases Morris Raphael Cohen has said:

> The vicious circle inherent in this reasoning is plain. It purports to base legal protection upon economic value, when, as a matter of actual fact, the economic value of a sales device depends upon the extent to which it will be legally protected. . . . The circularity of legal reasoning in the whole field of unfair competition is veiled by the "thingification" of property. Legal language portrays courts as examining commercial words and finding, somewhere inhering in them, property rights. It is by virtue of the property right which the plaintiff has acquired in the word that he is entitled to an injunction or an award of damages. According to the recognized authorities on the law of unfair competition, courts are not creating property, but are merely recognizing a pre-existent something. . . .[104]

This criticism is equally applicable to the common-law copyright cases where the protection granted is based on a "property" interest.

To criticize the reasoning whereby a person is said to have property because he has created something of value is to indulge in intellectual snobbery; the mind of the logician who has an aesthetic appreciation for a properly constructed argument is shocked. However, criticism usually is directed only at the reasoning in the opinions and not at the holdings of the cases which generally are justified on principles of fairness and moral uprightness ("moral" pragmatically defined to be what the great majority of people would agree to be fair or just). In the language of Holmes, "The word property as applied to trade-marks and trade secrets is an unanalyzed expression of certain secondary consequences of the primary fact that the law makes some rudimentary requirements of good faith." [105]

The more important criticism of calling such rights "property" is that it blinds the recognition of certain interests of the artist which are elevated to the level of legally protected rights

[104] Cohen, *supra* note 87, at 815.

[105] E. I. DuPont de Nemours Powder Co. v. Masland, 244 U.S. 100, 102 (1917).

in the countries which recognize the *droit moral* and the *droit de suite*. Carlos Mouchet writes,

> The whole architecture and the spirit of the law now in force suffer from the capital error of having started from the controversial concept, already obsolete in legal science, of assimilating intellectual rights to "property," forgetting that works of the mind must be treated by the law as an expression of the personality and dignity of their creators and as belonging to the world of culture. Force of habit and preconceived ideas have affected this sector of knowledge and legal activity. *For a matter of cultural concern necessitating new and appropriate legal institutions, an attempt has been made, although without success, to fit this subject into archaic molds corresponding to materialistic concepts of law.* [Emphasis added.]
>
> The very terminology of "intellectual property" produces lamentable consequences in the solution arrived at. In law it can be said as in the Gospel: "In the beginning was the Word." [106]

Having classed creators' rights as property rights, the courts are prevented from protecting certain of creators' interests by a self-imposed straitjacket of remedies developed from the necessity of redressing rights in real and chattel property.

The essential nonproperty nature of creators' rights is demonstrated by the fact that the owner of a copyrighted work has no property in unlawfully made reproductions. He has no right to possess copies; he can only prevent their sale or the continued infringement of his work, and bring an action for damages against the infringer. The right is strictly personal.

"Thingification," the term coined by Cohen, perhaps explains why the property concept is inappropriate in the area of creators' rights. The word "property" traditionally connotes the right to possess a thing. Like "property," "thing" may be defined to be anything. However, in ordinary usage, a thing may be seen visually, felt, and described pictorially. Property in it exists in the right to possess it physically, to do things to it physically, and to prevent others from doing these things to it. For example, a man who owns a house has a right

[106] Mouchet, *Protection of Literary and Artistic Works in Argentina*, 7 BULL. CR. SOC'Y 216, 217 (1960).

to tear it down, paint it blue, and not permit others to do these things to it. He would not have any rights against a builder who constructed identical houses up and down the street on either side of him even if the consequent appearance of the neighborhood should lower the value of his house. This would be true even if he designed and built the house himself (although he might prevent the actual copying of copyrighted blueprints).

Property in a house is very different from rights in a copyright. Fundamentally, a copyright is a right to have others not copy the form in which an idea is expressed. Thus a copyright in a work does not have a tangible form. It cannot be physically possessed although it remains in the author after he may have relinquished his rights to the possession of the paper on which it was first embodied. The transfer of a copyright is the granting of a right to produce copies of the form in which the author or creator expressed an idea. The transferee receives nothing that he can touch or possess or see. Nor does he receive a right that will mature into something valuable without an act on his part, as he would if he were the recipient of a note embodying an unconditional right to receive money at a future date. The transferee of a copyright receives only the right to produce copies and to prevent others from making copies. Nothing is transferred to him which he can alter or destroy. The economic value of his new right is purely speculative, being the value to be derived from exploiting it. However, once this intangible interest of the author is labeled "property" it immediately becomes thingified and an attempt is made to treat it as the law treats tangibles. Furthermore, lawmakers do not even stop to consider the reality that there are important rights stemming from the act of creation that are not a part of the copyright. Thingification obscures the difference between houses and poems and other artistic works, and between the different interests of the home owner and the creator, each of whom stand in need of legal protection.

CONCLUSION

It has been said,

> When an artist creates, be he an author, a painter, a sculptor, an architect or a musician, he does more than bring into the world a unique object having only exploitive possibilities; he projects into the world part of his personality and subjects it to the ravages of public use. There are possibilities of injury to the creator other than merely economic ones.[107]

For over a hundred years the civil-law countries have protected the very special rights of creators under the doctrine of *droit moral.* Decreeing that the artist shall participate in the proceeds from successive sales of the work, a few nations have recognized an economic right which lingers in artists and sculptors after sales of a painting or sculptures, of which they are the sole source of intrinsic value. Although the *droit de suite* is a money right, its source, too, is moral.

Concern with material matters in a country producing economic wealth at a rate unparalleled in the history of man obscured recognition of the unique interests of artists in the first centuries of our nation's growth. Young America equated economic value with property, and property with the protection of law. The great preoccupation of our courts with problems of civil rights and due process indicates there is a growing recognition by society and by the law of values which are human and moral. The poignancy of the struggle for equality of men of all colors makes civil rights more readily apparent to the public than the moral rights of the creator. Our historic concern for the liberty of the individual and the inviolability of property creates a general predisposition to sympathize with the unduly oppressed. Moral rights spring not from liberty or equality, but from dignity, a third quality marking man's noblest state. Paradoxically they are not observed in a country dedicated to a belief in the worth of the individual.

[107] Roeder, *supra* note 19, at 557.

Artists stand on the fringe of society. Art is enjoyed by all, yet artists are known and understood by a few. Their rights, which are protected in other countries by the doctrine of *droit moral* and *droit de suite*, are the proper concern of the public. But because the injuries to an artistic personality are not felt by those who do not themselves create, these rights of the creator go unnoticed. Thus far the courts have been unduly conservative in protecting newly recognized values. They have attempted to protect artists' rights under materialistic concepts of law which were developed to protect a totally different kind of interest. These ill-suited doctrines are proving to be inadequate for the task. It is time America discarded inappropriate "property" notions in the field of artists' personal rights and caught up with the older nations of the world in protecting those to whom culture is entrusted.

NATIONAL SECOND PRIZE, 1963

Common-Law Overtones of Statutory Copyright: An Inquiry into the Status of a Federal Common Law of Unfair Competition

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INTRODUCTION

THE DUAL SOVEREIGNTY of state and federal governments which exists in this country has given rise to a number of perplexing problems. Among these is the problem of defining the limitations of the federal courts in enforcing civil remedies having their basis in state law, where federal jurisdiction is based upon something other than diversity of citizenship. This phenomenon most commonly arises in cases wherein a single fact situation gives rise to a plurality of claims for relief, at least one of which is founded upon federal law and another upon state or "common" law. It is the purpose of this essay to examine the problems incident to linking a common-law claim with a remedy provided by the federal copyright statutes, with special emphasis on the question of whether state or federal law is to be applied to the common-law claim in such actions.

Copyright law may be said to have existed in some form or another since man first learned to communicate by reproducible means.[1] It was not until the advent of printing and

[1] An interesting account of the historical background of present copyright law may be found in the first chapter of WITTENBERG, THE LAW OF LITERARY PROPERTY (1957).

other techniques of mass reproduction, however, that the subject commanded serious and widespread attention. According to the majority opinion of the U.S. Supreme Court in reviewing the famous copyright litigation involving the literary works of Mr. Holmes, Sr., the author's right under English law to exercise exclusive control over publication of his works finds its embryonic stages in "certain decrees of the Star Chamber promulgated in 1556, 1585, 1623 and 1637." [2]

Although one would hesitate to seek judicial precedents in the pronouncements of that particular "common-law" court, the idea seems to have taken hold, and Parliament was moved, in the eighth year of the reign of Queen Anne, to provide a statutory basis for the protection of authors' rights.[3] It appears, however, that the English courts had some difficulty in reaching an accord on the question of how the statute affected the rather ill-defined common-law rights which an author had previously enjoyed (or sought to enjoy, as his respective case may have held). In the landmark case of *Donaldson v. Becket*,[4] decided more than sixty years after the enactment of the first copyright statute, among the five questions answered directly by their Lordships were the following:

4. "Whether the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity by the common law." This question was decided in the affirmative by a seven to four vote of the eleven participating judges.

5. "Whether this right is in any way impeached, restrained or taken away by the Statute 8 Anne." By the slim majority of six to five, the judges decided that it was.[5]

[2] Holmes v. Hurst, 174 U.S. 82, 85 (1899).

[3] 8 Anne c. 19 (1709). In its early development this statute was amended by statute of George III and again by statute of Victoria.

[4] 4 Burr. 2408, 98 Eng. Rep. 257, 2 Brown Parl. Cas. 129, 1 Eng. Rep. 837 (H.L. 1774).

[5] The tie-breaking vote was cast by the Lord Chief Justice. Thanks to Burrow's thorough job of reporting, we are informed that on the day decisions were rendered Justice Blackstone was confined to his room with the gout. This leads us to ponder idly whether the entire concept of copyright law would be different today had he not been so afflicted.

The eventual effect of this decision was that the writings subject to protection by the statute [6] were the exclusive property of the creator so long as he did not give them general publication, this right still being known as "common-law copyright." From the time of publication on, however, he is limited to the remedies provided by the statute in seeking redress against those who copy the work without his permission.

The English law of copyright, at least up to the stage of development outlined above, has been largely emulated in the United States. Direct constitutional authority is provided for the enactment of appropriate copyright legislation by Congress.[7] No time was wasted by Congress in acting on this authority, the first U.S. copyright statute being enacted in 1790.[8] Decisions of the U.S. Supreme Court have also adopted the view that the statutes "impeached, restrained" or otherwise limited an author's common-law copyright in much the same manner as the English decisions.[9] Although there are many who maintain that another general overhaul of the U.S. copyright statutes is long overdue,[10] it is not my purpose here to comment upon the adequacy of the statutes, but rather to recognize the rights granted thereby for purposes of comparison rather than criticism.

Aside from performance rights and the right to make new versions of literary, dramatic, and musical works, the basic right of a copyright owner under the present U.S. Copyright Act is the exclusive right "to print, reprint, publish, copy, and vend the copyrighted work." [11] Classes or types of works sub-

[6] For a thorough analysis of what constitutes a "writing" within the meaning of the U.S. Copyright Act, see Note, 31 N.Y.U.L. Rev. 1363 (1956).

[7] U.S. Const., art. I, § 8.

[8] Act of May 31, 1790, ch. 15, 1 Stat. 124. The first statute has undergone three general revisions—in 1831, 1870, and 1909. The present Copyright Act is embodied in Title 17 of the U.S. Code.

[9] Wheaton v. Peters, 33 U.S. (8 Pet.) 592 (1834); Holmes v. Hurst, *supra* note 2.

[10] See, *e.g.*, House Comm. on the Judiciary, 87th Cong., 1st Sess., Copyright Law Revision (Comm. Print 1961).

[11] 17 U.S.C. § 1 (a) (1958).

ject to copyright have been specified in each of the copyright statutes; the list has grown from maps, charts, and books in the original 1790 statute to a list of thirteen classes of copyrightable works in the present statute.[12] Although this list is presumably provided merely as an aid in classifying copyright registrations, "all works that have been held copyrightable under the statute can be fitted into the classes enumerated in section 5." [13] Since a copyright owner who has complied with the applicable portions of the statute has the exclusive right to copy, a cause of action accrues under the statute as soon as a copy is made without the permission of the owner. However, the copying is often only the first step in a commercial scheme which also includes the sale or other commercial use of the copied material for profit; in some cases this unauthorized use may provide the copyright owner with another ground for recovery, commonly termed "unfair competition."

The legal concept of unfair competition, in its modern development, is a relative newcomer as compared with copyright law. In one of the most authoritative works on the subject, we are told that "very few cases dealing with the question were decided in England or America prior to 1850." [14] Perhaps because of the fact that the right of action for unfair competition may be considered to be in a relatively early stage of development, the principles laid down by the various courts are far from uniform. Some cases, for example, held that no cause of action is stated unless it is alleged that the defendant has attempted to masquerade his own goods as those of the plaintiff, or vice versa.[15] Other cases allow recovery in actions characterized by the court as "unfair competition" without proof of deception.[16]

[12] 17 U.S.C. § 5 (1958). [13] *Supra*, note 10, at 10.

[14] Nims, Unfair Competition and Trade Marks 6 (4th ed., 1947).

[15] Everett Piano Co. v. Maus, 200 Fed. 718 (6th Cir. 1912); Edward Hilker Mop Co. v. United States Mop Co., 191 Fed. 613, 618 (6th Cir. 1911).

[16] *E.g.*, Witkop & Holmes Co. v. Atlantic & Pac. Tea Co., 69 Misc. 90, 124 N.Y. Supp. 956, (Sup. Ct. 1910) (opinion by Judge Pound).

Judge Hough offered an all-embracing definition by saying that unfair competition "consists in selling goods by means which shock judicial sensibilities." [17] This is in marked contrast to an English case decided only twenty-five years earlier wherein Lord Justice Fry said, "To draw a line between fair and unfair competition, between what is reasonable and unreasonable, passes the power of the Court." [18] The Lord Justice added, however, that he did not doubt that interference with another's trade by fraud or misrepresentation was actionable, apparently wishing to avoid the use of the term "unfair competition" as a basis for recovery. Under whatever name it travels, however, and irrespective of the disputes which still rage over the extent of its ever-expanding boundaries, that branch of the law which seeks to promote honest and fair trading and to protect the rights of the purchasing public is here, along with the horseless carriage, to stay.

THE INEVITABLE OVERLAPPING OF TWO RELATED AND EXPANDING FIELDS OF LAW

One branch of the law of unfair competition is concerned with simulation or copying of certain (usually "nonfunctional") features of the goods of a competitor or of an entire article of manufacture. Since "works of art" may comprise the subject matter of a copyright even though intended for mass production,[19] an obvious example of a possible plurality of remedies arising from a single fact situation is thus provided. Although unfair competition situations may arise with regard to virtually any copyrighted work, the area of product simulation illustrates the overlapping of the two fields. In a recent article on the subject, we are told that the "field of unfair competition in which a plaintiff may have recourse to the

[17] Margarete Steiff, Inc. v. Bing, 215 Fed. 204, 206 (S.D.N.Y. 1914). This is followed by the remark "and the Second Circuit has long been very sensitive."
[18] Mogul S.S. Co. v. McGregor, Gow & Co., 23 Q.B. 598, 625 (1889).
[19] Mazer v. Stein, 347 U.S. 201 (1954).

law of product simulation is one in which an alternate or concurrent cause of action under the copyright law . . . may also be present." [20]

As is generally the case in some other areas of unfair competition, the exact circumstances or amount and nature of the proof required to maintain an action for product simulation are not entirely clear.[21] The "true rule" according to Nims [22] is that laid down by Knowlton, C.J., in the Massachusetts case of *George G. Fox Co. v. Glynn.*[23] This rule, in substance, holds that a distinctive configuration or "get-up" of a particular article, evidently devised by a dealer to distinguish the article from those of his competitors, imposes a duty on the competitors to conduct their business so as "not to unreasonably and unnecessarily interfere with the plaintiff's business through deception to the public." Thus, the test is whether or not the public has been or is likely to be deceived by the copying of the article with proximately resulting harm to the plaintiff's business. This test obviously may be applied in a given situation irrespective of any statutory copyright which may or may not exist in the article.

The overlap of copyright and unfair competition rights in the area of product simulation is substantial in view of the fact that the copied item is normally sold and the sale is likely to result in deception, or at least confusion, of the purchasing public and in "unreasonable interference" with the plaintiff's business. The right to prevent unauthorized copying per se is based on federal statutes, while the right to prevent or recover damages for the unfairly competing sale of the copies is a common-law right which is generally assumed to owe its exist-

[20] Jackson, *Unfair Competition by Product Simulation v. Copyright Protection for Designs*, 45 J. PAT. OFF. SOC'Y. 422 (1963).

[21] See, *e.g.*, Pollack, *Unfair Trading by Product Simulation: Rule or Rankle*, 52 TRADEMARK REP. 517 (1962).

[22] NIMS, UNFAIR COMPETITION AND TRADE MARKS 375 (3d ed. 1936).

[23] 191 Mass. 344, 78 N.E. 89 (1906).

ence to the respective states. This dichotomy of sovereign origin of the two fields of law has done little to help the problem of finding a compatible application of the two doctrines.

Acceptance of the view that an unauthorized copying could give rise to an action under a federal statute and that a sale of the copies could infringe common-law rights immediately raised jurisdictional questions. While exclusive jurisdiction over the action arising under the copyright, as well as the patent and trademark laws, was reserved to the federal district courts,[24] the common-law cause presumably could not be heard in the federal court unless the parties were citizens of different states.[25] The question was not unique to the field of unfair competition and related federal laws, but arose repeatedly in the federal courts where a nonfederal count or cause was joined with any more or less related federal cause.[26]

JOINDER OF COPYRIGHT AND UNFAIR COMPETITION COUNTS IN SINGLE ACTION [27]

The federal courts, particularly those of the Second Circuit, at one time held firmly to the position that they were without

[24] The present jurisdictional statute is 28 U.S.C. 1338(a) (1958): "The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases." See note 36 *infra*, for subsection (b) of this statute.

[25] Palmer v. Dewitt, 47 N.Y. 532 (1872).

[26] *E.g.*, Louisville & N. R. Co. v. Garrett, 231 U.S. 298 (1913); Lincoln Gas & Elec. Light Co. v. Lincoln, 250 U.S. 256 (1919); Siler v. Louisville & N. R. Co., 213 U.S. 175 (1909).

[27] In discussing the matter of unfair competition in the federal courts, a broader perspective may be gained by considering it in connection with the patent and trademark, as well as the copyright laws. Although these three branches of law are sometimes lumped together and comparisons for which no valid basis exists are drawn, the subject at hand lends itself well to such treatment since it is concerned mainly with procedural aspects. It is therefore to be understood that the trademark-unfair competition and patent-unfair competition cases which are considered hereinafter may be applied in the same manner to the field of copyright-unfair competition in the areas with which this article is concerned.

authority to decide any unfair competition claim on the merits merely because it happened to be joined with a claim arising under federal statutes.[28] For example, in a 1915 decision,[29] after finding infringement of the plaintiff's federally registered trademark, the court ends with the summary statement that the part of the complaint alleging unfair trading was properly dismissed by the district court, since the parties were not citizens of different states. The opposite result was reached some twelve years later in a Sixth Circuit case [30] involving substantially the same facts. Although the court of appeals agreed that the plaintiff was not entitled to relief for trademark infringement, they reversed the district court's ruling on the unfair competition count and allowed recovery. Again in 1932, however, the "Second Circuit rule," as it had now become known, was restated in the Southern District of New York.[31] The court ruled that it was without jurisdiction to determine the unfair competition count before even considering the count for violation of a trademark registered under federal statutes.[32]

The same result was reached for a second time in the same year by the same court in the case of *Hurn v. Oursler.* The plaintiff had alleged both copyright infringement and unfair competition, but the court refused to consider the latter count since there was no diversity of citizenship. When this decision was affirmed, per curiam, in the Second Circuit Court of Ap-

[28] This does not mean that the view was not shared by other federal courts. In fact, Supreme Court decisions such as A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co., 201 U.S. 166 (1906), and Elgin Nat'l Watch Co. v. Illinois Watch Case Co., 179 U.S. 665 (1901), indicate that a federal court could not entertain nonfederal claims, unless the plaintiff had proved a right to recover on federal grounds.

[29] Planten v. Gedney, 224 Fed. 382 (2d Cir. 1915).

[30] Vogue Co. v. Vogue Hat Co., 12 F.2d 991 (6th Cir. 1926). It is interesting to note that both plaintiff and defendant in this case were New York corporations, although it is not readily apparent that the purpose of instituting suit in Ohio was to avoid the "Second Circuit rule."

[31] Recamier Mfg. Co. v. Harriet Hubbard Ayer, Inc., 59 F.2d 802 (S.D.N.Y. 1932).

[32] 15 U.S.C. §§ 1052–1127 (1958) is the present Trademark Act.

peals,[33] the question was considered ripe for review by the Supreme Court. In a comprehensive decision[34] which considered the force and effect of many of the previous conflicting decisions in this area, the Court ruled that when two grounds, one federal and the other nonfederal, were advanced in support of a single cause of action, the federal courts had jurisdiction to consider both grounds on the merits whether or not the federal ground was established. The Court added the qualification that, although it is not a prerequisite to the authority of the Court to decide the nonfederal question that the plaintiff recover on the federal ground, it must appear that such ground is one of substance and not merely a hollow allegation which might be made solely for the purpose of getting into the federal court. It appeared to the Court that prior decisions clearly indicated that federal courts had the authority to decide state questions in cases involving, for example, both the federal Constitution and a state or local law. Even the Supreme Court had apparently made an exception to this general rule in cases involving patents, trademarks, and copyrights, but it was held in the *Hurn* case that "we perceive no sufficient reason for the exception suggested."[35]

The *Hurn* case specifically upheld the authority of the federal courts to decide nonfederal questions in cases involving a substantial claim for copyright infringement, even though the plaintiff was not entitled to recover for the infringement. The distinction made, and perhaps the most important question decided, was that a claim for copyright infringement and a claim for unfair competition arising from the same set of facts constituted a single cause of action. If a nonfederal count alleged in the same complaint with a federal count constituted not a second ground for recovery in a single cause of action,

[33] Hurn v. Oursler, 61 F.2d 1031 (2d Cir. 1932) (mem.).

[34] Hurn v. Oursler, 289 U.S. 238 (1933). A footnote to the decision, at 289 U.S. 241, provides a brief but thorough delineation of the plethora of conflicting views expressed on the subject by various federal courts up to that time.

[35] 289 U.S. 238, 245.

but rather a totally distinct cause of action, then the federal court was without jurisdiction (again, in the absence of diversity) to determine the nonfederal cause.

In 1948 Congress amended Title 28 of the U.S. Code to give statutory authority to the jurisdiction of the federal courts over civil claims of unfair competition joined in the same action with a claim under the federal copyright, patent, or trademark laws.[36] Although the question is still raised from time to time, it is now generally accepted, even in the Second Circuit,[37] that a federal court may dispose on the merits of a claim for unfair competition where the complaint alleges a not clearly unsubstantial claim of copyright, patent, or trademark infringement.

It is thus established by statutes and judicial decisions that a copyright proprietor does not, by virtue of seeking statutory protection, sacrifice his common-law rights against one who unfairly competes by (among other things) copying the protected material. Furthermore, it is established that the claim for recovery on the ground of unfair competition may be joined in the same action with a claim for recovery based on rights secured by the Copyright Act and the federal courts have jurisdiction to hear and dispose of both claims on the merits, even though the plaintiff does not establish his right to recover under the federal statute. In individual cases disputes may still arise, for example, as to whether a particular set of facts constitutes "a substantial and related claim" within the meaning of the statute, or whether the plaintiff's claims are in fact for two separate and distinct causes of action. However, these are normally fact questions to be determined in the usual

[36] 28 U.S.C. § 1338(b) (1958): "The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trademark laws."

[37] See, *e.g.*, the more recent Second Circuit decision in the cases of Nikanov v. Simon & Schuster, Inc., 246 F.2d 501 (2d Cir. 1957). See also Remington Research, Inc. v. Modern Aids, Inc., 170 F. Supp. 7 (S.D.N.Y. 1959).

manner, and once they have been resolved there is a sound legal basis on which to proceed.

Although this might appear to put an end to the matter, there is yet another question which deserves serious consideration and which is not nearly so well settled as those previously discussed. This is the question of which law should be applied by the federal courts with respect to the unfair competition claim in actions wherein jurisdiction is based on 28 U.S.C. 1338(b). At first glance, this question may also appear to be one of those well settled by unmistakable weight of authority. A closer look, however, gives rise to second thoughts on the matter, and a more detailed analysis may lead to the conviction that a truly definitive position has yet to be reached.

APPLICATION OF LAW BY FEDERAL COURTS IN UNFAIR COMPETITION COUNTS

One of the first statutes passed by Congress was intended to guide the federal courts in the application of state laws in cases wherein the latter arose. Enacted in the year preceding passage of the first U.S. copyright statute, the Rules of Decision Act [38] provided:

> The laws of the several states, except where the Constitution, treaties or statutes of the United States otherwise require or provide, shall be regarded as rules of decision in trials at common law, in the courts of the United States, in cases where they apply.

The interpretation of this law by the federal courts was for many years the doctrine enunciated in *Swift v. Tyson.*[39] This case held that "laws of the several States" meant "the rules and enactments promulgated by the legislative authority thereof, or long established local customs having the force of laws." [40] Under this doctrine the federal courts were free to apply their own law in matters founded upon common law or

[38] Act of Sept. 24, 1789, ch. 20, § 34, 1 Stat. 92. This statute is still in effect with only slight changes in phraseology (28 U.S.C. § 1652).

[39] 41 U.S. (16 Pet.) 1 (1842). [40] *Id.* at 18.

judicial rules rather than upon state or local statutes. Mr. Justice Holmes pointed out what he considered to be the basic fallacy of this position in a dissenting opinion.[41] In Holmes's view, there is no body of law to be applied in common-law actions except that which arises by virtue of the development of such law within and by the courts of the respective states. If there were a body of common law outside the states, Holmes observed, the federal courts might properly interpret it as they see fit, but since there is not they should be bound to apply the law as expressed by judicial decisions of the state courts, wherein such law arises.

Following Holmes's dissent, the doctrine of *Swift v. Tyson* was widely criticized and finally was expressly overruled in the case of *Erie R. Co. v. Tompkins*,[42] which forms the basis of the present doctrine. The Court's opinion in the *Erie* case, as expressed by Mr. Justice Brandeis, adopted Holmes's view that the application of "general law" by the federal courts was an invasion of rights which the Constitution reserved to the states. The Court took the flat position that "there is no federal general common law," [43] making it obligatory for the federal courts to look to the common law of the state or states concerned when considering a matter arising thereunder. Over the past twenty-five years the *Erie* doctrine has been applied countless number of times and has naturally produced a great deal of comment.[44] Although anything more than a cursory comment on the doctrine is beyond the scope of this essay, a few observations are necessary before proceeding further.

One of the leading casebooks in the conflict of laws field [45]

[41] Black & White Taxicab & Transfer Co. v. Brown & Yellow Taxicab Co., 276 U.S. 518, 532 (1928).

[42] Erie R. Co. v. Tompkins, 304 U.S. 64 (1938). [43] *Id.* at 78.

[44] *E.g.*, Tunks, *Categorization and Federalism: "Substance" and "Procedure" After Erie R. v. Tompkins*, 34 Ill. L. Rev. 271 (1939); Hill, *The Erie Doctrine and the Constitution*, 53 Nw. U.L. Rev. 427 (1958); Jessup, *The Doctrine of Erie R. v. Tompkins Applied to International Law*, 33 Am. J. Int'l L. 740 (1939); Breckenridge, *The Federal Rules and the Tompkins Case*, 10 Duke B.A.J. 20 (1942). See also 36 Ill. L. Rev. 493 (1942); 52 Harv. L. Rev. 1002 (1939); 9 U. Chi. L. Rev. 113 (1941).

[45] Stumberg, Cases on the Conflict of Laws (1956).

says with regard to *Erie*, "the doctrine with its implications has been confined to diversity cases." [46] The majority of cases in which state law is in issue are undoubtedly those wherein federal jurisdiction is based on diversity of citizenship.[47] However, since the *Hurn* case,[48] and even before, federal courts have been deciding unfair competition counts with jurisdiction based on the fact that such counts are related to a substantial count arising under federal statutes. Since it has been determined that federal jurisdiction over unfair competition counts may be predicated upon their relationships to federal statutory counts, the question arises of whether the same relationship makes it permissible (or even, perhaps, mandatory) for federal law to be applied to such unfair competition counts. Some courts when faced with this question have held that the *Erie* doctrine applies to make state law controlling; others have held that federal law should be applied, while in a number of such cases the decision is written without reference to the law being applied.[49]

The case of *Capitol Records, Inc. v. Mercury Records Corp.*[50] is often discussed in connection with the question of applicable law. After deciding that a performer's rendition of a public-domain musical work could not be protected under the Copyright Act, the majority opinion in the *Capitol Records* case held that there was no basis for applying federal law. Even though jurisdiction was based solely on diversity of citizenship and the claim for recovery was not based upon a substantial and related claim under the copyright laws, the court still considered at length the question of applicable law. The decision may be taken to mean that a federal law would have

[46] *Id.* at 282. *Cf.* Sedler, *The Erie Outcome Test as a Guide to Substance and Procedure in the Conflict of Laws*, 37 N.Y.U.L. Rev. 813 (1962). "In other areas . . . (aside from diversity cases) where reference is made to state law, the courts were more likely to look to the state decisions even before Erie." *Id.* at 819.

[47] 28 U.S.C. § 1332. [48] Hurn v. Oursler, *supra* note 34.

[49] It is possible that the conflicting theories of unfair competition law within, as well as among, the various jurisdictions are considered by some courts to render the question of controlling law moot in certain borderline situations.

[50] 221 F.2d 657 (2d Cir. 1955).

been applied only if recovery could be based upon some provision of the Copyright Act; it may also mean that a federal law would have been applied to what Professor Kaplan characterizes as "a kind of stray of common-law copyright and unfair competition" [51] if the latter was found to be related to a claim for recovery under the Copyright Act. At any rate, the court considered the law of New York to be controlling "under the supposed compulsion of the *Erie* doctrine." [52] It is interesting to note, however, that when the court sought the applicable New York law on the subject at hand they found a "complete dearth of authority" and proceeded to a "decision upon principle." The decision was ostensibly based upon what the court thought the New York law might have been, however, and not upon their conception of federal law on the subject.

Two prior cases [53] (both decided after *Erie*) were considered at length in the *Capitol Records* case, especially in Judge Hand's dissent, relating to the question of applicable law. Judge Hand had written the majority opinion in both of these cases, and the decisions seem to be based largely on an application of federal law in a rather negative manner. That is, since the relief sought in the *RCA* case [54] would have established what the court considered to be exclusive rights in the nature of a statutory copyright, and since the subject matter (phonograph recordings of orchestral renditions) was not copyrightable under the statute, the court held that no remedy was available. The decision recognizes that the law of Pennsylvania, on the basis of a decision of the Supreme Court of that state,[55] would have permitted the action to be maintained, and

[51] Kaplan, *Performer's Right & Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 410 (1956).

[52] *Id.* at 415. This remark implies that in Professor Kaplan's opinion the court need not have applied state law under the *Erie* doctrine even though no substantial and related claim under the copyright laws was presented and jurisdiction was based on diversity of citizenship.

[53] RCA Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir. 1940), *Cert. denied*, 311 U.S. 712 (1940); Fashion Originator's Guild of America, Inc., v. FTC, 114 F.2d 80 (2d Cir. 1940), *aff'd*, 312 U.S. 457 (1941).

[54] *Supra* note 53.

[55] Waring v. WDAS Broadcasting Co., 327 Pa. 433, 194 Atl. 631 (1937).

states that an injunction in the case at bar would have been granted to prevent broadcasting into the state of Pennsylvania if it were technically possible to enforce. The opinion goes on, "we have of course given the most respectful consideration to the conclusions of that great court, but with much regret we find ourselves unconvinced for the reasons we have tried to state." [56] Judging from this comment, if the federal court had been persuaded by the Pennsylvania court's reasoning, it would have felt free to apply that law in the *RCA* case. This clearly indicates that the court did not consider itself bound to apply the state law of New York, wherein the action arose, but could apply its own law, looking to both state and federal decisions for guidance. On the other hand, the ruling that broadcasts received in Pennsylvania would be enjoined, if possible, on the basis of Pennsylvania law, implies that such would be the case in any state whose law conformed to that of Pennsylvania on this subject, thus making state law controlling. The *RCA* case, therefore, appears to straddle the issue of applicable law, but since it does not aver to address itself squarely to the question, any attempt to interpret the opinion as expressing a preference for either state or federal law may be begging the question.

The *Fashion Originator's* case,[57] similar in many respects to *RCA*, was decided just three days before the opinion in the latter case was handed down. In holding uncopyrighted dress designs to be unprotected against copying, in exactly the same way as the recordings of a musical performance in the *RCA* case, the court was applying federal law, but not in a way dispositive of the question at hand. That is, the extent of copyright protection and the nature of copyrightable subject matter are determined by federal statutes and federal decisions interpreting these statutes. Since the *Fashion Originator's* case arose under the Federal Trade Commission Act,[58] it is evident that the alleged wrongful acts took place in interstate com-

[56] 114 F.2d at 89. [57] *Supra* note 53.
[58] 15 U.S.C. §§ 41–77 (1958). See note 110 *infra*, and accompanying text.

merce in a field preempted by federal legislation. Therefore, this case, although frequently cited in discussions involving the applicability of federal or state law, is only indirectly concerned with the problem, if at all. In fact, in both the *RCA* and *Fashion Originator's* cases, the court was not making a deliberate choice between federal and state law since, as Judge Hand points out in his *Capitol Records* dissent, "we had no reason to anticipate that the law of New York would take a different view." [59]

The Supreme Court, in affirming the decision of the Court of Appeals in the *Fashion Originator's* case,[60] made a rare reference to the question of the applicable law in this field. The defendant-appellant attempted to explain the unlawful combination of which it had been accused by the FTC, on the grounds that the systematic copying of dress designs by those against whom the combination was directed was a tortious act, constituting or akin to unfair competition. The Supreme Court held that "whether or not given conduct is tortious is a question of state law, under our decision in *Erie R. Co. v. Tompkins*. . . . [But] even if copying were an acknowledged tort under the law of every state, that situation would not justify petitioners in combining together to regulate and restrain interstate commerce in violation of federal law." [61] It must be remembered, however, that the unfair competition advanced as a defense in this case was not related to a claim arising under the copyright laws. Thus, Kaplan was led to remark that "the Supreme Court in this case did not foreclose the question of applicable law." [62]

A quite thorough discussion of the question is found in a footnote to the decision in the trademark-unfair competition case of *Maternally Yours, Inc., v. Your Maternity Shop, Inc.*[63] The court makes several interesting observations with regard

[59] 221 F.2d at 666. See note 49 *supra*.
[60] Fashion Originator's Guild of America, Inc. v. FTC, 312 U.S. 457 (1941).
[61] *Id.* at 468. [62] Kaplan, *supra* note 51, at 419.
[63] 234 F.2d 538, 540–41 (2d Cir. 1956).

to practices in the choice of law up to that time. The prevailing view, the court says, is that state law controls common-law unfair competition on the basis of the *Erie* doctrine. Second Circuit practice, however, ran more to an application of a general composite of both federal and state law.[64] The problems of applicable law are described, however, as "usually-theoretical" and are discussed in the present case "only to indicate that we are conscious of their existence." [65]

In a more recent Second Circuit case [66] the plaintiff asked for a declaratory judgment of invalidity of defendant's patent and also alleged that the defendant had made false and malicious statements that the plaintiff had infringed, which would appear to be a form of unfair competition. Since the plaintiff's claim relating to the false and malicious statements is created, according to the court, under state and not federal law, state law should be applied. For unimpeachable authority the court cites the opinion of Mr. Justice Holmes: "But whether it is a wrong or not depends upon the law of the State where the act is done, not upon the patent law and therefore the suit arises under the law of the State." [67] The District Court recognizes, however, that "choice of law in unfair competition and defamation cases where the disparagement has been circulated in many states has often presented considerable difficulties." [68]

Although the question of whether state or federal law is to be applied to unfair competition counts in actions based on

[64] *Id.* at 540, n. 1, citing Swanson Mfg. Co. v. Feinberg-Henry Mfg. Co., 147 F.2d 500 (2d Cir. 1944).

[65] *Cf.* note 49 *supra.*

[66] Ostow & Jacobs, Inc. v. Morgan-Jones, Inc., 180 F. Supp. 38 (S.D.N.Y. 1959).

[67] American Well Works Co. v. Layne & Bowler Co., 241 U.S. 257, 260 (1916). Smith v. Kansas City Title Co., 255 U.S. 180 (1921), is cited in the instant case as a contrary opinion, but the *Smith* case appears to relate more to authority for the federal court's jurisdiction than to the applicable law.

[68] Ostow & Jacobs, Inc. v. Morgan-Jones, Inc., *supra* note 66, at 41, citing Mattox v. News Syndicate Co., 176 F.2d 897 (2d Cir. 1949); Palmisano v. News Syndicate Co., 130 F. Supp. 17 (S.D.N.Y. 1955); Dale Sys., Inc. v. Time, Inc., 116 F. Supp. 527 (D. Conn. 1953).

28 U.S.C. § 1338(b) may have been of only academic interest in the past, this is no longer the case in view of the rapidly increasing use of this jurisdictional statute and the expansion of its scope. The Second Circuit is "now committed to a broader view of pendent jurisdiction, at least in those cases involving a substantial federal question under the patent, copyright or trademark laws within 28 U.S.C.A. § 1338(b)." [69] This position was expressly endorsed by a more recent decision wherein the district court's jurisdiction over a claim for breach of contract relating to use of a trade name was upheld.[70] As the list of cases decided in this area continues to grow, the courts are more frequently forced to address themselves squarely to the question of applicable law. Regrettably, however, there appears to be no unanimity of opinion in the matter.

In a 1951 decision of the Eighth Circuit Court of Appeals [71] both plaintiff and defendant were citizens of South Dakota. The complaint alleged wrongful trademark registration and unfair competition. Jurisdiction of the federal court was based upon 15 U.S.C. §§ 1120-1121 and 28 U.S.C. § 1338(b). The question of applicable law was of pressing importance since exemplary damages could have been awarded under a state statute, but only damages consequential to the wrongful registration could be recovered under federal law. The court held that since this was not a diversity case the rights of the parties were controlled by federal and not state law. This position is quite obviously in conflict with the view expressed by the Second Circuit which would disregard the jurisdictional grounds.[72]

The disparity of thinking among the federal courts on this subject may be best illustrated by two cases, both decided in

[69] Maternally Yours, Inc. v. Your Maternity Shop, Inc., 234 F.2d 538, 544 (2d Cir. 1956).

[70] Hazel Bishop, Inc. v. Perfemme, Inc., 314 F.2d 399 (2d Cir. 1963). However, complaints are still dismissed where it is found that the federal grounds alleged are not substantial. Kaz Mfg. Co. v. Chesebrough-Pond's, Inc., 211 F. Supp. 815 (S.D.N.Y. 1962).

[71] Landstrom v. Thorpe, 189 F.2d 46 (8th Cir. 1951).

[72] See text accompanying note 77 *infra*.

1963, with results as far apart as the courts which decided them (one in New York, the other in California). In the case of *Flexitized, Inc., v. National Flexitized Corp.*,[73] the New York District Court reviewed thoroughly the position in the Second Circuit but found little in the way of helpful guidance. In fact, the court of appeals had "expressly declined to give a definitive answer" since the particular facts of the cases decided in the past [74] had not required a firm position to be taken. A couple of "suggestions" are noted, one that federal law should be applied to unfair competition claims when joined with trademark (and presumably copyright) infringement claims,[75] the other that "indeterminate general law," which may mean either a federal law or an "undifferentiated composite" of state and federal law, should be applied in such cases.[76]

After deciding that the unfair competition rights arose under state law, the court held that the *Erie* doctrine applied and New York law controlled. Although there was diversity of citizenship in this case, the court thought the *Erie* doctrine should apply to make state law applicable to the unfair competition count even if jurisdiction were based solely on 28 U.S.C. § 1338(b). As authority for this position, the court quotes from the *Maternally Yours* footnote, which states, "[I]t is the source of the right sued upon, and not the ground on which federal jurisdiction over the case is founded, which determines the governing law." [77] Judge Tyler observed, however, that "there is much to be said for applying a potentially uniform

[73] 214 F. Supp. 664 (S.D.N.Y. 1963).

[74] These include the Capitol Records (*supra* note 50), *RCA* (*supra* note 53), Fashion Originator's (*supra* note 53), Maternally Yours (*supra* note 63), and Ostow & Jacobs (*supra* note 66) cases.

[75] Authority advanced in support of this view is the separate concurring opinion of Chief Judge Clark in the Maternally Yours case. Although the majority opinion in this case leans toward the view that state law should control (see text following note 63 *supra*), Clark says that "we necessarily have now at least a partial federal law of unfair competition."

[76] Hygienic Specialties Co. v. H. G. Salzman, Inc., 302 F.2d 614, 619 n. 9 (2d Cir. 1962).

[77] *Supra* note 63, at 540–41, n. 1.

federal law of unfair competition, at least where multistate activity is involved," [78] although he felt constrained to rule otherwise. Presumably, the state law to be applied must be that where the last act necessary to establish the defendant's liability occurs. If the unfair competition is considered to be a tort, as it usually is, the completing event is injury to the plaintiff,[79] which would compel the court to apply the law of each state where injury occurred. In many cases this would place a practically impossible burden on the court and the convenient result of applying New York law all the way down the line, regardless of the place of injury, was reached in the *Flexitized* case. This is based upon authority found in New York cases,[80] and the federal court says that New York law may constitutionally be applied to extrastate torts where the defendant is a New York corporation and the acts of unfair competition were initiated there.[81]

It is also most interesting to note that the court expressly made "several invitations" to counsel for both parties to advise on the question of governing law. Both were reluctant to take a firm position although defense counsel finally did indicate in general terms his view that federal law is controlling.[82] We are thus provided with another clean-cut example of the dearth of information and lack of any satisfactory conclusion on this question, both by the courts and the practitioners.

The second recent case in which the court addresses itself

[78] *Cf.* remark to the same effect in the *Ostow & Jacobs* case, *supra* note 69.

[79] RESTATEMENT (SECOND) CONFLICT OF LAWS, § 377 (1958).

[80] *E.g.*, Keasbey v. Brooklyn Chem. Works, 142 N.Y. 467, 37 N.E. 476 (1894).

[81] This is apparently an application to the tort field of current thinking in the area of contract law. See RESTATEMENT (SECOND), CONFLICT OF LAWS, SELECTED MATERIALS FROM TENTATIVE DRAFT NO. 6, AS MODIFIED AT THE 37TH ANNUAL MEETING (1960). The law governing all matters of validity, effect, and performance is now said to be the local law of the state with which the contract has its most significant relationships, rather than the respective places of where the contract is executed and where it is performed. The unfair competition in the Flexitized case obviously had its most significant contacts in New York.

[82] 214 F. Supp. at 670, n. 9.

squarely to the question of applicable law in suits under 28 U.S.C. § 1338(b), *Bliss v. Gotham Indus., Inc.*,[83] was decided a month after the *Flexitized* case by the Ninth Circuit Court of Appeals. The action was on two counts, one for infringement of a design patent wherein jurisdiction as to both defendants was based on 28 U.S.C. § 1338(a), and the other for unfair competition wherein the complaint alleged that jurisdiction as to one defendant was based upon diversity of citizenship [28 U.S.C. § 1332(a) (1)] and as to both defendants upon 28 U.S.C. § 1338(b), the unfair competition claim being joined with the substantial and related claim under the patent laws. Plaintiffs-appellants argued on appeal that California state law should have been applied to their unfair competition claim. In support of this contention, appellants cited the *Kemart* case,[84] also decided by the Ninth Circuit Court of Appeals, which held that state law would be applied to an unfair competition claim regardless of whether it was appended to the claim arising under the patent laws or "had standing in the court below solely because of the diversity of citizenship of the parties." The court in the instant case explained that state law was applied in the *Kemart* case because diversity existed. In the present case, it was held that since only one of the two defendants was a citizen of a state other than that of the plaintiff, jurisdiction was not acquired by diversity but solely on the basis of 28 U.S.C. § 1338(b).[85] In fact, the major part of the decision dealing with the unfair competition claim is devoted to a consideration of whether or not there was diversity of citizenship, which would be a basis for federal jurisdiction in the absence of 28 U.S.C. § 1338(b). Upon finding there was no diversity the court simply stated "California law does not apply to the appellant's claim for un-

[83] 316 F.2d 848 (9th Cir. 1963).

[84] Kemart Corp. v. Printing Arts Research Lab., Inc., 269 F.2d 375 (9th Cir. 1959).

[85] Based largely on the Eighth Circuit cases of Dryden v. Dryden, 265 F.2d 870 (8th Cir. 1959), and Thomas v. Anderson, 223 Fed. 41 (8th Cir. 1915).

fair competition . . . the District Court having jurisdiction of the subject matter of this controversy by reason of the Federal statute. . . ." [86] The only authority cited in the opinion is with regard to the determination of diversity. The court apparently bases its holding that state law does not apply solely on the fact that the district court had jurisdiction by reason of the federal statute, *i.e.*, 28 U.S.C. § 1338(b), but left no doubt whatever that in its opinion federal law applied to all counts in such cases.

The position that the *Erie* doctrine does not necessarily control the choice of law in unfair competition counts which are related to federal statutory counts was not new in the *Bliss* case. A district court decision in the First Circuit had made a similar holding even before the passage of 28 U.S.C. § 1338(b). This was the *Bulova Watch* case [87] which recognized the fact that tradition was being ignored to some extent in the interests of a change in policy which was demanded by the times. Although this case was not cited in the other cases discussed previously herein as authority for the position that federal law should control, the following portion of Judge Sweeney's opinion is one of the best statements to be found in support of such a view:

> There is much authority to the effect that we are bound by the Massachusetts law.[88] My own decision in Mishawaka Rubber & Woolen Mfg. Co. v. Panther-Panco Rubber Co.,[89] followed this general rule although the question was not raised in the case. On more careful consideration, I feel that there is a strong policy in favor of interstate uniformity in the field of unfair competition. There is the dilemma between a checker-board result in the automatic application of Klaxon Co. v. Stentor Electric Mfg. Co.[90] to multistate unfair competition on

[86] 316 F.2d at 854.

[87] Bulova Watch Co. v. Stolzberg, 69 F. Supp. 543 (D. Mass. 1947).

[88] Citations of authority include Time, Inc. v. Viobin Corp., 128 F.2d 860 (7th Cir. 1942); National Fruit Prod. Co. v. Dwinell-Wright Co., 47 F. Supp. 499 (D. Mass. 1942); Folmer Graflex Corp. v. Graphic Photo Serv., 44 F. Supp. 429 (D. Mass. 1942).

[89] 55 F. Supp. 308 (D. Mass. 1944). [90] 313 U.S. 487 (1941).

the one hand, or a return, on the other, to the evils of choice of forum if local law is to govern the interstate as well as local aspects of the tort.[91]

One other recent case on this topic, although based upon a quite special set of facts, deserves some consideration. This is a case [92] which came before the U.S. Court of Claims on a charge that the federal government had violated a confidential relationship with the plaintiff and was thereby guilty of something akin to unfair competition. The court held that although the "parties seem to think that New York law controls," transactions of the United States are governed by uniform federal common law,[93] even if unfair competition is the basis for recovery. The fact that a uniform federal common law governs unfair competition by or on behalf of the federal government, whether joined with a count arising under the copyright, patent, or trademark laws or not, is thus one area in which the question is settled, apparently somewhat to the surprise of the parties in the instant case.

SUMMARY OF THE PRESENT STATE OF THE LAW AND A FEW SUGGESTIONS

Regardless of the position one takes with regard to whether state or federal law should apply to a claim for unfair competition when joined with a substantial and related claim arising under the copyright laws, it must be admitted that the question has not been satisfactorily decided. Positions taken and held

[91] 69 F. Supp. at 546.

[92] Padbloc Co. v. United States, 137 U.S.P.Q. 224 (U.S. Ct. Cl. April 5, 1963).

[93] Citations of authority on this point include United States v. Allegheny County, 322 U.S. 174, 183 (1944); S.R.A., Inc. v. Minnesota, 327 U.S. 558, 564 (1946); Kern-Limerick, Inc. v. Scurlock, 347 U.S. 110, 121–22 (1954); and United States v. Jones, 176 F.2d 278, 281 (9th Cir. 1949). In a footnote to these citations (137 U.S.P.Q. 227, n. 3), the court pointed out that in any prior decisions which indicated that state law applied the situations were distinguishable either on the grounds that general uniformity was not appropriate "or the statements in the opinions were inadvertent or unnecessary."

at the present time by various federal courts may be summarized as follows:

1. The position that state law controls, based on the premise that the *Erie* doctrine applies and that there is no such thing as a federal law of unfair competition.

2. The position that the unfair competition claim is so closely related to the infringement claim as to come within the field of copyright law where it is permissible for Congress to enact legislative relief. And, since they have not done so, no relief is available.

3. The position that federal law controls, based on the premise that the *Erie* doctrine applies to make state law controlling only when jurisdiction is based on diversity of citizenship.

The first of the above positions is typified by the recent opinion in the *Flexitized* case [94] and appears to be the established rule in the Second Circuit. It is also the rule, at the present time, in the Seventh Circuit, wherein two cases involving design patents and unfair competition were recently decided. In the first of these cases [95] the court states, with regard to the unfair competition count, "It is not contested that Illinois law governs the case before us," and in the second,[96] "Under Illinois law, which governs here. . . ." In neither case did the court indicate that it felt there was the slightest possibility that anything but state law could apply. The Supreme Court has granted certiorari in both of these cases and may be expected to shed some light on the question of applicable law in the forthcoming decision.[97]

[94] *Supra* note 73.

[95] Day-Brite Lighting, Inc. v. Compco Corp., 311 F.2d 26 (7th Cir.), *cert. granted*, 374 U.S. 825 (1963).

[96] Stiffel Co. v. Sears, Roebuck & Co., 313 F.2d 115 (7th Cir. 1963).

[97] The following notice appeared on p. 27 of the New York Times of Tuesday, June 18, 1963: The Supreme Court "agreed to decide whether the owner of a design patent found invalid may invoke Illinois law and obtain a permanent injunction against sale of a similar product on the ground that it is in unfair competition with his [Nos. 1010, Compco Corp. v. Day-Brite Lighting, and 1020, Sears-Roebuck v. Stiffel Co.]."

The second-mentioned position taken by the courts when faced with a choice of law problem is best set forth in Judge Hand's opinions in such cases as *RCA*, *Fashion Originator's*, and the dissent in *Capitol Records*,[98] sometimes referred to as the "limited Times" doctrine. In this view, the constitutional provision empowering Congress to enact legislation securing to authors the exclusive right to their writings "for limited Times" [99] prohibits the application of any law other than federally enacted statutes to prevent copying or other acts in the nature of copyright infringement. Although under most, if not all, theories of unfair competition more than mere copying must be shown in order to maintain the action, the result is in the nature of a recognized right in the plaintiff to prevent others from copying and selling his material. This view is no longer as popular as it once was (as witness the fact that Hand was in the minority in the *Capitol Records* case), but it is not as dead as some might think. For example, in the petition for certiorari in the *Compco* case, which has been granted, it is urged that by electing to acquire a federal cause of action (patent or copyright) all common-law rights of action, including unfair competition, are rejected, and a plaintiff should not be allowed to turn to a common-law cause of action when it is found that he cannot recover under his federal statutory rights.[100] This position would thus hold that neither a state nor a federal common law of unfair competition would be applicable to secure rights which could be created by federal statutes under constitutional authority, on the grounds that such would be a usurpation by the courts of legislative prerogative.

The third position of those mentioned is apparently the rule in the Eighth and Ninth Circuits, and possibly the First. The opinions in the Eighth Circuit case of *Landstrom v. Thorpe* [101]

[98] *Supra* notes 53 and 50. [99] *Supra* note 7.

[100] Petition for Writ of Certiorari to the U.S. Court of Appeals for the Seventh Circuit, Compco Corporation, Petitioner v. Day-Brite Lighting, Inc., Respondent, October Term, 1962, No. 1010 (filed April 11, 1963).

[101] *Supra* note 71.

and the Ninth Circuit case of *Bliss v. Gotham Indus.*[102] state flatly that both of these courts consider the *Erie* doctrine applicable to make state law controlling only where federal jurisdiction is based upon diversity of citizenship. The Ninth Circuit indicated that if there was in fact diversity of citizenship then state law should control whether or not jurisdiction could also be predicated upon 28 U.S.C. § 1338(b), while no such decision was called for from the Eighth Circuit. Although the same result was reached in the *Bulova Watch* case,[103] the decision was based more on the dictates of sound policy than on technical distinctions.

It is thus evident that the federal courts are following their own respective views with regard to the matter of applicable law. Not only is there no uniform federal law of unfair competition to be applied by federal courts, but it cannot always be known which state law, if any, will be applied.

In reviewing the current thinking on this question, it seems apparent that there is a large measure of agreement that a uniform federal law would be desirable. Chief among the reasons for this is the present state of development of commerce. The enormous increase in the volume of interstate commerce has brought about necessary changes in all branches of the law having any relation to commerce, including the concept of unfair competition. Ease of travel, communications, and transportation of goods have shrunk the importance of state boundaries to the point that it is no longer practical or reasonable to apply rules of law which were dictated by entirely different conditions. Actions for unfair competition wherein the most substantial damages are involved are associated with a commercial situation which extends to every corner of the country. To apply the unfair competition law of each state wherein a transaction took place would, for all intents and purposes, be impossible, and to choose one state whose law is to be applied to the entire matter is often inequitable.

[102] *Supra* note 83. [103] See notes 87–91 *supra*, and accompanying text.

In discussing the question of the law applicable to an unfair competition claim when joined with a claim arising under federal statutes, authorities such as Callman have said, "It certainly seems more consonant with logic and more expeditious to apply federal law to both the federal and non-federal question in the same suit than to resort to different sources of law in deciding the several issues." [104] A number of articles and comments by other legal writers dating back some twenty years were similarly oriented.[105] A more recent article, directed specifically to the application of unfair competition principles in the copyright field, observes, "The nature of unfair competition must be clarified if the principles of unfair competition are to be used effectively as a supplement to copyright." [106] Such a task would indeed appear hopeless if federal court decisions in this field are to be bound by the conflicting views of the various state courts.

In the *Flexitized* case [107] the desirability of a federal law of unfair competition was noted, but the application, if not the existence, of such was rejected on the basis of prior authority and "the conceptual and practical difficulties of such a doctrine." Since the question was so carefully and thoroughly discussed in this decision, as previously noted, perhaps a consideration of the authority advanced in support of the application of state law and the difficulties posed by the application of federal law will prove helpful in substantiating the proposition that federal law should be applied.

The foundation of the authority for holding state law applicable is the *Erie* doctrine, in view of such related comments

[104] 4 CALLMAN, UNFAIR COMPETITION AND TRADEMARKS 1955–56 (2d ed. 1950).

[105] *E.g.*, Zlinkoff, *Monopoly Versus Competition* 53 YALE L.J. 514, 542 (1944); Zlinkoff, *Erie v. Tompkins: In Relation to the Law of Trademarks and Unfair Competition*, 42 COLUM. L. REV. 955, 988 (1942); and see 32 TRADEMARK REP. 131 (1942).

[106] Feldman, *The Relationship Between Copyright and Unfair Competition Principles*, 31 TUL. L. REV. 523 (1957).

[107] *Supra* note 73.

as those in *Maternally Yours;*[108] that is, state law is considered applicable to any claim finding its source in state law without regard to the ground for federal jurisdiction. While this reasoning would certainly appear preferable to a blind holding that the *Erie* doctrine applies only where federal jurisdiction is based upon diversity of citizenship, it is seriously disputed whether a claim for unfair competition which is so closely related to a claim for copyright infringement as to form a part of the same cause of action has its source in state law. It is undeniable that the concept of unfair competition was born and raised at common law, but this should not operate as a permanent bar to the development and application of federal principles to be applied in cases where the unfair competition proximately flows from a commercial situation involving at least a substantial possibility of copyright infringement. The choice of applicable law, here as in the *Erie* case, rests largely on policy considerations in an attempt to make the law best suit the needs and conditions of the times. As aptly pointed out by Judge Sweeney,[109] the federal courts are under no compulsion to apply state law in situations such as the *Flexitized* case, where sound policy dictates the opposite, and this is not in conflict with the *Erie* doctrine.

The difficulties of a federal law doctrine in this regard, posed in the *Flexitized* case, may be summarized as follows:

1. There is a serious question as to the existence of a federal law of unfair competition.

2. If there is a federal law of unfair competition there is still doubt as to the circumstances under which it is applicable.

3. If there is such a law and it is to be applied in all cases wherein federal jurisdiction is or may be based upon 28 U.S.C. § 1338(b), cases involving common-law copyright and trademarks would be excluded while some cases involving only intrastate acts of unfair competition would be included.

4. In any event, there would still remain the question of

[108] *Supra* note 63. [109] 69 F. Supp. at 546.

whether such a federal law should replace or be conjunctive with state unfair competition law.

The first of these problems has been dealt with previously. There is certainly ample basis for positing the existence of a federal law of unfair competition on policy grounds and the only thing standing in the way of the existence of such a law in any federal court is an express acknowledgment by that court of such existence. The mischief sought to be prevented by the *Erie* doctrine was the assumption by the federal courts of "the power to declare rules of decision which Congress was confessedly without power to enact as statutes." [110] That Congress may legislate in the unfair competition field, at least where interstate commerce is involved, is demonstrated quite frequently. The Fair Trade Commission Act [111] makes unlawful all "unfair methods of competition in commerce." Civil remedies for persons damaged by unfair commercial activities in or affecting commerce would be provided by a bill [112] introduced in the Senate on March 7, 1963. A federal statute for the protection of designs, an area which was previously within the exclusive scope of "common-law" unfair competition, was passed by the Senate on July 23, 1962.[113] It is therefore quite apparent that decisions by federal courts in this area were not intended to be limited by the *Erie* doctrine.

As to the second of the "difficulties," a federal law of unfair competition should certainly be applied in cases wherein the claim for unfair competition is joined with a claim arising under the copyright, patent, and trademark statutes and related so closely thereto as to form a part of a single cause of action. Such a law would therefore be applied in all cases where jurisdiction could be based upon 28 U.S.C. § 1338(b)

[110] Erie R. Co. v. Tompkins, 304 U.S. 64, 72 (1938).

[111] 15 U.S.C. §§ 41–77 (1958) (also called the McCarron Act).

[112] S. 1038, 88th Cong., 1st Sess. (1963).

[113] S. 1884, 88th Cong., 1st Sess. (1964). Hearings on this bill were conducted on August 15, 16, and 17, 1961. Support was enthusiastic and reflected the view that unfair competition remedies in the design field under state common law were totally inadequate.

whether or not diversity of citizenship is also present. Although it appears that ample grounds exist for the application of a federal law of unfair competition in all actions therefore before the federal courts, at least where interstate commerce is involved, no position is taken here with regard to expanding the doctrine beyond cases wherein the claim is linked to, *e.g.*, a claim for copyright infringement.

Since state law is presently applied to common-law copyright and trademarks and federal law to copyrights and trademarks registered under federal statutes, no inconsistency is seen in applying state unfair competition law to claims related to the former and a uniform federal law of unfair competition to substantial and related claims arising under the latter. Whether federal law should be expanded to include within its scope common-law copyright and trademarks is not considered here. The fact that a claim for unfair competition is of such a nature that it can be joined as a part of the same cause of action with a claim arising under federal statutes is sufficient basis for applying federal law to both claims as well as a basis for assuming federal jurisdiction over each. Although the fact that unfair competitive acts have taken place in interstate commerce may provide grounds for extending federal jurisdiction and applying federal law in such cases if the unfair competition is intimately related to infringement of federal rights, the fact that interstate commerce was not involved should not operate to oust the federal court of jurisdiction or the right to apply its own law.

The final problem raised with regard to the application of federal law is concerned with the possible consequences of a suit wherein the state unfair competition law, if it were applied, would be more comprehensive than the federal. For example, if federal law were applied to all unfair competition counts wherein jurisdiction was based upon 28 U.S.C. § 1338(b), could a plaintiff bring suit for infringement, basing jurisdiction upon 28 U.S.C. § 1338(a), and add a count

for unfair competition with jurisdiction based upon diversity, where such existed, to make state law applicable? A federal court's answer to this should be an unequivocal "no" in cases where the infringement and unfair competition claims grow out of the same set of facts. Obviously, the parties to a suit should not be allowed to control the law to be applied in a given case, or any part thereof, by juggling jurisdictional statutes. In suits presently brought under 28 U.S.C. § 1338(b), the court must find as a fact that the claim under federal statutes is substantial and related to the unfair competition claim. Hence, a requirement for such a finding in all suits involving both claims arising under the copyright, patent, or trademark laws and unfair competition, regardless of the alleged grounds for federal jurisdiction, would impose no undue burden on the courts.

CONCLUSION

In the ever-increasing numbers of copyright infringement suits wherein a count for unfair competition is joined, a lawyer may be placed in a position of not knowing whether to prepare one brief or fifty on the law governing the unfair competition claim. The courts have been reluctant to take a firm position on the question of whether federal law or state law should be applied to unfair competition counts joined with a substantial and related claim arising under the copyright statutes, and the positions they have taken are poles apart. Although the weight of reasoned authority appears to demand that state law be applied, sound policy considerations militate in favor of a uniform federal law of unfair competition to be applied at least in cases where the claim for unfair competition forms a part of the same cause of action with a claim for copyright infringement. Only in this way can recognized rights of unfair competition be made to serve the purpose for which they were originally devised. Otherwise the

entire concept may become obscured in a hopeless morass of jurisdictional statutes and conflict of laws rules.

We cannot escape the fact that copyright and unfair competition overlap to some extent and will continue to arise in single fact situations. The federal courts must someday unite in applying either state or federal law to unfair competition claims joined in the same cause of action with copyright infringement claims. It is strongly urged that, irrespective of any formidable array of authority to the contrary, the federal courts should endorse the position that a uniform federal law should be applied to all claims for unfair competition which are joined in the same cause of action with substantial and related claims under the copyright laws of the United States.

NATIONAL THIRD PRIZE, 1963

The Fine Arts: What Constitutes Infringement

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SOME 15,000 TO 20,000 years ago in a dimly lit recess of a large cave on Blackacre, *X*, a man of unparalleled imagination and genius, in response to an inexplicable inspiration, grasped a bit of prehistoric chalk and sketched upon a limestone wall the picture of a bison. Returning from the hunt, his friends were exultant. Something strange and new had been added to the history of civilization. They immediately realized that *X*'s talents should be protected, that his creativity should be encouraged, that proper steps should be taken to ensure that no second-rate imitator drew cheap copies of *X*'s masterpiece in every other cave in the world, thereby decreasing the value of Blackacre, which now possessed untold magical powers, not to speak of its practical values. *X* had become the world's first artist. He had also become the recipient of the first copyright.

Without a doubt, the history of art, and of copyright law, did not begin in this fashion, but it is true that the creators of works of the fine arts have been honored members of society from Magdalenian man to the present. "[W]e do know definitely that from the earliest times until today human beings the world over have given expression to human experience in concrete tangible forms which we call works of art." [1] Civiliza-

[1] GARDNER, ART THROUGH THE AGES 1 (1926).

tion has recognized value in artistic creation—economic, political, utilitarian, or aesthetic—and states have afforded it various forms of protection. Copyright statutes relating to the fine arts can be found in England as far back as 1735,[2] and in the United States dating from 1790.[3]

Of all the fields of creative endeavor afforded protection by our current copyright statutes,[4] none would seem to encompass such an extensive and variegated array of items as does the category "works of art." The Copyright Act provides that "any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right: (a) To print, reprint, publish, copy and vend the copyrighted work," [5] and this protection is extended to "works of art; models or designs for works of art." [6]

The U.S. Copyright Office has supplied the following description of the category:

Works of Art (Class G).

(a) General. This class includes published or unpublished works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as works belonging to the fine arts, such as paintings, drawings, and sculpture.

(b) In order to be acceptable as a work of art, the work must embody some creative authorship in its delineation or form. . . .

(c) If the sole intrinsic function of an article is its utility, the fact that the article is unique and attractively shaped will not qualify it as a work of art. . . .[7]

The multiplicity of items which have qualified within this

[2] 8 Geo. 2, c. 13 (1735): "Whereas divers persons have by their own genius, industry, pains, and expense, invented and engraved, or worked in Mezzotinto or Chiaro Oscuro, sets of historical and other prints, in hopes to have reaped the sole benefit of their labours; and whereas print-sellers and other persons have of late, without the consent of the inventors, designers, and proprietors of such prints, frequently taken the liberty of copying, engraving, and publishing or causing to be copied, engraved, and published, base copies of such works, designs, and prints, to the very great prejudice and detriment of the inventors, designers, and proprietors thereof. . . ."

[3] Act of May 31, 1790, ch. 15, 1 Stat. 124.

[4] 17 U.S.C. §§ 1–216 (1958).

[5] 17 U.S.C. § 1(a) (1958).

[6] 17 U.S.C. § 5(g) (1958).

[7] 37 C.F.R. § 202.10 (1960).

definition of "works of art" was noted by Justice Douglas in a concurring opinion in *Mazer v. Stein:*

> The Copyright Office has supplied us with a long list of such articles which have been copyrighted—statuettes, bookends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays.[8]

In view of the large range of objects encompassed by the phrase "works of art," the present writer has confined his consideration to what has been referred to above as "the fine arts." Except where otherwise noted, all cases discussed or noted have involved drawings, paintings, engravings, sculpture, or, in a few instances, photographs, the area of photography being increasingly the subject of artistic endeavor in recent years. Though works of art have always served functional purposes, at times for good and at times for bad, they have at the same time been cherished in and for themselves.[9] It is hoped that by limiting the scope of the present inquiry it will be possible to determine the attitude of the courts to art *qua* art, and that certain unanswered problems in this area may at least be identified.

WHY PROTECT THE ARTIST?

The early English justices would appear to have possessed a greater respect for an understanding of law than art,[10] and

[8] 347 U.S. 201, 220–21 (1954).

[9] PARKER, THE PRINCIPLES OF AESTHETICS 14 (1946): "No matter what further purpose artistic expressions may serve, they are produced and valued for themselves. . . . Any sort of practical purpose may be one motive in the creation of a work of art, but its significance is broader than the success or failure of that motive."

[10] In Gambart v. Ball, 32 L.J.C.P. 166, 143 Eng. Rep. 463, 468 (1863), Chief Justice Erle observes, "[W]e feel the same degree of pleasure in looking at the forms and attitudes of the beautiful animals there portrayed whether we see them in the size in which they are drawn in the original picture, or in the reduced size of the engraving, or in the still more diminished form in which they appear in the photograph." In Martin v. Wright, 6 Sim. 297, 58 Eng. Rep. 605, 606 (1833), Sir L. Shadwell notes, "Then with respect to the Defendant representing his copy as Martin's picture. It must be either better or worse; if it is better, Martin has the benefit of it; if worse, then the misrepresentation is only a sort of libel, and this court will not prevent the publication of a libel."

seldom does one find an inclination to speak in terms of a work of art as of value in itself.[11] This is not to say that the courts are not generous in the protection afforded, but the decisions are more often based on injury to the reputation of the artist [12] or to the commercial value of the work of art.[13]

The United States courts, while noting that there is no standard of artistic taste,[14] have nevertheless recognized that "the concept of beauty expressed in the materials of statuary or drawing, is the thing which is copyrighted." [15] And Justice Reed, speaking for the U.S. Supreme Court in 1954, said, "Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered." [16]

The basic philosophy underlying the decisions was enunciated by District Judge Kickinson in *Pellegrini v. Allegrini:*

> The beautiful and the development of a love of the beautiful and of the artistic sense and taste is as much necessary to a well-rounded life as are the useful things. A like comment applies to our national life. It is well, therefore, to encourage the production of works of art. The policy is in line with, and in one sense an extension of, the policy avowed in our Constitution "to promote the progress of science and useful arts." Article 1, §8, cl. 8. These policies, if not the same, are very much alike.[17]

[11] *Cf.*, Dicks v. Brooks, 15 Ch. D. 22, 35 (1880). James, L. J., makes reference to "the print *qua* print," but goes on to refer to reputation and commercial value in the same sentence.

[12] Dicks v. Brooks, *supra* note 11; Gambart v. Ball, 32 L.J.C.P. 166, 143 Eng. Rep. 463, 467 (1863).

[13] Dicks v. Brooks, *supra* note 11; Gambart v. Ball, *supra* note 10, "Engravings are things having a commercial value, and the statute gives protection to the *money value of the creation* of the artist's mind." (Emphasis added.) Hansfstaengl v. W. H. Smith & Sons, [1905] 1 Ch. 519, 525, "[N]o alleged copy whether of a picture or of an engraving can properly be held to be a copy within the meaning of the statute and prohibited thereby unless commercial injury can be proved or reasonably presumed."

[14] Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 251 (1903); Pellegrini v. Allegrini, 2 F.2d 610, 611 (E.D. Pa. 1924).

[15] Jones Bros. Co. v. Underkoffler, 16 F. Supp. 729, 732 (M.D. Pa. 1936), *final decree rendered*, 24 F. Supp. 393 (M.D. Pa. 1938). See also, Home Art, Inc. v. Glensder Textile Corp., 81 F. Supp. 551 (S.D.N.Y. 1948).

[16] Mazer v. Stein, 347 U.S. 201, 219 (1954).

[17] 2 F.2d 610–11 (E.D. Pa. 1924).

THE SUBSTANTIAL COPY DOCTRINE

Both the English and American cases have applied the general rule of copyright law to works of art in declaring that to constitute infringement there must be a copying of a substantial part,[18] or a copy "more or less servile," [19] or similar language.[20] What constitutes a substantial copying is always a question of fact, but the decisions provide some guidance in making the determination.

It is uniformly held that "slight" [21] or "colorable" [22] or "trivial" [23] variations are inconsequential in the determination of infringement. The crucial question is whether there has been a usurpation of the substantial ideas,[24] and "it is no defense that close scrutiny may detect slight differences." [25] The

[18] Springer Lithographing Co. v. Falk, 59 Fed. 707, 712 (2d Cir. 1894), *appeal dismissed*, 17 S.Ct. 998 (1896); M. J. Golden & Co. v. Pittsburgh Brewing Co., 137 F. Supp. 455, 457 (W.D. Pa. 1956); Fleischer Studios v. Ralph A. Freudlich, Inc., 5 F. Supp. 808, 809 (S.D.N.Y.), *aff'd*, 73 F.2d 276 (1934), *cert. denied*, 294 U.S. 717 (1935) (infringement of animated cartoon character); Morrison v. Pettibone, 87 Fed. 330, 332 (N.D. Ill. 1897); Falk v. Donaldson, 57 Fed. 32, 35 (S.D.N.Y. 1893); Fishel v. Lueckel, 53 Fed. 499, 500 (S.D.N.Y. 1892); Falk v. Brett Lithographing Co., 48 Fed. 678, 679 (S.D.N.Y. 1891); Moore v. Clark, 9 M. & W. 692, 152 Eng. Rep. 293 (1842); Bradbury, Agnew & Co. v. Day, 32 T.L.R. 349 (1916).

[19] Alva Studios, Inc. v. Winniger, 177 F. Supp. 265, 267 (S.D.N.Y. 1959); Pellegrini v. Allegrini, 2 F.2d 610, 612 (E.D. Pa. 1924).

[20] Rosenthal v. Stein, 205 F.2d 633, 636 (9th Cir. 1953); Contemporary Arts v. F. W. Woolworth Co., 93 F. Supp. 739, 743 (S.D.N.Y. 1950), *aff'd*, 193 F.2d 162 (2d Cir. 1951), *aff'd*, 344 U.S. 228 (1952), "[I]t is not necessary that a copy be a 'Chinese copy' in order to find infringement."; Jones Bros. Co. v. Underkoffler, *supra* note 15, "The test of infringement is whether the defendants have made an original independent production or a copy of the plaintiff's work."; Hansfstaengl v. Empire Palace, [1894] 3 Ch. 109, 130 ("conveying tolerably correct ideas").

[21] Gerlach-Barklow Co. v. Morris & Bendien, Inc., 23 F.2d 159, 161 (2d Cir. 1927).

[22] Munro v. Smith, 42 Fed. 266, 267 (S.D.N.Y. 1890) (differences more than colorable); West v. Francis, 5 B. & Ald. 737, 106 Eng. Rep. 1361, 1362 (1822).

[23] Gross v. Seligman, 212 Fed. 930, 931 (2d Cir. 1914).

[24] Springer Lithographing Co. v. Falk, *supra* note 18; Falk v. Donaldson, *supra* note 18 ("Is the sculptor compelled to see his life work in marble appropriated, and modeled in soap or sugar, because forsooth, the 'dimples are lacking' from the imitation . . .?"); Falk v. Brett Lithographic Co., *supra* note 18.

[25] Gerlach-Barklow Co. v. Morris & Bendien, Inc., *supra* note 21, at 161.

fact that the picture is reverse in the copy will not prevent infringement.[26]

It is not uncommon for an artist to infringe a copyright on a work of his own creation. The case of *Gross v. Seligman*,[27] which came before the Second Circuit Court of Appeals in 1947, involved two photographs made by the same professional photographer, the first sold to the plaintiffs with all rights thereto, the second to the defendants. Both photographs were of the same nude, though taken two years apart. The two poses were identical with the exception that in the second "the young woman now wears a smile and holds a cherry stem between her teeth," [28] and "some slight changes in the contours of her figure are discoverable." [29] The court had no difficulty in determining that the second picture was an infringement of the first. "The one thing, viz., the exercise of artistic talent, which made the first photographic picture a subject of copyright, has been used not to produce another picture, but to duplicate the original." [30] The same principle would be applicable to paintings.[31]

SIMILAR INDEPENDENT WORK

Some of the more difficult factual problems arise when the defendant readily admits that his work is substantially similar to that of the plaintiff but argues that it was independently produced—that the similarity is a result of pure coincidence. Or, an even more common situation, the two artists have used the same source of inspiration in conceiving their work—perhaps both have made replicas of artistic works in the public domain. How are these cases to be distinguished from those discussed above?

In the *Seligman* case,[32] the court made clear the point that

[26] Falk v. Brett Lithographic Co., *supra* note 18.
[27] 212 Fed. 930 (2d Cir. 1914). [28] *Ibid.* [29] *Id.* at 931.
[30] *Ibid.* [31] *Ibid.* [32] *Supra* note 27.

if there had in fact been an independent production, the similarity of the pictures would not have made the second an infringement.

> Of course when the first picture has been produced and copyrighted every other artist is entirely free to form his own conception of the Grace of Youth, or anything else, and to avail of the same young woman's services in making it permanent, whether he works with pigments or a camera. If, by chance, the pose, background, light, and shade, etc., of this new picture were strikingly similar, and if, by reason of the circumstance that the same young woman was the prominent feature in both compositions, it might be very difficult to distinguish the new picture from the old one, the new would still not be an infringement of the old because it is in no true sense a *copy* of the old.[33]

A more difficult problem confronted the Southern District of New York in *Alva Studios, Inc. v. Winninger*.[34] In this case, the plaintiff had created a minutely detailed reproduction of Rodin's "Hand of God." The reproduction did not constitute an exact replica in that the original work had been reduced in size, a fact which, the plaintiff contended, increased the difficulty of the work and required "an extremely skilled sculptor" for its execution. The plaintiff claimed that the defendant was marketing products which made use of the artistic work contained in his reproduction. The defendant argued that his work was an original interpretation.

The court observed that where both plaintiff and defendant have used an object in the public domain, or any common source, for their work, mere resemblance will not constitute an infringement.[35] In line with the reasoning in the *Seligman* case, the court said, "Publication of *identical works* cannot be

[33] *Id.* at 931. [34] 177 F. Supp. 265 (S.D.N.Y. 1959).

[35] *Id.* at 267. See also Allegrini v. De Angelis, 59 F. Supp. 248, 251 (E.D. Pa. 1945), *aff'd*, 149 F.2d 815 (3d Cir. 1945); Jones Bros. Co. v. Underkoffler, 16 F. Supp. 729, 731 (M.D. Pa. 1936); Pellegrini v. Allegrini, *supra* note 19; Munro v. Smith, *supra* note 22; 8 HALSBURY, LAWS OF ENGLAND 426 (3d ed. 1954).

enjoined if it is the result of independent research." [36] But, at the same time, "the availability to a defendant of other 'common sources' is not a defense to an action for copyright infringement if the defendant actually copied the plaintiff's work." [37] The court found that in this case the evidence supported the argument that the work had in fact been copied.

It would appear from these cases that whenever the defendant can successfully show that the allegedly infringing object was an independently created work, the defendant will not be guilty of piracy, no matter how nearly the works approximate each other.

At least one case has suggested that where the defendant has produced both the original and the allegedly infringing work the degree of similarity between the two necessary to constitute infringement may depend to some extent on the latitude of talent possessed by the defendant. In *Esquire, Inc. v. Varga Enterprises, Inc.*,[38] the plaintiff had hired the defendant to produce for it a number of "girl" paintings.[39] The plaintiff claimed that subsequent to the repudiation of the contract the defendant caused to be published elsewhere four paintings which were copied from paintings previously submitted to the plaintiff and which had been copyrighted by the plaintiff. The court in its opinion scrupulously compared each pair of paintings to show the distinctions between them and held that these were all independently created works. Typical of the comparisons were the following:

[36] Alva Studios, Inc. v. Winninger, *supra* note 34, at 267 (emphasis supplied). See ADMUR, COPYRIGHT LAW AND PRACTICE 70 (1936), "[I]t is possible to have a plurality of valid copyrights directed to closely identical or even identical works. Moreover, none of them, if independently arrived at will constitute an infringement of the copyright of the others."

[37] Alva Studios, Inc. v. Winninger, *supra* note 34, at 268.

[38] 81 F. Supp. 306 (N.D. Ill. 1948), *aff'd on this point*, 185 F.2d 14 (7th Cir. 1950).

[39] "This particular form of art portrays women in a state of semi-nudity and emphasizes, or rather over-emphasizes, many of the physical details peculiar to the female anatomy." 81 F. Supp. at 307.

Hair—Accused's hair is long and gathered at the base of the neck; Original's is combed upward to the top of the head in the well-known "upsweep" coiffure. . . . Shoulders—due to the different positions of the arms, there is a slightly different muscular effect in the vicinity of the shoulders and upper back.[40]

Significant to the decision reached by the court is this statement made by District Judge Campbell in defending this rigid examination of the paintings:

Any attempt to point out the distinguishing elements of the various paintings should be prefaced by the observation that the over one hundred paintings by defendant in evidence reveal that defendant's artistic talent is limited to the portrayal of the female figure in varying degrees of undress. . . . It is apparent from the testimony that this is all he has ever drawn and seems to be all he ever will draw. It follows, therefore, that all his future drawings will bear some similarity to his previous work, whether or not his past creations are before him at the time he is painting.[41]

This court, then, is not looking merely at the works of art involved in the litigation.[42] What if the purported copies had not been made by the creator of the original? If they had been made by a specialist in seascapes, for example, would the court have held differently? Would distinctions between the paintings such as those quoted above have been a substantial variance so as to constitute an independent work? Obviously, the *Esquire* opinion suggests that the decision might have been different, and, at the very least, the presumption of an independently created painting would be significantly weakened.

The present case has not been subsequently cited on this particular point. So far as this writer is able to determine, similar reasoning has been employed in no other decision relating to artistic copyrights. If it were to be followed in the future, it would represent a significant development in copyright law, for it has been a cardinal principle that the test of infringement is the apparence of a copying to the ordinary

[40] *Id.* at 308. [41] *Id.* at 307–08. [42] See *infra* note 50.

observer.[43] Here a court has suggested that the talents and abilities of the accused infringer may be a material factor in determining liability. Needless to say, such qualities are not readily apparent to the ordinary observer upon examination of the artistic works.

"THE ORDINARY OBSERVER"

A considerable amount of recent art criticism has suggested that many of the masters of fine art "borrowed" portions of their works from previously created works. One writer [44] persuasively demonstrates the similarity between a portion of Rembrandt's etching "Christ Driving Money Changers from the Temple," and a woodcut by Durer made a century before; between Gauguin's "We Shall not Go to Market Today" and an ancient Egyptian frieze; and even between Picasso's abstract human figures and drawings made 2,700 years ago on the walls of buildings in what is now Turkey. A similar comparison has been made between the abstract work of the contemporary artist Jackson Pollock, and the realistic paintings of Thomas Hart Benton, under whom the former studied.[45]

Though undoubtedly none of the examples cited above would give rise to a justiciable controversy, they do give rise to a new area of possible infringement. The courts have held as a general rule that the mode used in copying is of no consequence in determining infringement.[46] But what about variations in style? Would the holder of a copyright in a realistic portrait painting, for example, have a cause of action against one who had, using the first painting as his sole inspiration, created an abstract interpretation of the same subject?

Apparently no case has yet reached the appellate level based on facts such as these, but the statements made by the

[43] See following section.
[44] Watson, "Borrowing of the Masters," American Artist, Feb. 1960, p. 38.
[45] "Baffling U.S. Art: What It Is About," Life, Nov. 9, 1959, p. 10.
[46] See *infra* note 67 and accompanying text.

courts leave little doubt that the charge of infringement would not be sustained, barring visible evidence of a substantial similarity. Repeatedly, the courts are heard to say that the existence of a substantial copying is to be determined by the appearance to the "ordinary observer," [47] or the "ordinary reasonable person," [48] or other language connoting the same idea.[49] The proof of similarity must be found in the works of art themselves.[50] Consistent with this notion, there has been a tendency to be wary of the use of expert testimony to demonstrate similarities.[51]

Although the "ordinary observer" test, or "audience" test,

[47] Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487 (2d Cir. 1960) (infringement of ornamental cloth design copied from work of art); Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc., 73 F.2d 276, 278 (2d Cir. 1934), *cert. denied*, 294 U.S. 717 (1935) (infringement of animated cartoon character); Allegrini v. De Angelis, *supra* note 35.

[48] Contemporary Arts v. F. W. Woolworth Co., 93 F. Supp. 739, 744 (D. Mass. 1950); Allegrini v. De Angelis, *supra* note 35.

[49] West v. Francis, 5 F. & Ald. 737, 106 Eng. Rep. 1361, 1363, "A copy is that which comes so near to the original as to give to every person seeing it the idea created by the original."

[50] Weitzenkorn v. Lesser, 40 Cal. 2d 778, 256 P.2d 947 (1953); Golding v. R.K.O. Pictures, 35 Cal. 2d 690, 221 P.2d 95, 101 (1950), "[D]issection may be necessary to define the existence and extent of a plaintiff's property interest, and on the issue of similarity the test is always that of the average observer comparing such property interest with the alleged copy made by the defendant" [infringement of stage play by motion picture]. See also, Carman, *The Function of the Judge and Jury in the "Literary Property" Lawsuit*, 42 CALIF. L. REV. 52 (1954).

[51] Contemporary Arts v. F. W. Woolworth Co., 93 F. Supp. 739, 743–44 (S.D.N.Y. 1950); Allegrini v. De Angelis, *supra* note 35, "The court must determine whether or not the fact of infringement is proven; and the opinion of experts, although helpful, may not be substituted for the court's judgement."; Falk v. Donaldson, *supra* note 18; Burtis v. Universal Pictures Co., 40 Cal. 2d 823, 256 P.2d 933, 940 (1953), "[T]he standard of the ordinary observer should be applied and comparison of the protectible portions should be made without dissection and without expert or elaborate analysis." [infringement of a common-law copyright in a manuscript by a motion picture]; Fox, *Evidence of Plagiarism in the Law of Copyright*, 6 U. TORONTO L.J. 414, 452 (1946), "[I]t may be said that the courts, while ready to hear the testimony of expert witnesses and to benefit by the assistance which they give in the way of carefully prepared and critical analyses and comparisons of the works involved in an action, are rather disposed . . . to consider themselves more properly the arbiters of originality and plagiarism and to base their conclusions on their own literary, dramatic, musical, or artistic perceptions."

as it is sometimes referred to, is a firmly accepted doctrine of copyright law, particularly in the area of the fine arts, it is not without its critics. This writer would tend to agree with the proposition that artistic works are not always created for, nor understood by, the "ordinary observer." By comparison, in the area of patent infringement it would be considered sheer folly to expect a jury to determine the similarities or differences between two intricate and complex machines on the basis of "ordinary observation." The copying involved in such a situation very possibly would not be readily apparent to the eye. Can it be denied that there is more to a work of art than that which meets the eye? Are there not more subtle ways of pirating the genius of another than by superficial similarities?

One writer [52] has observed,

> [T]here can be no dispute that the "spontaneous and immediate" reactions of the ordinary observer are relevant evidence in determining whether works were copied, but stealing and the immediate impression of stealing are not the same thing. . . . [I]t is unlikely that the basic purpose of the Act is merely to protect against the general public's "spontaneous and immediate" impression that these fruits have been stolen. . . . Ordinary observers may very easily find a literary product enjoyable and worth paying for without being able to recognize that it is the product of the plaintiff's creative effort, and that all the defendant has contributed is a shrewd disguise.[53]

It should be noted that in a few cases involving dramatic property [54] and musical property [55] the courts have been persuaded to rely more heavily upon expert testimony, and occa-

[52] Nimmer, *Inroads on Copyright Protection*, 64 HARV. L. REV. 1125, 1137 (1951) (Footnotes omitted.).

[53] The context of the article would not indicate that the phrase "a literary product" was used in the above quotation for the purpose of excluding works of the fine arts.

[54] Shipman v. R.K.O. Radio Pictures, Inc., 100 F.2d 533 (2d Cir. 1938).

[55] Heim v. Universal Pictures Co., 154 F.2d 480 (2d Cir. 1946); Wilkie v. Santly Bros., Inc., 91 F.2d 978 (2d Cir.), *cert. denied*, 302 U.S. 735 (1937); Montgomery v. United States, 290 Fed. 961 (7th Cir. 1923); Arnstein v. American Soc'y of Composers, Authors & Publishers, 29 F. Supp 388 (S.D.N.Y. 1939). See also Orth, *The Use of Expert Witnesses in Musical Infringement Cases*, 16 U. PITT. L. REV. 232 (1955).

sionally one will find judicial criticism of the general rule.[56] To date, however, no cases would appear to have reached the appellate level in which expert testimony has been seriously considered regarding works of the fine arts. It would seem that works of art and sculpture, at least as much as these other categories, are a field so specialized as to deserve examination and evaluation by experts, and that "on matters that appeal to a more intelligent, artistically aware audience, full resort to intelligence should be brought to bear on the determination of infringement." [57]

OTHER FACTORS IMMATERIAL IN DETERMINING INFRINGEMENT

Numerous other distinguishing features have been held by the courts as immaterial in determining copyright infringement. Thus it has been the attitude of the courts that the artistic merit of the defendant's work either by itself or as compared to that of the plaintiff is of no consequence.[58] It may even be the case that the defendant's copy is more meritable than the original,[59] but still the original creator is to be protected. Justice Holmes, in ruling that a circus poster was a work of art,[60] maintained that the courts were not prepared to consider artistic genius in reaching decisions. "It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time." [61] It also follows that whether the defendant's work is of marketable quality makes no difference.[62]

Differences which relate merely to size are unimportant.[63]

[56] Shipman v. R.K.O. Radio Pictures, Inc., *supra* note 54, at 536.

[57] Orth, *supra* note 55, at 260.

[58] Bleistein v. Donaldson Lithographic Co., *supra* note 14; Pellegrini v. Allegrini, *supra* note 14; Bracken v. Rosenthal, 151 Fed. 136, 137 (N.D. Ill. 1907); Allegrini v. De Angelis, *supra* note 35; Falk v. Donaldson, *supra* note 18.

[59] Pellegrini v. Allegrini, *supra* note 14.

[60] Bleistein v. Donaldson Lithographic Co., 188 U.S. 239 (1903).

[61] *Id.* at 251.

[62] Fishel v. Lueckel, *supra* note 18; Hansfstaengl v. Empire Palace, *supra* note 20.

[63] Falk v. T. P. Howell & Co., 37 Fed. 202 (S.D.N.Y. 1888); Gambart v. Ball, *supra* note 10.

But what if the alleged copy of the plaintiff's work is of only part of that work? Again it would appear that infringement will turn on whether there has been a substantial copying. In *Fishel v. Lueckel* [64] the court said, "The appropriation of part of a work is no less an infringement than the appropriation of the whole, provided 'the alleged infringing part contains any substantial repetitions of any material parts which are original and distinctive.' " [65]

The fact that the plaintiff's work was incomplete at the time of the alleged copying provides no defense. In *Beifeld v. Dodge Publishing Co.*,[66] the defendant contended that there was no infringement of the plaintiff's painting, because the copying was of a preliminary sketch which the plaintiff had made prior to the completion of the painting. The court held that even if the preliminary drawing had been completed before the painting was begun, the copyright on the painting would protect the sketch as well, and a copying of the sketch would constitute an infringement. The court reasoned that if the plaintiff had himself attempted to sell the preliminary sketch after selling the painting, such a sale would infringe the copyright on the painting. Thus, it concluded, in legal contemplation, the two works are the same.

THE MODE OF COPYING

The methods used in duplicating the works of art involved in infringement cases have been varied, and often ingenious. Generally, the cases have held that the mode employed in copying is immaterial.[67]

[64] 53 Fed. 499 (S.D.N.Y. 1892).

[65] *Id.* at 500. See also Morrison v. Pettibone, *supra* note 18; The London Stereoscopic and Photographic Co. v. Kelly, [1888] 5 T.L.R. 169.

[66] 198 Fed. 658 (S.D.N.Y. 1911). See also, Fishel v. Lueckel, 53 Fed. 499 (S.D.N.Y. 1892).

[67] Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99 (2d Cir. 1951); M. J. Golden & Co. v. Pittsburgh Brewing Co., 137 F. Supp. 455 (W.D. Pa. 1956); Jones Bros. Co. v. Underkoffler, 16 F. Supp. 729 (M.D. Pa. 1936); Bracken v. Rosenthal, 151 Fed. 136 (N.D. Ill. 1907); Werckmeister v. Pierce &

One of the earliest problems to confront the English courts was the *tableau vivant*, or "living picture." This innovation involved the arrangement of human beings and scenery in such a manner as to duplicate the image produced by the plaintiff's picture. In an early case,[68] the Chancery court ruled that such a representation did not constitute an infringement of the plaintiff's copyright. But following the passage of the Copyright Act of 1911,[69] the problem was again brought before the court,[70] and the living picture was held to be an infringement.[71] Much earlier, in 1859, an Irish court had held that where the defendant had arranged a "living picture" and photographed it, the photograph constituted an infringement of the plaintiff's copyright.[72]

Other more conventional forms of copying have generally afforded no difficulty. A water color painting may be infringed by an oil, or a crayon, or a lithographic facsimile.[73] A litho-

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Bushnell Mfg. Co., 63 Fed. 445 (D. Mass. 1894), *rev'd on other grounds*, 72 Fed. 54 (1st Cir. 1896); Falk v. Donaldson, 57 Fed. 32 (S.D.N.Y. 1893); Falk v. Brett Lithographic Co., 48 Fed. 678 (S.D.N.Y. 1891); Falk v. T. P. Howell & Co., 37 Fed. 202 (S.D.N.Y. 1888); Schumacher v. Schwencke, 30 Fed. 690 (S.D.N.Y. 1887); Rossiter v. Hall, 20 Fed. Cas. 1253 (No. 12082) (E.D.N.Y. 1886); Turner v. Robinson, 10 Ir. Ch. Rep. 121; Frost & Reed v. Olive Series Publishing Co., [1859] 24 T.L.R. 649 (1908); Bradbury, Agnew & Co. v. Day, *supra* note 18; *Ex parte* Beal, L.R. 3 Q.B. 387 (1868). In Gambart v. Ball, 32 L.J.C.P. 166, 143 Eng. Rep. 463 (1863), the defendant contended that a photograph could not infringe an engraving since the art of photography was not known at the time the copyright act was passed. In holding for the plaintiff, Chief Justice Erle said, "I see no reason why these very wide and general words should not be construed according to their plain and ordinary meaning, and be held to apply to any mode of copying known at that time and to such other modes of multiplying copies as the ingenuity of man may from time to time discover."

[68] Hanfstaengl v. Empire Palace, Ltd., [1894] 3 Ch. 109.

[69] 1 & 2 Geo. 5, c. 46 (1911).

[70] Bradbury, Agnew & Co. v. Day, *supra* note 18.

[71] *Ibid.* Justice Coleridge, speaking for the courts, said, "Before 1911 the law protected the design, which meant the particular form in which the idea was embodied, and since 1911 the law has protected that embodiment, whatever be the medium in which it was expressed. [I]f the embodiment of the idea or any substantial part of it was copied, copyright was infringed."

[72] Turner v. Robinson, *supra* note 67.

[73] Schumacher v. Schwencke, *supra* note 67, at 691 (dictum).

graph may infringe a copyrighted photograph.[74] A photograph may be an infringement of a piece of statuary [75] or an engraving.[76] And a photograph which combines the plaintiff's photograph and an independently made drawing may infringe the original photograph.[77] Finally, in *Falk v. T. P. Howell & Co.*,[78] the Southern District of New York held that the plaintiff's photograph would be infringed when the defendant stamped a raised figure, like the picture, on the leather out of which he made the bottoms and backs of chairs. And the same court, sixty years later, held a scarf design to infringe the copyright on an oil painting reproduction.[79]

COPY OF A COPY

To this point consideration has only been given to those situations in which the defendant was accused of copying the original work of art. Additional problems arise in those cases in which there is a dispute as to whether the alleged infringing copy was based upon the original or upon a reproduction.

It is germane to this discussion to note here a feature which distinguishes artistic works from other forms of creative endeavor. The copyright of such works, with the exception of photographs, attaches to their physical embodiment.[80] That is to say, the copyright of a painting provides protection for certain bits of pigment applied with certain brush strokes on a particular canvas. The copyright of a statuary is related to a given piece of granite, etc. By contrast, when a literary work is copyrighted, a percise copy may be made of the protected words—by typing, by writing in longhand, by any method

[74] Falk v. Donaldson, *supra* note 67; Falk v. Brett Lithographic Co., *supra* note 67.

[75] Bracken v. Rosenthal, *supra* note 67; M. J. Golden & Co. v. Pittsburgh Brewing Co., *supra* note 67.

[76] Rossiter v. Hall, *supra* note 67; M. J. Golden & Co. v. Pittsburgh Brewing Co., *supra* note 67; Gambart v. Ball, *supra* note 67.

[77] Lumiere v. Pathé Exch., Inc., 275 Fed. 428 (2d Cir. 1921).

[78] 37 Fed. 202 (S.D.N.Y. 1888).

[79] Home Art, Inc. v. Glensder Textile Corp., *supra* note 15.

[80] *Cf.* 47 L.Q. Rev. 332 (1931).

whatever, and, for that matter, in any language. The fact that the infringing work does not physically look like the original is immaterial. In the same fashion, what is protected by a musical copyright is not the sheets of paper inscribed with symbols; it is the melody represented by those symbols. Any accurate copying will produce the same combination of sounds when played by an accomplished musician.

Such is not the case with works of art. It would not be inaccurate to say that it is actually impossible to make a true copy of a copyrighted painting or work of sculpture. Only approximations of the original can be made, a fact which has been dramatically brought home to any person of normal perception who has had the opportunity of comparing only a few paintings with their reproductions.

Because of this it has long been recognized that the making of reproductions of art is an art in itself.[81] In *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*,[82] District Judge Smith said:

> Of course, the ideas for the subject are entirely those of the first artist, the painter. What is original with the engraver is the handling of the painting in another medium to bring out the engraver's conception of the total effect of the old master. The engraver is not trying to alter or improve on the old master. He is trying to express in another medium what the original artist expressed in oils on canvas.

In implementing the protection provided for reproductions by the Copyright Act,[83] the Copyright Office has described the category as follows:

> Reproductions of works of art (Class H).
> This class includes published reproductions of existing works of art in the same or a different medium, such as lithograph, photoengraving, etching or drawing of a painting, sculpture or other work of art.[84]

Thus in the area of artistic copyright there arises the unique situation in which the same work of art may be the subject of two or even more copyrights.

[81] Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 104–05 (2d Cir. 1951); Alva Studios, Inc. v. Winninger, 177 F. Supp. 265, 267 (S.D.N.Y. 1959).
[82] 74 F. Supp. 973, 976 (S.D.N.Y. 1947), *modified*, 191 F.2d 99 (2d Cir. 1951).
[83] 17 U.S.C. § 5(h) (1958). [84] 37 C.F.R. § 202.11 (1960).

In an 1887 case, *Schumacher v. Schwencke,*[85] the plaintiff held a copyright on an original painting. The plaintiff made lithographic copies of the painting, which were not in themselves copyrighted. The defendant made copies of the plaintiff's work, *from the lithographic copies.* The defendant contended, and apparently it was not challenged by the plaintiff, that he had in fact never even seen the original work of art. The court ruled in favor of the plaintiff, saying:

> It by no means follows from the fact that the law recognizes a distinction between a painting and a print that a copyright for the former will not protect its owner in the sale of copies thereof, even though they may appropriately be called prints. It is clear that the defendants are wrong-doers. They have invaded the complainants' territory. They have copied the painting. It is immaterial how this was accomplished, whether directly or indirectly. They have copied a lithograph which was protected by the complainants' copyright, and have thus attempted unlawfully, and without due recompense, to reap the fruits of the complainants' genius and enterprise.[86]

Sixteen years later, in *Champney v. Haag,*[87] the plaintiff's copyrighted painting had been reproduced by a copyrighted photograph. This action was brought for an infringement of the copyright in the painting. Upon the trial of the case, the evidence showed that the defendant's copies were made from the photograph and not from the painting. The court held that there was an infringement of the copyright on the photograph but not on the painting. It said that the plaintiff would have to show that the illustrations in question were not copied from the photograph, a requirement which he failed to meet.

It is possible to reconcile these two decisions on the basis that in the *Schumacher* case there was but a single copyright—that on the original work; in the *Champney* case, both the original and the reproduction had been copyrighted. But considering the vociferous language used in the *Schumacher* opinion, in guaranteeing the original work an absolute protection from infringement, it would appear more likely that that

[85] 30 Fed. 690 (S.D.N.Y. 1887).
[86] *Id.* at 691–92.
[87] 121 Fed. 944 (E.D. Pa. 1903).

court would not have agreed with the *Champney* decision and would have held the defendant to have infringed the protection afforded for both the original painting and the photograph.

The Southern District of New York followed the reasoning of the *Champney* case (though not referring to it) in a recent case[88] in which the opposite situation was presented. The plaintiff was the owner of a copyrighted reproduction, and the defendant contended that his copy constituted no infringement, because he had copied the original oil painting. Though the ruling was for the plaintiff, the court indicated that the defendant would not have been liable if the evidence had supported his contention.

The rule is clearly sound in this latter decision. It could hardly be denied that when a third party makes a reproduction of an original work he has not infringed the copyright on another reproduction. He has not utilized the talents of the first reproducer. But in the original situation, where the third party copies the reproduction, it would likewise appear clear that the injury done extends beyond the reproduction to the original work. The concept of beauty expressed in the materials of statuary or drawing, is the thing which is copyrighted.[89] The aesthetic value to be found in the reproduction is for the very large part contingent upon the artistic genius of the creator of the work.

The *Schumacher* and *Champney* cases were both decided prior to the passage of the Copyright Act of 1909. This act required, *inter alia*, that a copyrighted work of art or reproduction carry notice of copyright,[90] a requirement which had been present in the previous act,[91] but contained a new provision that where the copyright proprietor had omitted the notice by accident or mistake the act would "prevent the recovery of damages against an innocent infringer who has been

[88] Home Art, Inc. v. Glensder Textile Corp., *supra* note 15.
[89] See cases cited note 15 *supra*. [90] 17 U.S.C. § 19 (1958).
[91] Act of June 18, 1874, ch. 301, § 1, 18 Stat. 79.

misled by the omission of the notice." [92] If notice were intentionally omitted, the copyright would be forfeited.[93] The problem of notice did not confront the court in the previously discussed cases. With this enactment, it became a determination precedent to the question of copying.

In *Leigh v. Barnhart*,[94] a photograph of the plaintiff's oil painting appeared in a magazine, but the magazine inadvertently failed to identify it as copyrighted. The plaintiff did not hold a copyright on the reproduction.[95] The defendants had made copies of the reproduction in the magazine. The court denied relief to the plaintiff as there was no notice given to the defendants of the copyright. This is the only case decided since the passage of the Copyright Act of 1909 that the present writer has been able to uncover in which the holder of the copyright on an original work of art has brought an action for infringement against one who has copied from a reproduction in which the plaintiff did not hold the copyright. The court strongly implies here that if there had been a compliance with the statutory requirement of notice, the plaintiff would have been entitled to relief, as well as would the holder of the copyright on the reproduction.

CONCLUSION

The number of cases involving infringement of works of the fine arts to come before the appellate courts has been relatively small, a fact which has no doubt impeded the development of the law in this area to some extent. The lack of controversies may be attributed to a number of reasons. Works of art are normally not channeled through publishing outlets in the same

[92] Peter Pan Fabrics, Inc. v. Martin Weiner Corp., 274 F.2d 487, 489 (2d Cir. 1960).

[93] 17 U.S.C. § 21 (1958).

[94] 96 F. Supp. 194 (D.N.J. 1951).

[95] Plaintiff contended that the magazine had assigned the copyright in the reproduction to him, but the court found that it had only unsuccessfully attempted to reconvey the copyright in the original, which in fact the plaintiff had never given up.

manner as are literary and musical compositions. As a result, many artists receive little guidance in the marketing of their material and thus are virtually unaware of their legal rights so far as their creations are concerned. Furthermore, piracy is not so common in this area as in others because of the manifest difficulties entailed in copying—in many instances, it would take another artist to substantially copy a work of art. Finally, the factual requirements for proving an infringement would appear at times quite difficult to fulfill, especially in cases of like reproductions of works in the public domain.

At present, the great weight of authority would confine the determination of infringement to a comparison of the works of art involved in the controversy. In suggesting that the court should go beyond the paintings themselves and that the defendant's artistic talent should be taken into account, the *Esquire* decision is quite obviously not in line with the prevailing attitude. Due to the particular facts there involved, the defendant's abilities would appear quite relevant to a fair disposal of the case. But to extend the principle beyond this narrowly defined fact situation would be exceedingly dangerous. Virtually every proficient artist's works are stylistically similar to some extent, at least enough that his works can be recognized as his. Should the courts examine all of an artist's work in order to find out if there is a substantial similarity between two of these works? Or is the fact that "girl" paintings are aesthetically inferior, or easily produced, or not of lasting value, important? Any of these approaches would go against the grain of recognized copyright law and plunge the courts into the area of artistic value determinations, an area which they have systematically avoided in infringement cases in the past.

The more difficult problems confronted in all infringement cases are factual,[96] and it would at least appear questionable

[96] Yankwich, *Legal Protection of Ideas—A Judge's Approach*, 43 VA. L. REV. 375, 379 (1957).

that the standards applied by the courts are completely satisfactory. The adoption of the familiar "reasonable man" legal standard in the guise of the "ordinary observer" would not seem in all cases equal to the task of determining piracy. One United States district judge has said that the best the judges can do in cases of this nature is to "seek to approximate the median impression." [97] The present writer would suggest that though the impression of the "ordinary observer" is an important consideration, to limit the proof of infringement this narrowly would be in effect to sanction many real but subtle methods of piracy. It is to be hoped that in the area of the fine arts we shall see an increasing reliance upon expert witnesses in the future; in this respect, the artistic works decisions would not appear to have kept pace with those in other types of copyright infringement.

If, as Justice Reed has said, "Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered," [98] it would certainly seem that any piracy should be prevented, whether visible to the "ordinary observer" or not. Concomitantly, where the defendant has substantially copied a reproduction of the plaintiff's work, the artistic ability which the plaintiff has embodied in the work has been wrongfully used, and the plaintiff should be allowed redress, regardless of whether he holds a copyright on the reproduction.

[97] *Ibid.* [98] Mazer v. Stein, 347 U.S. 201, 219 (1954).

HONORABLE MENTION, 1963

Some Copyright Implications of Videotapes (Suggesting the Need for Statutory Revision)

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COPYRIGHTABILITY

EVERY TIME ANOTHER METHOD of mass communications is developed, the scope of section 5 of the Copyright Act [1] is put to a new test. Three times this century the problem has arisen, and three times the solutions have differed. First to arrive were motion pictures, held copyrightable in *Edison v. Lubin* [2] as technologically similar to photographs, which expressly had been copyrightable under section 5 since 1865. Since motion pictures were merely a composite of several still photographs, each of which could be separably copyrighted, the court assumed it simply made more sense to hold that the movie itself could be protected by a single copyright than to require separate copyrights for each frame.[3] Congress in 1912 memorial-

[1] 17 U.S.C. §§ 1–216 (1958). Hereinafter all statutory references are to this title.

[2] 122 Fed. 240 (3d Cir. 1903).

[3] *Id.* at 241. See WARNER, RADIO AND TELEVISION RIGHTS 73 (1953) (hereinafter cited as WARNER), for the ensuing case law development.

ized the decision by specifically providing for the copyrightability of motion pictures under section 5.

When phonograph record manufacturers sought copyrights, however, courts were unable to recognize any technologically similar device already afforded the shield of the Act.[4] Early dicta consistently denied that phonograph records could be copyrighted,[5] and the Second Circuit just a few years ago expressly held them noncopyrightable, primarily because Congress, over the years, had rejected several proposals that would have extended protection to "mechanical reproductions," [6] which was assumed to cover phonograph records.[7] There is some evidence suggesting that Congress' attitude stemmed from a feeling that records could not fit under the constitutional provision limiting copyrightable items to "writings" [8] because they were not readable to the naked eye.[9]

The Copyright Office to this day expressly refuses to accept phonograph records,[10] tape recordings, or any "sound recordings," [11] although the current study designed to overhaul the Act expresses dissatisfaction with the law and recommends in general terms that "federal statutory protection should be accorded [recordings] within appropriate limits." [12]

[4] *Cf.* Chafee, *Reflections on the Law of Copyright: II*, 45 COLUM. L. REV. 719, 734 (1945).

[5] The conclusion in most cases was merely assumed. *E.g.*, RCA Mfg. Co. v. Whiteman, 114 F.2d 86, 87 (2d Cir. 1940); Aeolian Co. v. Royal Music Roll Co., 196 Fed. 926, 927 (1912).

[6] Capitol Records, Inc. v. Mercury Records Corp., 221 F.2d 657 (2d Cir. 1955).

[7] See generally, Ringer, *The Unauthorized Duplication of Sound Recordings* 3–5, Study No. 26, U.S. COPYRIGHT LAW REVISION STUDIES (1957); Note, 31 N.Y.U.L. REV. 1263, 1274–82 (1956).

[8] U.S. CONST., art I, § 8, cl. 8: "The Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

[9] See, *e.g.*, *Hearings Before Committees on Patents on S. 6330 and H.R. 19853*, 59th Cong., 1st Sess. 27, 154 (1906); *Hearings Before Committees on Patents on Pending Bills*, 60th Cong., 1st Sess. 345–47 (1908). See also Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884), stating in dictum that "writings" requires "visible expression."

[10] 37 C.F.R. § 202.8(b) (1960).

[11] See COPYRIGHT OFFICE, CIRCULAR 54 (1962).

[12] REGISTER OF COPYRIGHTS, COPYRIGHT LAW REVISION, REPORT ON THE GEN-

Finally, although there have been no cases on this question, the leading writers in the field generally have assumed that radio and television broadcasts are not themselves copyrightable. The full impact of this restriction is not felt, however, because most matters that appear on television, such as dramatic presentations reduced to script form, films, or musical compositions, are themselves separably copyrightable. But the issue is important where the subject matter of a telecast is in the public domain or is of a spontaneous event not previously filmed or memorialized in script. Unlike motion pictures, television programs do not represent a mere technological refinement or development of an earlier art already expressly granted copyright status under section 5.[13] Moreover, it is frequently argued that a television program is too "evanescent" [14] or impermanent to be copyrightable. What its transient quality has to do with its copyright status, however, is less uniformly agreed on. Some say it merely means that there can be no tangible "copy" for physical deposit in the Copyright Office; [15] others view permanency as a prerequisite to visibility, and thus at the base of constitutional, or at least section 4, "writing" requirements.[16]

With the advent of videotape,[17] however, it may suddenly have become possible to secure for television broadcasts all the blessings of copyright now enjoyed by motion pictures, for it is no problem simply to videotape all "live" television shows and thus create a permanent item that can be deposited in the

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ERAL REVISION OF THE U.S. COPYRIGHT LAW, HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS. (Comm. Print 1961) (hereinafter cited as REVISION REPORT). The Office to date has not undertaken sufficient studies to permit more detailed recommendations. *Ibid.*

[13] Deutsch, *Unauthorized Use of Live Television Broadcasts of Public Domain Materials—Theories of Relief*, 1 PEAL Q. 288, 293–94 (1961).

[14] Probably the first to evolve this reason was WEIL, COPYRIGHT LAW 30 (1917).

[15] WARNER 41–42; Nimmer, *The Nature of the Rights Protected by Copyright*, 10 U.C.L.A.L. REV. 60, 64 (1962).

[16] WARNER 580–81. *Cf.*, Chafee, *Reflections on the Law of Copyright: I*, 45 COLUM L. REV. 503, 504–05 (1945).

[17] See BOGART, THE AGE OF TELEVISION 290–91 (2d rev. ed. 1958).

Copyright Office. The crucial issue, of course, is whether section 5 can be interpreted to afford copyright protection for videotapes.

It is generally agreed that a television broadcast can be copyrighted by prerecording it on film, simply by depositing the film as a motion picture.[18] So, by emphasizing that videotape generally is used as a substitute for films because of its better quality and instantaneous usability, it can be argued that the two should be given the same copyright treatment. Moreover, in view of the great liberality with which courts have extended the meaning of "writings" in the Constitution, allowing copyright status to such diverse items as motion pictures, advertisements,[19] statuettes,[20] kewpie dolls,[21] chromolithographs,[22] book ends, clocks, lamps, door knockers, candlesticks, inkstands, chandeliers, piggy banks, sundials, salt and pepper shakers, fish bowls, casseroles, and ash trays,[23] it hardly seems debatable that magnetic tape recordings could not be included,[24] or that there would be anything terribly revolutionary about doing so.

Indeed, the "saving clause" of section 4—"the works for which copyright may be secured under this title shall *include* all the writings of an author"—when read literally in conjunction with the last sentence of section 5—"the above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title"—could be construed to present an open-ended authorization for the extension of copyright protection to all items not offending

[18] See, *e.g.*, 37 C.F.R. § 202.15(a), (b) (1960). See also WARNER 42.

[19] WARNER 48–49. [20] Mazer v. Stein, 347 U.S. 201 (1954).

[21] Wilson v. Haber Bros., Inc., 275 Fed. 346 (2d Cir. 1921).

[22] Bleistein v. Donaldson Lithographic Co., 188 U.S. 239 (1903).

[23] Mazer v. Stein, 347 U.S. 201, 221 (1954) (dissenting opinion of Douglas, J.). See generally, WARNER § 31g, and cases cited therein.

[24] It is also quite evident from the cases that the term "authors," also used in the Constitution, has been broadened as much as "writings," so that a videotape producer most likely would not be disqualified. See Note, 31 N.Y.U.L. REV. 1263, 1286 (1956).

the broad constitutional provisions.[25] The Copyright Office itself apparently has followed this thinking, having accepted for deposit three videotapes and announced its intention to treat them like motion pictures.[26]

But a somewhat different view of authorities suggests that all is not quite so pat—at least there is enough doubt to make reliance upon judicial interpretations of the present Act risky. For one thing, it is far from clear that the literal reading of the section 4 "saving clause," as having exhausted the constitutional power of Congress to extend copyright protection, is correct. In *Capitol Records*, holding phonograph records not copyrightable under the Act while allowing that it would not be unconstitutional to do so, the court expressly rejected an expansive interpretation of section 4. The court maintained that section 4, rather than being an open-ended saving clause, was no more than declaratory of law existing in 1909.[27] Several writers have supported this view on the theory that the words "writing" and "authors" should be construed more narrowly for section 4 than for constitutional purposes.[28] Specifically, it is argued that, although to comply with the constitutional "writing" requirement a device may not have to be readable or visible, this visibility requirement is part of sections 4 and 5. The visibility requirement was first set forth in 1884 by the Supreme Court, albeit in dictum, as both a constitutional and statutory condition:

[25] HOWELL, COPYRIGHT LAW 8 (3rd ed. 1952); WEIL, COPYRIGHT LAW 214 (1917).

[26] See *Annual Report of the Register of Copyrights for the Fiscal Year Ending June 30, 1961*, at 3; Colby, *An Historic "First"—Copyright Office Accepts Magnetic Video Tape for Registration*, 8 BULL. CR. SOC'Y 205 (1961); REVISION REPORT 10–11.

[27] Capitol Records, Inc. v. Mercury Records Corp., *supra* note 6. See also Mazer v. Stein, *supra* note 20, at 210: "Some writers interpret [§ 4] as being coextensive with the constitutional grant, but the House Report, while inconclusive, indicates that it was 'declaratory of existing law' only."

[28] See, *e.g.*, Note, 31 N.Y.U.L. REV. 1263, 1273 (1956). Chafee, *supra* note 4, at 735; REVISION REPORT 10. But see Metro-Goldwyn-Mayer Distrib. Co. v. Bijou Theatre Co., 3 F. Supp. 66, 72–73 (D. Mass. 1933).

By writings in that clause [referring here to the constitutional clause] is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing, engraving, etching, & c., by which the ideas in the mind of the author are given visible expression.[29]

The viewpoint was given further implementation in 1905, in a case expressly holding that a motion picture could be copyrightable as a photograph, and, in the process, stating that "[a] photograph may . . . be the subject of copyright, for it may give visible expression to an author's idea or conception." [30] The *Capitol Records* [31] case, however, probably washed out visibility as a constitutional requirement, but nothing yet has removed it from section 4.[32] The justification for the disparity seems to be a theory that words used in the Constitution—like "commerce," "income," and "writings"—inherently have greater elasticity, because of the flexible nature of a constitution, than the same words used in a statute designed to achieve a particular legislative purpose,[33] and that if "writings" in section 4 were given broad scope, there would be no "shape" or "dimension" left to the Act.[34] If so, videotapes may more easily be treated as uncopyrightable phonograph records than motion pictures. Such a treatment, of course, ignores the *similarity of functions* between videotapes and motion pictures, and instead puts full emphasis upon the *technological similarity* between videotapes and

[29] Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 58 (1884).

[30] American Mutoscope & Biograph Co. v. Edison Mfg. Co., 137 Fed. 262, 265 (D.N.J. 1905).

[31] *Supra* note 6.

[32] *E.g.*, Diamond, *Copyright Problems in the Phonograph Record Industry*, 15 VAND. L. REV. 419, 434–36 (1962); Chafee, *supra* note 4, at 734–36; Kaplan, *Performer's Rights and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 413–15 (1956). Although some commentators think that once a presentation has been captured in permanent form, as on videotape, it becomes "visible" to satisfy all requirements of "writings" (*e.g.*, WARNER 41–42; Deutsch, *supra* note 13, at 298–300), others do not recognize such a connection (*e.g.*, Diamond and Kaplan, *supra*).

[33] Chafee, *supra* note 4, at 735–36.

[34] Kaplan, *supra* note 32, at 415.

phonograph records that renders them illegible. But, although similarity of function may be the relevant test for extending the scope of section 1 protection against infringement,[35] there is strong case support for the proposition that only technological similarity is relevant for interpreting section 5. The distinction is dramatically demonstrated by a pair of 1866 cases involving the status of photographs under the Copyright Act of 1831, which made no mention of them. First came *Wood v. Abbott*,[36] which involved the issue whether a photograph was copyrightable under a statute permitting only "prints," "cuts," and "engravings" to be copyrighted. The court first went into a detailed description of the technology of photography, then compared it with that of printing and engraving, emphasizing their technological dissimilarity.[37] Squarely on that basis it found that photography

> is not printing in any sense known to the arts at the time this copyright act was passed; nor is it an extension of the old processes, or a new development of the art of printing or the art of engraving, as those arts were then understood. It is an entirely original and independent method of producing and multiplying pictures.[38]

Photographs were thus held noncopyrightable. Yet later the same year another court, distinguishing *Abbott* and ignoring the technological similarity argument, held that photographs could be an infringing "copy" of a copyrighted engraving under what is now section 1,[39] because its function was similar to the engraving. Since videotapes technologically are to motion pictures what photographs were to prints or engravings, *Wood v. Abbott* seems to argue strongly against treating them alike under section 5. Moreover, since videotapes are clearly more technologically similar to phonograph records than to anything else, *Wood v. Abbott* seems to represent an affirmative command to give them the same noncopyrightable status

[35] See notes 165–66 *infra*, and accompanying text.
[36] 30 Fed. Cas. 424 (No. 17983) (S.D.N.Y. 1866).
[37] *Id.* at 425. [38] *Ibid.*
[39] Rossiter v. Hall, 20 Fed. Cas. 1253 (No. 12082) (E.D.N.Y. 1866).

as *Capitol Records* gave recordings. *Wood*, furthermore, has not been withered by age, it seems, for the only known case extending copyright protection to a new device not specifically mentioned in section 5 did so precisely on the same technological similarity argument.[40]

Taking the technological similarity point one step further, it may be argued that Congress has manifested an express intent not to extend copyright protection to videotapes, just as it has expressed such a negative intent regarding phonograph records.[41] The argument would turn on the view that, by talking in terms of "mechanical reproductions" instead of "phonograph records," congressional thoughts were directed to all existing and future devices technologically on the order of phonograph records.

It seems, therefore, that the Copyright Act as it currently exists does not with reasonable certainty answer questions about the copyright status of videotapes.[42] To leave the fate of videotapes to judicial determination, therefore, invites a patchwork of inconsistency and unpredictability, the very antithesis of the uniformity a federal statute hopes to achieve.[43] Since to date there have been no cases determining

[40] Edison v. Lubin, *supra* note 2. Concurrently, the similarity of use approach to section 1 has been given relatively modern validity. See notes 165–66 *infra*, and accompanying text.

[41] See notes 6–7 *supra*, and accompanying text. *Cf.* Jerome v. Twentieth Century Fox Film Corp., 67 F. Supp. 736 (S.D.N.Y. 1946), holding that the sound track of a motion picture film is not a use similar to phonograph records so as to come within the section 1(e) "compulsory license" provisions. The reason given is that "talkies" are of the genus "motion pictures" (*id.* at 742) because, technologically, "[T]he sound on film parallels and synchronizes with the pictures on the film." *Id.* at 741. See also REVISION REPORT 10–11, indicating that the assumption currently held by the Copyright Office that videotapes are copyrightable is based on the belief that they are merely a technological advance of motion pictures.

[42] For a viewpoint that seems less troubled by the prospects of copyrighting videotapes under the present act, see Meagher, *Copyright Problems Presented by a New Act*, 30 N.Y.U.L. REV. 1081 (1955).

[43] See Judge L. Hand, dissenting, in Capitol Records, Inc. v. Mercury Records Corp., *supra* note 6, at 667.

the copyrightability of videotapes,[44] the situation will never be riper for the clear legislative pronouncement on the issue, in advance, which seems badly needed. Moreover, the current project to revise the statute (which essentially remains unchanged since 1909)[45] presents the perfect opportunity for a thorough examination of the videotape question purely from a policy standpoint, without the restrictions at every turn presented by a crystallized statute. In fact, the revisers expressly recommend the amendment of section 5, and the deletion of the nonspecific provisions of section 4, to permit expressly the copyright "not only [of] those forms in which copyrightable works are now being produced, but also new forms which are invented or come into use later." [46] In view of the Copyright Office's present assumption that videotapes are copyrightable, the proposal seems clearly to include them.

What one thinks of this idea, of course, depends largely upon the balance of advantages and disadvantages between the common law and the statute upon the particular interests he favors.[47] Strictly, then, there can be no "correct" decision on so basic a question. In the interest of preventing hopeless inconsistency, however, everyone can hope that the decision to make videotapes copyrightable will be followed by a careful reappraisal of the other aspects of the copyright laws, with particular reference to television problems. Yet there appears to be a tendency to assume that if videotapes are made copyrightable under section 5, they would simply be treated like copyrightable motion pictures for all other purposes of the Act, and, conversely, if excluded from section 5, that they

[44] *Cf.* LATMAN, HOWELL'S COPYRIGHT LAWS 12 (rev. ed. 1962) (hereinafter cited as LATMAN).

[45] Kaminstein, *Copyright Law Revision*, 9 BULL. CR. SOC'Y 9 (1961).

[46] REVISION REPORT II. For varying reactions to this proposal, see REGISTER OF COPYRIGHTS, COPYRIGHT LAW REVISION, REPORT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW II. HOUSE COMM. ON THE JUDICIARY, 87TH CONG., 1ST SESS. 7–19 (Comm. Print 1963) (hereinafter cited as REVISION REPORT II).

[47] These considerations have been thoroughly enumerated in WARNER 241–43.

would be accorded the same treatment given noncopyrightable phonograph records in all other matters.[48] Even apart from its failure to consider whatever problems there might be peculiar to television, however, this nice categorization has its own difficulties. What do you do, for example, if the same amendment to section 5 makes both videotapes and phonograph records copyrightable, a result not too improbable in light of the current recommendations?[49] Moreover, the assumption is premised on the belief that videotapes are similar to records and movies in a *similar manner*. But this is not true—as to recordings there is a technological similarity, but as to movies a functional one—and some grounds of similarity seem more relevant than others for different parts of the Act.[50] Thus, regardless of how the problems are finally resolved, there should at least be no rigid commitment *a priori* to follow the "phonograph record" or "motion picture" line in adjusting the rest of the copyright laws to an amended section 5.

PUBLICATION

The fact of publication is crucial at two points in the copyright laws.[51] Publication of an uncopyrighted work is said to "dedicate" (more correctly, forfeit)[52] the common-law rights to the work—the so-called divestitive function. Publication is also a condition precedent to the operation of the Federal Copyright Act—the so-called investitive function. Nevertheless, the concept is nowhere defined in the statute, although some standards are set forth in section 26, which specifies that the "date of publication"[53] occurs "when copies . . .

[48] See generally, Meagher, *supra* note 42; REVISION REPORT 10–11.

[49] REVISION REPORT 17–18.

[50] See notes 36–40 *supra*, and accompanying text.

[51] Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185 (1956).

[52] Finkelstein, Book Review, 72 YALE L.J. 844, 845 (1963).

[53] It has been decided that this clause does not constitute a definition of "publication" for general purposes of the act. Cardinal Film Corp. v. Beck, 248 Fed. 368 (D.C. Cir. 1918).

[are] placed on sale, sold, or publicly distributed," and courts and writers have attempted to extract from this a general definition of publication relevant to the problems of divestiture and investiture. They generally begin with a broad, conclusionary statement that publication consists of a general disclosure of the subject matter in a way that "permits" copies to be made or "implies an abandonment" of the work to the general public.[54] But when they try to construct an objective test, it usually comes out that publication occurs when "copies" are made available to an unrestricted "general public," [55] a test, of course, that still leaves two key concepts undefined.

DIVESTMENT OF UNCOPYRIGHTED COPYRIGHTABLES

The focus upon "copies" as part of the test of publication has led to the general rule that "live" performances or exhibitions of an uncopyrighted work which could have been copyrighted do not constitute publication so as to divest the creator of his common law-copyright therein (the so-called right of "first publication"). The rule was first set forth by the Supreme Court in *Ferris v. Frohman*,[56] holding that a stage performance of an uncopyrighted drama does not divestively publish the work, and it since has been extended to oral presentations of a lecture [57] and "live" renditions of a song.[58] The rule has also been applied to radio broadcasts, despite their far larger audiences,[59] so that a "live" radio program dedicates neither the underlying script,[60] nor the program format

[54] See, *e.g.*, Werckmeister v. American Lithographic Co., 134 Fed. 321, 326 (1904); WARNER 866.

[55] See, *e.g.*, Roberts, *Publication in the Law of Copyright*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER NINE 111, 117 (1958); Nimmer, *supra* note 51, at 187; WARNER 868.

[56] 223 U.S. 424 (1912).

[57] Nutt v. National Institute, Inc. 31 F.2d 236 (2d Cir. 1929).

[58] Heim v. Universal Pictures Co., 154 F.2d 480 (2d Cir. 1946); McCarthy & Fischer, Inc. v. White, 259 Fed. 364 (S.D.N.Y. 1919).

[59] Roberts, *supra* note 55, at 128.

[60] Uproar v. National Broadcasting Co., 8 F. Supp. 358 (D. Mass. 1934).

itself,[61] and apparently is favored with respect to live television broadcasts.[62]

But when a television program is memorialized on videotape—clearly a tangible form that can be distributed into the possession of others—the pegs on which the performance rule rests are removed, and the foundations of the law of publication somewhat shaken. Will this new device be considered a "copy," the distribution of which will be deemed publication and thus a loss of the common-law rights therein? When this question was first raised courts very easily could have answered "No," and the matter would have been ended. There was ample precedent in an early case holding that a pianola roll (and in dictum saying that a phonograph record) was not a "copy" of a song as to violate the copyright holder's section 1 rights, because the perforated roll was not intelligible to the naked eye.[63] Had courts applied this holding to "copy" problems in the publication field, we would now be struggling with reasoning that would logically demand that an illegible videotape not be deemed a copy, but that a motion picture film (at least the visual side) be treated otherwise. Instead, however, courts generally have assumed that both phonograph records and motion pictures (including the sound tracks) are enough like "copies" [64] so that there is publication if their distribution is sufficiently unrestricted. The cases thus turn on the manner of distribution.

Publication has almost uniformly been found where there is an outright sale of a mechanical reproduction to the general public. Until 1950, however, the rule was thought to be other-

[61] Stanley v. Columbia Broadcasting Sys., Inc., 192 P.2d 495 (Cal. App. 1948), *aff'd*, 208 P.2d 9 (Cal. 1949), *aff'd on reargument*, 35 Cal. 2d 653, 221 P.2d 73 (1950).

[62] See, *e.g.*, Warner, *Protection of the Content of Radio and Television Programs by Common Law Copyright*, 3 VAND. L. REV. 209 (1950); Nimmer, *supra* note 51, at 196–97.

[63] White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1 (1908).

[64] Shapiro-Bernstein & Co. v. Miracle Records Co., 91 F. Supp. 473, 475 (N.D. Ill. 1950). *Cf.* WARNER 176.

wise, lawyers in the phonograph record industry having assumed that the sale of a recorded song did not constitute publication, and thus dedication, of the tune.[65] Their theory was that the recording constituted merely a "captured performance," [66] and thus would logically be treated like the live performance cases. They therefore advised their clients not to secure a copyright for a song prior to recording it, so as to avoid the fifty-six year copyright limitation and compulsory license provisions imposed by the statute.[67] The confidence of the Copyright Bar was severely challenged, however, by Judge Igoe in *Shapiro, Bernstein & Co. v. Miracle Records Co.*,[68] a suit in which plaintiff claimed defendant's song, "Long Gone," infringed his common-law copyright in "Yancey Special." The court held that plaintiff was not the original composer of "Yancey Special," and thus possessed no common-law rights to be infringed, but added in dictum that even if plaintiff had a common-law copyright, he had lost it through publication by permitting recordings of the song to be sold. The dictum was given more solid footing in Judge Igoe's subsequent opinion denying a motion for new trial, which rested squarely on the rule that sale of a recording "in every city, town and hamlet" [69] constitutes divesting publication of the underlying song if a statutory copyright is not previously secured. The case has since been given added strength through dictum in at least two other cases,[70] and perhaps a holding in a third, although the basis of decision there is not clear.[71] All these cases involved the sale of phonograph records, but the

[65] KAPLAN & BROWN, CASES ON COPYRIGHT 73 (1960). The industry attorneys received some meager support from a California district court's short opinion in Yacoubian v. Carroll, 74 U.S.P.Q. 257 (S.D. Cal. 1947).

[66] Apparently Kaplan's term. See Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 480 (1955).

[67] *Id.* at 472, n. 20; Roberts, *supra* note 55, at 140.

[68] 91 F. Supp. 473 (N.D. Ill. 1950). [69] *Id.* at 475.

[70] McIntyre v. Double-A Music Corp., 166 F. Supp. 681 (S.D. Cal. 1958); Mills Music, Inc. v. Cromwell Music, Inc., 126 F. Supp. 54, 69–70 (S.D.N.Y. 1954).

[71] Biltmore Music Corp. v. Kittinger, 29 Cr. Dec. 32, 37 (S.D. Cal.), *modified*, 238 F.2d 373 (9th Cir. 1954), *cert. denied*, 352 U.S. 954 (1956).

rule appears identical in the rare case in which a motion picture is sold to the general public.[72]

The only major deviation from an otherwise uniform treatment of sales cases arose in the Second Circuit's opinion in the *Capitol Records* case,[73] in which plaintiff sought an injunction against the manufacture and distribution of a particular phonograph record on the theory that plaintiff retained a common-law copyright in the master recording. The court first held that the recording itself was not copyrightable under the federal statute, and concluded that divestment of common-law rights through publication is to be decided under state law. The court then held that under the law of New York sale of a phonograph record does *not* dedicate rights therein, and that plaintiff was still able to secure his injunction. Learned Hand dissented, but only on the choice of law, agreeing that New York law was as the majority found it. Both opinions rely entirely on two earlier decisions. The first, *RCA Mfg. Co. v. Whiteman,*[74] decided by the Second Circuit itself, had held that any common-law rights bandleader Whiteman might have had in his recorded renditions were lost upon sale of the records, so that he could not later enjoin a radio broadcast of the records.

In *Capitol Records,* however, it was stated that *Whiteman* merely involved an interpretation of New York state law, which the New York Supreme Court later repudiated in *Metropolitan Opera Ass'n v. Wagner-Nichols Recording Corp.*[75] That case involved a suit to enjoin defendant from recording off the air live broadcasts of Metropolitan Opera performances. The court rejected defendants' contention that plaintiff had dedicated all rights he had in the performance by per-

[72] Universal Film Mfg. Co. v. Copperman, 212 Fed. 301 (S.D.N.Y. 1914); WARNER 168.

[73] Capitol Records, Inc. v. Mercury Records Corp., 221 F.2d 657 (2d Cir. 1955).

[74] 114 F.2d 86 (2d Cir. 1940).

[75] 199 Misc. 786, 101 N.Y.S.2d 483 (1950), *aff'd,* 279 App. Div. 32, 107 N.Y.S.2d 795 (1951).

mitting the broadcasts, and granted the injunction. Plaintiff also, however, had permitted Columbia Records to record special studio performances of the same operas later broadcast over the air, and it was this fact upon which the court in *Capitol Records* pinned its argument that *Metropolitan Opera* had repudiated *Whiteman*. It would have been "capricious," [76] said the court in *Capitol Records*, for the court in *Metropolitan Opera* to enjoin defendant from recording the stage performances if *Whiteman* was accepted as the law, for that would have left defendant perfectly free merely to copy the performances as recorded on the Columbia records, sale of such records being dedication of all rights therein under *Whiteman*. Thus, the Second Circuit concluded that *Whiteman* was no longer the law, and that under New York law neither a live radio broadcast of a performance nor the sale of recordings of a performance constitutes dedication.[77] But the Second Circuit's reasoning calls for closer scrutiny. In the first place, it does not follow from the decision in *Whiteman* that anyone can rerecord a recording sold to the public and resell it under a new label. *Whiteman* held only that records, having been sold, cannot be prohibited from use on the radio by an "equitable servitude." But the generally accepted doctrine of "unfair competition" frequently has been asserted to prevent the sale of rerecordings.[78] Moreover, the "capriciousness" the Second Circuit wanted to avoid really can occur only in the rare case in which there is both a recordable live performance and a separate recording of a performance of the same work by the same artists. For perhaps just this reason other jurisdictions have not seen fit to reject the distinction

[76] 221 F.2d at 663.

[77] This reasoning seems to have caused some confusion in the New York courts themselves. *Compare* Gieseking v. Urania Records, 17 Misc. 2d 1034, 155 N.Y.S.2d 171 (Sup. Ct. 1956), *with* Mills Music, Inc. v. Cromwell Music, Inc., *supra* note 70.

[78] *Cf.*, Fisher v. Star Co., 231 N.Y. 414, 132 N.E. 133 (1921); Madison Square Garden Corp. v. Universal Pictures Co., 255 App. Div. 459, 7 N.Y.S.2d 845 (1938). See generally, Ringer, *supra* note 7, at 8–20.

that while live broadcasts do not dedicate, sale of records does.[79] In fact, Learned Hand himself—and perhaps the full court—would have found that the federal law was that sale of records does dedicate (otherwise he would have concurred instead of dissented) in the face of clear holdings elsewhere that live broadcasts do not.[80] (And with national distribution of records and broadcasts, only a uniform national rule would effectively avoid the capriciousness.) Finally, the opinion in *Capitol Records* fails to recognize that each performance of a musical work—one in the recording studio and the later one on stage—is unique, just as legally separate copyrights often can be taken on different versions of the same work by the same author.[81] It is not unreasonable to suppose that the defendant in *Metropolitan Opera* was interested only in the "live" stage performance, with the spontaneity of a theater audience, and would not have been content to rerecord the polished studio performances captured on the Columbia records, even if doctrines of "unfair competition" did not prohibit it.[82]

But even if all the "sales" cases can be reconciled, the videotape question is not necessarily decided. For, unlike phonograph records, which usually are sold outright to the general public, a videotape is made by a television network and usually leased to its affiliates for exhibition to the general public, or not distributed at all and exhibited directly by the network itself.[83] Although something resembling a tangible copy thus is made (at least in the same way that a phonograph record can be called a "copy"), there is only a limited distri-

[79] *Compare* Stanley v. Columbia Broadcasting Sys., Inc., *supra* note 61, *with* McIntyre v. Double-A Music Corp., *supra* note 70.

[80] Indeed, this would seem to be required in the Second Circuit, unless the dictum in *Mills Music*, *supra* note 70, decided the year before *Capitol Records*, is to be rejected.

[81] *Cf.* Gross v. Seligman, 212 Fed. 930, 931 (2d Cir. 1914); Kalem Co. v. Harper Bros., 222 U.S. 55 (1911); REVISION REPORT II, at 13.

[82] *Cf.* Kaplan, *supra* note 32, at 427.

[83] *Cf.* WARNER 171; Nimmer, *supra* note 51, at 198.

bution to a select group of lessees.[84] Accepting the general view that publication requires an unrestricted distribution to all comers,[85] it can be argued that there is at best only a "limited publication" of a videotape, not enough to divest common-law rights.[86]

Indeed, the argument receives strong support in the language of some early cases in the motion picture industry, which distributes its films as networks distribute videotapes, by leasing and exhibition.[87] Although it was held that leasing books constitutes a general publication,[88] it was held by a lower New York court in *DeMille v. Casey* [89] that neither leasing nor exhibition of a film causes publication. Mere leasing was too restricted to be a general publication; exhibition, too much like an intangible stage performance to constitute dissemination of "copies." [90] More authoritatively, it was held by the Second Circuit in *Patterson v. Century Prods., Inc.*[91] that the exhibition of films, distributed by gratuitous loan, did not constitute general publication so as to deprive the film of copyright protection as an unpublished work under what is now section 12 of the Act.

> Public exhibition is not necessarily a general publication merely because the public generally is shown the work. The test of general publication is whether the exhibition of the work to the public is under such conditions as to show dedication without reservation of rights or only the right to view or inspect it without more.[92]

Although the "leasing and exhibition" cases involve motion

[84] Nimmer, *supra* note 51. [85] *Id.* at 187; WARNER 866–69.

[86] Thus, some writers feel that mere leasing does not constitute publication, but exhibition does. Nimmer, *supra* note 51, at 198; LATMAN 64. Others argue that exhibition does not publish, but leasing does. WARNER 171, 280–82.

[87] WARNER 873–74, Nimmer, *supra* note 51, at 197; Aronson, *The Development of Motion Picture Copyright*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER THREE 339, 352 (1940).

[88] Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Publishing Co., 155 N.Y. 241, 49 N.E. 872 (1898).

[89] 121 Misc. 78, 201 N.Y. Supp. 20 (Sup. Ct. 1923). [90] *Ibid.*

[91] 93 F.2d 489 (2d Cir. 1937), *cert. denied*, 303 U.S. 655 (1938).

[92] *Id.* at 492.

pictures, it is thought that a similar distribution of phonograph records would save the recorded work from dedication.[93]

Despite the *DeMille* and *Patterson* cases, however, motion picture lawyers, perhaps more conservative than their brethren in the record industry, generally have assumed that somewhere in the complex process of leasing, shipping, and exhibiting a film, the magic line of publication is crossed.[94] Indeed, their wariness may have been well taken in view of *Blanc v. Lanz*,[95] a well-publicized lower state court decision construing a California statute. Plaintiff there was the creator of a "musical laugh" used in movie cartoon sound-tracks as the voice of Woody Woodpecker. Defendant had copied the laugh—but apparently not plaintiff's vocal rendition of it recorded in the sound track—as part of a popular song. His defense in the ensuing infringement action was that plaintiff, by permitting the laugh to be recorded without first having secured a copyright for it, had published divestively all rights. The court rejected plaintiff's argument, made in reliance on *Patterson*, that recording the composition on a film sound track, later leased to theaters and exhibited on the screen to the general public, constituted merely a "performance," not general publication, and held that

> the distribution and exhibition of these films in commercial theaters throughout the world . . . constitutes so general a publication of the contents of the film and its sound track as to result in the loss of the common law copyright. The fact that the copies of the film were leased rather than sold does not prevent the distribution from constituting a "publication" resulting in the termination of the common law right.[96]

The case seems especially important to videotape recordings of television programs because of the court's emphasis that

[93] See, *e.g.*, Mills Music, Inc. v. Cromwell Music, Inc., 126 F. Supp. 54, 70 (S.D.N.Y. 1954). See also Kaplan, *supra* note 32, at 416. Thus, the making of a videotape for staging purposes, without its ultimate exhibition, would probably constitute no dedication.

[94] WARNER 168–69.

[95] 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

[96] *Id.* at 142.

plaintiff had not been content merely to perform his composition "live," but elected to memorialize it in "tangible form." [97]

The case may have its limitations, however. For one thing, the court tried to sidestep the *Patterson* decision on the theory that distribution of the film there had been on a noncommercial basis. But the rule has never been that an otherwise general publication can be avoided simply by making the distribution gratuitously.[98] More important, since *Blanc* does not strictly involve a determination under the Federal Copyright Act, its value as precedent in that area is questionable. Moreover, given the implication in *Capitol Records* that questions about the dedication of common-law rights through publication are determined, under *Erie*,[99] by state law only when the work cannot be copyrighted under the federal statute, federal courts are not bound by *Blanc* if videotapes are made copyrightable. Even if videotapes are not copyrightable, and dedication problems are referred to state law, *Blanc* may be far from uniformly accepted. Very recently, for example, a lower New York state court rejected *Blanc* and, reaffirming *DeMille*, held that under its law, distribution and exhibition of a motion picture by the usual means dedicated nothing.[100] Finally, although *Blanc* talks as though the publication took place in the entire film, the dissemination actually used only the sound track. *Blanc* thus may come to be considered merely a hybrid phonograph record case, and *Patterson* still considered the

[97] *Ibid.*

[98] See, *e.g.*, White v. Kimmell, 193 F.2d 744 (9th Cir.), *cert. denied*, 343 U.S. 957 (1952).

[99] Erie R. Co. v. Tompkins, 304 U.S. 64 (1938). *Compare* WARNER 879–81, *with* Kaplan, *supra* note 32, at 415–28. Congress might wish to consider the application of Erie principles to problems of dedication in deciding whether to extend protection of the statute to videotapes. For if they decide against it, under Capitol Records the holder of various unregistered common-law rights in a tape runs the risk of inconsistent dispositions of his interests. *Cf.* Judge Hand, dissenting in Capitol Records, 221 F.2d 657, 667; WARNER 880–81.

[100] Brandon Films, Inc. v. Arjay Enterprises, Inc., 33 Misc. 2d 794, 230 N.Y.S. 2d 56 (Sup. Ct. 1962). This case, however, is itself subject to a possible distinction in that it involved ownership of property under the U.S. Trading with the Enemy Act, over which the court did not feel it had jurisdiction.

leading authority in an unblemished line of motion picture leasing and exhibiting cases.

Nonetheless, there is a certain air of unpredictability about the law of publication—both in the sales and lease-exhibit cases—that would suggest the need for an express determination, one way or the other, by the current copyright law revisers. But to them has fallen a rather delicate problem. They could have required that a performance "captured" on videotape results in a divesting publication of the underlying script or musical score for which no statutory copyright had been secured. This might have caused songwriters and scriptwriters to abandon their perpetual monopolies and begin securing the limited statutory protection—and with it such other restrictions as the compulsory license provision—as a matter of course. Or, it may simply have driven them away from videotapes completely, hardly a flattering acknowledgment for allowing videotapes protection of the Act. Unfortunately, there is no way to predict which alternative the writers will choose, since it depends primarily on the relative economics in the industry, which can easily change from year to year. On the other hand, the revisers could expressly have permitted writers to use their uncopyrighted material on videotapes without risking forfeiture. But this might have gone a long way toward creating perpetual monopolies in creative works, strongly disapproved by many writers.[101] In fact, the revisers have taken neither of these narrower courses, but have recommended broadly that divestitive publication occur whenever a "copyrightable work is publicly disseminated by the publication of copies, registration in the Copyright Office, public performance, or the public distribution of sound recordings." [102]

[101] Roberts, *supra* note 55, at 123; Kaplan, *supra* note 32, at 435. *But see* WARNER 878.

[102] REVISION REPORT 43. "Apparently, the Copyright Office began receding from this position late in 1962, and has subsequently put forward alternative suggestions. Whether this change in the recommendations will be permanent, and, if so, what will emerge, is still unclear."

This view appears to extend even further than *Blanc v. Lanz*,[103] for if live performance causes dedication, it seems to follow *a fortiori* that public exhibition of a recorded performance would. The recommendation thus completely rejects the traditional definitions of "publication" and the ensuing emphasis upon "live performance" versus "tangible copy" as the line of demarcation, and in so doing more closely comports with the several policies supposedly at the base of the federal copyright system. The earlier emphasis on the tangible nature of what was publicly distributed may have been useful in enabling the courts and writers to do justice to the given definitions of "publication," but it means little as a basic justification for the outcome. If the rule (that publication ensued only when a tangible item was distributed to the public) was designed to prevent songwriters and authors from retaining perpetual rights while exploiting their work,[104] then all exploitations—even live performances and mechanical reproductions, whether sold or leased, distributed or exhibited—should have been held to dedicate. The fact of tangibility is irrelevant to the policy against perpetual monopoly. Moreover, the "sale" cases appear to work directly contrary to the "lease-exhibit" and "live performance" cases in securing for creative artists a maximum reward, another frequently mentioned goal of the law,[105] for their rewards would appear to be maximized when they can avoid the limitations of the Act completely and still exploit their work by an efficient means *ad infinitum*. Finally, there is still a third basic policy, al-

[103] *Supra* note 95.

[104] Strauss, *Protection of Unpublished Works 13, Study No. 29*, U.S. COPYRIGHT LAW REVISION STUDIES (1957); Morrison, *Copyright Publication: The Sale and Distribution of Phonograph Records*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER TEN 385, 369–99 (1959); Kaplan, *supra* note 66, at 469–70, 480–81.

[105] REVISION REPORT 56; Chafee, *supra* note 16, at 509; McConnell, *The Effect of the Universal Copyright Convention on other International Conventions and Arrangements*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER NINE 32, 45 (1958).

though frequently overlooked,[106] which is directly undermined if exhibition of mechanical reproductions dedicates but live performances do not—the encouragement of others to make creative use of basic works. If any public exhibition of a mechanically recorded performance dedicates the underlying work, songwriters and authors may concentrate heavily upon live presentations, wasting the artistic potentiality of the mechanical devices. But if all performances are held to dedicate, none has a favored position. Moreover, since the mechanical reproductions are themselves copyrightable under the proposed revision,[107] their value is secured for a sufficient time to induce producers to find profitable use for them.

ABANDONMENT OF COPYRIGHTED WORKS AND EXCLUSIVE CONTROL OVER

Public Domain Material. If videotapes are copyrighted under the Act, section 3 assures that public distribution or exhibition will work no abandonment of component copyrighted or copyrightable works through publication. Conversely, it seems unlikely that a producer, by securing a copyright upon a videotaped performance of a work already in the public domain, can include the basic work under his statutory monopoly to the exclusion of all others. For what would be copyrighted would be the videotaped work itself, the originality in the videotaped production added to the underlying script or musical composition—a second tier of creative contribution.[108] Thus, it is generally held that a work must display some degree of originality to be copyrighted, but generally the demands are quite low. "Original in reference to a copyrighted work means that the particular work owes its origin to the author. No large measure of novelty is necessary." [109] Presumably, therefore, a television performance captured on videotape will be pro-

[106] *But see* Chafee, *supra* note 16, at 511–13; McConnell, *supra* note 105.

[107] REVISION REPORT 11.

[108] Dorsey v. Old Sur. Life Ins. Co., 98 F.2d 872, 873 (10th Cir. 1938).

[109] Alfred Bell & Co. v. Catalda Fine Arts, Inc., 191 F.2d 99, 102 (2d Cir. 1951). See also WARNER 42–50. For a somewhat stricter view see Amsterdam v. Triangle Publishing, Inc., 189 F.2d 104 (3d Cir. 1951).

tected in that it has contributed lighting effects, a particular dramatic interpretation, "stagings," camera angles, and varying tempos to the original, separately copyrighted, script.[110]

As a matter of practice, however, it may be possible for a television network to expand its exclusive rights into the realm of the public domain by the simple expedient of videotaping performances of public domain material. Since the cost of producing a separate television performance is prohibitively high for typical independent television stations, they rely almost exclusively on the networks to supply major dramatic and musical presentations. If their supply is limited to spontaneous networking, however, the local stations are forced either to take the show when presented or not at all, and they cannot later offer rebroadcasts if the show turns out to be in great demand. Local stations, therefore, would like to tape the network's presentation for a permanent file, but since under present law a "live" broadcast does not publish its contents, any later replaying of the tape without royalty payments may constitute infringement of the tape or a violation of the "unfair competition" doctrine.[111] On the other hand, if the live performance becomes a dedication but a videotape of it is copyrightable, the networks have but to prerecord the performance, copyright it, and broadcast the taped rendition to prevent the local stations from playing their own tape of the network's presentation. Thus, the only way a local station, in terms of economic realities, can independently televise a performance of a given work, even if it is in the public domain, is to buy or lease from the network a copy of its videotaped per-

[110] Warner, *supra* note 62, at 216. Indeed, videotaped productions of a drama contain as much originality as motion pictures, which never had any difficulty meeting this condition. *Cf.* Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53 (1884) (on the originality in a still photograph); Dworkin, *Originality in the Law of Copyright*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER ELEVEN 60, 77 (1962). The proposed revision does not seem to suggest tightening the standards of originality (REVISION REPORT 9), but some of its critics would have it otherwise (REVISION REPORT II, at 9–16).

[111] *Cf.* Metropolitan Opera Ass'n. v. Wagner-Nichols Recording Corp., *supra* note 175.

formance.[112] But before it is concluded that this will undesirably expand the existing oligopoly in the network industry, consider the equal likelihood that it might stimulate the formation of a totally new "tape network" in competition with the other three. It seems advisable, therefore, to await subsequent developments before framing counteracting legislation.

If videotapes are denied copyright status, however, there seems to be but one way in which it can affect the status of underlying works. Assume that the law should develop in the direction of *Shapiro-Bernstein*[113] and *Blanc v. Lanz*,[114] and that public exhibition of a videotape should come to constitute "publication" of its contents. Since videotapes would not themselves be copyrightable, it may be argued that any copyright notice appearing thereon would be a nullity, even if it is notice as to its contents rather than itself. The copyrighted work it contains would thus be published without a legally sufficient notice, which generally is held to dedicate it to the public domain.[115] On the other hand, it might successfully be argued that if the public exhibition of a videotape constitutes publication, it should at least be considered a "copy" for purposes of section 10, which would then permit a valid notice of the copyright on the underlying work to appear in the videotape.[116] But the issue is enough in doubt that it seems advisable

[112] In an analogous manner, members of ASCAP, by copyrighting new arrangements of musical compositions in the public domain and leasing the copyrighted version to local stations, have expanded the Society's exclusive control into the realm of public domain. WARNER 81.

[113] *Supra* note 68. [114] *Supra* note 95.

[115] Holmes v. Hurst, 174 U.S. 82 (1899); REVISION REPORT 61. *Cf.* WARNER 174–75; Strauss, *supra* note 104 (making the same argument with respect to phonograph records).

[116] The argument is helped by the tacit assumption in the wording of section 10 that any publishing device is a "copy." An argument like this succeeded before a South Carolina district judge, who, on the same day, held that the absence of notice on a pianola roll and phonograph record did not throw the underlying copyrighted song into the public domain. Buck v. Lester, 24 F.2d 877 (E.D.S.C. 1928) (pianola roll); Buck v. Heretis, 24 F.2d 876 (E.D.S.C. 1928) (phonograph record). Moreover, because mechanical reproductions, or, for that matter, any television or radio broadcast, can easily be reproduced with modern recording devices, there seems to be greater need today than when section 10 was passed to protect copyright holders by a liberal notice provision.

that if Congress accepts the revisers' suggestion to make every public performance a dedicating publication, but rejects the suggestion to make videotapes copyrightable, some provision should be made for notice of the copyright status of underlying works to accompany an uncopyrightable reproduction.

INVESTMENT OF STATUTORY COPYRIGHT

The "publication" necessary to secure the normal statutory copyright probably will be satisfied by any act that constitutes divestitive publication, since the standards for the latter are generally considered much stricter.

> The copyright cases . . . suggest that (a) where common law protection is sought because a federal copyright has not been applied for, the courts will require considerably more open dissemination before holding that publication has taken place so as to deprive the creator of the material of his rights in it, than (b) where a copyright certificate has been obtained and the plaintiff is claiming sufficient publication to enable him to maintain an action on the federal statute.[117]

Moreover, regardless of whether leasing and exhibiting a videotape is divestitive publication, there is ample precedent for holding it to be investitive publication,[118] although merely filing a tape in the Copyright Office may not be good enough.[119]

The filing requirement does raise a slight problem, however, since section 13 requires that two "copies" of the work be filed in the Copyright Office prior to securing a statutory copyright. Although the Office accepts positive prints of a motion

[117] American Visuals Corp. v. Holland, 239 F.2d 740, 743 (2d Cir. 1956).

[118] Thus, while mere exhibition of a painting in an art gallery did not constitute divestitive publication, Werckmeister v. American Lithographic Co., 134 Fed. 321 (1904), the identical facts were enough to constitute publication enabling protection under the statute, Werckmeister v. Price & Bushnell Mfg. Co., 72 Fed. 54 (1896). See also Kaplan, *supra* note 66, at 484–85.

[119] WARNER 178. *But see* Cardinal Film Corp. v. Beck, 248 Fed. 368 (S.D.N.Y. 1918) and Stern v. Jerome H. Remick & Co., 175 Fed. 282 (S.D.N.Y. 1915). In any event, it seems quite clear that mere filing of copies in the Copyright Office is not divestitive publication. Osgood v. A. S. Aloe Instrument Co., 69 Fed. 291 (E.D. Mo. 1895). The liberal definition of publication currently being recommended would permit investitive publication simply by filing a copy with the Copyright Office. See note 102 *supra*, and accompanying text.

picture film,[120] it has specifically ruled that "phonograph records, tape recordings, and other sound recordings are not regarded as 'copies' of the material reproduced on them. The Copyright Office therefore does not accept recordings for deposit. . . ." [121] Although the Office has apparently considered a videotape a copy for registration, it might be wise expressly to so provide by amendment to the Act if videotapes are given express copyright protection.

REGISTRATION OF UNPUBLISHED WORKS

Section 12 permits, but does not require,[122] the statutory copyright to be secured on certain works "not produced for sale," a term which has come to mean "unpublished" works.[123] Since videotapes have been treated by the Copyright Office like motion pictures, which are accorded the privileges of section 12, chances are that tapes, too, will be brought under the provision. Nevertheless, for many of the same reasons discussed earlier in connection with the extension of section 5 to videotapes, there is enough doubt on the correctness of the Office's policy that express provision should be made, one way or the other, in the Act.[124]

Most of the problems created by section 12 have been analyzed elsewhere,[125] but there remain a few of particular relevance to videotapes. Since protection under section 12 is lost upon "publication," one question arising immediately is whether this publication is tested by the stricter divestitive, or the more liberal investitive, criteria. If anything, it seems that it is even more difficult to lose section 12 protection through publication than to lose common-law rights. For instance, the

[120] COPYRIGHT OFFICE, CIRCULAR 7 (1962).
[121] COPYRIGHT OFFICE, CIRCULAR 54 (1962).
[122] REVISION REPORT 39; Kaplan, *supra* note 66, at 478–79.
[123] LATMAN 108–09; WARNER 237. See also Patterson v. Century Prods, Inc., 93 F.2d 489 (2d Cir. 1937), *cert. denied*, 303 U.S. 655 (1938).
[124] The current revisers seem to recommend the inclusion of videotapes under Section 12. REVISION REPORT 42.
[125] WARNER § 72.

same court ruled that the sale of a phonograph record does not publish the musical composition for section 12 purposes [126] but does as far as common-law rights are concerned,[127] although the latter case made no mention of the former and may be construed to have overruled it. Assuming that *Blanc v. Lanz* [128] is good law, moreover, the same dichotomy exists in the lease-exhibit cases involving motion pictures.[129]

More important, it still is not clear what the effect of choosing section 12 is upon one's common-law rights. Although it is generally stated that an individual abandons all common-law rights by availing himself of section 12,[130] dictum in one case, *Loew's Inc. v. Superior Court of Los Angeles*,[131] casts doubt on such a broad generalization. The plaintiff, who had registered a dramatic composition as an unpublished work under section 11 (now section 12), brought suit in a state court, claiming defendants' motion picture had infringed his exclusive right to dramatize the work. Defendants moved to dismiss on the theory that by registering the work under the federal Act plaintiff no longer possessed any common-law rights in the work, and all rights were measured by the statute, over which federal courts had exclusive jurisdiction. On the understanding that plaintiff was not suing for infringement of his right to *publish* the work, but of his right to dramatize it,[132] the court granted defendants' motion, holding that the "rights of one who proceeds under the statute should thenceforth be measured by the provisions of the statute." [133] In dictum, however, the court discussed what would have happened had plaintiff alleged an infringement of his right to first publication. In

[126] Yacoubian v. Carroll, *supra* note 65.

[127] McIntyre v. Double-A Corp., *supra* note 70. [128] *Supra* note 95.

[129] *Compare* Blanc v. Lanz, *supra* note 95, *with* Patterson v. Century Prods, Inc., *supra* note 123.

[130] See Shilkret v. Musicraft Records, Inc., 131 F.2d 929 (2d Cir. 1942), discussed in WARNER 238–39; LATMAN 11.

[131] 18 Cal. 2d 419, 115 P.2d 983 (1941).

[132] *Cf.* Nimmer, *supra* note 15, at 72. [133] 18 Cal. 2d at 424, 115 P.2d. at 986.

that case, the court assumed, "the author or his assignee still has the common law right of first publication, redress for the infringement of which it is also assumed may be sought in the state courts." [134] Thus, the state courts are free to decide whether someone has infringed an author's rights by publishing his work registered under section 12, but not by dramatizing or making other uses of it. The question left open was whether state courts are also free to decide whether the plaintiff lost his section 12 protection by exercising his "common law right of first publication." If so, a videotape producer who wants to sell the tape or exhibit it on network television is little blessed by section 12, for he opens himself to inconsistent state determinations of whether the dissemination constitutes divesting publication. If not, then section 12 gives the producer a right to pick his forum according to its views on publication, either by electing or ignoring [135] section 12, hardly commensurate with the desire to provide uniformity through a federal copyright act. This determination, of course, would be based upon his view of the relative advantages and disadvantages of statutory, as opposed to common-law, protection of his other rights. The problem might be alleviated, however, if the federal statute itself specifies what constitutes publication for purposes of section 12, or by the elimination of section 12 entirely.

Indeed, the direction being taken by the current revisers invites serious consideration of the latter suggestion. It is generally agreed that the "act of grace" [136] accorded by section 12 was designed to give added protection to authors of works primarily disseminated by methods that do not constitute publication, specifically by providing that the certificate of registration is *prima facie* evidence of ownership in a later infringe-

[134] *Id.* at 426, 115 P.2d at 987. *But see* section 1(a), which gives the copyright holder the exclusive right to "publish" the work.

[135] It was held in *Capitol Records, supra* note 6, that state law determines divestitive publication for nonregistered works.

[136] Latman's words. LATMAN 108.

ment suit, and by permitting the award of statutory damages where none actually can be proved.[137] But since the revisers suggest that practically any form of public dissemination constitutes publication, hence permitting recourse to section 5, there may be no need for section 12.[138] It would only be useful where some dissemination is made, such as a private film exhibit, which is not enough to invest statutory protection. But the more private the dissemination, the less the odds that someone will pirate the work. Weighed against this possibility, furthermore, are the other problems created by section 12 already discussed,[139] and the balance may now favor eliminating the provision. The revisers, however, have felt otherwise, and recommend not only the retention of section 12, but its extension over all unpublished works voluntarily registered.[140]

INFRINGEMENT OF COPYRIGHTS BY VIDEOTAPE

Infringement by videotape, as a practical matter, generally occurs by making and publicly exhibiting an "off the air" tape [141] of creative matter contained in a live, filmed, or previously taped television program. Little difficulty is encountered, however, where there has been no publication of the material and it has not been registered under the Act—common-law copyright protects the owner against virtually any

[137] WARNER 243.

[138] On the other hand, if the exhibition of videotapes and other mechanical reproductions should eventually be determined not to constitute investitive publication, there is even more need than before to continue the section 12 option, in view of the widespread use of such devices as means of exhibition into millions of private homes.

[139] In addition, section 12 makes it even easier for a network, by videotaping performances of works in the public domain, to extend *de facto* exclusiveness into the public domain. See notes 111–12 *supra*, and accompanying text. Under section 12 the network need not even exhibit the work to obtain statutory protection.

[140] REVISION REPORT 42.

[141] *Cf.* Needham, *Tape Recording, Photocopying, and Fair Use*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER TEN 75, 100–02 (1959).

unauthorized use of his work.[142] But where the material has been brought under the Act, protection is limited to the uses specifically enumerated in section 1.[143]

RIGHT TO COPY

Among the rights secured copyright holders by section 1, those in subsection (a) (to "print, reprint, publish, copy and vend") have been called the "most fundamental";[144] and of these, the right to "copy" is considered crucial.[145] Thus, the question is whether a videotape constitutes a "copy" within the meaning of section 1(a). Just as a live television show is believed neither copyrightable nor a publication because of its "evanescent" nature, this intangibility is said to preclude it from being an infringing "copy" as that word has been construed for purposes of section 1(a).[146] If so, it would seem clear that a taped television program is a copy, and thus an infringement, of its contents. Unfortunately, this has not been quite so clear to the courts. An early case held that a piano roll was not a "copy" of the underlying tune under common definitions, because the tune itself could not be read from the roll.[147] The court also recognized a tangibility test, but apparently held that this required that the underlying work itself be reproduced in tangible form, not merely reduced to such a form,[148] and that an unintelligible notation satisfied only the latter. The court's dictum that a phonograph record also could not constitute a "copy" for purposes of section 1 (a)[149] was elevated to a holding in a later case.[150] These cases, standing alone, would thus seem to dispose of videotapes without much

[142] WARNER § 202.

[143] Discussion in this section concerns rights to basic works—scripts, novels, songs, paintings, etc.—as opposed to copyrights in other videotapes, assuming videotapes copyrightable. The latter will be discussed in the next section.

[144] Nimmer, *supra* note 15, at 62.

[145] It "comprehends the rights to print, reprint and publish." WARNER 269.

[146] Nimmer, *supra* note 15, at 62.

[147] White-Smith Music Co. v. Apollo Co., 209 U.S. 1 (1908).

[148] *Id.* at 17. [149] *Id.* at 17–18.

[150] Corcoran v. Montgomery Ward & Co., 121 F.2d 572 (9th Cir. 1941).

debate, for videotapes likewise are unintelligible to the eye.[151]

The only apparent way around this, short of amending the Act, is to apply the holding of *Patterson v. Century Prods., Inc.*[152] to videotapes. In that case defendant had made a positive of the negative of defendant's motion picture film and had exhibited it publicly in various theaters. The court held that plaintiff's film had been copied, not only by making the positive itself, which of course was clearly intelligible when held up to light, but also, contrary to earlier decisions,[153] by exhibiting it on the screen. This holding may be construed to have broadened the base of the readability test quite significantly, for under *Patterson* there seems to be intelligibility even though the image captured on a mechanical device can be "read" only with the aid of a reproducing instrument. If so, the image produced by a videotape on a television screen can also be a copy.

Patterson is rather a maverick, however, and its application to videotape without an express legislative mandate seems doubtful, especially since it would raise some curious, although probably not insurmountable, problems. For one thing, taken to its logical extreme it could render every private television viewer a copier simply by switching on his set and causing the tape to be exhibited,[154] since the copy provision is not limited by requirements that the copy be made public or produced for profit.[155] It could also foreclose the use of private tapes taken off the air for noncommercial purposes, which someday may become economically as feasible as magnetic sound tapes are now. Since courts certainly would not be anxious to reach such harsh results without express legislative direction, they may be quite prone to let *Patterson* drop by the

[151] Meagher, *supra* note 42, at 1098. [152] *Supra* note 123.

[153] *E.g.*, Tiffany Prod. v. Dewing, 50 F.2d 911 (D. Md. 1931) (dictum).

[154] *Cf.* Buck v. Jewell-LaSalle Realty Co., 283 U.S. 191 (1931), holding that a hotel owner violated the right to perform a musical composition by switching on a radio station which was broadcasting the song and allowing it to be played over speakers installed in the defendant's hotel.

[155] *Cf.* LATMAN 139.

wayside.[156] Furthermore, because *Patterson* could not overrule *White-Smith*, their dual existence could produce some rather touchy problems. Presumably the *White-Smith* distinction between reproducing a basic work itself in tangible form and its mere reduction to tangible form would remain. Thus, although the exhibition of a videotape would be a copy of visual works, such as paintings or sculptures in the rare case in which they are reproduced on tape,[157] it would not necessarily be a copy of an underlying script or musical composition.[158] Suppose, for example, there is exhibited a tape of an authorized production of a dramatic work, which knowingly, but without permission, uses a copyrighted painting in the background. Section 1(a) would allow the proprietor of the rights in the painting to obtain damages, perhaps even enjoin the entire production, even though his work is used only incidentally.[159] But if the opposite were true, and the dramatic work were being taped without a license, the script writer would have no remedy under section 1(a). Even though exploitation of his work was at the core of the production, it was merely being reduced to tangible form, but not itself copied.[160]

DRAMATIZATIONS AND OTHER VERSIONS

Of the several rights secured by section 1(b), the rights to "make any other version" of a literary work and to "dramatize" a nondramatic work seem particularly relevant to videotapes. It is fairly clear, however, that the former can be

[156] Needham, *supra* note 141, at 98–102.

[157] Presumably the work would have to be given reasonable prominence, otherwise it might be deemed a "fair use." WARNER 580, 584–85, however, thinks that it will not take too much to be an infringement.

[158] Judge Chase in *Patterson* distinguished *White-Smith* in this manner in holding that projection of the movie onto the screen "copied" plaintiff's film. 93 F.2d at 494.

[159] *Cf.* Hawkes & Sons, Ltd. v. Paramount Film Serv., Ltd. [1934], 1 Ch. 593, 50 T.L.R. 363. If the work is displayed unintentionally, however, the infringer will probably be liable only for $100 in damages. WARNER 584–85.

[160] For many of these reasons, the copyright revisers recommend the burial of *Patterson* in the motion picture field (REVISION REPORT 28–29), but the adverse reaction in the film industry has been rather strong. REVISION REPORT II, at 52–53, 347–50, 404–07.

exercised only with something that meets the section 1(a) requirements of a "copy," [161] and thus adds nothing to protections afforded by the earlier subsection.[162]

The same is said of the right to dramatize,[163] but the case law may suggest a somewhat different result. The principal case is *Kalem Co. v. Harper Bros.*,[164] in which plaintiff, holder of the copyright on the novel *Ben Hur*, claimed defendant's silent motion picture version of the story infringed his exclusive right to dramatize the work, but made no claim of a right to copy. Mr. Justice Holmes held that the film was a "dramatization" within the meaning of the Act, because even a silent motion picture photoplay does basically the same thing that the usual stage dramatization does:

> if a pantomime of Ben Hur would be a dramatizing of Ben Hur, it would be none the less so that it was exhibited to the audience by reflection from a glass and not by direct vision of the figures. . . . The essence of the matter . . . is not the mechanism employed but that we see the event or story lived.[165]

It seems, therefore, that for purposes of section 1, although perhaps not for other sections of the Act, similarity of use bridges the gap between the traditional communication devices and the modern.[166] Since production,[167] distribution,[168] and exhibition [169] of motion pictures consistently have been held to infringe the right of an underlying copyright holder to dramatize a nondramatic work, and since there has never been a dis-

[161] *Cf.* Corcoran v. Montgomery Ward, *supra* note 150, at 573; see Nimmer, *supra* note 15, at 73; REVISION REPORT 22.

[162] *Cf.* Meagher, *supra* note 42, at 1098. [163] Nimmer, *supra* note 15, at 75.

[164] 222 U.S. 55 (1911).

[165] *Id.* at 61. *Cf.* Tiffany Prods., Inc. v. Dewing, 50 F.2d 911 (D. Md. 1931).

[166] "The most innocent objects . . . may be used for unlawful purposes. And if, as we have tried to show, moving pictures may be used for dramatizing a novel, when the photographs are used in that way they are used to infringe a right which the statute reserves." 222 U.S. at 62.

[167] *Cf.* Tiffany Prods., Inc. v. Dewing, *supra* note 165.

[168] Kalem v. Harper Bros., *supra* note 164, in which defendant sold the films but did not exhibit them. *Cf.* Photo Drama Motion Picture Co. v. Social Uplift Film Corp., 213 Fed. 347 (S.D.N.Y. 1914), *aff'd*, 220 Fed. 448 (2d Cir. 1915) (dictum).

[169] Metro-Goldwyn-Mayer Distrib. Corp. v. Bijou Theatre Co., 3 F. Supp. 66, 73 (D. Mass. 1933).

tinction drawn between theater and television films,[170] videotapes could be treated similarly, for they are but a substitute for lower fidelity films. Although this analysis sidesteps completely the concept of "copy" and its inherent difficulties, and thus arguably could be applied to section 1(a), conceptually it seems less uncomfortable to apply it only with respect to dramatizations. The terms of section 1(a) seem to command that the rights be exercised only upon copies; otherwise the copyright holder has only the right to publish or sell his entire copyright interest once, and cannot exploit it while still retaining it. The statutory terms themselves appear to support this, referring merely to a "copyrighted work" instead of the broader "copyright interest." [171] But no such limitation suggests itself quite so manifestly with respect to dramatizations.

Thus, under section 1(b) it is possible that a novelist or song writer gets the protection against unauthorized videotaped productions of his work denied him by section 1(a), provided the production takes the form of a dramatic presentation.[172] But section 1(b) by no means affords full protection. Assuming *Patterson* is not applied to tapes under section 1(a), the holders of copyright interests in visual works are still unprotected, for their works never can be dramatized. More important, there is still no protection to creators of nonvisual works—poets, playrights, and songwriters, for instance —whose works are merely read or performed on the stage, not "dramatized." [173]

[170] *Cf.* 17 C.F.R. § 202.15 (1960).

[171] *Cf.* Nimmer, *supra* note 15, at 67–68, 72–73; WARNER 269, 271.

[172] Meagher, *supra* note 42, at 1098. In an unusual case, it was held that a song had illegally been "dramatized," although the reasoning is rather scanty. The "dramatization" was accomplished by playing the song "Kiss Me Again" on a piano to the action (unspecified, unfortunately) in a silent movie. Witmark & Sons v. Pastime Amusement Co., 298 Fed. 470 (D.S.C.), *aff'd per curiam*, 2 F.2d 1020 (4th Cir. 1924). Perhaps a better example would be available if someone made a movie of the melodious melodrama, "Frankie and Johnny," without permission.

[173] For a general definition of a dramatic work, see WARNER 287, who focuses on the storytelling function.

PERFORMING RIGHTS

Section 1(c) grants the copyright holder an exclusive right to read or perform a nondramatic work, section 1(d) a dramatic work, and section 1(e) a musical composition.

Although common usage of the word "perform" suggests that it is limited to live renditions, *Buck v. Jewell-LaSalle Realty Co.*[174] introduced a far broader view. In that case a hotel proprietor who provided his guests with radio speakers, but kept station selection to himself, was sued on the performance theory when the station he happened to tune in played plaintiff's song. In finding for the plaintiff the Court held broadly that mechanical exhibitions or reproductions constitute performance:

> We are satisfied that the reception of a radio broadcast and its translation into audible sound is not a mere audition of the original program. It is essentially a reproduction. . . . These radio waves are not audible. . . . The transmitted radio waves require a receiving set for their detection and translation . . . just as the record requires another mechanism for the reproduction of the recorded composition. In neither case is the original program heard; and, in the former, complicated electrical instrumentalities are necessary for its adequate reception and distribution. Reproduction in both cases amounts to a performance.[175]

Thus, rebroadcast of a network program by local stations constitutes an infringing performance,[176] unless the stations independently secure authority to reproduce the work; the same is true as to exhibition of a motion picture by a theater owner.[177] By the same token, exhibition of a videotape should constitute a performance of its contents, unless the "similar use" analogy suggested in the *Kalem* case is rejected.

From the *Jewell-LaSalle* case also has developed the "multiple performance" doctrine, which holds that every reproduction, transmission, exhibition, or original broadcast constitutes

[174] 283 U.S. 191 (1931). [175] *Id.* at 199–201.

[176] Law v. National Broadcasting Co., 51 F. Supp. 798 (S.D.N.Y. 1943).

[177] Tiffany Prods. v. Dewing, *supra* note 165; Hawkes & Sons, Ltd. v. Paramount Film Serv., Ltd., *supra* note 159.

a separate performance. Indeed, the single emission of a videotaped program from New York over a network can mushroom into literally millions of performances—one by each station rebroadcasting the signal to the general public,[178] and one by each viewer who tunes it in at home.[179] Does this mean, therefore, that each home viewer is an infringer under the performance provisions whenever he switches on his television set, just as he would be under the copy provisions if *Patterson* is applied to tapes? The performance right is qualified by a requirement that it be public, and this would most likely relieve the ordinary home viewer except for reasoning by the circuit court in the *Jewell-LaSalle* remand.[180] Having been instructed by the Supreme Court to find that reproduction of the music in hotel rooms was a performance, the lower court held it to be public solely on the ground that the original broadcast by the station was public.[181] But merely that the first of two successive performances is public does not mean that a later and admittedly separate performance also is. Thus, unlike the logic in the copy situation, this reasoning reaches its conclusion only on the crest of a perfect *non sequitur*, and hopefully will be rejected.

Even if the *Jewell-LaSalle* reasoning is followed, however, its effects may not be too severe, for the second limitation upon the performance right is that performance of nondramatic works and musical compositions be made for profit. A home viewer, therefore, would be liable only when an unauthorized videotape of a dramatic work is broadcast. On the other hand, the network and local stations can take no refuge behind this limitation, since practically all public broadcasts are held to be for profit, even sustaining programs by a nonprofit organi-

[178] Law v. National Broadcasting Co., *supra* note 176.

[179] *Cf.* Buck v. Jewell-LaSalle Realty Co., *supra* note 154. An interesting side question arises with respect to community antenna television systems, some of which actively boost or convert the signals, others of which act merely as a sort of electronic conduit. How much control is necessary to become a "performer"? See Nimmer, *supra* note 15, at 88–91.

[180] Buck v. Jewell-LaSalle Realty Co., 51 F.2d 726 (8th Cir. 1931).

[181] *Id.* at 729.

zation.[182] Nevertheless, it might be worthwhile expressly to avoid the problem by an appropriate amendment to this part of the Act.[183]

The performance provisions, however, are of limited value. Obviously they offer no protection to rights in purely visual works, which cannot be performed.[184] Moreover, whatever the outer limitations of the "public" requirement,[185] it seems fairly clear that the performance of a song or dramatic work before the videotape cameras is not a public performance,[186] although it probably would be if a live audience were present, by analogy to motion picture exhibitions. Thus, although the creators of works that can be dramatized or performed are fairly well protected against the exhibition of unauthorized tapes, they are not directly protected from the actual production of the tape.[187] This protection, if available at all, would be found in the recording rights.

RECORDING RIGHTS

Section 1(c) gives the copyright holder of a nondramatic literary work the exclusive right to record his work; section

[182] Associated Music Publishers, Inc. v. Debs Memorial Radio Fund, Inc., 141 F.2d 852 (2d Cir. 1944).

[183] The revisers, of course, oppose holding the private viewer liable, but they seem to assume there are no problems, and so make no specific recommendation. They do, however, generally recommend that the "statute . . . exempt the mere reception of broadcasts from the public performance right," a proposal designed to change the hotel and restaurant cases, like Jewell-LaSalle, and this would correct the situation. REVISION REPORT 31.

[184] Nimmer, *supra* note 15, at 79.

[185] See generally, LATMAN 138–39; WARNER 316.

[186] *Cf.* Blaisdell, *The Economic Aspects of the Compulsory License, Study No. 6*, U.S. COPYRIGHT LAW REVISION STUDIES 99, 105 (1958), pointing out that in the music industry performing licenses do not carry the initial right to record the composition and separate royalties are exacted for each function.

[187] There may be liability on the part of producers and distributors on a theory of contributory infringement. But this, too, raises problems. For example, contributory infringement is said to require proof of intent, which makes matters much more difficult than usual, especially since several middlemen may be involved before the device is transformed into a "copy." Latman & Tager, *Liability of Innocent Infringers of Copyrights, Study No. 25*, U.S. COPYRIGHT LAW REVISION STUDIES 148 (1958). *But see* Fishel v. Lueckel, 53 Fed. 499 (S.D.N.Y. 1892); Harper v. Shoppell, 28 Fed. 613 (S.D.N.Y. 1886).

1(d) grants the same right to dramatic works; and section 1(e) to musical compositions, except for the compulsory license qualification. The original recording provision, applying only to dramatic works and musical compositions, was passed in 1909 specifically to reverse the *White-Smith* [188] rule that an unauthorized piano roll or phonograph record did not infringe rights in a copyrighted song.[189] The recording rights were extended to nondramatic literary works in 1952 in reaction to a similar rule [190] involving rights in a copyrighted poem.[191] Arguably, therefore, the word "record" as used in section 1 refers only to phonograph records (and piano rolls, if they still exist), but not to motion pictures, tapes, or other modern devices that reproduce both sounds and images. Most of the commentators [192] and a pair of cases on the issue, however, suggest otherwise. For example, it was held that a motion picture can be a "record" within the meaning of section 1, although the court continued somewhat unclearly to say that it was the unauthorized *exhibition* of the movie that specifically violated the copyright holder's recording rights:

> The words in subsection (d), "any transcription or record thereof," reasonably include a motion picture photoplay depicting the drama or dramatic work, and that subdivision in terms gives the author or owner of the copyrighted drama the exclusive right to exhibit the motion picture photoplay, the transcription or record depicting the drama or dramatic work.[193]

Since disposition of the case on remand turned on a dramatization theory,[194] its authority may be somewhat limited. The Second Circuit a few years later, however, said that making an

[188] White-Smith Music Co. v. Apollo Records, 209 U.S. 1 (1908).

[189] Revision Report 23; Metro-Goldwyn-Mayer Distrib. Co. v. Bijou Theatre Co., 59 F.2d 70, 74–75 (1st Cir. 1932).

[190] Corcoran v. Montgomery Ward & Co., *supra* note 150.

[191] Latman 137–38.

[192] See, *e.g.*, Nimmer, *supra* note 15, at 110; Revision Report 23.

[193] Metro-Goldwyn-Mayer Distrib. Co. v. Bijou Theatre Co., *supra* note 189, at 73.

[194] 3 F. Supp. 66 (D. Mass. 1933).

unauthorized motion picture can violate the recording rights in an underlying copyrighted play, although the court offered no discussion of the point.[195]

If this is the law, however uncertain the authorities, the recording provisions represent one of the few places in the Act where phonograph records and motion pictures are treated alike. This being the case, any treatment of videotapes on the basis of analogy alone almost automatically requires their inclusion in the recording provisions, for they are both technologically similar to records and functionally similar to motion pictures. But although this reasoning would protect the interests of most creative artists, it probably would not protect purely visual artists—painters and sculptors, for example. Presumably their efforts would qualify as nondramatic works, but the Act extends recording rights only to nondramatic *literary* works, which, under common understanding of the term, may not be broad enough to include them.

The recommendation of the current revisers, however (securing "the right to make any form of transcription or record, visual or aural, from which the work can be performed or reproduced" [196]) seems to remove the need to rely on the vicissitudes of analogy.[197] It is obviously broad enough to encompass not only videotapes, but all mechanical reproductive devices that may be developed in the future, and, by replacing the three separate recording provisions, seems to extend protection to all basic works—literary or otherwise. Moreover, case law developed under the present Act suggests that the new provision affords protection not only from the act of recording itself, but also from the manufacture [198] and distribution [199] of the device. Coupled with protection against exhibition pro-

[195] Sheldon v. Metro-Goldwyn-Mayer Pictures Corp., 106 F.2d 45, 52 (2d Cir.), *aff'd*, 309 U.S. 390 (1939).

[196] REVISION REPORT 23.

[197] *Cf.* text accompanying notes 47–50 *supra*.

[198] Reeve Music Co. v. Crest Records, Inc., 285 F.2d 546 (2d Cir. 1960).

[199] Shapiro-Bernstein & Co. v. Goody, 248 F.2d 260 (2d Cir. 1957), *cert. denied*, 355 U.S. 952 (1958).

vided by the dramatization and performing rights, the proposed amendment thus affords nearly complete protection to basic copyright holders from unauthorized videotapes. The only gap is protection from the exhibition of tapes containing purely visual works, but this could be filled by a fairly simple provision securing the exclusive right to play or perform the recording in public,[200] with the "for profit" qualification where appropriate.[201]

The soundness of such broad protections against videotapes seems clear in view of the other changes in the copyright laws also being proposed. Since it is suggested that practically any form of dissemination constitutes divestitive publication, basic creative artists desiring to exploit their work are being forced to abandon their perpetual common-law rights for a statutory protection limited in time. This may be a serious cutback in their potential rewards and, unless the protection offered them during the limited period is complete, there could be a stifling of creative output.[202]

This broad susceptibility of videotapes to infringement liability exceeds that of live television broadcasting in one small area—live broadcasts apparently can include views of visual works with impunity, since they constitute no copy, dramatization, performance, or recording of the work. It could be argued, therefore, that producers using such works will avoid videotapes, thus wasting their potential. But this probably would overstate the case, because visual works are rarely used on tape, and where they are used, industry practice has been to resort to public domain material.[203] If custom should change, however, it may be worthwhile to buttress the mechani-

[200] At least one writer suggests that the Act already contains such provisions. Nimmer, *supra* note 15, at 86.

[201] REVISION REPORT 27–28.

[202] Complete protection is a generally recognized policy of the infringement rules, even under the current statute permitting extensive exploitation without subjection to the statutory limitations. See, *e.g.*, Chafee, *supra* note 16, at 504–05; Note, 31 N.Y.U.L. REV. 1263, 1269 (1956).

[203] WARNER 585.

cal reproduction provisions with an amendment securing the exclusive right to exhibit visual works in public.

Having decided to bring videotapes within the recording provisions, the question of whether to bring them under the compulsory license provision arises. The provision states generally that once the holder of a copyright in a musical composition permits a "mechanical reproduction" of his work to be made, he must permit all others to make a "similar use." Since this provision was originally designed specifically to prevent an oligopoly that was imminent in the phonograph record industry around 1909,[204] there has arisen great controversy on its application to other mechanical reproductions.[205] The authorities are divided, for example, on whether it applies to motion picture sound tracks [206] and to radio transcriptions.[207] But whatever its merits in the phonograph record business, it appears wholly inapplicable to videotapes. In the first place, the provision sets a maximum royalty of two cents "on each . . . part manufactured." It may be tolerable to exact no more than a two cent fee for each phonograph record of a song, but it is utterly absurd to restrict a songwriter to a reward of two cents when only one taped performance of his work is made but exhibited to seventy million people; songwriters will simply insist on live performances. Whether or not the compulsory license provision discouraged monopolistic monsters in the phonograph record industry, or merely smothered the little man, it will have no antitrust effect in the television industry. If there is to be a monopoly, it will be created through networking and option time-must buy contracts, not through videotaping, which is a comparatively minor activity. Finally, the application of the compulsory recording license rule to

[204] REVISION REPORT 32–33.

[205] *Compare* Dubin, *Copyright Aspects of Sound Recordings*, 26 So. CAL. L. REV. 139, 147–49 (1953), *with* WARNER 440.

[206] *Compare* Jerome v. Twentieth Century-Fox Film Corp., 67 F. Supp. 736 (S.D.N.Y. 1946) *with* Famous Music Corp. v. Melz, 28 F. Supp. 767 (W.D. La. 1939).

[207] See generally, WARNER 440–44.

videotape broadcasting would in effect create a compulsory performing license rule, whereby each station would have the right to perform on tape any song once similarly performed by another station. But such a rule would achieve no more than is currently accomplished by the blanket performing licenses regularly issued by ASCAP, BMI, and SESAC, under which all stations paying a certain fee are given a nearly unlimited right to use all musical compositions in the extensive repertoires of those organizations.[208] The current revisers, fortunately for videotapes, are recommending the complete abolition of the provision,[209] although not without igniting heated debate.[210] Hopefully, however, it will at least not be extended beyond phonograph records.

INFRINGEMENT OF COPYRIGHTS IN VIDEOTAPES

It means very little to be accorded copyright status under section 5 of the Act unless the particular rights thus secured under section 1 are worthwhile, and for a videotape copyright holder this means primarily protection of the exclusive right to duplicate and exhibit the tape in public. Section 1 as it now stands, unfortunately, is not readily adaptable to secure this protection completely. Although the "copy" provisions of section 1(a) may prohibit a motion picture from incorporating or being patterned after a videotaped production,[211] it is totally impotent against the same appropriation by another tape, since the second tape could not meet the *White-Smith* readability test. The translation right and the right to convert an original dramatic taped production into nondramatic

[208] See, generally, KAPLAN & BROWN, *supra* note 65, at 428–32; Blaisdell, *supra* note 186. The organizations are generally prohibited from denying a license to anyone who wants one. WARNER 383–85, § 135d.

[209] REVISION REPORT 35.

[210] See, generally, comments following *Study No. 5*, at 63–85, U.S. COPYRIGHT LAW REVISION STUDIES (1956).

[211] *Cf.* Cardinal Films, Inc. v. Republic Pictures Corp., 148 F. Supp. 156 (S.D.N.Y. 1957); Patterson v. Century Prods., Inc., *supra* note 123.

form,[212] secured by section 1(b), would probably be applicable to videotapes, but the occasions of their use are quite rare, and the right to dramatize a nondramatic work, although theoretically applicable to such things as documentary tapes, will probably never be used. Finally, the recording and performing rights of section 1(d) clearly would prevent the unauthorized reproduction and exhibition of a copyrighted tape provided it was a dramatic production. But what about a copyrighted taping of a musical performance (as distinct from a copyright in the composition itself), a dance, news or sporting event, panel discussion, religious exercise, and other nondramatic production? Only an uncomfortable distortion of language could label them "literary" works or musical compositions to fit the language of sections 1(c) or 1(e). When motion pictures were made copyrightable in 1912 nothing was done to change section 1,[213] and courts ever since have been forced into some rather extraordinary linguistic contortions, at least according to several critics,[214] to secure the protections obviously intended. Hopefully this can be avoided with respect to videotapes.

One solution, of course, would be to amend each part of section 1 so that videotapes could be slipped horizontally through the five subsections with a minimum of friction. This would probably secure the videotape copyright holder his maximum protection, but what it would do to the ideal that copyright laws be easily manageable [215] is another question. The better solution seems to be the addition of a new subsection to section 1 in which the rights of special importance to holders of copyrights in mechanical reproductions—motion pictures, phonograph records, sound tapes, and videotapes—

[212] Nimmer, *supra* note 15, at 106. [213] *Id.* at 105.

[214] Most frequently criticized is *Patterson*, *supra* note 123, holding the impermanent image of a film flashed on the screen a "copy." See WARNER 279–82; REVISION REPORT 78. Heads might also be scratched at the MGM case, *supra* note 169, which said that exhibition of a nondramatic film is a "dramatization" of a nondramatic literary work.

[215] Chafee, *supra* note 16, at 514–15.

are set forth together, with particular emphasis on preventing their unauthorized duplication or public exhibition in any form. The revision recommendations, however, seem to go only part of the way. While apparently recommending that all forms of mechanical reproduction, including videotapes, be accorded copyright status under section 5, the revisers mention only that exhibition rights in motion pictures expressly be secured by section 1.[216]

There also seems to be no suggestion to assure protection from the reproduction or distribution of bootlegged tapes, unless such protection will come from the expansion of the recording rights.[217]

CONCLUSION

The problems created by the advent of videotape discussed here, although perhaps the most immediate, by no means exhaust the field. A whole universe of legal turmoil, for example, exists beyond the world of the Copyright Act in the vast expanse of the common law, with its problems clustering around equitable servitudes, unfair competition, moral rights, and right to privacy, all of which are affected by videotapes, especially if videotapes are not brought within the statute. And even under the Act there are further trouble spots which suggest separate studies in themselves. One, for example, is the interpretation of licenses and assignments that make no mention of the right to videotape the work in question. It may be that little difficulty is encountered where the copyright holder grants an "assignment of all rights," such a clause generally being construed as a full assignment of the holder's entire copyright interest, including new uses uncontemplated by the parties, regardless of economic consequences.[218] But suppose

[216] REVISION REPORT 11, 17–18, 29.

[217] See note 196 *supra*, and accompanying text.

[218] Cohn, *Old Licenses and New Uses*, 19 LAW & CONTEMP. PROB. 184, 186 (1954); *cf.* Silverberg, *Televising Old Films*, 38 VA. L. REV. 615, 619–20 (1952).

the copyright holder purports to assign less than full interest. Does the grant of specific rights carry with it videotape rights or have these been retained by the holder? Or perhaps only the grant of certain rights will be construed to include videotapes, but not others. One might suppose, as a plausible hypothesis, that the more specific the enumeration of rights the more likely a court to find that the right to make videotapes is not transferred, on an *expressio unius* theory buttressed by the general rule that conveyances are construed against the grantee.[219] Unfortunately, case law in analogous areas does not bear out the hypothesis. While some courts, for example, said that a broad conveyance of "dramatic rights" included a transfer of motion picture rights,[220] others said the opposite.[221] Similarly, a license to make motion pictures of a work has been held by some courts to permit a television presentation of the work [222] or the exhibition of the film on television,[223] but not by others.[224] Finally, while some commentators apparently believe that a specific grant of television performance rights would not include kinescoping or videotaping on a theory that "performing" and "recording" rights are distinct,[225] others would construe the contract to permit it, at least if the film or tape is used only once and then destroyed.[226] But does it not defeat a major purpose of videotapes to require that they be erased after just one exhibition?

Another wealth of problems is in international treaties. Some agreements, for instance, do not protect composers from

[219] WARNER 126.

[220] Photo-Drama Motion Picture Co. v. Social Uplift Film Corp., 213 Fed. 374 (S.D.N.Y. 1914), *aff'd*, 220 Fed. 448 (2d Cir. 1915); Lipzin v. Gordin, 166 Misc. 197, 166 N.Y. Supp. 792 (Sup. Ct. 1915).

[221] Manners v. Morosco, 252 U.S. 317 (1920); Klein v. Beach, 239 Fed. 108 (2d Cir. 1917); Hayer Bros. v. Klaw, 232 Fed. 609 (S.D.N.Y. 1916).

[222] Wexley v. KTTV, Inc., 108 F. Supp. 558 (S.D. Cal. 1952).

[223] Republic Pictures Corp. v. Rogers, 213 F.2d 662 (9th Cir.), *cert. denied*, 348 U.S. 858 (1954).

[224] Weiss v. Hollywood Film Enterprises, 81 U.S.P.Q. 570 (Super. Ct. Los Angeles 1949).

[225] Nimmer, *supra* note 15, at 95.

[226] WARNER 129; *Cf.* Cohn, *supra* note 218, at 188–89.

unauthorized mechanical reproductions of their songs,[227] but this is afforded under the United States statute. And under the Universal Copyright Convention the definition of "publication" requires reproduction in tangible and readable form,[228] but this is not required under the Berne Convention, nor would it be in the United States if the revisers' recommendations are adopted.

Fortunately, the copyright statute as it now stands, although perhaps containing some undesirable features, on the whole is a manageable, consistent, comprehensible unit. It would be a shame to transform it into a multiheaded beast like the Internal Revenue Code by tacking onto it a series of poorly thought through, internally conflicting amendments. If the current revisers take the pains now to analyze carefully the implications of their proposals—as they seem well to be doing —the tradition can be begun that the Copyright Act is one statute that will not be bandied about carelessly; careful reappraisal will be the custom whenever new communication devices come into being, as surely they will.

[227] Todamerica Musica, Ltd. v. R.C.A., 171 F.2d 369 (2d Cir. 1948).
[228] Universal Copyright Convention, art. 6.

HONORABLE MENTION, 1963

Electronic Music and the Copyright Law

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> If a man does not keep pace with his companions, perhaps it is because he hears a different drummer. Let him step to the music which he hears, however measured or far away.[1]

ELECTRONIC MUSIC [2] is a recent innovation, but it is not an isolated instance of the adaptation of technological achievement for the creation of music.[3] The musician has historically been a close observer of science and the instruments of modern orchestras were developed only after advances in technology made possible their construction. However, in the case of electronic music, the composer is exploring new concepts of music as well as new means of performance.

Electronic music is a new medium of artistic expression and, like all other new art forms, presents numerous problems for the copyright law. One should have at least a basic understanding of the development and composition of electronic music before considering these copyright problems. Explaining this new art form to anyone is a difficult task for, as the Dutch composer Henk Badings has written:

> Anyone who sets out to explain what electronic music is soon runs into difficulties. His account either lapses into the arcane language of

[1] THOREAU, WALDEN 430 (Harper & Bros. ed. 1954).

[2] The term "electronic music" is used in this essay to refer to all methods of musical composition using electronic devices. This is one widely used meaning of the term, but it is not the exclusive meaning.

[3] REDFIELD, MUSIC—A SCIENCE AND AN ART Ch. XIV (1928).

the initiate or skims the surface without touching the heart of the matter.[4]

The following discussion is at the most intended to give the reader enough exposure to understand the copyright problems of electronic music, and should be accepted with this warning in mind and not as a substitute for reading authoritative writings and listening to the music.

THE DEVELOPMENT AND COMPOSITION OF ELECTRONIC MUSIC

Since 1900, there have been many attempts to create new musical instruments and sounds, including the Dynamophone of Thaddeus Cahill, Leon Theremin's ether wave music, Joerg Mager's spherophon, the Trautonium devised by Fritz Trautwein and Oskar Sala, and Maurice Martenot's Ondes Martenot.[5] All of these used technology to produce new musical sounds. In addition, distinguished composers such as Arnold Schonberg, Anton von Webern, Paul Hindemith, and Edgar Varese have demonstrated that serious music does not have to follow classical doctrines.[6]

The development of the tape recorder and beginning of computer technology during the Second World War opened vast new areas to adventurous musicians and composers.[7] Phonograph records recorded sound, but were relatively inflexible and did not permit the sound to be easily rearranged

[4] Badings, *Electronic Music—Its Development in the Netherlands*, Delta, Winter 1958–1959, pp. 85, 86. On Badings' work, see the N.Y. Times, Aug. 7, 1960, § 2, p. 9, col. 1 and Dance Magazine, Aug. 1961, p. 24.

[5] ROCKEFELLER REPORT 4–15 (1956–1957). This was a preliminary unpublished report on the development of electronic music which was written by Professors Luening and Ussachevsky of Columbia University, prior to a $175,000 grant from the Rockefeller Foundation for research and composition in electronic music. Reports on the grant include the N.Y. Times, Jan. 18, 1959, § 2, p. 9, col. 8; Newsweek, Jan. 26, 1959, p. 91; Musical America, Feb. 1959, p. 213.

[6] MCKINNEY & ANDERSON, MUSIC IN HISTORY 839–48, 868 (1940).

[7] BARNOUW, MASS COMMUNICATIONS 159 (1960).

or edited. However, tape was similar to motion picture film and sounds could be edited with simple splicing equipment. Moreover, the development of computers soon raised the issue of whether this machine could be programmed or "taught" to compose music.

A few young European composers and technicians seized upon the tape recorder and electronic audio devices as a means of creating a new electronic music. Pierre Schaeffer, a Frenchman, began experimenting and broadcasting in 1948, calling his compositions "musique concrète" because he started with concrete or natural sounds.[8] In Cologne, Germany, Dr. Werner Meyer-Eppler, working with several associates, began exploring "elektronische musik" which used only sounds originating from electronic generators.[9] Early American experiments, conducted by Professors Vladimir A. Ussachevsky and Otto Luening of Columbia University, used musical instruments and other sources to compose "tape-music," first publicly performed in 1952 at the New York Museum of Modern Art.[10] In 1955–1956, two Americans programmed a digital computer and composed the "Illiac Suite for String Quartet." [11]

Electronic music, initially regarded by skeptics as simple sound effects, has been accepted by serious composers, and today major studios are located at the Columbia-Princeton Electronic Music Center at Columbia University; [12] the University of Illinois; the Electronic Music Center of the Royal Conservatory of Music in Toronto, Canada; the Northwest German Broadcasting System; Radiodiffusion Francaise; and

[8] ROCKEFELLER REPORT, *op. cit. supra* note 5, app. II. [9] *Id.*, app. I.

[10] Ussachevsky, *Columbia-Princeton Electronic Music Center*, 13 Rev. Belge de Musicologie, 1959, vol. 13, p. 129, discusses the development of electronic music in the United States.

[11] HILLER & ISAACSON, EXPERIMENTAL MUSIC—COMPOSITION WITH AN ELECTRONIC COMPUTER (1959).

[12] The center is directed by Professors Luening and Ussachevsky of Columbia University and Professors Roger Sessions and Milton Babbitt of Princeton University.

in Milan,[13] Warsaw, Moscow, Tokyo, Buenos Aires, Brussels, Sweden, Switzerland, Holland, and Israel.[14]

Many talented composers have spent time working in these studios and several compositions have been released on commercial records.[15] Numerous public performances have included the Brussels World Fair, Town Hall in New York City,[16] television and radio,[17] and the score of the recent film *No Exit*.[18] Electronic composers have also met at several international conferences.[19]

Presently, most electronic music is tape recorder music and

[13] Musical Times, 1958, vol. 99, p. 98, and Wilkinson, *Two Months in the "Studio di Fonologia,"* The Score, Feb., 1958, p. 41, are reports of the work being done in Italy.

[14] This list was compiled from studios listed in the ROCKEFELLER REPORT, *op. cit. supra* note 5, at 15–20; Moor, *Sinus Tones with Nuts and Bolts*, Harper's Magazine, Oct., 1962, p. 49, and Summary of Interview with Professor Otto Luening, in *Electronic Music: A Practical Guide*, Music Today, Nov.–Dec. 1960, p. 3.

[15] Released records include Luening and Ussachevsky's "A Poem of Cycles and Bells" and "Suite from 'King Lear'"; Ussachevsky's "Piece for Tape Recorder" (Composers Recordings, Inc.); Karl Birger Blondahl's opera "Aniara" (Columbia 1961); Badings' electronic ballet music "Cain and Abel" (Phillips); "Electronic Compositions" by several German composers (Deutsche Gramophone Gesellschaft); "Sonnova 1988," a recent release which includes Bulent Arel's "Electronic Music No. One," "Sacred Service: Prelude and Postlude," and "Fragment from Theatre Music," Mario Davidovsky's "Study No. Two" and Ussachevsky's "Metamorphoses" and "Experiment No. 4711."

[16] The major piece performed at the Brussel's Fair was "Poeme Electronique," a completely noninstrumental composition by Edgar Varese, who later presented some of his works at Town Hall. On Varese, see the N.Y. Times, Nov. 16, 1958, § 2, p. 8, col. 7; Saturday Review, Dec. 31, 1960, p. 34, and Time, May 12, 1961, p. 51.

[17] ROCKEFELLER REPORT, *op. cit. supra* note 5, apps. V, VI, and VII list, among other performances, the "Today" show, "The Big Story," "Wide Wide World," numerous radio performances, and a short sequence in the movie *To Catch a Thief*.

[18] Professor Ussachevsky composed the score for the recent film version of Sartre's *No Exit*, which Newsweek, Dec. 10, 1962, p. 86, described as "a powerful and penetrating work which should do much to popularize the cause of electronic music in the United States."

[19] Ussachevsky, *As Europe Takes to Tape* (a report of the First International Decade of Experimental Music), Bulletin of American Composers Alliance, Autumn 1953, p. 10; Musical America, Oct. 1960, p. 33; Moor, *supra* note 14, includes comments on the first Congresso Internationale di Musica Esperimentale in Venice, Italy.

there is only one detailed description of the composition of computer music. Professor Lejaren A. Hiller, Jr. and Leonard M. Isaacson, the composers of the "Illiac Suite for String Quartet," have related their experience in a book, *Experimental Music—Composition with an Electronic Computer*.[20] Their objective was to determine whether an automatic high-speed digital computer could compose music from a general program of music composition rules. The "Illiac Suite" demonstrated that technical concepts of composition could be programmed for the computer.

A digital computer is basically an information storage and selection device. Information is coded to make up a program which the computer can store in its memory unit on such familiar items as punch cards or tape. The program is the key to successful operation of the machine and must be correctly completed if the computer is to function properly. After the computer has received and stored the programmed information, one may submit coded instructions to the machine and it will select the proper information to carry out the instructions. For example, the rules included in the program may include a requirement that sound x is never to follow sound y. Thus, if the computer is then instructed to compose a musical composition beginning with the sound y, it will follow the program and select—according to the rules—a sound other than x as the second sound.

The computer cannot think or create; it can only store information, respond to instructions, and present the resulting information to the operator. The music output of any computer is limited exclusively by the program input.[21]

A few more short musical pieces have been composed with computers,[22] but the development of other devices appears to be of greater significance for the future. Dr. Harry F. Olson

[20] HILLER & ISAACSON, *op. cit. supra* note 11; Musical America, Sept. 1956, p. 13.

[21] HILLER & ISAACSON, *op. cit. supra* note 11, at 65–68. [22] *Id.* at 55.

and Herbert Belar have developed the RCA Electronic Music Synthesizer, a remarkable machine which is reported to be able to generate any sound. Instructions are given to the synthesizer through a perforated paper roll. These instructions control the various factors making up a sound.[23] Serious electronic composers hope that the synthesizer may eventually be used to create sounds and avoid much of the time-consuming work presently involved in composing tape-recorder music. RCA believes it will be a successful source of commercial recordings and has already released "The Sounds and Music of the RCA Electronic Music Synthesizer." Although cautioning against scoffing at an admirable first attempt, one reviewer described the synthesized dance, hillbilly, and piano music as "nothing else than bad imitations of the real thing." Dr. Olson asserts that eventually "we could even put out a synthesized record of Caruso singing *Davy Crockett.*" [24]

Composers of all tape-recorder music (*musique concrète, elektronische musik,* and tape music),[25] by far the largest and most successful group, sometimes begin with pencil and paper and plan their piece in some unique electronic notation

[23] N.Y. Times, Feb. 1, 1955, § 1, p. 8, col. 2; *id.*, Feb. 6, 1955, § 2, p. 9, col. 8; *id.*, May 21, 1961, § 2, p. 9, col. 1; Newsweek, Feb. 7, 1955, p. 70; Saturday Review, April 30, 1955, p. 64; Maren, *Electronic Music: Untouched by Human Hands,* The Reporter, April 18, 1957, p. 40; Douglas, *The Electrical Production of Music,* J. Audio Engineering Soc'y, 1958, vol. 6, p. 146; Business Week, June 18, 1960, p. 119; HILLER & ISAACSON, *op. cit. supra* note 11, at 44–45. The Bell Telephone Laboratories in Murray Hill, N.J., are conducting experiments with similar equipment.

[24] Gelatt, *Music Makers,* High Fidelity, Aug. 1955, p. 41.

[25] Some articles which include relatively nontechnical descriptions of the equipment and procedures are Glansville-Hicks, *Tapesichord—The Music of the Whistle and Bang,* Vogue, July 1953, p. 80; Maren, *Music by Montage and Mixing,* The Reporter, Oct. 6, 1955, p. 38; Ussachevsky, *The Processes of Experimental Music,* J. Audio Engineering Soc'y, 1958, vol. 6, p. 202; Badings, *supra* note 4; Randolf, *A New Music Made With a Machine,* Horizon, Jan. 1959, p. 50; Ussachevsky, *Music in the Tape Medium,* Julliard Rev., Spring 1959, p. 8; Electronics Illustrated, Nov. 1959, p. 76. Articles dealing particularly with German composers are found in die Reihe, vol. 1, a periodical of contemporary music published in German in 1955 and issued in English in 1958; Krenek, *New Development in Electronic Music,* Musical America, Sept. 1955, p. 8; and Forte, *Composing with Electrons in Cologne,* High Fidelity, Oct. 1956, p. 64.

scheme. They believe traditional notation is inadequate to express their music. However, planning on paper is not universal and other composers make only preliminary notes or work without any written aids. Many of those who compose without a score never prepare one because of the time and effort involved in devising a system of notation.

The composer starts with a particular sound. *Elektronische musik* initially used only pure or sine tones that were free of all overtone and without any counterpart in traditional music. Pierre Schaeffer rejected such sounds. An excellent illustration of the sources used by Professors Ussachevsky and Luening is Ussachevsky's "Piece for Tape Recorder" which included the following:

> Non-electronic: a gong, a piano, a single stroke on a cymbal, a single note on a kettledrum, the noise of a jet plane, a few chords on an organ.
>
> Electronic: four pure tones, produced on an oscillator, a tremolo produced by the stabilized reverberation of a click from a switch on a tape recorder.[26]

Today, studios are compiling tape libraries of many basic sounds. The sound is on a loop of tape and is always available.

After recording the desired sound, all the composers follow the same basic procedure to create a final work. They use different devices and terminology, but the process includes sound mutation or transformation followed by the mixing or arrangement of the sounds and the recording of the final composition.

Sound mutation or transformation is simply the reshaping of the sound by prolonging or shortening its duration or reversing it, cutting out, and using only a portion of the original sound or otherwise changing its characteristics with electronic equipment.

After completing this process as desired on each sound, the composer may mix various sounds. One common way of mixing is to superimpose sounds on each other. All the sounds are

[26] Ussachevsky, *Notes on a Piece for Tape Recorder,* Musical Q., 1960, vol. 46, p. 202.

then arranged in sequence and the composition is ready for recording on a single tape or record. This final recording is the sole "performance" in compositions which contain sounds that cannot be duplicated without repeating the original electronic procedures.

A SUMMARY OF THE COPYRIGHT PROBLEM

Every new form of artistic expression creates numerous copyright problems. Some of these problems appear immediately and others develop as the particular art form increases in popularity or is modified by technological advances. The preceding discussion of electronic music may suggest many questions, but the basic issue which most disturbs electronic composers and deserves exploration is the copyrightability of their works and the securing of adequate protection under the present statute.

The ultimate source of statutory copyright protection is the power delegated to Congress in the U.S. Constitution, article I, section 8: "To promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . ."

The present copyright statute has classified copyrightable "Writings" in thirteen classes and requires the application for copyright registration to specify a particular class.[27] It includes the classification "Musical compositions." [28] Thus, the initial question is whether an electronic piece is a statutory musical composition.

If the work is eligible for copyright, the second problem is who is entitled to copyright. The Constitution and the statute state that authors are entitled to copyright, but neither defines an author.[29]

[27] 17 U.S.C. § 5 (1958). [28] *Id.* § 5(e).

[29] *Id.* § 9 (1954). Section 9 does include certain restrictions based on nationality.

These two issues present interesting intellectual problems, but they are easily resolved and the principal practical problem facing the electronic composer is presenting his work to the copyright office in acceptable form. At the present time, several electronic composers have registered written scores "containing nonstandard notation" [30] and received copyright certificates, but the Register of Copyrights refuses to accept pieces scored in completely unconventional electronic notation systems. Moreover, a composer who does not have any written score cannot copyright a sound recording of his work.

Little attention has been paid to these problems. There has been no litigation involving electronic compositions. Senator Hubert Humphrey has twice introduced a bill authorizing the direct registration and deposit of electronic tapes and records, but no action was taken on either occasion.[31] Electronic composers have written articles expressing outrage at the lack of protection under the present statute, but these articles have not had any practical effect.

DISCUSSION OF THE COPYRIGHT PROBLEMS

The initial issue is whether an electronic composition is a statutory musical composition. There is a difference between a statutory musical composition and music as an artistic arrangement of sound having certain aesthetic qualities. Music is an almost indefinable part of our culture. Few music scholars can agree on a definition of its boundaries and there is no universal rule which clearly differentiates music from other organized sound. However, the statutory musical composition is a creation of the copyright law and derives all its qualities from the law. One of the basic requirements for a statutory musical composition is proper form; it must exist in the form

[30] 1959 Register of Copyrights Annual Report 3.

[31] S. 4317, 85th Cong., 2d Sess. (1958); S. 1357, 86th Cong., 1st Sess. (1959); 104 Cong. Rec. 18607 (1958) (remarks of Senator Humphrey); The Billboard, Aug. 25, 1958, p. 4.

of "visible notation." [32] Another major requirement is originality.

Assuming that the electronic composer presents his piece to the Register of Copyrights in acceptable form, should it be set apart from the traditional musical composition? [33] Although the statute includes clauses which might permit the copyrighting of an electronic work excluded from the musical composition classification,[34] the only reasons for relegating the electronic piece to this statutory limbo would be a determination (1) that it does not meet the standard of originality required for a musical composition, or (2) that although the work meets all the requirements for a musical composition, it is not copyrightable because the substance of the piece is not music in the statutory sense.

The slightest originality will satisfy the copyright law.[35] The old case of *Jollie v. Jacques*, where the piece was an adaptation of the song of a German composer, stated:

> The musical composition contemplated by the statute must doubtless, be substantially a new and original work; and not a copy of a piece already produced with additions and variations, which a writer of music with experience and skill might readily make. . . . That portions

[32] 37 C.F.R. § 202.8 (1959). It has been extremely difficult for electronic composers to conform to the Register's interpretation of this requirement. This problem and some suggestions will be discussed in a later section. On the power of the Register to reject applications for copyright, see CARUTHERS, AUTHORITY OF THE REGISTER OF COPYRIGHTS TO REJECT APPLICATIONS PREPARED FOR REGISTRATION, COPYRIGHT LAW REVISION STUDY NO. 18, PREPARED FOR THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE HOUSE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS. (Comm. Print 1960); Bouve v. Twentieth Century-Fox Film Corp., 122 F.2d 51 (D.C. Cir. 1941).

[33] Renauld, *Concrete Music, Electronic Music and Copyright*, translated from 131 INTER-AUTEURS 42–47 (2d Trimestre 1958), and distributed by the Copyright Society of the U.S.A. to its sustaining members and sustaining subscribers, raises and discusses this issue.

[34] See 17 U.S.C. § 5 (1958) which, immediately following the listing of the thirteen classifications, states: "The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title. . . ." 17 U.S.C. § 4 (1958) states: "The works for which copyright may be secured under this title shall include all the writings of an author."

[35] SHAFTER, MUSICAL COPYRIGHT 35 (1939); Dworkin, *Originality in the Law of Copyright*, 39 B.U.L. REV. 526 (1959).

may be taken and mixed up in the new arrangement and composition, cannot probably be denied; and there may be great difficulty in distinguishing between those new compositions that do, and those that do not absorb the merit of the original work. *Each case must depend upon its own particular facts and circumstances.*[36] [Italics added]

Numerous other decisions have repeated and affirmed the low standard of originality.[37] Gilbert and Sullivan lost their opportunity to protect *The Mikado* in the United States through an unfortunate publication which put the operetta in the public domain,[38] but a pianoforte arrangement of the orchestral score was sufficient to meet the originality requirement because the composer-arranger employed "musical taste and skill of a high order. . . ." [39] And in *Hein v. Harris*, Judge Learned Hand, after analyzing the components of an infringing song, commented:

the lack of originality and musical merit in both songs, upon which the defendant insists, is of no consequence in law. While the public taste continues to give pecuniary value to a composition of no artistic excellence, the court must continue to recognize the value so created.[40]

More recently, a court suggested that the test might be whether the piece is an original treatment of an old work or a "colorable attempt" to use another work! [41] In another contemporary case, the composer compiled a number of musical pieces in the public domain and added marks for fingering, phrasing, and expression to simplify understanding the compositions. The decision for copyrightability was not based on

[36] 13 Fed. Cas. 910, 913–914 (No. 7437) (C.C.S.D.N.Y. 1850); *accord*, Schuberth v. Shaw, 21 Fed. Cas. 738 (No. 12482) (C.C.E.D. Pa. 1879).

[37] Wihtol v. Wells, 231 F.2d 550 (7th Cir. 1956); Heim v. Universal Pictures Co., 154 F.2d (2d Cir. 1946); Arnstein v. Edward B. Marks Music Corp., 82 F.2d 275 (2d Cir. 1936); Buck v. Russo, 25 F. Supp. 317 (D. Mass. 1938); Hirsch v. Paramount Pictures, Inc., 17 F. Supp. 816 (S.D. Cal. 1937); Italian Book Co. v. Rossi, 27 F.2d 1014 (S.D.N.Y. 1928); Fred Fisher, Inc. v. Dillingham, 298 Fed. 145 (S.D.N.Y. 1924).

[38] The Mikado, Etc., Case, 25 Fed. 183 (C.C.S.D.N.Y. 1885).

[39] Carte v. Evans, 27 Fed. 861, 862 (C.C. Mass. 1886).

[40] 175 Fed. 875, 877 (C.C.S.D.N.Y. 1910); *aff'd*, 183 Fed. 107 (2d Cir. 1910).

[41] Northern Music Corp. v. King Record Distrib. Co., 105 F. Supp. 393, 399 (S.D.N.Y. 1952).

the creation of a new musical work, but it is interesting to note the judge's statement that "the criterion here is originality which amounts to a little more than a mere trivial variation." [42]

This statement may be a slight exaggeration, since several other cases have held pieces uncopyrightable because of "mere trivial variation." Adding an alto part to a song previously having only soprano, tenor, and bass was not sufficient to meet the originality requirement.[43] The same was held where the composer made only "occasional changes in the length of certain notes." [44] Similarly, "inconsequential melodic and harmonic embellishments such as are frequently improvised by any competent musician" [45] and a bass part which was determined to be the "mechanical application of a simple harmonious chord" [46] were not considered sufficiently original contributions for copyrightability.

One enterprising brewery devised an advertising jingle which went "Tic Toc, Tic Toc, Time for Muehlebach" and set it to the musical notes C and G in the key of C.[47] The result was a clock-ticking effect. The court rejected the argument that this was an original musical composition created from words and music in the public domain, stating that it was necessary to add originality to such common materials.

Even this cursory glance at some of the decisions dealing with the law of copyright originality clearly indicates that the same rules can readily be applied to electronic music. The tape-recorder owner who records the song of a robin on a spring morning has not met the requirement of originality. Nobody can "own" the song of a robin. The computer pro-

[42] Consolidated Music Publishers, Inc. v. Ashley Publications, Inc., 197 F. Supp. 17, 18 (S.D.N.Y. 1961).

[43] Cooper v. James, 213 Fed. 871 (N.D. Ga. 1914).

[44] Norden v. Oliver Ditson Co., 13 F. Supp. 415, 418 (D. Mass. 1936).

[45] McIntyre v. Double-A Music Corp., 166 F. Supp. 681, 683 (S.D. Cal. 1958).

[46] Shapiro, Bernstein & Co. v. Miracle Record Co., 91 F. Supp. 473, 474 (N.D. Ill. 1950).

[47] Smith v. George E. Muehlebach Brewing Co., 140 F. Supp. 729 (W.D. Mo. 1956).

gramming expert who instructs the machine to set the phrase "strike three, you're out!" to three musical notes would be unsuccessful in any attempt to enjoin a baseball umpire from calling a pitch with the same intonation. However, a unique arrangement of various birdsongs, regardless of any mutation, is probably an original composition; an electronically composed two-minute "strike three, you're out!" rendition set to a series of traditional notes or new sounds would also be copyrightable.[48] A lengthy discussion of diverse hypothetical compositions would undoubtedly raise numerous issues, but the important factor is that these problems can be resolved in familiar ways under the present law.

An electronic composition which is original and meets all the other requirements for a statutory musical composition should not be denied copyright protection because the Register or court believes that it is not "music" in the statutory sense. A work meeting the statutory requirements for music should be a copyrightable composition even though there may be disagreement as to its musical value.

However, electronic music has introduced new methods of composition and unique sounds to music and has raised the issue of whether the method of creation or musical qualities of a piece should be additional requirements for copyrightability.[49] The copyright law has neither the duty nor the right to evalute these elements of a work. If a composer rolls dice or uses random-selection statistical systems to choose each note of a piece, the aesthetic value of his composition may be debated throughout the musical world, but the copyright law must protect it. The same is true of a piece composed of strange and unique sounds. Some may consider it sound effects and others may call it noise, but it should be a copyrightable musical composition if it meets such legal requirements as proper form and originality. Justice Holmes, in a famous

[48] Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 249–50 (1903), discusses the use of materials from real life in copyrightable works.

[49] Renauld, *supra* note 33.

decision upholding the copyrightability of circus posters, cautioned the judiciary on the pitfalls of entering this area of aesthetic evaluation:

> It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an aesthetic and educational value—and the taste of any public is not to be treated with contempt.[50]

Any attempt to fashion rules of musical acceptability or appraise individual works would clearly be a step beyond "the narrow and most obvious limits" correctly set by Justice Holmes and would change the copyright law into a modifier of culture. As for the argument that permitting such works to be statutory musical compositions will turn the Copyright Office into a chamber of sound horrors, there are many who believe that the chamber is already partially filled.

For those who maintain that anyone can distinguish music from sound effects or noise, despite the form of the composition, Professor Milton Babbitt of the Columbia-Princeton Electronic Music Center has written an article entitled "Who Cares if You Listen?" in which he forcefully asserts:

> The time has passed when the normally well-educated man without special preparation could understand the most advanced work in, for example, mathematics, philosophy, and physics. Advanced music, to the extent that it reflects the knowledge and originality of the informed composer, scarcely can be expected to appear more intelligible than these arts and sciences to the person whose musical educa-

[50] Bleistein v. Donaldson Lithographing Co., *supra* note 48, at 251–52. *Accord*, Henderson v. Tompkins, 60 Fed. 758 (C.C. Mass. 1894), Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457, 483 (1951).

tion usually has been even less extensive than his background in other fields. But to this, a double standard is invoked, with the words "music is music," implying also that "music is *just* music." Why not, then, equate the activities of the radio repairman with those of the theoretical physicist, on the basis of the dictum that "physics is physics"? [51]

One may take issue with some of Professor Babbitt's views; nevertheless, they represent an additional argument why the courts should sidestep the music question.

Finally, it must be said that the vast majority of persons who are professionally associated with serious music have accepted electronic music as musical expression. Even those who may belittle present compositions generally agree that future developments will improve the quality of serious electronic music.[52] A German electronic composer, attempting to describe the new medium in 1954, stated:

> Electronic music is essentially a part of our musical culture. It cannot be described as purely technical, or merely physiological, or even as something faddish and surrealist. However, in the unmistakable way in which it departs from traditional music, it is clear that it can neither take over the latter's functions nor simulate them. Rather, it depends on a recognition of the new possibilities of producing musical sounds as such. This recognition cannot be achieved by merely translating the existing range of sounds into the electro-acoustic medium. . . . This can be done, of course, but . . . the result is never more than a "substitute [for traditional music]." [53]

A recent magazine article states that the "usual first reaction is laughter, but this does not last long." [54] And Harold Schon-

[51] High Fidelity, Feb. 1958, p. 38, 40. Similar discussions include Cazden, *Synthetic Languages for the Composer,* Bulletin of American Composers Alliance, Winter 1952–1953, p. 8; ROCKEFELLER REPORT, *op. cit. supra* note 5, app. II, p. 7; Wilkinson, *supra* note 13, at 48; JUDD, ELECTRONIC MUSIC AND MUSIQUE CONCRETE 64 (1961).

[52] Myers, *Music in France in the Post-War Decade,* Proceedings of the Royal Musical Acad., 1954–1955, p. 93; Brindle, *The Lunatic Fringe* I, II, III Musical Times, 1956, vol. 97, pp. 246, 300, 354; Stadlen, Musical Times, 1960, vol. 101, p. 758.

[53] Eimert, *Electronic Music* (*Elektronische Musik*), pp. 2–3, an unpublished translation, by the National Research Council of Canada in 1956, of a paper originally issued by the Northwest German Broadcasting System (1954), Technical Translation TT-601.

[54] Moor, *supra* note 14, at 50.

berg of the New York *Times* wrote in 1957: "Despite the trickery and monotony of much of the final product, the composers, both French and American, have come up with something that cannot be shrugged off as crackpot." [55]

Nobody can predict the eventual dimensions or qualities of this "something." The art is still "in its infancy" and even the most recent concerts have been referred to as "purely experimental." [56] Under these circumstances, it would be a cultural tragedy for the copyright law to consider the mode of creation or musical character of an electronic composition.

The question of who is entitled to the copyright for electronically composed music does not present new or complex problems. The copyright statute specifically reserves this right to the "author" or his successors in interest [57] and the present rules are easily applied to the electronic composer.

Who is an author? The Supreme Court, in 1884, stated that the "question here presented is one of first impression under our Constitution," [58] and looked to the English decision of *Nottage v. Jackson* for a definition.[59] In that case, it was held that two partners in a photography business were not the "authors" of a photograph taken by one of their employees. Brett, M.R., stated that the author should be "the person who effectively is as near as he can be, the cause of the picture which is produced . . . who has actually formed the picture.

[55] Other commentary includes the N.Y. Times, Jan. 27, 1957, § 2, p. 15, col. 4; Gradenwitz, *Experiments in Sound*, Bull. American Composers Alliance, Autumn 1953, p. 12; Eimert, *The Place of Electronic Music in the Musical Situation*, an unpublished translation, by the National Research Council of Canada in 1956, of a paper originally issued by the Northwest German Broadcasting System (1954), Technical Translation, TT-610; Eimert, *What is Electronic Music?*, die Reihe, *supra* note 25, at 1; Stuckenschmidt, *The Third Stage—Some Observations of the Aesthetics of Electronic Music*, Die Reihe, *supra* note 25, at 11; Maren, *supra* note 23; Ussachevsky, *The Processes of Experimental Music*, *supra* note 25; Bowers, *Electronics As Music*, Saturday Review, Nov. 11, 1961, p. 60; Time, July 2, 1956, p. 39.

[56] N.Y. Times, May 7, 1963, § 2, p. 47, cols. 1–2. [57] 17 U.S.C. § 9 (1958).

[58] Burrow Giles Lithograph Co. v. Sarony, 111 U.S. 53, 60 (1884). One earlier case is Atwill v. Ferrett, 2 Fed. Cas. 195 (No. 640) (C.C.S.D.N.Y. 1846).

[59] 11 Q.B.D. 627 (1883).

. . ." [60] Cotton, L.J., believed that the term " 'author' involves originating, making, producing, as the inventive or master mind, the thing which is to be protected. . . ." [61]

A few years later, National Telegraph News was sued by Western Union for taking news off Western Union tapes for forwarding to National Telegraph customers. The tapes were held uncopyrightable and the court commented on authorship as follows:

> Generally speaking, authorship implies that there has been put into the production something meritorious from the author's own mind; that the product embodies the thought of the author, as well as the thought of others; and would not have found existence in the form presented, but for the distinctive individuality of mind from which it sprang. A mere annal, on the contrary, is the reduction to copy of an event that others, in a like situation, would have observed; and its statement in the substantial form that people generally would have adopted. . . . In authorship, the product has some likeness to the mind underneath it; in a work of mere notation, the mind is guide only to the fingers that make the notation. One is the product of originality; the other the product of opportunity.[62]

Thus, the essence of authorship is the requirement that the author be the creative or inventive element. One potential point of confusion stems from the relationship of man to machine. It is possible that one who is uninformed may actually believe that the machine has created the work and is an author. However, the introductory discussion of the composing process clearly indicates that it is the man who creates the work.[63]

Electronic audio devices, the sound synthesizer, and the computer, despite their remarkable characteristics, are in this respect no different from other machines. They cannot create. They are completely dependent upon human ingenuity. The closest a computer can come to creating is the choosing of a particular result at random from several given elements; this

[60] *Id.* at 632. [61] *Id.* at 635.

[62] National Tel. News Co. v. Western Union Tel. Co., 119 Fed. 294, 297–98 (7th Cir. 1902).

[63] Maren, *supra* note 25, states at 42: "As is always the case, only a fine artist can produce fine art, no matter what the medium may be. . . ."

can be done only through programming for random selection. Neither a machine nor the manufacturer of a machine can qualify as the sole legal author of an electronic work.

A second minor problem which might be raised is the question of joint authorship or ownership of an electronic piece. Is it conceivable that the inventor or manufacturer who cannot be the sole author would have such a claim to the result? The answer is clearly no.

The concept of joint authorship in American copyright law [64] is in a state of confusion, but no definition could extend it to an inventor or manufacturer who did not participate in creating the work.

A survey of leading decisions erases any remaining doubt. The classic definition, stated in *Maurel v. Smith*,[65] was adopted from the English case of *Levy v. Rutley:*

> If two persons undertake jointly to write a play, agreeing on the general outline and design and sharing the labor of working it out, each would be contributing to the whole production, and they might be said to be joint authors of it; but to constitute joint authorship there must be a common design.[66]

Recently, in the controversial "12th Street Rag" case, a court seemed to alter this by stating that the test was "consent, by the one who holds the copyright on the product of the first author, at the time of the collaboration, to the collaboration by the second author." [67] A lyricist hired by the assignee of the composer, who added words several years after the composi-

[64] Taubman, *Joint Authorship and Co-Ownership in American Copyright Law*, 27 N.Y.U.L. Rev. 1246 (1952); Cary, Joint Ownership of Copyrights, Copyright Law Revision Study No. 12, Prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the House Comm. on the Judiciary, 86th Cong., 2d Sess. (Comm. Print 1960); Comment, 8 U.C.L.A.L. Rev. 1035 (1961).

[65] 220 Fed. 195 (S.D.N.Y. 1915), *aff'd*, 271 Fed. 211 (2d Cir. 1921). The definition was also used in Edward B. Marks Music Corp. v. Jerry Vogel Music Co., 42 F. Supp. 859 (S.D.N.Y. 1942), *aff'd*, 140 F.2d 266 (2d Cir. 1944); Shapiro, Bernstein & Co. v. Jerry Vogel Music Co., 161 F.2d 406 (2d Cir. 1947); Noble v. D. Van Nostrand Co., 63 N.J. Super. 534, 164 A.2d 834 (Ch. 1960).

[66] L.R. 6 C.P. 523, 529 (1871).

[67] Shapiro, Bernstein & Co. v. Jerry Vogel Music Co., 221 F.2d 569, 570 (2d Cir. 1955).

tion of the original work, was held a joint author. In any event, the confusion resulting from this decision does not affect the relationship between the composer and electronic equipment, since the machinery could not participate in creation.

More serious questions of joint authorship might result from the working relationships between composers and technicians. Computer programming experts, sound technicians, and other persons who actively participate in the creation of a work may claim to be joint authors. Such disputes may present difficult factual problems for the courts, but they are similar to the disagreements that arise between joint composers of traditional music and can be resolved under the same rules. The electronics technician who has performed purely mechanical functions can be compared to the piano player hired by a traditional composer who desires to listen to a piece as he works on it. The technician and the piano player have not participated in the creative process. However, the technician who has made genuine contributions to a composition may be a joint author and will have to assert his claim under the subtleties of the present law.

The greatest practical issue inhibiting complete protection for all electronic music is the inability of composers to put much of their work into a form which is acceptable for copyright registration as a statutory musical composition. The regulations of the Copyright Office define a musical composition as follows:

> (a) This class includes published or unpublished musical compositions in the form of visible notation . . . with or without words, as well as new versions of musical compositions, such as adaptations or arrangements, and editing when such editing is the writing of the author. . . .
>
> (b) A phonograph record or other sound recording is not considered a "copy" of the compositions recorded on it, and is not acceptable for copyright registration. . . .[68]

As previously discussed, many electronic compositions—particularly those composed of unique electronic sounds—

[68] 37 C.F.R. § 202.8 (1959).

exist only as sound recordings. Moreover, the composers who do write scores for their works have rejected traditional musical notation as completely unsuitable for expressing electronic music. While it is easy to contend that every musical composition should have a written score, the inadequacy of traditional notation, lack of a universally accepted system of electronic notation, technical difficuties of scoring a piece, and Register's rejection of completely unconventional notation present complex problems which often discourage the most ambitious composer. The musical layman who insists that traditional notation is adequate for any music is only expressing his ignorance of the situation.

These are the copyright issues that most disturb the composers. The *Rockefeller Report* by Professors Ussachevsky and Luening stated:

> Conventional musical notation, the only kind acceptable to the copyright bureau, is exceedingly unwieldy and inadequate when it comes to transcribing vague pitches, complex sonorities and electronically created reverberation. . . . The Bureau is willing to make some concessions in the direction of introducing mechanical means of sound identification, accompanied by abbreviated musical notation . . . The entire question of securing copyright by depositing a recording itself promises to be a part of a long-drawn battle to change some of the outmoded provisions. . . .[69]

Professor Ussachevsky, in an article describing one of his compositions, added:

> Since the Copyright Office in Washington does not grant a copyright on a work as a musical composition unless it is written or printed in ordinary musical notation, I rather unwillingly spend forty hours to produce a score. . . . My reluctance was based on the impossibility of describing many of the sounds in conventional musical notation.[70]

More recently, American composer Roger Goeb, in an article discussing copyright revision, commented:

> Copyright registration has been granted to certain works where the composer "fakes" an apparent score (readable only by himself), but

[69] ROCKEFELLER REPORT, *op. cit. supra* note 5, at 21.
[70] Ussachevsky, *supra* note 26, at 203.

other composers find that process so onerous and impossible that they take the risk of not applying for registration and go on with performances.[71]

The electronic composer is interested in several questions, none of which have been before the courts in cases involving electronic music. Is the present regulation which prohibits the copyrighting of sound recordings valid for electronic music? Can he sell an uncopyrighted sound recording to the public and still retain his common-law copyright? Does the regulation phrase "visible notation" include unconventional electronic notation?

Judicial opinions and legal writings agree that although a sound recording is probably a constitutional writing, Congress has never added sound recordings to the list of copyrightable items. Thus, there is little doubt that the Register has the legal power to reject a sound recording submitted for copyright registration.[72]

Prior to the last general revision of the copyright law in 1909, the Supreme Court had held that perforated rolls of music used in player pianos did not constitute an infringement of copyright because they were not copies. Justice Day, discussing the meaning of the word "copy," said that a copy "appeals to the eye" and is "in a form which others can see and read." [73]

The next year, Congress revised the law and added the famous compulsory license provision for "mechanical reproductions" of musical compositions.[74] The new statute did not

[71] Goeb, *A Revision of the U.S. Copyright Law*, Bull. American Composers Alliance, May 1962, p. 14, 16.

[72] Chafee, *Reflections on the Law of Copyright: I, II*, 45 COLUM. L. REV. 503, 719 (1945); Finkelstein, *The Copyright Law—A Reappraisal*, 104 U. PA. L. REV. 1024 (1956); DERENBERG, THE MEANING OF "WRITINGS" IN THE COPYRIGHT CLAUSE OF THE CONSTITUTION, COPYRIGHT LAW REVISION STUDY NO. 3, PREPARED FOR THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE HOUSE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS. (Comm. Print 1960); Diamond, *Copyright Problems of the Phonograph Record Industry*, 15 VAND. L. REV. 419 (1962).

[73] White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1, 17 (1908).

[74] 17 U.S.C. § 1(e) (1958).

appear to make a "mechanical reproduction" copyrightable. This view was strengthened by a congressional committee report which stated that it was "not the intention of the committee to extend the right of copyright to the mechanical reproductions themselves. . . ." [75] Finally, during the past fifty years, several court decisions have contained dictum that sound recordings are not copyrightable.[76]

An attempt to copyright a sound recording under the section four and section five "catch-all" provisions of the statute [77] would probably also be unsuccessful. Professor Chafee has stated that despite these clauses, "it seems practically necessary to bring the submitted work within one of the specific compartments of section 5. . . ." [78] There is also a proposition that a word can have a broader meaning in the Constitution than in a statute and this has already been suggested as a reason why constitutional "Writings" are not always copyrightable.[79] Moreover, this has not been a major issue or one of great judicial significance and it is doubtful whether the courts would disturb the present situation.

Unable to copyright his composition, the electronic composer who does not possess an acceptable written score is forced to decide whether he will restrict the use of his recording so as not to endanger the common-law copyright in his unpublished work or exploit the composition and hope that he will retain nonstatutory copyright. Since the chief means of

[75] H.R. Rep. No. 2222, 60th Cong., 2d Sess. 9 (1909).

[76] Aeolian Co. v. Royal Music Roll Co., 196 Fed. 926, 927 (W.D.N.Y. 1912); Waring v. WDAS Broadcasting Station, Inc. 327 Pa. 433, n. 2 at 438, 194 Atl. 631, n. 2 at 633–34 (1937); RCA Mfg. Co. v. Whiteman, 114 F.2d 86, 89 (2d Cir. 1940); Jerome v. Twentieth Century Fox-Film Corp., 67 F. Supp. 736, 742 (S.D.N.Y. 1946); Capitol Records, Inc. v. Mercury Records Corp., 221 F.2d 657, 660, 664 (2d Cir. 1955). For a case stating that records are "capable of registration," see Fonotopia Ltd. v. Bradley, 171 Fed. 951 (C.C.E.D.N.Y. 1909).

[77] 17 U.S.C. §§ 4–5 (1958). The relevant portions are included in note 34 *supra*.

[78] Chafee, *supra* note 72, at 520.

[79] Towne v. Eisner, 245 U.S. 418, 425 (1918); Chafee, *supra* note 72, at 735. *But see* Derenberg, *supra* note 72, and Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. Pa. L. Rev. 469, 484 (1955).

commercial exploitation is sound recordings, the composer who chooses the former course of action is unlikely to derive much income from his work. There is great temptation to release the record.

Prior to 1950, the composer would have released the record without any fear of losing his common-law copyright through "publication" or dedication to the public domain. However, in 1950, the following dictum appeared in the now (in)famous *Miracle Record* decision:

> It seems to me that publication is a practical question and does not rest on any technical definition of the word "copy". . . . Modern recording has made possible the preservation and reproduction of sound which theretofore had disappeared immediately upon its creation. Where phonograph records of a musical composition are available for purchase in every city, town and hamlet, certainly the dissemination of the composition to the public is complete, and is as complete as by sale of a sheet music reproduction of the composition.[80]

Other decisions with similar dicta have since been written [81] and there is now considerable doubt whether common-law copyright exists after the general release and sale of a record or tape.[82] The composer of traditional music can avoid the hazards of possible publication by copyrighting his score, but the electronic composer who has no score must take his chances and, if the *Miracle Record* dictum is correct, has cast his work into the public domain.

Thus, the electronic composer who desires assurance of effective copyright protection must submit a score to the Register. The refusal of the Register to accept radically new notation has led to an unsatisfactory compromise by some composers who combine conventional notes, original symbols, and

[80] Shapiro, Bernstein & Co. v. Miracle Record Co., *supra* note 46, at 475. A decision with similar dictum which appeared even prior to this was Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Sup. Ct. 1949).

[81] McIntyre v. Double-A Music Corp., *supra* note 45; Mills Music, Inc. v. Cromwell Music, Inc., 126 F. Supp. 54 (S.D.N.Y. 1954).

[82] Diamond, *supra* note 72; Kaplan, *supra* note 79; Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185 (1956); Selvin, *Should Performance Dedicate?* 42 CALIF. L. REV. 40 (1954).

verbal description for a score. Those who have devised unique notation systems would like to copyright their works in electronic notation. It cannot be overemphasized that traditional notation is not suitable for electronic music not within the framework of traditional musical sound. Three respected German composers expressed the problem as follows:

> Conventional musical symbols cannot be used for writing down electronic music. The multiplicity of electronic shaping elements goes far beyond the graphical powers of representation of our [traditional] notation. It is necessary, therefore, to take into account the differentiations of electronic music not known in earlier music, by means of a notation, which will correspond to the acoustic processes. This cannot be accomplished by any extension of the traditional notation, which suffices, at most, for the writing down of quarter or sixth tone music.[83]

The present copyright statute was enacted in 1909 when electronic music and notation, as they exist today, did not exist and could not have intentionally been included within the scope of the act. The question is whether a new and unique system of electronic notation, which did not exist at the time of enactment and is not universally accepted in the manner of traditional staff notation, is copyrightable musical expression.

Many technological advances in creating and reproducing art forms have been protected under copyright statutes passed before the new medium was in existence. The general rule appears to be that copyright will be granted to anything other than a totally new art. In 1909, Congress clearly intended to make copyrightable a musical composition scored in traditional notation. If a particular method of electronic notation can be regarded as an alternative or substitute form of musical notation, used to more effectively characterize the actual sounds of the electronic composition, these decisions indicate

[83] Eimert, Enkel, & Stockhausen, *Problems of Electronic Music Notation*, p. 2, an unpublished translation, by the National Research Council of Canada in 1956, of a paper originally issued by the Northwest German Broadcasting System (1954), Technical Translation, TT-612. Related materials include Eimert, *What is Electronic Music?*, *supra* note 55; *Music Without Musicians*, Saturday Review, Jan. 26, 1957, p. 56; Discovery, Jan. 1958, p. 4; Badings, *supra* note 4, at 87.

that the electronic score might be copyrightable notation under the present act.

Before photographs were specifically included in the statute,[84] an attempt to copyright a photograph as a "print, cut or engraving" under the 1831 act was rejected by a court which examined the process of producing the photograph and then stated:

> This is a new and beautiful art, discovered long after the statute in question was enacted. . . . It is not printing in any sense known to the arts at the time this copyright act was passed; nor is it an extension of the old processes, or a new development of the art of printing or the art of engraving. . . . It is an entirely original and independent method of producing and multiplying pictures. . . .[85]

However, a multicolored lithographic print or chromo was copyrightable under the 1831 act as a "print" before being added as a separate category in 1870.[86]

The copyright of Thomas Edison for a 300-foot motion picture film registered as a photograph was upheld in an infringement action where the court considered motion pictures as an extension of still photography:

> To say that the continuous method by which this negative was secured was unknown when the act was passed, and therefore a photograph of it was not covered by the act, is to beg the question. . . . It must have recognized there would be change and advance in making photographs, just as there has been in making books, printing chromos, and other subjects of copyright protection. . . .[87]

Similarly, courts have stated that pantomime and silent movies may be an infringing dramatization,[88] sound tracks

[84] Photographs were added on March 3, 1865. 13 Stat. 540. The constitutional validity of the clause was upheld in Burrow-Giles Lithographing Co. v. Sarony, *supra* note 58. However, these cases arose before the new statute came into effect and the 1831 act had no clause similar to the present § 4. See note 34 *supra*.

[85] Wood v. Abbott, 30 Fed. Cas. 424, 425 (No. 17938) (C.C.S.D.N.Y. 1866). Compare Rossiter v. Hall, 20 Fed. Cas. 1253 (No. 12083) (C.C.E.D.N.Y. 1866).

[86] Yuengling v. Schile, 12 Fed. 97 (C.C.S.D.N.Y. 1882).

[87] Edison v. Lubin, 122 Fed. 240, 242 (3d Cir. 1903). Other early movie cases were American Mutoscope & Biograph Co. v. Edison Mfg. Co., 137 Fed. 262 (C.C.D.N.J. 1905) and United States v. Berst, 175 Fed. 121 (S.D.N.Y. 1909). The latter case involved the Tariff Act, 30 Stat. 189 (1897).

[88] Kalem Co. v. Harper Bros., 222 U.S. 55 (1911); Daly v. Palmer, 6 Fed. Cas. 1132 (No. 3552) (C.C.S.D.N.Y. 1868).

and talking pictures were "a species of the genus motion pictures," [89] and that the fact that radio broadcasting was unknown in 1909 did not prevent it from being within the scope of the statute.[90]

It seems that there is a much closer connection between two systems of musical notation than between printing and photography. The relationship between traditional and electronic notation might be an analogy to that of the black and white and color lithograph or still photo and motion picture. This position is supported by the recent acceptance for copyright registration as a motion picture photoplay of a magnetic videotape recording of Gian Carlo Menotti's opera *The Consul.*[91] Videotape, commonly used in the television industry, differs from motion picture film in that it is blank or devoid of images to the naked eye. It was developed after the appearance of commercial television and Congress has not acted to extend the coverage of the motion picture classification to videotape.

Moreover, modern copyright decisions have consistently emphasized that the statute should be liberally construed so that technicalities do not exclude authors and works otherwise within its scope.[92] Thus, there is a real question whether

[89] L. C. Page & Co. v. Fox Film Corp., 83 F.2d 196, 199 (2d Cir. 1936); Jerome v. Twentieth Century Fox-Film Corp., *supra* note 76, at 740.

[90] Buck v. Jewell-LaSalle Realty Co., 283 U.S. 191 (1931); Jerome H. Remick & Co. v. American Automobile Accessories Co., 5 F.2d 411 (6th Cir. 1925).

[91] Colby, *An Historic "First"—Copyright Office Accepts Magnetic Video Tape for Registration*, 8 BULL. CR. SOC'Y 205 (1961). Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U.L. REV. 1081 (1955) discusses the copyrightability of videotape and the scope of the statute.

[92] Washington Publishing Co. v. Pearson, 306 U.S. 30 (1939); Bobbs-Merrill Co. v. Straus, 210 U.S. 339 (1908); Advisers, Inc. v. Wiesen-Hart, Inc., 238 F.2d 706 (6th Cir. 1956); Biltmore Music Corp. v. Kittinger, 238 F.2d 373 (9th Cir. 1956); United States v. Backer, 134 F.2d 533 (2d Cir. 1943); Metro-Goldwyn-Mayer Distrib. Corp. v. Bijou Theatre Co., 59 F.2d 70 (1st Cir. 1932); Bavesi v. Edward O'Toole Co., 26 F. Supp. 41 (S.D.N.Y. 1939); Foreign & Domestic Music Corp. v. Twentieth Century Fox Film Corp., 19 F. Supp. 769 (S.D.N.Y. 1937); Southern Music Publishing Co. v. Bibo-Lang, Inc. 10 F. Supp. 972 (S.D.N.Y. 1935); Joe Mittenthal, Inc. v. Irving Berlin, Inc. 291 Fed. 714 (S.D.N.Y. 1923); Ford v. Charles E. Blaney Amusement Co., 148 Fed. 642 (S.D.N.Y. 1906); Werckmeister v. American Lithographic Co., 142 Fed. 827 (S.D.N.Y. 1905), *aff'd per curiam*, 148 Fed. 1022 (2d Cir. 1906); Waring v. WDAS Broadcasting Station, Inc., 327 Pa. 433, 194 Atl. 631 (1927).

the Register is legally correct in forcing electronic composers to submit their works in a mixed traditional and symbolic notation. It is quite possible that the courts might consider an entirely original notation system a suitable substitute for traditional notation.

There are potentially serious barriers to such an interpretation of the 1909 act. One is a perhaps justifiable fear that the Copyright Office will receive electronic compositions notated in dozens of different systems. Many of these electronic notation systems may use strange symbols and be impossible to understand without a thorough explanation by the composer and study by the reader. Faced with this dilemma, it is possible that the Register may seek to construe the statute and Regulation requirement of "visible notation" [93] to exclude systems which cannot be readily understood by a person with a musical education. The rationale might be that traditional notation was easily understood by persons with a musical background, and a system of electronic notation cannot be a statutory substitute for traditional notation unless it also makes the work "visible" to such a person.

Grove's *Dictionary of Music and Musicians* defines a musical notation system as "any set of written symbols devised or adapted for the purpose of recording musical ideas." [94] It states that only staff notation is in international use. Discussing the construction of a notation system, Grove comments that the difficulties are "immense" because of the need for visually distinct symbols which are similar in size, capable of meaningful combination, concise, easy to write, flexible, and internationally understood and accepted.[95]

Today's electronic notation systems cannot meet all these requirements and perhaps Grove could be used to support an argument that copyrightable electronic notation must be easily understood by a person who can read traditional notation.

[93] 37 C.F.R. § 202.8 (1959).
[94] 6 GROVE, DICTIONARY OF MUSIC AND MUSICIANS 108 (5th ed. 1955).
[95] *Id.* at 109.

However, there are several reasons why this is not a very strong contention.

The cases which established the concept that new forms of expression which are not new arts are copyrightable do not affirmatively lend support to this position. Understanding an electronic notation system may require explanation and study, but this does not make the notation a new art. Complex musical compositions in traditional notation must also be studied before they are "visible" to the most highly skilled musicians. Again, an analogy may be made to still photography and motion pictures rather than printing and photography. Moreover, the registration of magnetic videotape indicates that these decisions may be applied to a situation where there is a difference in such a fundamental characteristic as visibility to the human eye.

The copyrightability of modern choreographic compositions is another factor. A choreographic work which includes a story theme is copyrightable as a dramatic or dramatico-musical composition.[96] Thirty-five years ago, Rudolf Laban devised a system of choreographic notation which has since become universally accepted. It is a very complex and technical system which can be understood only by highly skilled professional notators. This has been said to be its greatest disadvantage, but the copyright law has never questioned the use of the Laban system or other personally devised systems of choreographic notation on these grounds.[97]

Furthermore, there is no reason why the general public, including those with musical training, should be able to readily

[96] 17 U.S.C. § 5(d) (1958); 37 C.F.R. § 202.7 (1959).

[97] Hutchinson, *The Preservation of the Dance Score Through Notation*, in THE DANCE HAS MANY FACES 49 (1951); Mirell, *Legal Protection for Choreography*, 27 N.Y.U.L. REV. 792 (1952); VARMER, COPYRIGHT IN CHOREOGRAPHIC WORKS, COPYRIGHT LAW REVISION STUDY NO. 28 PREPARED FOR THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS OF THE HOUSE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS. (Comm. Print 1961); Martinetti v. Maguire, 16 Fed. Cas. 920 (No. 9173) (C.C. Cal. 1867); Barnes v. Miner, 122 Fed. 480 (C.C.S.D. N.Y. 1903).

understand every copyrighted musical composition.[98] There are now numerous copyrighted works in almost every classification that are absolutely incomprehensible to all but a few highly skilled individuals.

The arguments for rejecting a standard based upon the ability of the person with a musical education to read electronic notation do not open the gate to every system of electronic notation or preclude the Register from establishing valid requirements. The composer may be required to explain the significance of his symbols. The notation should provide a reasonable guide to the technically competent musician who desires to reproduce the sounds included in the composition. This will enable those who are willing to study the method and composition to understand them.

A second potential barrier to the copyrightability of diverse methods of electronic notation, as outlined above, might be the contention that the present interpretation of "visible notation," restricting the electronic composer to a combination of traditional notation, original symbols, and verbal explanation, is the only factor which is preventing the copyrighting of original sound effects and noise as statutory musical compositions. The argument would stem from the fear that nonmusical sound arrangements, which cannot presently be notated, would be submitted in copyrightable electronic notation and become statutory musical compositions. As previously discussed, a work which meets the form and other requirements for a statutory musical composition should not be denied copyright protection because it is not believed to be music in the statutory sense.

There is no established boundary between electronic music and original sound effects and no electronic notation differentiates between music and other sound arrangements. The Copyright Office could not establish notation requirements which would exclude only nonmusical sound arrangements. There-

[98] Babbitt, *supra* note 51.

fore, it is quite possible that acceptance of original methods of electronic notation might permit the copyrighting of works which even some electronic composers call sound effects.[99] However, the alternative choice is to maintain the present rules and prohibit the copyrighting of all pieces in electronic notation. Under these circumstances, the lesser of the two evils seems to be acceptance by the Register of electronic notation and the possibility of having to copyright works of questionable musical value.

Thus, although prevented from copyrighting a sound recording under the present law, the electronic composer probably should be permitted to copyright an original electronic musical composition in electronic notation as a statutory musical composition.

SOME SUGGESTIONS

Enough has been said to justify the conclusion that the copyright statute does not effectively protect the composer of electronic music and that legislation is necessary to alter this situation. As the Copyright Office is presently preparing a major revision of the act, this is a particularly opportune time to consider some of the alternatives which might be included to protect this new art form.

Any proposal on electronic music must obviously deal with the copyrightability of sound recordings and musical scores in electronic notation. The revision bill may eliminate these major problems, either through specific sections drafted for electronic music or general clauses which offer adequate protection.

Several reasons indicate that general clauses might be preferable to specific provisions. It is already reasonably certain

[99] Professor Ussachevsky, in a speech to the American Symphony Orchestra League, published in the Newsletter of the League, July 1960, pp. 5–10, discussed the possibility that the near future may bring "a good deal of electronic nonsense parading as electronic music. . . ."

that the bill will provide for the general copyrightability of sound recordings. Moreover, general clauses would be more acceptable to the Copyright Office, Congress, and other parties seeking similar protection for sound recordings. In addition, there is no need for specific sections if general provisions can provide adequate protection.

The musical compositions section could provide for the copyrightability of works notated in any system which met the requirements previously discussed. There is no need for a specific section.

Preliminary drafts of the revision bill indicate that the Copyright Office is planning to provide for the copyrightability of sound recordings, but grant different exclusive rights to the owners of statutory musical composition copyrights and sound recording copyrights. One possibility is that the latter will be limited to copying and distribution rights whereas the owner of a musical composition copyright will have, in addition, exclusive performance rights.

The electronic composer who creates and registers an electronic score will not be affected by this distinction. He will be the owner of a musical composition copyright. However, the scoreless electronic composer who copyrights a sound recording of his work will be the owner of a sound recording copyright and will not have exclusive performance rights for his sound recording. If this sound recording is also the sole "performance" of the piece, he will have no statutory right to prevent any public performance of the composition in its only performance. He becomes a "second-class" copyright owner to the composer with a written score.

One solution would be a provision that sound recordings which are copyrighted by the statutory author (or his successor) of the work and which are not copyrighted by the author in another category shall have exclusive performance rights and whatever other rights are given to authors who register their works in other categories. This would eliminate

discrimination between equally deserving authors of copyrightable works, some of whom can register their compositions only as sound recordings.

These few suggestions will provide the electronic composer with effective protection under flexible provisions which may be applied to future developments in the medium. Even these suggestions emphasize the most important point of this study: copyrightable writings should not be excluded from statutory protection because they are embodied in a new art form.

HONORABLE MENTION, 1963

The Question of Choice Between Copyrighting or Patenting a Design

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MUCH HAS BEEN WRITTEN in recent years of the overlap between copyright law and design patent law.[1] This overlap was brought into prominent focus by the U.S. Supreme Court in *Mazer v. Stein* [2] when that Court held that either type of protection would be available for works such as statuettes which would fall under the provisions of both the design patent [3] and copyright laws.[4] The Court further held that the use of such

[1] Buckles, *Property Rights in Creative Works—A Comparison of Copyright and Patent Laws*, 32 J. PAT. OFF. SOC'Y 414 (1950); Derenberg, *Copyright No-Man's Land; Fringe Rights in Literary and Artistic Property*, 35 J. PAT. OFF. SOC'Y 690 (1953); Kelly, *Design Patents and Copyrights: The Scope of Protection*, 21 GEO. WASH. L. REV. 353 (1953); Pogue, *Borderland—Where Copyright and Design Patent Meet*, ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER SIX 3 (1955), 52 MICH. L. REV. 33 (1953); Sokolski, *Is Our Design Patent Statute Adequate?*, 42 J. PAT. OFF. SOC'Y 496 (1960). Note, *Protecting the Artistic Aspects of Articles of Utility: Copyright or Design Patent?*, 66 HARV. L. REV. 877 (1953).

[2] Mazer v. Stein, 347 U.S. 201 (1954).

[3] 35 U.S.C. § 171 (1958): "Patents for designs. Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title. The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

[4] 17 U.S.C. § 5 (1958): "Classification of works for registration. The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

(a) Books, including composite and cyclopedic works, directories, gazetteers, and other compilations;

(b) Periodicals, including newspapers;

(c) Lectures, sermons, addresses (prepared for oral delivery);

works in a product having utility would not be a bar to copyright coverage.

One of the questions left open by the *Mazer v. Stein* decision was whether the same thing may be the subject of both a design patent and a copyright as a work of art or a design therefor. The Supreme Court in deciding the *Mazer* case expressly refused to rule on this point on the ground that, because the action was one for copyright infringement and the works involved had been found to be copyrightable, a holding as to their patentability was unnecessary.[5] The purpose of this essay is to examine this question in the light of the provisions of the Federal Constitution and statutes, and expressions of the judiciary, and to offer a recommendation.

CONSTITUTIONAL AND STATUTORY PROVISIONS

The U.S. Constitution, art. 1, section 8, clause 8, provides that Congress shall "have Power to promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." It is under this grant of power that the copyright and patent acts have been developed.

The first copyright act was passed in 1790, only one year after the adoption of the Constitution by Congress. This act confined its protection to maps, charts, and books.[6] The classes

(d) Dramatic or dramatico-musical compositions;
(e) Musical compositions;
(f) Maps;
(g) Works of art; models or designs for works of art;
(h) Reproductions of a work of art;
(i) Drawings or plastic works of a scientific or technical character;
(j) Photographs;
(k) Prints and pictorial illustrations including prints or labels used for articles of merchandise;
(l) Motion-picture photoplays.
The above specifications shall not be held to limit the subject matter of copyright as defined in Section 4 of this title, nor shall any error in classification invalidate or impair the copyright protection secured under this title."

[5] 347 U.S. at 201. [6] Act of May 31, 190, ch. 15, 1 Stat. 124.

of work protected were broadened with each subsequent act.[7] It was not until the Act of 1870, however, that Congress saw fit to protect designs.

Sec. 86. And be it further enacted, That any citizen of the United States, or resident therein, who shall be the author, inventor, designer, or proprietor of any book, map, chart, dramatic or musical composition, engraving, cut, print, or photograph or negative thereof, or of a painting, drawing, chromo, statue, statuary, and of models or designs intended to be perfected as works of the fine arts, and his executors, administrators, or assigns, shall, upon complying with the provisions of this act, have the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing, and vending the same; and in the case of a dramatic composition, of publicly performing or representing it, or causing it to be performed or represented by others; and authors may reserve the right to dramatize or to translate their own works.[8]

The term of protection was twenty-eight years, renewable for a further term of fourteen years.

The first patent law was also passed in 1790, one year after Congress adopted the Constitution.[9] Several patent acts[10] followed this first enactment but it was not until 1836 that Congress provided for the establishment of the Patent Office and a system of examination.[11] The Patent Act of 1842 established the design patent, providing for grant of a patent to any "citizen . . . who by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new

[7] Act of April 29, 1802, 2 Stat. 171, ch. 36, extended copyright protection to those "who shall invent and design, engrave, etch or work . . . any historical or other print or prints." Act of Feb. 3, 1831, 4 Stat. 436, ch. 16, added musical compositions and cuts to the list. Dramatic compositions, previously impliedly covered, were made protected objects by the Act of Aug. 18, 1856, 11 Stat. 138, ch. 169. Photographs and negatives were expressly added to the list of protected works by the Act of March 3, 1865, 13 Stat. 540, ch. 126.

[8] Act of July 8, 1870, 16 Stat. 212, ch. 230, § 86.

[9] Act of April 10, 1790, 1 Stat. 109.

[10] Act of Feb. 21, 1793, 1 Stat. 318, ch. 11; Act of June 7, 1794, 1 Stat. 393, ch. 58; Act of April 17, 1800, 2 Stat. 37, ch. 25; Act of Feb. 15, 1819, 3 Stat. 481, ch. 19; Act of July 3, 1832, 4 Stat. 559, ch. 162; Act of July 13, 1832, 4 Stat. 577, ch. 203.

[11] Act of July 4, 1836, 5 Stat. 117, ch. 357.

and original design for a manufacture, . . . printing of . . . fabrics . . . bust, statue, or bas relief. . . ." [12] The Act of 1842 provided that the duration of the patent granted for a design would be seven years.

The Patent Act of March 2, 1861, broadened the term of protection to three and a half, seven, or fourteen years at the election of the applicant, but eliminated fabrics from the list of designs protected.[13] Fabrics were once again given design protection in the Consolidated Patent Act of 1870, the term "useful" being inserted in the statute to define the design to be protected.

> Sec. 71. And be it further enacted, That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.[14]

The wording of this design patent section of the Act of 1870, when compared with the wording of the previously quoted section of the same Act covering copyright of a design, reveals the beginning of the overlap in these two forms of protection. A statue, for example, could have received copyright protection under Section 86 of the Act of 1870, and patent protection under section 71 of the same Act. A painting could similarly qualify for both forms of protection. The statutory wording of these enactments thus evidences the congressional intent that a design be protected by either copyright or design

[12] Act of Aug. 29, 1842, Stat. 544, ch. 358, § 3.
[13] Act of March 12, 1861, 12 Stat. 246, ch. 88.
[14] Act of July 8, 1870, 16 Stat. 209, ch. 230, § 71.

patent or both, if the design meets the particular requirements for each type of protection.

Subsequent congressional enactments in these two fields seem to adhere to this view. The Patent Act of 1902 broadened the scope of design patent protection by abolishing the requirement that the design be useful to be patentable.[15] Further, the specific statement of a number of different objects to which the design patent applied under the 1870 Act was omitted. Essentially the 1902 Act crystallized the modern definition of a design patent and authorized the grant of a patent to "any person who has invented any new, original and ornamental design for an article of manufacture. . . ."

The Copyright Act of 1909 similarly broadened the scope of the copyright law.[16] The subjects of copyright were covered in sections 4 and 5, the former being the general all-inclusive section [17] and the latter designating specific classes to which the work is ascribed.[18] The broad language used in section 4 and in the closing sentence of section 5 clearly indicated a congressional desire to broaden the scope of copyright pro-

[15] Act of May 9, 1902, 32 Stat. 193, ch. 783.

[16] Act of March 4, 1909, 35 Stat. 1075, ch. 320.

[17] *Id.*, § 4. That the works for which copyright may be secured under this Act shall include all the writings of an author."

[18] *Id.*, § 5. That the application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

(a) Books, including composite and cyclopaedic works, directories, gazetteers, and other compilations;
(b) Periodicals, including newspapers;
(c) Lectures, sermons, addresses, prepared for oral delivery;
(d) Dramatic or dramatico-musical compositions;
(e) Musical compositions;
(f) Maps;
(g) Works of art; models or designs for works of art;
(h) Reproductions of a work of art;
(i) Drawings or plastic works of a scientific or technical character;
(j) Photographs;
(k) Prints and pictorial illustrations.

Provided, nevertheless, That the above specifications shall not be held to limit the subject matter of copyright as defined in Section four of this Act, nor shall any error in classification invalidate or impair the copyright protection secured under this Act."

tection with the only limitation being the Federal Constitution. The wording of subsection (g) in section 5, "works of art" rather than "works of fine art" as used in the 1870 law, specifically broadened the area of design copyright protection. This same wording, "works of art," is used in the present copyright statute.[19]

It is interesting to note that this change in wording as to copyrightable works of art was in an area which would most likely overlap into the area covered by design patent law. Here existed an excellent opportunity for Congress, if it saw fit, to delimit the scope of the copyright so as not to transgress the alleged sanctity of the design patent. But, as pointed out by Mr. Justice Reed in the *Mazer v. Stein* case, "neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted." [20]

The modifications made in the Patent Act of 1902 with respect to design patents when read with the modifications of the Copyright Act of 1909 point strongly, then, to the fact that neither act was intended to have exclusive jurisdiction where both overlapped. The statutory wording of these early 1900 Acts has been essentially carried through to the present Acts.[21] The intent of Congress, therefore, seems to be clear that certain designs and objects can be protected by either copyright or design patent. And if by either, why not by both?

CASE LAW

The U.S. Constitution and the federal statutes enacted under its authority do not prohibit the protection of a given design by both a copyright and a patent. Such prohibition as does exist has its origin and authority in the dictum of several

[19] 17 U.S.C. § 5(g) (1958). [20] Mazer v. Stein, 347 U.S. 201, 217 (1954).

[21] The design patent section of the Patent Act of 1902 was amended Aug. 5, 1939, 53 Stat. 1212, ch. 450, when the two-year limitation as to prior public use or sale was reduced to one year. On July 19, 1952, the present statutory provision, 66 Stat. 805, ch. 16, was enacted. The copyright act was amended Aug. 24, 1912, 37 Stat. 488, ch. 356, to include motion pictures as item (m) in section 5.

courts, starting with *DeJonge & Co. v. Breuker & Kessler Co.* in 1910.[22]

The *DeJonge* case involved an infringement suit of a copyright on a small painting in watercolors of holly, mistletoe, and spruce arranged in the form of an open square. The painting had been adapted as a design for fancy paper to cover boxes. The court, in holding the copyright not infringed because the copyright notice did not appear on each separate copy but merely on each print containing twelve copies, uttered this dictum:

> In the present instance the artist was commissioned to produce a design for the useful arts; in executing the commission, he produced a painting of artistic excellence, original and pleasing, merely regarded by itself as a picture, and also original and ornamental as a design; and with such a work in his possession the owner or author might treat and protect it in either of its aspects. Since it was qualified for admission into the two statutory classes, I see no reason why it might not be placed in either. But it could not enter both. The method of procedure, the term of protection, and the penalties for infringement, are so different that the author or owner of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision. Ordinarily, of course, there is no difficulty. Not many paintings are suitable for use as designs, and only a few designs possess the qualities demanded by the fine arts. But it is easily conceivable that here and there a painting may be eligible for either class, and the water color in question is, I think, an excellent example. Such a work may be used in both the fine and the useful arts; but it can have protection in only one of these classes. The author or owner is driven to his election, and must stand by his choice.[23]

Additional judicial reasoning to support refusal of both copyright and patent protection for a design for a hosiery ticket was given by the Court of Appeals for the District of Columbia in 1927.[24] The petitioner's application for registra-

[22] DeJonge & Co. v. Breuker & Kessler Co., 182 Fed. 150 (C.C.S.E.D. Pa. 1910).

[23] DeJonge & Co. v. Breuker & Kessler Co., 182 Fed. 150, 151–52 (C.C.S.E.D. Pa. 1910).

[24] *In re* Blood, 23 F.2d 772 (D.C. Cir. 1927).

tion as a patent of a design for a hosiery ticket which had previously been copyrighted was refused, the court stating that "such a course would result for all practical purposes in an extension of the design monopoly." [25] The extension of the design monopoly referred to was beyond the period of protection afforded by the design patent section of the Patent Act, maximum of fourteen years, to the limit of the Copyright Act, maximum today of fifty-six years from the date of first publication. The court cited with approval the *DeJonge* case.

The 1929 case of *Korzybski v. Underwood & Underwood, Inc.*, brought forth still another judicially discovered reason for holding that a given model could not be protected by both a copyright and a patent.[26] In this case the plaintiff had obtained both a patent and a copyright on a model illustrating thought processes and formulating scientific information in regard to the same. The defendant photographed this "antropometer" and the plaintiff brought suit for copyright infringement. The Court of Appeals for the Second Circuit found no infringement, ruling the copyright invalid "because the subject-matter had become a part of the public domain when complainant filed the prior application which resulted in the grant of his patent." [27] The court reasoned that when Korzybski filed his application and received his patent, he made a full disclosure of his invention and dedicated it to the public save for the right to make, use, and vend it during the period for which the patent gave him that monopoly. Since the public had the right to the information disclosed in the Korzybski patent and the right to use and copy the text and diagrams, the Second Circuit found the copyright invalid because Section 7 of the Copyright Act of 1909 provided: "That no copy-

[25] The court went on to say: "The applicant was entitled to apply for a patent for the design as a hosiery label, or he might complete the label, and register the design, so completed, as a label. He could not do both. He elected to pursue the latter course, and has obtained the protection thereby assured to him, and he is bound by that election." *Ibid.*

[26] Korzybski v. Underwood & Underwood, Inc., 36 F.2d 727 (2d Cir. 1929).

[27] *Id.* at 729.

right shall subsist in the original text of any work which is in the public domain." [28]

It is interesting to note that the court in *Korzybski v. Underwood & Underwood, Inc.* quoted from Weil on *American Copyright Law:*

> While in doubtful cases the court will hold that presumptively the fact that a given work is patentable is ground for holding it is not copyrightable and vice versa it seems that there is no rule of law nor is there any consideration of public policy which will prevent the issuance of both a copyright and a patent to cover the same work in its different aspects in a given case.[29]

The "other side of the coin" situation to the *Korzybski* case arose in a 1952 ex parte opinion delivered within the Patent Office.[30] The applicant in this proceeding was attempting to obtain a design patent on a roof design which he had previously registered for copyright as a work of art. The Primary Examiner ruled that the applicant could not patent this design which was already protected by a copyright, even though the applicant contended that the only thing copyrighted was a color photograph of the roof. The Primary Examiner's decision was affirmed by the Patent Office Board of Appeals which cited with approval the *In re Blood* and the *DeJonge* cases. The Examiner in Chief pointed out that one of the considerations given by an applicant for any patent is that the public is entitled to use the same at the expiration of the patent. He went on to reason that it is difficult to see how this consideration would be given if upon the expiration of a design patent the patentee's copyright for the design was still in force. This decision was affirmed by the U.S. Court of Customs and Patent Appeals but on the ground that petitioner's roof design was disclosed by an existing patent, the court not adverting to the above reasoning of the Patent Office.[31]

[28] This same provision appears in 17 U.S.C. § 8 (1958).
[29] Korzybski v. Underwood & Underwood, Inc., *supra* note 26, at 729.
[30] *Ex parte* Guild, 98 U.S.P.Q. 464 (1952).
[31] Application of Lurelle Guild, 204 F.2d 700 (C.C.P.A. 1953).

The varied reasoning as expressed in the above cases has been repeated in other proceedings. In *Jones Bros. Co. v. Underkoffler*,[32] a district court found a design for a cemetery monument copyrightable as a work of art. The defendant contended the monument should have been patented as a design for an article of manufacture. The court ruled that the design could be either copyrighted or patented, but not both, citing *DeJonge*.[33] The court in the *Jones Bros.* case also quoted from Weil on *American Copyright Law* as follows:

> The Act of May 9, 1902, provides that any new original and ornamental designs for an article of manufacture may be patented. The Act is not specifically repealed by the present Copyright Code, but if such manufactured articles are to be "objects of art" it would appear that designs therefor may be copyrighted as "writings" whether or not they may be patented.
>
> It is deemed that it is merely a matter of legislative intention and procedure whether many forms of expression, lying on the borderland between copyright and patent, be subject to the Copyright or Patent Laws, and that such decisions fall into the natural, as distinguished from the artificial, historical, domain of copyright. Such designs would appear both copyrightable and patentable.[34]

The court in the *Jones Bros.* case was not confronted with a factual situation involving both forms of protection, as in the *Korzybski* and *Ex parte Guild* cases. Yet the court uttered dictum that either type of protection could be had in a given situation but not both, relying for authority on previous dicta and indirectly its supporting reasoning. Other courts have similarly uttered such dicta without advancing new and different supporting reasoning.[35]

[32] Jones Bros. v. Underkoffler, 16 F. Supp. 729 (M.D. Pa. 1936).

[33] DeJonge & Co. v. Breuker & Kessler Co., 182 Fed. 150 (C.C.S.E.D. Pa. 1910).

[34] WEIL, AMERICAN COPYRIGHT LAW 227 (1917).

[35] See Taylor Instrument Co. v. Fawley-Brost Co., 139 F.2d 98, 99 (7th Cir. 1943), involving copyrighted chart for a recording machine; Rosenthal v. Stein, 205 F.2d 633 (9th Cir. 1953), involving copyrighted statuettes used as lamp bases.

THE REASONING OF THE COURTS EXAMINED

Starting with the *DeJonge* case in 1910 through the Patent Office decision in the *Ex parte Guild* proceeding in 1952, the following reasons have been advanced by the courts and the Patent Office for holding that a given design cannot be protected by both a copyright and a design patent.

1. The method of procedure, the term of protection, and the penalties for infringement are too different. *DeJonge & Co. v. Breuker and Kessler Co.*

2. Allowing both copyright and patent protection would result for all practical purposes in an extension of the design monopoly. *In re Blood.*

3. Once a given design is patented, it becomes part of the public domain, except as to the patentee's right to make, use, and vend it for the period of patent protection. Being part of the public domain, copyright protection is not available because Section 8 of the Copyright Act (1952) provides "that no copyright shall subsist in the original text of any work which is in the public domain." *Korzybski v. Underwood & Underwood, Inc.*

4. One of the considerations given by an applicant for any patent is that the public is entitled to use the same at the expiration of the patent. This consideration would be lacking if upon the expiration of a design patent the patentee's copyright for the design was still in force. *Ex parte Guild.*

Grouping the reasoning of the various courts together as above leads to an initial basic conclusion. This is that each of the courts has failed to appreciate the difference between a copyright and a design patent. In the case of a given work of art, a copyright protects the expression of the idea of the author as embodied in the work of art.[36] A design patent, on the other hand, protects such "work of art" only when the inventor's design is embodied in an article of manufacture.[37]

[36] Baker v. Selden, 101 U.S. 99 (1879). [37] 35 U.S.C. § 171 (1958).

The concepts protected are separate and distinct. The mere fact that both concepts are embodied in the same article, therefore, should not mean that one or the other form of protection is not available.

Once the separate concepts involved are recognized, the fact that the method of procedure, the term of protection, and the penalties for infringement are different should not negate protection of both concepts in the same article.[38] These differences have been purposely enacted by Congress under authority of art. 1 § 8 of the U.S. Constitution. Furthermore, Congress has never enacted any provision that either the Copyright Act or the Patent Act has exclusive jurisdiction over the other, nor has there ever been a statutory provision that a given article cannot be protected by both a copyright and a design patent.

When the *DeJonge* case was decided in 1910, the breadth of

[38] For a good summary of the differences in the method of procedure and the term of protection between copyright and design patent see Pogue, "Borderland —Where Copyright and Design Patent Meet," ASCAP COPYRIGHT LAW SYMPOSIUM NUMBER SIX 3 (1955), 52 MICH. L. REV. 33, 36–39 (1953). As to the penalties for infringement, 35 U.S.C. § 289 (1958) provides: "Additional remedy for infringement of design patent. Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than $250, recoverable in any United States district court having jurisdiction of the parties.

"Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement." 17 U.S.C. § 101(b) (1958) provides: "Damages and profits; amount; other remedies. To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in providing profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost which he claims, or in lieu of actual damages and profits, such damages as to the court shall appear to be just, and in assessing such damages the court may, in its discretion, allow the amounts as hereinafter stated. . . . First. In the case of a painting, statue, or sculpture, $10 for every infringing copy made or sold by or found in the possession of the infringer or his agents or employees. Second. In the case of any work enumerated in section 5 of this title, except a painting, statue, or sculpture, $1 for every infringing copy made or sold by or found in the possession of the infringer or his agents or employees. . . ."

copyrightable designs was still limited to works of fine art. Even after the fine arts requirement was eliminated from the statute by the 1909 enactment, it was not until 1948 that the Copyright Office changed its requirement from "works of fine art" to "works of art." [39] Then came the *Mazer v. Stein* case in 1954, which further expanded the field of copyrightable works of art to those which are useful. In the light of this progressive expansion of the breadth of copyrightable designs and in the light of the lack of statutory prohibition against securing both copyright and patent protection for a given design, it is submitted that the *DeJonge* case should no longer be authority for the holding that a given design cannot be protected by both a copyright and a patent.

Each of the other three reasons listed above similarly should not be upheld today because each suffers from a lack of appreciation of the basically different concepts protected by copyright and design patent. Each of the reasons given by the courts has merit if the same concept is being protected by separate means. But this is not the situation. In *In re Blood*, the court was concerned with the extension of the design monopoly beyond the maximum period of fourteen years if the design were also granted a copyright. It is submitted that if the same design is protected by a patent and a copyright, the design as embodied in an article of manufacture would lose patent protection at the end of the statutory period, maximum of fourteen years. Only the design as embodied in a work of art would be protected from copying for the statutory period, maximum of fifty-six years. Thus the design patent monopoly would not be extended beyond its permissible statutory limit.

The court in *Korzybski v. Underwood & Underwood, Inc.* reasoned from the then Section 7 of the Copyright Act of 1909

[39] "Works of art (Class G)—(a) General. This class includes . . . works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned, such as artistic jewelry, enamels, glassware, and tapestries, as well as . . . paintings, drawings and sculpture." 37 C.F.R. § 202.10(a) (1949).

that copyright protection could not subsist in a work in the public domain as is a patented design after the statutory period of protection has passed. The reasoning of the court thus seems to be that though copyright protection might be valid during the period of patent protection of a given design, the copyright protection cannot continue once patent protection is at an end, for the design becomes a part of the public domain. This reasoning again fails to appreciate the different concepts of a given design afforded protection by the copyright and patent laws. For at the end of the period of patent protection the design embodied in an article of manufacture does become a part of the public domain. It is only the separate and distinct work of art design which continues to be protected from copying for the period of copyright protection, after which it also becomes a part of the public domain.

This same analysis applies to the reasoning of the Patent Office as expressed in the *Ex parte Guild* proceeding. Once the period of patent protection has expired, the public becomes entitled to use the design as embodied in an article of manufacture free of any license fee. Only the design as embodied in a work of art is barred from public copying until the copyright period of protection has expired. One of the considerations given by an applicant for any patent is thus not lacking.

RECOMMENDATION

Given a design which qualifies for copyright protection as a work of art,[40] and which further qualifies for a patent protection as a design embodied in an article of manufacture,[41] the separate forms of protection for the separate aspects or concepts of the design should be granted. Such a design was involved in *DeJonge & Co. v. Breuker & Kessler Co.*, namely, a painting.

An original painting as a work of art is entitled to copy-

[40] 17 U.S.C. § 5(g) (1958). [41] 35 U.S.C. § 171 (1958).

right protection. If such painting is used by its author as a design for an article of manufacture, as for Christmas wrapping paper, and the design patent requirements of originality (including invention) and ornamentality are fulfilled, patent protection should be afforded. With such facts or their equivalent, the dictum of the *DeJonge* case should no longer control the question of whether copyright protection and patent protection are available for a given design.

Rules Governing the Competition

1. *Participating Law Schools:* All accredited law schools are invited to participate in the Competition.

2. *Eligible Students:* Third-year students. In the discretion of the dean, second-year students may also be eligible.

3. *Subject Matter:* Any phase of *Copyright Law.*

4. *Determination of Awards:* The prizes will be awarded to the students who shall, in the sole judgment of the dean—or such other person or committee as he may delegate—prepare the two best papers. The dean may in his discretion withhold the awards entirely, if in his opinion no worthy paper is submitted, or may award only the first or second prize.

5. *Prizes: A first prize of $250 and a second prize of $100* at each participating law school, to be paid through the dean, upon his written certification. Winning papers will be entered in the National Competition, in which the best papers will be considered for awards of *$1,000, $500,* and *$250* (see Rule 9, *infra*).

6. *Formal Requirements, Right of Publication, etc.:*
   (a) Manuscript must be typewritten (double-spaced) on 8½″ × 11″ paper, 1″ margin all around. All quotations exceeding four lines must be indented and single spaced.
   (b) Manuscript must not exceed 50 pages.
   (c) Citations must be in approved law review form.
   (d) *Two* copies of manuscript must be submitted.
   (e) Cover for manuscript: any standard form stiff cover with label on outside showing title of paper, author's name, and permanent *home address.*
   (f) Winning papers will be forwarded in duplicate by the dean to the Society, which may authorize publication.
   (g) Papers may appear in Law Reviews, provided their entry in the Nathan Burkan Memorial Competition is duly noted.

7. As papers are presumed to represent individual study, collaboration with others in their preparation is not permitted.

8. *Closing date:* August 15th—or any earlier date the dean may specify. Winning papers must be certified to the Society not later than August 31st.

9. *National Awards:* The best papers certified to the Society will be selected for National Awards of *$1,000*, *$500*, and *$250*, respectively. The award papers and one or two additional papers selected by the judges will be printed in the form of a "Copyright Law Symposium."

Questions concerning the Competition may be addressed to the Society's General Counsel, Herman Finkelstein, 575 Madison Avenue, New York 10022, N.Y.

Panels of Judges

SYMPOSIUM NUMBER ONE (1939)

Edward A. Sargoy, Stephen P. Ladas, Edward S. Rogers, Dr. Louis Charles Smith, the late John H. Wigmore, members of a Committee of the American Bar Association appointed by Thomas E. Robertson, Chairman of the Section of Patent, Trade-Mark and Copyright Law

SYMPOSIUM NUMBER TWO (1940)

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

SYMPOSIUM NUMBER THREE (1940)

The late John H. Wigmore, Dean of Northwestern University School of Law

SYMPOSIUM NUMBER FOUR (1952)

The late Judge Herbert F. Goodrich, of the United States Court of Appeals for the Third Circuit

Justice Roger J. Traynor, of the Supreme Court of the State of California

Judge George T. Washington, of the Court of Appeals for the District of Columbia Circuit

SYMPOSIUM NUMBER FIVE (1954)

Judge Stanley H. Fuld, of the Court of Appeals of the State of New York

Chief Judge Leon R. Yankwich, of the United States District Court for the Southern District of California

SYMPOSIUM NUMBER SIX (1955)

The late Chief Judge Sam Driver, of the United States District Court for the Eastern District of Washington

The late Dean Wesley A. Sturges, President of the American Association of Law Schools

SYMPOSIUM NUMBER SEVEN (1956)

Justice George Rossman, of the Supreme Court of Oregon

Loyd Wright, President of the American Bar Association

Edward A. Sargoy, Former Chairman of the Copyright Subsection of the Patent, Trade-Mark and Copyright Section of the American Bar Association

The late Louis E. Swarts, former Chairman of the above Subsection

SYMPOSIUM NUMBER EIGHT (1957)

The late Chief Judge Charles E. Clark, of the United States Court of Appeals for the Second Circuit

The late Chief Justice A. Cecil Snyder, of the Supreme Court of Puerto Rico

SYMPOSIUM NUMBER NINE (1958)

Chief Judge John Biggs, Jr., of the United States Court of Appeals for the Third Circuit

Chief Judge Simon E. Sobeloff, of the United States Court of Appeals for the Fourth Circuit

Judge William H. Hastie, of the United States Court of Appeals for the Third Circuit

SYMPOSIUM NUMBER TEN (1959)

Chief Justice Frank R. Kenison, of the Supreme Court of New Hampshire

Chief Judge Alfred P. Murrah, of the United States Court of Appeals for the Tenth Circuit

SYMPOSIUM NUMBER ELEVEN (1962)

Panel for 1959 National Competition

Chief Judge Charles S. Desmond, of the New York Court of Appeals

Judge David T. Lewis, of the United States Court of Appeals for the Tenth Circuit

Panel for 1960 National Competition

Justice Tom C. Clark, of the United States Supreme Court

Chief Justice Paul Reardon, of the Superior Court of Massachusetts

Judge Elbert P. Tuttle, of the United States Court of Appeals for the Fifth Circuit

SYMPOSIUM NUMBER TWELVE (1963)

Panel for 1961 National Competition

Justice Walter V. Schaefer, of the Illinois Supreme Court

Judge Sterry R. Waterman, of the United States Court of Appeals for the Second Circuit

Panel for 1962 National Competition

Judge Frederick G. Hamley, of the United States Court of Appeals for the Ninth Circuit

Judge John Minor Wisdom, of the United States Court of Appeals for the Fifth Circuit

SYMPOSIUM NUMBER THIRTEEN (1964)

Justice Leonard v. B. Sutton, of the Supreme Court of Colorado

Justice Samuel Freedman, of the Court of Appeal of Manitoba

Justice James L. McLennan, of the Supreme Court of Ontario

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