# COPYRIGHT LAW SYMPOSIUM

*Number Nine*

NATHAN BURKAN
MEMORIAL COMPETITION

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# *Foreword*

THE NINTH ANNUAL SYMPOSIUM, commemorating the nineteenth successive year of the Nathan Burkan Memorial Competition, brought to the three judges for their examination a total of thirty-eight papers. All of these were interesting and most possessed substantial worth. It should be noted that the three judges, examining the papers separately, one at some geographic distance from the others, agreed as to the five best papers. There was also, somewhat to the judges' astonishment, a complete agreement as to the two best papers. But the difficulty of deciding which of the two latter essays was really the best increased with each examination of the manuscripts. We remark parenthetically that "essay" is perhaps too "fine" a term to put on such robust legal writings. Happily, permission to make two first place awards has relieved the judges of the burden of making a choice which could not have left the panel wholly happy. The paper by Arthur Rossett of the Columbia University School of Law, "Burlesque as Copyright Infringement," and the paper by G. T. McConnell of the Harvard University Law School, "The Effect of the Universal Copyright Convention on Other International Conventions and Arrangements," though differing greatly in style and contents, were each awarded first place.

Mr. Rossett's article is sharply and brilliantly written and demonstrates an originality of thought which the judges found appealing. Mr. McConnell's paper is a thorough and painstaking examination of the treaty field. It demonstrates a high degree of scholarship and should prove most useful to students of copyright law and to those of the judiciary who must delve into international copyright arrangements. The judges also

agreed that the three remaining papers should be awarded honorable mention. These are Stuart Jay Young's "Freebooters in Fashions: The Need for a Copyright in Textile and Garment Designs," written at the Columbia University School of Law; Richard W. Roberts's "Publication in the Law of Copyright," written at the University of Virginia Law School; and Edward Silber's "Use of the Expert in Literary Piracy: A Proposal," written at the University of Wisconsin Law School.

The Competition this year, as in the past, has brought forth distinguished work which merits high praise. Moreover, the labor has been most useful. The intricacies and ramifications of the copyright system increase with each passing year, and the winning papers and those which we have mentioned throw light on shadowy or dark corners of our copyright law. The judges themselves have profited from reading the papers submitted. We entertain no doubt that as time goes on the Nathan Burkan Memorial Competition will serve an ever more useful purpose, and that the scholarly papers submitted, published as they will be each year by ASCAP, will supply a growing fringe of law to be embodied in future decisions of our courts.

JOHN BIGGS, JR.
CHIEF JUDGE, UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

WILLIAM H. HASTIE
CIRCUIT JUDGE, UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

SIMON E. SOBELOFF
CIRCUIT JUDGE, UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

*August, 1958*

NATHAN BURKAN
1878–1936

# *Introduction*

THE PUBLICATION of this, the Ninth Copyright Law Symposium, marks the nineteenth successive year of the Nathan Burkan Memorial Competition.

The care with which the papers are selected for publication in the Symposium is indicated by the outstanding qualifications of the Panel of Judges.

Chief Judge John Biggs, Jr., of the United States Court of Appeals for the Third Circuit served as Chairman of the Panel. His interest in literature is not limited to its legal aspects for he is an author, not merely of such legal tomes as *Delaware Laws Affecting Business Corporations* but of two novels as well: *Demigods*, published in 1926, and *Seven Days' Whipping*, published in 1928. In addition, he was a contributor to *Scribner's Magazine*.

Judge William H. Hastie became an associate of Judge Biggs on the United States Court of Appeals for the Third Circuit after distinguished service as Governor of the Virgin Islands, Dean of Howard University School of Law, and Federal District Court Judge in the Virgin Islands.

Judge Simon E. Sobeloff of the United States Court of Appeals for the Fourth Circuit came to that post after making an enviable record as Solicitor General of the United States, Chief Judge of the Maryland Court of Appeals, City Solicitor of Baltimore, and Chairman of the Commission on Administrative Organization of the State of Maryland.

The five papers which appear in this volume were chosen by this eminent Panel of Judges from 38 papers written by

students attending 31 different law schools throughout the country.[1]

The essays published here were written by students at four of the country's leading law schools: Columbia University, Harvard University, the University of Virginia, and the University of Wisconsin. The Columbia, Harvard, and Wisconsin law schools have been regular contributors to the Competition and have been represented in earlier Symposia. However, this is the first year in which a paper written by a student in the University of Virginia Law School has been submitted for consideration in the National Competition. This initial entry was considered by the Judges of sufficiently high caliber to merit publication in this annual Symposium.

The Nathan Burkan Memorial Competition was instituted by the American Society of Composers, Authors and Publishers in honor of the Society's first general counsel. Over the years, the Competition has gained a firm foothold in the law schools of the country and in the legal profession in general. By encouraging law students to delve deeply into many aspects of the copyright law, the Competition has been an important factor in helping the legal profession keep pace with the ever increasing role literature and the arts enjoy in the world today.

The scope of the problems basic to many areas of copyright law is illustrated by the five papers appearing in this volume. Evidencing scholarly research, these papers show an imaginative approach by their authors in their search for a solution to the various problems discussed.

"Burlesque as Copyright Infringement," by Arthur Rossett of the Columbia University School of Law, one of the two National Award winners, points up most vividly the policy decision which a court must make when faced with the con-

[1] The papers which appeared in the eight previous Copyright Law Symposia, arranged according to the authors' law schools, are listed at pages 177 to 181 of this volume.

flicting interests of one presenting a parody and the author of the copyrighted work which is the subject of the parody. While recognizing parody as a desirable form of artistic creation, Mr. Rossett maintains that satire should not be treated as fair use of copyrighted material if it merely reenacts the borrowed work without substantially changing it. The author has aptly illustrated his thesis by a thorough discussion of the two most recent cases on this subject: *Loew's Inc. v. Columbia Broadcasting System*[2] (Jack Benny's parody of the movie *Gaslight*), and *Columbia Pictures Corp. v. National Broadcasting Co.*[3] (Sid Caesar's parody of the movie *From Here to Eternity*). The recent per curiam affirmance, by an equally divided Supreme Court, of the district and appellate courts' holding that Jack Benny's parody of *Gaslight* constituted copyright infringement has excited much comment in nonlegal circles.[4]

The other National Award winning paper, "The Effect of the Universal Copyright Convention on Other International Arrangements" by G. T. McConnell of Harvard University Law School, is a penetrating analysis of a vitally important aspect of copyright law—the Universal Copyright Convention.

Since its adoption in 1954, the UCC has been a popular topic with student winners of the yearly Competition at many law schools. Two of these essays on the Convention which have been published in earlier volumes should be of interest to students of international copyright law: "International Copyright Protection and the United States: The Impact of the Universal Copyright Convention on Existing Law," by Daniel M. Singer of Yale University School of Law;[5] and "The

[2] 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd sub nom.*, Loew's Inc. v. Benny, 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided Court* 78 S. Ct. 667 (1958).

[3] 137 F. Supp. 348 (S.D. Cal. 1955).

[4] *E.g.*, Poore, *Ardent Plea for the Art of Parody*, New York Times Sunday Magazine Section, March 9, 1958, p. 3; Commonweal, April 4, 1958, p. 4; Time, March 31, 1958, p. 40.

[5] COPYRIGHT LAW SYMPOSIUM NUMBER SEVEN 176 (1956).

Universal Copyright Convention and the United States: A Study of Conflict and Compromise," by William H. Wells of the University of Illinois College of Law.[6]

Mr. McConnell's paper, published in this Symposium, is a detailed discussion of the many problems which may arise in applying various provisions of the Universal Copyright Convention in areas of the world where its parent—the Berne Convention—is also in force. The author graphically illustrates his points by the use of well-chosen hypothetical examples. As a member of the American delegation to the Geneva Convention which drafted the Universal Copyright Convention, I know that many of us were concerned with some of these same issues raised by Mr. McConnell. His paper, treating as it does with many questions which have not yet been dealt with judicially, affords him ample opportunity for original thinking; it shows that he has made excellent use of this opportunity.

The three remaining papers chosen by the Judges for publication in this Symposium are also illustrative of the wide variety of problems which frequently arise in copyright law.

"Freebooters in Fashions: The Need for a Copyright in Textile and Garment Designs," by Stuart Jay Young of Columbia University School of Law, points up well the unique problem faced by the creators of short-lived fashions in seeking protection from design piracy.

Richard W. Roberts of the University of Virginia Law School, who writes on "Publication in the Law of Copyright," presents a thorough study of the crucial "publication" issue which arises so often in copyright cases.

"Use of the Expert in Literary Piracy: A Proposal," by Edward Silber of the University of Wisconsin Law School is a critical study of the "ordinary observer" test which the

[6] COPYRIGHT LAW SYMPOSIUM NUMBER EIGHT 69 (1957).

courts use in determining the existence of copyright infringement.

The enthusiasm and thoroughness with which the three distinguished Judges approached the selection of the papers which appear here is a tribute to our judiciary, whose members appreciate the necessity of encouraging law students to make creative use of the research techniques made available to them in the nation's law schools. On behalf of the Society, the writer wishes to express deep appreciation to the Panel of Judges for an outstanding contribution to the high level of legal thinking which the Nathan Burkan Memorial Competition seeks to encourage and which this volume represents.

HERMAN FINKELSTEIN, GENERAL ATTORNEY
AMERICAN SOCIETY OF COMPOSERS,
AUTHORS AND PUBLISHERS

*New York, New York*
*August, 1958*

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# *ASCAP*

COPYRIGHT LAW SYMPOSIUM

*Number Nine*

NATIONAL AWARD ESSAY, 1956

# *Burlesque as Copyright Infringement*

By ARTHUR ROSSETT

COLUMBIA UNIVERSITY SCHOOL OF LAW

DEFINING THE LEGAL INTEREST of an author in his work has been a serious problem in the law since the invention of movable type made possible the mass dissemination of ideas and thus gave artistic products substantial economic value.[1] The problem is acute in modern society, where the arts are "big business" [2] and economic return, rather than patronage, supports the arts.

Recently, ancillary to the sharp competition between the giant television and motion picture industries, a unique problem of copyright law has been brought into direct litigation for the first time. Two cases decided recently in the District Court for the Southern District of California involved suits

[1] The concept that an author has some economic rights in his work is itself very old, going back at least to Roman times. It is interesting to note how quickly after the time of Gutenberg sanctions were imposed to control the new craft. For early history of copyright see BOWKER, COPYRIGHT, ITS HISTORY AND LAW 8–28 (1912); PUTNAM, THE QUESTION OF COPYRIGHT 355–64 (3d ed. 1904). See Yankwich, *Originality in the Law of Intellectual Property*, 11 F.R.D. 457 (1952).

[2] The industries in this field have indeed become gargantuan. THE STATISTICAL ABSTRACT OF THE UNITED STATES 386, 528–34 (1954), reports that in 1952 the total broadcast revenues of the 2,502 radio and television stations in the United States was $793,915,000. During 1953, 12,050 new books and new editions were published while total net paid circulation of American newspapers was 54,472,000. The same source reports that in 1950 the motion picture industry reported total compiled receipts of $1,608,064,000. These figures should be compared with the ten year period from 1790–1800, during which a total of 556 titles (mostly pedagogical) were registered in the District Courts for copyright. GOFF, THE FIRST DECADE OF THE FEDERAL ACT FOR COPYRIGHT 1–2 (1951).

by motion picture companies against broadcasting networks and television comedians.[3] In both cases, the plaintiffs claimed infringement of their copyright in a motion picture through a television skit lampooning the film. The problem of parody and copyright infringement is significant to the legal nonspecialist because it highlights three fundamental issues of the copyright law: the nature of the copyright infringement, the types of use excepted from liability under the copyright law, and the relief afforded a successful copyright plaintiff. This essay will analyze these traditional concepts of the copyright law and examine the changes suggested in these traditional approaches by the novel fact situation involved in the problem of copyright infringement by parody.

## BACKGROUND OF COPYRIGHT LAW

The copyright law of the United States is based on the constitutional grant to Congress of 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." [4] Building upon the general framework provided by English copyright law,[5] Con-

[3] Columbia Pictures Corp. v. National Broadcasting Co., 137 F. Supp. 348 (S.D. Cal. 1956); Loew's Inc. v. Columbia Broadcasting System, 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd sub nom.*, Loew's Inc. v. Benny, 239 F.2d 532 (9th Cir. 1956).

[4] U.S. CONST. art. I, § 8.

[5] The printing industry in England was controlled during its early history by the Stationer's Company, which originated in the early part of the fifteenth century as a guild of printers, bookbinders and publishers and which received governmental sanction through enforcement in the Star Chamber under the Tudors. See Holdsworth, *Press Control and Copyright in the 16th and 17th Centuries*, 29 YALE L.J. 841 (1920). After the abolition of the Star Chamber in 1640, courts began to speak of the common law rights of an author in his work. For a collection of cases finding common law copyright during this period see Justice Wille's opinion in Millar v. Taylor, 4 Burr. 2303, 2314–18, 98 Eng. Rep. 201, 207–10 (K.B. 1769). In 1709, by the statute of 8 ANNE c. 19, the sole right of publication for a renewable fourteen-year period was granted to authors of books registered with the Stationer's Company. The act provided for fixed statutory damages (§ 1) and also contained provisions to regulate prices and ensure that they were reasonable (§ 4) and for the distribution of

gress has established federal control of postpublication copyright [6] but has reserved to authors their common law rights to unpublished works.[7] The constitutional purpose is to promote "Science and useful Arts"; the securing of exclusive rights being a means to the end, but not an end in itself. The clause has been so interpreted by Congress [8] and by the courts

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copies of copyrighted works to various libraries throughout the realm (§ 5). These provisions indicate the strong intent of the act to encourage the dissemination of learning and progress of the arts as well as to protect authors. The effect of the statute on the perpetual common law rights lay in doubt for sixty years, until a divided House of Lords held that the statute limited the pre-existent common law rights. Donaldson v. Beckett, 4 Burr. 2408, 98 Eng. Rep. 257 (H.L. 1774). This view was later accepted in the United States. Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834).

The English statute did not extend to the American colonies. Pursuant to the recommendation of the Continental Congress, all of the original states except Delaware enacted copyright legislation before the Constitution came into effect. Resolution of May 2, 1783, 24 JOURNALS OF THE CONTINENTAL CONGRESS 326 (1922). (The resolution recommended a renewable grant for at least 14 years to extend to all citizens of the United States.) These state acts are compiled in COPYRIGHT ENACTMENTS OF THE UNITED STATES, 1783–1906 (U.S. COPYRIGHT OFFICE BULL. No. 3, 1906).

[6] The first copyright act protected only a "map, chart, book or books." Act of May 31, 1790, c. 15, § 1, 1 STAT. 124. In 1802 this protection was extended to "any historical or other print or prints." Act of April 29, 1802, c. 36, § 2, 2 STAT. 171. Musical compositions became copyrightable by the Act of Feb. 3, 1831, c. 16, § 1, 4 STAT. 436. The sole right to perform, publish and act dramatic compositions was given by the Act of Aug. 18, 1856, c. 169, § 1, 11 STAT. 138. Photographs were granted protection by the Act of March 3, 1865, c. 126, § 1, 13 STAT. 540. Paintings, drawings, chromos, statues, models and designs intended to be perfected as works of the fine arts were first mentioned in the Act of July 8, 1870, c. 230, § 86, 16 STAT. 212. Unauthorized public performance of copyrighted musical material was prohibited by the Act of Jan. 6, 1897, c. 4, § 4966, 29 STAT. 481. Foreign authors were protected for the first time by the Act of March 3, 1891, c. 565, §§ 4952, 4956, 26 STAT. 1106. Mechanical reproduction of music was added to the protected list by the revision of 1909. Act of March 4, 1909, c. 320, 35 STAT. 1075. Motion pictures were added by the Townsend Amendment in 1912. 37 STAT. 488.

[7] 17 U.S.C. § 2 (1952). Federal district courts have exclusive jurisdiction in postpublication copyright cases. 28 U.S.C. § 1338(a) (1952).

[8] See H.R. REP. No. 2222, 60th Cong., 2d Sess. (1909), reprinted in HOWELL, THE COPYRIGHT LAW 253, 260 (3d ed. 1952). The materials on the constitutional convention are noteworthy for their lack of enlightenment on the copyright clause. The clause was approved without debate. See Fenning, *The Origin of the Patent and the Copyright Clause of the Constitution*, 17 GEO. L.J. 109 (1929). Madison limits the discussion of the clause to one paragraph in THE FEDERALIST. See No. 43 at 278–79 (Modern Library ed.).

in litigation where both patent [9] and copyright [10] were involved.

In many civil law countries certain rights, such as the author's right to have his name associated with the work or to veto alterations, are considered personal and are not lost by sale or assignment of the copyright.[11] In the United States such rights are not given explicit recognition,[12] but since eco-

[9] See, *e.g.*, Woodbridge v. United States, 263 U.S. 50, 55–56 (1923) (purpose of the Constitution is to encourage science by monopoly grant); Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U.S. 502, 510–511 (1917); Torok v. Watson, 122 F. Supp. 788, 790–91 (D.C.D.C. 1954) (application for patent must be measured against constitutional purpose).

[10] See, *e.g.*, Mazer v. Stein, 347 U.S. 201 (1954); Becker v. Loew's Inc., 133 F. 2d 889, 891 (7th Cir. 1943), *cert. denied*, 319 U.S. 772 (1943); Martinetti v. Maguire, 16 Fed. Cas. No. 9173, at 922 (C.C. Cal. 1867).

[11] These rights are protected in civil law countries by the *droit moral*. Other examples of this doctrine are the right to prevent the publication, unskilled or inartistic presentation, or abusive and excessive criticism of the work. In France the *droit moral* is nonstatutory but has been recognized by the courts since 1814. For an excellent study of the *droit moral*, with particular emphasis on the law of France see MICHAEL-NOUROS, THE MORAL RIGHT OF THE AUTHOR (1935). For a compendium of the law on the subject see 2 PINNER, WORLD COPYRIGHT 994–1058 (1954). It appears from Pinner's survey that at least 33 nations recognize these personal rights of the author in some form. This essay will not consider whether the United States should adopt the *droit moral*. For discussions of this interesting problem see Katz, *The Doctrine of Moral Right and American Copyright Law—A Proposal*, 24 So. CALIF. L. REV. 375 (1951); Roeder, *The Doctrine of Moral Right: A Study in the Law of Artists, Authors and Creators*, 53 HARV. L. REV. 554 (1940); 49 COLUM. L. REV. 132 (1949). In 1936 the Senate passed a bill which would have introduced into the copyright law the moral right provisions of Article 6 *bis* of the Berne Convention. S. 3047, 74th Cong., 1st Sess. § 41(b) (1936). The bill failed to pass the House. Great Britain does not recognize the moral right. Skone-James in 2 PINNER, WORLD COPYRIGHT 507 (1954). However, the Canadian Copyright Act does. Copyright Act of 1931, c. 8, § 5, CAN. REV. STAT. c. 55, § 12(7) (1952).

[12] It seems clear that so long as the grant is for a limited time, Congress is not restricted by the constitutional grant as to what "exclusive Right to their respective Writings" it can give authors. U.S. CONST. art. 1, § 8. To some extent artistic integrity has been protected by state equity courts. This protection has been spotty, however, and has been based on many theories of liability. In New York, for example, the right not to have one's name used on a work one did not write has been protected under the state's "right to privacy" statute (§§ 50, 51, N.Y. CIVIL RIGHTS LAW): Eliot v. Jones, 66 Misc. 95, 120 N.Y. Supp. 989 (Sup. Ct. 1910), *aff'd.*, 140 App. Div. 911, 125 N.Y. Supp., 1119 (1st Dep't 1911) (use of Harvard president's name in connection

nomic detriment is not an element of the cause of action for infringement, purely artistic or personal rights have been given at least indirect protection. Thus the Code protects the right of an author, so long as he is the proprietor of the copyright, not to use his work and still maintain an action for infringement.[13] Most cases, in practice, involve some form of economic detriment to the borrowed work. In view of the fact that artistic motivations are often strong stimulants to creation,[14] however, there would seem to be no reason why the law should be limited to the protection of pecuniary in-

with books he did not write enjoined under statute); Ellis v. Hurst, 66 Misc. 235, 121 N.Y. Supp. 438 (Sup. Ct. 1910), aff'd, 140 App. Div. 918, 130 N.Y. Supp. 1110 (1st Dep't 1911) (publication of work in public domain under proper name of author rather than *nom de plume* enjoined); as libel *per se:* Ben Oliel v. Press Publishing Co., 251 N.Y. 250, 167 N.E. 432 (1929); Gershwin v. Ethical Pub. Co., 166 Misc. 39, 1 N.Y.S. 2d 904 (City Ct. N.Y. 1937) (doctor's name given as author of medical article he didn't write); or under a contract theory: Fairbanks v. Winik, 206 App. Div. 449, 201 N.Y. Supp. 487 (1st Dep't 1923) (detrimental editing of films enjoined on petition of actor on basis of contract); Packard v. Fox Film Corp., 207 App. Div. 311, 202 N.Y. Supp. 164 (1st Dept. 1923) (use of plaintiff's name on motion picture drastically altered from plaintiff's original story). It should be noted that in all these cases there was some ancillary ground for finding liability; where the question is squarely put, American courts have denied the existence of any doctrine of personal or "moral" rights in our law. Vargas v. Esquire Inc., 164 F.2d 522, 526 (7th Cir. 1947); Shostakovitch v. Twentieth Century Fox Film Corp., 196 Misc. 67, 70, 80 N.Y.S. 2d 575, 578 (Sup. Ct. 1948), *aff'd*, 275 App. Div. 692, 87 N.Y.S. 2d 430 (1st Dep't 1949); Crimi v. Rutgers Presbyterian Church, 194 Misc. 570, 574–77, 89 N.Y.S. 2d 813, 817–19 (Sup. Ct. 1949). See 49 COLUM. L. REV. 132 (1949) (review of cases up to that time).

[13] See Fox Film Corp. v. Doyal, 286 U.S. 123, 127 (1932) (dictum). The constitutional justification for the right of non-user is not as obvious as that for economic rights. Indeed, the proposition that the arts are promoted by the permissive stifling of artistic works, even by their creators, seems paradoxical. The apparent inconsistency is minimized when it is considered that if this right were denied, and the author were not permitted to prevent publication of works he considered unworthy of perpetuation, artistic integrity and pride would suffer; as a result, authors would be discouraged from producing. To those authors for whom the noneconomic spurs to creation are the greatest, this right to protect one's artistic reputation would be particularly valuable and effective in encouraging creativity.

[14] Motivations other than economic reward and artistic integrity which contribute to the creation of artistic works include the psychological necessity of the individual to create and the drive for fame.

terests. Another reason for not limiting protection to cases of proven economic detriment is that such injury is often extremely speculative and difficult to prove.

## INFRINGEMENT

All statutory actions for infringement [15] are based on section 1 of the Copyright Act,[16] which defines the rights of the proprietor of the copyright to a work. Literary infringement actions arise out of section 1(a), which gives the copyright holder the exclusive right to "print, reprint, publish, copy and vend" [17] his work.

Most infringement actions involve the lifting of an idea, sequence, or story line rather than verbatim copying. Rarely is the appropriator so crude as to lift the plaintiff's words outright. As the works become increasingly dissimilar, or the context in which the borrowed material is used grows less like the original, the difficulty of determining what constitutes infringement increases.[18] Courts have generally resolved this

[15] The American Copyright Act contains no definition of infringement. The British Copyright Act states that the "Copyright in a work shall be deemed to be infringed by any person who, without the consent of the owner of the copyright, does anything the sole right to do which is by this Act conferred on the owner of the copyright. . . ." 1 & 2 GEO. 5, c. 46, § 2(1) (1911).

[16] 17 U.S.C. § 1 (1952).

[17] U.S.C. § 1(a) (1952).

[18] "It is of course essential to any protection of literary property, whether at common-law or under the statute, that the right cannot be limited literally to the text, else a plagiarist would escape by immaterial variations. That has never been the law, but, as soon as literal appropriation ceases to be the test, the whole matter is necessarily at large, so that . . . the decisions cannot help much in a new case." L. Hand, J., in Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931); Fendler v. Morosco, 253 N.Y. 281, 292, 171 N.E. 56, 59–60 (1930). See Universal Pictures Inc. v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1947); Story, J., in Folsom v. Marsh, 9 Fed. Cas. No. 4901, at 344 (C.C. Mass. 1841), "Patents and copyrights approach, nearer than any other cases belonging to forensic discussions, to what may be called the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and, sometimes, almost evanescent."

It should be noted that these same problems involving the extent of copyright, the protection of abstractions, and the like reappear in many guises throughout the various phases of copyright law, such as substantiality, copying,

problem by requiring substantial copying of the physical expression of the copyrighted work as the essential element of a cause of action.

PHYSICAL EXPRESSION V. IDEAS

Courts have said that copyright does not protect ideas expressed in the work,[19] but rather only the physical expression of these ideas.[20] The law does not grant monopolies in ideas because it is considered undesirable and contrary to the bases of our social system to limit the free dissemination of ideas.[21] The problem of applying general rules to particular situations is therefore particularly difficult in copyright law. Words in themselves have no intrinsic meaning, they are merely symbols for ideas.[22] Yet no monopoly is granted to the use of the idea symbolized by the words. If the copyright protection is extended to something more than the precise expression in the copyrighted work, other artists may be overly hampered in their treatment of the same idea.[23] But, if protection is limited to the actual working of the copyrighted work, the

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fair use, and infringement. The problem in all contexts is essentially the same: whether the constitutional ends will be served by permitting this type of appropriation. Although the categorization used in this essay may differ from those used by other writers these differences do not appear to be overly important. They seem purely conceptual and in no wise affect the determinative factors to be considered, or the result in any factual situation.

[19] *E.g.*, Mazer v. Stein, 347 U.S. 201, 217–18 (1954) (idea of using statuettes of human beings as bases for table lamps); Baker v. Selden, 101 U.S. 99 (1879) (bookkeeping system); Dellar v. Samuel Goldwyn Inc., 150 F.2d 612 (2d Cir. 1945), *cert. denied*, 327 U.S. 790 (1946) (play's plot, theme, or ideas but not its expression); Dymow v. Bolton, 11 F.2d 690 (2d Cir. 1926) (play's plot). *But cf.* Dam v. Kirk La Shelle, 175 Fed. 902 (2d Cir. 1910), and Shelden v. Metro-Goldwyn-Mayer, 309 U.S. 390 (1940), where infringement was found despite differences in language, plot, and characters.

[20] See Holmes v. Hurst, 174 U.S. 82, 86 (1899) (dictum); Eichel v. Marcin, 241 Fed. 404, 408–09 (S.D.N.Y. 1913) (dictum).

[21] *Cf.* Dissenting opinion of Mr. Justice Brandeis in International News Service v. Associated Press, 248 U.S. 215, 263 (1918).

[22] *Cf.* Ogden and Richards, The Meaning of Meaning (1925).

[23] See Chafee, *Reflections on the Law of Copyright*, 45 Colum. L. Rev. 503, 511–14 (1945).

right is of little economic value to the author, since other authors can use synonyms to express the same idea. The physical expression concept, therefore, does not furnish a sole criterion for delimiting the extent of copyright protection.

COPYING

Most infringement actions arise as alleged violations of that provision of the Copyright Act that gives a holder exclusive right to "copy" his work.[24] Copying is used in two distinct contexts. The first is its common usage, as a synonym for appropriation. When used in this sense, the court simply determines whether, in fact, *A* took material from *B*'s copyrighted work. Though this is an element of every infringement action, it does not in itself suffice to constitute the cause of action. A second and more meaningful context is the sense in which it was defined by the Supreme Court the year before the present Copyright Act was enacted. In *White-Smith Music Pub. Co. v. Apollo Co.*,[25] the Court adopted the often cited definition from the English case of *West v. Francis:*[26] "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." This definition was understood by the Court in *White-Smith* to require a finding that the use of copyrighted music on music rolls for player pianos does not infringe the copyright to the sheet music.[27] Clearly, as applied by the Court and ap-

[24] 17 U.S.C. § 1(a) (1952). The term "copy" is nowhere defined in the statute. The House Committee Report on the 1909 Act, which is substantially the present Copyright Act, noted that the wording of § 1(a) was carried over unchanged from earlier statutes because it was "felt that it was safer to retain without change the old phraseology which has been so often construed by the courts." H.R. REP. No. 2222, 60th Cong., 2d Sess. (1909) as reprinted in HOWELL, THE COPYRIGHT LAW 253, 257 (3d ed. 1952).

[25] 209 U.S. 1, 17 (1908).

[26] 5 B. & Ald. 738, 743, 106 Eng. Rep. 1361, 1363 (K.B. 1822).

[27] The holding in this case is no longer the law as the Copyright Act of 1909 specificially reserves to the proprietor of the copyright on a musical

parently as adopted by Congress in the Act of 1909, the definition requires something more than mere appropriation to constitute copying.

Courts have recognized the necessity for this additional element in requiring that appropriation, to constitute infringement, must be substantial. It is this context of copying, *i.e.*, as a work of art requiring substantial appropriation, which Congress seems to have had in mind when it passed the 1909 Act, and it is on this basis that the requirement of substantiality can be considered statutory. Consequently, the crucial test for infringement would seem more directly dependent on what is meant by substantiality than by the statutory word "copying."

SUBSTANTIALITY

Copyright protection is often defined as protection against substantial appropriation of copyrighted material.[28] Substantiality as yet has defied precise definition and often seems a coverall for some unarticulated basis of judicial determinations. The term probably came into copyright law through equity practice, where plaintiffs whose grievances were unsubstantial would be denied relief under the *de minimus* doctrine.[29]

The nature of literary activity demands some requirement

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composition the right of mechanical reproduction. 35 STAT. 1075 (1909), 17 U.S.C. § 1(e) (1952). The interpretation of the term "copying" remains unchallenged although other slightly variant definitions have been used by the courts.

[28] *E.g.*, Perris v. Hexamer, 99 U.S. 674, 676 (1878) (map symbols); Carr v. National Capital Press, 71 F.2d 220 (D.C. Cir. 1934) (format of poster based on Washington portrait); Dymow v. Bolton, 11 F.2d 690, 691–92 (2d Cir. 1926).

[29] See, *e.g.*, Howell v. Miller, 91 Fed. 129, 142 (6th Cir. 1898); Dun v. Lumberman's Credit Ass'n., 144 Fed. 83, 84 (7th Cir. 1906), *aff'd*, 209 U.S. 20 (1908); Lewis v. Fullarton, 2 Beav. 6, 48 Eng. Rep. 1080, 1082 (Rolls Ct. 1839). See also Nimmer, *Inroads on Copyright Protection*, 64 HARV. L. REV. 1125, 1127–33 (1951). In Great Britain the requirement of substantiality is statutory. 1 & 2 GEO. 5 c. 46, § 1(2) (1911).

akin to substantiality in the copyright law. Each author builds on what has gone before, and the ends of the copyright law are served by permitting a certain amount of imitation.[30]

Like copying, substantiality has several different connotations when it is applied by the courts to questions of copyright infringement. These elements are not mutually exclusive, and one is likely to find a court using two or more connotations of the term in the same opinion.[31]

The first connotation of substantiality as a criterion of infringement involves the "ordinary observer" test. To have infringement under this test it must spontaneously and immediately appear to the "ordinary observer" or "average person" that defendant's work was based on, or used, plaintiff's work.[32] This test appears to involve some sort of rough and nontechnical comparison of the two works. On the basis of reliance on the ordinary observer, the use of expert testimony has been disparaged.[33] The weakness of this test is this same attribute, its reliance on the ill-defined, visceral reaction of a nonexpert. Substantiality is always concerned with the question of the quality or quantity of the material *appropriated.* It would appear unreasonable—if not impossible—to ask a layman to distinguish between those elements of the borrowing work which were actually appropriated and those which,

[30] "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.' Progress would be stifled if the author had a complete monopoly of everything in his book for fifty-six years or any other long period." Chafee, *Reflections on the Law of Copyright,* 45 COLUM. L. REV. 503, 511 (1945).

[31] Columbia Pictures Corp. v. National Broadcasting Co., 137 F. Supp. 348 (S.D. Cal. 1956); Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1947). The last cited case is a veritable potpourri of criteria on which the finding of substantiality is based.

[32] Harold Lloyd Corp. v. Witwer, 65 F.2d 1, 18–19 (9th Cir. 1933), *cert. dismissed,* 296 U.S. 669 (1933); King Features Syndicate v. Fleischer, 299 Fed. 533 (2d Cir. 1924).

[33] Nichols v. Universal Pictures Corp., 45 F.2d 119, 123 (2d Cir. 1930), *cert. denied,* 282 U.S. 902 (1931); Harold Lloyd Inc. v. Witwer, 65 F.2d 1 (9th Cir. 1933), *cert. dismissed,* 296 U.S. 669 (1933); Cain v. Universal Pictures, 47 F. Supp. 1013, 1015 (S.D. Cal. 1942).

although superficially similar, were the result of independent labor.[34]

The second connotation of substantiality involves considerations of economic detriment. Economic detriment appears to have come into the field of infringement from the area of fair use through the improper citation of fair use cases in situations involving the question of infringement.[35] The criterion does have the virtue of being directly related to the constitutional policy of promoting the progress of the arts through the establishment of economic rewards for artistic production. It should not be given undue significance, however, since the arts may be promoted by other motivations apart from financial gain. Moreover, to make economic detriment a *sine qua non* of substantiality would be to defeat valid copyright claims in those cases where problems of proof prevent plaintiff from showing economic injury.[36] Thus it seems preferable to consider economic detriment as a factor in determining the applicability of the doctrine of fair use or in ascertaining the nature and amount of relief to be awarded.

A third connotation, or perhaps more accurately, group

[34] An independently conceived work, though similar to the copyrighted one, is not an infringement. Baker v. Selden, 101 U.S. 99, 102–3 (1879) (dictum); Alfred Bell & Co. v. Catalda Fine Arts Inc., 191 F.2d 99, 102 (2d Cir. 1951); Ricker v. General Electric Co., 162 F.2d 141 (2d Cir. 1947); Christie v. Harris, 47 F. Supp. 39 (S.D.N.Y. 1942), *aff'd*, 154 F.2d 827 (2d Cir. 1944), *cert. denied*, 329 U.S. 734 (1946). In the absence of a showing of independent labor, however, similarity is strong evidence of copying. Lawrence v. Dana, 15 Fed. Cas. No. 8,136, at 60 (C.C.D. Mass. 1869).

[35] See the citation of West Pub. Co. v. Thompson, 169 Fed. 833, 854 (C.C.E.D.N.Y. 1909) which is a fair use case, based on Lawrence v. Dana, *supra* n. 34 and Folsom v. Marsh, 9 Fed. Cas. 342, No. 4901 (C.C. Mass. 1841), in such straight infringement cases as, *e.g.*, Universal Pictures Co. v. Harold Lloyd Corp., 162 F. 2d 354, 361 (9th Cir. 1947); National Inst. for Improvement of Memory v. Nutt, 28 F.2d 132, 135 (D.C. Conn. 1928), *aff'd*, 31 F.2d 236 (2d Cir. 1929). *Compare* BALL, LAW OF COPYRIGHT AND LITERARY PROPERTY 334 (1944), and WARNER, RADIO AND TELEVISION RIGHTS 571 (1953), *with Folsom v. Marsh*, *supra* at 344.

[36] The requirement of economic detriment as an element of substantiality and therefore of an infringement cause of action would also prevent recovery by a non-using copyright proprietor.

of connotations, is based on some literary classification or analysis.[37] These tests appear to call for expert, as opposed to "ordinary observer" determination. They are useful in so far as they indicate that substantiality is a qualitative rather than a quantitative concept. They fail in so far as they embroil the court in abstract literary speculations unrelated to the ends of the copyright law. The tests do represent a factor which should be considered in determining substantiality.

A fourth connotation of substantiality is a purely quantitative one. This meaning of substantiality probably arose under the old common law practice where law and equity were separate and the court was required to dismiss the suit if the amount appropriated was not sufficient to justify enjoining the entire work. Today, however, one court can award both an injunction and damages, and no reason exists, therefore, why a defendant should escape monetary liability solely because the amount taken was small.

Furthermore, a quantitative test would not seem sufficiently to delimit that which deserves copyright protection from that which does not. Particular words, plot incidents, and musical figures are all susceptible to more than one mode of physical expression. A plot incident that one author uses to heighten suspense may be used by another to provoke laughter and by a third as an allegorical symbol. These units of communication receive their emotional coloring from the context in which they appear. If material of a substantial nature is appropriated and expressed in an emotive context identical to that of the original work, it is clearly an infringement. If the same material is appropriated but the emotional coloring is removed, leaving only the words themselves,

[37] See, *e.g.*, Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931) ("patterns of increasing generality"); Nimmer, *Inroads in Copyright Protection*, 64 HARV. L. REV. 1125, 1127–33 (1951) ("basic plots" v. "embellishments"); Chafee, *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 503, 513–14 (1945) ("the pattern of the work" which appears to be "the sequence of events and the development of the interplay of the characters").

there seems to be a real question whether infringement exists. Thus, if ideas alone are appropriated without their physical embodiment there is no infringement, and if words alone are taken without any of their emotive context there is likewise no infringement.

Quantitative considerations alone therefore can never be determinative of substantiality; any test must examine the extent to which the emotive context of the borrowed material is similar to that of the original. Quantitative factors should, however, be one of the elements considered by a court in making an *ad hoc* determination of whether the appropriation was sufficiently substantial in relation to the constitutional policies of the Copyright Act.

## FAIR USE

Even if substantial appropriation is found, a cause of action for infringement can be defeated if the borrowing comes within the doctrine of "fair use." [38] Though the existence of such nonstatutory exceptions to liability has long been recognized,[39] no general criteria have been found which define what constitutes such "fair use." [40] The doctrine focuses on an examination of the borrowing work, while substantiality usually places emphasis primarily on the borrowed work. Fair use has been limited to cases where the material is ap-

[38] The question of fair use should be decided by the court as a question of law. In so far as questions of fact may be involved, for instance, in issues of competition, commerciality, or loss of sales value, the burden of coming forward and the burden of persuasion would appear to be on the defendant.

[39] See Folsom v. Marsh, 9 Fed. Cas. No. 4901, at 344 (C.C.D. Mass. 1841); Wilkins v. Aikin, 17 Ves. 422, 34 Eng. Rep. 163 (Ch. 1810); Gyles v. Wilcox, Barrow and Nutt, 2 Atk. 141, 26 Eng. Rep. 489 (Ch. 1740); Cary v. Kearsley, 4 Esp. 168, 170 Eng. Rep. 679, 680 (K.B. 1802).

[40] See, *e.g.*, Dellar v. Samuel Goldwyn, Inc., 104 F.2d 661, 662 (2d Cir. 1939) (". . . the most troublesome [issue] in the whole law of copyright . . ."); Lawrence v. Dana, 15 Fed. Cas. No. 8136, at 59 (C.C.D. Mass. 1869) (". . . one of the most difficult questions which can well arise for judicial consideration . . ."); Folsom v. Marsh, 9 Fed. Cas. No. 4901, at 344 (C.C.D. Mass. 1841) (". . . subtile and refined . . ."); WARNER, RADIO AND TELEVISION RIGHTS § 157, at 613 (1953); Yankwich, *What Is Fair Use?* 22 U. CHI. L. REV. 203 (1954).

propriated either for purposes of criticism, comment, or scholarship;[41] or where the appropriated work is used in a purely incidental manner in the borrowing work.[42]

Many efforts have been made to provide a rationale for fair use. One explanation which applies best to incidental uses is that fair use, like substantiality, is based on the application of the *de minimis* doctrine in the courts of equity, where many of the early cases involving fair use arose.[43] The

[41] This privilege is consonant with the grant of copyright for "the Progress of Science and Useful Arts." The considerations which enter into the grant of such a privilege were expressed by Lord Mansfield. ". . . we must take care to guard against two extremes equally prejudicial; the one, that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits, and the reward of their ingenuity and labour; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded." Sayre v. Moore, discussed in Cary v. Longman, 1 East. 358, 102 Eng. Rep. 138, 140 (K.B. 1801). See Cary v. Kearsley, 4 Esp. 168, 170, Eng. Rep. 679, 680 (K.B. 1802).

Early copyright law placed great stress on whether defendant's work was the product of independent effort. Thus translations and adaptations were considered fair uses. *E.g.*, Lawrence v. Dana, 15 Fed. Cas. 26, No. 8136 (C.C.D. Mass. 1869) (alternative holding); Stowe v. Thomas, 23 Fed. Cas. 201, No. 13514 (C.C.E.D. Pa. 1853) (translation); Story v. Holcombe, 23 Fed. Cas. 171, No. 13497 (C.C.D. Ohio 1847) (abridgment lawful, compilation an infringement). The first federal copyright act extended protection only to books, maps, and charts. Act of May 31, 1790, c. 15, § 1, 1 STAT. 124. Such an emphasis would naturally require the classification as fair use of most parodies. It was not until 1870 that authors were given the power to reserve the right to translate and dramatize their works. Act of July 8, 1870, c. 230, § 86, 16 STAT. 212. In 1891 these rights were given authors without specific reservation. Act of March 3, 1891, c. 565, § 1, 26 STAT. 1107. The present United States Copyright Code, reflecting these later extensions of protection, grants the copyright proprietor the exclusive right to ". . . translate . . . make any other version . . . dramatize . . . convert . . . arrange or adapt" the work. Act of March 4, 1909, c. 320, § 1(b), 35 STAT. 1075, now 17 U.S.C. § 1(b) (1952).

[42] See Karll v. Curtis Pub. Co., 39 F. Supp. 836 (E.D. Wis. 1941) (use of a professional football team's fight song in a magazine article about the team); Broadway Music Corp. v. F-R Pub. Corp., 31 F. Supp. 817 (S.D.N.Y. 1940) (use of a song associated with a movie actress in a comment on her death); Shapiro, Bernstein & Co. v. P. F. Collier & Son Co., 26 U.S.P.Q. 40 (S.D.N.Y. 1934) (use of a popular song to set mood in a short story).

[43] For early fair use cases brought in equity see, *e.g.*, Lawrence v. Dana, 15 Fed. Cas. 26, No. 8136 (C.C.D. Mass. 1869); Mawman v. Tegg, 2 Russ. 385, 38 Eng. Rep. 330 (Ch. 1826); Lewis v. Fullarton, 2 Beav. 6, 48 Eng. Rep. 1080 (Rolls Ct. 1839); Cohen, *Fair Use in the Law of Copyright*, in ASCAP, COPYRIGHT LAW SYMPOSIUM NUMBER SIX 43, 47 (1955).

plaintiff rarely suffers significant injury where the amount taken is not large, and to avoid encouraging such nuisance suits the Chancellor may well have been reluctant to grant equitable relief. Perhaps this reluctance is anachronistic under modern practice where one court can award damages as well as an injunction and other equitable remedies.[44] Since a consideration of the amount taken is one of the factors which enters into the determination of substantiality, it need not enter into the question of fair use. If the taking is not sufficient to be substantial, the question of fair use does not arise.

Another explanation postulates that fair use arises out of the implied consent of the author to the limited use of his works.[45] While we may meaningfully speak of the implied consent of the author to having his book read, resold, or criticized by a purchaser,[46] and a few other uses,[47] in most cases this implication of consent appears blatantly fictitious and unsuited for a candid system of jurisprudence. Also, if fair use is based on implied consent an author should be able to withdraw these rights by appropriate notice contained in the work.[48]

Some fair use has been justified in terms of customary usage.[49] It is questionable whether a plaintiff should be fore-

[44] See text following note 36 *supra*.

[45] *E.g.*, Sampson & Murdock Co. v. Seaver-Radford Co., 140 Fed. 539, 541 (1st Cir. 1905); Karll v. Curtis Pub. Co., 39 F. Supp. 836, 837 (E.D. Wis. 1941); Henry Holt & Co. v. Liggett & Myers Tobacco Co., 23 F. Supp. 302, 304 (E.D. Pa. 1938); see 2 LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 805 (1938).

[46] See Universal Film Mfg. Co. v. Copperman, 218 Fed. 577 (2d Cir. 1914).

[47] *E.g.*, Baker v. Selden, 101 U.S. 99, 103 (1879) (use of bookkeeping system); American Institute of Architects v. Fenichel, 41 F. Supp. 146, 147 (S.D.N.Y. 1941) (use of forms from architectural contract form book); Karll v. Curtis Pub. Co., 39 F. Supp. 836, 837 (E.D. Wis. 1941) (use of song dedicated to a professional football team in article about team).

[48] Cohen, *supra* note 43, at 51.

[49] See Dodsley v. Kinnersley, Amb. 403, 27 Eng. Rep. 270 (Ch. 1761); BALL, COPYRIGHT AND LITERARY PROPERTY 260 (1944); DEWOLF, AN OUTLINE OF COPYRIGHT LAW 143 (1925); WEIL, AMERICAN COPYRIGHT LAW 429-30 (1917); 15

stalled from relief solely because generations of previous potential plaintiffs have not chosen to exercise their rights. Yet the lack of litigation on parody as infringement despite the large number of parodies produced over the years appears significant.[50] It would seem that writers should be able to feel secure from legal liability when following long established practices of their art.

Perhaps the most useful justification for fair use is phrased in terms of the constitutional scheme of which it is part. Although fair use was not included by Congress in its formulation of the statutory scheme of copyright, the doctrine has a definite place in the constitutional plan for literary protection. Fair use thus defined is a use which will not seriously discourage progress by artists or whose social value greatly outweighs any detriment to the artist whose work is borrowed.[51]

In areas of the law where the boundaries of legal rights

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So. Calif. L. Rev. 249, 250 (1942). *But see* Walter v. Steinkopff [1892] 3 Ch. D. 489.

[50] See note 73 *infra.*

[51] Even if the plaintiff shows substantial appropriation, thus raising the inference that he was injured and therefore the use was detrimental to the progress of the arts, defendant can still come forward and show no detriment actually resulted from the use to the arts. The importance of economic detriment as a factor in finding fair use is limited by the presence of an interest in artistic integrity and the difficulty of proof, both discussed in text at note 36 *supra.* The considerations usually cited by courts as determinative of whether a particular use is fair were definitively outlined by Justice Story in Folsom v. Marsh, 9 Fed. Cas. No. 4901, at 342 (C.C.D. Mass. 1841). In that case, the copyright holder of the private papers of George Washington sued the publishers of a short life of Washington written in autobiographical form based on excerpts from plaintiff's work. Story held the value of the excerpts taken was sufficient to outweigh the benefit to the public derived from defendant's work and awarded judgment to the plaintiff. Story's criteria are: the comparative use in one work of the materials of the other; the nature, extent, and value of the materials thus used; the object of each work; and the degree to which the writers may fairly be presumed to have resorted to the same sources. (*Id.* at 344.) The last criterion seems to go to the question of appropriation rather than fair use. Use of common sources would show an absence of copying and negates infringement. If this is shown no question of fair use arises. Similarity between two works is not proof of copying if both are the result of independent labor. See cases cited note 34 *supra.*

and liabilities are not fixed, the question of economic detriment is likely to enmesh the court in a tautology, since courts base a finding of economic detriment on whether plaintiff would have been able to sell the particular right to exploit involved in the absence of the appropriation. But an author can only sell those rights which are legally protectable. Thus, vendability cannot properly be a factor in deciding the question of liability. In areas where legal rights are crystallized, however, economic detriment properly can mean economic damages such as reduction of sales of the borrowed work because of the alleged infringement. Such proof would seem to be a significant factor negativing fair use. Where a use impairs the selling value of the borrowed work, such use becomes inconsistent with the constitutional view of the Copyright Act that one of the chief stimulants to artistic progress is the economic advantage given to the creator.

In accordance with this, courts properly have placed emphasis on the effect of the use on the original,[52] expressing it in terms of whether the two works will tend to compete with each other, or whether the copy will tend to supersede the original.[53] Greater use can safely be permitted to a writer in

[52] This was rejected by the court in Loew's Inc. v. Columbia Broadcasting System, 131 F. Supp. 165, 183–84 (S.D. Cal. 1955) *aff'd sub nom.*, Loew's Inc. v. Benny, 239 F.2d 532 (9th Cir. 1956). It also appears to have been rejected by the court in Columbia Pictures v. National Broadcasting Co., 137 F. Supp. 348 (S.D. Cal. 1956).

[53] Where the issue is fair use, the competitive or superseding effect is usually considered a factor. Folsom v. Marsh, 9 Fed. Cas. No. 4901, at 344–45 (C.C.D. Mass. 1841) (". . . On the other hand, it is as clear, that if he [a critic] thus cites the most important parts of the work, with a view, not to criticise, but to supersede the use of the original work, . . . such a use will be deemed in law a piracy."); Karll v. Curtis Pub. Co., 39 F. Supp. 836, 837 (E.D. Wis. 1941) ("No music was set forth in the magazine article and it is very difficult to see how the value of the song could in any manner have been diminished by the article in question."); Shapiro, Bernstein & Co. v. P. F. Collier & Son Co., 26 U.S.P.Q. 40, 41 (S.D.N.Y. 1934) (". . . there could not have been any direct falling off of the sales of the printed copies of the song, because of any competition from this story."); Sayers v. Spaeth, *Copyright Decisions* 1924–35, U.S. COPYRIGHT OFFICE BULLETIN No. 20, at 625, 626 (S.D.N.Y. 1932). *But see* Leon v. Pacific Tel. & Tel. Co., 91 F.2d 484 (9th Cir. 1937), where defendant's substantial appropriation of material from plaintiff's telephone directory was held

an unrelated field than can be granted to a competitor. The courts also have been more reluctant to find fair use where the material was used for a commercial as opposed to an artistic or scholarly purpose.[54] Consequently, scientists and other scholars have been allowed great latitude in quoting and in other ways using the works of persons in their field of learning.[55] On the other hand, works of fiction may be quoted only in an incidental way, as, for example, to establish atmosphere for a story.[56]

The trouble with this commercial-noncommercial distinction is that both commercial and artistic elements are involved in almost every use. Television, movies, and the legitimate stage, although clearly commercial, are among the major media for artistic expression in our culture. Similarly, a number of learned books on scholarly subjects have recently enjoyed great popularity.[57] Their authors, while scholars, also may be fairly labeled academic entrepreneurs,

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not privileged as fair use although the two directories did not directly compete. This case can be understood as not involving a substantial question of fair use. Clearly, if the only issue is infringement and fair use is not involved, supplantation and competition do not affect liability. Falk v. Donaldson, 57 Fed. 32, 36–37 (C.C.S.D.N.Y. 1893); Reed v. Holliday, 19 Fed. 325, 327 (C.C.W.D. Pa. 1894), where court rejects defendant's fair use claim and then rejects position that defendant didn't intend to supersede or infringe. Noncompetition does affect remedies. Warren v. White & Wyckoff Mfg. Co., 39 F.2d 922, 923 (S.D.N.Y. 1930) (no competition found and therefore plaintiff left to statutory damages).

[54] See Loew's Inc. v. Columbia Broadcasting System, 131 F. Supp. 165, 175 (S.D. Cal. 1955) *aff'd sub nom.*, Loew's Inc. v. Benny 239 F.2d 532 (9th Cir. 1956). See also Henry Holt & Co. v. Liggett & Myers Tobacco Co., 23 F. Supp. 302 (E.D. Pa. 1938), where the use of three sentences from a medical treatise on diseases of the throat in a pamphlet advertising cigarettes was held not to be a fair use.

[55] See, *e.g.*, Thompson v. Gernsback, 94 F. Supp. 453, 454 (S.D.N.Y. 1950) (defendant's claim that infringing magazine was "scientific" work raised sufficient triable issue to require denial of plaintiff's motion for summary judgment). Simms v. Stanton, 75 Fed. 6 (C.C.N.D. Cal. 1896) (work on physiognomy privileged as fair use); Cary v. Kearsley, 4 Esp. 168, 170, 170 Eng. Rep. 679, 680 (K.B. 1802).

[56] See cases cited note 42 *supra.*

[57] See, *e.g.*, HIGHET, THE CLASSICAL TRADITION (1953); MEAD, MALE AND FEMALE (1949); WILSON, THE DEAD SEA SCROLLS (1955).

exploiting for commercial gain the fruits of their intellectual labors. The noncommerciality of the work, in so far as it is determinable, is relevant, however, in determining what types of uses should be encompassed within fair use as not being likely to compete with the borrowed work. Noncommercial uses should be more liberally permitted, since they are unlikely to cause direct competitive damage to the borrowed work. The converse of this proposition, *i.e.*, that if a work is commercial it is in direct competition, is not always true and hence should not often be used to deny a claim of fair use.

### RELIEF

Under the provisions of the Copyright Act the infringer is liable for: (a) an injunction restraining the infringement; (b) damages caused by the infringement; (c) an accounting of profits made by the infringement; (d) in lieu of (b) and (c) such damages as the court, in its discretion, may consider just within statutory limits.[58]

### INJUNCTIVE RELIEF

The granting of injunctive relief in a copyright action almost of necessity involves the stifling of some artistic expression. Although the seriousness of this problem varies with the degree of artistic effort in the infringing work, it would appear to be undesirable in any case to prohibit outright the publication of a work of art if a less stringent sanction is available. An injunction, of course, should not be granted unless the injury is continuing and the damages are likely to continue in the future. The extent of the taking is another

[58] 17 U.S.C. § 101 (1952). Additionally, the court may decree the destruction of infringing copies and materials used in their manufacture. *Id.* at § 101(d). In the case of musical reproductions mandatory royalties may be imposed. *Id.* at § 101(e). In all copyright actions, except those brought against the United States, the court must impose full costs and may in its discretion award attorney's fees as part of costs. *Id.* at § 116.

factor which the court should consider. Where large parts of plaintiff's work have been copied verbatim by a defendant an injunction would appear less offensive than where the amount taken was small and defendant's work contains much original material not related to the infringement. In this latter case, it is also less likely that irreparable harm was done to the sales value of plaintiff's work by defendant's taking.

MONETARY RELIEF

*Damages.* The successful plaintiff is entitled to recover any directly attributable damages or diminution in the value of his copyright resulting from the infringement. Proof of damages is often difficult in copyright cases, but several possible approaches are open to plaintiff.[59] Plaintiff may recover any loss in the capital or sales value of the copyright resulting from the infringement.[60] As speculative expert testimony is required to show loss of capital value, the utility of this measure is doubtful. Another measure of damages also requiring expert testimony would be to award the plaintiff as damages an amount equal to a reasonable royalty for the use defendant made of the work. The reasonable royalty measure has been used successfully in patent cases [61] and in at least one copyright case.[62] Several courts, however, have denied its applicability to copyright cases.[63] The concept of

[59] On the general subject of monetary relief for copyright infringement, see Note, *Monetary Recovery for Copyright Infringement,* 67 HARV. L. REV. 1044 (1954).

[60] Paramore v. Mack Sennett, Inc., 9 F.2d 66, 68 (S.D. Cal. 1925). This case is questionable on the issue of infringement. It is more easily explained in terms of unfair competition and "palming off" than copyright infringement.

[61] *E.g.*, 35 U.S.C. § 284 (1952); Dowagiac Mfg. Co. v. Minnesota Moline Plow Co., 235 U.S. 641 (1915); Enterprise Mfg. Co. v. Shakespeare Co., 141 F.2d 916 (6th Cir. 1944); Horvath v. McCord Radiator & Mfg. Co., 100 F.2d 326 (6th Cir. 1938), *cert. denied,* 308 U.S. 581, *rehearing denied,* 308 U.S. 636 (1939).

[62] Atlantic Monthly Co. v. Post Pub. Co., 27 F.2d 556 (D. Mass. 1928) (value of letter in literary market estimated and used as basis of profits).

[63] Widenski v. Shapiro, Bernstein & Co., 147 F.2d 909 (1st Cir. 1945); Lundberg v. Welles, 93 F. Supp. 359, 362–63 (S.D.N.Y. 1950).

reasonable royalty appears related to the "unjust enrichment" aspect of copyright liability, and in effect it is a way of granting plaintiff defendant's profits or statutory damages under another guise.[64]

*Profits.* If profits are awarded, the plaintiff is entitled only to that part of the defendant's profits which are attributable to the infringing use.[65] Large parts of profits are generally attributable to the presence of a known star, a skilled advertising campaign, or other aspects of the production in no way related to the infringement.[66] In the computation of profits resulting from the infringing use some courts, following *Sheldon v. Metro-Goldwyn Pictures Corp.*, have allocated 20 percent of defendant's net profits to the plaintiff.[67] This use of a fixed standard seems undesirable. Each case should be subject to individual determination to set the proper allocation.

*Statutory Damages.* As it may be impossible to prove damages satisfactorily and the profits attributable to the infringing use may be inadequate compensation, the Act provides for arbitrary damages to prevent the infringer from escaping

[64] Thus, in patent suits, the royalty rule provides successful plaintiffs who have been harmed but cannot prove either their actual damages or the defendant's actual profits with a means to escape the hollow victory of purely nominal damages. But the Copyright Act itself makes provision for similarly situated plaintiffs in copyright cases through the "in lieu" (statutory damage) clause of § 101(b), a provision not found in the corresponding section of the Patent Act, 35 U.S.C. § 284 (1952), and from this it can be concluded that it is a substitute for the established or reasonable royalty rule applied in patent cases. Widenski v. Shapiro, Bernstein & Co., 147 F.2d 909, 911 (1st Cir. 1945).

[65] 17 U.S.C. § 101(b) (1952).

[66] Profits attributable to such sources are not awarded. Sheldon v. Metro-Goldwyn-Mayer Pictures Corp., 106 F.2d 45 (2d Cir. 1939), *aff'd*, 309 U.S. 390 (1940). *But see* Dam v. Kirke La Shelle Co., 166 Fed. 589 (C.C.S.D.N.Y. 1908), *aff'd*, 175 Fed. 902 (2d Cir. 1910), *overruled by implication* Sheldon v. Metro-Goldwyn Pictures Corp., 309 U.S. 390 at 406 (1940). This computation of the profit attributable to the use is distinct from the cost deductions from sales which the defendant is permitted to prove under the statute. 17 U.S.C. § 101(b) (1952).

[67] See Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354 (9th Cir. 1947); Stonesifer v. Twentieth Century-Fox Film Corp., 48 F. Supp. 196 (S.D. Cal. 1942) *aff'd*, 140 F.2d 579 (9th Cir. 1944); Sheldon v. Moredall Realty Corp., 29 F. Supp. 729 (S.D.N.Y. 1939).

with only nominal liability.[68] Such statutory damages have long been a feature of copyright legislation [69] and the power to award them appears to exist even if some actual damages or profits are shown.[70] The Act sets fixed sums in several situations, but in most cases it permits the court to award ". . . such damages as to the court shall appear to be just. . . ." [71] The feeling probably is that the court should have wide discretion to find that plaintiff's proven damages were not sufficient to cover all the losses which he actually incurred.

Any one of these three remedies—damages, profits, or statutory damages—used in conjunction with a conditional injunction, could adequately compensate the injured copyright proprietor without creating the undesirable interference with free communication and criticism involved when a blanket injunction restraining publication of the infringing work is issued.

[68] 17 U.S.C. § 101(b) (1952). The minimum damages provisions of the statute are particularly important to such organizations as the American Society of Composers, Authors and Publishers, which depends upon them to enforce its licensing system. It is exceedingly difficult, for example, for ASCAP to show damages, or the profits inuring to a small neighborhood restaurateur from the infringing use of a radio performance of ASCAP music in the restaurant. The provisions are also employed by motion picture producers against theatre operators who use copyrighted films contrary to the provisions of the licensing agreement. In this situation also actual damages and profits are difficult to prove. See Note, *Monetary Recovery for Copyright Infringement*, 67 HARV. L. REV. 1044, 1054 (1954).

[69] The Statute of Anne provided for a form of statutory damages. See Note 5 *supra*. At least ten of the twelve states which passed copyright acts before 1787 also had provisions for some damages other than the actual damages to the plaintiff. See *Copyright Enactments of the United States, 1783–1906*, U.S. COPYRIGHT OFFICE BULLETIN No. 3, 1906. The first federal copyright act contained provisions similar to those of the Statute of Anne. Act of May 31, 1790, c. 15, § 6, 1 STAT. 124.

[70] See Jackson, J., in F. W. Woolworth Co. v. Contemporary Arts, Inc., 344 U.S. 228, 234 (1952), "We think that the statute empowers the trial court in its sound exercise of judicial discretion to determine whether on all the facts a recovery upon proven profits and damages or one estimated within the statutory limits is more just." *But see* Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354, 378 (9th Cir. 1947). "Award of statutory damages in the terms of the statute is proper only in the absence of proof of actual damages and profits."

[71] 17 U.S.C. § 101(b) (1952).

PARODY AND THE COPYRIGHT LAWS

Consideration of the relation of parody to the copyright laws will center around an examination of the two recent cases in the Southern District Court of California. Prior to these decisions case law on the problem of burlesque [72] was sparse,[73] although several text writers had discussed the is-

[72] The terms burlesque, satire, parody, and lampoon are not distinguished for purposes of this essay and are used interchangeably. These terms are used to denote literary forms characterized by: (a) humor; (b) comment or criticism of the work copied and possibly of matters topical or artistic; and (c) literary form, *i.e.*, not disjointed "gags" or episodes. Strictness of literary form is not required; the broad treatment of burlesque is sufficient. Mimicry, in so far as it is a criticism of the thing imitated, is also included. See Note 73 *infra.*

[73] Five American cases have been found which may have involved parody and infringement. The earliest was Bloom & Hamlin v. Nixon, 125 Fed. 977 (C.C.E.D. Pa. 1903). This suit was brought by the owner of a song copyright against a performer who mimicked an artist singing the song. Only the chorus of the song was used; this was found an incidental fair use. The imitated gestures were found not protected by copyright and an ex parte application for a preliminary injunction was denied. The court said that a parody would not infringe ". . . merely because a few lines of the original might be textually reproduced" (*id.* at 978), but emphasized the necessity of "good faith" in the mimicry. By way of dictum the court implied that parody is not infringement so long as it is in "good faith" and does not involve substantial appropriation. Under this view, a parody would not seem to have any greater rights than any other appropriating works, but *quaere*, whether mimicking a singer is parody as defined in note 72 *supra.* See also Savage v. Hoffmann, 159 Fed. 584, 585 (C.C.S.D.N.Y. 1908).

Two similar cases arose in the Circuit Court for the Southern District of New York in 1909. In Green v. Minzensheimer, 177 Fed. 286, the motion for preliminary injunction was denied. Although this suit was for infringement of the song copyright no music was played during the infringing performance and thus the case appears of little significance. In Green v. Luby, 177 Fed. 287, the preliminary injunction was granted. Since in *Green v. Luby*, the entire song was sung, the court distinguished *Bloom & Hamlin supra*, on the basis of that court's finding of insubstantial appropriation. The court said that if the defendant wanted to mimic another performer she could have imitated her gestures without music, or at least without using copyrighted music. Here again the question arises whether the defendant's performance constituted parody as defined for purposes of this essay.

The fourth American case, Hill v. Whalen & Martell, Inc., 220 Fed. 359 (S.D.N.Y. 1914) involved an adoption of the "Mutt and Jeff" comic strip as a stage presentation. The defendant claimed the work was a parody and privileged. In granting an injunction the court said: "A copyrighted work is subject to fair criticism, serious or humorous. So far as is necessary to that end, quotations may be made from it, and it may be described by words, representations, pictures,

sue.[74] In *Loew's, Inc. v. Columbia Broadcasting System*, Loew's sought to enjoin CBS and Jack Benny from using copyrighted material from the melodrama *Gaslight*.[75] The parodying skit followed the original play closely, using the locale, period, setting, characters, story points, plot development, sequence, climax, and much of the dialogue from plaintiff's motion picture.[76] The injunction was granted.

The second case, *Columbia Pictures Corp. v. National Broadcasting Co.*, was a suit by Columbia Pictures against NBC for infringement of Columbia's copyright in the film *From Here to Eternity* by a burlesque of the movie on the

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or suggestions. . . . One test which, when applicable, would seem to be ordinarily decisive, is whether or not so much as has been reproduced as [*sic*] will materially reduce the demand for the original." *Id.* at 360. Such reduction in demand was found here.

In the last American case, Leo Feist, Inc. v. Song Parodies, Inc., 146 F.2d 400 (2d Cir. 1944), defendant sold words which parodied the lyrics of popular copyrighted songs. No music was involved. Infringement was found but the question of parody as fair use was not litigated.

The British cases are not overly enlightening. In Francis, Day & Hunter v. Feldman & Co., [1914] 2 Ch. 728, the court of appeals reversed a finding that what appeared to be a parody of "You Made Me Love You" infringed the copyright of that song. The general question of parody and infringement was not discussed in the court's opinion.

Glyn v. Weston Feature Film Co., [1916] 1 Ch. 261, involved a motion picture burlesque of the novel *Three Weeks*. The court first found there was not substantial appropriation and then proceeded to discuss the problem of parody, deciding that it could not be infringement. *Id.* at 268–69.

The only report of Carlton v. Mortimer (K.B.D. Nov. 9, 1920) available is contained in MACGILLIVRAY, COPYRIGHT CASES 1917–23, 194. This case was a suit by the proprietors of the dramatic rights to "Tarzan and the Apes" against the producer of a comic acrobatic act "Warzan and his Apes." As reported by Macgillivray the court mentioned but did not consider the general problem and found that the burlesquing of two minor incidents and the title did not constitute infringement.

[74] See, *e.g.*, BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 290 (1944); SPRING, RISKS AND RIGHTS IN PUBLISHING, TELEVISION, RADIO, MOTION PICTURES, ADVERTISING AND THE THEATRE 177 (1952); WARNER, RADIO AND TELEVISION RIGHTS § 157, at 619 (1953); WEIL, AMERICAN COPYRIGHT LAW 432 (1917), all finding parody noninfringing. *But see* COPINGER AND SKONE-JAMES, LAW OF COPYRIGHT 131–32 (8th ed. 1948) (English text; treats parody with same rules as all other uses).

[75] 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd sub. nom.*, Benny v. Loew's Inc. 239 F.2d 532 (9th Cir. 1956).

[76] *Id.* at 170–71.

Sid Caesar television program.[77] In the latter case the appropriation was not as extensive as in the former, although setting, situation, characters, incidents, and details of development of the movie were consciously used in the skit. The plot of the skit, although similar to that of the movie, was transformed in several vital respects to conform to the needs of the comedy.[78] For instance, the motion picture's two leading male characters were combined into one character to be played by Sid Caesar, and the leading female characters were merged into one part to be played by Imogene Coca. Plot, sequence, development, and dialogue differed in the two works. The court gave judgment for the defendant after trial.

Since all parody involves some conscious imitation of another literary work, the questions of access and appropriation cannot arise in a case of infringement by burlesque. Consequently, the first question to be considered is whether parodies should be found noninfringing because the appropriation is not substantial.

*Substantiality.* The finding in the *Loew's* case that appropriation was substantial appears justified under almost any of the theories of substantiality.[79] The quantity of the material appropriated was large. Most of the appropriated material was borrowed "straight," to serve dramatic functions in the skit unrelated to any burlesque or humorous elements. Only a small amount was transformed in context or connotation. Thus the works, aside from the humor in the skit, would seem so superficially identical as to be easily encompassed under the "ordinary observer" test. It is quite probable that the similarity was also so pervasive that it could be found to constitute substantial appropriation under almost any form of literary analysis.

It is not clear from the trial judge's opinion in the *Colum-*

[77] Columbia Pictures Corp. v. National Broadcasting Co., 137 F. Supp. 348 (S.D. Cal. 1956).

[78] *Ibid.* Findings of fact and Exhibit B.

[79] See text *supra* at pp. 9–13.

*bia Pictures* case whether he considered the appropriation insufficiently substantial to constitute infringement, or whether it was substantial but nevertheless nonactionable on the basis of fair use. It appears that the court made both findings, although once it decided that the taking was not sufficiently substantial it is difficult to see any purpose in discussing fair use at all. In any event, the finding that the appropriation was nonsubstantial appears justified from the facts of the case. Though the quantity of material taken was fairly large, it was considerably smaller than that appropriated in the *Loew's* case. More important, the material was radically transformed in the skit. The dramatic became the whimsical, the moving, the incongruous, and the tragic was transformed into the absurd.[80] Thus, there was clearly a superficial dissimilarity between the works. Furthermore, refined literary analysis would reveal that Sid Caesar's skit was different from the lampooned film in such essential elements as plot, character, development, and dramatic form. It was this latter factor, the feeling of intrinsic dissimilarity, which not only distinguished the *Columbia Pictures* case from the *Loew's* decision, but which also provided the chief and most valid justification for the court's finding of insubstantiality.

*Fair Use.* The court in the *Loew's* case felt there could be no immunity for burlesque on grounds of fair use so long as there is substantial appropriation,[81] but the same court in the *Columbia Pictures* case appears to have taken a more liberal view towards burlesque.[82] The doctrine of fair use should only be invoked either where there is little likelihood

[80] The finding of nonsubstantial appropriation in this case would thus be consistent with the view of substantiality expressed at pp. 11–12 *supra.*

[81] 131 F. Supp. at 182–83.

[82] "Since a burlesquer must make a sufficient use of the original to recall or conjure up the subject matter being burlesqued, the law permits more extensive use of the protectible portion of a copyrighted work in the creation of a burlesque of that work than in the creation of other fictional or dramatic works. . . ." 137 F. Supp., at 354.

of economic detriment to the author resulting in an inhibition of the arts or where the social utility of the borrowing work is sufficiently great to justify any such detriment. The application of these principles to the parody situation appears to justify invoking the doctrine. Proof tending to show that the parody had an adverse effect on the sales value of the copyrighted work in these cases is so highly speculative as to be practically meaningless. Moreover, the absence of direct competition between the two works would seem to suggest that no such actual impairment of sales of the movie was likely to result. In the *Loew's* case, for example, plaintiff's film was not being exhibited domestically at the time of the infringing performance,[83] and therefore the damages, if any, were to the reissue and remake rights of the film. Thus in all probability *Gaslight*'s reissue value was enhanced by the nationwide publicity it received on defendant's program.[84] Defendant's use may well have had the salutary effect of refreshing the public's memory of the film.

Normally, infringing uses deter progress in the arts because they deprive the copyright proprietor of the opportunity to exploit the work successfully himself in a particular way. Dramatizing a novel or making a motion picture from a play, for example, prevents the proprietor from exploiting to the utmost the economic potential of his work. This, of course, is not true of parody, as it is difficult to imagine any author satirizing his own creation. An author may be encouraged to write a novel in order to obtain movie and drama rights, but it is doubtful whether he will feel similarly stimulated because he will have parody rights to the work. On the other hand, the author may be deterred from creating by the knowledge that his work will be subject to ridicule by others.

Assuming, *arguendo*, that parody results in a substantial

[83] 131 F. Supp. at 168.

[84] *Cf.* G. Ricordi & Co. v. Mason, 201 Fed. 182, 183 (C.C.S.D.N.Y. 1911) (dictum).

inhibition of the arts, nevertheless there is a strong policy favoring inclusion of parody within the doctrine of fair use. Parody, as criticism, is itself a socially desirable form of artistic creation and hence worthy of constitutional protection. In part, the difference in result between the *Loew's* and *Columbia Pictures* decisions can be explained because of the latter court's increasing awareness of the value of burlesque as an independent literary form.

In order, of course, for satire to come within the fair use doctrine, it must involve an actual evaluation or analysis of the parodied work, albeit in a humourous manner.[85] Where the supposed parody merely reenacts the borrowed work without substantial changes, the case for according it a wide critical privilege is weakest. Such a use, without substantial change, of a considerable amount of material by Jack Benny is another factor which explains, in part, the difference in result between the two decisions.

*Relief.* In the *Loew's* case the court granted plaintiff an injunction, restraining further exhibition of the offending cinescope.[86] Even if parody is an infringement, and not within the doctrine of fair use, it would, nonetheless, seem deserving of at least enough protection to prevent its annihilation. So long as the criticism is fair, it is of great social value and should not be subjected to censorship by either court or author. A blanket injunction restraining all publication of parody containing fair criticism as well as infringing elements seems undesirable for this reason. A better remedy would be a conditional injunction, phrased in the alternative, restraining the work unless the offending portions are deleted or modified.

In the *Loew's* case no damages were asked and attorney's fees were not awarded.[87] In awarding monetary relief the courts should, of course, try to limit the damages and profits

[85] See Hill v. Whalen & Martell, Inc., 220 Fed. 359, 360 (S.D.N.Y. 1914), quoted *supra* note 73.

[86] 131 F. Supp. at 186. [87] *Ibid.*

to economic detriment resulting from the infringing, as opposed to the critical aspects of the parody.[88]

*Unfair Competition.* It is doubtful whether either of the plaintiffs in the parody cases were concerned primarily with the fate of their motion pictures. Rather, the suits appear to be essentially nuisance actions serving a part in the competitive war between the motion picture and television industries. Consequently, the disputes might have been better settled under the law of unfair competition, which is designed to insure fair play between competitors.[89]

In both cases the plaintiffs did allege unfair competition by claiming trade-mark infringement of the motion picture's title; this contention properly was rejected on the ground that there was "no attempt to deceive the public as to the origin of [the] literary work." [90] Plaintiff in *Columbia Pictures v. National Broadcasting Co.* also claimed unfair competition in that NBC "took a free ride on" Columbia's advertising buildup for *From Here to Eternity.*[91] This contention was based on *International News Service v. Associated Press,*[92] where the Supreme Court indicated that "palming off" is not

[88] Only those damages attributable to the infringing act can be allowed. 17 U.S.C. § 101(b) (1952). Since criticism is a noninfringing use, damages due to it cannot be recovered. The problem is similar to that of separating the damages due to the defendant's infringement from those due to other prior infringements. Universal Pictures Co. v. Harold Lloyd Corp., 162 F.2d 354, 368–74 (9th Cir. 1947).

[89] Plaintiff can raise claims of unfair competition in a federal court where the sole basis of jurisdiction is a cause of action under the copyright laws. If the copyright claim is dismissed the court retains jurisdiction and the plaintiff can obtain a determination on the unfair competition question. 28 U.S.C. § 1338(b) (1952); Hurn v. Oursler, 289 U.S. 238 (1933); see HART AND WECHSLER, THE FEDERAL COURTS AND THE FEDERAL SYSTEM 797–809 (1953).

[90] Columbia Pictures Corp. v. National Broadcasting Co., 137 F. Supp. at 354 (S.D. Cal. 1956). See Frohman v. William Morris Inc., 68 Misc. 461, 123 N.Y. Supp. 1090 (Sup. Ct. 1910), where defendant's use of the title "Chanticlair" in a parody of Rostand's play *Chantecler* was enjoined on the basis of unfair competition because of the possibility of confusion in the minds of theatergoers. The injunction extended only to the use of the similar title and did not prohibit the continued presentation of the parody.

[91] Post Trial Memorandum for Plaintiff, pp. 26–28, Columbia Pictures Corp. v. National Broadcasting Co., 137 F. Supp. 348 (S.D. Cal. 1956).

[92] 248 U.S. 215, 241–42 (1918).

a necessary element of an unfair competition cause of action. The court in *Columbia Pictures* declined to extend this to cover the parody situation and rejected plaintiff's claim. This argument is likely to continue to receive a hostile reception from courts in the future in view of the subsequent limiting of the *International News Service* case.[93]

## CONCLUSION

Tremendous technological and commercial advances in the field of communications have put rapidly increasing burdens on the copyright law. The history of Anglo-American copyright from the Statute of Anne to the present has been one of uninterrupted expansion of the bounds of protection to encompass new technical advances and old techniques which through commercial exploitation have become newly valuable.[94] The more significant problems of contemporary copyright law involve media such as radio, recordings,[95] motion pictures, and television, none of which were significant fifty years ago.[96] Further problems loom on the horizon.[97] Fortunately, our constitutional scheme is sufficiently broad to provide unified federal control of the field. The system on the whole appears sound.[98]

What is required is an abandonment of the tendency to regard new problems in the light of old judicial doctrines ap-

[93] See RCA Mfg. Co. v. Whiteman, 114 F.2d 86, 90 (2d Cir. 1940), *cert. denied*, 311 U.S. 712 (1940); 2 NIMS, UNFAIR COMPETITION AND TRADEMARKS § 277 at 905, n.11 (4th ed. 1947).

[94] See note 6 *supra*.

[95] See Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409 (1956).

[96] See Chafee, *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 503 (1945).

[97] See Kupferman, *Rights in New Media*, 19 LAW & CONTEMP. PROB. 172 (1954) (phonographic transcription and community television antenna systems); Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U.L. REV. 1081 (magnetic tape recordings of television programs).

[98] Funds for a three-year study by the Copyright Office aimed at complete revision of the Copyright Act were appropriated last year. 69 STAT. 499 (1955). See H.R. REP. No. 1036, 84th Cong., 1st Sess. 6 (1955).

propriate to an era when the printed word was the main source of copyright litigation. The approach suggested here involves no radical changes in the copyright law.[99] What is called for is conscious and explicit discussion of the use in terms of its relation to the progress of the arts. As these problems lose their novelty, their positions in the law will become crystallized through the force of precedent. But while they are still new they deserve a more explicit judicial examination than they often receive, in order to insure that the fullest protection is given by the law to the interests of both artists and the community at large.

[99] A consideration which tends to limit any attempt to change drastically the present Copyright Act is the participation of the United States in international copyright treaties. The Universal Copyright Convention, recently ratified by the United States, differs from previous international conventions in that it permits each member nation to develop its own substantive copyright law rather than legislating substantive provisions for all member nations. While this approach permits greater variation in each nation's copyright law than previous international copyright treaties, it would seem to imply a basic parallelism among all nations on the basic attributes of copyright protection. Revisers of the United States act should try not to do violence to this parallelism.

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# *The Effect of the Universal Copyright Convention on Other International Conventions and Arrangements*

By G. T. McCONNELL

HARVARD UNIVERSITY LAW SCHOOL

## INTRODUCTION

THIS PAPER DEALS primarily with the problem of how the Universal Copyright Convention of 1952 [1] affects other international copyright arrangements. The vast network of several multilateral copyright conventions, many bilateral treaties, and varying treatments of foreign authors under domestic laws raises intricate questions of which treaty or which law prevails. The Universal Copyright Convention (hereinafter referred to as the UCC) contains specific provisions as to its effect on other international arrangements in article 17 and the appendix declaration relating thereto, article 18 and article 19. The chief purpose of this paper is to ascertain the meaning of these articles. The international law of treaties must be considered in order to interpret the articles properly and to determine which treaty governs in situations where other treaties co-exist. The problems which will arise in the application of the UCC will involve choosing between different and conflicting treaty provisions, and this paper at-

[1] The Universal Copyright Convention, dated Sept. 6, 1952, became effective on Sept. 16, 1955. RECORDS OF THE INTERGOVERNMENTAL COPYRIGHT CONFERENCE 9 (1955).

The United States Senate approved the Universal Copyright Convention (here-

tempts to examine the principles or rules which may guide that choice.

## EXISTING INTERNATIONAL COPYRIGHT SYSTEMS AND THE PURPOSES OF THE UNIVERSAL COPYRIGHT CONVENTION

### THE BERNE CONVENTION

Although the UCC is the most recent of several multilateral copyright conventions, it is by no means the only one. The largest and most successful such convention is the Berne Convention for the Protection of Literary and Artistic Works (hereinafter referred to as the Berne Convention or Berne).[2] The treaty of 1886 has undergone several successive revisions,[3] the latest text being the Brussels Revision of 1948.[4] The Berne Union [5] currently consists of forty-three states (including most of their colonies and overseas territories), and covers almost all of Europe and the Commonwealth countries.[6]

Despite the fact that the Berne Convention is open to accession by any country at any time,[7] only two countries of the Western Hemisphere, Brazil and Canada, are members. The main reason why neither the United States nor other Pan-

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inafter cited as UCC) on June 25, 1954. 100 CONG. REC. 8953 (1951). The United States' instrument of ratification was deposited with the Director-General of UNESCO, pursuant to article 8 of the UCC, on Dec. 6, 1954. A list of the countries ratifying or acceding to the UCC as of Nov. 1, 1955, appears in 8 UNESCO COPYRIGHT BULLETIN No. 2, at 135 (1955).

[2] Actes de la 3e Conférence Internationale pour la Protection des Oeuvres Littéraires et Artistiques 27 (1886), 12 de Martens, N.R.G., 2e sér. 173.

[3] The Berne Convention of 1886, with the Additional Articles (Paris, 1896), was revised at Berlin in 1908, at Rome in 1928, and at Brussels in 1948.

[4] Convention de Berne pour la Protection des Oeuvres Littéraires et Artistiques revisée à Bruxelles le 26 Juin 1948 (hereinafter cited as Brussels Revision of 1948). This document contains an equivalent English text.

[5] The term "Berne Union" refers to all states which have ratified or adhered to any of the Berne texts mentioned in note 3 *supra*.

[6] 1956 DROIT D'AUTEUR 1. An English version of the State of the Berne Union as of Jan. 1, 1955, appears in Translation Service, Copyright Society of the United States of America, No. 1a (1955).

[7] Brussels Revision of 1948, arts. 25 and 28.

American republics have joined Berne is because their basic principles of copyright law are different from Berne's requirements. Berne provides that the securing of copyright protection "shall not be subject to any formality," [8] and this provision is one of the fundamental advantages of that convention to Berne Union members. However, the "no formality" principle, in addition to the Berne provisions giving authors a nontransferable "moral right," [9] has been the main obstacle preventing United States accession to Berne.[10] Our copyright law is predicated on strict fulfillment of notice requirements for published works, and publication without proper notice of copyright results in a dedication, or relinquishment, of copyright protection.[11] The Berne "no formality" principle is also at variance with the laws of most Pan-American countries.[12] This difference goes beyond mere technicalities and represents a different premise of the legal basis and function of copyright.[13]

Although the Berne Union is limited geographically, it has established a highly developed system for its members. It has firmly implanted the principle of "national treatment" as a basis for all international copyright protection; [14] all other multilateral treaties have adopted that principle.[15]

[8] Brussels Revision of 1948, art. 4(2). This provision was not adopted in the original convention of 1886, but was introduced in the Berlin Revision of 1908, art. 4, para. 2.

[9] Brussels Revision of 1948, art. 6 bis.

[10] Senate Committee on Foreign Relations, *Universal Copyright Convention*, S. Exec. Rep. No. 5, 83d Cong., 2d Sess. 3 (1954). See also Schulman, *International Copyright in the United States: A Critical Analysis*, 19 Law & Contemp. Prob. 141, 149 (1954); Sherman, *The Universal Copyright Convention: Its Effect on U.S. Law*, 55 Colum. L. Rev. 1137, 1144-49 (1955).

[11] 17 U.S.C. § 10 (1947); Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834); Booth v. Haggard, 184 F.2d 470 (8th Cir. 1950).

[12] *UNESCO Study of Comparative Copyright Law*, 2 UNESCO Copyright Bulletin Nos. 2-3, at 94-100 (1949).

[13] Evans, *Copyright and the Public Interest*, 2 UNESCO Copyright Bulletin No. 1, at 16 (1949).

[14] Brussels Revision of 1948, arts. 4(2), 5, 6(1).

[15] The sole exception is the Montevideo Conventon of 1889, which states that the protection given in other contracting states shall be governed by the law of

"National treatment" means that a foreign author, once he has acquired his copyright under the treaty, is given the same scope of protection in the state where protection is sought which that state gives to its own nationals; it is thus a rule of no discrimination against the foreign author.[16] But, in addition to the reference by treaty to domestic law, Berne also contains provisions which require contracting states to pass implementing legislation. A third category of provisions operates directly to create new rules of law and can be truly called international legislation.[17] These law-making provisions, which restrict the autonomy of domestic law, have been extended and expanded in the several revisions of the convention texts [18] so that they now form a considerable part of the copyright law of the Berne Union countries. This factor, plus the large body of domestic court case law which has been defining the provisions of Berne for over fifty years, has built up an inertia in the Union against any radical change in the international copyright system.

When a new Universal Convention came up for consideration after World War II, it soon became apparent that the new convention could not replace Berne, but should exist in addition to Berne.[19] By 1952, this understandable desire to keep Berne in force had grown into a firm conviction on the part of some Berne countries that the UCC must provide for "safeguards for the Berne Convention." At the Geneva Con-

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the place of first publication. Treaty on Literary and Artistic Copyright, Feb. 11, 1889, art. 2. ACTAS Y TRATADOS CELEBRADOS POR EL CONGRESO INTERNACIONAL SUD-AMERICANO DE MONTEVIDEO, 1888–1889, 782 (Montevideo, 1911).

[16] The national treatment principle might be expressed in conflict of laws terms as an adoption of the *lex fori* to govern the scope of copyright protection. Perhaps more accurately it is the law of the place of injury which applies. See pp. 59–60 *infra*.

[17] See 1 LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 180–83 (1938).

[18] *Id.* at 184–89.

[19] See Bogsch, *Co-Existence of the Universal Copyright Convention with the Berne Conventions*, UNIVERSAL COPYRIGHT CONVENTION ANALYZED 141, 144–50 (1955).

ference itself, several important countries stated that, as an essential condition of their ratification, Berne must remain unaffected by the UCC.[20] This goal—to safeguard Berne—must be kept in mind in order properly to understand the effect of the UCC on this important earlier convention.

THE PAN-AMERICAN CONVENTIONS

The Americas have evolved their own international copyright system, quite independently of the Berne Union. Several multilateral conventions have been concluded among Pan-American countries, the most important ones being: the Montevideo Convention, 1889; [21] the Mexico City Convention, 1902; [22] the Rio de Janeiro Convention, 1906; [23] the Buenos Aires Convention, 1910; [24] the Havana Convention, 1928; [25] and the Washington Convention, 1946.[26] These treaties have partially replaced one another and have been ratified by different groups of countries. None of them, except the Buenos Aires Convention of 1910, could be considered of significantly wide geographic application.[27] Except for the Montevideo

[20] Report of the Rapporteur-General, RECORDS OF THE INTERGOVERNMENTAL COPYRIGHT CONFERENCE (hereinafter cited as RECORDS) 90 (1955). See especially the statements of the Italian and French delegates at the Conference meetings. Minutes, # 56 and # 76, in RECORDS 119 and 126. (Hereafter, references to the Minutes will include only the number of the entry.)

[21] See note 15 *supra*.

[22] Convention on Literary and Artistic Copyrights, Jan. 27, 1902, 35 STAT. 1934, T.S. No. 491.

[23] Convention on Patents of Invention, Drawings and Industrial Models, Trademarks, and Literary and Artistic Property, Aug. 23, 1906.

[24] Convention on Literary and Artistic Copyright, Aug. 11, 1910, 38 STAT. 1785, T.S. No. 593.

[25] Convention revising Convention of Buenos Aires on Literary and Artistic Copyright, Feb. 18, 1928. LAW AND TREATY SERIES OF THE PAN AMERICAN UNION No. 34 (Washington, D.C., 1950).

[26] Inter-American Convention on the Rights of the Author in Literary, Scientific and Artistic Works, 1946. Inter-American Conference of Experts on Copyright, Washington, June 1–22, 1946, ACTS AND DOCUMENTS PAN AMERICAN UNION, CONGRESS AND CONFERENCES SERIES No. 51, at 103.

[27] For a list of the countries which have ratified or acceded to these conventions, see CANYES, COLBURN, AND PIAZZA, COPYRIGHT PROTECTION IN THE AMERICAS 180–82 (1950), which also includes at 187–213, the texts of the treaties

Convention, which has long been outmoded, they are open to accession only by American republics.[28] The Buenos Aires Convention is decidedly the most important; it has been ratified by the United States.[29] The Washington Convention of 1946 is intended to replace the Buenos Aires Convention, and so far it has been moderately successful, fourteen American republics having ratified.[30] However, the United States has not ratified, despite efforts to obtain Senate consent,[31] and there is little likelihood that it will ratify in the future.

The Pan-American copyright treaties have not had the success or support which Berne has enjoyed. The reasons perhaps are that the smaller countries want to maximize the freedom of importing literary products, whereas the United States is more concerned with protecting the author and publisher. The smaller countries are largely importers of literary works, while the United States is an exporter with respect to these countries.

The Buenos Aires Convention, although adopting the national treatment principle of Berne,[32] does not contain many guarantees of minimum protection or many law-making provisions of direct applicability. Even the national treatment clause has been narrowly construed. In *Todamerica Musica, Ltda. v. Radio Corp. of America*, the court interpreted article 3 of the Buenos Aires Convention as not affording Latin American composers protection against mechanical reproductions, despite article 4, which states that the copyright

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cited in notes 21–26 *supra*. For a summary of the states between which these conventions are still in force, see 2 UNESCO COPYRIGHT BULLETIN No. 1, at 102–26 (1949).

[28] See Henn, *Interrelation Between the Universal Copyright Convention and the Pan-American Copyright Conventions*, UNIVERSAL COPYRIGHT CONVENTION ANALYZED 125, 127 (1955).

[29] See note 24 *supra*.

[30] This information was obtained from discussions with the members of the United States Copyright Office in March, 1956.

[31] *Inter-American Convention on the Rights of the Author in Literary, Scientific, and Artistic Works*, S. EXEC. DOC. HH, 80th Cong., 1st Sess. 2, 18 (1947).

[32] Buenos Aires Convention, *supra* note 24, arts. 3 and 6.

". . . includes for its author or assignes the exclusive power of . . . reproducing it in any form. . . ." [33]

However, in spite of possible objections to the completeness of these treaties, the American states as a whole did not want to see past accomplishments wiped out of existence by the UCC. Consequently, on the recommendation of a committee of American experts,[34] a special article preserving the existing treaties in part was included in the UCC.[35]

### OTHER INTERNATIONAL COPYRIGHT ARRANGEMENTS

In addition to the Berne and Pan-American multilateral conventions there are a host of bilateral and reciprocal copyright arrangements existing among all countries. Since the United States is not a member of the Berne Union, most of the United States' international arrangements are within this category.[36]

1. Protection of foreign authors' works in the United States has generally depended on domestic law. Although some bilateral conventions are in force, the bulk of foreigners' rights rest on the proclamation system, which originated with the Act of 1891.[37] Under section 9 of the Copyright Act (prior to the 1955 adoption of the UCC) protection to foreigners, who are not domiciled in the United States, exists only

(b) When the foreign state or nation of which such author or proprietor is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States the benefit of copyright on substantially the same basis as to its own citizens, or copyright protection substantially equal to the protection secured to such

[33] 171 F.2d 369 (2d Cir. 1948). *Accord*, Portuondo v. Columbia Phonograph Co., 81 F. Supp. 355 (S.D.N.Y. 1937). See note 42 *infra*.

[34] 5 UNESCO COPYRIGHT BULLETIN No. 1, at 5 (1952).

[35] Article 18 of the UCC will be discussed *infra*, pp. 64–75.

[36] For a list of the United States' copyright arrangements with other countries, see U.S. DEPT. OF STATE, INTERNATIONAL COPYRIGHT RELATIONS OF THE UNITED STATES OF AMERICA (rev. Jan. 20, 1955).

[37] 26 STAT. 1106.

foreign author under this title or by treaty; or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States may, at its pleasure, become a party thereto.

The existence of the reciprocal conditions aforesaid shall be determined by the President of the United States, by proclamation made from time to time, as the purposes of this title may require. . . .[38]

It should be noted that a proclamation may determine (i) the condition of reciprocity, which may be based on law or on treaties and may be of two types; or (ii) that the foreign state is party to a treaty to which the United States "may, at its pleasure, become a party." Most, if not all, of the proclamations are of the first category, and they usually refer to the foreign state's domestic law as the source of reciprocal treatment.[39] The wording of the Copyright Act indicates that the President must also proclaim the existence of copyright reciprocity by virtue of treaties with the United States, but a proclamation of the treaty itself apparently suffices.[40] There is one exception: in order to secure mechanical reproduction rights, specific wording of section 1(e) requires a separate proclamation.[41] Even if a proclaimed treaty contains clauses of such wide scope as articles 3 and 4 of the Buenos Aires Convention, a special proclamation as to mechanical reproduction rights must be alleged in the complaint.[42] Proclamations in the second category have apparently not been issued. *Quaere* if the President could proclaim all Berne countries as

[38] 17 U.S.C. § 9 (1947). Section 9 has been amended by 68 STAT. 1030, effective Sept. 16, 1955, the date the UCC becomes effective. Although subsection (b) is not changed, a new subsection (c) extends protection to works of UCC origin.

[39] See, for example, the Proclamation of July 1, 1891, 27 STAT. 981, and the Proclamation of April 9, 1910, 36 STAT. 2685.

[40] 38 STAT. 1785. No proclamations, other than that of the treaty, have been issued for signatories of the Buenos Aires Convention.

[41] 17 U.S.C. § 1(e) (1947); 29 OPS. ATT'Y GEN. 64 (1911).

[42] Portuondo v. Columbia Phonograph Co., 81 F. Supp. 355 (S.D.N.Y. 1937). For a criticism see LADAS, *op. cit. supra* note 17, at 838. The *Todamerica* case, *supra* note 33, indicates that the real ground for denying protection may have been that the Buenos Aires Convention as interpreted did not include protection against mechanical reproduction.

meeting the copyright reciprocity conditions, on the grounds that Berne is, by its terms, open to accession by the United States.[43]

The effect of these proclamations is a very limited one. Once a country is proclaimed as meeting the reciprocity conditions of section 9, a national of that country may thereafter secure United States copyright for his published work,[44] but he must meet all the requirements of formalities contained in the act. These formalities include: the notice requirements of section 10, the deposit requirements of sections 13 and 14, and the conditions of section 16—the "manufacturing clause"—which require books and periodicals in English to "be printed from type set within the limits of the United States." [45] The foreign author from proclaimed countries thus is given only half-hearted protection. He does get more than nationals of unproclaimed countries (if those nationals are not domiciled in the United States), since they get no protection at all for published works. But even a proclaimed country's author must comply with domestic formalities, including the discriminatory manufacturing clause.[46] This type of protection is to be distinguished from the "national treatment" principle of the multilateral conventions. Even where formalities are required by the treaty, as in article 3 of the Buenos Aires Convention, the work need meet only the formalities of the law of the place of first publication; [47] pro-

[43] It might be argued that since the United States would have to revise the entire structure of its copyright law in order to join Berne, the conditions of sec. 9(b) of the Copyright Act would not be met.

[44] Foreign authors do get common law protection for unpublished works on a nondiscriminatory basis. Ferris v. Frohman, 223 U.S. 424 (1912); Palmer v. DeWitt, 47 N.Y. 532 (1872).

[45] 17 U.S.C. § 16 (1947).

[46] Some alleviation from the manufacturing clause is offered by allowing "ad interim" protection of books and periodicals published abroad in English. This temporary protection, however, is limited to five years and is subject to the additional formalities of secs. 22 and 23 of the Copyright Act. See Sherman, *supra* note 10, at 1159; Frase, *Economic Effects of the Universal Copyright Convention*, 165 PUBLISHERS' WEEKLY 1502 (1954).

[47] HOWELL, THE COPYRIGHT LAW 169 (2d ed., 1948).

tection is then secured throughout the convention countries, although the scope of protection is determined by the place where protection is sought. The proclamation system of the United States has thus been justifiably criticized, and other countries have had a strong interest in getting the United States to join a "universal" convention. This was one of the chief purposes behind the UCC.

At this point an additional problem in regard to copyright proclamations should be noted. Are these proclamations international "arrangements"? They find their basis in a domestic statute (section 9[b] quoted *supra*) which allows the proclamations to be terminated at any time.[48] On the other hand, proclamations are often accompanied by an exchange of notes, which notes may or may not state expressly that the countries reach an agreement.[49] Even without the exchange of notes, the proclamations usually recite that "whereas satisfactory official assurances have been given" that the foreign law meets the reciprocity conditions of section 9, that foreign state is entitled to protection as a "proclaimed" country under our Copyright Act.[50] This problem is of particular importance in interpreting articles 18 and 19 of the UCC, which refer to international "conventions and arrangements"; it will be discussed in more detail under "The Meaning of 'Arrangements' " *infra*.

2. The copyright protection to United States authors in foreign countries is in a similar state of confusion and en-

[48] "The President may at any time terminate any proclamation authorized herein or any part thereof or suspend or extend its operation for such period or periods of time as in his judgment the interest of the United States may require." 17 U.S.C. § 9 (1947).

[49] An example of an exchange of notes which does explicitly reach an agreement is the Exchange of Notes between the United States and Monaco, Sept. 24, 1952, 3 U.S. TREATIES & OTHER INT'L AGREEMENTS 5112, T.I.A.S. No. 2702. An example of one that does not is the Jan. 1, 1915, Exchange of Notes between the United States and Great Britain, 1915 FOR. REL. 425. See Dixon, *Universal Copyright Convention and United States Bilateral Copyright Arrangements*, UNIVERSAL COPYRIGHT CONVENTION ANALYZED 113 (1955).

[50] For example, Proclamation of July 1, 1891, 27 STAT. 981.

tanglement.[51] Protection of our authors likewise depends largely on the domestic law of the foreign state. But since United States proclamations require reciprocal treatment, these foreign laws are generally amended (if that is required) to grant such protection to our authors at the time that our proclamations issue. If an international agreement is concluded, that will serve as a basis for protection abroad. On the whole, the United States author gets better treatment abroad than the foreign author gets in the United States: there are few formality requirements, and only Canada has anything like the manufacturing clause.[52] Moreover, United States authors do not have to publish in the foreign country, but get protection on first publication in the United States, except in the case of British countries.[53]

Notwithstanding this rather liberal treatment, our authors and publishers have not been satisfied. Perhaps weary of investigating all foreign laws to determine their rights, or skeptical of the protection foreign courts will afford, they also seek to secure Berne protection, although the United States is not a party to Berne. This opportunity is made possible by article 4(3) of the Berne Convention: Berne protection is secured if the work is first published in a country of the Berne Union (article 6[1]), and

> in the case of works published simultaneously in a country outside the Union and in a country of the Union, the latter country shall be considered exclusively as the country of origin.[54]

Consequently, if a United States work is simultaneously published in a Berne country, *e.g.*, Canada, protection under all the Berne provisions is easily obtained. Use of this device, known as the "back door to Berne," has understandably led to a reactionary attitude in some foreign quarters. In the Netherlands the Berne definition of publication has been narrowly

[51] See 2 LADAS, *op. cit. supra* note 17, at 841.
[52] *Ibid.* [53] *Id.* at 848–49.
[54] This provision also appears in the Rome Revision of 1928, art. 4(3).

construed to deny protection to United States authors in some cases.[55] The retaliatory basis for this attitude was indicated in an opinion by one of the Netherlands courts in the late 1930s:

> The only way to compel the United States to accede to the Berne Convention is to disregard, in the countries which have acceded to that Convention, the copyrights of the citizens of that country.[56]

This same idea led to a new clause in the Brussels Revision of 1948, to the effect that other Berne countries can similarly reduce the protection to be granted in such cases.[57]

The confused and even chaotic condition [58] of international copyright in the United States, both as to protection of foreign works in the United States and of its own works abroad, was a direct stimulus to promoting a universal copyright convention. Not only were private groups within the United States in full support of the UCC,[59] but also several foreign countries considered United States protection of their interests as essential and conditioned their own ratification on the United State's ratification.[60]

[55] The *Fu Manchu* case held that simultaneous sale in Canada of *Collier's* magazine, fully printed and bound in the United States, was not a "simultaneous publication" in Canada. Ward v. De Combinatie, Hooge Raad, 1936. But the *Gone With the Wind* case held that if sheets printed in the United States were sent to Canada and bound into books there, publication did occur in Canada. Marsh v. Zuid-Hollandsche Boeken Handelsdrukkerij, Hooge Raad, 1941.

[56] McCLURE, INTERNATIONAL LAW OF COPYRIGHT 19 n.29 (1938).

[57] Article 6(2).

[58] One particularly anomalous result of the Copyright Act is that a foreigner of an unproclaimed country, domiciled in the United States, cannot get statutory copyright for unpublished works. Leibowitz v. Columbia Gramophone Co., 298 Fed. 342 (S.D.N.Y. 1923).

[59] *Hearings before the Subcommittee on the Universal Copyright Convention of the Senate Committees on Foreign Relations and the Judiciary*, 83d Cong., 2d Sess., at 19, 44–46, 113–14 (1954). For a lone dissent, see Warner, *The UNESCO Universal Copyright Convention*, 1952 WIS. L. REV. 297, and the reply of Schulman, *Another View of Article III of the Universal Copyright Convention*, 1953 WIS. L. REV. 299.

[60] Report of the Rapporteur-General, in RECORDS, *supra* note 20, at 72; Minutes, # 76. See UCC, art. 9 and Protocol 3.

THE UNIVERSAL COPYRIGHT CONVENTION

The move towards a universal convention thus had several purposes to fulfill and many interests to safeguard. In the field of international copyright the world was virtually split in two; [61] the Berne Union and the Pan-American Conventions had only one common member—Brazil. The idea of a convention bridging the two existing systems was early discarded,[62] and the goal for the post World War II era became a new and independent copyright convention.

The fundamental purposes of the UCC can best be summarized by referring to the Preamble of the UCC itself:

> The Contracting States,
>
> Moved by the desire to assure in all countries copyright protection of literary, scientific and artistic works,
>
> Convinced that a system of copyright protection appropriate to all nations of the world and expressed in a universal convention, additional to, and without impairing international systems already in force, will ensure respect for the rights of the individual and encourage the development of literature, the sciences and the arts,
>
> Persuaded that such a universal copyright system will facilitate a wider dissemination of works of the human mind and increase international understanding,
>
> Have agreed as follows: . . .

Perhaps the most important goal of the UCC was to formulate a world-wide agreement, open to the maximum number of ratifications.[63] This purpose, it is suggested, was a recognition of the fact that "the primary problem in international copyright is not so much the quality of protection accorded to a work after it becomes entitled to the benefit of copyright, but how to acquire the right to protection and how to avoid losing its benefits." [64] Thus if all nations would agree to one set of

[61] See Note, 1 INT'L & COMP. L.Q. 217 (1952).

[62] Bogsch, *supra* note 19, at 144–50.

[63] Minutes, *supra* note 20, at # 70. See also Preamble of the Draft Convention. RECORDS, *supra* note 20, at 333.

[64] Schulman, *supra* note 10, at 146.

formalities necessary to obtain copyright in those countries requiring formalities, the most troublesome difficulty would be eliminated. The adopted solution is article 3 of the UCC, which obligates all contracting states to accept the formalities specified therein. Once the copyright is obtained, the UCC then adopts the "national treatment" principle in article 2.

A further purpose of the UCC was to set out certain requirements of minimum protection which all contracting states would be obliged to give to authors of other UCC states. Unlike Berne, this minimum protection was set at a relatively low level of protective standards in order to achieve maximum geographic adoption of the UCC.[65] The two areas of minimum protection given most weight in the UCC are translation rights (article 5) and the duration of copyright (article 4). However, other provisions of the UCC should properly be construed as imposing minimum obligations on states: for example, article 1 lists some of the types of works for which states must provide "adequate and effective protection."

Some of the interests sought to be safeguarded in the UCC are similar to the interests confronted in domestic legislation. First of all, there are the author's and publisher's interests in securing the maximum economic benefits of the literary or artistic product. But there is also the public interest, which in some respects may coincide with the author's interests and in other respects be at variance with them.[66] The public, and the state, want to encourage the creation and publication of literary products, and to this end both a monopoly and simplicity in acquiring that monopoly are given the author and publisher. On the other hand the public and the state also want to maximize the free exchange of ideas, and this aspect of the public interest does demand that limits be placed on that monopoly.

[65] Minutes, *supra* note 20, at # 62 and # 64.
[66] See Evans, *supra* note 13.

On the international level these conflicting interests are compounded with differing interests of states. The less culturally developed states—importers of intellectual products —stress the necessity of a free flow of ideas. Presumably this was UNESCO's basis for obtaining the world coordination on copyright problems which made the UCC possible.[67]

How far the text of the UCC can be considered to favor the public interest is a fundamental, but unsolved, question. The only explicit reference to the public interest appears in the Preamble of the UCC, where universal copyright protection is recognized as encouraging the development of the literary arts.[68] Other provisions seem to be designed solely to protect the author and/or publisher.[69] Indeed it is difficult to state that the public interest in limiting the monopoly in literary works found any direct expression in the UCC. Articles 4 and 5 allow domestic law to increase protection of the author beyond the minimum therein specified. Even article 3 does not require that formalities be used, but rather declares that *if* a state does require formalities in its domestic law, it must recognize those requirements as satisfied when the formalities of article 3 are followed.

One noted expert in international copyright, writing in 1950 of the proposed universal convention, said:

> The project lays it down as a principle that a *minimum* universal convention should involve no diminution in the *maximum* protection already accorded by the legislation or case law of particular countries

[67] The UNESCO Constitution, adopted Nov. 16, 1954, 4 UNITED NATIONS TREATY SERIES 275, states in article 1, § 2(c) that one of the purposes of UNESCO is to "maintain, increase and diffuse knowledge . . . by initiating methods of international cooperation calculated to give the people of all countries access to the printed and published materials produced by any of them." See Chediak, *The Progressive Development of World Copyright Law*, 42 AM. J. INT'L L. 797 (1948).

[68] Compare the Preamble of the Draft Convention, in RECORDS, *supra* note 20, at 333.

[69] For the view that the UCC favors publishers' interests over authors' interests, see Note, 1 INT'L & COMP. L.Q. 217, 220 (1952).

or under treaties or conventions of which they are signatories. Indeed, the view is taken that the maintenance of such maximum standards is an essential condition of the universal system of protection whose extension and improvement alike it seeks to bring about. To this end provisions are suggested designed to ensure the continuance and even the extension of existing conventions.[70]

This statement should serve as one of the main guiding principles for the interpretation and application of the provisions of the UCC. More particularly, it expresses the principle underlying the safeguarding provisions for the Berne Conventions, the Pan-American Conventions, and other international copyright arrangements contained in articles 17, 18 and 19 of the UCC.

## THE UNIVERSAL COPYRIGHT CONVENTION AND THE BERNE CONVENTION

### SUCCESSIVE MULTILATERAL TREATIES

Before examining the specific provisions adopted in the UCC *vis à vis* Berne, some consideration should be given to the international law of successive treaties. What would happen if the UCC said nothing about the Berne Convention?

In abstract, the Berne Union may be considered as consisting of the states *A*, *B*, *C*, through *J*. The UCC, later in time, consists of states *E*, *F*, *G*, through *N*.[71] Since both treaties deal with the same subject matter and the provisions of the two treaties differ, a question arises: which provisions prevail? As to relations exclusively between *A*, *B*, *C*, and *D*, which were not parties to the UCC, it seems clear that Berne continues to apply. Between *A*, not a party to UCC, and *E*, a party

[70] HEPP, EVOLUTION OF INTERNATIONAL COPYRIGHT LAW 6 (1950). M. Hepp was Chief of the Copyright Division of UNESCO during the years of formulation of the UCC.

[71] The Geneva Conference of 1952 consisted of about forty-four delegations; some but not all of the Berne states were represented, and several non-Berne states participated. RECORDS, *supra* note 20, at 41, 45, 70.

to both Berne and UCC, the earlier Berne Convention would prevail.[72] As among *E* through *J*, the rule *lex posterior derogat priori* would apply if neither treaty indicated otherwise, and the UCC would govern the relations between, say, *E* and *G*. Here the UCC would prevail in all cases where the two treaties were inconsistent, even if the provisions of the UCC were less favorable to the author than the Berne provisions.[73] Note, however, that there may be no conflict in a strict sense, but only a difference:[74] *e.g.*, if the earlier treaty says the duration of copyright may not be reduced below twenty-five years, and the later treaty says it may not be reduced below fifty years, applying the fifty-year rule will not violate the earlier treaty.

BERNE AND A SUBSEQUENT MULTILATERAL CONVENTION

The foregoing observations are based on customary international law rules, which might be called presumptions; the consequences may be altered by express provisions in the earlier treaty. Berne contains two such provisions in this respect. Article 20 states:

> The Governments of the countries of the Union reserve to themselves the right to enter into special Arrangements between each other, in so far as such Arrangements shall confer upon authors more extended rights than those granted by the Convention, or embody other provisions not contrary to this Convention.

On the other hand, article 24 on revisions states:

> . . . (3) No alteration in this Convention shall be binding on the Union except by the unanimous consent of the countries composing it.

At first glance, these provisions seem to conflict. Although article 24 deals with revisions of Berne and article 20 with "special Arrangements," the distinction between these two is

[72] Harvard Research, *Law of Treaties*, 29 AM. J. INT'L L. 1013 (2d Supp. 1935).

[73] *Id.*, art. 22(a) at 1009.

[74] Jenks, *The Conflict of Law-Making Treaties*, 30 BRITISH YEARBOOK OF INTERNATIONAL LAW 401, 425 (1953).

often difficult, especially since the revisions of Berne have been concluded without unanimous participation of all Union countries.[75] Perhaps the clauses can be reconciled if article 24 is construed strictly to refer to alterations which would be inconsistent with Berne. Thus, the "special Arrangements" under article 20 would not be "alterations," but would be supplemental provisions extending authors' rights, and applicable in addition to the full applicability of all Berne provisions.

The resulting implication is that any *inter se* agreements, not unanimously approved, which give less protection to authors than Berne gives, would be a violation of Berne. But what are the consequences of this violation? If the *inter se* agreement is admittedly *not* applicable to states not parties to it, then what harm is done to those states?

It might be argued that these third states have been harmed by a later treaty like the UCC, on the grounds that one of the primary purposes of Berne has been frustrated.[76] That purpose was a pact among all member states to give minimum Berne protection throughout the Union. All the states which joined Berne had an interest in stimulating the creation of literary works in *all* Union countries.[77] If the later treaty,

[75] At the Brussels revision conference of 1948, several Union countries did not officially participate. REPORT OF THE UNITED STATES OBSERVER DELEGATION AT THE BRUSSELS CONFERENCE 8 (1948). Unanimity has also been lacking in previous provisions. 1 LADAS, *op. cit. supra* note 17, at 138. For a historical survey of the unanimity rule, see TOBIN, THE TERMINATION OF MULTIPARTITE TREATIES 206-44 (1933).

[76] Harvard Research, *supra* note 72, art. 22(b): "Two or more of the States parties to a treaty to which other States are parties may make a later treaty which will supersede the earlier treaty in their relations *inter se*, only if this is not forbidden by the provisions of the earlier treaty and if the later treaty is not so inconsistent with the general purpose of the earlier treaty as to be likely to frustrate that purpose."

Although the Comment to this article, *id.* at 1018, might be taken to limit its applicability to earlier treaties of a quasi-constitutional nature, it has been extended to other multipartite treaties. Lauterpracht, *Second Report on the Law of Treaties*, INTERNATIONAL LAW COMMISSION, 6th Sess., at 41 (U.N. Doc. No. A/CN. 4/87) (1954).

[77] See Brussels Revision of 1948 art. 1.

giving less protection to authors, is to prevail among states *E* through *J*, then an author of state *E* has less stimulus for creation because he now receives less protection in states *E* through *J*. The purpose of uniformity of minimum protection would be frustrated. Moreover, by looking to the prior treaty, we see in article 29 of Berne that a procedure for denunciation was explicitly set out. This implies that a partial withdrawal, *vis à vis* some countries and not others, is not permissible. The impact of this line of argument would be that the UCC, since it does on the whole grant less protection to authors, could not be applied among states *E* through *J* even *inter se*. The applicability of the UCC would thus be limited to relations between a party to the UCC only (like state *N*) and other parties to the UCC (*E* through *M*).

A second position would be that among states parties to both treaties (*E* through *J*), solely the UCC applies; this would follow the rule *lex posterior derogat priori*. The argument here would stress the necessity of the freedom of states to contract as they wish and to undergo a partial novation. To the extent that article 20 of Berne has been ignored, the maxim *pacta sunt servanda* should not be invoked unless it serves the function of protecting a state's interests. Contrary to the first argument above, there is no tangible harm done to states *A* through *D*, since Berne is still in force between them and all other Berne countries. The fact that an author of state *E* receives less protection now than he did before the UCC was adopted gives *D* no grounds for complaint.

There are difficulties with both of these positions. Although the first solution—to apply only Berne—seems to fit into the rule laid out in article 22(b) of the Harvard Draft,[78] this rule should not be applied blindly. The possible frustration of the purposes of Berne should be weighed against the degree of harm suffered by a party to Berne. Similarly, even though article 20 of Berne clearly implies that a les-

[78] Harvard Research, *supra* note 72, at 1016. See note 76 *supra*.

sening of protection is not permissible, if a technical violation causes no real harm to a state, should it bind the parties for all future time? On the other hand, the second position, which allows full freedom to revise a prior treaty *inter se*, does undercut the need for reliability in the treaty system. States might hesitate to enter multilateral treaties if most of the other parties could provide for different treaties applicable among themselves.[79] The problem of choosing between these positions is related to the question of whether multipartite treaties are to be considered contractual or legislative. The modern development of international legislation, operating more on individuals than on states, may suggest a relaxation of strict contract analogies and a tendency to use the statutory *lex posterior* principle. Perhaps the basic difficulty as to Berne and the UCC is that these treaties are quite specialized, and any rule of interpreting which treaty should apply must look to the subject matter of the treaty and then seek a proper solution.

A third solution is that both treaties might exist concurrently among parties to both treaties, *i.e.*, the provisions of both Berne and the UCC are to apply. Where the provisions differ, the one most favorable to the author should prevail.[80] Since the parts of the UCC less favorable to the author are not invoked, there is no frustration of the purpose of the earlier treaty. To the contrary, that purpose is enhanced,[81] since the UCC contains some additional guarantees of minimal protection to authors. Also, there is no violation of article 20 of Berne. The possible objection to this position is that the parties to the UCC may intend that the provisions of the UCC

[79] *Id.* at 1018.

[80] This solution is adopted with respect to the co-existence of bilateral treaties and a subsequent multilateral treaty in LADAS, THE INTERNATIONAL PROTECTION OF INDUSTRIAL PROPERTY 139 (1930).

[81] The need to refer to the earlier treaty in interpreting the later treaty is recognized by Aufricht, who in general advocates a more extended use of the rule *lex posterior derogat priori*. Aufricht, *Supersession of Treaties in International Law*, 37 CORNELL L.Q. 655, 678 (1952).

be applied only as a whole and not be broken up into categories of ones more favorable or less favorable to authors than Berne. However, the provisions of the UCC are framed in such a way as to allow more extended protection to authors, and the purposes of the UCC were primarily to obtain uniformity of minimum, not maximum, protection.[82] Also, if the choice must be between (i) applying parts of the UCC along with Berne provisions and (ii) the UCC being discarded altogether for parties to both treaties, perhaps the intent of the UCC would be to apply both concurrently.

In summary, there are three possible positions as to which treaty should apply between parties to both Berne and the UCC: (i) Berne alone applies, (ii) the UCC alone applies, and (iii) both apply concurrently, the provisions more favorable to the protection of the author prevailing. Of these, it is suggested that the third solution is preferable.

### THE PROVISIONS OF THE UCC

The texts of article 17 and the appendix declaration relating to article 17 indicate three aims of the conference: (i) to declare that the UCC was not intended to affect Berne, (ii) to determine the extent of the application of the UCC in Berne countries, and (iii) to impose a sanction against states withdrawing from Berne. The severity of these provisions is not surprising when it is recalled that several countries stated they could not join the UCC unless Berne remained unimpaired.[83]

The sanction which was adopted in clause (2) of the appendix declaration illustrates the anxiety of the Berne countries that the UCC might weaken Berne or even gradually replace the Berne system. To rule out that possibility, it was provided that countries which withdrew from Berne, and which were also parties to the UCC, would lose not only Berne protection upon withdrawal, but would also lose protection

[82] See pp. 44-47 *supra*.

[83] See note 20 *supra*.

under the UCC. The details of the operation of this sanction are explored at great length by Dr. Bogsch in his recent article,[84] and they will not be discussed in this paper. It should be pointed out, however, that the sanction does not operate between two countries which have *both* withdrawn from Berne; between them the UCC applies.[85]

The first section of article 17 states that:

> This Convention shall not *in any way affect the provisions* of the Berne Convention . . . *or membership* in the Union created by that Convention. [Emphasis added.]

The effect of this clause is clear in some respects: first, that Berne has not been abrogated by any Berne country which joins the UCC, and second, that the provisions of Berne remain in force, even as among two states parties to both Berne and the UCC. This clause was necessary to avoid a possible violation of the Berne Convention. If the second position presented *supra* p. 50 were followed, so that Berne would not apply between parties to both treaties, parties to Berne and not to the UCC might claim that they were harmed.[86]

It is not so clear whether article 17(1) permits the UCC to supplement Berne, *i.e.*, to be applied in those situations where the UCC gives more extensive protection to the author. On the one hand, it might be argued the ordinary meaning of the words is that the UCC shall neither increase nor decrease the protection given by Berne: therefore in cases where both Berne and the UCC would be applicable without article 17(1), Berne alone would apply.[87] On the other hand, the Preamble of the UCC specifically states that the UCC is to be "additional to" the Berne Convention.[88] Since the UCC provisions less favorable to the author would not diminish pro-

[84] Bogsch, *supra* note 19, at 153–60.

[85] *Id.* at 156.

[86] For a different view, that article 17(1) is legally superfluous, see Bogsch, *supra* note 19, at 152.

[87] This was the view of the Indian delegate to the conference, who thought the appendix declaration was unnecessary since article 17(1) alone "guaranteed the future" of Berne. Minutes, *supra* note 20, at # 479.

[88] UCC, Preamble, para. 2.

tection, Berne would not be "impaired" nor would its provisions be "affected." This interpretation is probably preferable. It is consistent with the purposes of Berne to secure maximum protection, and also with article 20 of that treaty.

### CO-EXISTENCE OF THE BERNE CONVENTION AND THE UCC

The appendix declaration is clearly binding on states parties to both Berne and the UCC; this section will discuss the co-existence of Berne and the UCC in those states only.

The solution adopted by the UCC is that the UCC "shall not be applicable." [89] Thus for the typical cases of works published in a country party to both Berne and the UCC the protection sought in another such country will be governed solely by Berne provisions, even where the UCC gives greater protection to the author. This solution is, in the words of the introduction to the appendix declaration, motivated by the desire "to avoid any conflict which might result from the co-existence of the Convention of Berne and the Universal Convention."

The rule that the UCC is not applicable is limited, however, to those cases which meet the further conditions of Appendix Declaration (b):

> The Universal Copyright Convention shall not be applicable to the *relationships* among countries of the Berne Union insofar as it relates to the protection of *works having as their country of origin,* within the meaning of the Berne Convention, *a country of the International Union* created by the said Convention. [Emphasis added.]

For the requirement that the work have a Berne country of origin we look to the Berne Convention, and find that for published works the "country of origin" is the country of first publication,[90] and for unpublished works it is the coun-

[89] UCC, Appendix Declaration relating to Article 17, cl.(b).
[90] Brussells Revision of 1948, art. 4(3).

try of nationality of the author.[91] For example, if an author of a Berne country publishes his work only in a non-Berne country, he is not entitled to Berne protection.[92] Here clause (b) of the declaration would not apply; and if the publication were in a UCC country (or the author were a national of a UCC country), the UCC would be applicable. This situation serves to illustrate that not all "relationships among countries of the Berne Union" invoke clause (b) of the declaration. Here an author of a Berne country seeks protection in another Berne country, but because he has published in a country party only to the UCC he loses Berne protection and gains UCC protection.[93]

There is some ambiguity in the phrase "relationships among countries of the Berne Union." One problem [94] is presented by the fact that not all members of the Berne Union are bound by the same text of the successive revisions of Berne.[95] A few countries have ratified only the Brussels text of 1948. As between them and countries which have not yet ratified the Brussels revision, reciprocal treaty protection does not exist, since they are not parties to the same treaty. If two such Berne countries not linked by the same text of Berne, join the UCC, does the UCC apply between them? A literal reading of clause (b) would say the UCC would not apply: the work would have as a country of origin "a country of the International Union," and the second state, bound by the declaration as a member of the Union, would be told the UCC "shall not be applicable." This result was surely not intended. The effect would be that the two countries, both ratifying UCC and both

[91] Art. 4(5). [92] Art. 4(1).

[93] The opposite result seems to be suggested by De Sanctis, *The Clauses Providing "Safeguards for the Berne Convention" Contained in the Universal Copyright Convention*, 8 UNESCO COPYRIGHT BULLETIN No. 1, at 56 (1955).

[94] This problem was presented by Dr. Arpad Bogsch, of the United States Copyright Office, in his unpublished essay on Articles 17, 18 and 19 of the UCC. Wherever I have drawn on his suggestions or analysis, a footnote to "Bogsch, unpublished essay" will indicate the source.

[95] 1956 DROIT D'AUTEUR 1.

members of the Berne Union, would be unable to apply either treaty in controversies between them. To avoid this anomaly, it is necessary to read "relationships among countries of the Berne Union" as meaning relationships among parties to the same text of the several Berne Conventions.

### THE APPENDIX DECLARATION AND STATES RATIFYING THE UCC ONLY

An additional complication arises from the uncertainty as to which states are bound by the appendix declaration. Article 17(2) says that the declaration "is an integral part of this Convention for the States bound by the Berne Convention," and that ratification "by such States" shall include ratification of the declaration. Again, the declaration itself declares that "the States which are members" of the Berne Union agree to the terms of the declaration. The negative implication is clear: that parties only to the UCC have not accepted the terms of the declaration and are not bound by it. The argument on the other side,[96] that UCC-only states have recognized that Berne provisions alone are sufficient for all cases referred to in clause (b), ignores the wording of the provisions and the fact that clause (b) was put in an appendix declaration and not in the body of the UCC.[97] For the UCC-only states, if they are not bound by the declaration, only article 17(1) can be used against them.

The situations which raise questions of differences between the provisions of Berne and the UCC will generally involve three states, one of which is a party only to the UCC—a *U* state. A party to both Berne and the UCC will be called a *UCC–B* state, and a party to only Berne a *B* state.

1. If a national of *U* publishes his work in a *UCC–B* state, and he seeks protection in a second *UCC–B* state, is protection under Berne, or the UCC, or both, available to

[96] See De Sanctis, *supra* note 93.
[97] 1 OPPENHEIM, INTERNATIONAL LAW 955 (8th ed., Lauterpracht 1955).

him? Since the work has a Berne country of origin,[98] another *UCC–B* country is bound by the terms of clause (b) of the declaration to say the UCC is not applicable. But state *U* can claim that the UCC must be applied to its relationships with another party to the UCC. If a national of *U* published in any country of the world not a party to Berne, that national would be entitled to UCC protection in any other UCC state;[99] why should he lose that protection if he happens to publish in a *UCC–B* state? This dilemma cannot be solved by looking to the provisions of the declaration alone; the result for this situation is not spelled out.

2. Where there is simultaneous publication in a Berne country, which may also be a party to the UCC, and in a country party to the UCC only, what protection should be afforded in a *UCC–B* country? Should Berne alone apply as a consequence of clause (b)?[100] or should both Berne and the UCC apply? This situation is quite likely to occur, since authors of the United States (a *U* country) still have incentives to publish their works simultaneously in a Berne (or *UCC–B*) country. They thus acquire the generally more extensive protection afforded by Berne, and also get protection in all Berne countries which have not joined the UCC. Does the UCC say that this procedure forfeits the rights under UCC which are more favorable to authors than Berne?

The problem in these cases is one of interpretation of the UCC and the intent of its framers—at least to decide whether Berne alone, or both Berne and the UCC, should apply. It would be dangerous to say that the UCC could determine that Berne would not apply in such a case since that might be a violation of Berne. One of the sources for interpretation is the preparatory work of the conference which drafted the UCC.[101] The text of the draft convention included a third

[98] Brussels Revision of 1948, art. 6(1). [99] UCC, art. 2(1).

[100] The country of origin is a Berne country. Brussels Revision of 1948, art. 4(3).

[101] Harvard Research, *supra* note 72, art. 19; 1 OPPENHEIM, *op. cit. supra* note 97, at 957.

clause of the declaration (section 1[c] of the Draft Protocol) which specifically stated that both treaties would be applicable in situation (2) *supra*. Some delegates at the conference objected to section 1(c) on the grounds that it might nullify the effect of reservations to Berne. The Berne countries which did maintain reservations restricting translation rights [102] might be required to give the more extensive protection of article 5 of the UCC. The threat was that a Berne author might simultaneously publish in a *U* country, and thus claim the greater rights given him by the minimum protection of article 5. This by-passing of the reservations to Berne was recognized by the conference as objectionable, and consequently section 1(c) of the Draft Protocol was deleted.[103] The reason for dropping the clause was to guard against Berne authors publishing simultaneously in a *U* country. The situation where a national of *U* publishes simultaneously in a *UCC–B* country was not considered by the delegates.[104] Consequently it should be recognized that the preparatory work is inconclusive as to the intended outcome for the second situation *supra*.

The answer to whether Berne or both Berne and the UCC apply in the first and second situations depends on considerations of a more general nature. The interest of a *U* state must be taken into account. The author who is a national of *U* is explicitly given protection in other UCC states by article 2. This is not true under Berne, where article 4(1) gives protection to Berne authors *only* if they publish in a Berne country. This difference may serve to distinguish the case considered by the conference delegates when it deleted section 1(c) of the Draft Protocol. The rights conferred on the national of *U* include all guarantees of minimum protection

[102] 1956 DROIT D'AUTEUR 1.

[103] Report of the Rapporteur-General, in RECORDS, *supra* note 20, at 93. Minutes, at # 1061–1078, especially # 1066. See also Minutes, at # 1294.

[104] In fact, there is indication that the conference delegates thought simultaneous publication (the "back door to Berne") was no longer necessary. See Minutes, *op. cit. supra* note 20, at # 53. That statement, however, was made in regard to the whole of the draft text, including § 1(c) of the Draft Protocol.

granted by the UCC. These guarantees should not be lessened except by a clear showing of the intent of the UCC to the contrary. Therefore, both Berne and the UCC minimum guarantees should apply.[105] This solution would be consistent with the interpretation of article 17(1) given on pp. 53–54 *supra*, and it is in line with the purposes of Berne to secure as many benefits for authors as possible. The problem of conflicts, which the appendix declaration desired to avoid,[106] does not arise in cases of minimum protection. Berne and the UCC differ in their provisions of minimum protection, but both treaty obligations can be concurrently satisfied if the provisions giving greater protection to the author are applied.

3. A third situation raises somewhat different questions. Suppose a work is published in a country party to both Berne and the UCC, and infringement of the copyright takes place in a second country party to both treaties (both are *UCC–B* countries). The defendant, however, is a domicile of *U*, a party to UCC only, and the suit is brought in the courts of *U*. Does Berne alone, or both Berne and the UCC, apply?

There are some preliminary questions of jurisdiction here. If the suit is for an injunction, the courts would probably say the plaintiff should sue in the state where the infringement is taking place, and would not reach the merits.[107] However, the defendant might not be suable in the second *UCC–B* state, if, for instance, the defendant had ceased to do business there and the plaintiff were seeking damages for past infringe-

[105] The same result is reached by Bogsch in his unpublished essay (see note 94 *supra*), and in Henn, *supra* note 28, at 136 n. 38. De Sanctis, *supra* note 93, would favor applying Berne only.

[106] One delegate at the conference thought that Berne would somehow be weakened if the question of which treaty gave greater rights to authors were left open to the courts. Minutes, *op. cit. supra* note 20, at # 1294. But it cannot be ignored that differences do exist, and that state *U* would insist on its full rights under the UCC.

[107] "Morocco Bound" Syndicate v. Harris, [1895] 1 Ch. 534. United States courts would also probably dismiss on grounds of lack of jurisdiction or forum non conveniens in view of the traditional hesitancy of equity to act extraterritorially. *Quaere* if these grounds are always valid if jurisdiction over the person is obtained.

ments. The jurisdictional difficulty might also be resolved if defendant's infringements were in both *U* and the second *UCC–B* state; in this case the court, obtaining jurisdiction for the infringements in *U*, might also enjoin infringements abroad.[108]

But once the court reaches the merits, which treaty is applicable? [109] Avoiding the question of which domestic law should be used,[110] suppose plaintiff claims a violation of a minimum treaty right, such as the translation rights of article 5 of the UCC? All three states are parties to the UCC, but if suit were brought in the second *UCC–B* country, only Berne protection would be given because of clause (b) of the declaration. In this situation, unlike the first and second situations *supra*, the interest of *U* in claiming the UCC should apply is lacking. The state of publication and of nationality of the author is a Berne country, and it cannot insist on the additional rights of its authors under the UCC, because it is bound by the appendix declaration. In this case, then, Berne alone should apply.

## SOME SUBSTANTIVE DIFFERENCES BETWEEN BERNE AND THE UCC

Since both Berne and the UCC are based on the principle of national treatment—that there should be no discrimination against foreigners—the full scope of protection by domestic law is available under either treaty. Thus for many cases, differences between the convention provisions will not be relevant. But the problems of co-existence do arise because the two treaties differ in the minimum scope of protection they require. A state where protection of the foreigners is based on

[108] *Cf.* George W. Luft Co. v. Zande Cosmetic Co., 142 F.2d 536 (2d Cir. 1944).

[109] De Sanctis, *supra* note 93, at 53 seems to have this sort of situation in mind.

[110] Both the UCC, art. 2, and Brussels Revision of 1948, art. 4(2), contemplate the scope of protection to be governed by the domestic law of the state where protection is sought. The case of infringement in one country when redress is sought in the courts of another country is not provided for.

these minimum requirements will thus face the problem of which minimum protection it is obligated to give in the situations such as those described *supra*. In most cases the Berne minimums give more extended rights to authors than the UCC; but in other instances the UCC minimums give greater rights. Note that these differences are not conflicts, since performance of both treaty obligations is possible and, indeed, preferable. Differences in regard to translation rights will serve as an illustration.

States which have made reservations to the Berne Convention are obliged to give authors an exclusive right of translation for ten years only.[111] Under article 5 of the UCC the minimum is seven years, but thereafter the author is guaranteed a correct translation and just compensation. If both Berne and the UCC are to apply, then the author could claim an exclusive right for ten years (not just for seven years) and also a right to a correct translation and just compensation after the ten years expired.

Whether it is possible to have a conflict or an inconsistency between the provisions of Berne and the UCC is uncertain, since both treaties are on the whole concerned with securing minimum protection without imposing maximum limits on that protection. A hypothetical case may, however, suggest the difficulties which would arise. The definition of "publication" in the UCC differs from the Berne definition. Article 6 of the UCC states:

> "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.

Presumably this means that the showing of a movie is a publication,[112] and this will be assumed *arguendo*. Under Berne, article 4 (4), the presentation of a cinematographic work is

[111] Brussels Revision of 1948, art. 25(3).

[112] Kaye, *Duration of Copyright Protection and Publication Under the Convention: Articles IV and VI*, UNIVERSAL COPYRIGHT CONVENTION ANALYZED 39, 46–50 (1955).

not to be considered publication. The UCC requires published works to be protected as published works (article 2[1]), and consequently to be subject to the duration of protection provided in article 4. Unpublished works under Berne are to be protected indefinitely, without time limits.[113]

If a national of a *UCC–B* state has his work "published" (according to the UCC, but not according to Berne) in a *U* country, and he seeks protection in a second *UCC–B* country, should his work be considered published or unpublished? The language of clause (b) of the declaration is technically met; the work has a Berne country of origin [114] and therefore the UCC is "not applicable." But was it not intended that this case be governed by the UCC?

In this case, perhaps both treaties could not be applied concurrently. Although by granting indefinite protection the author would be given the most favorable protection, it is arguable that the UCC intended published works to have protection only for a limited time, and thereafter fall into the public domain. For this situation the UCC might be interpreted as guarding the interest of the public and not the author's interest.[115] However, even in this case, a court might refuse to recognize an inconsistency and treat the two treaties as only differing, and thus apply the more extended protection under Berne. Article 4 of the UCC would seem to allow indefinite duration of protection by domestic law if a state so desired; the only restrictive obligations being ones of minimum duration. The presumption against inconsistencies would, and probably should, be a strong presumption in the area of copyright treaties.

[113] 1 LADAS, *op. cit. supra* note 17, at 302.

[114] Brussels Revision of 1948, art. 4(1), protects unpublished works of Berne nationals, and, according to Berne, this is an unpublished work.

[115] See pp. 44–47 *supra.*

## THE UCC AND INTERNATIONAL COPYRIGHT SYSTEMS OTHER THAN THE BERNE CONVENTION

### THE PURPOSES OF ARTICLES 18 AND 19

The distinction made in the provision of the UCC between the Berne Convention and all other international copyright arrangements originated several years before the Geneva Conference met. The Third UNESCO Committee of Experts in 1950 recommended that a special clause be devoted to safeguarding Berne and another clause deal with all other systems of international protection.[116] The decision to maintain the Berne Convention intact and to provide that the UCC should not diminish the protection available under Berne was incorporated into the draft version, drawn up in 1951.[117] The Draft did not include the text of the additional clause contemplated for other international systems, but recognized the need to assure the continued existence of such systems.[118] The text which was presented to the Geneva Conference in 1952 was drawn up earlier in 1952 at a meeting of the Copyright Experts of the American Republics. This clause, draft article 16, which applied to all conventions and arrangements other than Berne (and thus not limited to Pan-American systems exclusively) provided that in cases of "differences or variances" from the UCC provisions, the later in time should prevail. For all treaties existing when the UCC came into force, this meant the UCC was to prevail.

[116] *Recommendation of the Committee of Experts*, 3 UNESCO COPYRIGHT BULLETIN Nos. 3-4, at 9-10 (1950).

[117] *Acts of the Fourth Committee of Copyright Experts*, 4 UNESCO COPYRIGHT BULLETIN No. 3, at 12 (1951).

[118] Annex No. 3 of the Draft Convention included the Recommendation of the 1950 Experts Committee (see note 116 *supra*): "In order that the Universal Convention may not prejudice the multilateral and bilateral systems of copyright protection such as those of the American Hemisphere, there should be specific assurance in the Universal Copyright Convention that it cannot be interpreted as abridging the rights to legal protection derived from any existing conventions or from any bilateral treaty presently in force."

Both articles 18 and 19, as finally adopted, maintain this distinction between how the UCC should affect Berne and how it should affect all the other treaties.[119] The reason behind this differentiation was the general opinion that Berne was a highly developed scheme of international protection and should be kept in force unaffected by the UCC, since on the whole it gave better protection to authors than did the UCC. On the other hand, the Pan-American Conventions and other arrangements [120] were considered as giving on the whole less protection to authors than the UCC gave, and since the UCC would be an advancement in many cases, it was thought the UCC should prevail over the older treaties.[121]

The reason two clauses were needed—one for the Pan-American systems and another one for all others—is not clear. However it was decided at the Conference to limit the scope of draft article 16 to Pan-American arrangements only.[122] This raised the question of whether a separate article would be needed for other arrangements. At this point in the proceedings several delegates suggested that a new article was unnecessary, since the effect of the UCC on those other arrangements could be settled by international law.[123] However, a new article was proposed and after some revisions was adopted as article 19.

### COMPARISON OF ARTICLES 18 AND 19

Article 18 by its terms applies only to arrangements which are "*exclusively* between two or more American *republics*." (Emphasis added.) A treaty or convention to which one country, not an American republic, is a party is not within the scope of article 18 but is covered by article 19. The Monte-

[119] At the conference, Cuba proposed to eliminate the distinction in the treatment given Berne and other treaties. Working Document DA/131, RECORDS, *supra* note 20, at 367. This proposal was rejected. Minutes, at # 488.

[120] See pp. 36–38 and 38–43 *supra*.

[121] Report of the Rapporteur-General, RECORDS, *supra* note 20, at 92. Minutes, at # 734.

[122] Minutes, *supra* note 20, at # 529.

[123] *Id.* at # 521–# 523.

video Convention of 1889,[124] since it includes European countries as adherents, is thus covered by article 19 and not article 18. Article 18 is also limited to "American republics," and Canada and colonies or possessions of European countries are not "republics." Consequently, a bilateral arrangement between the United States and Canada would also be governed by article 19.

Another difference between the two articles is that article 18 specifically mentions future arrangements, namely, those which "may be formulated between two or more American republics after this Convention comes into force," and provides that the "most recently formulated shall prevail." Article 19, on the other hand, refers only to "existing conventions and arrangements" and states that in cases of differences of provisions the UCC shall prevail. Some technical differences should be noted here. In article 18, the criterion for which treaty shall prevail is the date of formulation. For the UCC, that date is September 6, 1952, the date of its entry into force. For the Washington Convention,[125] the latest Pan-American multilateral treaty, the date would be 1946. Since the UCC is "the most recently formulated of these two treaties, the UCC would prevail even in a state where the UCC was ratified and came into force before the Washington Convention was ratified.[126] The result might present an anomalous situation, since the normal rule would be that the treaty which last enters into force must prevail. Presumably the courts of such a state would construe the Washington Convention with reference to the UCC (and article 18 in particular). In any event, under international law the UCC would have to prevail in order not to violate article 18. This difficulty is avoided by article 19, because it does not refer to the date of formulation. Since the normal construction of the phrase "existing conventions or arrangements" would cover only those which

[124] See note 15 *supra.*

[125] See note 26 *supra.*

[126] Bogsch, unpublished essay. See note 92 *supra.*

were in force in a given state at the time the UCC comes into force in that state, article 19 would not apply to conventions adopted after, though formulated before, the UCC.

THE PRINCIPLE OF NON-ABROGATION

In the same way that article 17 declares that the UCC was not in any way to affect the Berne Provisions,[127] so the first sentence of both articles 18 and 19 was perhaps necessary to avoid a violation of prior multilateral convention treaties. In the absence of this provision, adoption of the UCC by two or more states parties to such a multilateral treaty would probably be considered a complete substitution of the UCC for the prior treaty, and this might be considered a violation of the prior treaty. This would also be true for a prior bilateral treaty between a state not a party to the UCC and a state ratifying the UCC. Such treaties would not be abrogated, but would remain in full force.

The statement in article 18 that the UCC shall not abrogate conventions or arrangements "that are *or may be* in effect" between two American republics may seem somewhat superfluous, since the UCC can clearly not abrogate the future treaties. This phrase achieves meaning when it is realized that some treaties may become effective after the UCC was written but before it took effect. The phrase makes clear that the UCC will neither abrogate these treaties nor treaties that "are . . . in effect" on September 6, 1952.

The main impact of this first sentence is on treaties all the the parties to which have ratified the UCC. The clause indicates that these are to continue in force, unabrogated. Thus, the first sentence anticipates that differences will arise between such a treaty and the UCC, and the second sentence regulates that problem.

[127] See pp. 52–54 *supra.*

THE MEANING OF "DIFFERENCE"

Both articles 18 and 19 state that "in the event of any difference" between the provisions of the UCC and the provisions of another convention or arrangement then either the most recently formulated, in the case of article 18, or the UCC, in the case of article 19, shall prevail. There are three possible meanings that can be given to the phrase "in the event of any difference." In the following analysis it will be supposed that states *X* and *Y* have an existing treaty in effect between them, and that both states later ratify the UCC.

1. One interpretation would be that whenever a result obtained by applying the prior treaty differed from that reached by applying the UCC, then the UCC should be applied.[128] If the prior treaty does not protect the work in a particular case and the UCC does protect it, then the UCC will be applied. In addition, if the prior treaty does give protection where the UCC does not, then the work will not be protected, since the UCC prevails. That is, the UCC will prevail without regard to whether the UCC gives more or less protection to the author.

2. If a different result were obtained by applying the prior treaty and applying the UCC, the UCC would prevail only if its application were more favorable to the author than the application of the prior treaty. With this interpretation, if the prior treaty affords protection when the UCC does not, the work will nevertheless be protected, since that is the result most favorable to the author.

3. A third interpretation of the word "difference" is that it is intended to mean a conflict in its strict sense, *i.e.*, an incompatibility.[129] If the UCC protected a work when the prior

[128] This interpretation is adopted by Bogsch in his unpublished essay. See note 94 *supra.*

[129] This interpretation is advanced by the former President of the Geneva Conference. Bolla, *Article XIX of the Universal Copyright Convention,* 8 UNESCO COPYRIGHT BULLETIN No. 1, at 27 (1955).

treaty did not protect it, then the UCC would apply to protect the work. But if the prior treaty did afford protection and the UCC did not, it would be necessary to examine the UCC further to see if it required a contradictory rule. Only if the UCC explicitly or by proper interpretation required that the work *not* be protected, would the UCC be applied; in all other cases the work would be protected by the prior treaty, since this would not be in conflict or incompatible with the UCC.

Of these three possible interpretations, it should first be determined whether any one meaning was intended by those who wrote these words into articles 18 and 19. In support of the first meaning there is the rule of interpretation that words should be given their ordinary meaning;[130] "difference" and not "conflict" or "inconsistency" was used. However, by looking behind the wording, it can be shown that the drafters did not have this distinction of words in mind.[131] The Rapporteur-General of the Conference, in describing articles 18 and 19, says that the rule of those provisions was that the UCC should prevail over prior treaties "in the event of *conflict*."[132] (Emphasis added.) Moreover, the discussions at the Conference itself indicate that "difference" was not used in the sense here described under 1. Several of the Pan-American delegates thought that the prior Washington Convention would be safeguarded and its provision remain undiminished under such a clause as article 18.[133] The United States delegate, speaking of the proposed article 19, stated that, in line with the Preamble of the UCC, he "joined with others in thinking that, *in so far as the proposed Convention* [the UCC] marked an advance over existing systems, *it should prevail* over them. That point was covered in the proposed article [article 19]."[134] (Emphasis added.) The Conference was thinking in terms of making sure that the

[130] 1 OPPENHEIM, *op. cit. supra* note 7, at 952.
[131] Harvard Research, *supra* note 72, art. 19(a); and Comment, at 961.
[132] Report of the Rapporteur-General, RECORDS, *supra* note 20, at 91.
[133] Minutes, *supra* note 20, at # 500, # 523.
[134] *Id.* at # 734.

improvements contained in the UCC should not be forsaken because of the Preamble's phrase that the UCC was not intended to impair existing international systems already in force.[135] But, as has been stated by the President of the Geneva Conference, the delegates were not considering situations in which the prior treaty might give more extended rights to the authors than did the UCC; "the meeting concentrated on the opposite hypothesis." [136]

The greatest difficulty with construing "difference" as meaning all situations where a different result is obtained is that it makes the first sentence of articles 18 and 19 almost meaningless. If the prior treaty is not applicable whenever it differs in result from the UCC, then it does apply only if its provisions are the same as the provisions of the UCC. This makes the prior treaty completely superfluous, and it is hard to see why the UCC declared explicitly that these treaties were not abrogated.[137] The first sentence would have meaning only if it is supposed that the two parties to the earlier treaty, having joined the UCC, later denounce or abrogate the UCC; then the earlier treaty would revive and be in full force without renegotiation. It is difficult to see that this was all that was intended in stating that such treaties were not abrogated, and a more meaningful interpretation should be preferred.

If the provisions of articles 18 and 19 are considered in the context of the whole treaty of which they are part,[138] the argument against the first meaning is fortified. In the first place, the Preamble states that the UCC is to be "additional to, and without impairing international systems already in force." Although this general statement of purpose should not be read as prevailing over the more specific language of articles 18 and 19, it is quite appropriate to use it as a guide

[135] *Ibid.*

[136] Bolla, *supra* note 129, at 25.

[137] Bogsch in his unpublished essay (see note 94 *supra*) admits that this difficulty exists with his interpretation.

[138] 1 OPPENHEIM, *op. cit. supra* note 97, at 953.

to interpreting those provisions. It is strong evidence that the "differences" contained in the UCC should not impair the rights of authors already available under prior treaties. But this statement of purpose is not only expressed in the Preamble; it runs throughout the various articles of the UCC. The three most prominent articles—on formality (article 4), duration (article 5), and translation rights (article 6), are all framed in terms of extending to the author the maximum protection afforded by the law of the state where protection is sought.[139] They then declare that the protecting state may, but is by no means required to, limit authors' rights under certain specified conditions; and that, in all cases, a minimum protection is afforded. Article 5, for instance, provides that authors shall have the exclusive right of translation but allows a state to restrict such rights subject to the minimum standards prescribed. It would seem necessary to agree with Dr. Bolla [140] that the UCC, in giving states an option to reduce the copyright protection afforded, should be construed as intending to leave the provisions of prior treaties giving more extended rights to authors in full force.

There is an additional problem of choosing between the second and third meanings of "difference" described above. Although both of these interpretations would, in most cases, result in applying the provisions of the treaty more favorable to the author, there might be cases where applying the earlier treaty would be inconsistent with the UCC. If the UCC were construed in some case to set a maximum as well as a minimum of protection on the author's rights, then a true conflict might require the UCC to prevail, although it gave less protection to the author than the earlier treaty. Although such a safeguarding of this aspect of the public interest is not present in most of the provisions of the UCC, the possibility that it may occur should not be foreclosed. This is one reason

[139] See pp. 44–47 and note 70 *supra*.

[140] Bolla, *supra* note 129, at 27–33. This article is particularly illuminating in showing how these "optional" provisions are not in conflict with, and should not reduce, the protection afforded by prior treaties.

why the third meaning for "difference" is preferred to the second meaning.

Another reason is that the third meaning would be consistent with the customary law of treaties. When two successive treaties are concluded between the same parties, the provisions of the later treaty prevail to the extent that they are inconsistent with the provisions of the earlier treaty.[141] Adopting the second meaning would be a departure from this normal rule, since by that interpretation, the earlier treaty might prevail even though it was inconsistent with the later UCC. It should be noted that some of the Conference delegates were also of the view that articles 18 and 19 were expressions of the ordinary rule of international law,[142] but it was concluded that those articles should be adopted to make the intent clear and to avoid implications from the Preamble and from article 17 and the appendix declaration that prior treaties were to remain completely unimpaired.

The preferable interpretation then of "difference" is that it means "inconsistent." In view of the strong presumption against conflicts of treaty provisions,[143] the usual case of concurrent applicability of both treaties would result in no impairment of the author's rights. However, in the last sentence of articles 18 and 19 explicit provision is made for rights acquired under existing treaties, so that even in situations where there is a conflict such that the UCC must prevail over prior treaties, previously acquired rights will not be affected.

### THE MEANING OF "ARRANGEMENTS"

Both articles 18 and 19 state that the UCC shall not abrogate "multilateral or bilateral copyright conventions or arrangements," and that "in the event of any difference" in the provisions, the UCC (or in article 18 the most recently

[141] Harvard Research, *supra* note 72, art. 22(a).
[142] Minutes, *supra* note 20, at # 523, # 734.
[143] Harvard Research, *supra* note 72, at 1011; OPPENHEIM, *op. cit. supra* note 97, at 952; Jenks, *supra* note 74, at 427.

formulated) is to prevail. Both articles would clearly apply to any existing multilateral conventions or bilateral treaties; [144] they would also apply to an exchange of notes between two governments which expressly reached an agreement to give reciprocal copyright treatment.[145] But does the term "arrangements" have a wider scope? The main problem raised by this question is with respect to the proclamation system in the United States. Some of the characteristics of the system were discussed *supra* pp. 38–41. Here it should be pointed out that, in addition to proclamations based on international agreements, there are two other types of proclamations.

1. The proclamation may be accompanied by an exchange of notes, which does not explicitly recite that an agreement was made but does give assurances that both the United States and the foreign state did or would give reciprocal copyright protection to each other's authors. The copyright protection is given by domestic law, and the notes are assurances that the respective domestic law would apply to authors of the other state.[146] The Presidential proclamation then usually recites that "whereas satisfactory official assurance has been given" [147] the foreign law does meet the reciprocity requirements of section 9(b),[148] and reference is made to the exchange of notes; therefore authors of that state are afforded protection under our Copyright Act. Authorities consider this type of assurance to be an international obligation.[149] It would seem that it would come within the term "arrangements" in articles 18 and 19.

[144] The United States is a party to a few bilateral copyright treaties (with China, Hungary, and Siam).

[145] See note 49 *supra*.

[146] One example is the Exchange of Notes between Great Britain and the United States of Jan. 1, 1915. See note 49 *supra*.

[147] Proclamation of Jan. 1, 1915, 38 STAT. 2044.

[148] 17 U.S.C. § 9(b) (1947).

[149] Hyde, *Constitutional Procedures for International Agreement by the United States*, PROC. AM. SOC'Y INT'L L. 45, 49–50 (1937); 5 HACKWORTH, DIGEST OF INTERNATIONAL LAW 413 (1943).

It would also seem to be unnecessary for the proclamation to make explicit reference to an exchange of notes if the notes do exist and such notes are the basis of "assurances" recited in the proclamation.

2. Proclamations may be issued although no exchange of notes has taken place. However, the proclamation still recites that "satisfactory official assurances" have been given, or "satisfactory evidence has been received," and that the foreign law affords reciprocal treatment.[150] Presumably this evidence of foreign law is obtained in the United States from agencies [151] such as the Copyright Office or the Department of State, or from communications of an informal nature from the foreign government. This type of reciprocal treatment would seem to be unilateral, since there is no basis for showing that mutual obligations are undertaken. Such proclamations could be terminated at any time [152] and no breach of an international agreement would be involved.

But there is evidence from the proceedings of the Geneva Conference that even these proclamations were considered to be "bilateral . . . arrangements." The United States delegate to the conference made reference to the bilateral arrangements with India,[153] and, in answer to a specific question of the Irish delegate,[154] stated that the "United States had bilateral arrangements with India and Ireland." [155] However, in the case of both India and Ireland, the only arrangements which exist with the United States are proclamations which are not accompanied by an exchange of notes.[156] "Arrangements" was thus used indiscriminately to cover not only

[150] Examples are the proclamations extending protection to French citizens: Proclamation of July 1, 1891, 27 STAT. 981; Proclamation of April 9, 1910, 36 STAT. 2685.

[151] See Dixon, *supra* note 49, at 116.

[152] 17 U.S.C. § 9(b), para. 3. See note 48 *supra*.

[153] Minutes, *supra* note 20, at # 744.

[154] *Id.* at # 746.

[155] *Id.* at # 747.

[156] Proclamation of Oct. 21, 1954 (India), 19 FED. REG. 6967. Proclamation of Sept. 28, 1929 (Ireland), 46 STAT. 3005.

all international agreements but all copyright proclamations.

One reason for the failure to define "arrangements" more accurately was that the Conference delegates were thinking of what improvements in copyright protection would be made by the UCC, and were neglecting those situations where the existing arrangements gave better protection.[157] They were anxious to make it clear that just because a proclamation would permit a foreign author to publish in the United States and thereby obtain protection under the Copyright Act, this should not override all the advantages offered by the UCC. Under article 2, for instance, a national of another contracting state could publish anywhere and the United States would be obliged to grant copyright protection, if article 3 formalities were observed; a proclamation as to that state should not diminish this advantage.

Even if it were clear that the framers meant to include all proclamations in the term "arrangements," it is not certain that that intention would be conclusive. Articles 18 and 19 apply to "multilateral or bilateral . . . arrangements." It would be difficult to say that proclamations issued without exchange of notes were bilateral, at least in international law, since no binding obligations are incurred.

The effect of including or excluding proclamations from the definition of "bilateral . . . arrangements" is insignificant in most respects because proclamations on the whole do no more than give the foreign author national treatment, which is also given by article 2 of the UCC. Thus the problem of a possible conflict or a decrease of protection under the UCC, is not likely to arise. But, in the absence of a conflict, our bilateral arrangements with other countries will continue in force. Thus, for example, it would not be open to the United States to reduce the translation rights of a German author, although article 5 of the UCC would permit such a reduction of protection, since the prior bilateral arrangements

[157] See pp 66–71 and note 136, *supra*.

afford exclusive translation rights as part of the full national treatment.

## CONCLUSION

Perhaps one of the most intricate problems of interpretation and application which will be raised by the UCC is that of the co-existence of the UCC with other international copyright arrangements. Although articles 17, 18, and 19 attempt to deal with some of the important issues in this respect, there are many problems which were not solved by the Geneva Conference, and many new questions of interpretation have arisen from the texts which were adopted. On the whole, little help can be obtained from the conference proceedings in clarifying the intention of the framers as to specific situations which might arise. But some basis for interpretation should be found, and it is suggested that by looking to the whole of the treaty, and in particular to the purposes which the UCC sought to accomplish, some guiding principles have emerged to resolve the difficulties of co-existence with other treaties.

# *Freebooters in Fashions: The Need for a Copyright in Textile and Garment Designs*

By STUART JAY YOUNG

COLUMBIA UNIVERSITY SCHOOL OF LAW

THE NEW YORK *Times* recently published an article entitled "'Best Year' Ahead for Style Pirates," which candidly predicted that in 1956 the perennial problem of flagrant imitation of exclusive fashions would assume "especial importance." It ascribed the expected banner year for copyists to the marked increase of fashion-consciousness among the mass buying public and among the manufacturers of the sundry articles that comprise our standard of living.[1] The reason for the problem's current pressing nature [2] is itself an indication that as our standard of living continues to rise the American public will become increasingly discriminating and style-conscious. Consequently, the passage of time will *increase*, not lessen, the need for a solution.

As can already be surmised, this paper relates to the theft of designs, *primarily* in the textile and garment industry,

[1] N.Y. Times, Aug. 14, 1955, § 3, p. 1, col. 2. This article gives as reasons for the current increase in the problem's significance: "With the country in a fantastic producing and buying spree, quality of design has been emphasized as never before. While consumers are earning and spending at record levels, they are 'trading up' in their tastes. Higher priced merchandise is becoming easier to sell. More expensive automobiles outstrip the sales of low priced cars. Air conditioners outsell fans. Cashmere coats are sold to women who bought less impressive fabrics last time. . . . Design has become the key word in moving goods . . . today, with more consciousness than ever before on design quality, pirating of original creations is commensurately more of a nuisance."

[2] N.Y. Times, June 18, 1955, p. 15, col. 3; N.Y. Times, Oct. 9, 1955, § 3, p. 1, col. 8.

but has incidental (and not unintentional) application to related industries producing articles of manufacture which have utilitarian value and embody designs of artistic value as well (*e.g.*, glassware, wallpaper, costume jewelry, dolls). This writer is aware that the words "theft" and "piracy" are technically conclusions of law. Nevertheless, despite legal tolerance of the activity of the copyists (with certain exceptions), and the consequent absence of any "legal property" in a thing unprotected by law, this writer is compelled by a layman's sense of justice (not unshared by many jurists and writers on the subject) to use these terms hereinafter.

The tone of this paper is mainly expository of the differing approaches taken by the industry to obtain relief, and of the social, economic, and cultural problems attendant in the absence of such relief. However, where legal analysis is essential to a proper understanding of thematic development, the writer has tried to supply such analysis.

## COMMON LAW PROTECTION

At common law a creator had a property right in his creation in that he was vested with a common law copyright. This right was extinguished by publication or dedication.[3] Subsequent to publication, the law allowed the public to freely appropriate and copy the object, the creator's property rights *then* being restricted solely to the physical subject matter of his creation. There being no limitation on this general rule of common law protection, logic would command, and indeed courts imply,[4] its application to dress designers as well as to other categories of creators.

While it is true that a general publication destroys the

[3] Note, *Common Law Property Rights in Dress Designs*, 27 VA. L. REV. 230 (1940). Weikart, *Design Piracy*, 19 IND. L.J. 235, 241 (1944). See also, Pickard, *Common-Law Rights before Publication*, ASCAP, COPYRIGHT LAW SYMPOSIUM, NUMBER FOUR 298 (1940); White v. Kimmel, 193 F.2d 744 (9th Cir. 1952), *reversing* 94 F. Supp. 502 (S.D. Cal. 1950).

[4] Note, *id.* at 231. Cheney Bros. v. Doris Silk Corporation, 35 F.2d 279 (2d Cir. 1929). Here, instead of relying on a copyright argument, plaintiff urged

common law property right, a limited or qualified publication does not.[5] Hence the question as to what constitutes a general publication assumes importance. Courts have held a display of works of art at a public exhibition (where by-laws and tacit understandings prohibiting copying are in force),[6] distribution to subscribers of specialized collected information,[7] and a public performance of a play,[8] are merely examples of limited or qualified publication and, as such, have no destructive effect upon common law rights. On the other hand, a general sale of dresses or other wearing apparel with the inherent element of fashion *is* a general publication,[9] al-

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a theory of unfair competition. In Montegut v. Hickson, Inc., 178 App. Div. 94, 164 N.Y. Supp. 858 (1st Dep't 1917), plaintiff sought and obtained relief on an unfair competition theory where defendant obtained possession of one of plaintiff's dress models by bribing one of plaintiff's employees.

[5] Wm. A. Meir Glass Co. v. Anchor Hocking Glass Corp., 11 F.R.D. 487 (W.D. Pa. 1951), involved an uncopyrighted "loop design" on glassware. *Held:* After publication the "trade secret" is gone. Supreme Records, Inc. v. Decca Records, Inc., 90 F. Supp. 903 (S.D. Cal. 1950), involved a sale of recordings of a musical arrangement of a song previously arranged by plaintiff. *Held:* In absence of a statutory copyright, publication destroys the common law protection. (Plaintiff also sought to press a theory of unfair competition which was rejected.)

[6] American Tobacco Co. v. Werckmeister, 207 U.S. 284 (1907).

[7] F. W. Dodge Co. v. Construction Information Co., 183 Mass. 62, 66 N.E. 204 (1903). Plaintiff was in the business of collecting information in regard to the erection of buildings which it sold to subscribers, which information plaintiff alleged defendant unlawfully obtained from one of plaintiff's subscribers by inducing the latter to break his contract with plaintiff as regards disclosures of the information. In holding for plaintiff, the court said at 65 (66 N.E. at 206) "private circulation of information or literary composition, in writing or in print, for a restricted purpose, is not a publication which gives the public a right to use it."

[8] Ferris v. Frohman, 223 U.S. 424 (1912). Plaintiffs sued to restrain the production of a piratical copy of a play. The original play was copyrighted in London and though not copyrighted here, permission to perform it in the United States was given. The defendant urged that the London performance extinguished the common law copyright both in England and America by virtue of English statute (at common law, a performance has no such effect). *Held:* Defendant's contention is only true as regards English territory and not America (where the force of English statutory law has no effect). Consequently, in view of an English statutory copyright owned by plaintiffs, the contention of defendant, in so far as it is valid, is irrelevant.

[9] Fashion Originators' Guild of America v. Federal Trade Commission, 114 F.2d 80 (2d Cir. 1940).

though an exclusive, pre-sale style show where attendance is "by invitation only" is obviously *not* a dedication to the public. Consequently, designers find themselves without common law protection precisely when they are most in need of it, *viz.*, at the stage in which their creation bears economic fruit. Indeed, though technically protected at private style shows (*not* held for retail sale purposes), the fear of piracy is so marked that extraordinary measures of secrecy are taken.[10]

Clearly, whether retail sale occurs in high fashion stores, or in private style shows held for sale purposes, publication takes place; the bars are lowered and the copyist, like the privateer of old, roams the seas of fashion.

## STATUTORY PROTECTION

Having learned that publication destroys common law protection, one might suppose the economic future of creative artists in general to be rather dismal. Viewed alone, this might indeed be the case, were it not for the foresight of the founding fathers who provided that Congress shall have the authority to grant legislative protection [11] to these artists to supplement the common law protection, *i.e.*, "to take over" when rights under the common law have either ceased or been extinguished. Congress has used its constitutional power, and such legislation is embodied in Title 17 of the United

[10] N.Y. Times, June 18, 1955, p. 15, col. 3:

"Paris, June 15th—Paris halls of fashion were being cloaked in secrecy today as the couturiers sought to frustrate subversion by a corps of clever spies.

"The style-snitching espionage agents have already burrowed deep into the industry, fashion officials conceded. Although none could estimate the dollar loss to the pattern pilferers, one said he believed it runs into 'tens of millions of francs' yearly.

"As the season for new styles approaches, sewing rooms of Dior, Fath, Balenciaga, and the other creators of women's fashions begin to take on the top-secret atmosphere of a military headquarters."

[11] U.S. CONST. art. 1, § 8: "To promote the Progress of Science . . . by securing for limited times to Authors . . . the exclusive Right to their respective Writings. . . ."

States Code.[12] Consequently, those sufficiently fortunate to come within the terms of the federal statute continue to walk under an umbrella of property right protection. For others not so fortunate, the story is sadly different.

## THE COPYRIGHT STATUTE

One of the approaches taken by the textile and garment industries to solve their problem has been to "interpret their way" into the statute, or at least into section 5(g) [13] which provides for the copyrighting of "works of art; models or designs for works of art." The question (unlike the answer) is quite simple: Are original fashion designs in textiles and garments either "works of art" or "models or designs for works of art"? A brief look at the history of copyright legislation is helpful at this point.

In all, six basic acts or revisions have occurred since 1790. The first was the Act of May 31, 1790,[14] which protected "authors of any map, chart, book or books already printed," giving to such authors the "sole right and liberty of printing,

[12] 17 U.S.C. §§ 1–215 (1952).

[13] 17 U.S.C. § 5 (g) (1952). Section 5 provides in the main:

"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).

"(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.

"(m) Motion pictures other than photoplays.

"The above specifications shall not be held to limit the subject matter of copyright. . . ."

[14] 1 STAT. 124 (1790).

reprinting, publishing and vending" such maps and books for fourteen years, renewable for a like period. The Act of April 29, 1802,[15] extended protection to those "who shall invent and design, engrave, etch, or work . . . any historical or other print or prints."

A general revision of the copyright statute in 1831,[16] in addition to lengthening the period of protection from fourteen to twenty-eight years, brought authors of musical compositions into the ranks of those protected by statute. In 1870, a second general revision of the copyright law [17] repealed former law on the subject and *inter multa alia* granted protection for a "painting, drawing, chromo, statue, statuary, and . . . models or designs intended to be perfected as works of the fine arts." [18]

The Copyright Act of 1909,[19] the basis of our present copyright law, was a thoroughgoing revision of former law containing many new substantative provisions, including another expansion of the area of protection to encompass "all the writings of an author." The 1909 law deleted the phrase contained in the 1870 law, *viz.*, "intended to be perfected as works of the fine arts" leaving it to read: "works of art; models or designs for works of art" which is today the exact wording of section 5(g) of the present law.[20] Some writers view this deletion as a blurring of "the line of demarcation between purely aesthetic articles and useful works of art." [21] The Act of 1947 enacted Title 17 of the United States Code into positive law, but it made no major substantive changes. In essence, the law of 1909 is the law of today.

It is clear that through the years the scope of protection has been steadily widened. Though the pre-1909 distinction between "fine arts" and arts having a useful function no

[15] 2 STAT. 171 (1802).
[16] 4 STAT. 436 (1831).
[17] 16 STAT. 198 (1870).
[18] *Id.* § 86.
[19] 35 STAT. 1075 (1909).
[20] 17 U.S.C. § 5(g) (1952).
[21] Pogue, *Borderland—Where Copyright and Design Patent Meet*, ASCAP, COPYRIGHT LAW SYMPOSIUM, NUMBER SIX (1955).

longer obtained after 1909, the early Rules and Regulations of the Copyright Office [22] nevertheless continued the distinction. Rule 12(g) provided:

*Works of art*—This term includes all works belonging fairly 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.*

*No copyright exists in toys, games, dolls, advertising, novelties, garments, laces, woven fabrics, or any similar articles.*[23] [Emphasis supplied.]

An amendment to these rules evidenced a step in the right direction, changing the second sentence of the above-quoted regulation to read:

The protection of productions of the industrial arts utilitarian in purpose and character, even if artistically made or ornamented depends upon action under the patent law; but registration in the Copyright Office has been made to protect artistic drawings *notwithstanding they may afterwards be utilized for articles of manufacture.*[24] [Emphasis supplied.]

Though the utility was losing *some* force as an invalidating factor, these Regulations constituted a departure from the "spirit of the changes made by the Act of 1909" [25] and represented the Office's official policy. The 1948 amendment to the Regulations reversed the trend:

Section 202.8 Works of art. (Class G)—(a) in 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 works belonging to the fine arts, such as paintings, drawings, and sculpture.[26] [Emphasis supplied.]

[22] Under 17 U.S.C. § 207 (1952), the Register of Copyrights has authority to promulgate rules and regulations for the registration of copyrights, subject to the approval of the Librarian of Congress.

[23] WEIL, AMERICAN COPYRIGHT LAW 625 (1917).

[24] Regulation 12(g) (1926).

[25] Pogue, *supra* note 21, at 18.

[26] 37 C.F.R. § 202.8.(a) (1952).

Here at last was a Regulation upon which one could base a claim to the copyrighting of an artistic object having *inherent* utilitarian features. Though the Regulation does not specifically mention *garments* and *textiles* as illustrative of the articles within the meaning of the Regulation, the applicability of *ejusdem generis* could conceivably cure this omission, providing garments and textiles possess the same characteristics that inhere in the articles mentioned, *viz.* utility *and* artistry.

That garments serve a useful function is indisputable and calls for no discussion. As to the artistry of creators of original fashion designs in fabrics and apparel, the most casual reference to the press, radio, motion picture screen, and other forms of mass communication reveal the public's recognition of their artistic genius. In the final analysis, world opinion, and *not* the judgment of legislators or jurists, resolves questions of aesthetic values.[27] Judicial notice of the inherent artistic qualities of the products of fashion designers surely rests on safe ground. Writers on the subject are in accord.[28] However, the interpretation of this most recent Regulation seems to be that articles which are artistic but possess more than merely incidental utilitarian value may be copyrighted with respect to the applied designs, although as utility begins to overshadow relative aesthetic attraction the likelihood of obtaining a copyright becomes increasingly doubtful.[29]

[27] Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903) at 251: "It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations. . . ."

[28] See, *e.g.*, Hugin, *Copyrighting Works of Art*, 31 J. PAT. OFF. SOC'Y 710 (1949): "Works of art are not only to be found in the classes specifically enumerated. Creations involving very real artistry are conceived and given material form by designers of such articles as milady's chapeaux, gowns, wraps, and similar garments." The writer argues at 712 that if book ends, ash trays, jewelry (of late), and even bathing suits are copyrightable, stylish garments should also have protection. "There is considerable justification, therefore, for a ruling that copyrightable works of art include clothing of all kinds, even hats, gloves, shoes, and other articles, providing, of course, that they be artistic."

[29] *Intention* to put the object to practical use may cause this "overshadowing" and consequent invalidation. See Stein v. Expert Lamp Co., 96 F. Supp. 97

Though it is ridiculous to contend that fashionable garments are *not* intended for practical use, it *is* questionable whether such practical use is their *dominant* function. Purchasers of such apparel do not pay the considerable sums demanded by designers merely to provide protection against the elements. Nor do most women, as nearly all husbands will testify, go shopping for this year's dresses because those bought last year have worn out. That the presence of utility in an article would not per se invalidate a copyright has been fairly well established.[30] It would appear then, that fashion designers have little to worry about. The courts do not agree.

In 1880, in *Rosenbach v. Dreyfuss*,[31] copyright protection was refused for pattern prints of balloons under section 5 of the 1870 act ("prints or works of art"). In 1929 a federal court of appeals held in *Kemp and Beatley, Inc. v. Hirsch* [32] that a design for dress goods (whether stamped on paper or on the goods) was not a "work of art" or a "design for a work of art." In the court's opinion, a "work of art" meant a

(N.D. Ill.) *aff'd*, 188 F.2d 611 (7th Cir. 1951), *cert. denied*, 342 U.S. 829 (1951). Stein v. Rosenthal, 103 F. Supp. 227 (S.D. Cal. 1952), *aff'd*, 205 F.2d 633 (9th Cir. 1933) ("intention" test rejected); Stein v. Benaderet, 109 F. Supp. 364 (E.D. Mich. 1952) ("intention" test reinstated; *Rosenthal* rejected); Stein v. Mazer, 111 F. Supp. 359 (D.C. Md. 1953), *rev'd*, 204 F.2d 472 (4th Cir. 1953), *aff'd*, 347 U.S. 201 (1954).

In Note, *Copyrighting Works of Artistic Craftsmanship Embodied in Articles of Practical Use*, 27 IND. L.J. 130 (1951), at 131, the writer is of the view that Regulation 202.8 indicates the extension of protection to all works of artistic craftsmanship even though embodied in an article of more than incidental utilitarian value.

For an excellent treatment of the factor of utility and its relation to applied designs, see Pogue, *supra* note 21 at 20–30.

[30] Bleistein v. Donaldson Lithographing Co., 188 U.S. 239 (1903). Pogue, *supra* note 21, at 21–22, citing sample case authority states: "In practice the Copyright Office has not followed this approach, and it has refused to deny registration merely because of the possible utilitarian aspects of an article. Thus, registration has been granted for stained glass windows, bas-relief bronze doors, sculptured book-ends, candlestick holders, sanctuary lamps, paperweights, automobile radiator caps, and savings banks. In each case registration was granted because the article was basically a work of art; the Register of Copyrights simply ignored the presence of the utilitarian aspects in determining whether there was proper subject matter for copyright."

[31] 2 Fed. 217 (S.D.N.Y. 1880). [32] 34 F. 2d 291 (E.D.N.Y. 1929).

"painting, drawing, sculpture," and it cited the *Rosenbach* decision as support for its view,[33] disregarding the fact that since *Rosenbach*, the "fine arts" proviso of the 1870 Act had been deleted by the 1909 law.

The blow dealt by the *Kemp* decision to the fashion industry was immeasurably aggravated by the famous case of *Cheney Brothers v. Doris Silk Corporation*,[34] also decided the same year. The plaintiff in that case was a manufacturer of silks and brought suit on grounds of copyright infringement of a design. After holding the designs incapable of a copyright and agreeing as to the impracticality of a design patent, the court went on to deny the requested relief on grounds of unfair competition as well.

The courts have compounded the error in *Kemp* throughout the years following,[35] finally culminating in 1949 in the *Verney* decision [36] wherein the plaintiff alleged an infringement of his copyright of a design for use upon textiles. Here, by registering under the "commercial print or label" category,[37] the plaintiff hoped to prevail. The court held that "print" as defined in the Copyright Office Circular Number 46 (March 18, 1941) precluded plaintiff from relief, since he printed the design *on* the fabric and it was used as part of the article to be sold and not merely in connection with its sale or advertisement.[38] As an afterthought, or perhaps by

[33] *Id.* at 292.

[34] 35 F.2d 279 (2d Cir. 1929).

[35] Statements in accord with the view in *Kemp*, to the effect that articles of wearing apparel are not works of art, may be found in Nat Lewis Purses v. Carole Bags, 83 F.2d 475, 476 (2d Cir. 1936); White v. Leanore Frocks, 120 F.2d 113, 114–15 (2d Cir. 1941); Belding Heminway Co. v. Future Fashions, 143 F.2d 216, 218 (2d Cir. 1944).

[36] Verney Corporation v. Rose Fabric Converters Corporation, 87 F. Supp. 802 (S.D.N.Y. 1949).

[37] Act of July 31, 1939, 53 STAT. 1142, added to § 5: "including prints or labels used for articles of merchandise." 17 U.S.C. § 5(k) (1952).

[38] In the *Verney* decision, *supra* note 36, at 804, the court quoted the text of COPYRIGHT OFFICE CIRCULAR No. 46 of March 18, 1941: "The term 'print' as used in the said Act may be defined as an artistic work with or without accompanying text matter published in a periodical or separately, *used in connection with the sale or advertisement of an article or articles of merchandise.*" (Emphasis supplied.)

way of justifying its decision, the court held the copyright invalid in any case due to the absence of a copyright notice, an omission of which plaintiff was unquestionably guilty.[39]

The unreceptive attitude of the courts through the years has forced the fashion industry to resort to other avenues of approach (discussed *infra*) to the solution of design piracy. It is only very recently that new hope in this area has begun to filter through, primarily as a result of two cases decided in 1955. *Rushton v. Vitale* [40] involved a suit for copyright infringement of a doll in the form of a chimpanzee. This toy was marketed after a considerable expenditure of time, effort, and money "to fulfill a seasonal demand created by the Howdy Doody television program, on which a chimpanzee named Zippy appears." [41] In granting relief on grounds of infringement of a valid copyright, the court made the statement:

> Copyright protection extends to any production of some originality and novelty regardless of its commercial exploitation or lack of artistic merit.[42]

Though the fashion industry may bristle at being forced to seek the umbrage of a judicial statement so pregnant with deprecatory implications concerning "lack of artistic merit," the legal argument in its favor would be clearly a fortiori. The *Trifari* case,[43] decided in the fall of 1955, subsequently to *Rushton*, is even more favorable. In that case the plaintiff, owner of a copyright on the designs of certain pieces of costume jewelry, moved for a preliminary injunction to restrain infringement. Though validity of the copyright was put in issue on three grounds, *viz.*, lack of originality, inadequate notice, and general ineligibility as "art," it is only the last issue that is pertinent. With respect thereto, the court said:

[39] *Ibid.*
[40] 218 F.2d 434 (2d Cir. 1955).
[41] *Id.* at 435.
[42] *Ibid.*
[43] Trifari, Kressman and Fishel v. Charel Co., 134 F. Supp. 551 (S.D.N.Y. 1955).

Simply because it [costume jewelry] is a *commonplace fashion accessory,* not an expression of "pure" or "fine" art *does not preclude a finding that plaintiff's copyrighted article is a "work of art" within the meaning . . . of the Act.*[44] [Emphasis supplied.]

In discussing the issue of originality the court remarked:

The copyrighted matter need not be strikingly unique or novel. All that is needed is that the author contribute more than a merely trivial variation, *something recognizably his own.*[45] [Emphasis supplied.]

It would not be inaccurate to say that a "Dior," a "Balenciaga," or an "Ann Fogarty" creation carries the same distinctive individuality and prestige in the world of fashion apparel as "Trifari" enjoys in jewelry.

Clearly the *Trifari* case is as close as any lawyer can ever hope to get without turning up a decision "on all fours." Nor is the *Trifari* case a judicial accident. It was born of an inexorably expanding interpretative policy on the part of the United States Copyright Office—an interpretation which the courts could ignore no longer. Indeed, the decision was foretold as far back as 1949.[46] The hope it stirred in the industry received wide circulation in the press [47] and already legal action is pending which may culminate in the long-sought-for solution.[48] It should be noted, regardless of the

[44] *Id.* at 553. [45] *Ibid.*

[46] Warner, *Copyrighting Jewelry,* 31 J. PAT. OFF. SOC'Y 487 (1949) at 489: "I cannot see why if a book end or an ash tray can be a work of art, it is impossible for a piece of jewelry to be a work of art." (Warner was the Register of Copyright at the time the article was written.)

[47] N.Y. Times, Oct. 9, 1955, § 3, p. 1, col. 8:

"For the first time, a manufacturer has used a copyright of a fashion accessory item—an article of costume jewelry—to win a court injunction restraining a competitor from marketing a copy of his product.

"The decision does not apply directly to fashions in wearing apparel. Federal copyright authorities . . . take the position that while the recent court decision has now upheld their policy of granting a copyright for the design of a piece of costume jewelry as a valid work of art, legislative clarification will be required before other fashion creations can be copyrighted."

[48] N.Y. Times, Oct. 26, 1955, p. 48, col. 2, reported that four leading Paris houses of fashion (Dior, Fath, House of Lanvin, House of Patou) are suing a New York designer for $1,350,000 for selling sketches of their collections within five days after the showing in Paris. The defendant operates a sketch service for manufacturers in the United States.

outcome of action initiated by the industry, that the Copyright Office may at its own volition provide the relief.[49]

THE DESIGN PATENT STATUTE

No attempt is made at a detailed study of this statute. Rather it is this writer's intention to show why it does not provide the fashion industry with a workable solution. Examination of the statute reveals the pertinent class of patentable subject matter to be "a new, original, and ornamental design for an article of manufacture." [50] Viewed as such, no problem appears to exist. However, the crucial words are: "new" and "original," and, taken together with the requirement that a patent meet the test of "invention," [51] a problem of immense proportion looms up.

On the question of "originality" and "invention" inherent in an article of fashion with respect to design patents, courts are in definite accord that most of them just do not meet the test, whether the article be ladies' handbags,[52] or dresses.[53]

[49] 17 U.S.C. § 5 (1952). ". . . the above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title. . . ."

[50] 35 U.S.C. § 171 (1952).

[51] It has been said that application of the standards of invention of mechanical patents to design patents was accidental, and not Congress's intent. Nevertheless, it is well settled today. See, *e.g.*, Western Electric Mfg. Co. v. Odell, 18 Fed. 321 (N.D. 1883) at 322: "'It is now tolerably well settled that design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originative faculty'"; Steffens v. Steiner, 232 Fed. 862 (2d Cir. 1916). A design patent for a cigar band was held void for want of invention.

[52] Nat Lewis Purses, Inc. v. Carole Bags Inc., 83 F.2d 475 (2d Cir. 1936) at 476: ". . . the same exceptional talent that is required for a mechanical patent"; Gold Seal Importers v. Morris White Fashions Inc., 124 F.2d 141 (2d Cir. 1941) at 142: "The bag of the patented design has a uniqueness of appearance and an aesthetic appeal not found in any prior patent or publication. But it is not enough for patentability to show that a design is novel, ornamental and pleasing in appearance. As this court has often said, particularly in recent years, 'it must be the product of invention'; that is, the conception of the design must require some exceptional talent beyond the range of the ordinary designer familiar with the prior art."

[53] White v. Leanore Frocks, 120 F.2d 113 (2d Cir. 1941) at 114: "The validity of a design patent depends upon the same factors as that of a

Indeed, in several of these cases the court expressly views a design patent as inappropriate to the needs of fashion designers.[54] Nor are the courts alone of this view.[55] Moreover, even if validity of the design patent is conceded or not in issue, the difficulties of proving infringement are formidable if not altogether impossible in the case of garments and other articles of fashion.[56]

Aside from purely legal hurdles, the design patent approach offers practical difficulties in that the time element is a serious stumbling block. Before a patent will issue, a search of the "prior art" is needed. This may easily take several months. Due to the ephemeral nature of fashion designs, the subject of a sought-for design patent may consequently have little or no commercial value by the time a design patent is finally granted. Patent Office procedure is complex and expensive. No one enters the realm of patents without a well-paid patent attorney for a guide,[57] whereas a copyright can

mechanical patent." In Belding Heminway Co. v. Future Fashions Inc., 143 F.2d 216 (2d Cir. 1944), the court held that design patent is not valid unless it is a wide departure from the prior art.

[54] Nat Lewis Purses, Inc. v. Carole Bags Inc., 83 F.2d 475 (2d Cir. 1936) at 476: ". . . perhaps new designs ought to be entitled to a limited copyright." White v. Leanore Frocks, 120 F.2d 113 (2d Cir. 1941) at 114: "[This case] is the latest, and presumably the last, effort of dress designers to get some protection against what they call the 'piracy' of their designs. We fear that their hope will prove illusory; there is little chance that valid design patents can be procured in any such number as to answer their demand. What they need is rather a statute which will protect them against the plagiarism of their designs. . . . Recourse to the courts, as the law now stands, is not likely to help them"; Belding Heminway Co. v. Future Fashions Inc., 143 F.2d 216 (2d Cir. 1944) at 218: "Apparently what the makers of women's dresses really need is that copyright protection, which Congress has hitherto denied them."

[55] *Cf.* Derenberg, *Copyright No-Man's Land: Fringe Rights in Literary and Artistic Property*, in 1953 COPYRIGHT PROBLEMS ANALYZED 215, 257.

[56] See Callman, *Style and Design Piracy*, 22 J. PAT. OFF. SOC'Y 557 (1940). The difficulties of establishing infringement in fashions are considerable as viewed by the writer at 557: ". . . more usually than not an 'original' fashion creation is but a very slight modification of a known idea, and . . . such a slight modification may be of tremendous commercial value to the creator manufacturer."

[57] For procedure relating to design patents, see SHOEMAKER, PATENTS FOR DESIGNS 270–301 (1929).

be gotten by anyone without counsel or large expense. The author merely publishes the work with a copyright notice attached to each published copy. He then deposits two copies with the Copyright Office, which makes a cursory examination concerning the copyrightability of the subject matter. If an affirmative finding is made, the certificate of registration is issued. Clearly, the design patent approach is not suitable.[58]

## THE TORT OF UNFAIR COMPETITION

The fashion industry has not relied solely on the copyright theory. Turning to the common law tort of unfair competition, the designers again took up the battle—and again without success.

### THE ELEMENTS OF THE TORT

Simply stated, unfair competition (in this area of imitation) is directed against the copying of a competitor's products in such a manner that their sale to the public by the copyist would actually amount to "passing off" his product as that of the manufacturer of the original. Even if the action of the imitative competitor does not actually amount to such "passing off," he may nevertheless be restrained under unfair competition if his sale of the copied article serves to confuse the public as to the *source* of the article. Such confusion is often due to a "secondary meaning" which the original article had acquired during the prior years when it was exclusively manufactured by the original manufacturer, and as a consequence, had become associated with him.

Judicial literature on the subject is profuse, and examples of "passing off" and "secondary meaning" are numerous. Thus, for example, slavish imitations of a manufacturer's

[58] For a general discussion of the problem, see Dahn, *Designs—Patents or Copyrights?*, 10 J. PAT. OFF. SOC'Y 297 (1928).

coffee mills,[59] Christmas editions of books,[60] locks,[61] tanked acetylene gas, [62] and auto tools, [63] have been enjoined as examples of unfair competition under the "passing off" theory. However, not all who seek relief under this theory obtain it,[64] and to date no case involving dress designs has

[59] Enterprise Mfg. Co. v. Landers, Frory and Clark, 131 Fed. 240 (2d Cir. 1904). At 241 the court states the doctrine: ". . . a court of equity will not allow a man to palm off his goods as those of another . . . by simulating the collocation of details of appearance by which the consuming public has come to recognize the product of his competitor."

[60] E. P. Dutton and Co. v. Cupples, 117 App. Div. 172, 102 N.Y. Supp. 309 (1st Dep't 1907). Plaintiff had put out "Christmas editions" of books and defendant had "reproduced plaintiff's books as faithfully and exactly as could be done by photography." On the theory that the public was deceived into thinking it was buying plaintiff's books, *held:* Unfair competition.

[61] Yale and Towne Mfg. Co. v. Adler, 154 Fed. 37 (2d Cir. 1907). A manufacturer of locks intentionally copied a higher priced lock of plaintiff's in form, size, finish, etc., so that the two were substantially identical in appearance to a casual observer who would be likely to mistake one for the other. *Held:* Unfair competition, even though lock parts were unpatented.

[62] Prest-O-Lite Co. v. Avery Lighting Co., 161 Fed. 648 (C.C.N.D.N.Y. 1908). Plaintiff had manufactured "Prest-O-Lite" auto gas tanks bearing his trademarks, which he sold to auto owners. When empty, the tanks were exchangeable for full ones at plaintiff's exchange stations. Defendant bought up plaintiff's empty tanks and refilled them with its own gas. *Held:* Unfair competition. The court at 650 denied the defendant "the right to palm off on the public . . . acetylene gas as 'Prest-O-Lite' acetylene gas either in these tanks or others." *N.B.:* Plaintiff had no statutory trade-mark protection. Prest-O-Lite Co. v. Post and Lester, 163 Fed. 63 (C.C. Conn. 1908), involved the same facts as *Avery Lighting*, except here both parties agreed not to use each other's tanks without first obliterating the label, since the court held paper labels pasted over the metallic label were not good enough and that the original label must be obliterated. Prest-O-Lite Co. v. H. W. Bogen, Inc., 209 Fed. 915 (C.C.D. Cal. 1910); Searchlight Gas Co. v. Prest-O-Lite Co., 215 Fed. 692 (7th Cir. 1914); Prest-O-Lite Co. v. Heiden, 219 Fed. 845 (8th Cir. 1915) (all three cases involved the same facts and reached the same decisions as the *Post* and *Lester* cases). *N.B.:* These cases have elements of "palming off" as well as of the "free ride" on plaintiff's business system.

[63] Stewart v. Hudson, 222 Fed. 584 (E.D. Pa. 1915). Plaintiff invented an auto tool (patent pending) and had built up a market for it. Defendant started making a tool almost identical with plaintiff's. *Held:* Unfair competition—the public was deceived. The court at 587 limited the effect of its ruling to "enjoining the defendant from selling or advertising such make of the tool . . . as may be imposed upon intending purchasers as the make of the plaintiff."

[64] Clipper Belt Lacer Co. v. Detroit Belt Lacer Co., 223 Mich. 399, 194 N.W. 125 (1923). Defendant sold carded belt-lacing hooks spaced like the un-

been decided (either favorably or adversely) on precisely this issue, despite the mass of decisions in this area.[65] Undoubtedly this is because copyists proudly concede that their wares *are copies*, or what they choose to term, "exclusive reproductions." Consequently no "passing off" issue arises.

On the theory of "secondary meaning," courts have been rather reluctant to grant relief, refusing to see a case of "secondary meaning" in chocolate drinks,[66] steering wheel knobs,[67] handbags,[68] wrenches,[69] ladies' compacts,[70] and toy machine

patented hooks manufactured and sold by the plaintiff for use with plaintiff's patented belt-lacing machines (these machines were sold by plaintiff at no profit to enlarge the market for hooks). *Held:* No unfair competition.

[65] See, *e.g.*, Estate Stove Co. v. Gray and Dudley Co., 41 F.2d 462 (6th Cir. 1930), *vacated by* 50 F.2d 413 (6th Cir. 1930) (stove in music cabinet form); Harvey Hubbell, Inc. v. General Electric Co., 262 Fed. 155 (S.D.N.Y. 1919) (electrical contact devices).

[66] Krem-Ko Co. v. R. G. Miller and Sons, 68 F.2d 872 (2d Cir. 1934). Plaintiff was the manufacturer of a chocolate drink distributed in its patented bottle. Defendant sold *its* chocolate drink in plaintiff's bottle after first grinding off plaintiff's name and used different cups. After holding the patent on the bottle invalid, the court *held:* No unfair competition, since there was no "secondary meaning" in plaintiff's bottle.

[67] Sinko v. Snow-Craggs Corp., 105 F.2d 450 (7th Cir. 1939).

[68] Lewis v. Vendome Bags, Inc., 108 F.2d 16, 18 (2d Cir. 1939):

"Merely copying an article unprotected by patent, copyright or trademark does not establish unfair competition, unless the article or its design has a secondary meaning. . . . Nor does the fact that bags of the appearance of exhibit 3 have become popular as a result of the plaintiff's advertising make the defendant's duplication of them a tort. Since . . . the findings of fact do not establish any passing off of the defendant's bags or those of the plaintiff's. . . ." *Held:* No unfair competition.

[69] Crescent Tool Co. v. Kilborn and Bishop Co., 247 Fed. 299 (2d Cir. 1917). Plaintiff was the manufacturer of an adjustable wrench of a new and original shape ("crescent shape"). Defendant started to make and sell a wrench similar in design and shape. *Held:* No unfair competition. In answer to the critical question (". . . whether the public is moved in any degree to buy the article because of its source . . ."), the court was of the opinion that the wrench did not indicate a source or have an inherent "secondary meaning."

[70] Mavco Inc. v. Hampden Sales Ass'n., 273 App. Div. 297, 77 N.Y.S. 2d 510 (1st Dep't 1948). Plaintiff, a manufacturer of a face powder compact, sought to restrain (on a theory of unfair competition) the defendant from selling a compact which was similarly "gem-cut" "in design." *Held:* No unfair competition (absence of "palming off" or "secondary meaning"). The court stated at 305 (77 N.Y.S. 2d at 518): "the mere copying of a style, unprotected by patent or by statutory trade mark . . . does not in and of itself entitle the original designer to protection unless that copying is accompanied by conduct or circumstances constituting unfair competition."

guns.[71] Nor has the "secondary meaning" doctrine been restricted to mechanical articles.[72] Again, no case involving *dress designs* has been decided on this precise point. This is not surprising, for the fleeting nature of fashions negates the assumption of the acquisition of a "secondary meaning." However, in view of the case of *Lewis v. Vendome Bags,*[73] the "secondary meaning" doctrine in the area of fashion is of doubtful utility.

In decisions on this type of case courts often express the opinion that it is the copying of "non-functional" features that results in unfair competition, as discussed *supra.*[74] Does this imply that the copying of the *functional* features *only,* will *never* result in unfair competition, even though it would ordinarily fall within the two theories already mentioned? In *Crescent Tool,*[75] Judge Learned Hand views "non-functional" unfair competition as merely an instance of the doctrine of " 'secondary' meaning" [76] and rightly so. He states:

[71] Unique Art Mfg. Co. v. T. Cohn, Inc., 81 F. Supp. 742 (E.D.N.Y. 1949), *aff'd,* 178 F.2d 403 (2d Cir. 1949). The case involved a toy machine gun manufactured by plaintiff and copied by defendant. *Held:* No unfair competition in the absence of "palming off" and "secondary meaning."

[72] See, *e.g.,* Shredded Wheat Co. v. Humphrey Cornell Co., 250 Fed. 960, 966 (2d Cir. 1918) (breakfast cereal); Upjohn Co. v. Wm. S. Merrell Chemical Co., 269 Fed. 209 (6th Cir. 1920) (pharmaceutical preparations).

[73] See note 68 *supra.*

[74] Rushmore v. Badger Brass Mfg. Co., 198 Fed. 379 (2d Cir. 1907). In this case, involving the copying of auto lamps, the court said at 380: "When it appears that a competitor has unnecessarily and knowingly imitated his rivals' goods in non-functional features, a court of equity is justified in interfering. Further than this we do not intend to extend the doctrine." For cases where a "non-functional" feature was copied, see Globe Wernicke Co. v. Fred Macey Co., 119 Fed. 696 (6th Cir. 1902) (sectional bookcases); Lovell-McConnell Mfg. Co. v. American Ever-Ready Co., 195 Fed. 931 (2d Cir. 1912); Wesson v. Galef, 286 Fed. 621 (S.D.N.Y. 1922).

For cases where a "functional" feature was copied without liability see Marvel Co. v. Pearl, 133 Fed. 160 (2d Cir. 1904) (rubber bulb syringes); Hamilton Mfg. Co. v. Tubbs Mfg. Co., 216 Fed. 401 (C.C.W.D. Mich. 1908) (type cases); Keystone Type Foundry v. Portland Pub. Co., 186 Fed. 690 (1st Cir. 1911) (printing type); Pope Automatic Merchandising Co. v. McCrum-Howell Co., 191 Fed. 979 (7th Cir. 1911) (suction cleaners).

[75] Crescent Tool Co. v. Kilborn and Bishop Co., 247 Fed. 299 (2d Cir. 1917).

[76] *Id.* at 300.

The proper meaning of the phrase "non-functional" is only this: That in such cases the injunction is *usually* confined to non-essential elements, since these are usually enough to distinguish the goods, and are the least burdensome for the defendant to change.[77] [Emphasis supplied.]

The *probable implication* is that the unusual case of "functional" copying would receive the same treatment as those involving "non-functional" features. If this were *not* so, then textile and dress designers might conceivably have a peg upon which to hang a cause of action in unfair competition.[78]

OTHER RELIEF UNDER THE TORT ACTION

Theoretically at least, the fashion industry may obtain relief sounding in unfair competition under very limited and prescribed conditions unrelated to the "passing off" and "secondary meaning" doctrines. Part of the general body of the common law of unfair competition allows relief where the copyist, *by his acts of copying*, actually appropriates the *business system* of his competitor. Thus relief has been granted where a defendant disrupted plaintiff's trading stamp system.[79] Similar relief was granted in the "tanked gas" cases [80] where the defendant used the plaintiff's empty con-

[77] *Id.* at 301.

[78] Weikart, *Design Piracy*, 19 IND. L.J. 235 (1944) at 241: "A textile design or dress design probably cannot be considered to be a functional part of the finished textile or dress, though the more emphasis that is placed on style and appearance, *the closer the design comes to being actually a functional part of the cloth.*" (Emphasis supplied.)

[79] Sperry & Hutchinson v. Louis Weber & Co., 161 Fed. 219 (C.C.N.D. Ill. 1908).

[80] Prest-O-Lite Co. v. Davis, 209 Fed. 917 (S.D. Ohio 1913). At 919 the court stated: "Howsoever far deception . . . might be practiced by an unscrupulous dealer . . . is not directly involved in this controversy, but reflects upon the more subtle form of deception with which the defendants are charged." See also Prest-O-Lite Co. v. Davis, 215 Fed. 349 (6th Cir. 1914); Meyer v. Hurwitz, 5 F. Supp. 370 (E.D. Pa. 1925) *aff'd*, 10 F. 2d 1019 (3rd Cir. 1926) (defendant restrained from copying plaintiff's picture post cards and, in so doing, appropriating plaintiff's distribution system).

Callman, *He Who Reaps Where He Has Not Sown: Unjust Enrichment in the Law of Unfair Competition*, 55 HARV. L. REV. 595, 600–604 (1942).

tainers and refilled them with its own gas. The court's theory was that in so doing the defendant disrupted the plaintiff's exchange system whereby empties would be refilled. Unfortunately, no cases involving the fashion industry have been decided on this point. It is argued that the copyists deprive sellers of original creations of much business every year. While this is undoubtedly true, the test is not the deprivation of business *volume*, but of a business *system*. Until that test is met, no relief can be given.

Of course, apart from all other considerations discussed herein, if the copyist obtains his copies by fraud, deceit, or by inducing a breach of trust or of contract, the injured party may obtain relief. Thus, where the plaintiff was in the business of collecting information in regard to the erection of buildings which it sold only to subscribers, and the defendant, for the purposes of resale to its own subscribers, obtained this information unlawfully and dishonestly from plaintiff's subscriber, inducing him to breach his contract with the plaintiff not to reveal the information to competitors, the court granted relief.[81] Unlike other areas in unfair competition, manufacturers of fashion apparel have been markedly successful here. In the leading case of *Montegut v. Hickson, Inc.*,[82] decided in 1917, relief was granted to the plaintiff, a dress designer, where the defendant obtained possession of plaintiff's models by bribing one of plaintiff's employees to secretly give the defendant an opportunity to copy them. The court recognized the right of the defendant to copy, but not to

> obtain plaintiff's trade by resort to fraud and deception practiced upon the plaintiffs at the instigation and hiring of the defendant.[83]

[81] F. W. Dodge Co. v. Construction Information Co., 183 Mass. 62, 65 N.E. 204, 206 (1903). The court said: ". . . private circulation of information or literary composition, in writing or in print, for a restricted purpose is not a publication which gives the public a right to use it."

[82] 178 App. Div. 94, 164 N.Y. Supp. 858 (1st Dep't 1917).

[83] *Id.* at 859.

Similarly, and more recently, in *Cornibert v. Cohen,*[84] the plaintiff, a manufacturer of silk scarfs imprinted with a "football" and "collegiate" design, obtained relief as against a defendant who had gotten the design from former employees of the plaintiff, *even though he obtained it one month after publication.* Again, the court (at page 354) took the position that:

> Defendants had a legal right to copy and to sell as their own creation the exclusive model designed by plaintiff if the model or an inspection was *procured by fair means,* but the defendants had no right to obtain the plaintiff's trade by unfair means. [Emphasis supplied.]

The methods of the design pirates are often unscrupulous and seething with trickery and deceit. Consequently, this avenue of approach may be of some help to fashion creators. However, the burden of proof in such cases must be borne by the designer, not the pirate, and the elements of fraud and deceit are not always readily established.

## THE "TICKER CASES"

Until now, we have examined possible theories of relief under the general body of unfair competition law. In 1876 the courts began to carve out an exception to this general body of law, whereby a plaintiff need not prove the elements already discussed to procure a remedy. These are the "ticker cases." They began in 1876 with *Kiernan v. Manhattan Quotation Telegraph Co.*[85] when the defendant was enjoined from pirating foreign financial news which was gathered by the plaintiff news service at great labor and expense and transmitted to customers. At this stage, the court guardedly chose to peg its grant of relief on the theory that the transmission of its news was merely a "qualified publication." Nearly thirty years later, in the famous *Board of Trade* [86] case, the

[84] 169 Misc. 285, 7 N.Y.S. 2d 351 (1938).
[85] 50 How. Pr. 194 (Sup. Ct. N.Y. 1876).
[86] Board of Trade v. Christie Grain and Stock Co., 198 U.S. 236 (1905).

defendant was again enjoined from using and distributing plaintiff's price quotations. The Supreme Court talked about the right of the plaintiff to keep the work which it has done, or paid for, to itself, but actually based its holding on the fact that the defendant got its information surreptitiously in an undisclosed manner and *presumably* fraudently.[87] Clearly, the Court clung to the façade of the old theories of relief. Apparently it was not yet ready to "lay it on the line." Nor was it ready to do so in a case before it two years later,[88] in which a defendant was restrained from receiving and using quotations of sales made upon the Exchange. There the court, citing *Board of Trade*, based its holding on the *method* of obtaining the quotations, rather than any inherent *right* of the plaintiff in such property.[89]

The decisive opinion was the celebrated case of *International News Service v. Associated Press*,[90] in which two competitive news gathering services were embroiled. The defendant was charged with the pirating of news bulletins gathered by the plaintiff service and released for publication in the newspapers which were under contract to the plaintiff. Here, for the first time, the Supreme Court blandly asserted an inherent property right in uncopyrighted news matter after publication. (The element of defendant's acquisition was not an issue here.) The court said:

> . . . although we may and do assume that neither party has any remaining property interest as against the public in uncopyrighted news matter after the moment of its first publication, it by no means follows that there is no remaining property interest in it as between themselves. . . .
>
> Regarding the news . . . we can hardly 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.[91] [Emphasis supplied.]

[87] *Id.* at 250.
[88] Hunt v. New York Cotton Exchange, 205 U.S. 322 (1907).
[89] *Id.* at 338.
[90] 248 U.S. 215 (1918).
[91] *Id.* at 236.

There was a separate concurrence by Justice Holmes and a dissent by Justice Brandeis.[92]

Clearly, here was a crack in the doctrine through which a variety of plaintiffs sought to squeeze, with the fashion industry in the lead. In the leading case of *Cheney Brothers v. Doris Silk Corporation,*[93] the plaintiff, a manufacturer of silks, sought to prevent the defendant from copying its designs. The plaintiff relied on the *International News Service* case. The court rejected this position in these words:

> Of the cases on which plaintiff relies, the chief is International News Service v. Associated Press. . . . Although that concerned another subject matter—printed news dispatches—*we agree that, if it meant to lay down a general doctrine, it would cover this case;* at least the language of the majority opinion goes so far. *We do not believe that it did.* While it is of course true that the law ordinarily speaks in general terms, there are cases where the occasion is at once the justification for, and the limit of, what is decided. This appears to be such an instance; *we think that no more was covered than situations substantially similar to those then at bar. The difficulties of understanding it otherwise are insuperable.*[94] [Emphasis supplied.]

Thus the application of the *International News Service* case was henceforth rigidly limited to news matter and "situations substantially similar" [95] and not extended to cover any other

[92] *Id.* at 246 and 248 (per Holmes J. at 246): "Property, a creation of law, does not arise from value, although exchangeable—a matter of fact. Many exchangeable values may be destroyed intentionally without compensation. Property depends upon exclusion by law from interference. . . ."

[93] 35 F.2d 279 (2d Cir. 1929).

[94] *Id.* at 280.

[95] See, *e.g.*, National Telephone Directory Co. v. Dawson Mfg. Co., 214 Mo. App. 683, 263 S.W. 483 (1924). Yet the court in this case stated the doctrine *generally*, at 484: "The doctrine [of unfair competition] as thus announced has since, by process of growth, been greatly expanded in its scope to encompass the schemes and inventions of the modern genius bent upon reaping where he has not sown."

Associated Press v. KVOS, Inc., 80 F.2d 575 (9th Cir. 1935), *rev'd for want of jurisdiction*, 299 U.S. 269 (1936). Here, defendant, a radio station, appropriated and used news from three newspapers which subscribed to plaintiff's news service. *Held:* for plaintiff (on basis of *International* case). Twentieth Century Sporting Club, Inc. v. Transradio Press Service, Inc., 165 Misc. 71, 300 N.Y. Supp. 159 (Sup. Ct. 1937). Plaintiff sought to restrain defendant radio

subject matter.[96] This delimitation persists, though the reasons which the court gave in *International News Service* apply with equal force to an aggrieved dress designer, *viz.*, the considerable outlay of time, energy, and money together with the temporal and seasonal nature of the subject matter.[97] Perhaps the illogical refusal of the courts to extend the *International* decision to cover subjects other than news matter is

news service from broadcasting a ringside account of a prize fight from information gained from an actual ringside broadcast to which plaintiff had sold radio rights to the National Broadcasting Company. *Held:* for plaintiff (on basis of *International* case). The court said at 161: "By appropriating or utilizing the whole or the substance of the plaintiffs' broadcast the defendants would be enabled to derive profits from the exhibition without having expended any time, labor, and money for the presentation of such an exhibition. It is to be borne in mind that this exhibition will only be possible as a result of an expenditure of considerable time, labor, and money by the plaintiffs."

[96] Supreme Records, Inc. v. Decca Records, Inc., 90 F. Supp. 904 (S.D. Cal. 1950). In a suit to enjoin the sale of recordings of a musical arrangement of a song previously arranged by the plaintiff, the court in holding for the defendant stated at 908: "I do not believe that the Supreme Court intended the decision in International News Service v. Associated Press . . . to apply to appropriations of a different character. The limitations which other courts have placed upon the case confining it to news gathering only, accords with my own interpretation."

Charles D. Briddel, Inc. v. Alglobe Trading Corp., 194 F.2d 416 (2d Cir. 1952). In denying an injunction to restrain copying of a steak knife set, the dissent of Judge Clark at 422 is of some interest: ". . . no 'likelihood of confusion'—the governing requirement—will ever be accepted as possible unless a strong showing of actual confusion from the persons confused is made. That means that even the rawest copying will not be actionable. And that is new law, as the cases cited in the opinions show.

"I wish I could be as certain as my brethren that a green light to 'free-riders' is of the essence of a competitive society and that we have a duty to carry out this high public policy. But, as my opinions show, I am bothered by troublesome doubts."

[97] Note, *Common Law Property Right in Dress Designs*, 27 VA. L. REV. 230 (1940) at 231: "the decision in the instant case [*Cheney*], though based on sound precedent, indicates a failure to appreciate the seasonal and highly competitive characteristics of the dress designing industry. These factors could quite properly bring the case within the doctrine of *International News Service v. Associated Press.*"

For an illogical argument distinguishing *Cheney* from *International News Service*, see Comment, *Protection of Intellectual Property*, 35 ILL. L. REV. 546, 555 (1941). Concerning the *International News Service* case as adding the doctrine of unjust enrichment to the law of unfair competition, see Callman, *He Who Reaps Where He Has Not Sown: Unjust Enrichment in the Law of Unfair Competition*, 55 HARV. L. REV. 595, 597 (1942).

due to the force of the statements of Holmes and Brandeis. Perhaps the realization that the decision was an error to begin with was also a factor. In *Cheney* the court comes close to admitting this ("the difficulties of understanding it otherwise are insuperable"). If so, then a reversal is in order. Failure either to extend the application of the case or to reverse it flies in the face of a much older precedent (the one having to do with sauce for a goose and a gander). It seems that the best the courts have been able to do for the fashion industry is to cluck their tongues sympathetically as the court did in *Cheney* when it stated:

> True, it would seem as though the plaintiff had suffered a grievance for which there should be a remedy, perhaps by an amendment of the Copyright Law, assuming that this does not already cover the case, which is not urged here. It seems a lame answer in such a case to turn the injured party out of court, but there are larger issues at stake than his redress. Judges have only a limited power to amend the law; when the subject has been confided to a Legislature, they must stand aside, *even though there be an hiatus in completed justice.*[98] [Emphasis supplied.]

Since *Erie Railroad v. Tompkins*,[99] state law of unfair competition has taken on new importance. The hope of the fashion industry in this area hinges on a more liberal development by state courts than that given by federal courts.

### ATTEMPTS AT LEGISLATION

The advice to seek new legislation was "old hat" to the fashion industry. It had been engaged in that fight for years. To place these efforts at legislative reform in proper perspective, a brief look at the development of the modern textile and garment industry and the concurrent growth of the piracy problem would be helpful.

The ready-made apparel industry had its real start just prior to the First World War. By then "store clothes" were no longer a novelty. The important factors in bringing this

[98] Cheney Brothers v. Doris Silk Corporation, 35 F.2d 279, 281 (2d Cir. 1929).
[99] 304 U.S. 64 (1938).

change about were the rise of department stores, mail order houses, the concept of low prices through large stocks, the use of automobiles for "in town" shopping, and the increasing effectiveness of national advertising. The advent of the "career woman" and the impact of the feminists also played an effective role. The new desire for freedom in all social spheres swept aside the prior preoccupations of women in the home and created a demand for the new, the convenient, the fashionable. The end of the war in 1918 brought with it a social reaction to the uniform and a consequent emphasis on and desire for "civvies," luxury, style. The infant industry was in its heyday. After a period of price gouging in 1920, a consequent consumer strike forced prices down. This culminated, in 1921, in the industry's first crisis. Overproduction was estimated at 50 percent and the cause was said to be overabundance of small manufacturing organizations.

The jobber became important at this stage. His function was to buy all the necessary fabrics and supply manufacturers with them on a contract basis for cutting, trimming, and finishing. The garments would be returned to the jobber who sold them to retailers. In 1924, 80 percent of women's apparel was sold by this method.[100] The costs of the jobber were negligible, owing to these factors: competitive bidding by manufacturers, no factory costs, no traveling salesman (merely displays of stocks to retail buyers), and no designing department (exploitation of free lance designers).

It was this jobber system that encouraged design copying. Since free lance designers were commonly "sucked dry" of all their creative ideas by the jobbers and promptly fired, they were forced to peddle the same designs to different jobbers and even to manufacturers. In addition, "hand-to-mouth" buying, *i.e.*, buying for immediate sale, necessitated the carrying of large stocks. As soon as the orders began to pour in, the design pirates were apprised of what was going to

[100] See Weikart, *Design Piracy*, 19 IND. L.J. 235 (1944) at 237 for a detailed account of the industry's development.

"catch on." [101] As the economic importance of the apparel industry has risen, so has the pirate's booty.

An account of the mechanics of pirating designs reads like the diary of an international espionage agent. Since the cost to produce a "single line" (*i.e.*, a collection of fashion garments) may range from $30,000 to $50,000, it is just "clever business" to "cut costs." Rather than employ stylists and send them to the fashion centers of the world for ideas, it is "smarter" to copy the creations of those who do undertake this expense. The copyist may either buy dresses from retailers (who bought them from original creators), or visit showrooms and take written or mental notes, or obtain secret sketches or photographs. Many bribe employees of original creators to get samples or at least an opportunity to copy them.[102]

The evil effects of piracy were fairly stated in the *Filene* case.[103]

> Copying destroys the style value of dresses which are copied. Women will not buy dresses at a good price at one store if dresses which look about the same are offered for sale at another store at half those prices. For this reason, copying substantially reduces the number and amount of reorders which the original creators get. With this uncertainty with respect to reorders, original creators cannot afford to buy materials in large quantities as they otherwise would. This tends to increase the cost of their dresses and the prices at which they must be sold.
>
> Reputation for honesty, style, and service is an important asset of retailers. Copying often injures such a reputation. A customer who has bought a dress at one store and later sees a copy of it at another store at a lower price is quite likely to think that the retailer from whom she bought the dress lacks the ability to select distinctive models and that she has been overcharged. Dresses are returned and customers are lost.

[101] *Id.* at 238–239 for a general discussion of this area. See also, NYSTROM, THE ECONOMICS OF FASHION (1928).

[102] Wm. Filene's Sons Co. v. Fashion Originators' Guild of America, 90 F.2d 556, 558 (1st Cir. 1937). N.Y. Times, June 18, 1955, p. 15, col. 3.

[103] *Id.* at 558.

Apart from effect on the fashion industry, piracy has a deleterious effect on the designing profession.[104]

Against this backdrop of activity it was small wonder that the agitation for legislation became increasingly noticeable. The efforts of the industry in this direction began in 1914, and throughout the twenties no less than thirty-two bills were introduced into Congress.[105] Of these, five were reported out

[104] GOTSCHAL AND LIEF, THE PIRATES WILL GET YOU 30 (1945): "Fresh from a visit to the Paris industrial arts exposition, a commission appointed by Secretary of Commerce Hoover reported that Paris abounded in designs for textiles, leather, jewelry, etc., and 'France is never short of craftsmen,' whereas American schools were handicapped because they did not lead to a career. 'As a nation, we now live artificially on warmed-over dishes. . . . The modern movement in industrial art, if approached intelligently and courageously by American manufacturers, may well be the means by which our country will achieve a larger measure of artistic independence.' They said that the evils of design piracy, 'so strongly prevalent with us,' presented 'a very strong argument' for copyright protection such as the Vestal bill would give."

[105] H.R. 11321, 63d Cong., 2d Sess. (1914), by Hon. W. A. Oldfield.
H.R. 18223, 63d Cong., 2d Sess. (1914), by Hon. W. A. Oldfield (amended bill).
H.R. 6458, 64th Cong., 1st Sess. (1915), by Hon. W. A. Oldfield.
H.R. 14666, 64th Cong., 1st Sess. (1916), by Hon. M. A. Morrison.
H.R. 17209, 64th Cong., 1st Sess. (1916), by Hon. M. A. Morrison.
S. 6925, 64th Cong., 1st Sess. (1916), by Hon. Thomas Taggart.
H.R. 20842, 64th Cong., 2d Sess. (1917), by Hon. M. A. Morrison.
H.R. 10028, 65th Cong., 2d Sess. (1918), by Hon. C. B. Smith.
S. 2601, 68th Cong., 1st Sess. (1924), by Hon. Arthur Clapper.
H.R. 7539, 68th Cong., 1st Sess. (1924), by Hon. A. H. Vestal.
H.R. 10351, 68th Cong., 2nd Sess. (1924), by Hon. A. H. Vestal (bill drafted by T. Solberg, Register of Copyright).
H.R. 13117, 69th Cong., 1st Sess. (1926), by Hon. A. H. Vestal. See favorable report in H.R. Rep. 1521, 68th Cong., 2d Sess. (1925).
H.R. 9358, 70th Cong., 1st Sess. (1928), by Hon. A. H. Vestal.
H.R. 13453, 70th Cong., 1st Sess. (1928), by Hon A. H. Vestal.
H.R. 7243, 71st Cong., 2d Sess. (1929), by Hon. A. H. Vestal (same as H.R. 9358 amended).
H.R. 7495, 71st Cong., 2d Sess. (1929), by Hon. W. I. Sirovich. "Any person who created or is the author of any creation, style, and/or design may secure copyright."
H.R. 11852, 71st Cong., 2d Sess. (1930), by Hon. A. H. Vestal (passed House July 2, 1930).
H.R. 11852, 71st Cong., 2d Sess. (1930), in Senate July 3, 1930. Senate Committee hearings Jan. 1, 1931.
H.R. 138, 72d Cong., 1st Sess. (1931), by Hon. A. H. Vestal.
S. 2678, 72d Cong., 1st Sess. (1931), by Hon. Felix Hebert.
H.R. 12897, 72d Cong., 1st Sess. (1932), by Hon. W. I. Sirovich.

of committee,[106] one passed the House,[107] and one passed the Senate.[108] Since then Congressional activity on the subject has been negligible.[109]

### THE VESTAL BILL

The bill that almost became a law was the Vestal Bill.[110] It provided for registration by any citizen of the United States "who is author of any design as hereinafter defined or the legal representative or assignee of said author." An "author" was defined as "one who originates a design and in so doing contributed intellectual effort to the composition thereof." [111] The definition of a "design" was more elaborate:

> . . . pattern . . . shape, or form of, a manufactured product, or dies, molds, or devices by which a pattern, shape or form may be produced, original in its application to or embodiment in such manufactured product and which produces an artistic or ornamental effect or decoration, but [it] shall not include shapes or forms which have merely a functional or mechanical purpose.[112]

Section 3 of the bill, later to become a focal point of opposition, provided:

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S. 5057, 72d Cong., 2d Sess. (1932), by Mr. Hastings for Hon. Felix Hebert.
S. 241, 73d Cong., 1st Sess. (1933), by Hon. F. Hebert (Same as S. 5075).
H.R. 4115, 73d Cong., 1st Sess. (1933), by Hon. W. I. Sirovich (same as S. 241).
H.R. 7359, 73d Cong., 2d Sess. (1934), by Hon. T. A. Peyser.
S. 3166, 73d Cong., 2d Sess. (1934), by Hon. G. P. Nye.
S.J. Res. 120, 73d Cong., 2d Sess. (1934), by Hon. J. F. Byrnes.
H.R. 5859, 74th Cong., 1st Sess. (1935), by Hon. W. I. Sirovich.
S. 3208, 74th Cong., 1st Sess. (1935), by Hon. A. Lonergan.
H.R. 8099, 74th Cong., 1st Sess. (1935), by Hon. T. O'Malley.
S. 3047, 74th Cong., 1st Sess. (1935).

[106] H.R. 9358, 70th Cong., 1st Sess. (1928); H.R. 7243, 71st Cong., 2d Sess. (1929); H.R. 11852, 71st Cong., 2d Sess. (1929); H.R. 138, 72d Cong., 1st Sess. (1931); H.R. 8099, 74th Cong., 1st Sess. (1935).

[107] H.R. 11852, 71st Cong., 2d Sess. (1929), passed the House July 2, 1930.

[108] S. 3047, 74th Cong., 1st Sess. (1935), passed the Senate July 29, 1935.

[109] *Hearings Before Subcommittee On Patents, Trade-Marks and Copyrights*, H.R. 2860, 80th Cong., 1st Sess. (1947). A bill to provide protection for designs for textile fabrics. An article in N.Y. Times, October 9, 1955, § 3, p. 1, col. 8, hints that new legislation is pending.

[110] H.R. 9358, 70th Cong., 1st Sess. (1928), introduced by Hon. A. H. Vestal (the "Vestal Bill").

[111] *Id.* § 1(a). [112] *Id.* § 1(b).

As prerequisite to copyright protection under this act the author or his legal representative or his assignee must (1) *actually cause the design to be applied to or embodied in the manufactured product.* . . . [Emphasis supplied.]

The bill further provided that the certificate of registration was to be prima facie evidence of the date of the copyright, that the period of protection was to extend for two years with an eighteen month extension, and infringement was to be found in a

. . . colorable imitation of the copyright design or of any characteristic original feature thereof in manufactured products of the same class, or any similar product; or selling or publicly distributing *or exposing for sale any such product embodying such a colorable imitation.*[113] [Emphasis supplied.]

The opposition was both instantaneous and bitter, and its targets were sections 3 and 8. The attack on section 8 as it had existed in a previous draft of the bill was based on the injustice of shifting the risk of innocently infringing to the retailer.[114] The keenness of this argument had been somewhat blunted by the insertion of the following into section 8:

If such sale or public distribution or exposure for sale or public distribution is by anyone other than the manufacturer of the copy or colorable imitation, it shall be unlawful only as to goods purchased after actual notice in writing that the design is copyrighted.[115]

[113] *Id.* § 8.

[114] *Hearing Before Committee on Patents,* H.R. 9358, 70th Cong., 1st Sess. (1928), at 25:

*Mr. Hahn* (Managing director of the National Retail Dry Goods Association): ". . . there is a tremendous element of design included in the stocks of these stores. Now I want to know if you gentlemen can tell me how it would be possible under this act . . . for any retailer or any buyer for a retail institution to go into a market and look at hundreds of lines of varying goods and know that he has the right to buy this particular thing which carried this particular design."

*Mr. Lanham:* "In other words, you think it would be misplaced responsibility?"

*Mr. Hahn:* "I think so. And I do not think you can place it anywhere except on the retailer."

[115] H.R. 9358, 70th Cong., 1st Session, § 8 (1928).

The effect of this section was to prevent a retailer from reordering those designs concerning which he had received a notice of infringement. If he were able to tell whether or not they were in fact infringements, he could reorder with immunity. Since the average retailer did not maintain the staff of design experts necessary for the making of this decision, he reordered at his own risk.

The attack on section 3 crystallized at a later hearing,[116] on the grounds that this section shifted protection from the author to the manufacturer-owner, since for an author to secure protection the author "must actually cause the design to be applied to or embodied in the manufactured product." [117] Thus a designer needed a manufacturer-patron. Bitter opposition by organized retail associations (*e.g.*, The National Retail Dry Goods Association) in this and subsequent hearings [118] was sufficient to prevent the enactment of a design copyright bill into law, although it did manage to pass the House.[119] In the Senate, however, the bill died a lingering death.[120] Thus ended the attempts to procure legislation.

### BY THEIR OWN BOOTSTRAPS

Rebuffed by the courts and Congress, the industry looked to its own resources for a solution. Its efforts in this direction took the form of the Fashion Originators' Guild of

[116] *Hearings Before Committee on Patents*, H.R. 7243, 71st Cong., 2d Sess. (1930).

[117] H.R. 9358, 70th Cong., 1st Sess. § 3(1) (1928).

[118] See, *e.g.*, *Hearings Before Committee on Patents*, H.R. 8899, 74th Cong., 1st Sess. (1935).

[119] Passed by the House of Representatives, July 2, 1930.

[120] The bill was referred to a Senate Committee where it was watered down to apply to textiles, laces, embroideries, furniture, lamps and lighting fixtures, shoes, jewelry, *dresses being expressly excluded*. Bitter opposition from these industries *included* was successful in obtaining a further amendment excusing *them* from its operation. From this point, the bill steadily lost prestige and support, and though it passed the Senate on July 29, 1935, it was a tattered remnant of the Vestal proposal. This bill was then referred to a House Committee for study, where it died.

America. Essentially, it was a trade association and its membership was comprised of garment manufacturers and retailers who dealt with and used the products of fashion designers. As an organization, it was dedicated to crush the design pirate. Its methods were rooted in self-discipline imposed upon its members and the retailers to whom they sold. This was done by a "declaration of cooperation" signed by retailers and manufacturers, whereby they pledged to deal *only* in original creations. The Guild had an elaborate detective system to enforce such cooperation and a "piracy committee" which sat when copies and noncooperating members were "put on trial." An extensive design registration bureau containing the designs registered by Guild members was maintained. However, the Guild's most potent weapon was in the form of a little red card. These cards were sent to all members from time to time bearing on their face, the name of a "noncooperating" retailer. Henceforth all other members of the Guild were forbidden to deal with that retailer under penalty of large fines. The textile field also had a registration bureau in the National Federation of Textiles Inc. which affiliated itself with the Guild.

It was not very long before the Guild was embroiled in legal action. In 1935 a "red-carded" retailer operating from a downtown New York city apartment, sought an injunction against the Guild [121] on the grounds that it unreasonably restrained trade and competition in violation of the anti-trust laws. The plaintiff was denied relief.[122] At this point it should be noted that over twelve thousand retailers had signed the pledge and the Guild had 42 percent control of womens' dresses selling for more than $10.95 (and 10 percent of those selling for less). Two years later another "uncooperative" retailer sought to enjoin the Guild on identical

[121] Wolfenstein v. Fashion Originators' Guild of America, 244 App. Div. 656, 280 N.Y. Supp. 361 (1st Dep't 1935).

[122] *Ibid.* The court cited Appalachian Coals, Inc. v. United States, 288 U.S. 344 (1933) in support of its decision.

grounds.[123] After reference to the evils of design piracy, the court refused to find an indictable concentration of economic power as a result of the Guild's activities, being of the opinion that the plaintiff had a "reasonably adequate market outside of the Guild." [124] The court neatly sidestepped a decision of the Federal Trade Commission (made just prior to *this* decision) wherein a "cease and desist" order had been issued against the Guild's counterpart in the millinery field,[125] by distinguishing it on the ground that the latter organization "formed a substantial majority of the originators . . . of high grade millinery for women," [126]—a statement equally apropos (in the field of garments) to the Guild.

It began to seem that fashion designers had at long last found the answer, when the Guild was hit with a "cease and desist" order.[127] This was reviewed and affirmed in an elaborately detailed account of the Guild's activities (which, incidentally, revealed the operation of regional affiliates of the Guild).[128] In a companion review of a "cease and desist" order against similar activities of the Millinery Guild, the Commission stated:

> We believe . . . that concerted action to eliminate style piracy extends beyond the permissible area of industrial self-regulation.[129]

A review of the Commission's order in the Second Circuit resulted in an affirmance,[130] and the Supreme Court closed the

[123] Wm. Filene's Sons Co. v. Fashion Originators' Guild of America, 90 F.2d 556 (1st Cir. 1937).

[124] *Id.* at 562.

[125] In the Matter of Millinery Quality Guild Inc., 24 F.T.C. 1136 (1937).

[126] See note 123 *supra.*

[127] In the Matter of Fashion Originators' Guild of America, Inc., 28 F.T.C. 430 (1939).

[128] Other guilds were: Michigan Avenue Guild of Chicago, Minneapolis Fashion Guild, Ladies Ready-To-Wear Guild of Baltimore, Inc., and National Federation of Textiles, Inc.

[129] Millinery Creator's Guild v. Federal Trade Commission, 109 F. 2d 175, 178 (2d Cir. 1940).

[130] Fashion Originators' Guild of America Inc. v. Federal Trade Commission, 114 F.2d 80 (2d Cir. 1940).

chapter with its pronouncement [131] that the Guild's plan was contrary to the policy of the Sherman Act [132] in that, *inter alia*, it narrowed manufacturers' outlets and retailers' sources of supply, and subjected "uncooperative" retailers and manufacturers to boycotts. Nor could its policy of preventing design piracy suffice as a justification.[133]

## CONCLUSION

As stated previously, a few scattered rays of hope do exist. A more liberal *state* development of the doctrine of unfair competition, a favorable interpretation of section 5(g) of the Copyright Act (entirely possible as a result of the *Trifari* case), and the ever constant hope of invoking the aid of Congress, are all possibilities. Unfortunately the garment and textile industries cannot function on mere possibilities. A concrete approach is needed to supplant these nebulous hopes.

That certain obstacles block the road to legislative reform is conceded. Past hearings have served to highlight the difficulties inherent in drafting the needed legislation. That enforcement of the mechanics of copyright protection presents difficulties (especially with respect to copyright notice and the establishment of infringement), is not denied. That these problems should permanently preclude a continued and forceful advance toward a solution is most emphatically denounced.

Other nations have left this country far behind in providing design protection.[134] The failure of the United States to

[131] Fashion Originators' Guild of America Inc. v. Federal Trade Commission, 312 U.S. 457 (1941).

[132] 26 STAT. 209 (1890), 15 U.S.C. §§ 1–7, 15 (1955).

[133] Fashion Originators' Guild of America v. Federal Trade Commission, 312 U.S. 457, 462 (1941); Millinery Creator's Guild v. Federal Trade Commission, 312 U.S. 469 (1941), was *affirmed* on authority of the *Fashion Originators' Guild* case *supra*.

[134] For a collection of German and Swiss decisions granting relief, see Wolff, *Is Design Piracy Unfair Competition?*, 23 J. PAT. OFF. SOC'Y 431 (1941). *Contra*, Benjamin, *Is Design and Construction "Piracy" Unfair Competition?*, 23 J. PAT. OFF. SOC'Y 862 (1941), which takes issue with Wolff's interpreta-

protect its own has a demoralizing and devastating effect upon the designing profession in America.[135] That irreparable harm in this direction has not already been inflicted is a considerable surprise in view of the continued existence of this legal outrage. This writer, in a final appraisal of the entire situation as it stands at present, finds himself in full accord with the following observation:

> It can certainly be said . . . that a hundred years from now people will look back with amazement on the laws of the nineteen thirties and forties, which refused protection to the non-functional designs of such great designers as Norman Bel Geddes, and yet gave protection to the creators of "Superman" and "Little Orphan Annie."[136]

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tion. See also Note, 1 AM. J. COMP. L. 137 (1952), for discussion of a French case granting relief.

[135] For an account of the effect on the profession, see GOTSCHAL AND LIEF, THE PIRATES WILL GET YOU (1945).

[136] Weikart, *Design Piracy*, 19 IND. L.J. 235, 257 (1944).

# *Publication in the Law of Copyright*

By RICHARD W. ROBERTS

UNIVERSITY OF VIRGINIA LAW SCHOOL

INVENTORS AND AUTHORS, by specific provision of the Constitution, may secure a limited monopoly in the fruits of their intellectual labors. Authors (this includes anyone who creates a "Writing") are the more fortunate of the two: if they follow the instructions of skilled counsel by studiously refraining from registration of their works under the Copyright Act, and by exploiting these works only in carefully selected media, they have the assurance of a perpetual monopoly.

This odd result obtains because of the existence in the United States of a dual system of protection of intellectual property. The common law, which protects the writings of an author before publication, secures to the author a perpetual property right in his work; [1] the Copyright Act, which operates after publication or upon registration of certain unpublished works,[2] permits a fifty-six year maximum protection. In be-

[1] The author's common law right prior to publication has been expressly reserved by the Act: "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor." 17 U.S.C. § 2 (1952).

This section first appeared in the 1909 Act (35 STAT. 1076). A classic statement of the common law rule that before publication the author has a perpetual property right may be found in Donaldson v. Becket, 4 Burr. 2408, 98 Eng. Rep. 257 (H.L. 1774).

[2] 17 U.S.C. § 12 (1952) permits voluntary registration of enumerated unpublished works: lectures, dramatic and musical compositions, motion pictures, photographs, and works registerable under § 5(g), (h), or (i) of the Act.

tween these areas of safety lies a no-man's land: the public domain. The author who publishes (renouncing common law protection) and for some reason fails to register under the Copyright Act (forfeiting statutory protection) is euphemistically said to have "dedicated" his work to the public.[3] But if an author can successfully exploit his work without "publishing" it, he can retain indefinitely the more advantageous common law property in his work.[4]

Reflection on this result invites attention to the policy of the Copyright Act. Lord Mansfield set forth the fundamental problem of copyright in these words:

> We must take care to guard against two extremes equally prejudicial: The one that men of ability, who have employed their time for the service of the community, may not be deprived of their just merits and the reward of their ingenuity and labor; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded.[5]

Congress was given power to plot a course between these two extremes by a briefly worded mandate in the Constitution:

> Art. I . . . Section 8. "The Congress shall have power . . . [clause 8] 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."

"Limited Times" is a vague phrase; Professor Chafee urges that it be defined so as to achieve these objectives:

[3] The terms "abandonment," "dedication," and "forfeiture" are analyzed by Judge L. Hand in National Comics Publications v. Fawcett Publications, 191 F.2d 594 (2d Cir. 1951) at 598.

[4] The rights of an author at common law before publication have been summarized as follows: "The sole, exclusive interest, use, and control. The right to its name, to control, or prevent publication. The right of private exhibition, for criticism or otherwise, reading, representation, and restricted circulation; to copy, and permit others to copy, and to give away a copy; to translate or dramatize the work; to print without publication; to make qualified distribution. The right to make the first publication." Harper & Bros. v. M. A. Donohue & Co., 144 Fed. 491, 492 (C.C.N.D. Ill. 1905).

[5] Sayre v. Moore, 1 East 361 (K.B. 1801), quoted in Eichel v. Marcin, 241 Fed. 404 (S.D.N.Y. 1913), at 410.

. . . (a) for the author, to supply a direct or indirect pecuniary return as an incentive to creation and to confer upon him control over the marketing of his creation; (b) for the surviving family, to give a pecuniary return which will save them from destitution and impel the author to create, *without allowing the family to abuse a prolonged monopoly;* (c) for the publisher, to give a continued pecuniary return which will indirectly benefit the author and yield to the publisher an equitable return on his investment, *but which will not prevent the public from getting easy access to the creation after the author's death.*[6] [Emphasis supplied.]

The manner in which publication is defined bears most directly on the objectives in italics above. If the concept of publication operates to give an author an exclusive right for unlimited times, and thereby to create a monopoly and, incidentally, to prevent public access to his work, then a fundamental reappraisal of publication is not amiss. These results have in fact occurred, chiefly, as will be seen, because of an inflexible judicial application of an outmoded test of publication to new methods of exploiting intellectual property and new media of communication. Today publication is complicated and fragmentized, and operates largely in derogation of the policy of the constitutional clause.

An understanding of the manner in which publication came to occupy the key role in the dual system requires a brief historical review. Prior to the passage of the first English Copyright Act, the Statute of Anne of 1710,[7] the common law protection of literary property had developed around prepublication rights. From 1556 to 1694 a group of London printers, united together as the Stationer's Company, enjoyed a state granted monopoly. Authors were little concerned with what happened to their works after printing, because it was the custom for the printer to buy the manuscript outright. Upon sale, the title of the work was entered in the famous

[6] Chafee, *Reflections on the Law of Copyright: I,* 45 COLUM. L. REV. 503 (1945), at 510–511.

[7] 8 ANNE c. 19 (1710).

Stationer's Register in the printer's name, and the printer thereupon acquired the sole right to make copies. Piracy was quelled by a system of intercompany fines, or by assistance from the Star Chamber if an outsider infringed.[8] Parliament allowed the Stationer's license to expire in 1694. Piracy immediately became widespread. Surreptitious printers, who had been deterred by Star Chamber decrees and Licensing Acts, had little to fear from the common law judges, because of the difficulty of proving damages.[9]

The authors and publishers petitioned Parliament for relief, and finally secured passage of the Statute of Anne in 1710, which granted a fourteen-year monopoly in new works and a twenty-one-year monopoly in old works. The booksellers continued to urge in the courts that the Copyright Act gave a cumulative remedy, but did not affect their old perpetual common law monopoly, even after publication.[10] This issue was resolved in the leading case of *Donaldson v. Becket*,[11] in which the House of Lords held that the Statute of Anne established a dual system, and that although at common law authors had a perpetual property in their works, upon publication the statute became the sole measure of their rights. Whether the court was correct in asserting that prior to the act a perpetual common law property existed in books even *after* the first printing is a matter of some controversy.[12]

[8] BALL, THE LAW OF COPYRIGHT AND LITERARY PROPERTY 9–11 (1944); WITTENBERG, THE PROTECTION AND MARKETING OF LITERARY PROPERTY 20-22 (1937).

[9] BALL, *id.* at 11–12.

[10] Comment, *Copyright: History and Development*, 28 CALIF. L. REV. 620, 630 (1940); Rogers, *A Chapter in the History of Literary Property: The Booksellers' Fight for Perpetual Copyright*, 5 ILL. L. REV. 551 (1911).

[11] 4 Burr. 2408, 98 Eng. Rep. 257 (H.L. 1774), *reversing* Millar v. Taylor, 4 Burr. 2303, 98 Eng. Rep. 201 (K.B. 1769).

[12] The fourth question put to the judges in the *Donaldson* case was this: "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?"

The vote was yes, 7 to 4. In Jefferys v. Boosey, 4 H.L. Cas. 814, 10 Eng. Rep. 681 (1854), two of the Lords expressed doubt on this point. See Lord

A dispute between two Supreme Court reporters culminated in an American decision closely paralleling the *Donaldson* case. In *Wheaton v. Peters*, decided in 1834, the Supreme Court declared that Congress, in passing the original Copyright Acts of 1790 and 1802,[13] had not merely provided a cumulative remedy but had created a new right,[14] and that if an author chose to publish his work, he had to conform to the statutory formalities (and accept the limitations) in order to recover for an alleged infringement. *Wheaton v. Peters* affirmed the existence in the United States of a dual system of protection, with publication as the dividing line, and disposed of the notion that a common law perpetual property right could coexist in the same composition with a statutory copyright limited in time.[15] Once publication became the threshold between private (common law) and public (*i.e.*, dedicated or copyrighted) property, pressures began to build up around the concept of publication. Creators, formerly on their own behalf but now represented chiefly by ASCAP or a corporate member of the mass communications industry, have sought

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Brougham's opinion at 10 Eng. Rep. 738–40; Lord St. Leonard's opinion at 744–5. In Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 657 (1834), the majority questioned the same point.

Justice Holmes, speaking generally, was more emphatic:

"I have often thought of writing about a page on copyright. The notion that such a right could exist at common law or be worked out by it seems to me imbecility. It would be intolerable if not limited in time and I think it would be hard to state a basis for the notion which would not lead one far afield. *Non obstant* the long-winded judgments in the old cases." 1 HOLMES-POLLOCK LETTERS 53 (Howe ed. 1941). See also, Fashion Originators' Guild of America, Inc. v. F.T.C., 114 F.2d 80, 83 (2d Cir. 1940).

[13] 1 STAT. 124 (1790); 2 STAT. 171 (1802).

[14] 33 U.S. (8 Pet.) 591 (1834). The court observed that it was doubtful whether even before publication an author could enjoy a perpetual common law right of printing in Pennsylvania, where the case arose, since the state had adopted selected portions of the common law at a time when the perpetual right was not recognized in England (at 658–60).

[15] See Globe Newspaper Co. v. Walker, 210 U.S. 356 (1908). Expiration of copyright and ensuing dedication to the public is regulated by the Copyright Act, and is thus a federal question. G. Ricordi & Co. v. Haendler, 194 F.2d 914 (2d Cir. 1952).

to expand the scope of common law rights by confining publication to a narrow limit: offering a "copy" for sale. Defendants, accused of infringement, have urged that the policy of the constitutional clause requires a broader meaning for publication, to forestall monopoly and give the public access to created works. Particularly since the *Erie* case,[16] the importance of state law definitions of publication has been magnified, raising an issue of the distribution of state and federal power.[17] For example, in a recent case, *Capitol Records, Inc. v. Mercury Records Corp.*,[18] the Second Circuit upheld a state definition of publication which appears to contravene previous federal common law definitions of publication [19] and the constitutional clause itself.[20] This issue of federal preemption (to be discussed *infra*) can be best understood as an outgrowth of the fundamental conflict already suggested between the creators' desire for a perpetual monopoly at common law and the policy of the constitutional clause requiring a limited monopoly. The primary aim of the creators has been to fashion a narrow test of publication, then to urge that acts falling outside this definition do not constitute publishing; hence they declare that the creator retains his common law rights. The manner in which these pressures have operated to produce a narrow and unsatisfactory definition of publication will now be fully discussed.

There is little doubt that what the Supreme Court in the *Wheaton* case and the House of Lords in the *Donaldson* case meant by publication was the reproduction of copies of a

[16] Erie R.R. v. Tompkins, 304 U.S. 64 (1938).

[17] A number of state statutes regulating copyright are collected in HOWELL, THE COPYRIGHT LAW 183–92 (3d ed. 1952). Most regulate unpublished works, and so avoid conflict with federal definitions of publication. See the discussion of § 983 of the California Code, *infra* note 90.

[18] 221 F.2d 657 (2d Cir. 1955).

[19] *Id.* at 664–8.

[20] The positions of both majority and dissent are exhaustively analyzed in Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409 (1956).

written work for sale.[21] While neither the Copyright Act of 1790 nor any of its amendments contains a definition of publication, the phrases "reproduced in copies for sale," and "offered for sale" appear to be used synonymously with "publication" throughout the act.[22] The test of publication which the courts employ today, reflecting adherence to the traditional author-manuscript model, is this: if the author has reproduced copies of his work for sale, or sold the original, or acted toward his work in a manner inconsistent with retention of his property rights, publication results.[23] When applied to intellectual property which is exploited primarily by sale of the original or copies thereof, such as maps, books, paintings, sculpture, and photographs, this traditional test tends to produce results consistent with the constitutional policy; the creator of a novel or painting can only profit from his creation in a substantial way by selling the work or copies, and when he does so he is required to make his bargain with the public by registration of the work under the act, with forfeiture as a penalty.

The traditional test begins to show signs of strain when applied to intellectual productions which are exploited primarily by performance. A dramatic composition, for example, is seldom reproduced in copies for sale; the dramatist depends on repeated performances for his income. There is no question that the dramatist has made his work widely accessible to the public by performance, just as surely as the novelist has by printing up and selling copies of his novel; yet the

[21] That the Statute of Anne was directed toward authors and publishers is indicated by the language of the preamble:

". . . printers, booksellers and other persons have of late frequently taken the liberty of printing, reprinting and publishing . . . books and other writings, without the consent of the authors or proprietors. . . ." 8 ANNE c. 19 (1710). Similarly, article I, § 8, of the Constitution secures to "Authors" the exclusive right to their "Writings."

[22] 17 U.S.C. §§ 10, 12, 26 (1952); see Patterson v. Century Productions, Inc., 93 F.2d 489, 492 (2d Cir. 1937).

[23] Werckmeister v. American Lithographic Co., 134 Fed. 321 (2d Cir. 1904).

courts have declared that performance does not publish.[24]

The traditional test produces even more puzzling results when the problem before the court is an unconventional means of exploiting intellectual property, such as the phonograph record. In a famous early copyright case,[25] the Supreme Court held that a piano-roll (including by implication the phonograph record) was not a "copy" within the meaning of the Copyright Act. Mr. Justice Holmes, in a concurring opinion, saw the point: namely, that mechanical reproduction of music communicates the artist's work to the public just as surely as copies of the sheet music; but rather than stretch publication beyond any previous bounds, he preferred to leave the matter to Congress.[26]

Before turning to a survey of the cases, a substitute test of publication is here tentatively suggested.[27] Appraisal of its possible efficacy in promoting the policy of the Constitution and the Copyright Act will be made from time to time. The test is this: if the author's work has been exploited in a commercial way, publication should result, regardless of whether the author grants the public access to his work by performing it, by multiplying copies of it, or communicating it in some way not now envisioned by the Copyright Act. This suggested test of publication is not intended to operate when the ques-

[24] Ferris v. Frohman, 223 U.S. 424 (1912).

[25] White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1 (1908).

[26] *Id.* at 20. The Shotwell Bill, 86 CONG. REC. 63–76 (1940), a recent attempt at revision of the Act, includes a catch-all phrase to insure protection of the author in new media; he is entitled:

4(c) "To make or procure the making of any transcription, record, film, wire, disc, or other device or instrumentality, in which the thought of an author may be recorded, and by, from, and by means of which, in whole or in part, the work may in any manner or by any method now or hereafter known or devised be read, exhibited, performed, represented, produced, reproduced, or otherwise communicated or disseminated. . . ." (at 63).

[27] Commentators on publication invariably suggest changes. See, *e.g.*, Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469 (1955), at 488–490; Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185 201–202 (1956). Nimmer notes (at 201 n. 135) that during the fiscal year ending June 30, 1955, twenty copyright bills were proposed in Congress, of which one passed.

tion is whether an author who made no attempt to derive a profit from his work has circulated it so freely as to amount to an abandonment of the work to the public. Rather the economic test of publication is to be applied when, contrary to the policy of the Copyright Act, an author seeks to capitalize on his creation by circulating it in some form or other while retaining a perpetual common law property in the work. For example, the public exhibition of a motion picture, the broadcast of a radio script from a commercial broadcasting station, the sale of a phonograph record, or the performance of a drama over a commercial television program, all constitute communication of an author's work to the public for profit, and should constitute publication unless the author agrees to accept the limited monopoly offered by the terms of the Copyright Act.

### PUBLICATION OF WORKS EXPLOITED BY SALE OF "COPIES" OR BY EXHIBITION

The author of any printed work, the painter, the sculptor, the photographer, and some other creators get their principal profit from outright sale of their productions or by multiplying copies and selling them. Prior to realization of gain in this fashion, they frequently circulate their works for criticism, to enhance their reputation, or to encourage offers to buy. This is a restricted circulation to special persons for a special purpose. Such acts constitute a limited publication, which does not dedicate, as opposed to general publication, which does. Limited publication has been defined as follows:

> The communication of the contents of an unpublished work constitutes a limited publication when the owner thereof releases it, subject to restrictions on its use and enjoyment, to definitely selected individuals, or to a limited, ascertained class, or expressly or impliedly confines the use and enjoyment to a prescribed occasion or purpose.[28]

[28] BALL, *op. cit. supra*, note 8 at 134; see Prince Albert v. Strange, 1 Macn. & Gord. 25 (Ch. 1849).

If the circulation is not in the form of a sale, the courts weigh heavily the intention of the author and, unless he has displayed a complete indifference to the uses made of his work, will find that limited publication has occurred. The distribution of a manuscript to a ceremonial committee for approval,[29] the performance of a radio script at an audition,[30] the submission of a musical composition to orchestra leaders with the object of securing an offer,[31] or the submission of sample photographs to a limited class of prospective buyers,[32] have all been held not to constitute a dedication of the creator's work to the public. Similarly, the writer of a personal letter makes a limited publication and does not grant the receiver the right to print and sell the contents.[33] The same rationale applies to painters and sculptors who exhibit their productions in a gallery where the public is forbidden to copy the work; they are held to have made only a limited circulation, falling short of abandonment of the work to the public.[34] All of these instances of limited publication are harmonious with the purpose of the constitutional clause, because the author has not yet begun to exploit his work in a commercial fashion [35] and is thus free to deal with it as his own personal property, unless he deliberately abandons his work to the public.

General publication, on the other hand, occurs when the artist begins to capitalize on his intellectual property by selling the original or copies—or when he displays complete in-

[29] Press Pub. Co. v. Monroe, 73 Fed. 196 (2d Cir. 1896).

[30] Stanley v. Columbia Broadcasting System, Inc., 35 Cal.2d 653, 221 P.2d 73 (1950).

[31] Allen v. Walt Disney Productions, Ltd., 41 F. Supp. 134 (S.D.N.Y. 1941).

[32] *Cf.* Falk v. Gast Lithograph & Engraving Co. Ltd., 54 Fed. 890 (2d Cir. 1890).

[33] Baker v. Libbie, 210 Mass. 599, 97 N.E. 109 (1912); *cf.* Chamberlain v. Feldman, 274 App. Div. 515, 84 N.Y.S. 2d 713 (1st Dep't 1948).

[34] American Tobacco Co. v. Werckmeister, 207 U.S. 284 (1907).

[35] In a strict view, the painter who realizes a profit from exhibition of his work in a gallery has begun exploitation. However, the primary means of profiting from the work would be sale or reproduction of copies.

difference to its use in the market place. When an author gives his work away,[36] or permits the work to be circulated and reproduced by others for an extended period without asserting his rights in it, general publication results.[37] If an artist begins to trade copies of his work for money, or sells the original, he has in effect made his "first printing," and the courts look to the objective effect of the circulation rather than to the author's professed intent.[38] Richard Wagner's heirs were unable to prevent American performances of "Parsifal" after sale in this country of the uncopyrighted complete score, even though the score carried a legend forbidding performance.[39] The sale of a single copy of a printed work is sufficient to accomplish publication within the meaning of the act.[40] The painter or sculptor who sells his work unconditionally,[41] or who makes free and unrestricted display of it to the public,[42] cannot thereafter prevent others from freely reproducing the same work.

[36] D'Ole v. Kansas City Star Co., 94 Fed. 840 (C.C.W.D.Mo. 1899).

[37] Egner v. E. C. Schirmer Music Co., 48 F. Supp. 187 (D.C. Mass. 1942); White v. Kimmell, 193 F.2d 744 (9th Cir. 1952).

[38] See the general discussion in Waring v. WDAS Broadcasting Station, Inc., 327 Pa. 433, 194 A+1. 631 (1937), at 636.

[39] Wagner v. Conried, 125 Fed. 798 (C.C.S.D.N.Y. 1903). Sale abroad before registration may deprive the U.S. proprietor of his common law rights in his work. See Hill and Range Songs, Inc. v. London Records, Inc., 142 N.Y.S. 2d 311 (Sup. Ct. 1955).

[40] 17 U.S.C. § 10 (1952). Dictum in one case suggested that deposit of two copies of a work with the Copyright Office might be sufficient to publish within the meaning of the Act, Stern v. Jerome H. Remick & Co., 175 Fed. 282 (C.C.S.D.N.Y. 1910), but the rule now appears to be that at least one copy must be offered to the public for sale, Atlantic Monthly Co. v. Post Pub. Co., 27 F.2d 556 (D.C. Mass. 1928), see HOWELL, THE COPYRIGHT LAW 64 (3d ed. 1952), unless the work is to be registered as an unpublished work under § 12 of the Act. For a statement that in defining publication generally the scheme of the Act should be considered, see Patterson v. Century Productions, Inc., 93 F.2d 489 (2d Cir. 1937).

[41] Pushman v. New York Graphic Society, Inc., 25 N.Y.S. 2d 32 (Sup. Ct. 1941); Grandma Moses Properties, Inc. v. This Week Magazine, 117 F. Supp. 348 (S.D.N.Y. 1953); Parton v. Prang, 18 Fed. Cas. 1273, No. 10784 (C.C. Mass. 1872).

[42] Carns v. Keefe Bros., 242 Fed. 745 (D.C. Mont. 1917); Morton v. Raphael, 334 Ill. App. 399, 79 N.E. 2d 522 (1948); William A. Meier Glass Co., Inc. v. Anchor Hocking Glass Corp., 95 F. Supp. 264 (W.D. Pa. 1951).

An attempt to achieve limited publication while in reality making a sale for profit was struck down in the leading case of *Jewelers' Mercantile Agency v. Jewelers' Weekly Publishing Co.*,[43] in which a credit agency published and sold an information book under a so-called "lease" contract which forbade unauthorized use of the contents. It was held that this attempt to impose a servitude on a chattel after sale was of no effect, and general publication resulted. The court said:

> It has not hitherto been understood to be the law that the common-law right could be so utilized as to secure to an author or publisher a continuing revenue from the public for a much longer period of time than Congress has been willing to grant to him the exclusive right to publish.[44]

The court here recognized that long-continued commercial exploitation of intellectual property under the mantle of common law protection goes against the grain of the Copyright Act. Analysis of economic realities is infrequent in discussions of publication.[45]

With respect to intellectual property exploited primarily by sale of copies or exhibition, then, the cases decided under the traditional test of publication (whether copies or the original have been sold or reproduced for sale or abandoned) would most probably be decided in exactly the same way under the proposed economic test (whether the author has exploited his work in a commercial way). As applied to works exploited by sale of copies or exhibition, the traditional test effectuates the policy of the constitutional clause, because the acts which produce revenue for the proprietor, such as the sale or public exhibition of the work, constitute legal dedication unless the author agrees to accept the limited monopoly prescribed by the statute.

[43] 155 N.Y. 241, 49 N.E. 872 (1898); followed in Larrowe-Loisette v. O'Loughlin, 88 Fed. 896 (C.C.S.D.N.Y. 1898); *cf.* Bobbs-Merrill Co. v. Straus, 147 Fed. 15 (2d Cir. 1906).

[44] 155 N.Y. at 250.

[45] For another expression in economic terms, see Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

### PUBLICATION OF WORKS EXPLOITED PRIMARILY BY PERFORMANCE

It has been previously suggested that when an author begins to capitalize on his work in a substantial way the underlying purpose of the Copyright Act demands that publication occur, and that the author agree to accept a monopoly limited in time or, in the alternative, dedicate his work to the public. If the economic measuring rod is used, it should not matter whether an author derives his profit from selling copies of his work or from the royalties on a dramatic version performed before the public. In both cases the author communicates his artistic creation to the public through a medium in exchange for cash. (It is true that the purchaser of the novel gets something tangible, but to argue that the transfer of tangible property is the test of publication is to place an excessive premium on the physical entity aspect of a literary proprietorship.) [46] It should follow that the performance of a drama before a paying audience be held a publication. The Supreme Court came to exactly the opposite conclusion in the landmark case of *Ferris v. Frohman*,[47] decided in 1912, where it was held that performance of an uncopyrighted drama upon the stage did not constitute a publication, and therefore that the author of an unregistered drama called "The Fatal Card" could forbid others from presenting imitations, even though the work had previously been performed by the author in public.[48] The *Ferris* decision has proved to

[46] Nimmer, *supra*, note 27, at 197 suggests, "a *sine qua non* of publication should be the acquisition by members of the public of a possessory interest in *tangible* copies of the work in question." The criticism of this test is inherent in discussion of the *Ferris* rule (see text at note 47, *infra*). Nimmer's test is a compromise, since he recognizes the improbability of getting a reversal of the *Ferris* decision.

[47] 223 U.S. 424 (1912).

[48] "The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right, save by operation of statute. At common law, the public performance of the play is not an abandonment of it to the public use." *Id.* at 435.

be something of a fatal card for the Copyright Act as well. Arriving at the crucial moment when radio broadcasting, motion picture production, and phonograph recording were infant industries, the *Ferris* doctrine has been readily invoked to extend the mantle of common law protection for "unpublished" works into every new medium of mass communication. It is hardly surprising, for example, to hear that counsel for major broadcasting companies advise their clients against copyrighting works which are to be performed.

The *Ferris* opinion itself is curiously deficient in analysis of the interests involved; there was no discussion of the constitutional clause, nor of the purpose of the Copyright Act, nor of the adequacy of the traditional test of publication to works exploited in nontraditional ways.[49] Instead, the Court cites as authority for its decision six earlier American and English cases: *Macklin v. Richardson*,[50] *Morris v. Kelly*,[51] *Boucicault v. Fox*,[52] *Crowe v. Aiken*,[53] *Palmer v. De Witt*,[54] and *Tompkins v. Halleck*.[55] While three of these decisions give reasonably solid support to this conclusion,[56] the *Macklin* and *Palmer* cases merely decided that *printing* of the plaintiffs' plays was forbidden; the *Morris* case most probably was an action for breach of contract—the factual setting is in doubt.[57] Another line of cases, given scant notice by the Court, distinguishes outright copying or theft of the drama from memorization, permitting the plaintiff no relief where agents of the defendant carry away the play in their minds.[58]

[49] Ladas suggests that the real rationale of the case was that the performance of the work does not communicate a copy to the public—hence no publication occurs. This result obtains under the traditional test. 2 LADAS, THE INTERNATIONAL PROTECTION OF LITERARY AND ARTISTIC PROPERTY 693 (1938).

[50] 2 Amb. 694 (Ch. 1770). [51] 1 J.&W. 481, 27 Eng. Rep. 451 (Ch. 1770).

[52] 3 Fed. Cas. 977, No. 1691 (C.C.S.D.N.Y. 1862).

[53] 6 Fed. Cas. 904, No. 3441 (C.C.N.D. Ill. 1870).

[54] 47 N.Y. 532 (1872). [55] 133 Mass. 32 (1882).

[56] *Ibid.*; *Boucicault*, *supra*, note 52; *Crowe*, *supra*, note 53.

[57] The cases are discussed in Collins, *Playright and the Common Law*, 15 CALIF. L. REV. 381 (1927).

[58] Keene v. Kimball, 82 Mass. (16 Gray) 545 (1860); Keene v. Wheatley, 14

In the majority of decisions on publication of dramatic works, the rationale is a supposed understanding between the dramatist and the audience that no one is to copy, since the dramatist does not intend to abandon.[59] Some of the opinions derived support from the analogy of the lecturer who does not dedicate his lecture by presenting it before an audience.[60] There is little direct support in the early cases for the flat rule that performance of a drama unconditionally dedicates.[61] An examination of the common law authority leaves the matter in doubt.[62]

At the time the facts of the *Ferris* case arose, section 11 of the Copyright Act of 1909 (now section 12), permitting registration of unpublished dramatic works,[63] had not yet become law, and the Supreme Court did not consider the effect of this section in deciding the case. The Court's alternatives, therefore, were either to hold that an uncopyrighted dramatic work was not forfeited by performance, or to require publication and registration under the act as an absolute condition precedent to performance, unless the author desired to dedicate. After the passage of section 11, however, the author of an unpublished work could secure a copyright, and hence a performance right, in his work, and therefore there is considerable merit to the argument that under the reasoning of the *Donaldson* and *Wheaton* cases, the common law property right should have been superseded by the limited monopoly right granted in the statute.[64] Doubt has been expressed

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Fed. Cas. 180, No. 7644 (C.C.E.D. Pa. 1860); see dictum to the same effect in Crowe v. Aiken, 6 Fed. Cas. 904, No. 3441 (C.C.N.D. Ill. 1870).

[59] See, *e.g.*, Keene v. Kimball, *supra* note 58, at 550.

[60] Caird v. Sime, 12 App. Cas. 326 (H.L. 1887); Nutt v. National Institute Inc. for the Improvement of Memory, 31 F.2d 236 (2d Cir. 1929); *cf.* Bartlett v. Crittenden, 2 Fed. Cas. 967, No. 1076 (C.C. Ohio 1849).

[61] Collins, *supra* note 57, at 381–5.

[62] *Id.* at 386–7; 2 STORY, EQUITY JURISPRUDENCE § 950 (12th ed. 1877).

[63] 35 STAT. 1078 (1909).

[64] This argument is advanced in Selvin, *Should Performance Dedicate?*, 42 CALIF. L. REV. 40 (1954), at 44–45, who appears to have acquired it from Collins, *supra* note 57, at 389.

that Congress intended that authors whose unpublished writings were copyrightable under the act could, by deliberately refraining from registration, maintain a perpetual property right in their works.[65] However, section 12, by its terms, leaves registration voluntary and does not decree forfeiture if the work is performed before registration.[66] Curiously enough, the committe report accompanying the Copyright Act of 1909 indicates that the committee had the distinct impression that performance of a drama *did* dedicate it.[67]

Again, it has been argued that the words of Justice Hughes in *Ferris v. Frohman*, to the effect that performance of a dramatic composition does not deprive the owner of his common law right "save by operation of statute" [68] refer to section 11 (now section 12) and that the presence of section 11 in the act has this divestitive effect.[69] It appears more likely that the kind of statute the court was referring to was the English statute cited in the opinion, which provides unequivocally that performance of a drama dedicates it.[70]

[65] Selvin, *id.* at 46–47.

[66] Copyright Act protection of the unpublished work begins upon deposit of the work at the Copyright Office. Marx v. United States, 96 F.2d 204 (9th Cir. 1938). The difficulty of construing § 12 as making registration mandatory is set forth in Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. Pa. L. Rev. 469, 478 (1955).

[67] H.R. Rep. No. 2222, 60th Cong., 2d Sess. 4 (1909). "This section is intended to give adequate protection to the proprietor of a dramatic work. It is usual for the author of a dramatic work to refrain from reproducing copies of the work for sale. . . . His compensation comes solely from public representation of the work. It has sometimes happened that upon the first production of a dramatic work a stenographer would be present and would take all the words down and would then turn the manuscript over to someone who had hired him. . . . This manuscript would then be duplicated and sold to persons who, without any authority whatever from the author, would give public performances of the work. It needs no argument to demonstrate how great the injustice of such a proceeding is, for under it the author's rights are necessarily greatly impaired. If an author desires to keep his dramatic work in unpublished form and give public representations thereof only, this right should be fully secured to him by law. We have endeavored to so frame this paragraph as to amply secure him in these rights."

[68] 223 U.S. at 435 (1912).

[69] Selvin, *supra*, note 64, at 45.

[70] The English statute, the Copyright Act of 1842, cited in the *Ferris* opinion at 432, provides that "the first public Representation or Performance of any

To repeat, the *Ferris* case is a landmark. By deciding that performance did not dedicate, the Supreme Court unduly limited the thrust of the clause. If the dramatist does not publish because there is a fictitious implicit understanding between himself and the audience that it will not copy, why is there not an implicit understanding that the reader of an unregistered novel will not copy? The *Jewelers'* case [71] tagged that sort of understanding (there contractual, not fictional) as a pious hope by the author that he could retain a perpetual monopoly while exploiting his work to the fullest, a scheme incompatible with the common law protection of literary property, which extends only to a right of first printing. In fairness to the court, some of the implications of the decision were not foreseeable: the possibility of a performance, frozen in permanent form (*e.g.*, a film, a record), capable of being reproduced at any time in the future, presented before a national audience, yet protected perpetually by the common law, would no doubt have given the court pause. Such a blunting of the force of the Copyright Act might have seemed breathtaking; yet that result has come to pass, because the *Ferris* decision casts aside the economic test where a work is exploited by performance, and provides no logical cut-off point; if performance before an audience of ten does not dedicate, multiplying the number should not change the result.

The manner in which the *Ferris* doctrine has been extended to new media and new intellectual productions becomes the next subject of inquiry.

### RADIO BROADCASTING

If performance of a drama before a theater audience does not dedicate, should performance of the same drama before

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Dramatic Piece or Musical Composition shall be deemed equivalent . . . to the first Publication of any Book." 5 & 6 Vict. c. 45, § 20.

[71] Jewelers' Mercantile Agency v. Jewelers' Pub. Co., 155 N.Y. 241 (1898).

an audience at a radio broadcasting studio? And if the drama is simultaneously broadcast to the listening public, could it then be urged that the work was dedicated to the listening public but not to the studio audience, or vice versa? Once it is settled that performance does not dedicate, neither the size of the audience nor its presence in the same room with the performers can logically control publication. No such distinction has been successfully propounded, and the rule today is that performance of a script, drama, or musical composition over the air does not dedicate. The cases reach the result by citing *Ferris*, or by declaring that the author did not intend to part with his rights by broadcasting.[72] Consequently, the industry practice is not to copyright works intended for broadcast, thus preserving the perpetual common law property.[73] Current practice in the television industry varies: some members depend on common law rights, but include an announcement forbidding copying;[74] others copyright the script, or film the performance and copyright the film.[75]

MOTION PICTURE FILMS

The rule is that exhibition of an uncopyrighted moving picture film, like performance of an uncopyrighted drama, or broadcast of an uncopyrighted radio script, does not dedicate the contents to the public.[76] It is immaterial whether the script or scenario from which the film was taken was copy-

[72] Uproar Co. v. National Broadcasting Co., 8 F. Supp. 358 (D.C. Mass. 1934), *aff'd*, 81 F.2d 373 (1st Cir. 1936), *cert. denied*, 298 U.S. 670 (1936); Stanley v. Columbia Broadcasting System, 35 Cal.2d 653, 221 P.2d 73 (1950); Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp., 199 Misc. 786, 101 N.Y. S.2d 483 (Sup. Ct. 1950), *aff'd mem.*, 279 App. Div. 632, 107 N.Y.S. 2d 795 (1st Dep't 1951); Warner, *Protection of the Content of Radio and Television Programs by Common Law Copyright*, 3 VAND. L. REV. 209, 231 (1950). *But cf.* Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

[73] McDonald, *The Law of Broadcasting*, in 7 COPYRIGHT PROBLEMS ANALYZED 31 (C.C.H. 1952), at 46.

[74] Warner, *supra*, note 72, at 233. [75] McDonald, *supra*, note 73, at 61.

[76] De Mille Co. v. Casey, 121 Misc. 78, 201 N.Y. Supp. 20 (Sup. Ct. 1923); Universal Film Mfg. Co. v. Copperman, 218 Fed. 577 (2d Cir. 1914), *cert. denied*, 235 U.S. 704 (1914) (dictum).

righted.[77] The objections attaching to the *Ferris* rule are equally applicable here; the dramatic work is exploited to the fullest by public showings, yet the owner retains his common law property in his work. Moreover, as is true of dramatic works, protection under the act is sufficiently complete:[78] the copyright proprietor has the exclusive right to make copies and to exhibit,[79] and the unauthorized use of copies of the film, or plagiarism of the plot constitutes actionable infringement.[80] Television films are now registerable, by a recent addition to the Copyright Regulations.[81]

If exhibition of an uncopyrighted film does not dedicate, the owner of the film may present it in his own theater. But to obtain maximum profits, a licensing or leasing arrangement with exhibitors is necessary. The harder question is whether the practice of licensing films for public exhibition works a dedication to the public. It has been held that the lease and subsequent exhibition by the lessee of an uncopyrighted film does not constitute a publication, on the ground that the owner does not part with his common law rights by a licensing agreement, and exhibition, like performance of a play, does not dedicate.[82] The unauthorized performance of a copyrighted film, the subject of a licensing agreement, constitutes an infringement.[83] Unsettled today is the question

[77] Universal Film Mfg. Co. v. Copperman, 218 Fed. 577 (2d Cir. 1914), *cert. denied*, 235 U.S. 704 (1914) (dictum). If the script is copyrighted the proprietor acquires film rights under § 1(d) of the Copyright Act (17 U.S.C.).

[78] Films are registerable as "Motion picture photoplays" under § 5(l) and as "Motion pictures other than photoplays" under § 5(m) of the Act, and also as unpublished works under § 12.

[79] 17 U.S.C. § 1(a), (d) (1952).

[80] Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theater Co. of Holyoke, 3 F. Supp. 66 (D.C. Mass. 1933); Tiffany Productions Inc. v. Dewing, 50 F.2d 911 (D.C. Md. 1931); Universal Pictures Co. v. Harold Lloyd Corporation, 162 F.2d 354 (9th Cir. 1947).

[81] 17 C.F.R. § 202.13, § 202.14 (1949).

[82] De Mille Co. v. Casey, 121 Misc. 78, 201 N.Y. Supp. 20 (Sup. Ct. 1923); Universal Film Mfg. Co. v. Copperman, 218 Fed. 577 (2d Cir. 1914), *cert. denied*, 235 U.S. 704 (1914) (dictum).

[83] Metro-Goldwyn-Mayer Distributing Corp. v. Bijou Theater, 3 F. Supp. 66 (D.C. Mass. 1933).

of whether an unconditional sale of an uncopyrighted film constitutes a publication.[84] It has been decided that one who makes a negative film from another's negative film has created a "copy." [85] Hence sale of a copy of an uncopyrighted master film would, by the traditional test of publication, be an offering of a copy for sale sufficient to dedicate. The only discovered case on the subject said by way of dictum that sale of an uncopyrighted film does not work a dedication, and that the buyer acquires a performing right, but no one, by virtue of the sale, acquires the right to reenact the underlying dramatic work or to make copies of the film.[86]

Thus the conflict between the *Ferris* case and the spirit of the constitutional clause extends into the motion picture field. The film producer who deliberately refrains from registering his works under the act may assert perpetual monopoly rights, whereas the producer who registers acquires limited protection. There is little doubt that the rule that performance of an uncopyrighted film does not dedicate is consistent with the *Ferris* case and its progeny; less harmonious is the apparent invulnerability of the industry practice of film leasing and licensing to attack under the *Jeweler's* case.[87] That case, it will be recalled, involved substantial exploitation of the proprietor's credit rating book by a contrived lease arrangement. It is submitted that the *Jeweler's* case, forcefully argued, might cause a court to find that lease of an uncopyrighted film to exhibitors would constitute a general publication.

A recent California decision adopted this approach—essentially an economic test of publication—and concluded

[84] The film industry ordinarily copyrights its films, so that the question does not affect current practice to any marked degree. See Warner, *supra* note 72, at 234.

[85] Patterson v. Century Productions, Inc., 93 F.2d 489 (2d Cir. 1937).

[86] Universal Film Mfg. Co. v. Copperman, 218 Fed. 577 (2d Cir. 1914), *cert. denied*, 235 U.S. 704 (1914). See, generally, Nimmer, *supra* note 27, at 197–98.

[87] See text at note 43, *supra*.

that the widespread lease and exhibition of a motion picture film dedicates the contents. This is the "Woody Woodpecker" case,[88] in which the creator of the staccato musical laugh of the animated cartoon bird known to the public as "Woody Woodpecker" had broadcast his laugh over the air and had recorded it on the sound track of several cartoons, all before securing copyright.[89] The creator sued an imitator, relying on his common law property right, but was denied recovery on the ground that the lease and exhibition of the films embodying this laugh constituted a general publication. To some extent the force of the opinion is vitiated by the court's partial reliance on the very broad language of a California statute on publication.[90] However, the opinion as a whole reflects a direct concern with the fundamental purpose of the Copyright Act, rather than the California statute, which had been subject to conflicting interpretations.[91] The plaintiff relied on the *MGM*, *Universal*, and *Patterson* cases for the proposition that exhibition of a film does not dedicate;[92] the court replied that only the *Universal* case dealt with the specific question of whether leasing plus exhibition constitutes publication, and the language there was dictum.[93] Having disposed of the few cases throwing light on the problem, the judge felt free to adopt a "basic policy" approach:

> I am unable to concur in plaintiff's contention that the distribution of the Woody Woodpecker cartoons at most amounted to a "limited"

[88] Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

[89] The opinion does not indicate whether the cartoons had been copyrighted.

[90] "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 the law of this state is concerned." CAL. CIV. CODE § 983 (Deering 1941). Section 983 has been amended to substitute the word "publishes" for "make it public," CAL. CIV. CODE § 983(a) (Deering 1949) thus presumably adopting the federal definition of publication.

[91] Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super Ct. 1949).

[92] *Id.* at 140. Metro-Goldwyn-Mayer Distributing Co. v. Bijou Theater, 3 F. Supp. 66 (D.C. Mass. 1933); Universal Film Mfg. Co. v. Copperman, 218 Fed. 577 (2d Cir. 1914), *cert. denied*, 235 U.S. 704 (1914); Patterson v. Century Productions, Inc., 93 F.2d 489 (2d Cir. 1937).

[93] Blanc v. Lantz, *supra* note 92 at 141.

as distinguished from a "general" publication. The distribution and exhibition of these films 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. Jewelers Mercantile Agency v. Jewelers Publishing Co., 155 N.Y. 241, 49 N.E. 872, 41 L.R.A. 846.

Here then we are confronted with a situation where, for the purpose of this motion, the plaintiff had created a musical composition which he could have copyrighted under federal law and thereby have secured a limited monopoly to the exclusive performance of his intellectual product. By failure so to protect his work, yet by electing to exploit it commercially not only by personal performance but also by reproducing his work in a tangible form permitting general circulation of that composition by way of copies, I conclude that plaintiff has lost his right to the exclusive property in the laugh.[94]

The case has received a cool reception.[95] In view of the millions of dollars invested in uncopyrighted films, some alarm is to be expected from members of the industry. The opinion itself leaves unanswered a number of problems: for example, does the court hold by implication that the entire subject-matter of the cartoon is published, or only the sound track? If only the sound track, then are all sound tracks to be treated as mechanical reproductions of music, like phonograph records?[96] And does it make any difference whether the film itself was copyrighted? The case does not resolve these questions, but has the merit of treating publication problems in terms of the policy of the Copyright Act and of the economic

[94] *Id.* at 142.

[95] Warner, *supra* note 72, at 236–38.

[96] In Jerome v. Twentieth Century-Fox Film Corp., 67 F. Supp. 736 (S.D.N.Y. 1946), *aff'd per curiam*, 165 F.2d 784 (2d Cir. 1948), the court stated that motion picture sound tracks were not "mechanical reproductions" within the meaning of the Copyright Act. But the Second Circuit Court, in Foreign & Domestic Music Corp. v. Licht, 196 F.2d 627 (2d Cir. 1952) decided that reproduction of a copyrighted musical composition upon a sound track could infringe. See Dubin, *Copyright Aspects of Sound Recordings*, 26 So. Calif. L. Rev. 139 (1953), at 147–49.

interests involved, an approach which, if widely applied, would clarify much of the clouded doctrine of publication as it now exists.

### EXTENTION OF THE FERRIS DOCTRINE IN THE ARTS

New media, new art forms, and new methods of publication excite the imagination and challenge interpreters of the Copyright Act.[97] Several representative problems are here surveyed.

#### CHOREOGRAPHIC COMPOSITIONS

Recent advance in the art of recording, in permanent form, the postures and movements of dancers now makes possible the reproduction of a ballet or choreographic work on paper with considerable accuracy.[98] By a timely addition to the Copyright Regulations, "ballets" may be registered as "dramatic" or "dramatico-musical" compositions, whether published or unpublished.[99] Narrative choreographic works may be registered under section 5(d) of the Copyright Act.[100] The protection would appear adequate; yet proponents of the unlimited extension of the *Ferris* doctrine here urge that performance of an uncopyrighted ballet or dance routine should not dedicate, and the creator should be entitled to a perpetual common law property in his works.[101] While a reason existed for finding that a choreographer had a common law property in a dance routine when no protection was available under the act, the reason disappears with the advance in the system of notation of dance movements, permitting registration of

[97] See, *e.g.*, Kupferman, *Rights in New Media*, in 19 LAW & CONTEMP. PROB. 172 (1954); Meagher, *Copyright Problems Presented by a New Art*, 30 N.Y.U.L. REV. 1081 (1955).

[98] Mirell, *Legal Protection for Choreography*, 27 N.Y.U.L. REV. 792 (1952), at 792–93.

[99] 17 C.F.R. § 202.5 (1949).

[100] See Mirell, *supra*, note 98, at 803 n. 52. The meaning of "dramatic" is discussed in Daly v. Palmer, 6 Fed. Cas. 1132, No. 3552 (CC.S.D.N.Y. 1868).

[101] Mirell, *supra*, note 98, at 799.

the work. Perhaps common law protection of nondramatic dance works might still be desirable, since no Copyright Act security is yet provided;[102] but otherwise, performance should dedicate.

ARCHITECTURAL DRAWINGS

Another form of intellectual property about which little law has developed is the drawings of an architect. Under the Copyright Act, architectural blueprints, sketches, plans, and models, published or unpublished, may be registered.[103] The most important rights secured are those of printing and selling the drawings, together with the sole right to erect a building from the plan.[104] The extent of the architect's rights after the building goes up is a matter of speculation. The "ideas" in the architect's plan (and presumably the "ideas" as embodied in the physical structure of the building) may be freely borrowed.[105] Making a copy of another's work from photographs of the "copyrighted" structure constitutes infringement.[106] A commentator suggests that infringement under the act may also occur if the defendant makes a "copy" on paper of the building erected from the copyrighted plan.[107] Since it would appear difficult to produce an imitation of another's building without making notes, the probable rule offers the architect sufficient security.

[102] Fuller v. Bemis, 50 Fed. 926 (C.C.S.D.N.Y. 1892); *but see* Mirell, *id.* at 810, where the author cites the instance of a recent Copyright Office acceptance for registration of a choreographic routine consisting of "mood and idea" pieces.

[103] 17 U.S.C. §§ 5(g) (i) (1952); 17 C.F.R. § 202.8 and § 202.10 (1949). Additional protection is available if the work qualifies for a design patent.

[104] 17 U.S.C. § 1(a) (1952). The right to erect the building is derived from a latitudinarian reading of § 1(b): "to complete, execute, and finish it if it be a model or design for a work of art."

[105] Muller v. Triborough Bridge Authority, 43 F. Supp. 298 (S.D.N.Y. 1942); *cf.* Larkin v. Pennsylvania R.R. Co., 125 Misc. 238, 210 N.Y. Supp. 374 (Sup. Ct. 1925).

[106] See Jones Bros. v. Underkoffler, 16 F. Supp. 729 (M.D. Pa. 1936).

[107] See Katz, *Copyright Protection of Architectural Plans, Drawings, and Designs*, 19 LAW & CONTEMP. PROB. 224 (1954) at 245. *But see* BALL, *op. cit. supra* note 8, at 397.

Prior to erection of a building, or reproduction of the drawings in copies for sale, architectural plans are protected by the common law principles applied to literary property.[108] In one instance it was held that registration of an architect's plan with a municipal building department constituted publication.[109] This decision is difficult to justify on any theory, since the architect derived no profit from registration, did not thereby sell the work, and had no intention to dedicate. With respect to the architect's common law property in his design upon completion of the building, the rule appears to be that a general publication occurs.[110] This result is criticized on the ground that a building is not a "copy" (invoking the *Apollo* case),[111] and that the artist does not intend to dedicate.[112] The real question is, has the architect, by completing the structure he designed, exploited his work in a substantial way? If so, publication should follow, and the act, although admittedly ambiguous, should be the measure of his rights.[113]

Further questions naturally suggest themselves: is a completed building a "Writing"?[114] Should a distinction be drawn between publication of a one-of-a-kind structure (a bridge, *e.g.*), on the one hand, and plans for a massive de-

[108] See Note, *Common Law Property Rights in Architectural Plans*, 75 U. PA. L. REV. 458 (1927).

[109] Wright v. Eisle, 86 App. Div. 356, 83 N.Y. Supp. 887 (2d Dep't 1903).

[110] Kurfiss v. Cowherd, 233 Mo. App. 397, 121 S.W.2d 282 (1938); Gendell v. Orr, 36 Leg. Inst. (Pa.) 412, 13 Phila. 191 (1879).

[111] White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1 (1908).

[112] Katz, *supra*, note 107, at 233–7.

[113] The British Copyright Act provides that the construction of an architectural work does not constitute publication. 1 & 2 GEO. 5, c. 46, § 1(3) (1911).

[114] "Writing" has been expanded by Congress to include forms of intellectual property not contemplated at the time of drafting the constitutional clause. In the recent case of Mazer v. Stein, 347 U.S. 201 (1954) which held copyrightable a lampbase, Justice Douglas, concurring, at 219–21, questioned whether the meaning of "Writings" in the clause could be indefinitely expanded. In view of the long trend toward a dynamic interpretation of "Writings" by both Congress and the courts, it appears improbable that Congressional protection of new forms of communication will be found unconstitutional. See Note, *Constitutional Limits on Copyright Protection*, 68 HARV. L. REV. 517 (1955).

velopment of look-alike houses on the other? And to what extent should an action for unfair competition be available at common law? Such teasing problems await legislative clarification or the collaboration of sophisticated copyright counsel with a sympathetic court.

### MUSICAL COMPOSITIONS

Musical compositions are exploited in a greater variety of ways than any other form of "Writing": the composition may be printed as sheet music, performed before an audience, embodied on phonograph records, incorporated on the sound track of a motion picture film, arranged, or performed in a highly individual fashion by an artist in a number of media. The extent to which a composer can profit from his composition and still retain his common law copyright varies with the medium in which he chooses to exploit his intellectual product.

Printed copies of an uncopyrighted musical composition are treated like printed copies of a book; reproduction plus sale dedicates.[115] If the composition is reduced to notes on a sheet of paper, it may be registered as a published or unpublished work under the Copyright Act, in which event the rights of reprinting and any form of performance in public are secured to the composer,[116] except that the composer cannot prevent performances not for profit.[117] The music industry practice is to avoid copyright, at least until the public reaction has been tested by issuance of records of the composition.[118]

Since a musical composition may, like a dramatic com-

[115] Wagner v. Conried, 125 Fed. 798 (C.C.S.D.N.Y. 1903).

[116] 17 U.S.C. § 1(a) and (e) (1952); Herbert v. Shanley Co., 242 U.S. 591 (1917); Buck v. Jewell-LaSalle Realty Co., 283 U.S. 191 (1931); Associated Music Publishers, Inc. v. Debs Memorial Radio Fund, Inc., 46 F. Supp. 829 (S.D.N.Y. 1942); Famous Music Corp. v. Melz, 28 F. Supp. 767 (W.D. La. 1939); Foreign & Domestic Music Corp. v. Licht, 196 F.2d 627 (2d Cir. 1952).

[117] See 17 U.S.C. § 1(e) (1952).

[118] Burton, *Business Practices in the Copyright Field*, in 7 COPYRIGHT PROBLEMS ANALYZED 87 (C.C.H. 1952) at 102–3.

position, be performed before an audience, the *Ferris* rule dictates that performance of an uncopyrighted musical work is not sufficient publication to dedicate the work.[119] But if the composer permits his composition to be widely performed over an extended period of time without taking decisive steps to assert his rights, dedication results.[120] Radio broadcasting does not publish; [121] nor does the incorporation of an uncopyrighted musical composition in a moving picture sound track, where the film is exhibited to the public.[122]

Different results, of course, would flow if the proposed economic test of publication were applied. The inconsistency of holding that sale of one copy of the sheet music version of a musical work dedicates, while unlimited performances over the air waves, or the issuance of quantities of phonograph records of the composition does not, sufficiently illustrates the need for a reexamination of the *Ferris* doctrine.

PHONOGRAPH RECORDS

The common law notion of publication springs, as we have seen, from the relation of the author to his printed manuscript: when the work is reproduced in copies for sale, publication results. From this premise, a corollary follows: where no copies are sold, no publication results. In 1908, the Supreme Court considered the matter of piano-rolls—"copies" or not? The *Apollo* decision [123] held that a piano-roll was not a "copy" within the meaning of the Copyright Act. (The language of the opinion was broad enough to include phonograph records.) [124] Under the traditional test of publication, it should follow that issuance and sale of phonograph records

[119] McCarthy & Fischer, Inc. v. White, 259 Fed. 364 (S.D.N.Y. 1919).

[120] Egner v. E. C. Schirmer Music Co., 48 F. Supp. 187 (D.C. Mass. 1942).

[121] Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp., 199 Misc. 786, 101 N.Y.S. 2d 483 (Sup. Ct. 1950), *aff'd mem.*, 279 App. Div. 632, 107 N.Y.S. 2d 795 (1st Dep't 1951).

[122] Heim v. Universal Pictures Co., 154 F.2d 480 (2d Cir. 1946). *But see* Blanc v. Lantz, 83 U.S.P.Q. 137 (Cal. Super. Ct. 1949).

[123] 209 U.S. 1 (1908).

[124] *Id.* at 17–18.

do not dedicate the underlying composition. In its deliberations on treatment of phonograph records under the Copyright Act, Congress was unwilling to permit this result. After extended hearings,[125] Congress in 1909 gave to the copyright proprietor of a musical composition the first right of mechanical reproduction of the sheet music, but added a compulsory licensing provision whereby, after the proprietor caused records to be made, any other person might record the composition on payment of a royalty of two cents per record.[126] Copyright proprietors of unpublished, registered works do not lose the protection of the act because of sale of records,[127] and prior to manufacturing records, may prevent others from doing so.[128] The licensee must, of course, make his own recording, and not merely reissue the proprietor's.[129] A record itself cannot be copyrighted,[130] since the *Apollo* case established that a record was not a copy and hence incapable of fulfilling, *inter alia*, the requirement of the act that two "copies" [131] of the work be presented for registration. The courts have held that playing a record for profit constitutes a "performance" within the meaning of the act, and hence the proprietor of copyrighted music from which the record was made may enjoin playing of the record for profit.[132] Thus

[125] H.R. REP No. 2222, *op. cit. supra*, note 67.

[126] 17 U.S.C. § 1(e) (1952). The fear of a "music trust" in which a few leading recording companies might dominate the issuance of new records prompted the compulsory licensing provision. See H.R. REP No. 2222, *op. cit. supra*, note 67, at 9.

[127] Yacoubian v. Carroll, 74 U.S.P.Q. 257 (S.D. Cal. 1947).

[128] Shilkret v. Musicraft Records, Inc., 131 F.2d 929 (2d Cir. 1942).

[129] *Accord* Aeolian Co. v. Royal Music Roll Co., 196 Fed. 926 (W.D.N.Y. 1912).

[130] The Committee Report states: "It is not the intention of the committee to extend the right of copyright to the mechanical reproductions themselves, but only to give the composer or copyright proprietor the control, in accordance with the provisions of the bill, of the manufacture and use of such devices." H.R. REP No. 2222, *op. cit. supra* note 67, at 9.

[131] 17 U.S.C. § 13 (1952).

[132] Irving Berlin, Inc. v. Daigle, 31 F.2d 832 (5th Cir. 1929); Associated Music Publishers, Inc. v. Debs Memorial Radio Fund, Inc., 46 F. Supp. 829 (S.D.N.Y. 1942).

the Copyright Act achieves a compromise on the question of whether sale of a phonograph record of a copyrighted musical composition dedicates: the owner's record may not be directly copied, but the sheet music is dedicated in that another musician may make a new recording of it.[133] And registration of sheet music itself dedicates, to a degree: another musician may, with permission, make and copyright an arrangement of the original.[134] (In practice, however, arrangements are not cleared with the copyright proprietor, who rarely objects because his profits increase with the number of such arrangements.)[135]

The recording company which issues a record of a musical work without securing copyright—a frequent practice in the industry [136]—and the composer who neglects to copyright his work and thereafter issues a recording of it, necessarily depend on common law protection of their works, since the records themselves cannot be copyrighted, as previously noted.[137] The traditional test is that reproduction of copies of an artist's work for sale constitutes a dedication. Whatever the merit of calling a record a "copy" and going on from there may be, the issue has been largely foreclosed by the *Apollo* case,[138] although strictly speaking that decision merely interpreted the meaning of "copy" under the Copyright Act, and not for all purposes. Under the economic test, the composer of an uncopyrighted musical work who sells a recording of the work has begun to realize substantial gain and should register or forfeit.

The music industry assumes that the sale of a record of an uncopyrighted musical work does not dedicate it.[139] The economic advantages of neglecting to register sheet music for

[133] 17 U.S.C. § 1(e) (1952). As to the status of sound tracks, see note 96, *supra.*

[134] 17 U.S.C. § 7 (1952).

[135] McDonald, *supra* note 73, at 48.

[136] Burton, *supra* note 118, at 103.

[137] See note 130, *supra.*

[138] *But cf.* Blanc v. Lantz, 83 U.S.P.Q. 137, 140 (Cal. Super. Ct. 1949).

[139] Burton, *supra* note 118, at 103.

copyright are considerable: whereas the copyright proprietor of sheet music who issues a record retains only a limited statutory monopoly, is subject to the compulsory licensing provision, and loses a potential source of profit because of the juke-box exemption,[140] the composer who refrains from copyright has a perpetual monopoly, is outside the compulsory licensing provision, and avoids the juke-box provision—all assuming sale of the record does not dedicate.

One argument against general publication, previously noted, is that a phonograph record is not a copy, and hence nothing is published by its sale.[141] Another contention runs thus: the *Donaldson* case is authority for the proposition that where the statute fails to give protection, the author retains his perpetual common law right even after publication;[142] since the Copyright Act does not protect records as such, the composer retains a perpetual common law property in his work.[143] The difficulty with this contention is that the statute does make specific provision for phonograph records, though it does not permit them to be registered.[144]

The argument against the perpetual monopoly of the recording companies is shortly stated in the case of *Shapiro, Bernstein & Co. v. Miracle Record Co.*,[145] in which it was held that sale of recordings of an uncopyrighted work dedicated the musical composition to the public:

[140] 17 U.S.C. § 1(d) (1952). For a criticism of the juke-box exemption, see Finkelstein, *Public Performance Rights in Music and Performance Right Societies*, in 7 COPYRIGHT PROBLEMS ANALYZED 69 (C.C.H. 1952), at 71.

[141] This point was advanced in Shapiro, Bernstein & Co. v. Miracle Record Co., 91 F. Supp. 473 (N.D. Ill. 1950) at 475: "The brief argues that phonograph records are not copies of a musical composition, that public sale of records therefore cannot constitute publication of the musical composition, and that sale of records prior to copyright therefore does not destroy common law rights in the musical composition."

[142] Nimmer, *supra*, note 27, at 189.

[143] The *Donaldson* rule (see text at note 11, *supra*) was repudiated by Judge L. Hand in Fashion Originators' Guild of America, Inc. v. F.T.C., 114 F.2d 80 (2d Cir. 1940), at 83, and in RCA Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir. 1940), at 89.

[144] 17 U.S.C. § 1(e) (1952).

[145] 91 F. Supp. 473 (N.D. Ill. 1950).

When 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. The Copyright Act grants a monopoly only under limited conditions. If plaintiff's argument is to succeed here, then a perpetual monopoly is granted without the necessity of compliance with the Copyright Act.[146]

A similar result has been reached in two other recent decisions, which may indicate the reversal of a trend.[147]

Thus the question of whether sale of a recording of an uncopyrighted musical composition dedicates the underlying work remains in doubt. A system of limited protection of such works might be evolved by the courts, since the problem is one of accommodating the common law to the statutory scheme,[148] as contrasted with the more vexing question of treatment of recordings made by performing artists, where the Copyright Act furnishes no guidance whatever.[149]

### ARTISTS' RENDITIONS RECORDED

The varied strands of publication in the fields of recording and broadcasting combine in a unique pattern in the performing artists' rendition cases. At one time, the performance of an artist was considered too ephemeral for copyright,[150] and the right of a performing artist to prevent imitators was

[146] *Id.* at 475. Reaction of industry spokesmen has been less than kind. Burton, *supra* note 118, states at 103: "No one in the music business seems to think the holding in this case is the law . . . no one is paying the slightest attention to the theory that, if you release records before a work is published with a copyright notice, it is dedication."

[147] Biltmore Music Corp. v. Kittinger, 2 BULL. COPYRIGHT SOC'Y 125 (S.D. Cal. 1954), cited in Derenberg, *Copyright Law, in Annual Survey of American Law*, 31 N.Y.U.L. REV. 334 (1956) at 340; *cf.* Mills Music, Inc. v. Cromwell Music, Inc., 126 F. Supp. 54 (S.D.N.Y. 1954).

[148] See Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469 (1955) at 487.

[149] Chafee, *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 719 (1945) at 734.

[150] Chappell & Co. v. Fields, 210 Fed. 864 (2d Cir. 1914); Fuller v. Bemis, 50 Fed. 926 (C.C.S.D.N.Y. 1892).

doubtful.[151] But with the advent of the film, the actor's performance became capable of reduction to copyrightable form, and the property right of a performing artist in his peculiar gifts gained recognition, as in the *Charlie Chaplin* case.[152] Since the Copyright Act of 1909, an arrangement of a musical composition, which is essentially a musician's stylistic rendition of the original, may be copyrighted under the act, if reduced to writing.[153] Like the film, the phonograph record is a medium in which performing artists reduce to concrete form their renditions of musical works; the question presented is the scope of protection of the recording artist.[154]

While there appears to be little doubt that phonograph records of a performing artist's renditions could be classified as "Writings" [155] and thereby regulated under the act, Congress has repeatedly declined to use its power in this area.[156] Thus while they are "Writings" within the constitutional clause,[157] they are not "work."

A distinction between the recording of an uncopyrighted musical composition and the recording of an artist's rendition of a musical work—whether or not copyrighted—must be drawn. Under the Copyright Act, the proprietor of a recording of an artist's rendition has no statutory protection whatever, whereas the proprietor of the recording of an uncopyrighted musical composition may, as we have seen, register, if he is the composer, and thereby exercise the right

[151] See Savage v. Hoffmann, 159 Fed. 584 (C.C.S.D.N.Y. 1908).

[152] Chaplin v. Amador, 93 Cal. App. 358, 269 Pac. 544 (1928). The theory of protection appears to have been unfair competition, based on "palming off."

[153] 17 U.S.C. § 7 (1952).

[154] Judge L. Hand declared that Congress, and not the courts, should undertake protection of the performing artist. R.C.A. Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir. 1940), at 90; however, no state court is likely to permit bare-faced piracy of performing artists' recordings, when the action for unfair competition is readily available; see note 161, *infra*.

[155] See Chafee, *supra*, note 149, at 734–36.

[156] Various attempts have been made to introduce protection of the performing artist into the Copyright Act. See 2 LADAS, *op. cit. supra*, note 49, at 871–73.

[157] This proposition was assumed by the majority in Capitol Records v. Mercury Records Corp., 221 F.2d 657 (2d Cir. 1955), and articulated in the dissent at 664.

to make first issue of records, and to receive the benefits of the compulsory licensing provision. Hence the reasoning of the *Wheaton v. Peters* case, to the effect that where the Copyright Act offers security, the common law right ceases to exist upon publication, is inapplicable, since the statute offers the performing artist no protection. Because of this difference the group of recent cases discussed above, which declared that sale of a recording of an uncopyrighted musical composition constitutes publication,[158] are not necessarily decisive where the performing artist is involved—he is not flouting the constitutional clause by refusing to register in an attempt to achieve perpetual rights; in fact he cannot register. Several recent cases have explored this problem and have thrown into relief not only the question of publication and treatment of performing artists' renditions, but also the extent of federal power in the copyright field.

Before taking up these cases, the test of publication proposed and applied in the foregoing pages must be reconsidered in the light of the statutory vacuum created by congressional inaction.[159] It will be recalled that under the proposed economic test the author who had begun to capitalize on his intellectual production would be required to make his bargain with the public, and register under the act, trading his perpetual right for a limited monopoly. Under this test, has the performing artist published by selling a recording of his rendition? It would appear not, since Congress has failed to fashion a mechanism by which the performing artist might acquire a right for limited times, and therefore, by implication at least, has left the regulation of the performer's monopoly to the states. The opposing argument, that publication of all "Writings"—works or not—is a federal question, has been developed in Judge Learned Hand's dissent in the *Capi-*

[158] See notes 145–47, *supra.*

[159] The authors of the Shotwell Bill, one of the most sweeping revisions of the Copyright Act proposed in recent years, declined to offer a solution to the performer's right problem, on the ground that "thought has not yet become crystallized. . . ." 86 CONG. REC. 63 (1940) at 78.

*tol Records* case.[160] The evolution of the performer's right doctrine prior to the *Capitol Records* case must be examined as a prelude to consideration of its implications.

In 1938, Fred Waring, a talented orchestra leader with a distinctive style of performance, had recorded several copyrighted numbers and sold the records, which bore the legend "not licensed for radio broadcast." The defendant radio station played them over the air without permission. Waring asked for an injunction in the Pennsylvania state court. The court granted the injunction, holding that the performing artist had a property right in his renditions, that the proprietor could enforce a restriction on use of the records even after sale, and that the proprietor also could recover on a theory of unfair competition.[161]

Paul Whiteman, another orchestra leader, sought similar relief in New York on substantially the same set of facts, relying heaving on the *Waring* case,[162] but on account of the diversity of the parties, the case was tried in the federal courts. The Second Circuit Court denied plaintiff's claim. Judge L. Hand began by assuming for the sake of argument that Whiteman had a common law property right in his performance, and hence a right to prevent others from reproducing the work, as by pressing records of a live performance; but he was unable to agree that the postulated common law property in the records continued after resale, citing in support the *Jeweler's* case.[163] He then declared that the restrictive legend was inoperative—the plaintiff's common law property in the records could not survive sale. The opinion referred to the *Fashion Originators' Guild* case,[164] in which

[160] 221 F.2d at 664 (1955).

[161] Waring v. WDAS Broadcasting Station, Inc., 327 Pa. 433, 194 Atl. 631 (1937). Waring recovered in North Carolina on the same theory, although in the latter case there had been, apparently, no sale of the recording. Waring v. Dunlea, 26 F. Supp. 338 (E.D.N.C. 1939).

[162] R.C.A. Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir. 1940).

[163] *Id.* at 88–89.

[164] Fashion Originators' Guild of America, Inc. v. F.T.C., 114 F.2d 80 (2d Cir. 1940).

the majority of the Second Circuit Court had concluded that common law property rights do not survive publication even where the artistic creation involved, in that case dress patterns, was ineligible for copyright. (The court there denied that *Donaldson v. Becket* was the law in respect of the fourth question put to the judges.) [165] Judge Hand then advanced the argument that a perpetual monopoly after publication was clearly inconsistent with the constitutional policy of finite rights in intellectual property, and that this policy applied even though the particular work was not entitled to protection under the act:

> . . . we see no reason why the same acts that unconditionally dedicate the common-law copyright in works copyrightable under the act, should not do the same in the case of works not copyrightable. Otherwise it would be possible, at least pro tanto, to have the advantage of dissemination of the work at large, and to retain a perpetual though partial, monopoly in it. That is contrary to the whole policy of the Copyright Act and of the Constitution.[166]

Thus the *RCA* decision treated the artist's recorded rendition with the common law principles applicable to a dramatic work: performance would not dedicate, but sale of copies of the intellectual property would have divestitive effect. The court assumed a common law property in the records, without deciding the point.

The existence of a common law property right of the artist in his renditions was given recognition under state law in *Metropolitan Opera Association Inc. v. Wagner-Nichols Recorder Corp.*,[167] where the defendant recording company was enjoined from making master recordings of Metropolitan Opera broadcasts and advertising and selling such records as Metropolitan performances. The court found, citing *Ferris* and *Uproar*,[168] that neither performance at the opera house,

[165] See note 12, *supra*.

[166] 114 F.2d at 89.

[167] 199 Misc. 786, 101 N.Y.S. 2d 483 (Sup. Ct. 1950).

[168] Ferris v. Frohman, 223 U.S. 424 (1912); Uproar Co. v. National Broadcasting Co., 8 F. Supp. 358 (D.C. Mass. 1934), *aff'd*, 81 F.2d 373 (1st Cir. 1936), *cert. denied*, 298 U.S. 670 (1936).

nor the broadcast, dedicated. What the result would have been if the defendant had taken copies of the Metropolitan official records and pressed duplicates from them was not before the court.

The latter question was taken up shortly thereafter by the Second Circuit, in the *Capitol Records* case.[169] Plaintiff and defendant were in possession of identical matrices of records embodying artists' performances of public domain works.[170] The plaintiff, who had sold copies of these records to the public, sought to enjoin defendant from manufacturing similar records. The court held that since the records were not copyrightable, the state law of literary property governed, citing *Erie v. Tompkins*.[171] The court then said that the recent decision in the *Metropolitan Opera* [172] case was that a performing artist's rendition of a public domain musical work was not dedicated by broadcast or performance, and hence it was illegal to sell records made from the broadcast. It followed, in Judge Dimock's opinion, that it would also have been illegal in New York for defendant Wagner-Nichols in the *Metropolitan Opera* case to have taken genuine Metropolitan records which had been sold to the public and pressed duplicates therefrom, and sold the duplicates.[173] Therefore, the law of New York was that the sale of a recording of a performing artist's rendition was not a publication.[174] Applying this assumed rule to the case at hand, the court found that the activities of defendant in pressing duplicate records from

[169] 221 F.2d 657 (2d Cir. 1955).

[170] Plaintiff derived title from a German recording company, defendant from its Czechoslovakian distributor.

[171] 304 U.S. 64 (1938).

[172] 199 Misc. 786, 101 N.Y.S. 2d 483 (Sup. Ct. 1950).

[173] "It would be capricious to enjoin at Columbia's suit sale of records made from the broadcasts of operas while the copying of Columbia's records of the same operas and the sale of the copies thus made were open to all the world." 221 F. 2d at 663.

[174] "We believe that the inescapable result of that case [*Metropolitan Opera*] is that, where the originator, or the assignee of the originator, of records of per-

a matrix identical to plaintiff's were enjoinable, since plaintiff had not dedicated his records by selling copies.

Judge Learned Hand dissented. He agreed that a record was a "Writing" within the meaning of the Constitution, and that Congress had not seen fit to grant copyright protection to artists' renditions embodied in phonograph records; but he asserted that "publication" was in all cases a federal question:

> . . . the states are not free to follow their own notions as to when an author's right shall be unlimited both in user and in duration. Such power of course they have as to "works" that are not "Writings"; but I submit that, once it is settled that a "work" is in that class, the Clause enforces upon the author the choice I have just mentioned; and, if so, it must follow that it is a federal question whether he has published the "work." [175]

He also declared that the need for uniformity required that the states not be free to define the limits of publication in accordance with their own conception of the duration of literary property rights.[176]

Thus in the *Capitol Records* case the vexing question of publication is considered, at least in the dissent, in the broader context of state and federal power over literary property. The issues became sharply drawn because the state law directly conflicted with a federal decision, the *RCA* case. There was room for a deliberate choice between state and federal law because of the silence of Congress in the performers' rights field; there was no statutory scheme to which the court, in defining publication, could refer.

The majority, considering itself bound by state law, may have opened a Pandora's box: the possibility of diverse state decisions and legislation on the scope of the performers' rights lies open. Interpretations of "publication" in the Cali-

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formances by musical artists puts those records on public sale, his act does not constitute a dedication of the right to copy and sell the records." *Ibid.*

[175] *Id.* at 667.

[176] *Ibid.*

fornia and New York state courts would in effect regulate nearly the entire mass-communication industry. Judge Hand's argument against state regulation, on the ground of uniformity and repugnance to the scheme of the Copyright Act of state-created performers' rights, is extensively developed by Professor Kaplan of Harvard in a recent article.[177] Pointing to the difficulties inherent in an attempt to work out performers' rights under the scheme of the act,[178] the author finds considerable support for Judge Hand's contention that the constitutional significance of publication demands federal treatment, preferably by legislation.

As a commentary on publication (traditional test v. economic test) the case is indecisive. Judge Hand, this time in the dissent, continues to maintain that a perpetual monopoly at common law is inconsistent with the purpose of the constitutional clause.[179] By implication at least, he would do away with the notion that performance does not dedicate. The decision of the majority does not preclude a fairly uniform definition of publication, consistent with the purpose of the constitutional clause, which might come about if enlightened state courts and legislatures shaped the concept of publication in conformity with neighboring state court decisions and the policy of the Copyright Act. Such enlightenment, in this writer's view, would consist of application of the economic test in all cases where protection of the work is available under the Act. The real villain of the piece continues to be the *Ferris* case, which, until modified by statute or cut down by exceptions, stands squarely in the way of the fundamental purpose of the constitutional mandate that authors shall have the exclusive right to their respective "Writings" for "limited Times."

[177] Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409 (1956).

[178] *Id.* at 430–39.

[179] 221 F.2d at 667; see R.C.A. Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir. 1940), at 89, for a similar expression by Judge L. Hand, speaking for the majority.

# *Use of the Expert in Literary Piracy*
# *A Proposal*

By EDWARD SILBER

UNIVERSITY OF WISCONSIN LAW SCHOOL

WHEN ASKED the meaning of a number of papermarks in a book he was reading, Lord Byron answered: "Only a book from which I am trying to crib, as I do whenever I can; and that's the way I get the character of being an original poet." [1]

Down through the ages, authors—the great and the not so great—have been borrowing from one another, sometimes with discrimination and other times unblushingly.[2] The works of Shakespeare can be traced back, some of them through several pens to antiquity.[3] In 1887 Andrew Lang summed up conditions in the statement: "originality can be expected from nobody except a lunatic, a hermit, or a sensational novelist." [4]

Only the writer who is unfamiliar with books has a subconscious mind that is not stored with material that has al-

[1] Paull, *The Ethics of Plagiarism*, 128 FORTNIGHTLY REVIEW 212 (Aug. 1927).

[2] Federal District Judge Carter in Loew's Inc. v. Columbia Broadcasting System, 131 F. Supp. 165, 182 (S.D. Cal. 1955), *aff'd*, 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided Court*, 78 Sup. Ct. 667 (March 1958), quoted Rudyard Kipling's poem, "When 'Omer Smote 'Is Bloomin' Lyre," the first stanza of which reads:

> "When 'Omer smote 'is bloomin' lyre,
> He'd 'eard men sing by land and sea;
> An' what he thought 'e might require,
> 'E went an' took—the same as me!"

[3] W. Fitzgibbon, *Other Men's Words*, N.Y. Times Sunday Magazine, Feb. 8, 1953.

[4] Lang, *Literary Plagiarism*, 51 CONTEMPORARY REVIEW 831 (1887).

ready served the uses of other authors. The number of basic plots upon which authors for centuries have built literary works has been generally accepted as thirty-six.[5]

Thus certain properties must necessarily be common to many literary works, and originality when dealing with such familiar properties must lie in their association and grouping in such a manner that the considered work presents a new conception or arrangement of events.[6]

It is difficult to find this new conception or arrangement of events in some fields. Look at the screenplays of a dozen Western movies for any given year and undoubtedly you will find close to a dozen plots that run from first song to the final sunset gallop with only differences in the sizes of the cowboy hero, or listen to several of the surviving radio "soap opera" serials and compare their miseries. They run together in cycles.

This similarity, whether due to borrowing or independent creation, is watched by the judicial eye to sustain and enhance the cultural level of the community. A class of professional authors cannot exist unless its output is protected as its property. By inadequate protection the artistic level of a community may fall; while this is difficult to measure exactly, the possibility is certainly logical. This burden of control rests upon copyright law, which has its origin in the Constitution.[7]

Whereas the primary aim of copyright law is made evident, to benefit the public by promoting culture,[8] and thereby secondarily rewarding the copyright owner;[9] it is an aim

[5] POLTI, GEORGES, THE THIRTY-SIX DRAMATIC SITUATIONS (1924).

[6] Stevenson v. Harris, 238 Fed. 432 (S.D.N.Y. 1917).

[7] U.S. Const. art. I, § 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."

[8] But see Chafee, *Reflections on the Law of Copyright*, 45 COLUM. L. REV. 503, 506 (1945).

[9] See U.S. v. Paramount Pictures Inc., 334 U.S. 131 (1948); and Washingtonian Publishing Co. v. Pearson, 306 U.S. 30 (1939).

difficult to apply. Too little control leads to chaos; too much to stagnation. A delicate balance must be maintained, and some certainty must exist if for no one else but publishers and copyright lawyers.

It has been repeatedly stated that one reason why new authors find it difficult to sell their material to magazines is the extreme caution exercised by publishers in buying material from "unknowns." Part of this overcaution is due to the almost complete uncertainty a defendant faces when the naïve test now used by the courts to determine copying is applied. The drastic effect on our cultural scene is all too apparent.[10]

It is submitted that the courts today treat the question of appropriation unscientifically when it can be treated scientifically, and inconsistently when it should be treated consistently; therefore the purpose of this paper is a proposal for legislation to alter the method of dealing with infringement actions.

The opinion that the judiciary is inconsistent and unscientific is not a blanket charge as such. The basis of the law today is sound; a study of copyright infringement proves it is in the application of the law that the courts err. Such study must begin with those basic elements.

The foundation of any discussion of an infringement action is the definition of infringement itself. Infringement is the copying of all or of a material or substantial part of a copyrighted and copyrightable work to which the infringer has had access. The problem is frequently not whether there was theft, but whether the thing supposedly infringed was copyrightable or protectible in the first place. That is, was it something which could be owned by the plaintiff author.

The several steps to an infringement action follow.

[10] We do not maintain that the beginning author is at all aware of copyright law, much less concerned with it; but through such overcaution he is affected by it. Too many rejection slips will drive the less persistent but not necessarily less talented fledgling from the literary community.

Whether the law is protecting the common law right, or whether the protection is granted under the Copyright Act,[11] the same principles, on the whole, govern the question of whether or not there has been appropriation by one of the work of another. The plaintiff must first show that his property is the product of his own effort. Certificate of copyright registration is prima facie evidence of facts stated therein and, in the absence of contradictory evidence, establishes a valid copyright in the holder.[12] If the plaintiff is relying on a common law copyright, he must introduce in evidence the original manuscript (or other work which constitutes his creation) and prove that his work was completed previous to the defendant's.[13]

Next, the court must be shown that the defendant had access (*i.e.* the opportunity to copy plaintiff's property). Access can be determined by a business association between the parties, the testimony of witnesses, or the fact that the work was published previous to the defendant's or at least submitted to someone with whom the defendant had dealings. Lastly, the copying of a substantial and material part of the infringed work must be proved.

The crucial points in the steps of an infringement action are the questions of the protectibility of portions of the plaintiff's work, and the determination of whether there was in fact copying.[14]

In considering what is here called protectibility, section four of the Copyright Act states: "The works for which copyright may be secured under this title shall include all the writings of an author." [15] The word "writings" as used here

[11] 17 U.S.C. §§ 1–215 (1952).

[12] Wihtol v. Wells, 231 F.2d 550 (7th Cir. 1956).

[13] This is often done by the plaintiff's submitting in evidence a sealed envelope (enclosing his manuscript) mailed to himself at time of completion.

[14] Whether or not the alleged infringer intended to infringe copyright is immaterial. Metro Associated Services v. Webster City Graphic, 117 F. Supp. 224 (N.D. Iowa 1953).

[15] 17 U.S.C. § 4 (1952).

is liberally construed by the courts to mean any composition which is original, that is, the product of intellectual labor.[16] But by construing original in the above sense, the courts do not protect all that is actually original in a literary work.[17] The work in question is broken down into its components and each analyzed separately to determine protectibility. They are not protectible unless highly developed, for it is not these abstract elements themselves which are copyrightable but their creator's method of expression.[18]

A discussion of the elements of a literary work should be useful here.

*Title.* The copyright of a work does not give the copyright owner the exclusive right to the use of its title. The title will be protected only under the theory of unfair competition.[19] This situation arises when a title has attained a secondary meaning so that mention of the title leads another person to assume that it naturally refers to that particular work. The court is trying to prevent the infringer from cashing in on the creator's popularity and also to shield the public from deception, so the test of infringement is whether or not the public has been misled.[20]

*Plot.* The plot of a literary work consists of a "sequence of events" through which the author expresses his theme or basic idea.[21] This bare basic plot, as such, is never protected.

[16] BALL, LAW OF COPYRIGHT AND LITERARY PROPERTY 65 (1944).

[17] We omit from this discussion all art other than literary property, and include all literary property regardless of the medium in which it is expressed, including books, short stories, plays, and motion pictures; and it may well be that the criticism and proposals in this paper would be inapplicable to musical infringement actions. Orth, *The Use of Expert Witnesses in Musical Infringement Cases*, 16 U. PITT. L. REV. 232 (1955).

[18] Loew's Inc. v. Columbia Broadcasting System, 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd*, 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided Court*, 78 Sup. Ct. 667 (March 1958).

[19] Becker v. Loew's Inc., 133 F.2d 889 (7th Cir.), *cert. denied*, 319 U.S. 772 (1943).

[20] See Lone Ranger Inc. v. Cox, 124 F.2d 650 (4th Cir. 1942), and Chaplin v. Amador, 93 Cal. App. 358, 269 Pac. 544 (1928).

[21] Shipman v. R.K.O. Radio Pictures Inc., 100 F.2d 533, 537 (2d Cir. 1938).

However, a plot which has been elaborated to the point of being a highly developed series of dramatic situations is protected. The courts have the difficult task of drawing the line, for in the vast majority of cases the plots lie somewhere between such extremes.

The trial court originally dismissed the infringement complaint in a case in point, *Sheldon v. Metro-Goldwyn Pictures Corp.*[22] This action began after the Edward Sheldon and Margaret Bayer Baines play *Dishonored Lady* had been rejected by M.G.M. because of the Hays office censor, although the studio subsequently filmed a novel, by Belloc Lowndes, which was based on the facts of the same Scottish murder trial.

In both works a girl of good family rushes into a purely physical affair with an adventurer, then falls in love with someone else. She tries to sever bonds with her lover, but he refuses and threatens that if she persists in leaving him he will expose her (he has in his possession compromising letters of hers). She, desperate, arranges a meeting, at which the two argue furiously; he sips a drink which she has brought into the room and dies of poisoning. His death is investigated, and the girl is suspected of administering the poison. She is about to confess when she is saved by a strange man who comes forth and swears that she spent the night in question in his rooms with him.

Although the details of the criminal case had been in the public domain for many years, details occurred in the play and the movie script which were not found either in the novel or in the facts of the case. The circuit court of appeals, deciding that the plot was developed to the point where it was protectible, found in favor of the plaintiff and remanded the case to the district court for a determination of damages.[23]

[22] 7 F. Supp. 837 (S.D.N.Y. 1934), *rev'd*, 81 F.2d 49 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936).

[23] Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936).

*Theme.* The theme of a literary work itself is rarely the basis of a suit for infringement and rightly so, for the theme, or general subject matter, is not copyrightable.[24] However, different themes often embody their own peculiar adornments. Witness the traditional confession story, appearing in a number of pulp magazines every month and always carrying the familiar sin and repent theme. Certain involvements or only a slight variation of involvements appear in every one.[25]

*Ideas.* The Copyright Act does not extend protection to the ideas of a work but only to their expression, if a concrete combination of these ideas has been appropriated.[26] Here again no one has yet determined the distinction between literary effort which is a mere uncopyrightable idea and that which is sufficiently concrete to warrant protection.

The court determined the author's expression of ideas was not appropriated in *Nichols v. Universal Pictures*,[27] where only the unprotected ideas had been taken. It stated:

> The only matter common to the two [plays] is a quarrel between a Jewish and an Irish father, the marriage of their children, the birth of grandchildren, and a reconciliation. . . . Though the plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too generalized an abstraction from what she wrote. It was only a part of her "ideas." [28]

*Setting.* Locale is not protected as literary property by copyright or common law protection. It is in the common fund of literary composition to which no one can claim ownership.[29]

This result was reached in the case of *Christie v. Harris*,[30]

[24] BALL, *op. cit. supra* note 16, at 117.

[25] The quality of a literary work has no bearing upon its protectibility.

[26] Stanley v. Columbia Broadcasting System, 35 Cal.2d 653, 221 P.2d 73 (1950); National Comics Publications v. Fawcett Publications, 191 F.2d 594 (2d Cir. 1951).

[27] 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931).

[28] *Id.* at 122.

[29] Schwartz v. Universal Pictures Co., 85 F. Supp. 270 (S.D. Cal. 1945).

[30] 47 F. Supp. 39 (S.D.N.Y. 1942).

where the plaintiff charged defendants had infringed her play *Through the Looking Glass* when they wrote and produced the play *Stage Door*. As to what similarity existed, the court said:

> True the story in each is of the stage, of actresses, playwrights and managers. True the first act in each play takes place in a boarding house for young actresses. This does not point to piracy. It is a common topic; many plays and stories have been written about the stage and about the struggles of young actresses, their successes and failures.
>
> Similarity of background does not give rise to an action for infringement. . . . That both authors should pick out an actual boarding house for actresses is not uncommon or strange.[31]

*Characters and Historical Events.* The stock character is never protectible. He is generalized, with stock physical traits and mental qualities which necessitate some similarity when two works make use of the stock character. In the *Nichols* case, the court stated: "It follows that the less developed the characters, the less they can be copyrighted; that is the penalty an author must bear for marking them too indistinctly." [32]

Again the courts must draw the fine line necessary to determine exactly where the character steps from the bounds of vague generality into concrete originality and this again is a question of degree, for the new character may be so closely imitated as to amount to an infringement.[33]

Historical figures and events belong to no one and are available to everyone who chooses to write about them; though each author must go to primary sources and not to previous works in which they are mentioned.

The case of *Funkhouser v. Loew's Inc.*[34] illustrates the unprotectibility of historical figures and events. When the producers of the movie *The Harvey Girls,* which depicted the lives of the waitresses in the Fred Harvey restaurant chain

[31] *Id.* at 41. [32] 45 F.2d at 121. [33] *Ibid.*

[34] Funkhouser v. Loew's Inc., 208 F.2d 185 (8th Cir. 1953), *cert. denied,* 348 U.S. 843 (1954).

in the old West, was sued for infringement, the court said: "Almost every story and motion picture about the old West contains some stereotyped roles of hero, heroine, and villain. Necessarily, character traits of individuals portraying these roles will exhibit similarities." [35] It further stated that since information for *The Harvey Girls* had come in both works from the same source, there were bound to be similarities in setting as well.[36]

Although the question of what is protected in a literary work is generally stated in specific terms, as to the important components of each work, the court is forced to make judgments based on its own knowledge of literature and authorship. Where, for example, lies the division between a "bare, basic" and a "highly developed" plot? When does a character leave the realm of the abstract and take on protectible characteristics? The courts are unable to answer these questions consistently and unwilling to rely upon any scientific method of determination. Decisions reflect the impatient and sometimes scornful attitude the courts take toward the meticulous analyses of the parties' own expert witnesses.

If the determination of copying, which must be proved to recover,[37] rested on direct evidence such determination would be greatly simplified. However, the plaintiff in the infringement action must prove by circumstantial evidence, access, and similarity, which, together, constitute proof of copying. Access must be present in a degree which complements the degree of similarity which is never enough to prove copying alone, even if the two works parallel one another exactly.[38] Judge Learned Hand has stated: ". . . but if by some magic a man who had never known it were to compose anew Keat's Ode on a Grecian Urn, he would be an 'author,' and, if he

[35] *Id.* at 189. [36] *Ibid.*

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

[38] Fred Fischer v. Dillingham, 298 Fed. 145 (2d Cir. 1930).

copyrighted it, others might not copy that poem, though they might of course copy Keats's." [39]

Copying is made more difficult to determine because it is not confined to literal repetition, but includes any variation, coloration, paraphrasing, or evasion which calls to mind the original. Within the meaning of the Copyright Act, a copy may be defined as that which would cause the average, ordinary man to recognize promptly, with no external aid or analysis, that it was so like the original as to cause him to believe that it was taken or reproduced from the original.[40]

Not only must the plaintiff prove copying, but he must also prove to the court that such copying was illicit and that the copied matter was a substantial and material portion of the work.[41] The word substantial as used here refers to quantity while material refers to quality, the importance to the whole of the part copied. Substantiality need not be present if materiality is proved; and whereas substantiality may be measured to a more exact degree, the question of materiality is a value judgment which must be made by the courts.

In 1892, it was said that a defendant might appropriate a separate scene or part of the dialogue of a play without taking substantially from that play.[42] However, using the definition of "material" found in infringement cases, if that scene or dialogue were sufficiently important to the play, the defendant could be guilty of infringement.

[39] Sheldon v. Metro-Goldwyn Pictures Corp., 81 F.2d 49, 54 (2d Cir.), *cert. denied*, 298 U.S. 669 (1936).

[40] McConnor v. Kaufman, 49 F. Supp. 738 (S.D.N.Y.), *aff'd*, 139 F.2d 116 (2d Cir. 1943).

[41] The need for ruling that the copying be of a substantial and material nature is evident; it is nearly impossible to write without unconsciously copying something which has been set down before. Tennyson was quoted by Paull as writing: "They will not allow one to say 'Ring the bell' without finding that we have taken it from Sir Phillip Sydney, or to use such a simple expression as 'the ocean roars' without finding out the precise verse in Homer or Horace from which we have plagiarized it." Paull, *supra* note 1, at 213.

[42] Daly v. Webster, 56 Fed. 483 (2d Cir. 1892) (dictum), *appeal dismissed*, 163 U.S. 155 (1896).

The judge makes such value judgments with no special training to help him determine what makes a literary work successful; yet the entire case could rest on a determination which is obviously a literary matter.

In the often cited case of *Caruthers v. R.K.O.*,[43] the court found that all the incidents save one which were common to both the plaintiff's unpublished work and the defendant's movie (based on Edna Ferber's novel *Cimarron*) were similar only because the background of both was in the Western frontier days. The only exception to this type of similarity occurred in a scene in which a little Negro boy was fanning a dinner table to shoo away flies. In both he was so carried away that he lost his balance; in one work he struck one of the diners and in the other fell into a frosted cake. The court ruled that this one incident was of too little importance to consider as copyright infringement even if it were original with the plaintiff.

Normally, however, it is more difficult to determine what has been copied by the alleged infringer, and the court must consider not only the quantity, quality, and value of the appropriated matter, but also the purpose for which it was published, by the defendant, as compared with the purpose of the original and the extent to which the plaintiff is injured by the appropriation. Litigants should have the right to rely on the court's understanding of the values of certain literary mechanisms which are included in most literary works. For example, what is the value of *scènes à faire*, *i.e.* scenes which must follow an earlier basic scene. Early identical situations found in two works, unimportant, common, and unprotected in themselves, call for scenes to follow which must be similar. An illustration is that of the man who cuts himself early in the plot of a mystery and wipes the blood on his handkerchief; the blood stained cloth later links him to the crime. Few decisions even show a recognition of this element of

[43] 20 F. Supp. 906 (S.D.N.Y. 1937).

creative writing.[44] Another example of a significant element of literary technique is the method used by an author to move his characters from one scene or one mood to another; the exact value of such mechanisms can be determined only by someone whose profession and training lies in the literary field.

In the determination of substantiality and materiality in copying it must be remembered that the copyright of a work does not decree that the work cannot be touched by others at all. According to the doctrine of fair use, others than the owner of a copyright may use the copyrighted material in a reasonable manner without the owner's consent.[45] Fair use is technically copyright infringement since the Copyright Act makes no provision for it; it is a privilege implied by the courts as necessary to the promotion of the progress of useful arts and science as decreed by the Constitution. Without it, authors could have no incentive to improve on prior works.[46]

The legal test used to determine if use is fair or unfair is whether or not the amount taken will reduce the demand for the original. The limits vary with the scope and purpose of different works and are impossible to apply uniformly. Infringement was found in a case where an advertisement for a popular cigarette quoted three lines from a medical book,[47] and again when 15 percent of a French textbook was stolen for use in another text.[48]

In discussing the question of fair use, the field of burlesque should be treated separately. While burlesque is as old as art itself, it is just coming into prominence as a subject

[44] An exception is Judge Yankwich in Schwartz v. Universal Pictures Co., 85 F. Supp. 270 (S.D. Cal. 1945).

[45] The most common example occurs in a critic's review of a book or play.

[46] BALL, *op. cit. supra* note 16, at 260.

[47] Henry Holt and Co. v. Liggett and Myers Tobacco Co., 23 F. Supp. 302 (E.D. Pa. 1938).

[48] College Entrance Book Co. v. Amsco Book Co., 119 F.2d 874 (2d Cir. 1941).

for infringement actions. The advent of radio and television comedy shows has opened the field for comedy writers who parlay a one- or two-hour motion picture into a fifteen- or twenty-minute "take-off" prepared for a national audience. Although the purposes of burlesque are at variance with those developed in cases involving infringement found in non-comic works, the same standards of judgment are used.

Loew's Inc. successfully brought an infringement action against the Columbia Broadcasting System, Jack Benny, and his sponsor, the American Tobacco Company, for the performance of a humorous sketch, produced on both radio and television, entitled "Autolight" which burlesqued the motion picture *Gaslight.* The court determined in this case that an author may not take substantially all of a copyrighted work and defend such taking on the ground that the alleged infringing work was burlesque.[49]

The court found infringement without dealing with the question of whether or not the parody reduced substantially the success of the original. However, the issue of reduced demand was the exclusive ground for the decision in the case of *Hill v. Whalen and Martell, Inc.*[50] The creators of the cartoon strip "Mutt and Jeff" sued a competitor who produced a dramatic skit entitled "Nut and Giff," and recovered by showing that the imitator substantially reduced the demand for their strip.

The court found for the defendant in the case of *Columbia Pictures Corp. v. National Broadcasting Company,*[51] where the plaintiff sued for the alleged infringement of the movie *From Here to Eternity* by Sid Caesar in a playlet entitled "From Here to Obscurity." The court felt that the taking here was sufficient only to cause the viewer to recall and conjure up the original, a necessary element of burlesque and not a

[49] Loew's Inc. v. Columbia Broadcasting System, 131 F. Supp. 165 (S.D. Cal. 1955), *aff'd,* 239 F.2d 532 (9th Cir. 1956), *aff'd by an equally divided Court,* 78 Sup. Ct. 667 (1958).

[50] 220 Fed. 359 (S.D.N.Y. 1914). [51] 137 F. Supp. 348 (S.D. Cal. 1956).

substantial taking. The opinion further recognized that the playlet did not constitute unfair competition while stating: "Unlimited and unrestrained taking by burlesque could destroy the Copyright Act . . . undermine the motion picture industry, the legitimate stage, and reduce the author to his status of three hundred years ago. . . ." [52]

In a rare recognition of the policy choices behind the linguistics of copyright law, Judge Carter said in *Columbia Pictures Corp. v. National Broadcasting System*, that the court was here working in a new field, trying primarily to decide just what television may and may not take from motion pictures for its shorter productions.[53]

The method which the courts use and repeatedly state is the only answer to the problem of proving similarity in an infringement action is the "ordinary observer" test, or the common knowledge of the average reader, observer, or listener.[54] The courts feel that literary works are written for the consumption of and impression upon great numbers of ordinary people and not for just a few critics or literary experts; therefore, if there is literary piracy, it should be detected by the ordinary person alone.

At present, the courts compare the two works in both their protected and unprotected portions to determine similarity, because, as has been stated:

> The importance of permitting a plaintiff to show similarities between all of the parts of his work, both the protected and unprotected parts, and the defendant's work rather than limiting similarity comparisons to only the protected parts of a plaintiff's work is best illustrated by a hypothetical situation. If we assume that there is but one sentence of a plaintiff's work which is both protected and material and the vast residue is unprotected, and the claim is the copying of this one sentence by evasion, obviously a holding which excludes a showing of identity or close similarity between the vast unprotected residue of plaintiff's work and the bulk of a defendant's work would eliminate

[52] *Id.* at 351.
[53] *Id.* at 350.
[54] Roe-Lawton v. Hal E. Roach Studios, 18 F.2d 126, 128 (S.D. Cal. 1927).

any possibility of a finding of copying of the one protected sentence.[55]

An equally persuasive argument can be made for the method of using only the protected portions of plaintiff's work in the comparison.[56] The point the latter argument makes is that the present mode of comparison is highly prejudicial to the defendant. It is reasonable to believe that an expert could deal with the unprotected portion without having this influence him in determining whether there was illicit copying.

It has been held that there is no infringement in a motion picture "unless the public is deceived by the picture, and led to believe that the films are a picturization of the plaintiff's literary work." [57]

Admittedly, the great majority of literary work is intended to entertain or inform the average man, but it also follows that the literary pirate will attempt to deceive this average man into thinking that the infringing work is original. By using this test, only the inept or inaccurate infringer is detected.

An example of inaccurate appropriation occurred in the case of *Acosta v. Brown*.[58] Mercedes DeAcosta wrote and circulated to the movie studios a screenplay based on the life of Clara Barton, in which she added to the facts several fictional characters including a lover for Miss Barton and a postal clerk named Eyra. Beth Brown's novel, entitled *Dedicated to Life* and also based on the life of Clara Barton, later appeared containing the same fictional characters with the same historical data. In her testimony Miss DeAcosta stated that the name Eyra, which also appeared in the defendant's book, was actually a misspelling by her typist of the name

[55] Morse v. Fields, 127 F. Supp. 63, 66 n. 3 (S.D.N.Y. 1954).
[56] Note, 38 CALIF. L. REV. 332 (1950).
[57] Roe-Lawton v. Hal E. Roach Studios, 18 F.2d 126, 128 (S.D. Cal. 1927).
[58] 50 F. Supp. 615 (S.D.N.Y. 1943), *aff'd sub nom.* Acosta v. Brown, 146 F.2d 408 (2d Cir. 1944), *cert. denied*, 325 U.S. 862 (1945).

Ezra. The lower court found for the plaintiff because the evidence was "so overwhelming as to exclude coincidence almost to a mathematical certainty." [59]

One can only speculate on the result the court would have reached if names, dates, and some incidents had been changed, because then it would be a case where the ordinary observer could more easily be misled than would the literary expert into believing the works too dissimilar to show copying.

An example of the inconsistencies resulting from use of the present test is found in the case of *Lloyd v. Witwer*, in which the trial court's finding of infringement was reversed by the appellate court.[60] Witwer was the author and copyright owner of a story entitled *The Emancipation of Rodney*, which concerned a shy, unathletic boy who entered college aspiring to be popular, fell in love with a girl, went out for football to impress her and failed at it, but through a series of unlikely incidents entered and won the last and crucial football game of the season.

Witwer was summoned by Harold Lloyd, who had been considering a movie along those general lines, to discuss a movie based on the story. Although the idea collapsed, Lloyd continued to think about such a movie until the idea for *The Freshman* was conceived. Work was started on the script and Lloyd, worried about an infringement suit by Witwer, saw him to discuss the work done on the movie to that point; he later swore Witwer raised no objections. About this, the majority opinion of the circuit court of appeals stated:

> . . . [it] is to be considered as an admission and as persuasive evidence that on October 4, 1924, the play, as then developed and as stated to Witwer at that time, did not infringe the copyright, and this . . . covers the theme, and in large measure, the plot and sequence of events relied upon by the appellee to show infringement.

[59] *Id.* at 616.

[60] 65 F.2d 1 (9th Cir. 1933), *reversing* 46 F.2d 792 (S.D. Cal. 1930), *appeal dismissed*, 296 U.S. 669 (1933).

It is persuasive evidence that at that time there had been no copying, plagiarism, or piracy, and if accepted, would limit our inquiry with reference to similarities to those portions of the play developed subsequent to the fourth of October, 1924.[61]

There is no reason why the opinion of Mr. Witwer should have entered into the case. If a man whose auto had been stolen mistakenly believed that an auto in a thief's possession was not his, he would not be deprived of his property. In this case, Witwer apparently had every reason to let the defendant complete the movie in order to recover.

Whereas the trial court listed the many similarities of substance or plot found in its comparison of the two works, the usual position taken by an appellate court is similar to the reasoning found in *Kustoff v. Chaplin:*

Appellant has presented a detailed account of alleged similarities between book and film. Such comparison is entirely unpersuasive of plagiarism. It is our view that no useful purpose would be served to discuss in detail such claimed similarities. The book and film are so essentially dissimilar that in our opinion the evidence would not support a finding of substantial copying had one been made.[62]

The appellate court in the *Witwer* case further stated that its decision was based on the fact that it believed that a spectator viewing the movie two or three weeks after a casual reading of the story would not believe that he was seeing in motion picture form the plaintiff's story or any part of it. The court mentioned differences between the appearance, name, and character of Rodney and Harold, and in the two football game episodes.[63]

It is not the emotions of the reader which are measured in determining copyright infringement but the form in which situations are described to arouse the emotions.[64] It is submitted that this is entirely too delicate a matter to be balanced by the ordinary observer.

[61] *Id.* at 15–16.
[62] 120 F.2d 551, 561 (9th Cir. 1941).
[63] 65 F.2d at 27–28.
[64] BALL, *op. cit. supra* note 16, at 344, 345.

Other inconsistencies arise under the test used today. In 1953, in the case of *Burtis v. Universal Pictures*, the California court stated:

> Although the court will dissect a literary production to determine what portion thereof is protectable . . . it will not dissect the protectable portion to discover isolated similarities as to each segment of the whole.[65]

However, a federal district court in *Warshawsky v. Carter*[66] held to the contrary. The plaintiff there was suing for infringement of his copyrighted story which appeared in serial form under the title *The Heart Compelled* in *Woman's Home Companion* from February through May of 1933, and which appeared in book form under the title *Woman of Destiny* during the year 1936. The defendant's alleged infringing story appeared serially in five issues of *Collier's* in March and April of 1948.

Each story has as its theme a woman becoming president of the United States via the route of the vice-presidency. Among the similarities are: In both the leading character is a woman who has attained some political prominence and who seeks to obtain national recognition of a program to which she is dedicated; both depict a political leader hostile to that program; both women gain strength in the national political convention with the result that each is nominated vice-president and subsequently elected; and both women attain the presidency, one by the death of the president and the other by his mental incapacitation. In both stories, the party leaders and cabinet members oppose the woman's incumbency and threaten to resign, but the acquisition of evidence of discreditable action on the part of the party leaders is used to enlist their aid in both heroines' administrations.

The court dismissed most of the similarities because they

[65] Burtis v. Universal Pictures Co., 40 Cal.2d 823, 832–33, 256 P.2d 933, 946 (1953).

[66] 132 F. Supp. 758 (D.C.D.C. 1955).

were of a kind which would normally occur in two stories dealing with a woman becoming president of the United States. Therefore it felt that while access was shown and while there was substantial similarity (in what the court called "theme" but by which it very likely meant "highly developed plot"), nevertheless the similarity was not due to copying.

To arrive at this conclusion the court abandoned the old "ordinary observer" crutch and the trite maxim about the court's being a library and not a dissecting room by its remark: "Unless subjected to a very critical analysis, one could easily reach the conclusion, . . . that there was piracy." [67]

Further clouding the scene is the fact that there are many unfounded and fraudulent claims. It is significant that just slightly under 40 percent of all the authors whose works ran for more than two hundred performances on Broadway between 1910 and 1930 were charged with infringement by an "unknown," and more significant that not one of these charges was proved.[68] There is, of course, the prevalent fear of denying the plaintiff his day in court, which can be more disastrous and far-reaching in this area than in other areas of the law.

Summary judgment under the Federal Rules [69] which could be used here to avoid unnecessary litigation, has not been successfully relied upon to any extent by authors defending against fortune hunters' suits. Typical of judicial holdings on summary judgment motions is that found in *Arnstein v. Porter:* "Although part of plaintiff's testimony on deposition . . . does seem 'fantastic'; yet plaintiff's credibility, even as to those improbabilities, should be left to the jury." [70]

The effect of such decisions is to virtually eliminate the possibility of avoiding trial. Only in rare instances does the

[67] *Id.* at 761.
[68] Pollock, *The Plagiarism Racket*, 60 AMERICAN MERCURY 613 (1945).
[69] FED. R. CIV. P. 56.
[70] 154 F.2d 464, 469 (2d Cir. 1946).

plaintiff have any difficulty in showing some slight similarity.

A classic example of both the unjust claim and the overcaution of the courts occurred a few years ago in the case of *MacDonald v. DuMaurier.*[71] Edwina MacDonald brought suit against the noted novelist Daphne DuMaurier in which she claimed that Miss DuMaurier's *Rebecca* had been stolen from her novel *Blind Windows.* The plaintiff's book, which had been published ten years before *Rebecca* appeared, had grown out of her confession story, *I Planned to Murder My Husband.*[72] It was seven years after the action was started when it finally came to trial in 1948. Originally, the trial court had dismissed the complaint on the ground that the claimed similarities resulted only from use of the same basic plot. Upon appeal, however, a divided circuit court reversed the trial court.[73]

Miss DuMaurier came to New York from England for the trial (her first trip to our shores). Harrison Smith, one of the editors of *The Saturday Review of Literature* and a literary man of long standing and great repute, who was used as an expert witness in the case, had this to say:

> However popular it [*Rebecca*] proved to be, the book was a work of literature, the characters were vital and alive and the atmosphere of suspense necessary in a novel of this sort was achieved with masterly skill. The evidence of the novel's originality was plain for anyone to see. . . .
>
> And yet here was a trial that dragged an author across the Atlantic. The scene in the darkly impressive court room on Foley square was grim enough. Miss DuMaurier sat in the witness chair bowed forward and answered her accusers in a quiet and calm voice. She was obviously suffering and deeply embarrassed. She might well have been, since the lawyers for the plaintiff quoted sentences she had written

[71] 75 F. Supp. 655 (S.D.N.Y. 1948).

[72] It is interesting to note that Mrs. MacDonald's attack was the second against REBECCA. The first was A SUCESORA, a Portuguese-language novel by Carolina Nabuco of Brazil, which was said by many who read it to be more similar to REBECCA than was BLIND WINDOWS. No action was taken. LINDEY, PLAGIARISM AND ORIGINALITY 112 (1952).

[73] 144 F.2d 696 (2dCir. 1944).

about her father and her family, for example, that some of them could lie charmingly if they wanted to, and that a feminine ancestor or two had broken more than one of the commandments. She was accused by indirection of inheriting their levity and therefore of being capable of not telling the truth as a witness and of being an immoral woman. Judge Bright was scrupulously fair throughout, but it seemed to be impossible in this kind of trial in which a writer's honesty is impugned to keep out what anywhere but in the courtroom would be plain libel . . . Some way must be found of preventing this injustice and manifest injury to a writer's purse and his honor.[74]

In the foregoing case, the testimony of Harrison Smith as an expert witness was at least admitted in evidence, contrary to the view of Learned Hand expressed in the *Nichols* case:

> The testimony of an expert . . . ought not to be allowed at all . . . the more the court is led into the intricacies of dramatic craftsmanship, the less likely it is to stand upon the firmer, if more naïve, ground of its considered impressions upon its own perusal. We hope that in this class of cases such evidence may in the future be entirely excluded, and the case confined to the actual issues; that is, whether the copyrighted work was original, and whether the defendant copied it, so far as the supposed infringement is identical.[75]

The attorney for the plaintiff in the *Nichols* case was Moses L. Malevinsky, who in 1925 wrote a book entitled *The Science of Playwrighting* in which he set forth an algebraic formula to determine the existence of copying [76] which has been the object of much derision without explanation. The formula, as set down by Malevinsky, is too inflexible; however, its main

[74] "The Rebecca Case," The Saturday Review of Literature, Feb. 7, 1948, p. 18.

[75] 45 F.2d at 123 (2d Cir. 1930).

[76] The formula states that any play, as represented by *X*, is the product of the sums of *A*, a basic emotion or an element in or of a basic emotion; *B*, character; *C*, motivated through (1) crucible, (2) conflict, (3) complications and/or intrigue to ultimate, (4) crisis and climax; *D*, progressed by narrative, plot, or story; *E*, compartmented by derivative situations; *F*, dressed up by incidental detailed construction; *G*, the underlying idea oriented through its constituent elements as dramatically expressed; *H*, articulated by words; and *I*, imagined with artistry. Only *A* plus *B* plus *C* could prove infringement even though the other six elements did not coincide, since they could be deliberately altered to thwart detection; and other characters and situations could be added and subtracted if the "organic structure" remained the same.

elements or similar elements could be used as a working tool by the literary expert. The main criticism of the formula is that it is completely useless unless applied by such unbiased experts.

Yet, the courts use the expert witness not at all or in the wrong capacity. Often judges are confused and the expert witness is forced to literally perjure himself when both sides call expert witnesses causing them to refute one another. This practice results in having the partisan experts called by the parties frequently confuse, annoy, or amuse judges, rather than inform.[77] In copyright cases particularly, the courts often take judicial notice of expert testimony, usually without even mentioning it.

Even as late as 1948 a district court concurred with Judge Learned Hand's opinion that expert testimony ought not to be used at all. The judge stated: ". . . I am glad to concur in the most emphatic way in Judge Learned Hand's observation in *Nichols v. Universal Pictures Corp.* . . ." [78]

However, the expert witness has been used to some extent although his testimony is still being treated as secondary rather than primary evidence.[79] In *Shipman v. R.K.O. Radio Pictures Inc.* the court stated that it felt that the audience test was inconclusive because, used alone, it cannot determine "whether the identity of the impression conveyed might be due to the 'nature of the subject' or because both authors used 'common materials and common sources.' " [80]

This case is not without precedent. In 1918, in *Frankel v. Irwin*, the court recognized that "the investigation [of infringement] should be gauged to the kind of man who does the sort of work under consideration. . . ." [81] Experts were

[77] Beuscher, *The Use of Experts By The Courts*, 54 HARV. L. REV. 1105, 1105–06 (1941).

[78] Burns v. Twentieth Century-Fox Film Corp., 75 F. Supp. 986, 992 (D.C. Mass. 1948).

[79] Encyclopaedia Britannica Co. v. American Newspaper Ass'n. 130 Fed. 460, 461 (C.C.D.N.J. 1904), *aff'd sub nom.* Werner Co. v. Encyclopaedia Britannica Co., 134 Fed. 831 (3d Cir. 1905).

[80] 100 F.2d 533, 536 (2d Cir. 1938). [81] 34 F.2d 142, 144 (S.D.N.Y. 1918).

used to determine the extent of damages, about which the ordinary observer admittedly knows little, in *Universal Pictures Co. v. Harold Lloyd Corp.*[82]

However, the courts have yet to realize completely that copyright infringement falls into the class of cases in which:

> . . . the conclusions to be drawn from the facts stated, as well as knowledge of the facts themselves, depend upon professional or scientific knowledge or skill not within the range of ordinary training or intelligence.[83]

The only test which should be used to determine the admissibility of opinion evidence in piracy actions should be whether the witnesses' knowledge will aid the court in its search for truth. Certainly we cannot attack its admission on the ground that the knowledge of the witness is not superior to that of the court.[84]

The courts in their capacity as ordinary observers cannot hope to recognize many elements of a literary work which are easily altered to avoid detection of similarity, but which are actually fundamentally alike. The literary expert would be able to easily spot these elements which the courts do not even consider in infringement cases today, and could use them as part of his master plan. An example is symbolism.

The use of symbolism in literature presents a peculiar, heretofore untouched, problem in the determination of infringement. It is entirely possible for an author to compose an entire work, an allegory, by use of symbolism exclusively.

[82] 162 F.2d 354, 369 (9th Cir. 1947). See also discussion in Sheldon v. Metro-Goldwyn-Mayer, 309 U.S. 390, 403–408 (1940) (expert testimony on damages resulting from infringement should be allowed "whenever it is found to be competent").

[83] Dougherty v. Milliken, 163 N.Y. 527, 533 (1900), quoted with approval in ROGERS, EXPERT TESTIMONY 637 (3d ed., Werne 1941).

The oft-cited case of Lawrence v. Dana, 15 Fed. Cas. 136, No. 8136 (C.C. Mass. 1869) held that copyright cases should be referred to a master for his opinion as to the existing similarity, and for a report as to the nature and extent of the infringement.

[84] Individual judges' knowledge of literature and literary craftsmanship, which shows through in many opinions, varies a great deal; while a judge may be highly qualified, frequently he is not.

If another author were to steal the entire "highly developed plot" from the allegory and build it into another work by using the ideas which appeared in the former as symbols, would the second author be guilty of infringement? This writer has come across no case which discusses the problem. It is more than probable that, were the two works read by an ordinary observer, no similarity would even be found. Yet, there has been borrowing of what surely would amount to a substantial and material degree.

The closest example of this point is illustrated by a charge which never reached the courts. Thornton Wilder's play, *The Skin of Our Teeth*, was received with divided reaction when it appeared in 1934. Yet, even those who thought the play less than wonderful, felt it at least was breaking new ground in the field of drama. Only two critics, Joseph Campbell and Henry Morton Robinson, recognized the play as a thinly disguised, Americanized version of James Joyce's *Finnegans Wake*.[85] They stated that important plot elements, characters, devices of presentation, as well as major themes and many of the monologues, were directly and frankly imitated. What controversy resulted, never reached the courts.

However, the incidence of such a charge illustrates the need for a means of dealing with the problem when it reaches the courts and such an answer will never be found in the "ordinary observer" test.

From the numerous foregoing observations, it is basically concluded that:

(1) The problem of applying the rule of protectibility in a literary work as well as the determination of materiality in copying should be delegated to an expert rather than relying on the literary ability of a judge.

(2) The "ordinary observer" test is not only naïve but not always used.

[85] "The Skin of Whose Teeth," The Saturday Review of Literature, Dec. 19, 1942, p. 3.

(3) Fear of prejudicing the defendant, when both the protected and unprotected portions of the plaintiff's work are compared, would be overcome if the person making the comparison were a literary expert.

The uncertainty facing litigants is not due to an unsettled state in copyright law, for the courts are relatively clear as to what part of an author's work is protected and the legal definition of infringement has been stated time and time again. The problems are rather in applying these statements of the law to specific fact situations; justice and certainty would be more completely attained if the crucial questions of fact (distinguishing a basic plot from a highly developed one and determining when there has, in fact, been copying, having only circumstantial evidence as a guide) were decided by a person or persons expert in the literary field. Such person or persons can be chosen from experienced literary agents, publishers, and literary scholars in our universities.[86]

The machinery which could be set up by legislation could take one of two forms which will be discussed briefly.

An expert or experts employed by, and acting for, the court could testify or give an advisory opinion, and only this opinion would be relied upon in the face of conflicting testimony from each of the parties' experts. Such a method would prevent the undesirable partisanship found in the way in which experts are used today.

The method used could correspond with that cited by Wigmore,[87] in which some twenty states and the federal government use court appointed experts in the determination of sanity in criminal actions; [88] or could be similar to the method provided in the Chandler Act [89] for corporate reorganization

[86] There is, of course, the danger that such experts would lack the element of flexibility which our present "ordinary observer" standard employed by judge or jury has. Such a danger, however, is more easily overcome than is the too frequent danger facing litigants when complete amateurs deal with difficult literary questions which require expert ability.

[87] 2 WIGMORE, EVIDENCE § 563 n. 7 (3d ed. 1940).

[88] *Id.* n. 7 (Supp. 1957).

[89] 11 U.S.C. §§ 501-676 (1952).

proceedings: ". . . the judge . . . shall . . . submit to the Securities and Exchange Commission for examination and report the plan or plans [of reorganization] which the judge regards as worthy of consideration. Such report shall be advisory only." [90]

The court could make use of the expert or experts before trial, thereby increasing the use of summary judgment.[91] Copies of the alleged infringed and infringing works are usually submitted to the court with the pleadings.[92] At this point they could be referred to such experts, whose opinions would be utilized by the courts to overcome the slight doubt which under the present system necessitates a full trial.

An alternate means, which would be both more extensive and expensive, would reduce the burden of cases on the district courts by placing the jurisdiction of infringement actions in a Copyright Court.[93] Such a court could embody aspects of both the Tax Court and the N.L.R.B. Since the great bulk of litigation occurs in the New York and California circuits, each could have its own Copyright Court or Board similar to the Tax Court. The remainder of the nation could be served initially by field agents such as are used by the N.L.R.B.

It is of less importance to this writer what form such an amendment to the Copyright Act assumes, than that there be incorporated into the law governing infringement actions a proper and effective use of the expert in a field in which he is needed.

[90] 11 U.S.C. § 572 (1952). Relying upon the words of the statute, courts have not felt bound by the advisory reports. In re Chicago Rys Co., 160 F.2d 59 (7th Cir.), *cert. denied*, 331 U.S. 808 (1947); but the report is not lightly regarded. Central States Electric Corp. v. Austrian, 183 F.2d 879 (4th Cir. 1950), *cert. denied*, 340 U.S. 917 (1951).

[91] FED. R. CIV. P. 56.

[92] Supreme Court, Rules for Practice and Procedure under 17 U.S.C. § 101 (1952), RULE 2.

[93] At present, the federal district courts have original jurisdiction. 28 U.S.C. § 1338 (1952).

# *Rules Governing the Competition*

1. All accredited law schools are invited to participate in the Nathan Burkan Memorial Competition.
2. The Competition is open, under such local rules as shall be specified by the dean of each law school, to all third-year students. In the discretion of the dean, second-year students may also be eligible.
3. The subject of the Competition shall be any phase of *Copyright Law*. The prizes will be awarded to the students who shall, in the sole judgment of the dean of the law school—or such other person or committee as he may delegate for the purpose—prepare the two best papers on this subject. 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 if only one worthy paper is submitted.
4. The awards in the competition will be a first prize of $150 and a second prize of $50, to be paid the winning students, through the dean, upon the latter's written certification to the Society.
5. To insure uniformity and convenience to the examining committees, local and national, please conform to the following rules:
   (a) Manuscript should be typewritten (double-space) on $8\frac{1}{2} \times 11''$ paper, $1''$ margin all around, with all quotations exceeding four lines in length single-spaced and indented.
   (b) Manuscript, including quotations, should not exceed fifty pages in length.
   (c) Citations should be in approved law review form.
   (d) Manuscript should be bound in any standard, letterhead-size manila or cardboard cover, plainly labeled on the outside front cover with the title of the paper and the author's name and permanent *home* address.
   (e) *Two* copies of the manuscript as thus prepared should be submitted.
   (f) In fairness to all contestants, as papers are presumed to represent individual study, collaboration with others in their preparation is not permitted.

6. The winning papers only (two copies), as determined under the foregoing rules, will be forwarded by the dean to the Society, which shall be privileged to authorize their publication.

7. Papers may appear as Law Review contributions, provided their entry in the Nathan Burkan Competition is duly noted.

8. Closing date for submission of papers is August 15—or such earlier date as the dean may specify. Winning papers must be certified to the Society not later than August 31.

9. After the close of the Competition in each participating law school, the best paper will be selected for a National Award of $500, and those which are adjudged to be the five best papers (or such other number as the judges of the National Competition may determine) will be printed in the form of a "Copyright Law Symposium."

Questions concerning the Competition may be addressed to the Society's General Attorney, Herman Finkelstein, 575 Madison Avenue, New York 22, N.Y.

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