

§ 1019
Effect of novelty of conception of plot as contrasted with novel use of old matter.

such media, be rare. The words of a song, as previously pointed out, may be a dramatic composition.⁵⁴ The interesting question has been suggested whether, if the central thought of a popular song be taken and acted out, either by human actors, with appropriate words embodying such thought but differing in every detail from the detail of the song, if any, or were performed by gesture and action in moving pictures, this would infringe a copyright in such song. In the last analysis, this would depend largely on whether the song could, as far as its words are concerned, be deemed a dramatic composition and if so, what was the detailed nature and scope of the defendant's production. This result appears to follow from the contrast between *Hanfstaengl v. Baines*, *supra*,⁵⁵ and a recent decision.⁵⁶ In the latter case the librettist of a copyrighted "comic opera," so-called, had conceived scenes where in a rural English neighborhood there had been talk about a French invasion, arrangements made to arouse the countryside, if this occurred, entrance of a moving picture producing company for the purpose of making a moving picture of Napoleon reviewing his troops, an appeal by a young woman for the life of her lover, condemned by him as a spy,—the ringing of the alarm bell and the onset of the whole neighborhood who thought the moving picture actors were the dreaded French invaders. An injunction was granted against the production of a later comic opera where the action was laid in the United States and Japanese substituted for French, the scenes being otherwise alike in conception. In this case there was not only substantial identity between the two works but also the subject comprised a novel

54—*Russell v. Smith*, 12 Q. B. 236; *Clark v. Bishop*, 25 L. T. N. S. 908.

55—See § 1015.

56—*Chappell v. Fields*, 210 F. 864.

series of ideas, while in the *Hanfstaengl* case, the requisite originality in the work lay in the treatment given an old subject.⁵⁷

As has been previously shown, the rights we call copyright exist not merely in the precise form in which a work is formulated, but rather in the intellectual concept or conceptions which are embodied in such work. But ideas are fecund. They breed ideas. Lord Byron, in writing of this very matter of infringement, said there was nothing new under the sun. Allowing for reasonable rhetorical exaggeration, it must be admitted that truly original ideas are epoch making. The copyright laws are not made for genius, but for the far humbler productions of the average author.⁵⁸ They are made for everyday use and not reserved for those great and solitary moments when that is said which had never been thought before by any man other than he who said it. The average copyright work, then, is simply a reformulation or regrouping, conscious or unconscious, of thoughts which have been thought before, at various times, by others. If this be an unconscious process, inherent, necessary limitations in property resting in ideas prevents complaint. The copyright proprietor obtained his material from prior sources. His thoughts, save in the most exceptional cases, originally came to him, from without.⁵⁹ He cannot, hence, complain, if others produce their works in this very same way, provided they do not take forbidden short cuts to achieve the same results. Of these interdicted practices, copying is the chief. But here again one is confronted

§ 1020
Indirect uses
of copyrighted
works, as sug-
gestions for
others.

57—Cf. *London v. Biograph Co.*, 233 F. 609. See § 1015.

58—See, *Spiers v. Brown*, 6 W. R. 352; *Bouccicault v. Fox*, 4 Blatch. 87.

59—See Mr. Justice Story's remarks in *Emerson v. Davies*, 3 Story 779, as illustrating the essential unoriginality of the average work which is mere or less a combination of what other men have thought or read.

§ 1021
Limit on fore-
going use.

§ 1022
Plagiarism.

§ 1023
Copying.

§ 1024
Paraphrasing.

§ 1025
Colorable
changes.

by the difficulty that originality for copyright purposes and true novelty are not synonymous.⁶⁰ Authorship and originality, for copyright purposes, are questions of fact and are in effect one question.⁶¹ To prove copying, in the absence of direct evidence, is a somewhat difficult task, for if the ideas which are comprised in the copyrighted work, and in which no copyright can exist, be refurbished, redressed and regrouped, who can say in the absence of direct evidence, that the second author did not "do his own thinking," or his own "research" work? Plagiarism and copying are not the same. They cannot well be and plagiarism is the price paid by authors for the fact that copyright is permitted in works which do not consist of totally novel or unique thoughts. The law, however, endeavors to strike a work-a-day balance between the necessities of the public and the transgressions of the individual. That plagiarism goes unpunished is not due to the theory of the law but to the hard realities of evidence.

Having considered infringement, in general, it may now be considered in detail. The right to multiply and sell copies of that which is original, in a given work, is one of the chief features of all copyrights. The infractions of this right, which are actionable, will now be discussed.

Literal repetition would, of course, be infringement. But there may be more subtle, but equally actionable, copying. Thus, paraphrasing may be infringement.⁶² That is to say, colorable changes or variations in works will not prevent the one from being a copy of the other.⁶³ In fact colorable variation of language tends to establish unfair use.⁶⁴

60—See § 482.

61—Byrne v. The Statist Co., (1914) 1 K. B. 622.

62—West Publishing Co. v. Edward Thompson Co., 169 F. 833 (semble).

63—West v. Francis, 5 B. & Ald. 737.

64—Jarrold v. Houlston, 3 Kay. & J. 708.

In a leading case, James, L. J., said:⁶⁵

“Open piracy is publication of an unauthorized edition of a copyrighted work or unauthorized importation and sale of such a work; literary larceny is the illegitimate appropriation of the fruit of a previous author’s literary labor by one who pretends to be the author of the work.”

§ 1026
Open and
secret copy-
ing defined.

“The true test whether there is piracy or not,” said Blatchford, J.,⁶⁶ “is to ascertain whether there is a servile or evasive imitation of plaintiff’s work or whether there is a bona fide, original compilation made up from common materials and common sources, with resemblances which are merely accidental or result from the nature of the subject.”

§ 1027
Copying and
compilation
distinguished.

For, as is well said, by another great judge:⁶⁷

“Copying is not confined to literal repetition but includes also the various modes in which the matter of any publication may be adopted, imitated or transferred, with more or less colorable alteration, to disguise the source from which the material was derived nor is it necessary that the whole or even the largest part of the work should be taken to constitute an invasion of the copyright.”⁶⁸

§ 1028
Disguised
copying.

“In considering whether there has been piracy, the questions are has there been an illegal appropriation of the substantial part of a copyrighted work or the results of the original conception, not as a matter of quantity, but of quality and value,”
said Townsend, J.⁶⁹

§ 1029
Copying sub-
stance of orig-
inal portion
of a work.

65—Dicks v. Yates, 18 Ch. D. 76, 90.

66—Daly v. Palmer, 6 Blatch. 256, 270.

67—Lawrence v. Dana, 4 Cliff. 80.

68—See also Greene v. Bishop, 1 Cliff. 186.

69—Falk v. Donaldson, 57 F. 32. See also Farmer v. Elstner, 33 F. 494.

§ 1030
What is a
copy.

Mr. Justice Bailey defined a copy as

“that which comes so near to the original as to give to every person seeing it, the idea created by the original.”⁷⁰

This language, said Lord Watson:⁷¹

“comes nearer to a definition of what constitutes copying than any thing which is to be found in the books.”

Lord Watson, however, criticised the use of the word “idea” in the definition, as there can be no monopoly in the idea, and hence, if this definition were applied literally, the measure of the copyright proprietor’s protection would be made too large. In a third case,⁷² Mr. Justice Kekewich suggested as a “rough” definition of “copy,”

“A copy is that which comes so near the original as to suggest that original to the mind of every person seeing it.”

The difficulty with this definition is that it is entirely too vague. Many things, quite different from one another, may suggest one another. Connotation cannot be infringement. Both these definitions overlook the fact that for a copy to be a copy, it must be derived, or taken from, the original, and not reproduced independently.⁷³ It may be that the following suggested definition would obviate these and various other⁷⁴ objections:

“A copy is that which, having been derived or taken from the original, comes so near to the original as to make the same or a substantially similar impression, as was made or would be made by the original, upon the mind of every average, reasonable person seeing it.”⁷⁴

70—*West v. Francis*, 5 B. & Ald. 737.

71—*Hanfstaengl v. Baines & Co.*, (1895) A. C. 20, 27.

72—*Hanfstaengl v. H. W. Smith & Sons*, L. R. (1905) 1 Ch. D. 524.

73—See §§ 154, 488, 998.

74—Cf. *Daly v. Palmer*, 6 Blatch. 270. A copy of a musical com-

Partial copying may be infringement.

“To multiply copies of a material portion of a work, which is entitled to copyright, is as much a breach of the law, though differing in degree, as to multiply copies of the whole work.”⁷⁵

§ 1031
Partial copying.

The question, in every case of asserted copying, is, merely, has the substantial part, or any substantial part, of that which is original and distinctive in the copyrighted work⁷⁶ been appropriated,⁷⁷ directly or evasively?⁷⁸ Or, to put it another way, is the part which has been copied, a material part of the original work?⁷⁹ If so, there has been infringement, no matter how little has been taken, if not there has been no infringement, no matter how much has been appropriated. The question is never one of quantity, but rather one of the quality or value of that which has been copied.⁸⁰ The test as to whether there was piracy, where part only of a copyrighted work is copied, has been said to depend on whether “so much is taken that the value of the original is materially diminished or the labors of the original author appropriated to an injurious extent.”⁸¹

§ 1032
Infringement limited to substantial or material copying of original part of a work.

§ 1033
Quality or value of part appropriated.

§ 1034
Injurious appropriation.

Other cases⁸² have, on special facts, looked at the matter from a different angle and held that a test of piracy may be less how much of plaintiff's work is taken, than how much the proportion so taken bears

§ 1035
Value also may be determined by looking at defendant's work.

position was, *under the prior Act*, defined as a written or printed record of it in intelligible notation. *White-Smith Music Publishing Co. v. Apollo Co.*, 209 U. S. 1.

75—*Ager v. P. & O., etc., Co.*, 26 Ch. D. 641; *Story v. Holcombe*, 4 McLean 306.

76—*Fishel v. Lueckel*, 53 F. 499. See also *Trusler v. Murray*, 1 East 362 (n).

77—*Moore v. Clark*, 9 M. & W. 692; *Falk v. Donaldson*, 57 F. 32.

78—*Emerson v. Davies*, 3 Story 768.

79—*Chatterton v. Cave*, 3 A. C. 483.

80—*Falk v. Donaldson*, 57 F. 32; *Bramwell v. Halecomb*, 3 Myl. & Cr. 737.

81—*Greene v. Bishop*, 1 Cliff. 186.

82—*Neale v. Harmer*, 13 T. L. R. 209. See also *Kelly v. Hooper*, 4 Jur. 21.

§ 1036
Copying, a
question of
fact.

to the rest of defendant's work. These cases merely arrive at the same result as the other cases, in a different way, as they arrive at the conclusion that what was copied was substantial, by noting the way it bulks up in defendant's work.

What the substantial or material part of a work is, and whether or not there can be shown to have been appropriation, are questions of fact.⁸³ Whether there is substantial identity, in whole or in part, between two works and whether the later one has been produced independently or merely taken, in essence, from the earlier, are also questions of fact. Sir William Page Wood, V. C., said that where the defendant claims resemblances in two works are due to common sources, the Court must examine these, itself, to determine the truth of this defense.⁸⁴

§ 1037
Infringement,
a question of
law and fact.

Clifford, J., deemed⁸⁵ infringement to be a mixed question of law and fact—the former being, was defendant's use of plaintiff's materials, if established, allowable, or was it of such a character and extent as to be non-allowable,—the question of fact being, what, if any, use did defendant make of plaintiff's property. In a very recent case,⁸⁶ it was said to be purely a question of fact, whether there is infringement or not. This, however, appears erroneous, as it ignores situations where the question involved is as to the scope of copyright. In the latter class of cases, as pointed out by Judge Clifford,⁸⁵ questions of law exist with respect to the admeasurement of rights under the statutes, as well as questions of fact when the specific matter copyrighted, that is the original portion of a work, is in process of ascertainment. The burden of establish-

§ 1038
Burden of
proof.

83—*Chatterton v. Cave*, 3 A. C. 483.

84—*Jarrod v. Houlston*, 3 Kay. & J. 708.

85—*Lawrence v. Dana*, 4 Cliff. 1.

86—*Francis, Day & Hunter v. Feldman & Co.*, L. R. (1914) 2 Ch. 723.

ing appropriation, of course, always rests upon the plaintiff.⁸⁷

If the substance of a work be taken, the fact that the work in which it was copied was produced in a different medium, or by a different process or that it differs in size,⁸⁸ shape, or details,⁸⁹ or was intended for a different purpose⁹⁰ is no defense. This rule was well illustrated in a case where an⁹¹ engraving portrayed a child and animals in a certain grouping, and with certain surroundings, to illustrate a definite conception of the author's. The work was copied, but other animals were substituted for the child. This change was held not to prevent the copying from being infringement.

Similarly, in a recent case,⁹² it was claimed that a song entitled, "I Hear You Calling Me," was infringed by another song entitled, "Tennessee, I Hear You Calling Me." The first composition was of a "dignified character," having as its "basic theme a living person standing on the grave of his loved one and hearing her voice." The second song, set to "ragtime," expresses the desire of a negro to go back to his old home in Tennessee. Repetition of the characteristic words, "I hear you calling me," with a practically identical musical phrase accompanying them, was deemed by the Court to constitute the main feature of each song that impressed the ordinary auditor or "uninformed and technically untutored public." The one composition was, accordingly, held to be an infringing copy of the other.

Reproducing printed copyrighted matter, in type-

§ 1039
Differences of
media.

§ 1040
Detail, size,
purpose, etc.,
immaterial.

87—Corelli v. Gray, 29 T. L. R. 570.

88—Graves v. Ashford, L. R. 2 C. P. 410.

89—Falk v. Brett Publishing Co., 48 F. 678; Springer Lithographing Co. v. Falk, 59 F. 707.

90—Reed v. Holliday, 19 F. 325.

91—Brooks v. Religious Tract Society, (1897) W. N. 25.

92—Boosey v. Empire Music Co., 224 F. 646.

§ 1041
Typewritten,
stenographic
and photo-
graphic copies.

§ 1042
Drawings and
stamped
copies.

§ 1043
Miniature
copies.

§ 1044
Rough copies.

§ 1045
Indirect copy-
ing.

writing⁹³ or in shorthand characters was held to be copying.⁹⁴ A photograph of a piece of sculpture⁹⁵ was held a copy as was one of an engraving.⁹⁶ A drawing made from a photograph was a copy.⁹⁷ The stamping of an enlarged imitation of a copyrighted photograph in raised figures upon leather chair bottoms and backs was held to be copying.⁹⁸ Judge Coxe said, in the case last cited:

“Differences that relate merely to size or material are not important. They may affect the question of damages but not the question of infringement.”

Printed reproductions in miniature of a copyrighted painting as part of the labels on pill boxes were, without discussion, held an infringement.⁹⁹ In a subsequent case¹ it was shown that a magazine had published rough reproductions, in miniature, of parts of well known advertisements in a so-called guessing contest, wherein participants were to endeavor to guess what the original advertisements were. One of these fragmentary advertisements contained the central figure of a copyrighted painting. The publication was held an infringement.¹ The case last mentioned, in addition to illustrating that the purpose or medium of a copy as well as its imperfection and size will not affect the question of infringement, also shows that copying need not be direct² to be actionable. Copying from a copy, if it

93—*Warne & Co. v. Seebohm*, 39 Ch. D. 73.

94—*Nicols v. Pitman*, 26 Ch. D. 73.

95—*Bracken v. Rosenthal*, 151 F. 136.

96—*Rossiter v. Hall*, 5 Blatch. 362; *Graves v. Ashford*, L. R. 2 C. P. 410; *Gambart v. Ball*, 4 C. B. N. S. 306.

97—*Bolton v. Alden*, 65 L. J. R. Q. B. D. N. S. 120.

98—*Falk v. T. P. Howell & Co.*, 37 F. 202.

99—*Hanfstaengl Art & Pub. Co. v. Holloway*, (1893) L. R. 2 Q. B. 1.

1—*Hanfstaengl v. W. H. Smith & Sons*, (1905) 1 Ch. D. 520.

2—Cf. *Turner v. Robinson*, 10 Ir. Ch. 121, 510. See § 1078 for a further discussion of this point.

actually be a copy, is none the less infringement, even though the original were never seen by the infringer,³ and he did not know it was copyrighted.⁴

Nor would the situation be altered if the purpose for which the copy was made was lawful.⁵ Thus, one who intending to make a mechanical music record of a copyrighted musical composition, as he lawfully might, made a copy of a copyrighted song, had it orchestrated and made the record, was held to have infringed by making the copy of the song and all the records of the song made by him from his copy were held infringing copies.⁶

§ 1046
Lawful intended use of copy, no defense.

Subject to the exception of cases covered by Section 20 of the Act,⁷ ignorance of the vendor that what he sold, copied or reproduced, was an infringement is no defense.⁸ One of the reasons for this is that, in the words of Blackburn, J.,⁹ "in almost every case, a man who copies a work without the authority of the owner must know that he is pirating the work of somebody."

§ 1047
Innocent infringement.

Intention to infringe is not a necessary ingredient to actionable infringement.¹⁰ In one case,¹¹ it appeared that a newspaper solicited the printing of a foreign governmental report, as an advertisement for pay. On procuring it, it had it translated and published the translation. Another newspaper solicited the advertising and on being employed by the government in question copied the translation, without making its own version. It was held the first newspaper had a copyright in its translation

§ 1048
Intent to infringe.

§ 1049
Copying paid translation for lawful use.

3—Ex parte Beal, L. R. 3 Q. B. 387.

4—Millett v. Snowden, 1 West. L. J. 240.

5—Warne & Co. v. Seebohm, 39 Ch. D. 73.

6—Chappell v. Columbia Gramophone Co., 30 L. T. R. N. S. 554, aff'd 31 L. T. R. N. S. 18.

7—See § 904.

8—West v. Francis, 5 B. & Ald. 737; Gambart v. Sumner, 5 Hurl. & N. 5.

9—Ex parte Beal, L. R. 3 Q. B. 387, 392.

10—Roworth v. Wilkes, 1 Camp. 94.

11—Byrne v. The Statist Co., (1914) 1 K. B. 622.

§ 1050
Reprint of
part of ad-
vertisement.

§ 1051
Reprint from
licensed pub-
lication.

§ 1052
Unoriginality
of part of
work.

§ 1053
Improvement
of copy-
righted work.

§ 1054
Imperfect or
unsuccessful
copying.

and that there had been actionable infringement. In another case,¹² the reprint by a newspaper, in good faith, of copyrighted matter, part of an advertisement, and, in a third one,¹³ the reprint of a short story, in publishing which a licensee had wrongfully omitted notice of copyright, were held not to be excused by the good faith or ignorance of the defendants of the existence of copyrights in such works.¹⁴

It should be noted in connection with the decisions just cited, that while infringement and piracy are generally deemed synonymous terms, the latter expression seems a very harsh term to apply to innocent infringement.

It is no defense that part of a work is unoriginal, if the whole, or a substantial part, of the original work in it, unless trifling, be copied.¹⁵ So new additions and corrections in an old work may not be copied, even if the old work is unprotected.¹⁶

It is no defense that a work which has copied the substantial part of a copyrighted work is an improvement upon it.¹⁷ The very fact that it be so, and hence would tend to drive the earlier work out of use, would seem to aggravate the copying. It is immaterial whether the improvement consists of alterations, additions, or what not, the result is the same.¹⁸ Similarly the fact that a copy omits details, is imperfect,¹⁹ ignorant,²⁰ vulgar,¹⁹ crude,¹⁹ blundering,²¹ or unsuccessful,²⁰ would seem an aggravation

12—Green v. Irish Independent, L. R. (1899) 1 Ir. R. 386.

13—American Press Association v. Daily Story Pub. Co., 66 L. R. A. 444, 120 F. 766.

14—See also Hanfstaengl v. W. H. Smith & Sons, (1905) 1 Ch. D. 520.

15—Millett v. Snowden, 1 West. L. J. 240.

16—Cary v. Longman, 1 East. 357.

17—Reed v. Holliday, 19 F. 325.

18—Shook v. Daly, 49 How. Pr. 366.

19—Hanfstaengl v. W. H. Smith & Sons, (1905) 1 Ch. D. 520.

20—Caird v. Sime, (1887) 12 A. C. 326.

21—Braeken v. Rosenthal, 151 F. 136.

of infringement, rather than a defense, as it might tend to cast ridicule upon the original work, or prevent its sale.

It is not deemed infringement, however, where the injury to the copyright proprietor is purely sentimental, or merely, and necessarily, nominal. This rule, appears, however, to be misapplied, at times. Thus, where the proprietors of copyright in a group copyright of an athletic team complained that defendants had copied individual portraits, it was held there was no infringement.²² The Court held that to constitute infringement what was done must of necessity injure and supersede the sale of the original work while what had been done by defendant could not be said, necessarily, to have any such probable effect. Persons who wished group photographs would not be deterred from purchasing because of the defendant's sale of portraits of individual members of the group. While there was copying in the case in question, the Court evidently deemed what was copied was not a substantial part of the copyrighted work. The decision is sustainable, if at all, only on the ground that, on its facts, there was no substantial copying and, hence, that there could only be nominal damage to the copyright proprietor. This was held not actionable. The language in the decision lays down a test of doubtful utility but is in line with another English decision,²³ where it was laid down that the test of piracy was whether the work would serve as a substitute for the original. This also appears doubtful, if not plainly erroneous, as it appears to ignore infringement by partial copying and violation of the copyright proprietor's potential, but unused, rights.

Commercial injury,²⁴ actual, probable, or reasonably possible, it has been deemed, must, however, be

§ 1055
Nominal in-
fringement.

§ 1056
Substitutability as test of
piracy.

§ 1057
Commercial
injury, as

22—Guggenheim v. Lang, 12 T. L. R. 491.

23—Roworth v. Wilkes, 1 Camp. 94.

24—Hanfstaengl v. W. H. Smith & Sons, (1905) 1 Ch. 520.

element in infringement.

§ 1058
Non-competitive nature of copy, no de-
rease.

§ 1059
Infringement of unused rights.

§ 1060
Publication of cartoons in history of caricature.

shown for an action to lie. Such commercial injury may result from vulgarization of a work, and in numerous other more direct ways. In practice, it is readily presumed.

In spite of the rules which the decisions cited in the previous paragraphs purport to lay down, it should be pointed out in this connection, however, that it is not necessary that an infringing article be competitive to the original to be forbidden.²⁵ The fact that a copyright proprietor may not exercise his positive rights of reproduction, etc., will not prevent his exercise of his negative rights²⁶ "to prevent the appropriation of the labors of an author by another."²⁷ Thus, as he has the right to vary the form of his work in various stated ways, any copy which would be an invasion of his rights to vary the form of his work, or to adapt it for different markets, or classes, by, for example, publishing cheaper or more expensive editions, or a work of art as a painting, print, photogravure, photograph, transparency, advertisement, etc., that is, any interference with the potential markets or customers he could thus reach, is an infringement of his copyright. These rules were well illustrated by a decision²⁸ where the proprietor of a copyright in caricature of Napoleon, which had appeared in "Punch," brought suit against one who published eight reduced facsimiles of these in a work on the history of the period, as shown in caricature. It was held there had been material and substantial infringement, and that neither the purpose or form of the reproduction, nor the fact that plaintiff had not chosen to make the use of his work in question, were defenses. But the mere fact that a given

25—Reed v. Holliday, 19 F. 325; Walter v. Steinkopff, (1892) L. R. 3 Ch. D. 489; Weatherby v. International Horse Exchange, 26 T. L. R. 30; Falk v. Donaldson, 57 F. 32.

26—Bradbury v. Hotten, L. R. 8 Ex. 1.

27—Corelli v. Gray, 29 T. L. R. 570.

28—Bradbury v. Hotten, L. R. 8 Ex. 1.

article can be used for the same purpose as a copyrighted one will not make it a copy.²⁹ Its purpose or utilitarian characteristics do not affect the question of infringement, although they may the question of damages, if infringement be shown.

§ 1061
Similar capacity of use, not necessarily copying.

In another case,³⁰ defendant had prepared a so-called key or commentary and elucidation of a copyrighted text book, containing copious excerpts from the original. It was held no defense in an action for infringement that the works were non-competing or that defendant thought his work would increase the sale of the other work or that he did not intend to infringe. It was further held that, the fact having been established that material portions of the copyrighted work had been appropriated, no proof of damage was necessary to establish infringement, as this might be presumed. The same result was reached where the copyrighted work was intended for adults and the infringing one for children only.³¹

§ 1062
Commentaries or explanations of quoted works.

§ 1063
Damage from infringement presumed.

§ 1064
Juvenile editions.

§ 1065
Private circulation no defense.

That copies are intended for private circulation will not prevent their being infringing. There can be no privilege in piracy. Thus in one case,³² it appeared defendant was a professional, but unofficial, tutor in a University town. He prepared outlines of a copyrighted book, supposed to be read by students at the University. The outlines contained memoranda as to the contents of the book, occasional quotations and catch words constituting a skeleton of the work. It was held to infringe, nor was this result avoided because the number of defendant's pupils was limited and they were supposed to return the copies to him. So where copies were made of a musical composition for members of

29—*Mabe v. Connor*, (1909) 1 K. B. 525, quoting from *Boosey v. Wight*, (1900) 1 Ch. 526.

30—*Reed v. Holliday*, 19 F. 325.

31—*Gilmore v. Anderson*, 38 F. 846.

32—*McMillan v. King*, 223 F. 862.

§ 1066
Copies for
personal use.

§ 1067
Gratuitous
circulation,
for advertis-
ing and other
purposes.

§ 1068
Impermanent
or impalpable
reproductions.

§ 1069
Copying by
mechanical
means
invented
after passage
of Act.

a singing society who were only to use them in their exercises, this was held infringement.³³ The same result was reached where copies of arbitrary words used in a cable code were made by a shipping company for the use of its various branches,³⁴ even though the meaning of such words was changed, in defendant's code.³⁵ In principle, at least, the same result would follow if an individual made copies for his personal use, even in his own handwriting, as there is no rule of law excepting manuscript copies from the law of infringement. That the copies are intended for gratuitous distribution is no defense³⁶ and should, it seems, aggravate rather than palliate defendant's offense, as, ordinarily, assuring a wider circulation of copies than if the copies were to be paid for. This is true whether the copies were intended for advertising purposes³⁷ or not.

It would seem that a copy involves the conception that it must have some degree of permanency³⁸ or the maxim *de minimis* would apply. Thus, while the making of a single copy may be infringement, if this copy were destroyed almost as soon as made, as, for example, if a vaudeville artist drew with colored chalks, or if a verse were cast upon a screen through a stereopticon, it may be doubted whether such a temporary production could fairly be called a copy.

The fact that a copy be made by some mechanical process or in some manner not known at the time a copyright arose, will not prevent it being an infringement. The rights created are broad enough

33—Novello v. Sudlow, 12 C. B. 177.

34—Ager v. Peninsular & Oriental S. S. Co., 26 Ch. D. 637.

35—Ager v. Collingridge, 2 T. L. R. 291.

36—Novello v. Sudlow, 12 C. B. 177; Ager v. Peninsular & Oriental S. S. Co., 26 Ch. D. 637.

37—Farmer v. Elstner, 33 F. 494; Hansen v. Jacquard Jewelry Co., 32 F. 202 (semble; contra, is a doubtful opinion).

38—Hanfstaengl v. Empire Palace, L. R. (1894) 2 Ch. 1, 3.

to prevent copying by known, or subsequently invented, or devised processes.

A distinction must be drawn between copying and attempted copying. There is no infringement where steps merely preliminary to copying are taken, no matter whether subsequent copying was intended or not. Thus the solicitation of orders for a contemplated piratical work³⁹ or the partial preparation of lithographs for that purpose, are not actionable on the ground of copying.⁴⁰

§ 1070
Attempted or incomplete copying.

Since copyright laws can have no extra-territorial effect, the making of copies, without the United States, is not an infringement of copyright⁴¹ nor would their possession in the United States be so, although their importation⁴² and sale in the United States might well be.⁴¹

§ 1071
Extra-territorial copying.

§ 1072
Status of such copies.

Thus in a decision bearing upon the questions,⁴³ the plaintiffs, it appeared, had ordered the defendant to print copies of a painting for them. He printed more copies than were ordered, abroad, and sent them into England before the work was registered for copyright, as required by the statute then in force. It was held that it was implied in the contract between the parties that the defendant would not print copies, save for the plaintiff, that there was a breach of his contract, warranting injunctive relief, and also that while the importation of copies, before registration was not infringement, their sale after registration was. The importation of piratical copies has, however, elsewhere been held to be in-

§ 1073
The importation and sale of foreign copies.

39—*Britain v. Kennedy*, 19 T. L. R. 122.

40—*Morrison v. Pettibone*, 87 F. 330.

41—*Tuck & Sons v. Priester*, 19 Q. B. D. 629.

42—*Cf. Millar & Lang Ltd. v. Polak*, (1908) 1 Ch. 433; § 30 of the Act of 1909.

43—*Tuck v. Continental Printing Co.*, 3 T. L. R. 826 (19 Q. B. D. 629).

§ 1074
Foreign
completion of
domestic
substantial
reproductions
of copy-
righted works.

§ 1075
Agreements
by manufac-
turer as to
risk of
infringement.

§ 1076
Domestic
retranslation
of foreign
translation.

§ 1077
Non-user by
proprietor,
no defense.

fringement.⁴⁴ This now appears to be the statutory rule in the United States.⁴⁵

A decision under the prior Act,⁴⁶ is instructive, in this connection. In that case defendants purchased copies of copyrighted engravings and etchings. They then delivered them to a third person who reproduced them in the United States, except that he omitted the title, tint and plate work and then, pursuant to an agreement with the defendants, sent the copies to London where the latter were put on and the completed pictures were delivered to defendants. The copies were held piratical, as made in the United States, in that they contained "substantial reproductions of that which was original and distinctive" in the copyrighted works, and, hence, it was immaterial whether they were marketable and where completed. Defendants' agreement provided the manufacturer was to take the risk of infringement, but this clause, of course, was held quite ineffectual to protect defendants as against plaintiffs. In another case⁴⁷ it was said that if an English work were lawfully translated abroad into a foreign tongue, if re-translation of the work were made in England, from such a foreign copy, the re-translation would infringe the English copyright.

It would seem clear that it would be no answer to a claim of infringement that the author did not utilize the right infringed.⁴⁸ He is not bound to make use of any of his rights and there is no power which can make him do so. Hence he is not to be penalized by permitting others to do what he need not do.

Copying may be either direct or indirect. The artist who, after seeing a copyrighted painting,

44—Tennyson v. Forester, 43 Scottish Jur. 278, quoted in Copinger Copyright, 195.

45—See § 31.

46—Fishel v. Lueckel, 53 F. 499.

47—Murray v. Bogue, 1 Drew 353.

48—Cf. Bradbury v. Hotten, L. R. 8 Ex. 1.

posed his own model in accordance with the painting and then reproduced it, from his model, was held an infringer.⁴⁹ The same result was reached where defendant copied infringements, even though he did not know they were infringements.⁵⁰ This point was further illustrated by the decision in a recent case.⁵¹ There copyrighted photographs of the same nude model were involved. Both were made by the same artist, two years apart. She had developed physically, to a considerable degree, in the interval. The pose in each was the same, the backgrounds were different, and there were other slight variations between the two resultant photographs. The second photograph was held to be an infringement, by indirect copying, of the artistic conception embodied in the first photograph, in that the second work could not be regarded as an independent conception. The Court evidently deemed that the first photograph was used to produce the second one and said it was immaterial whether the artist had a copy or used his recollection of the first in making the second.

§ 1078
Copying from
copies and
from memory,
with or with-
out models.

In a case involving a fruit catalogue, it was held piracy for a later writer to copy plaintiff's descriptions of fruits, after comparing them with actual specimens and seeing that they were correct.⁵²

§ 1079
Independent
investigation
preceding
copying.

Copying from a mechanical contrivance, such as electro-plates, made for the production of a copyrighted work, was held to be infringement.⁵³

§ 1080
Copying
from electro-
plates.

It was also held to be infringement of copyright⁵⁴ in several digests, to copy from a compilation of such digests.

§ 1081
Copying from
compilation.

49—Turner v. Robinson, 10 Ir. Ch. 121, 510.

50—Gilmore v. Anderson, 38 F. 846.

51—Gross v. Seligman, 212 F. 930. See also Rooney v. Kelly, 14 Irish L. R. N. S. 158.

52—Hogg v. Scott, L. R. 18 Eq. 445.

53—W. Marshall & Co. Ltd. v. A. H. Bull Ltd., 85 L. T. 77; Cooper v. Stephens, (1895) 1 Ch. 567.

54—Cate v. Devon, etc., Newspaper Co., L. R. 40 Ch. D. 500.

§ 1082
Copying com-
mon original.

Cases may well occur where copying the original would not be infringement. Thus where two publishers jointly obtained information for making up rival directories, a copyright obtained by the one would not prevent the other from issuing his directory, since nothing would be done by him which would infringe any right of the copyright proprietor.⁵⁵

§ 1083
Successive
copyrights
in painting
and photo-
graphic copy.

In one case,⁵⁶ a painting had been copyrighted. Later a photograph of the painting was copyrighted by other persons. In a suit for infringement of the copyright on the painting it was proven the piratical copies were made from a copy of the photograph. The plaintiff did not attack the validity of the copyright of the photograph. There was, accordingly, held to be no infringement of the copyright of the painting. Had it not been for the double copyright, the contrary result should have been reached.⁵⁷

§ 1084
Precedent
piracies, no
defense,
unless
by plaintiff.

It was held⁵⁸ no defense to a charge of infringement that some of the copied parts had been copied by third persons, from whose works, the defendant took them. On the other hand, relief was refused to one who had copyrighted matter which he himself had pirated as against one who, in turn, copied from him.⁵⁹ The distinction between these cases lay in the personal conduct of plaintiff in the second case. It was also held that there was no infringement where an alleged infringing print was designed from a foreign publication circulated in the United States before plaintiff obtained his copyright.⁶⁰ The alleged infringer had merely used his rights to use matter in the public domain.

§ 1085
Copying mat-
ter in public
domain.

55—Maloney v. Foote, 101 F. 264.

56—Champney v. Haag, 121 F. 944.

57—Ex parte Beal, L. R. 3 Q. B. 387; Schumacher v. Schwenke, 30 F. 690.

58—Gilmore v. Anderson, 38 F. 846.

59—Edward Thompson Co. v. American Law Book Co., 62 L. R. A. 607, 122 F. 922.

60—Johnson v. Donaldson, 3 F. 22.

In an instructive decision,⁶¹ it appeared the plaintiffs were manufacturers of church furniture. They published and copyrighted a book of engravings, illustrating their goods, with price list attached. The defendant manufactured similar goods from designs taken from these engravings and then published a similar book in which copies of its furniture appeared. The two pamphlets were necessarily similar. It was held there was no infringement. The copyright was in the depiction of the furniture, not in the furniture. Hence, defendant could lawfully reproduce the furniture,⁶² and being at liberty to do so, could make pictures of the furniture so made. Had the defendant, however, copied its catalogue from the first catalogue, or made drawings, or other pictorial copies, of individual designs in the catalogue to aid it in producing its furniture, a different result would have followed. Similarly, the copyright of a chart showing sections of human gums, with artificial teeth arranged in a novel way, to enable the placing of orders for latter by dentists, was held not to be infringed by copying the plan of the chart, with entirely different teeth and numbers upon it, and otherwise dissimilar details, since there was no copyright in the plan of the chart.⁶³ So of a book describing a system of stenography,⁶⁴ and of the form in which credit information was issued.⁶⁵ These are all cases applying and developing the doctrine of *Baker v. Selden*.⁶⁶

In that case⁶⁶ the complainant claimed copyright in a book or series of books, each consisting of an introductory essay with forms of blanks annexed, consisting of ruled lines and headings, illustrating a

§ 1086
Copying un-
copyrighted
matter and
thus reproduc-
ing the
equivalent of
copyrighted
works.

61—*Lamb v. Grand Rapids Furniture Co.*, 39 F. 477.

62—Cf. *Baker v. Selden*, 101 U. S. 99, 25 L. ed. 841.

63—*S. S. White Dental Co. v. Sibley*, 38 F. 751.

64—*Griggs v. Perrin*, 49 F. 15.

65—*Burnell v. Chown*, 69 F. 993.

66—101 U. S. 99, 25 L. ed. 841.

system of bookkeeping and showing how it was to be used in practice. The defendant made account books using the same plan, as far as results were concerned, but with a different arrangement of columns and headings and with the omission of the essays. It was held that complainant's copyright was not infringed. The plaintiff's copyright was not in the art or system described in his work but only in his description of it. By utilizing the former, then, there was no infringement of copyright, since it did not subsist in that which was copied.

§ 1087
Copying a
common
subject.

In cases where the subject is free to all, direct reproduction of the subject is not infringement, although reproduction of a prior reproduction would be.⁶⁷

In *Bleistein v. Donaldson Lithographing Co.*,⁶⁸ one of the grounds on which the validity of the copyrights in question was attacked, was discussed as follows:

“It is obvious also that the plaintiff's case is not affected by the fact, if it be one, that the pictures represent actual groups—visible things. They seem from the testimony to have been composed from hints or a description, not from sight of a performance, but even if they had been drawn from life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez, or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. . . . The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in

67—*Press Publishing Co. v. Falk*, 59 F. 324.

68—188 U. S. 239, 47 L. ed. 460.

handwriting and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act."

This subject is further illustrated by a decision in which⁶⁹ it appeared that the London Times had made a contract with the Chicago Tribune by which the latter was given the right to publish, in the United States, such telegrams and editorials appearing in the Times as it might choose to cable over. The Times "abandoned" in favor of the Tribune, its copyright in such matter, in so far as its publication in the United States was concerned. Both the Times and Tribune were copyrighted daily. It was held these copyrights would not prevent anyone reading the Times, from cabling the substance of the matter copyrighted, over to other newspapers in the United States, for republication there.

§ 1088
Republishing
news.

The cases of *Reade v. Conquest*⁷⁰ and *Boosey v. Fairlie*⁷¹ which, in effect, protected copyrighted works, as against works not copied from the copyrighted works but made from material in the public domain, have not been followed in the United States,⁷² and appear demonstrably unsound.⁷³ In the first mentioned case, it appeared that Charles Reade had written a play, "Gold," and procured the dramatic copyright in it under the English statute giving performing rights. He also took out a copyright in the play as a book. He then turned it into a novel which he copyrighted separately. He obtained no dramatic rights in connection with the last mentioned copyright. The defendant made a play out of the novel, without knowing of the existence of the original play, and without hearing or seeing its con-

§ 1089
English deci-
sions holding
copying
uncopyrighted
works may be
infringement
of copy-
righted ones.

69—*Tribune Co. of Chicago v. Associated Press*, 116 F. 126.

70—11 C. B. N. S. 479.

71—7 Ch. D. 301, aff'd L. R. 4 A. C. 711.

72—*Bentley v. Tibbals*, 223 F. 247.

73—See *Drone*, p. 457.

tents. The Court held his act was not a violation of any right in the novel, but that since by copying from the novel, he had indirectly copied the play, he thereby infringed the copyright in the play. A different result was reached under similar circumstances in the later case of *Toole v. Young*⁷⁴ where the work was first published as a book, the alleged distinction, under the then existing English statutes, being that copyright of a dramatic composition as a book, barred any right to dramatic copyright, but that dramatic copyright would not bar a subsequent literary copyright. In *Boosey v. Fairlie*, a dramatic representation in which a substantial part of the music of a copyrighted opera was performed, was held to infringe the sole right of publicly performing that music, although the music, as performed, was obtained by independent labor on an unprotected arrangement of it, made by another. The decision rests upon the peculiar language of the English statute then in force, and is not law in the United States.⁷⁵ This decision was followed in a New Jersey case,⁷⁶ without noting the effect of the statute involved in it. The Court in the latter case⁷⁶ held that a donation of literary property to the public for one purpose would not authorize the public to use it for all purposes, if the author show, unmistakably, that he did not intend to abandon all rights in it, but simply to give limited rights to use of it to the public. This erroneous⁷⁷ view rests in misconceptions of the law of publication.⁷⁸ The correct rule undoubtedly is that if a work becomes *publici juris*, and contains a copyrighted work, this renders the latter work also public property, free to anyone to copy.⁷⁹

§ 1090
Right to copy
copyrighted
work when
part of
uncopyrighted
one.

74—9 Q. B. 523.

75—See § 1110.

76—*Aronson v. Baker*, 43 N. J. Eq. 365.

77—*Bentley v. Tibbals*, 223 F. 247.

78—See § 310.

79—*Bentley v. Tibbals*, 223 F. 247.

In the case of works in the nature of compilations, digests, directories, etc., embracing matter or works in the public domain, copying may be looked at from a somewhat different angle. Here the materials are common and any one may utilize common materials. The copyright rests upon skill in selection and arrangement, that is in the combination. If both the same selections and arrangements are reproduced, there is, of course, no question that this is copying, if taken the one from the other.⁸⁰ If the same selections are taken and reproduced in a different order or arrangement, this may also be said to be copying, as the subsequent author is not only doing what he is entitled to do, that is, use common materials as he sees fit, but is also copying plaintiff's selective labor, which he cannot lawfully do.⁸¹ "The true principle in all these cases," said Sir Charles Hall, V. C., "is, that the defendant is not at liberty to use or avail himself of the labour which the plaintiff has been at for the purpose of producing his work, that is, in fact, merely to take away the result of another man's labour, or, in other words, his property."⁸² If different selections are taken and made in accordance with the same arrangement as in an earlier work, this would not be copying as the right alleged to be invaded is not in the plan of arrangement but in the materials in combination or arrangement.⁸³

§ 1001
Copying in
cases of works
in nature of
compilations.

Even if the same materials and arrangement are employed, it would seem, theoretically, that if the second author could show this was purely fortuitous and that he had made his work from common sources, by original effort, it would seem there could

80—Emerson v. Davies, 3 Story 793.

81—Moffat & Paige v. George Gill & Sons Ltd., 86 L. T. N. S. 465. The dictum to the contrary in Harper v. Schoppell, 26 F. 519, appears inadvertent or is based upon the language of the prior statute.

82—Hogg v. Scott, L. R. 18 Eq. 456.

83—See §§ 460, 466, 613 *et seq.*

not be said to be copying, but such a case is almost incredible in practice and one alleging such an accidental occurrence, should be held to the strictest proof. The questions involved in such cases are really questions of what use may be made of such works and are discussed in more detail elsewhere.⁸⁴

The case of *Mead v. West Publishing Co.*,⁸⁵ which ignores these rules, appears open to just criticism. In that case, Stephens' well known work on "Pleading" was in the public domain. Plaintiff owned a copyright on a new edition which had brought the work down to date, both by adding the newer authorities and additional chapters on topics not treated in the original. Defendant was properly held not to infringe merely because he treated the same new topics, in different language, in a further new edition of the work, but it also appeared he had reproduced the identical new citations which appeared in the first new version and had very apparently copied them, as common mistakes were reproduced.⁸⁶ Citations showing where the same cases appeared in unofficial reports were annexed and this routine editorial work appeared to the Court, sufficient "internal evidence" of an independent examination of the authorities, for it to hold there was no infringement. If this aspect of the case be law, which may well be doubted, it behooves every author making such a work diligently to hunt out every place where a given case is reported, as, otherwise, he may find himself in the unfortunate position of the plaintiff, in the case under discussion.

Lord Herschell, in considering this subject, said⁸⁷ that in dealing with compilations of common materials, it should be clearly established that looking at the copyrighted and alleged infringing works as a whole, there has been a substantial appropriation

84—See §§ 1130-1163.

85—80 F. 380.

86—See § 1210.

87—*Leslie v. Young*, (1894) 4 A. C. 335.

by the one party of the independent labor of the other, before any proceeding can be brought, based upon copyright grounds.

On the other hand, works handling common subjects must necessarily resemble one another, so that mere resemblance in such cases is not ground for deeming that there has probably been copying⁸⁸ and the use of collections of common materials as literary tools is freely sanctioned by the doctrines of fair use.

Thus, in discussing copyrights in marine charts,⁸⁹ it has been held that such copyrights cannot subsist in the general subject matter of the charts. The natural objects and public records from which they are made may be observed, and set down, by anyone. As was pointed out in an early case,⁹⁰ two maps, if both correct, and made by persons of equal skill, on the same scale, would be fac-similies, but this would not cause one to infringe the other. Hence, a copyright of a chart is violated only by actual copying,⁹¹ but if there is such copying, it is no defense that what is so copied, represents actualities open to everyone for independent reproduction.⁹¹

It would seem to make no difference how few copies are made. Even the making of one copy would seem an infringement.⁹² In the case of a dramatic production, or a moving picture drama, for example, large financial profits might be realized by the possession of a single unauthorized copy, and its maker, not the person using it, might alone be financially responsible. A single copy of advance sheets of a novel might, if communicated to the public, totally destroy its value. Legal responsibility

§ 1092
Resemblance
in the case of
works dealing
with same sub-
ject matter.

§ 1093
Maps and
charts.

§ 1094
The number
of copies as
affecting
infringement.

88—Pike v. Nicholas, L. R. 5 Ch. 251; Blunt v. Patten, 2 Paine 397.

89—Blunt v. Patten, 2 Paine 397; Chapman v. Ferry, 9 Sawy. 395.

90—Nichols v. Loder, 2 Coop. Ch. R. 217.

91—Farmer v. Calvert Lithographic Co., 5 Am. L. T. 168.

92—Butterworth v. Kelly, 4 T. L. R. 430.

§ 1095
Binding
copyrighted
with uncopy-
righted
matter.

§ 1096
Copying non-
literate
works.

§ 1097
Mimicry.

§ 1098
Stage busi-
ness and
properties.

§ 1099
Plan of enter-
tainment.

§ 1100
Characters.

§ 1101
Scenes and
scenic effects
distinguished.

is, of course, subject to being checked, in proper cases where there is no apparent damage, and very few copies were made, by the doctrine of "*de minimis*." ⁹³

Copyrighted articles cannot be copied merely because they are bound with uncopyrighted matter. ⁹⁴

The rules laid down with respect to copying apply equally to cases of copyright in literary, artistic or dramatic or musical works. ⁹⁵

Mere mimicry is not infringement, as there can be no copyright in the voice, manner or gestures of a performer ⁹⁶ and this has been held to be true even though an insignificant part of a copyrighted song is sung, in good faith, in connection with such mimicry. ⁹⁷ But if in the course of such mimicry, copyrighted material is used, such as the substantial part of a song, such use is none the less infringement ⁹⁸ because used in connection with a lawful purpose. So mere stage business or properties, or the plan of an entertainment ⁹⁹ cannot be protected by copyright, and hence, their imitation is not infringement. ¹ Nor can there be copyright in characters in a work so as to prevent others from using the same characters, under the same names but in different situations. ²

In a leading case, ³ the great scene of the play depicted an individual fastened to a railroad track, an approaching train, and a rescue by a third person

93—Cf. *Lawrence v. Dana*, 4 Cliff. 84.

94—*Black v. Henry G. Allen Co.*, 9 L. R. A. 433, 42 F. 618.

95—*Guichard v. Mori*, 2 Coop. Ch. R. 216.

96—*Savage v. Hoffman*, 159 F. 584; *Bloom & Hamlin v. Nixon*, 125 F. 977.

97—*Bloom & Hamlin v. Nixon*, 125 F. 977; *Greene v. Minzesheimer*, 177 F. 286.

98—*Green v. Luby*, 177 F. 287.

99—*Barnes v. Miner*, 122 F. 480.

1—*Serrana v. Jefferson*, 33 F. 347; *Daly v. Webster*, 56 F. 483 (semble).

2—*Munro v. Smith*, 42 F. 266.

3—*Daly v. Palmer*, 6 Blatch. 256.

who surmounted various obstacles and succeeded in releasing him at the last moment before the train went by. This combination or series of events, as a "scene," was fully protected by the Courts, according to its essence,⁴ as against colorable alterations. These cases may well be contrasted with a decision cited,^{4a} *supra*, where the scene which it was sought to protect rested upon the substitution of real water, for previous textile expedients, in a tank scene, and this was not protected, as not subject to copyright, where actually copied. The situations of the latter play, as distinguished from its apparatus, were old, while in the first mentioned play they were both novel. This fact is a distinguishing feature of *Daly v. Palmer*³ which must be understood to appreciate its true meaning.

It may also be contrasted with the decision in an English case,⁵ where rival vaudeville sketches, had dialogue differing essentially in substance but novel scenic effects, make-up of actors and stage business of the one were copied in the other. It was held that there was no infringement, since what was copied could only be protected in connection with the words and incidents of the piece, and, hence, that it was legitimate to use them in a different, distinct dramatic production.

Where plays were dissimilar in plot, characters, text and situations, there was held to be no infringement because both made use of an old situation, there being no direct evidence of copying.⁶ On the other hand, though the central situation in each play was old, there was held to be infringement, where there was striking similarity of characters, plot, action, situations, dialogue and scenes, although the names of the plays and characters were dissimilar.⁷

§ 1102
Copying
stage-business,
make-up and
scenic effects.

§ 1103
When and
how old basic
situations
may be
re-used by
others.

4—*Daly v. Webster*, 56 F. 483.

4a—*Seirana v. Jefferson*, 33 F. 347.

5—*Tate v. Fullbrook*, (1908) 1 K. B. 821.

6—*Hubges v. Belasco*, 130 F. 388.

7—*Eisefeldt v. Campbell*, 171 F. 594; *Harper v. Ranous*, 67 F. 904.

§ 1104
When common use of a novel central situation is not proof of piracy.

In a recent decision,⁸ it was held that mere similarities of phraseology, somewhat similar characters and a novel central situation would not outweigh testimony that it was an independent work, where its theory and method of execution entirely differed from the earlier work. A reading of the opinion, in this case, would appear to lead to the conclusion that, if sound, it should be limited to its special facts.

§ 1105
Piratical dramatization.

A playwright who appropriates the theme of a story cannot escape liability by adding to, or slightly varying, its incidents, by making omissions, changing names, adding characters⁹ or by omitting to use any of the language of the story.⁹

§ 1106
Test of dramatic piracy.

“It is piracy if the appropriated series of events when represented on the stage, although performed by new and different characters, using different language is recognized by the spectator, through any of the senses to which the representation is addressed, as conveying substantially the same impressions to, and exciting the same emotions in, the mind, in the same sequence or order.”¹⁰

§ 1107
Piratical dramatic adaptation.

Any adaptation of a copyrighted work which contains its plot or theme, if novel, is thus an infringement. The cases which have just been discussed are cases of copying, with changes of form and, in some instances, of the purpose of a work, but with an unlawful utilization of its copyrightable, intellectual concepts.

§ 1108
Copying in case of music.

The same rules apply to the copying of musical compositions.¹¹ Certain of the so-called music roll and mechanical music cases have been discussed else-

8—Vernon v. Shubert, 220 F. 694.

9—Dam v. Kirk La Shelle Co., 41 L. R. A. (N. S.) 1002, 175 F. 902.

10—Blatchford, J., in Daly v. Palmer, 6 Blatch. 256, 270. See to same effect, Martinetti v. Maguire, 1 Abb. U. S. R. 356.

11—Millett v. Snowden, 1 West. L. J. 240.

where.¹² An interesting case under the present law holds,¹³ without discussing the constitutional questions considered elsewhere, which apparently were not raised, that while a maker of mechanical music records may use copyrighted music to make such records, he may not copy other mechanical music records. This case is open to serious question, in other respects,¹⁴ but seems correct on this point. The English case¹⁵ holding that copyrighted music may not be copied to make mechanical records is cited elsewhere.

§ 1109
Copying
mechanical
music records.

A group of cases dealing with various aspects of light opera may be considered at this point. In the first of these¹⁶ the plaintiff was the proprietor of the "American rights" in Gounod's "Redemption," an oratorio or cantata. Gounod had permitted the words of his work and the vocal parts set to piano accompaniment to be published, with marginal references to instruments used in playing with full orchestra. He had retained his orchestration of the work in manuscript. It was held a new orchestration, made from the piano score, infringed the plaintiff's rights, on the ground that the composer's publication was a limited one, which did not divest his common law rights, in the orchestration. This case seems clearly erroneous¹⁷ unless it be treated as an unfair competition, and not a copyright, case.¹⁸ In the "Iolanthe Case," a diametrically opposite result was reached, even though the original title and composer's name were used, since there was coupled with this use, a statement that the orchestration was not the original composer's. The Iolanthe Case

§ 1110
Re-orchestra-
tion of music
published
without
copyright in
un-orches-
trated form.

12—See §§ 1009-1012.

13—*Aeolian Co. v. Royal Music Roll Co.*, 196 F. 926.

14—See §§ 152, 153.

15—See § 1946.

16—*Thomas v. Lennon*, 14 F. 849.

17—*Aronson v. Fleckenstein*, 28 F. 76 (The Ermine Case).

18—*Carte v. Ford*, 15 F. 439.

§ 1111
Decisions
illustrate
permissible
uses of public
property.

§ 1112
Former
English law
as to dramati-
zation of
novels.

was followed in the "Mikado" Case,¹⁹ but a different result was reached in a subsequent case²⁰ involving the "Mikado" where it appeared that a piano arrangement of the orchestral score had been copyrighted and the facts with respect to the publication of the libretto and songs were not brought out. These cases furnish interesting illustrations of the principles that if a work in any form become public property, any use may be made of it, that such use cannot be deemed infringing, and that an attempted copyright in one form may become entirely ineffectual if it be published in another form.²¹ This is also illustrated by two English cases. Under prior English statutes, copying was forbidden, but dramatization was not. It was, accordingly, held that turning a copyrighted novel into a drama and performing it was no infringement of the copyright in the novel.²² Nor could the author of the novel prevent the operation of this rule of law, by himself dramatizing the work.²³ But if, in the course of dramatization, any part of the novel was actually copied, this was infringement and the dramatist was liable for invasion of copyright.²³ This rule was applied where the proprietor of the drama made copies of a dramatization containing much of the language of the novel, for the sole purpose of registration of the drama and of its performance by his employees. The making of such copies was held an infringement, although performance and dramatization were not.²⁴

19—*Carte v. Duff*, 25 F. 183.

20—See also *Goldmark v. Kreling*, 35 F. 661; *Carte v. Evans*, 27 F. 861.

21—See also *Bentley v. Tibbals*, 223 F. 247.

22—*Toole v. Young*, L. R. 9 Q. B. 523; *Reade v. Conquest*, 9 C. B. N. S. 755; *Schlesinger v. Bedford*, 63 L. T. N. S. 762; *Coleman v. Walthen*, 5 T. R. 245; *Murray v. Elliston*, 5 B. & Ald. 657.

23—*Reade v. Conquest*, 11 C. B. N. S. 479.

24—*Warne v. Seebohm*, 39 Ch. D. 73. See also *Tinsley v. Lacy*, 1 H. & M. 747.

No attempted reservation of rights can alter this result. In an interesting case,²⁵ it appeared that Richard Wagner had sold the exclusive right of publication of "Parsifal" to B. Shotts Sons, the "absolute possession" or "unconditional ownership" of the composition and libretto having been previously transferred to them, but, in the contract, reserved the acting rights of the opera to himself. The publishers sent copies to the United States, to their New York agent, for sale to whomsoever would buy. The copies contained a notice, "This copy must not be used for production on the stage." The notice was held entirely ineffectual in the United States, whether effectual in Germany, or not, and public performance of the opera was held no infringement, as the publication of the work was complete, defeating any copyright. This result, required by the United States statutes, is sound, theoretically. The decisions to the contrary²⁶ rest upon the provisions of foreign statutes.²⁶

§ 1113
Attempted
reservation of
rights on
publication of
one version
of work.

Mere transposition of the key of a song is, of course, copying²⁷ just as much as merely changing the language of a novel by unauthorized translation would be,²⁸ a decision,²⁹ to the contrary notwithstanding. The last cited case is, in no event, law under the present Act and its fallacies under the Act involved in its decision, have been clearly demonstrated by Mr. Drone.²⁸

§ 1114
Transposition
and trans-
lation.

The similarity between translation and transposition directs attention to a further phase of musical compositions. The individual notes are comparable to the letters of the alphabet, chords to syllables and bars to words. Merely changing the order of the bars of a musical composition would, ordinarily,

25—Wagner v. Conreid, 125 F. 798.

26—Chappell v. Boosey, 21 Ch. D. 232. See also Schlesinger v. Turner, 63 L. T. N. S. 762.

27—Hein v. Harris, 175 F. 875.

28—See Drone, p. 450.

29—Stowe v. Thomas, 2 Wall. Jr. 564.

§ 1115
Other versions
of copy-
righted music.

§ 1116
A test of
musical
piracy.

not render the result anything but a copy of the original, any less than merely changing the order of the words of a composition would do so. If, however, the bars of music constituting the original were interspersed with other bars, or chords, drawn from other sources, or with original matter, the result might well be so radically different as to prevent it from being an infringement. In a leading case³⁰ the plaintiffs, who were the proprietors of an opera and the copyrights in it, in its overture, and in its airs, sued for infringement, the defendant having republished some of the airs, with alterations, as dance music. It was held that there was piracy since the original airs were republished, although with adaptations and harmonics, for performance on different instruments, and that under no stretch of the law of abridgment could one, in the case of music, take enough of the airs to incorporate bars in consecutive order, or the same air substantially. The test of piracy, in such cases, was said to be whether the same music though adapted to a different purpose from that of the original, might still be recognized by the ear. The question is one of degree of similarity, in every case, and of the value of the part taken, as well as of the permanence of its identity, if combined with other musical matter. It should always be remembered that there can no more be a copyright in mere sounds, than there can be in mere words, which are only conventional sounds, affording a means of communicating ideas. By proper appreciation of the nature of copyright in musical compositions, which is identical, in essence, with copyright in written compositions, consisting of words, errors, such as that set forth in a relatively recent opinion,³¹ may be avoided. In that case the Circuit Court of Appeals, in a *per curiam* opinion, said that a contention that a later

30—D'Almaine v. Boosey, 1 Young & Collyer's Exch. R. 288.

31—Hein v. Harris, 183 F. 107.

musical composition was produced in ignorance of the existence of an earlier copyrighted one, was no defense to an action for infringement, under a statute giving the copyright proprietor the "sole liberty" of copying, vending, etc., "the same."³² The Court evidently overlooked the effect of the last mentioned words, which mean the composition composed by the author and not all compositions by whomsoever composed. Since the Court was, undoubtedly, familiar with the various decisions in non-musical cases, which hold independent duplication is not infringement,³³ its decision can only be explained on the ground that it deemed that there was something in the nature of a musical composition requiring, or justifying, an exception to the general rule. But the same language, in the statutes, is used in connection with musical compositions, as is used in connection with the classes of works which include directories, digests, dramatizations, translations, or portraits, landscapes, maps, charts, etc. The same sentence refers to all and yet it cannot be contended, successfully, that ignorant original production of any of the last mentioned works, *if established*, would be an infringement of a work of a prior author which is substantially identical with such later production, even though an earlier copyright existed.³³ No Court is bound to accept statements in affidavits or proofs without the closest scrutiny and the defense of ignorant original production is so obviously calculated both to embarrass the other side and is so simple of fabrication that it is, legitimately, subject to the strongest suspicion. But though this be so, this is not the equivalent of saying that the defense does not exist, if satisfactorily proven,³⁴ and the decision under discussion, which is unique in its doctrine, and

§ 1117
Discussion of view that independent accidental duplication of music is infringement.

32—R. S. 4952, as amended by the Act of March 3, 1905.

33—See §§ 154, 488, 998, 999.

34—Cf. *Lawrence v. Dana*, 4 Cliff. 1.

contrary to all other judicial opinion, may be deemed open to the most serious question.

Methods in which copyright may be infringed, other than copying, will now be considered.

§ 1118
Piratical
changes of
form.

Since the right to change the form of a copyrighted work is, in cases where it is given, part and parcel of the copyright, any unauthorized violation of such right, whether by making a translation, other literary version, dramatization, novelization, arrangement, or adaptation of a musical work, or an abridgment, would be an infringement of copyright under the present Act.

§ 1119
Abridgement,
dramatization
and translation,
as
infringement.

The cases³⁵ holding a fair abridgment was not infringement, which were the subject of just criticism,³⁶ must accordingly be deemed overruled. Discussion of earlier cases bearing on this point and upon the question whether in the absence of statute, unauthorized dramatization or translation is infringement,³⁷ is rendered unnecessary by the express language of the statute.

The cases of infringement heretofore discussed have all been cases of physical reproduction of the copyrighted work in whole or in part. Another aspect of the question will now be considered.

§ 1120
Infringement
of rights of
public performance,
etc.

Under the Statute, copyright proprietors have rights of public delivery of lectures and other works intended for oral communication to hearers and also the exclusive direct, and indirect, rights of public performance of dramatic and musical compositions. The nature and scope of these rights have been explained elsewhere.³⁸ Very little requires to be added at this place. Any material violation of such rights constitutes infringement, provided the violation consists of the exercise, or partial exercise, of a

35—See *Story v. Holcombe*, 4 McLean 306; *Dodsley v. Kinnersley*, Amb. 403; *Newberry's Case*, Lofft. 775.

36—Drone, p. 440 *et seq.*

37—See §§ 351, 650-665.

38—See §§ 210-228.

right reserved to the copyright proprietor by the Act. In contradistinction to the law of infringement by copying, however, there can be no infringement by performance, unless this be public, nor, save in the case of dramatic compositions, unless this be for profit. The making of copies for private or gratuitous distribution has always been deemed infringement equally with the making of such copies for profit or public distribution.³⁹

§ 1121
Private and
gratuitous
performances.

Since copyright protects the whole of a work, and every copyrightable component part thereof, partial performance of a copyrighted work would seem infringing, if the part performed be a substantial part of the work, just as partial copying may be infringement. The same principles as to extent and manner govern, as in the case of physical copying.⁴⁰

§ 1122
Partial
performance.

The right to dramatize is a more comprehensive one than the right to prevent unlawful copying. Where rights of dramatization are not expressly conferred, it may be questioned to what extent protection would be secured to the author of a non-dramatic work against dramatizations, which while plagiarizing a portion, or the whole, of the plot, entirely differed in language, details, scenes, and characters.⁴¹ A novel is not usually a dramatic work, although exceptional cases are to be found, where a preponderance of dialogue in the subject matter may well lead to a different result. The average novel, however, requires considerable changing in order to dramatize it and the right to make such changes, where requisite, is comprehended in the right of dramatization. Such dramatization may be either in words, to be spoken, or in the form of a moving picture or directions for pantomime. Any

§ 1123
Dramatiza-
tions under
present Act.

39—See § 1065.

40—See § 1023 *et seq.*

41—Cf. *Toole v. Young*, 9 Q. B. 523, under the former English law.

§ 1124
Performance
of motion
pictures as
infringement,
though the
pictures
themselves
are not
infringements.

substantial encroachment on such rights would be infringement.

It has been pointed out⁴² that, infringement of a copyrighted drama may not, necessarily, be infringement of a copyrighted novel, from which the plot of the drama is taken and *vice versa*. This is certainly true if the copyrights are obtained under different statutes, as the rights under the different copyrights may be quite different and may also be so on the facts. In the case under discussion (1), a moving picture film was held not to be an infringement of either a drama or the novel from which it was taken, as the pictures on it merely expressed an artist's conception of what the novelist and dramatist expressed in their works,⁴³ and was not a copy of either. But the performance given by running off such motion picture, for profit, on a machine devised for the purpose, was an infringement of both the drama and the novel, where it conflicted with the rights owned by each proprietor in his work.

§ 1125
Dramatiza-
tions of plays
made from
common
sources.

What was said by the Court in the case last cited is illustrated, in a somewhat different manner, by another case.⁴⁴ There a copyrighted play, "The Two Orphans," which was translated from the French, was held not infringed by the performance of another authorized translation of the play, independently made. The same result was reached in the case of a dramatization from a work in the public domain, even where the second play reproduced unimportant scenes, added to the original theme by the author of the first play.⁴⁵ That the latter case must not, however, be unduly extended, is shown by later English cases.⁴⁶ Thus in one of

§ 1126
Reproduction
of trivial
additions.

§ 1127
What not
trivial.

42—Harper Brothers v. Kalem Co., 169 F. 61.

43—Cf. Munro v. Smith, 42 F. 266.

44—Shook v. Rankin, 6 Bissell 477.

45—Chatterton v. Cave, 3 A. C. 483.

46—Tree v. Bowkett, 74 L. T. N. S. 77; Nethersole v. Bell, (not officially reported), (1903) Chancery.

them,⁴⁷ taking three slight incidents from a play was, on the facts in evidence, held piratical.

The scope of copyright under the present Act, which is more comprehensive than under its predecessors, must be steadily borne in mind in considering the cases cited.

While unauthorized public performance of a musical or dramatic work for profit are patently infringement, public exhibition of a copy of a work of art would not be infringement, no right being invaded, although the person making the copy and its possessor would be guilty of infringement.⁴⁸

§ 1128
Public exhibition of copies of work of art.

Having considered the question of what may not be done without infringing the rights of a copyright proprietor, there remains for consideration what may be done without incurring liability.

As has been previously pointed out, the author of every work who sells, or publicly distributes it in copies, intends certain uses to be made of such copies.⁴⁹ Such use may either be physical, or of the contents of the work. The latter will be discussed first.

§ 1129
Fair use.

Anyone may make "fair use" of a copyrighted work, without being held an infringer. This rule is a necessary consequence of the extension of copyright protection to works essentially utilitarian in character. What such "fair use" has been deemed to be, has been gradually enlarged, as this result has received judicial cognizance. It is considered that it will be established by a consideration of the decisions which will be cited, that "fair use" simply means a use which is legally permissive, either because of the scope of a copyright, the nature of a work, or by reason of the application of known commercial, social or professional usages, having the effect of custom, insofar as these do not

§ 1130
Meaning of "fair use" in copyright law.

47—Beere v. Ellis, 4 L. T. 330.

48—Cf. Bolton v. London Exhibitions, 14 T. L. R. 550.

49—See § 971.

§ 1131
Tests of fair
use other than
by quotation.

expressly run contrary to the plain language of copyright legislation.

§ 1132
Unfair uses:
paraphrasing,
etc.

The question as to whether a defendant can claim to have made a fair use of a copyrighted work, said Lord Eldon,⁵⁰ depends, on the whole, on whether what he has done involves "the fair exercise of a mental operation deserving the character of an original work," such action "not being merely colorable," added Lord Cottenham.⁵¹ Thus it is not a fair use of a lecture, composed of common materials, simply to paraphrase it and publish the result;⁵² and where a work has been pirated, it has been held⁵³ an unfair use of the work to take it and a pirated copy, to compare them, crossing out the pirated matter and then, with this still physically before one's eyes, to endeavor by paraphrase, and otherwise, to construct a non-piratical version of the work.

§ 1133
Public or private readings.

The author of every printed work intends it to be read, and whether it is read silently, or aloud,⁵⁴ in public or in private, can make no difference, save in the class of cases where rights of performance or presentation, inhere in the copyright.

§ 1134
Reviews and quotations.

Since such has been the custom for decades, the author who hopes his work will be of sufficient interest to be reviewed in print, intends, that fair quotations may be made for the purpose of such review.⁵⁵ This is a "fair use" of the work. He does not, however, intend that his work shall be substantially reproduced, under guise of reviewing it,⁵⁶ or that it be attributed to somebody else.⁵⁷ If his

50—Wilkins v. Aiken, 17 Ves. 422.

51—Bramwell v. Halcomb, 3 My. & Cr. 737.

52—Chautauqua School of Nursing v. National School of Nursing, 211 F. 1014.

53—Moffat & Paige v. George Gill & Sons Ltd., 86 L. T. N. S. 465.

54—Tinsley v. Lacy, 1 H. & M. 747 (semble).

55—Chatterton v. Cave, L. R. 3 A. C. 492.

56—Roworth v. Wilkes, 1 Camp. 94.

57—West Publishing Co. v. Edward Thompson Co., 169 F. 833.

work is of a technical nature, such as for example, a medical or legal treatise, he, subject to the limitation last expressed, intends it may be quoted for professional purposes,⁵⁸ even in subsequent works on the same subject.⁵⁹ What is or is not fair quotation, or fair selective reproduction, is a question of degree, to be determined on the facts in each case.

§ 1135
Fair quotation, a question of degree.

The general rule has been well summarized as follows:

“In short we must in deciding questions of this sort look to the nature and objects of the selection made, the quantity and value of the material used and the degree to which the use may prejudice or diminish the profits or supersede the objects of the original work.”⁶⁰

If the excerpts be so extensive as to be copying, rather than quotation, or if they be used for any unauthorized purpose, the fact that quotation marks are used, or their authorship stated, would, obviously, be no defense.⁶¹

§ 1136
Unfair quotation.

Customs, which would supersede the copyright acts, cannot control their application. Thus in an English case, the Court said it would refuse to hold valid a custom of newspapers to copy matter from one another, on giving credit to the source.⁶² Admitted infringement would be infringement none the less because admitted.

§ 1137
Use quotation marks, etc. Newspaper custom.

Similarly, a volume endeavoring to prove that Thackeray's works were autobiographical, in large degree, by copious extracts from his works, was

§ 1138
Compilations of quotations.

58—Cf. *Wilkins v. Aiken*, 17 Ves. Jr. 422.

59—See *Cary v. Kearsley*, 4 Esp. 168; *Folsom v. Marsh*, 2 Story 100; *Wilkins v. Aiken*, 17 Ves. Jr. 422.

60—Story, J., in *Folsom v. Marsh*, 2 Story 100, 116, cited with approval in *Scott v. Stanford*, L. R. 3 Eq. 718.

61—*Scott v. Stanford*, L. R. 3 Eq. 718; *Gilmore v. Anderson*, 38 F. 846; *Bohn v. Bogue*, 10 Jur. 420.

62—*Walter v. Steinkopff*, (1892) L. R. 3 Ch. D. 489.

§ 1139
Quantity
quoted.

§ 1140
Test as to fair
quotation.

§ 1141
Unfavorable
reviews.

§ 1142
Parodies.

§ 1143
Scope of copy-
right as
determining
fair use.

held⁶³ to exceed the limits of "fair use," as superseding, to a damaging extent, the works so quoted.

The quantity reproduced, however large, is not necessarily determinative of the question, if the purpose of its reproduction be clearly for criticism only.⁶⁴ It has been said, however, that "one test which when applicable . . . would seem to be ordinarily decisive, is whether or not so much has been reproduced as will materially reduce the demand for the original," unless as the result of adverse criticism.⁶⁵

It would make no difference whether the reviews in which quotations occur were favorable or not, as copyright is not concerned with aesthetic, or intellectual merit.

A recognized form of review, although its nature is not always fully appreciated by its victims, is parody. It is entirely within the limits of fair use to make parodies or literary perversions of copyrighted works,⁶⁶ even, it seems, in the form of drawings or cartoons.⁶⁵

The scope of the copyright in a work may determine the use which may be made of it. Thus if a work describe an art, plan, method, forms, or something else that can be utilized, if put in action, fair use permits the use of that which is so described,⁶⁷ although it would not permit the copying of the book, as there is no copyright in the subject matter of the work so utilized.⁶⁸

The purpose of a copyrighted work may also enlarge the scope of its legitimate use. Many classes

63—*Smith v. Chatto*, 3 L. T. N. S. 775.

64—*Bell v. Whitehead*, 8 L. J. Ch. 141 (where nearly one-quarter of a work was reproduced); *Whittingham v. Wooler*, 2 Swanst. 428 (three-twentieths reproduced)

65—*Hill & Whalen v. Mart ., Inc.*, 220 F. 359. Cf. also *Story v. Holcombe*, 4 McLean 310.

66—Cf. *Bloom & Hamlin v. Nixon*, 125 F. 977.

67—See § 508.

68—See § 509.

of works are strictly utilitarian in character. A map may be used for finding one's way. A directory, to find a person. A digest, to find a case. Books may be intended to have portions of their contents copied, as in the case of legal form books, etc.⁶⁹ It would seem persons who use works for the purpose for which they are sold cannot be deemed infringers.⁷⁰ Thus in one instance,⁷¹ the work copyrighted was a manual of instruction, consisting of a system of salesmanship, designed to teach dealers how to advertise. It contained "copy" in the shape of forms, models, diagrams and text designed to be used in advertisements. It was held that the use of such material for advertising purposes, was no infringement, as that was just what the material was intended for.

§ 1144
Purpose of work as bearing on fair use: utilitarian works.

"It would seem," said Lacombe, J., in an especially well considered opinion,⁷² "that all books which are not purely literary, that is, are not works of creative or imaginative literature, but merely compilations of statements found elsewhere, should be treated alike in applying the principles of the law of copyright. Legal digests, algebras, arithmetics, etc., statistical year books, directories, gazetteers, business or social registers, are all produced by the same methods and by the use of skill which is merely clerical."

§ 1145
Uniform principles of law applicable to all utilitarian works.

Similarly, in an excellent and suggestive opinion, delivered by Wood, V. C.,⁷³ it was held that the compiler of a dictionary, in which absolute originality is of necessity excluded, was entitled to make use of preceding works on the subject, where, although he has the other works before him, he

§ 1146
Utilization of prior dictionaries in making subsequent ones.

69—Stover v. Lathrop, 33 F. 348.

70—Brightley v. Littleton, 37 F. 103.

71—Stone & McCurnach, Inc., v. Dugan Piano Co., 210 F. 399.

72—Colliery Engineer Co. v. Ewald, 126 F. 843.

73—Spiers v. Brown, 6 Weekly R. 352.

§ 1147
Admission of
such use.

bestows such mental labor upon what he has taken and subjects it to such revision and correction as to produce an original result, provided that he does not deny the use made of such preceding works, and that the alterations he makes are not colorable only. This opinion should be read by everyone interested in this subject.

§ 1148
Utilization of
works of
information
in general.

“The really difficult question in cases of this description, where it must be admitted that the matter is not original, is how far the author of the work in question can be said to have made an unfair or undue use of previous works protected by copyright. As regards all common sources, he is entitled to make what use of them he pleases; but as Lord Langdale said, in *Lewis v. Fullarton*, 2 Beav. 6, he is not entitled to make any use of a work protected by copyright which is not what may be called a fair use. . . . In publishing a work in the form of question and answer, on a variety of scientific subjects, ‘the author’ had a right to look at all those books which were unprotected by copyright and make such use of them as he thought fit, even though possibly if he had not read plaintiff’s book, he would not have thought of reading such books or utilizing the information in them. He might also see if he had forgotten any topics after writing his work by reference to the copyrighted works. He cannot, however, simply colorably adopt the work of the earlier author.”⁷⁴

§ 1149
Ascertainment
of sources
and facts.

§ 1150
Checking up
results.

§ 1151
Use of com-
pilations of
information.

Suggested distinctions⁷⁵ between works of the nature and purpose discussed in these opinions will, on analysis, be found to be based on commercial, not legal grounds.⁷⁶ All such works have one common foundation: their contents are intended for use.

74—Wood, V. C., in *Jarrold v. Houlston*, 3 Kay & J. 708.

75—*Sampson-Murdoch Co. v. Seaver-Radford Co.*, 140 F. 539.

76—See *Spiers v. Brown*, 6 Weekly R. 352.

They are tools in printed form and are intended to be used according to this essential purpose. There is normally no copyright in their contents, as they usually embrace facts or figures which are common property. Anyone may reproduce their facts and they, themselves, are primarily intended to apprise others of such facts. Frequently their arrangement is not novel. In the average directory, for example, names must be arranged alphabetically and, in digests, subjects must be arranged under the headings where those consulting the digests would expect to find the information they are seeking.

Similarity of subject matter and of form, rather than difference, is to be expected in rival works of this character. It is difficult to see why a purchaser of such work should be limited in the use he may make of it merely because such use may result in a rival publication, provided he only makes a use of it that persons not intending to make such rival publications might make. On the other hand, in the absence of artifice, such as printing an occasional false name and address or erroneous citation, it might be almost impossible to prove actual copying. Furthermore, the cost of the initial canvass resulting in a directory, or the original discovery of common sources of information, is frequently very great, and the results of this money expenditure and labor may frequently be gained at trifling expense, unless restrained by law. The harshness of applying logical rules of law in these cases is recognized⁷⁷ but what is not so generally appreciated is that it was only by a great stretch both of the Constitution and of the theory of copyright that such works were originally held copyrightable at all,⁷⁸ that he who seeks the far-reaching benefits of copyright cannot

77—*Colliery Engineering Co. v. Ewald*, 126 F. 843.

78—See remarks of Platt, J., in *Hartford Printing Co. v. Hartford Directory Co.*, 146 F. 332.

justly complain of its limitations,⁷⁹ and that it is within the power of the copyright proprietor, by fixing his sales prices at an adequate figure, to ensure, to a degree, financial recoupment for his expenditures.

§ 1152
Use of law
digests in
making
subsequent
law books.

The principles underlying this class of cases are well illustrated by a series of decisions which were rendered in a succession of actions which arose between rival makers of law digests. In the first of these causes, it appeared that the defendant furnished its editors with copies of decisions, prefixed by syllabi made by the plaintiff. Common errors were shown; and while the defendant and its editors denied that they had read the syllabi before making their own subsequent ones, the proof in this respect was not very persuasive. The Court held⁸⁰ that where notes, suitable for use in a digest, had been made from common sources of information, and copyrighted, subsequent compilers in the same field were not permitted to avail themselves of this original work and save time and labor by copying from their predecessors. They might use these as a guide to the original sources and make their own notes. They might also use the prior work to detect errors, omissions and other faults in their work, but they could not "exclusively or evasively use those already collected and embodied by the skill, industry and expenditures of another"⁸¹ and that the unfair appropriation of the labor of another constituted infringement, in such a case, irrespective of whether his original language was used, or was paraphrased. While this was actually a case of copying, it will be noted stress is laid in the language quoted, upon appropriation of labor, but such language should be

79—*Dejonge & Co. v. Breuker & Kessler Co.*, 235 U. S. 33, 37, 59 L. ed. 113, 116.

80—*West Pub. Co. v. Lawyers Cooperative Pub. Co.*, 25 L. R. A. 441, 64 F. 360, aff'd 35 L. R. A. 400, 79 F. 756.

81—Page 761.

considered strictly in connection with the facts of the case. The necessity for such caution in considering the language of the opinion is shown by the next case on the subject. It was there held⁸² that a copyrighted law book was not infringed by a subsequent work on the same subject, where the only accusation against the second author was that he had collected all available citations, including those found in the copyrighted work, and, after examining them, used those he considered applicable, in footnotes to support his own text. "If," said the Court, "it be held an author cannot consult the authorities collected by his predecessors, the law of copyright enacted to promote the progress of science and the useful arts will retard that progress." In a third case,⁸³ it appeared the plaintiff was in the business of digesting law reports and of reporting judicial opinions, unofficially. The defendant was engaged in the business of publishing legal encyclopedias. In the course of a most voluminous opinion, the lower Court, whose judgment was, subsequently, modified in other respects, but affirmed in general, held that, with reference to the directory, map and dictionary cases infringement depended more on the idea of unfair use in the unlawful saving of labor, to avoid unnecessary original research, than upon the appropriation of literary ideas, or arrangement, based upon literary ability, or studied plan. Fair use included the right to consult the copyright work for the purpose of obtaining clues to other decisions, or the meaning of the cases discussed in such digests, to collect the cases cited, if verified, and even to arrange and reprint them under the same heads, if the "literary arrangement" of the work was not appropriated thereby. But merely to read the head notes, verify their correctness and

82—Edward Thompson Co. v. Am. Law Book Co., 62 L. R. A. 607, 122 F. 922.

83—West Publishing Co. v. Edward Thompson Co., 169 F. 833.

then reprint them would be unfair use, as intellectual labor is involved in the making of such headnotes, even though the copies were appended as footnotes to original text and even though they could properly, and without criticism, have been made, independently, from the original sources.

§ 1153
The nature of such works as tools and the physical uses which can be made of copies recognized.

The Circuit Court of Appeals,⁸⁴ in a sound and instructive opinion, held that digests were mere tools: that, accordingly, from their nature, and from the fact of ownership of the individual copies, lists of cases could not only be made from these but this might be done by cutting out printed references to them from plaintiff's work. This was merely a "cheap and convenient method of transcription" and was within the limits of fair use, provided there was no copying, or paraphrasing, of copyrighted language, that is to say, of the plaintiff's version of the points decided by the cases digested.

§ 1154
The English directory cases.

This opinion appears to embody a sensible and salutary view of the essential purpose of this class of copyrighted matter, and of the scope of copyright therein.⁸⁵ It may be compared with advantage with the English directory cases where, after flatly denying that any use could be made of directories, by a subsequent author, save to check up his own researches as to the persons named therein,⁸⁶ it was finally held,⁸⁷ after a decision⁸⁸ in a compilation case had rendered this rule a logical absurdity, that although the compiler of a new directory was not justified in using slips, cut from one previously published, for the purpose of deriving information from them for his own work, or, in other words, copying them, he might use them for the purpose of directing him to the parties named in the direc-

84—176 F. 839.

85—See also *Dun v. International Mercantile Agency*, 127 F. 173.

86—*Kelly v. Morris*, L. R. 1 Eq. 697. Cf. *Morris v. Ashbee*, L. R. 7 Eq. 34; *Hogg v. Scott*, L. R. 18 Eq. 444.

87—*Morris v. Wright*, L. R. 5 Ch. App. 279.

88—*Pike v. Nicholas*, L. R. 5 Ch. App. 251.

tory, from whom he could obtain information about themselves. It is not doubted that, if cited, the views as to digests prevalent in the Second Circuit would, at present, be followed by the English Courts, with reference to directories.

Both the American and English cases, just cited, show the extension of the doctrine of fair use which has taken place, as a result of clearer perceptions as to the inherent limitations of copyright, in works of strictly utilitarian character, produced as a result of mechanical or clerical, rather than by imaginative, effort. Other decisions are to the same effect.

Thus, it has been held⁸⁹ that a subsequent author might copy and use in the same order citations found in a prior work, provided he examines and verifies the decisions before he does so.

It is quite impossible, logically, to differentiate cases where digests of common materials are involved, from cases of maps or directories,⁹⁰ except to the advantage of the former, in so far as these contain original digesting. Since there can be no property in the subject matter of either, this consisting of common facts and only valuable in so far as it is not the product of thought, but the statement of actualities, it would seem that there can be no infringement of such works, save by actual copying.⁹¹ There can be no infringement by merely utilizing the information contained in such works. Such contemplated use is their reason for being.

Much of the doctrine of unfair use, so-called, will, then, appear on examination to be mere aspects, either evidentiary or substantive, of the law of infringement by copying. Much of it further fails to distinguish between the work protected by copy-

§ 1155
Growth of doctrine of fair use of such works discussed and illustrated.

§ 1156
The doctrine as applicable to maps and directories.

89—White v. Bender, 185 F. 921

90—Colliery Engineer Co. v. Ewald, 126 F. 843; Bullinger v. Mackey, 15 Blatch. 558; Spiers v. Brown, 6 Weekly R. 352.

91—Cf. Pike v. Nicholas, 5 Ch. App. 251.

§ 1157
Unfair use of
selective
quotations.

right and physical copies of such work, or recognizes this distinction.

Thus, one English case⁹² involved rival annotated editions of "As You Like It." Each contained character sketches illustrated by quotations. The compiler of the second work verified the quotations and then copied them into his work. This was held to be infringement. The unfair use lay in the fact that the quotations had been selected and used for definite illustrative purposes. The copyright was predicated upon such selective labor and use and hence was invaded when the same illustrative use was made of the quotations, as a result of seeing and utilizing the selections in the first work.

§ 1158
Fair reproduction of
common
materials.

In another case,⁹³ the defendant had been enjoined from further publishing certain educational text books which he had copied from plaintiff's work, which in turn had been largely copied from prior publications. Defendant went through the works, kept all the matter plaintiff had copied, struck out all plaintiff's original matter and republished the work, as revised. This was held no infringement of copyright and not a violation of the injunction.

The distinction between these two cases is that the first involved construction by duplication of the plaintiff's selective labor and by paraphrasing, and the second, avoidance of infringement, by elimination.

§ 1159
Reproduction of original
sources as
illustrating
common and
unoriginal
thesis.

In a third case,⁹⁴ the plaintiff had written a work illustrative of the theory that the English were descended from the ancient Britons, rather than from the Anglo-Saxons. He quoted excerpts from various prior authors, for the purpose of illustrating such theories. It was held that a subsequent author could note the authorities cited, examine them and make

92—Moffat & Paige v. George Gill & Sons, Ltd., 86 L. T. N. S. 465.
Cf. Social Register Association v. Murphy, 128 F. 116.

93—Colliery Engineer Co. v. Ewald, 126 F. 843.

94—Pike v. Nicholas, L. R. 5 Ch. App. 251.

the same excerpts, for the purpose of illustrating the same theory. This decision may be compared to advantage with that in *Moffat & Paige v. George Gill & Sons Ltd.*, *supra*. The distinction between the two cases would appear to be that the Court must have deemed there was actual copying in the latter case, or that the different purposes of the works involved, the varying degrees of originality contained therein and the contrasting scope of the copyrights involved, justified the divergent results reached in their decision.

It will appear plain from an examination of the cases cited that many of the *dicta* contained in the books are either inadvertent or erroneous. Some of these will now be considered.

In an English case⁹⁵ it was said that no man is entitled to avail himself of the previous labors of another for the purpose of conveying to the public the same information, although he may append additional information to that already published. That this is not an accurate or helpful statement of the law appears from the cases bearing on legal digests, etc., which have been cited.⁹⁶ Although much repeated in earlier English cases,⁹⁷ its fallacies appear to have been recognized by the English Courts and its application limited by subsequent decisions of the higher English Courts.⁹⁸

In an early case⁹⁹ it was held that if one correct an erroneous chart, this is not servile copying and, hence, not infringement. This decision appears questionable, as it seems contrary to the many cases

§ 1160
Various
erroneous
dicta as to
fair use
collated and
discussed.

95—*Scott v. Stanford*, L. R. 3 Eq. 718 at 724.

96—*Edward Thompson Co. v. American Law Book Co.*, 62 L. R. A. 607, 122 F. 922; *West Publishing Co. v. Edward Thompson Co.*, 176 F. 839; *Pike v. Nicholas*, 5 Ch. App. 251.

97—*Lewis v. Fullerton*, 2 Beav. 6; *Murray v. Bogue*, 1 Drew. 353; *Kelly v. Morris*, L. R. 1 Eq. 697; *Morris v. Ashbee*, L. R. 7 Eq. 34.

98—*Morris v. Wright*, L. R. 5 Ch. App. 279; *Pike v. Nicholas*, L. R. 5 Ch. App. 279.

99—*Sayre v. Moore*, 1 East. 361 (n).

which hold that a work cannot be improved against the copyright proprietor's will.

It is in line with the views entertained by Lord Ellenborough, however, as expressed in another early case.¹ He appears to have thought that if parts of a work of non-imaginative character were copied, in good faith, in connection with the compilation of a useful book, for the benefit of the public, making a totally new arrangement of such facts, this, to "avoid putting manacles on science," was not to be deemed piracy, unless merely colorable, with a view to stealing plaintiff's copyright. Unless this view be limited to fair quotation,² it is unsupported by later authority.

"Examined as a question of strict law, apart from exceptional cases," said Clifford, J., "the privilege of fair use accorded to a subsequent writer must be such, and such only, as will not cause substantial injury to the proprietor of the first publication."³ The difficulty with this statement of the law is that the cases which are regarded by it as exceptional are so numerous as to destroy the value of any general rule which excepts them from its conclusion, without identifying them with more precision than by merely grouping them, as exceptions. As an enunciation of the law forbidding infringement by copying, the statement appears sound, but as a formulation of the law of "fair use," to be pregnant with misunderstanding. Judge Clifford also said, in the same case, that fair use will not permit the borrowing of materials, nor the use of their plan, or arrangement and mode of combination with the text, as fair use only applies to the use of materials, and not to plan, arrangement and mode of combination.

This statement appears too broad. Thus it has been held⁴ that where an author produced a new

1—Cary v. Kearsley, 4 Esp. 168.

2—See § 1134 *et seq.*

3—Lawrence v. Dana, 4 Cliff. 1, 83.

4—Mead v. West Publishing Co., 80 F. 380.

book by bringing a standard uncopyrighted work down to date, a process involving the addition of newer authorities and of chapters on topics not treated in the original, it is not an infringement, for one using the same original, to treat the same new topics, provided he does not reproduce his predecessor's language.

§ 1161
Fair use of plan, arrangement or suggested new topics for discussion.

The rule appears to be that if the literary labor on which a copyright rests has included selection and arrangement, this may not be copied,⁵ unless the nature of the work is such as to render a use of such arrangement or selection permissible. Whether a subsequent author may do so, depends on the circumstances and nature of the works involved, including their subject matter.⁶

Works of literature or art, as distinguished from merely utilitarian assemblages of facts, are addressed largely to the imagination and emotions of the public which they reach. If successful, they will frequently stimulate, or engender, original creative thought, in their turn, and it would seem that even though such works were used for that very purpose, such use would be a fair one, although the results may be somewhat startling or damaging to a copyright proprietor. This was illustrated by the decision in a case where⁷ the parties were rival publishers of so-called detective stories, written by an author using the pen name of "Old Sleuth," and dealing with the doings of an imaginary personage going under that name. The plaintiff had a fanciful picture of "Old Sleuth," the character, not the author, upon the covers of its series. The State Courts had held that the plaintiff had no trade mark, or trade name, in the picture, nor in the name "Old Sleuth." The Court held that, assuming there

§ 1162
Works suggested by copyrighted works.

§ 1163
Illustrations of fair use of works, as suggesting others.

5—West Publishing Co. v. Edward Thompson Co., 169 F. 833.

6—White v. Bender, 185 F. 921.

7—Munro v. Smith, 42 F. 266.

was copyright in the picture as part of the books, it was not infringement for the defendant to appropriate the plaintiff's conception of "Old Sleuth," as portrayed in the drawing, where the picture defendant made for his cover was entirely dissimilar from that on the covers of plaintiff's books.⁸

This point was also illustrated by a decision in which⁹ it was held not to be infringement to borrow the plan of a motion picture play where the resultant second picture was entirely different, save for this, from the earlier one. This decision is an extreme one, however, and its future application, even on its facts, would appear doubtful.¹⁰

§ 1164
Fair use of
physical
copies of a
work.

The law is well settled that the owner of a copy of a copyrighted work may make such physical use of it, as a physical object, as he pleases. Thus he may rebind it, and sell it as rebound, bind it, if unbound, clean it, cut it up, and though there are no decisions on the point, may doubtless extra-illustrate or annotate it for personal use.

§ 1165
Binding and
sale of sheets
sold as waste
paper: lawful
copies.

In a decision, in point,¹¹ it appeared that unbound sheets of a copyrighted work were sent to a binder. A destructive fire occurred and, thinking them worthless, they were sold as waste paper, under a contract by which the purchaser bound himself that they were to be utilized as paper stock and not placed upon the market as anything else. They were resold to a third person who had no knowledge of the contract, but put them on the market in book form. It was held that the plaintiff could not claim they were infringing copies or restrain their sale, being limited to remedies for breach of contract.

§ 1166
Rebinding
second hand
copies.

In another case,¹² it appeared that the defendant purchased copies of books published by plaintiffs

8—See § 1183.

9—American Mutoscope Co. v. Edison Mfg. Co., 137 F. 263.

10—Chappell v. Fields, 210 F. 864; Daly v. Palmer, 6 Blatch. 256.

11—Harrison v. Maynard, Merrill & Co., 61 F. 689. See also Universal Feature Film Co. v. Copperman, 218 F. 578 (motion pictures).

12—Doan v. American Book Co., 105 F. 772.

from third persons who had lawfully acquired them. It then cleaned and rebound the books in exact imitation of the original binding, including the original publisher's name. It was held that nothing done by defendant violated the copyright in the books but plaintiff was given limited relief, by requiring that the books be stamped as second hand, on principles of the law of unfair competition. This was the limit of relief possible to complainant.¹³

§ 1167
Unfair
competition
with second
hand copies.

In a third case,¹⁴ it was held that the purchaser of unbound copyrighted sheets had, in the absence of contract, the unrestricted right to bind and sell them as he saw fit and might make an index for them, even though the index contained words and phrases found in the text. It was further held there was nothing in the copyright law which would bind the purchaser from an agent, with respect to binding and reselling the same, because of some agreement between the copyright proprietor and his agent, not known to the purchaser.

§ 1168
Annexation
of indices,
in binding
sheets.

§ 1169
Secret limita-
tions on
agent's
authority in
selling sheets.

In the exercise of these rights he may not do anything which would be deemed unfair competition, but whether he does this depends on legal principles other than the law of copyright.¹⁵ He may also not violate any of the copyright proprietor's rights, in the course of his physical handling of the work. Thus, he may not reprint missing pages and insert them in copies, for such reprinting is infringement.¹⁶

§ 1170
Limits on
physical use:
unfair com-
petition.

§ 1171
Copying by
reprinting
missing pages.

A decision apparently contradictory of various rules laid down in the text is *Sampson & Murdock Co. v. Seaver Radford Co.*¹⁷ The opinion of the Circuit Court of Appeals contains various more or less doubtful *dicta* but the point actually decided was sound. In that case rival city directories were

§ 1172
Copying for
verification.

13—See § 1183.

14—*Kipling v. G. P. Putnam's Sons*, 65 L. R. A. 873, 120 F. 631.

15—See §§ 1173-1183.

16—*Ginn & Co. v. Apollo Publishing Co.*, 215 F. 772 (an instructive opinion).

17—140 F. 539, rev'g 134 F. 890.

involved. After the publisher of the second had completed its canvas, it checked up its list of names with those in plaintiff's publication, as it concededly, had a right to do,¹⁸ and copied the names not turned up by its canvass, upon slips of paper which it turned over to canvassers for verification. Some were verified and some were not. The reproduction of the latter was an infringement which certainly exceeded the limits of fair use, constituted copying and necessitated judgment for the plaintiff.

This was entirely sound, as copying is copying, whatever its purpose. As for the *dicta*, the *dicta* and decisions to the contrary in the Second Circuit¹⁹ appear based upon sounder legal principles. The decision illustrates the narrow distinctions which obtain in this class of cases, as the Court was much influenced by the initial physical copying, where it could not well be denied that, if, instead of writing down the names for verification, the book had been cut up for that purpose, such cutting and distribution of resultant slips would not have been copying.

§ 1173
Instructing
employees not
to copy.

§ 1174
Fair use of
motion picture
films.

All these cases hold that merely instructing employees not to copy, if such instructions are violated, is no defense.

The physical uses to which copies of books may be put without infringement have been discussed. Interesting questions remain with reference to the physical use which may be made of other copyrighted articles. A copy of a motion picture photograph is only adapted for performance. Under present conditions the seller of such a film must be taken to intend that it will be performed, or run off, for profit in public. It may, accordingly, be used for that purpose and such use is not infringement.²⁰

In the case of a printed drama, no such use is

18—Dun v. International Mercantile Agency, 127 F. 173.

19—See §§ 1145, 1152, 1153.

20—Universal Feature Film Co. v. Copperman, 218 F. 578.

contemplated and mere purchase of a copy of a book would not give rights of public performance. In the case of music, the matter is more doubtful, as music is ordinarily played in public to a great extent, as well as in private. On the whole, however, it is deemed that, having due regard to existing customs, no right of public performance, for profit, accrues to the purchaser of a copy of a musical composition, in the absence of express agreement. This view is strengthened by the omission from the Act, as finally passed, of a proposed provision found in the early drafts of the Act,²¹ that it should be requisite to print a reservation of the right of public performance on musical compositions, unless remedies for the prevention of public performance were waived. It has recently been held that when the proprietor of a musical copyright sells printed copies, the right of performing them publicly goes with them, and that rendition of the work by hotel orchestras is not an infringement, if no admission fee be charged. This decision,²² however, was reversed on appeal upon the ground that such a performance was for profit.

§ 1175
Fair use of
music:
performance.

How far fair use may be made of a title is an open question, as various cases hold that there can be no copyright in a title²³ separately from the work to which it refers. These cases are founded on statutes which conferred copyright upon books, and are, hence, deemed inapplicable under the present statute, which covers "original writings," whether books, or not. However, even where the titles were

§ 1176
Fair use of
titles.

§ 1177
Protection of
titles under
law of unfair
competition.

21—Copyright Office Bulletin 12, § 14.

22—John Church Co. v. Hilliar's Hotel Co., 221 F. 299, reversed, — U. S. — (N. Y. Law Journal, Feb. 2, 1917).

23—Maxwell v. Hogg, L. R. 2 Ch. 307; Kelly v. Hutton, L. R. 3 Ch. 703; Dicks v. Yates, 18 Ch. D. 76; Licensed Victuallers v. Bingham, 38 Ch. D. 139; Kelly v. Byles, 40 L. T. N. S. 623; Crotch v. Arnold, 45 Solic. J. 49; Broad v. Meyer, 57 Solic. J. 145. Contra, Mack v. Petter, L. R. 14 Eq. 431; Weldon v. Dicks, 10 Ch. D. 247.

held not subject to copyright, they are frequently protected on grounds akin to the law of unfair competition.²⁴ Thus, in one case,²⁵ the defendants were restrained from publishing the "Blue Bird Valse" upon the ground that the use of this title would reasonably lead to the belief that the music of the valse was taken from the score of a musical play called "The Blue Bird." But in another case,²⁶ an injunction was refused the publishers of "Punch" against use of the title "Punch & Judy," by a rival publication, on the ground it was not calculated to deceive; and the title "Charity" for a play was refused protection, where there was no unfair competition and the parties acted in good faith.²⁷

§ 1178
Proprietary
rights in titles
resting in
user.

The amount of such protection is always uncertain. The English cases²⁸ go on the theory of a common law proprietary right in the title, created by user, as distinguished from rights resting in principles of deceit or fraud.²⁹ The English cases hold even an innocent use of a title is actionable, if it has become another's by use and is calculated to cause a man of ordinary intelligence³⁰ to be deceived into believing he is buying one work, when he is buying another. That is, that it is not necessary to show fraudulent intent to restrain use of a misleading title, in a proper case.³¹

§ 1179
Wrongful
passing off.

Furthermore, it has been said³² to be a common law fraud to sell a work under the name and title of another man or of another man's work; and, in

24—Harper v. Holman, 84 F. 222; Estes v. Williams, 21 F. 189; Estes v. Leslie, 27 F. 22; Aronson v. Fleckenstein, 28 F. 75.

25—Elkin v. Francis Day & Hunter, London Times, Jan. 1910.

26—Bradbury v. Beeton, 21 L. T. N. S. 323.

27—Isaacs v. Daly, 39 N. Y. Super. (1 J. & S.) 220.

28—Ingram v. Stiff, 5 Jur. N. S. 947; Prowett v. Mortimer, 2 Jur. N. S. 414.

29—Borthwick v. Evening Post, 37 Ch. D. 449. See also Primrose Press Agency Co. v. Knowles, 2 L. T. 404.

30—Bradbury v. Beeton, 39 L. J. Ch. 57.

31—Clement v. Maddock, 1 Giff. 98.

32—Dicks v. Yates, 18 Ch. D. 76, 90 (semble).

another case,³³ publication of a work which purported to be continuation of another's work, though not purporting to be by the same author, was restrained, as tending to deceive purchasers.

Cases may arise where protection may be granted on principles of the law both of copyright and of unfair competition.

Thus, in one case,³⁴ early editions of a manual of musical instruction were in the public domain. There was a copyrighted fifth edition. The defendant compiled a work from the first four editions in the manner and form of the fifth edition, some of which he also copied. He was enjoined both on the ground of violating copyright and of unfair competition.

Various English decisions³⁵ gave protection to companies engaged in furnishing news, over telegraph tickers, upon equitable principles, distinct from copyright. The same result has been reached in the United States, copyright protection there having been judicially denied such matter.³⁶

It is not deemed within the scope of this work to discuss the law of unfair competition at any length. A number of cases may, however, be mentioned to advantage, where the effort has been made, with varying success, to eke out the copyright laws by invocation of the principles of the law of unfair competition and allied branches of the law.

The doctrines of unfair competition apply to musical compositions.³⁷

33—Hogg v. Kirby, 8 Ves. 215.

34—Hutchings v. Sheard, 1881 W. N. 20.

35—Exchange Telegraph Co. v. Central News Ltd., (1897) 2 Ch. 48; Exchange Telegraph Co. v. Howard, etc., Press Agency, (1906) 22 T. L. R. 375. The decision in Exchange Telegraph Co. v. Gregory & Co., (1895) L. R. 1 Q. B. 147, in so far as it granted relief on copyright grounds, may be deemed doubtful.

36—National Telegraph News Co. v. Western Union Co., 119 F. 294.

37—Chappell v. Sheard, 2 K. & J. 117; Chappell v. Davidson, 2 K. & J. 123.

§ 1180
Protection of
works subject,
or not subject,
to copyright,
under law of
unfair com-
petition.

§ 1181
Instances
where such
protection has
been granted
or refused in
uncopyrighted
works and
titles.

A series of decisions have dealt with efforts to control the exclusive use of the words "Webster's Dictionary," after the expiration of the original copyright in that work in 1847.

In the first of these,³⁸ it was held that this title became public property, free for use by anyone, on the expiration of the original copyright. It was also held the words in question could not be protected, as a trade-mark and that no publisher could obtain the exclusive right to make a book of a certain form or size. But it was alleged that, a subsequent new copyrighted edition of the work was published in 1864, that the defendants made a cheap photolithographic copy of the 1847 edition, omitting the preface which contained its history, represented in their advertisements that their edition was a copy of one selling at a price descriptive of the 1864, and not of the 1847 edition, which was not only cheaper, but had long been out of print, and that the public was deceived thereby and the plaintiff damaged. It was held that the plaintiff had pleaded a cause of action for unfair competition.

In a subsequent suit,³⁹ it was said that attempts to protect literary property in books which have become *publici juris* upon the expiration of copyrights, must prove futile, but that there might be a commercial property in books, as well as a literary property, and that when a publisher has imparted peculiar characteristics to his products, which enables the public to distinguish them from other books embodying the same literary property and to recognize them as his products, he might, in a proper case, receive protection on principles of the law of unfair competition, although his copyrights had expired. It was, accordingly, held that an answer which did not deny that the word

38—Merriam v. Famous Show & Clothing Co., 47 F. 411.

39—G. & C. Merriam v. Straus, 136 F. 477.

“Webster’s” had acquired a secondary meaning to distinguish plaintiff’s product, was bad.

In a third case,⁴⁰ it was held that even though the title of a work has acquired such a secondary meaning, anyone might use it, despite any alleged principles of trade-mark, trade name or unfair competition to the contrary, provided that the public was unmistakably informed that it was not the product of the former copyright proprietor, and provided there was no unfair advertising or holding out of the work as the other’s product. Putting the name of the second publisher on the back of the work and on its title page was enough to inform the public of its origin, even though the size and form of the two books were similar.

In a fourth case,⁴¹ protection sought for the title was granted on principles “akin” to the law of trade-marks.

The long struggle for pre-emption of the title in question appears to have been ended, for all except the most incautious, by the recent decision rendered by the Supreme Court,⁴² where protection was refused the plaintiff on principles of the law of trade-mark, and it was held that anyone, after the expiration of a copyright, might use any generic word, or name, by which the publication had been known during the existence of the copyright.

In another case,⁴³ the “essential portion” of a title was protected on principles of the law of trade-mark, even though this had theretofore been used by others than the plaintiff.

40—Ogilvie v. G. & C. Merriam Co., 149 F. 858. See also Glaser v. St. Elmo, Inc., 175 F. 276.

41—G. & C. Merriam v. Saalfeld, 198 F. 365.

42—Merriam Co. v. Syndicate Publishing Co., 237 U. S. 618, 59 L. ed. 1148.

43—Harper v. Holman, 84 F. 225. See also Potter v. McPherson, 21 Hun (N. Y.) 559.

The word "Oxford," used in connection with Bibles, has been protected as a trade-mark.⁴⁴

In the first of "The Chatterbox" cases,⁴⁵ one Johnston had published compilations for children, under that name, which had attained great popularity. He did not attempt to copyright his works. The defendant thereupon began to publish a similar series of works so like the first as to lead purchasers to think they were the same. Johnston assigned the exclusive right to use the name "The Chatterbox," in the United States, for ten years, to plaintiff. It was held Johnston had the right to be protected against unfair competition, by the defendant, that he could assign his rights to such protection, and an injunction was ordered accordingly.

In a subsequent case involving the same work,⁴⁶ the defendant showed that there had been laches in the application for an injunction, that the license to use the name was terminable at plaintiff's will and that the plaintiff had used the name for some time before he obtained the license. An injunction was accordingly refused him.

It has been held⁴⁷ that there could be no injunction on grounds of unfair competition where there was no deceit, and that proof that the publication as to which complaint is made, is calculated to deceive the public and would probably injure the plaintiff, is essential to such an action.⁴⁸

The limitations underlying the doctrine of unfair competition were forcibly illustrated in a case⁴⁹ where the plaintiff was shown to have published

§ 1182
Proof necessary where protection granted.

§ 1183
Limits of doctrine.

44—Chancellor, etc., of Oxford v. Wilmore-Andrews Publishing Co., 101 F. 443.

45—Estes v. Williams, 21 F. 189.

46—Estes v. Worthington, 22 F. 822.

47—Fisher v. Seeiey, 11 Sim. 581.

48—Borthwick v. The Evening Post, 37 Ch. D. 449; Walter v. Turner, 54 L. J. Ch. N. S. 1059.

49—Atlas Manufacturing Co. v. Street & Smith, 47 L. R. A. (N. S.) 1002, 204 F. 398.

uncopyrighted detective stories for a long period of time. They had various titles but were characterized by the general name of "Nick Carter," the principal personage in their action. The defendant had a scenario prepared, which appropriated neither the title, plot nor situations of any of the plaintiff's stories, and then had a moving picture film made from this scenario, which it called, "Nick Carter, the Great American Detective, Solving the Ten Million Dollar Jewel Mystery." The plaintiff had attempted to register the words "Nick Carter," as a trade-mark. Its registration was held bad, for technical reasons, but the Court deemed that even had it been good, it would have furnished no protection, as moving picture films and books are not in the same class of merchandise and that this was equally fatal to a claim of unfair competition. The Court further deemed that protection could not be given uncopyrighted works under guise of any doctrine of trade-mark or unfair competition. The Court, in an elaborate and instructive opinion, reviewed the authorities at length and came to the conclusion that in cases of literate works, the doctrines of unfair competition had been limited to cases of magazines, periodicals, newspapers, Bibles, dictionaries and works of like nature, where the name under which they went, had been used to designate productions of a given origin, for so long a period, that the only purpose of the use of the name by another could be to deceive the public.

In a very recent decision,⁵⁰ it was, however, held that where a play had been produced with success and a large expenditure, under the title "A Fool There Was," its proprietors could subsequently restrain the use of the same title in connection with a dissimilar motion picture, on the ground that the plaintiffs had acquired an exclusive proprietary

50—Klaw v. General Film Co., 154 N. Y. Supp. 988.

§ 1184
Separate.
acts of
infringement.

§ 1185
Breach of
license as
infringement.

right in the nature of trade-mark and trade name in this title.

That each sale of piratical copies, though on the same day, may be a separate act of infringement, is indicated by at least one decision.⁵¹

If a limited license to copy, print, or perform a copyrighted work be given, it would seem any act exceeding that license would be both a breach of contract and an infringement, as with respect to such unauthorized proceeding, the licensee would not be a licensee, but in the same position as any other stranger.⁵² Similarly, that an actor memorizes the lines of a play or learns its stage business, while in the employ of its proprietor, will, of course, give him no rights to use them after his employment terminates.⁵³

In an English case,⁵⁴ electro-blocks of copyrighted designs were purchased from the copyright proprietor with a view to their use, for printing, by the purchaser. This was held to confer a license upon the purchaser to make such use of them, but that this implied license was non-assignable, and any one else purchasing the blocks from the original vendee and using them, was an infringer of the copyright.⁵⁵ This case may be contrasted with another decision,⁵⁶ where the proprietors of copyright in a painting gave a license to a publisher to publish reduced facsimiles of it in a catalogue, provided that acknowledgment of the license was printed on it. The defendants cut out the copies, mounted them on

51—Brooke v. Milliken, 3 T. R. 509.

52—Fenning Film Service v. Wolverhampton, etc., Cinemas, Ltd., (1914) 3 K. B. 1171; Duck v. Mayer, 8 T. L. R. 339; F. A. Mills v. Standard Music Roll Co., 223 F. 849.

53—Fleron v. Lackaye, 14 N. Y. Supp. 292.

54—Cooper v. Stephens, (1895) 1 Ch. 567.

55—See also W. Marshall & Co. v. A. H. Bull, Ltd., 85 L. T. N. S. 77.

56—Frost v. Olive Series Publishing Co., 24 L. T. R. 649.

cards and sold them. This was held not to violate any of the copyright proprietor's rights.

If there be more than one proprietor of a copyright, any one may, it seems, give a valid license and such licensee could not be treated as an infringer by such of the copyright proprietors as had not joined in the license. The English rule to the contrary⁵⁷ appears, however, based upon sounder technical reasoning.⁵⁸ On the other hand, where there is a license, limited in its scope, such licensee cannot recover for infringement, in the absence of proof that the infringing copies fall within the scope of his license and were produced from his copies and not from the original.⁵⁹

Anyone who participates in an infringement is liable to the copyright proprietor for such infringement.⁶⁰

Thus it has been held that⁶¹ the manufacturer of a motion picture film was an infringer, as well as the parties who actually performed it, since he, necessarily, knew it was intended for performance and his manufacture of it enabled that performance to be held. Knowledge, actual or imputable, appears essential, for the doctrine to apply.⁶² An English case to the contrary⁶³ was based on the language of the English Statute involved, which fairly led to a result other than that reached in the Kalem case.

Unlicensed sale of an infringing copy of a drama, "with a view to its public representation," makes the seller a participant in causing the play to be publicly represented.⁶⁴

57—Powell v. Head, 12 Ch. D. 686; Strahan v. Graham, 16 L. T. 87.

58—See § 694.

59—Lucas v. Cooke, L. R. 13 Ch. D. 872.

60—Baschet v. London Illustrated Standard Co., (1900) 1 Ch. 63; Belford v. Scribner, 144 U. S. 488, 36 L. ed. 514; Greene v. Bishop, 1 Cliff. 105; Stevens v. Gladding, 1 Curtis (U. S.) 608.

61—Kalem Co. v. Harper Brothers, 222 U. S. 55, 56 L. ed. 92.

62—Harper v. Shoppell, 26 F. 19. Cf. same v. same, 28 F. 613.

63—Karno v. Pathe Freres, 100 L. T. 260.

64—Daly v. Palmer, 6 Blatch. 256 at p. 271.

§ 1186
Licensee of
joint
proprietor.

§ 1187
Proof
requisite in
action by
non-exclusive
licensee.

§ 1188
Who is an
infringer.

§ 1189
Manufacturer
of infringing
film.

§ 1190
Seller of
infringing
play.

§ 1191
Employers.

A master is responsible for infringement by his employees on ordinary principles of, and in accordance with, the law of agency.⁶⁵ He is not liable to penalties, under statutes awarding these, unless he has knowledge, or expressly sanctioned, the infringement.⁶⁶

§ 1192
Employees.

An employee would also be liable if he performed an infringing act and it would be no defense that he acted under his employer's instructions, as these could not give sanction to an unlawful act, nor would it be a defense to his employer that he disobeyed instructions.⁶⁷

§ 1193
Disobedience,
no defense.

§ 1194
Discretionary
relief.

Discretionary relief may, however, be refused, where an employee is sued rather than a financially responsible employer.⁶⁸

§ 1195
Joint and
several
infringement.

Frequently, various persons may each perform a part of an operation which results in an infringing work. Thus the printer of an infringing work would infringe the sole right of printing reserved to the copyright proprietor; the publisher, for whom he printed, would infringe the sole right of publication and the bookseller, who sold the resultant product, would violate the sole right of vending given by the Statute.

§ 1196
Proprietors of
theatres.

§ 1197
English statu-
tory rule.

This leads to the question whether the proprietor of a theatre is liable, as an infringer, if an infringing play is produced in his theatre by others. Under the English act he is liable if he allows the use of the theatre for profit, "unless he was not aware, and has no reasonable ground for suspecting, that the performance would be an infringement of copyright."⁶⁹ This mild statutory liability is practically limited to cases of culpable infringement.

65—*Monaghan v. Taylor*, 2 T. L. R. 685. Cf. *French v. Day*, 9 L. T. R. 548.

66—*Schreiber v. Sharpless*, 6 F. 175; *Taylor v. Gilman*, 24 F. 632; *McDonald v. Hearst*, 95 F. 656.

67—*Trow Directory Co. v. Boyd*, 97 F. 586.

68—*Stuart v. Smith*, 68 F. 189.

69—British Copyright Act 1911 (§ 2) (3).

There is no corresponding provision in the United States Statutes and there are no American cases which discuss the question but, on the whole, it may be doubted whether the proprietor of a theatre, unless he participates in the acts constituting infringement, merely by reason of his ownership of the place where infringement takes place, incurs any greater liability than the owner of any real property in which an unknown or known act of infringement takes place, in which such owner does not participate.⁷⁰ In general, it would seem⁷¹ that anyone would be held an infringer who either directly violates a copyright or, knowingly, provides the means for such violation and it is possible that facts might be adduced in an effort to hold the proprietor of a theatre where an infringing play had been performed, which might bring the matter within the doctrine of that case.

The result of the cases is, then, that anyone performing an act, or manufacturing an article, not necessarily infringing in itself, which can only result in infringement and is intended to be used for that purpose, is deemed to intend the necessary consequences of his acts, and is held to be a joint participant in such resulting infringement.^{71a}

Evidence of piracy may be both direct and indirect. Since in the nature of things infringement, like all violations of rights, tends to secret ways, it is difficult to obtain direct evidence of copying. Indirect evidence is apt to be abundant and convincing. As to the latter, comparison tests piracy. Such comparison should be made primarily with the naked eye, in the case of works of art, or with the ear, in cases of musical compositions, since that which impresses the eye, or ear, as being substantially similar

§ 1198
Evidence of
infringement.

§ 1199
Comparison.

§ 1200
Test of
comparison.

70—*Monaghan v. Taylor*, 2 T. L. R. 685. Cf. *French v. Day*, 9 L. T. R. 548.

71—*Kalem Co. v. Harper Brothers*, 222 U. S. 55, 56 L. ed. 92.

71a—*Gross v. Van Dyke Gravure Co.*, 230 F. 743.

to the material, original part of a copyrighted work, will be found to be an infringement.⁷²

Compilations of alleged points of infringement may be made by experts, in written form, and introduced in evidence. When so received, however, they have no probative force, but are treated merely as aids to the Court, in the nature of statements of facts in the briefs of counsel.⁷³

§ 1201
Expert
evidence.

The Court, or other triers of the facts, must determine whether or not the fact of infringement is proven and the opinions of experts cannot be substituted for those of the Court.⁷³ It is not a question of whether persons skilled in the arts can differentiate the two works or consider them dissimilar, but of whether the ordinary reasonable man would do so.⁷⁴

§ 1202
Sequence of
ideas; as
evidence of
copying.

There may be such a sequence of ideas or language as to furnish internal evidence of copying.⁷⁵ It has also been held,⁷⁶ where there were no common errors present, that substantial identity, or striking resemblance between two works, created a presumption of unlawful copying, which must be overcome by defendant, his naked denial being insufficient to overturn the presumption.

§ 1203
Identity,
presumptive
evidence.

§ 1204
Failure to
bring later
work down to
date, as
evidence.

The fact that in a later legal text book, subsequently decided cases were not cited, and attention was not called to reversals of decisions, mentioned in the earlier one, or changes in the law as laid down by it, was deemed persuasive evidence of copying.⁷⁷

§ 1205
Parallel
omissions.

It would seem⁷⁸ that omissions to treat certain

72—Falk v. Donaldson, 57 F. 32; Boosey v. Empire Music Co., 224 F. 146; Hein v. Harris, 175 F. 875.

73—Encyclopedia Britannica Co. v. American Newspaper Assn., 130 F. 460; West Publishing Co. v. Edward Thompson Co., 169 F. 833.

74—Hein v. Harris, 175 F. 875; Falk v. Donaldson, 57 F. 32.

75—West Publishing Co. v. Edward Thompson Co., 169 F. 833.

76—Encyclopedia Britannica Co. v. American Newspaper Assn., 130 F. 460; Haas v. Leo Feist, Inc., 234 F. 105.

77—White v. Bender, 185 F. 921.

78—Frank Shepard Co. v. Zachary P. Taylor Pub. Co., 185 F. 941.

topics or portions of topics in rival works might also, if marked, lead to a presumption of unlawful use.

Proof of the copying of one or more copyrighted cuts, is sufficient to support a finding that all the copyrighted cuts involved were copied, in the absence of a satisfactory denial or explanation, in connection therewith.⁷⁹

Reference has been made to the unlikelihood of two independent thinkers formulating the same result in various classes of works covered by copyright. This unlikelihood may approach a moral certainty in the case of an epic or a great novel. From cases where original imaginative effort and a skilled use of words concur, the gamut of copyrightable works runs down to such depths as a list of battles, catalogues of utilitarian objects, tables of logarithms, or rehashes of works in the public domain, with a steady corresponding diminution of the unlikelihood of independent duplication. The question, then, as to how far mere resemblance should afford ground for a holding of infringement, depends in each instance upon the nature and quality of the copyrighted work. In many cases, where, for example, common materials are treated, resemblance is to be expected rather than to be deemed suspicious.⁸⁰ In other cases, the reverse is obviously true.

In a recent case,⁸¹ a dramatic composition was based upon the conception that a young woman had a dual personality, one serious and conventional, the other frisky and highly unconventional. It was held a subsequent play based upon the same motif was not an infringement of the earlier one, where the material similarities were readily accounted for,

§ 1206
Presumption
of general
copying from
proof of par-
tial copying.

§ 1207
Resemblance
as evidence of
copying.

79—Da Prato Statuary Co. v. Giuliani, 139 F. 90.

80—Pike v. Nicholas, 5 Ch. App. 251; Glaser v. St. Elmo, Inc., 175 F. 276.

81—Bachman v. Belasco, 224 F. 817.

both by reference to a common source and also by the fact that the motif would naturally suggest to each author similar situations.

§ 1208
Trifling
resemblances.

An inference of copying cannot be raised merely because each work employs similar colloquialisms, or other inconsequential similarities.⁸²

§ 1209
Reproduction
of matter not
in a common
original.

A claim of independent dramatization from common sources was held, necessarily, to fail, where the work contained incidents, characters and scenes found in another version of it, which were foreign to the original work.⁸³

§ 1210
Common
errors.

One kind of resemblance, however, is almost invariably fatal to a defense of independent accidental reproduction. That is the ascertainment of common errors in both works. Their presence exceeds the limit of credibility. In rare cases, they may be accounted for on the score of errata, occurring in the original sources of information, or as likely to arise out of common efforts of the parties,⁸³ but, except in such very unusual instances, common errors, in the absence of satisfactory explanation, are, properly and necessarily, held to be conclusive evidence of copying.⁸⁴

§ 1211
Effect of
ascertainment
of common
errors.

In the nature of things, the number of errors in a work worth copying must be few. Extensive reproduction of such errors cannot be expected. On the other hand, where found, it is, accordingly, a legitimate inference that there has been copying of non-erroneous matter. Part of a work may unlawfully be a copy of another and the other parts not.⁸⁵ The law is, accordingly, thoroughly well settled that if common errors be shown the burden is on the defendant to show, by clear and satisfactory proof, that the remainder of the later work was not

§ 1212
Burden of
proof to show
what was
copied,
shifted.

82—Bachman v. Belasco, 224 F. 817.

83—Simms v. Stanton, 75 F. 6.

84—List Publishing Co. v. Keller, 30 F. 772; Frank Shepherd Co. v. Zachary P. Taylor Co., 185 F. 941; Jewelers Mercantile Agency v. Jewelers Weekly Publishing Co., 155 N. Y. 241, 41 L. R. A. 846.

85—Story v. Holcombe, 4 McLean 306.

copied.⁸⁶ In the absence of such proof, the whole work will be deemed infringing and, ordinarily, be subject to injunctive restraint.⁸⁷ The same rules apply where there is evidence that part of a non-imaginative work was pirated, although common errors are not shown.⁸⁸ If the defendant establish that portions of the work were not copied, these will be excepted from the injunction.

The rule was expressed, as follows, by Lord Eldon:⁸⁹

“If the parts which are copied, cannot be separated from those which are original, without destroying the use and value of the original matter, he who has made an improper use of that which does not belong to him must suffer the consequences of so doing. If a man mixes what belongs to him with what belongs to me, and the mixture be forbidden by the law, he must again separate them and he must bear all the mischief and loss which the separation may occasion. If an individual chooses in any work to mix the literary matter which belongs to me, he must be restrained from publishing the matter which belongs to me; and if the parts of the work cannot be separated, and if by that means the injunction which restrained the publication of my literary matter, prevents the publication of his own literary matter, he has only himself to blame.”

Clear, convincing and satisfactory proof, preferably documentary, is essential to counterweigh the presumption of copying created by common errors.⁹⁰

§ 1213
Effect of failure to meet burden.

§ 1214
Non-imaginative works: same rule, though no common errors.

§ 1215
Statement of foregoing rules.

§ 1216
Proof necessary to account for common errors.

86—West Publishing Co. v. Lawyers Cooperative Publishing Co., 35 L. R. A. 400, 79 F. 756; Frank Shepherd Co. v. Zachary P. Taylor Publishing Co., 185 F. 947

87—Lewis v. Fullerton, 2 Beav. 6. See also § 1408.

88—Lewis v. Fullerton, 2 Beav. 6.

89—Mawraan v. Tegg, 2 Russ. 385.

90—List Publishing Co. v. Keller, 30 F. 772.

The original manuscripts,⁹¹ notes, and other incidental, written tools, or adjuncts, to the production of the work, should be produced.⁹² If the work was the product of more than one mind, each author should give direct, unequivocal and detailed testimony as to how far, if at all, common errors affect his share of the work.⁹³

Instructions to employees to make personal investigations and not to copy would be no defense if disobeyed, although, it was said, such instructions would be considered on striking out the work of the dishonest employees only.⁹⁴

§ 1217
Bare denials.

Bare sworn denials of copying, and assertion of original research, will not avail in the presence of such demonstrated common errors.⁹⁵ He who does not respect the property of others cannot be expected to respect the truth. Or, to put it another way, a full denial, not impugned by intrinsic, or extrinsic, facts nor the suppression of evidence, will, it seems, meet the plaintiff's prima facie case based upon such common errors, but mere denials, however full, will not avail, where the circumstances are such as to show some piracy by the deniers.⁹²

§ 1218
Previous piracy.

§ 1219
Insufficient capital.

§ 1220
Number of common errors needed for rule to apply.

Evidence of prior piracies on defendant's part is a circumstance, having force, to be considered in this connection.⁹⁶ So is patently insufficient capital for the task in hand, if legitimately conducted.⁹²

Just how large a percentage of common errors must be shown for the rule to apply is not entirely clear. In one directory case,^{96a} thirty-nine (39)

91—Hotten v. Arthur, 1 H. & M. 747.

92—Chicago Directory Co. v. United States Directory, 122 F. 192.

93—West Publishing Co. v. Lawyers Cooperative Publishing Co., 25 L. B. A. 441, 64 F. 300; Trow Directory & Printing Co. v. Boyd, 97 F. 586.

94—Trow Directory Co. v. Boyd, 97 F. 586.

95—Chicago Dollar Directory v. Chicago Directory Co., 66 F. 977; George T. Bissel Co. v. Welch, 131 F. 586.

96—Park & Pollard Co. v. Kellerstrass, 181 F. 431; Jewelers Mercantile Agency v. Jewelers Publishing Co., 155 N. Y. 241, 41 L. R. A. 846.

96a—List Publishing Co. v. Keller, 30 F. 772.

errors in 2,800 names published; in another, 67 out of 6,000⁹⁷ and in a third, 12 names and addresses^{97a} were held to put defendant to its proof. In another case,^{97b} errors and other asserted instances of piracy, involving less than 1% of the subject matter, led to the same result.

On the other hand, it was held that where the trial Court had found as a fact that the proportion of infringing matter was "insignificant," as compared with the volume of independently acquired information, which was contained in the later compilation, which represented a great expenditure of time and money, an injunction would be refused, the plaintiff being remitted to a Court of law to recover such actual damages as could be proven.⁹⁸ The last cited case is based upon general equitable principles⁹⁹ and not upon any especial doctrine of copyright law.

The English Courts have been much influenced in such cases by consideration of whether the defendant has frankly avowed making some use of the prior work or not.¹ If use has been admitted, this has been deemed a factor in defendant's favor and if use has been denied, but some use deemed established to the satisfaction of the Court, this has been deemed fatal to defendant's case. So a denial by the defendant that he had done any copying, or that he had taken any ideas, or language from an earlier work, was held² inconsistent with a claim that he had made a fair use only of such work, where the

§ 1221
Admission of
use of copy-
righted work.

97—Trow Directory Co. v. Boyd, 97 F. 536.

97a—Trow Directory & Printing Co. v. United States Directory Co., 122 F. 191.

97b—West Publishing Co. v. Lawyers Cooperative Pub. Co., 79 F. 756, 35 L. R. A. 400.

98—Dun v. Lumberman's Credit Association, 209 U. S. 20, 52 L. ed. 663.

99—See also Record & Guide Co. v. Bromley, 175 F. 156.

1—See Spiers v. Brown, 6 Weekly R. 652; Wilkins v. Aiken, 17 Ves. Jr. 422.

2—Jarrold v. Houlston, 3 Kay. & J. 708.

Court found, that some of the ideas of the earlier work had been taken by him.

§ 1222
Proof of original to show copying.

It is unnecessary to produce the original copyrighted work to prove copying. The testimony of one who has seen it, is sufficient for that purpose.³

§ 1223
Burden of proof as to prior publication.

In an English case,⁴ prior publication of the work or transfer of the title thereto to one other than the plaintiff, were held defenses to be proven by defendant, if possible. Similarly, if defendant asserts prior foreign publication as a defense to an action for infringement, the burden is upon him, not only to prove such publication, but that it was authorized by the proprietor of the work or his predecessor in interest, while he held title to it.⁵

§ 1224
Various defenses to infringement: use of new title.

Where a work was copyrighted under one title, but produced under another, this was held⁶ to be no defense, to one who infringed with full knowledge of the facts, although it was intimated it might have been otherwise had there been absence of such knowledge.

§ 1225
Estoppel by conduct.

In an early case,⁷ it was held that an author, who first published his work abroad, and, who instead of using due diligence to publish it in England, forebore doing so until some other person did so, "fairly and without blame," could not, at a distance of time, stop such publication, or treat its continuance as a piracy. This decision rests upon the theory that that cannot be made unlawful which was lawful when begun; but for this to apply, if sound, in the United States, the question must first be answered as to what the effect of a foreign first publication is,⁸ as, if it is not equivalent to a domestic first publication, in any of its consequences, it would

3—Lucas v. Williams, (1892) 2 Q. B. 113.

4—Kenrick v. Danube Collieries etc. Co., 39 W. R. 473.

5—Shook v. Neuendorff, 11 N. Y. Daily R. 985.

6—Collier v. Imperial Film Co., 214 F. 27.

7—Clementi v. Walker, 2 Barn. & Cr. 861.

8—See § 736 *et seq.*

appear immaterial and the result of the case not law here.

A further defense to what otherwise would be infringement, may exist in the relations or contracts of parties to the controversy. Thus they may have precluded themselves by agreement from either attacking the validity of a copyright or from asserting rights against one another on principles of copyright law.⁹

§ 1226
Estoppel by contract.

Other questions of procedure and pleading in copyright causes are discussed elsewhere.¹⁰

Having now considered what constitutes infringement, the remedies provided against it, may be taken up, in their turn. We thus find a copyright proprietor whose work has been infringed is entitled:

Section 25 (Continued):

§ 1227
The remedies for infringement.

(A) To an injunction restraining such infringement.

§ 1228
(1) Injunction.

The general principles of equity apply. This subject is also covered by Section 36 of the Act, in connection with which the matter is discussed at length.¹¹

An infringer is further liable

(B) To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only and the defendant shall be required to prove every element of cost which he claims, or in lieu of actual damages and profits such damages as to the Court shall appear to be just, and in assessing such damages the Court may, in its discretion, allow the amounts as hereinafter stated, but in case of a

§ 1229
(2) Damages and accounting for profits.

9—Widmer v. Greene, 14 N. Y. Daily R. 529.

10—See §§ 1316 et seq., 1291 et seq., 1229 et seq., 1406 et seq.

11—See § 1404.

newspaper reproduction of a copyrighted photograph such damages shall not exceed the sum of two hundred dollars nor be less than the sum of fifty dollars, and in the case of the infringement of an undramatized or non-dramatic work by means of motion pictures, where the infringer shall show that he was not aware that he was infringing, and that such infringement could not have been reasonably foreseen, such damages shall not exceed the sum of one hundred dollars; and in the case of an infringement of a copyrighted dramatic or dramatico-musical work by a maker of motion pictures and his agencies for distribution thereof to exhibitors, where such infringer shows that he was not aware that he was infringing a copyrighted work, and that such infringements could not reasonably have been foreseen, the entire sum of such damages recoverable by the copyright proprietor from such infringing maker and his agencies for the distribution to exhibitors of such infringing motion picture shall not exceed the sum of five thousand dollars nor be less than two hundred and fifty dollars, and such damages shall in no other case exceed the sum of five thousand dollars nor be less than the sum of two hundred and fifty dollars, and shall not be regarded as a penalty. But the foregoing exceptions shall not deprive the copyright proprietor of any other remedy given him under this law, nor shall the limitation as to the amount of recovery apply to infringements occurring after the actual notice to a defendant, either by service of process in a suit or other written notice served upon him.

First. In the case of a painting, statue, or sculpture, ten dollars for every infringing copy made or sold by or found in the possession of the infringer or his agents or employees;

Second. In the case of any work enumerated in Section 5 of this Act, except a painting, statue, or

sculpture, one dollar for every infringing copy made or sold by or found in the possession of the infringer or his agents or employees;

Third. In the case of a lecture, sermon or address, fifty dollars for every infringing delivery;

Fourth. In the case of a dramatic or dramatico-musical or a choral or orchestral composition, one hundred dollars for the first and fifty dollars for every subsequent infringing performance; in the case of other musical compositions, ten dollars for every infringing performance.

This subdivision makes radical changes in the prior statutory law¹² and cases decided under former Acts are, to a considerable extent, overruled. Under the prior Acts, damages as distinguished from profits, could not be recovered at Equity;¹³ plaintiff was required to prove net profits, not merely gross receipts on sales;¹⁴ and penalties were awarded only in cases where copies were found in the possession of the defendant, through judicial seizure,¹⁵ prior to the institution of the suit for penalties.¹⁶ This has all been changed by the present Act.

A copyright proprietor now has three means of monetary compensation afforded him, where his rights are infringed.

First. He may recover all profits made by the infringer as a result of such infringement.

Second. He may recover his actual damages in addition to such profits, and

Thirdly. He may, in lieu of profits and actual

§ 1230
Changes effected in prior law by section.

§ 1231
Monetary remedies.

§ 1232
Accounting for profits.

§ 1233
Actual damages.

§ 1234
Amounts.

12—R. S. 4964, as amended by Act of March 3, 1891; R. S. 4965 as amended by Act of March 2nd, 1895.

13—Social Register Association v. Murphy, 129 F. 148; Stevens v. Gladding, 17 How. 447, 15 L. ed. 155.

14—Gilmore v. Anderson, 43 F. 267.

15—Bolles v. Outing Co., 175 U. S. 262, 44 L. ed. 156; Boston Traveller Co. v. Purdy, 137 F. 717.

16—Falk v. Curtis Publishing Co., 102 F. 967; aff'd 107 F. 967; Bolles v. Outing Co., 175 U. S. 262, 44 L. ed. 156.

§ 1235
Arbitrary or
fixed damages.

damages, if he so elects, recover arbitrary, fixed damages, "not by way of penalty," as follows:

(a) In the case of paintings, statuary or sculpture, \$10 per copy made, or sold by, or found in the possession of, an infringer;

(b) as to all works enumerated in Section 5 of the Act, not included in (a), \$1 per copy found in the possession of the infringer, or made, or sold by him;

(c) in the case of lectures, sermons or addresses, \$50 per infringing delivery;

(d) in the case of dramatic, dramatico-musical, choral or orchestral compositions, \$100 for the first, and \$50 for each subsequent, infringing performance; and

(e) in the case of other musical compositions, \$10 for each infringing performance.

§ 1236
Limit of
recovery of
fixed damages.

Such arbitrary, fixed damages cannot be less than \$250, nor more than \$5,000, in any case, except that in the case of newspaper reproductions of copyrighted photographs, such arbitrary damages shall not in any instance exceed \$200 nor be less than \$50 and except further, that in the case of innocent infringement, by motion pictures, of a non-dramatic or undramatized work, such fixed damages shall not exceed \$100. These limitations, however, do not apply to cases of infringement, after written notice.

§ 1237
Decisions
holding the
minimum
fixed damage
provisions not
binding upon
Court.

Various recent decisions appear, to take the view that even in cases of conceded infringement, where plaintiff seeks the fixed damages in question, the Court is not bound by the minimum amount. Thus in one case¹⁷ six cents damages only were allowed where the injury to plaintiff was nominal, infringement had been discontinued, and no profits had been made by defendant directly from the infringement. The Court does not appear to have considered that if there had not been indirect profit in this infringe-

17—F. A. Mills v. Standard Music Roll Co., 223 F. 849.

ment, by increasing defendant's sales, the piracy would almost certainly not have been committed.

There is a *dictum* in another case¹⁸ that the Court may go below even the minimum of fixed damages in making an award to plaintiff, if its discretion so decrees.

In a third decision,¹⁹ the Court held that for the minimum damage clause of the Act to apply the plaintiff must show actual substantial damage, at least equalling \$250, but that, if this is not done, the Court will disregard the minimum damage clause and fix its own measure of damages, arbitrarily, if it deems fit, in a lesser amount. If plaintiff can show "actual, substantial" damage, there is no need for him to invoke the provision as to fixed damages. He can then recover his actual damages. The provision was intended to cover cases, where such damage could not be proven.

None of these decisions refers to the others, and none cites any authority for its conclusions. It is deemed, with all due respect, that they misapprehend the language and purposes of the portion of the section under discussion, and that they are erroneous. It is of course plain, that the Court, in its discretion, may refuse to give any fixed damages at all, under this section. But this is not the equivalent of saying that if it finds, after having exercised that discretion, that some fixed damage should be allowed to plaintiff, that it may transcend *either* of the limits fixed by this section, for the allowance of such damages. If it is not bound by the provision as to minimum, logically, it would not be bound by the provision as to the maximum allowable. There is no difference in the language used in either connection. It would scarcely be contended that the Court is not bound by the limitation fixed as to the maximum of such fixed damages and this is deemed destructive

§ 1238
Discussion of
foregoing
cases.

18—Alfred Decker Cohn Co. v. Etchison Hat Co., 225 F. 136.

19—Woodman v. Lydiard Peterson Co., 192 F. 899.

of the asserted right to disregard the minimum provision. It is considered that, looking at the matter from the broad point of view which inspired this legislation, there is no injustice in this result. The minimum is low: the maximum, not over high. Cases doubtless will occur where adherence to the latter must work individual injustice. So instances where the former may do so must be expected.

Neither, however, furnishes any sound legal basis for ignoring the patent intention of Congress, and, in the long run, adherence to this, will, doubtless, result in reaching satisfactory results, when the general run of copyright litigation be considered.

§ 1239
Amount of
actual
damages
recoverable
unlimited.

The difficulty of proving actual damages in copyright cases is readily recognizable²⁰ but is diminishing with the spread of more liberal modern doctrines which allow the recovery of what a few years ago would have been regarded as purely speculative damages.²¹ It is to be observed that while there is a limit as to the arbitrary or fixed damages recoverable under the statute, there is no limit as to the actual damages recoverable, if proven.

§ 1240
The measure
of actual
damages.

The actual damages recoverable are all the damages which are the direct result of the infringer's wrongful act.²² In one instance,²³ it was held that the measure of plaintiff's damages was only for proven diminution of his sales up to the time of filing suit and not thereafter, since there was no competent evidence showing the number of infringing copies sold by the defendants and the profits realized thereon. In another instance,²⁴ the owner of unpublished pictures and designs suitable for advertisements recovered the cost of producing them, as damages, from an innocent infringer who

§ 1241
Cost of
production
an element.

20—Brady v. Daly, 175 U. S. 148 at p. 154, 44 L. ed. 109, 112.

21—Hough, J., in Universal Feature Film Co. v. Copperman, 218 F. 580.

22—Brady v. Daly, 175 U. S. 148 at p. 154, 44 L. ed. 109, 112.

23—Chils v. Gronlund, 41 F. 145.

24—Mansell v. Valley Printing Co., (1908) 2 Ch. 441.

had purchased them in good faith from a surreptitious copier. In a third case,²⁵ the damage incurred for unlawful performance of a play was deemed to be the value of a license to use the play, at the time and place of its infringing performance. The comparative rarity of cases on this point is unquestionably due to the, ordinarily, superior remedial value of other procedure open to plaintiff.²⁶

§ 1242
License value.

Relief, by way of an accounting for profits wrongfully obtained by infringement, was, even in the absence of statute, granted freely as incidental to a final injunction,²⁷ even where the occasion for the injunction had passed.²⁸ The entire net profits are awarded plaintiff in such a case.²⁹

§ 1243
Accounting.

While these profits are sometimes loosely spoken of as damages,³⁰ the inaccuracy of expression³¹ is readily perceptible when cases involving, for example, cheap reprints of expensive works are considered, where it may well be the copyright proprietor had no facilities for reaching the public

§ 1244
Net profits awarded.

§ 1245
Profits and damages distinguished.

25—Keene v. Wheatley, 4 Phila. 157.

26—The decisions which involve the conversion of works in which there is common law copyright and hold the measure of damages is their value to their owners, to be fixed in the sound discretion of the jury, may be consulted to possible advantage in certain cases. See Taft v. Smith Gray & Co., 134 N. Y. S. 1011.

27—Stevens v. Gladding, 17 How. 477; Fishel v. Lueckel, 53 F. 499; Falk v. Gast Lithographic Co., 54 F. 890; Dam v. Kirk La Shella Co., 41 L. R. A. (N. S.) 1002, 175 F. 902.

28—Hartford Printing Co. v. Hartford Directory Co., 146 F. 332; Gilmore v. Anderson, 38 F. 846.

29—Pike v. Nicholas, 5 Ch. App. 260, reversed on another point, 5 Ch. App. 251; Social Register Association v. Murphy, 129 F. 148. In Muddock v. Blackwood, (1897) 1 Ch. 58, the actual proceeds of the sale of copies were allowed the plaintiff as damages with no allowance for the selling expense, apparently on the theory, as expressed in the argument of counsel, that the sale of infringing copies was a tortious conversion of the same, but the report of the decision is too brief to render it clear.

30—Delfe v. Delamotte, 3 K. & J. 581.

31—Social Register Association v. Murphy, 129 F. 148.

§ 1246
Defendant's
actual, not
plaintiff's
possible,
profits
awarded.

§ 1247
The contrary
view adopted
in England.

§ 1248
Discussion of
the two views.

to which these appeal nor even a remote intention of essaying the task.

Thus, in one case,³² it appeared the copyrighted work was sold at \$1.75 a volume. The profit on this was about 56c a volume. The infringing volumes were sold at 50c and 10c a volume respectively. The plaintiff contended he was entitled to 56c for each volume sold, that is what his profits would have been, had he sold a corresponding number of volumes of his edition. It was held, however, he could only, on accounting, recover the profits realized by defendant, on the basis of defendant's prices.

This case cites and attempts to distinguish the rule of damages announced in an English case,^{32a} where the lower court said its view of the "damages" in cases of literary piracy was "that the defendant is to account for every copy of his book sold, as if it had been a copy of the plaintiff's and to pay the plaintiff the profit which he would have received from the sale of so many additional copies."

The injury to the copyright proprietor by infringement, through copying, is the reduction of his potential market for the sale of copies. Since this is demonstrably limited in every case, although the precise limits cannot be ascertained, every sale made by an infringer, in theory at least, since the person so purchasing will usually not purchase again from anyone, prevents a sale by the copyright proprietor. But it is normally impossible to show conversely, that any such sale would have been made to any given person by the copyright proprietor. His copies may be far less attractive in form,—he, or his salesmen, much less persuasive or enterprising, his prices (since he may have to pay royalties and other honest charges) much less attractive than the infringer's. He probably never heard of the pur-

32—Scribner v. Clark, 50 F. 473.

32a—Pike v. Nicholas, 5 Ch. App. 260.

chaser of the piratical copy and whether or not he would ever have heard of him, is entirely a question of chance. To say, then, that he would have sold him a copy of his work, if the infringer had not done so, is to substitute mere chance for even a degree of probability. In the Scribner case, the Court deemed it improbable that as many copies of an expensive edition would have been sold as of a cheap one.

This may or may not be true in a given case. Value, and selling power, is not necessarily a matter of price and many works are caviare to the general, whether they are produced in cheaper form or not. If, however, the Court's view be deemed sound, it is merely additional conjecture added to the conjecture that even if the edition had been of equal price the copyright proprietor might not have sold as many copies as the infringer did. The Scribner case appears indistinguishable, on principle, from *Pike v. Nicholas*, the cases differing, if at all, only in degree. It is unnecessary, however, to attempt to determine which case is correct, as an exposition of the law of damages, if the language of both is not erroneous in confusing profits with damages.³³ The present Act sharply differentiates between the two but allows *both* to be recovered, as one recovery, in a proper case. It would scarcely be contended that on infringement, a double measure of profits could be recovered, to wit, defendant's actual, and plaintiff's conjectural, ones, based on the number of infringing sales and on plaintiff's cost and sales prices. The language of the section elsewhere shows the profits referred to are the defendant's profits and are to be calculated on the basis of his sales and cost prices, not upon plaintiff's.

The general rule for accountings is to deduct from the selling price, the actual and legitimate manufacturing cost.³⁴ This rule makes no allow-

§ 1249
Method of
determining
profits.

33—Cf. *Social Register Association v. Murphy*, 129 F. 148.

34—*Callaghan v. Myers*, 128 U. S. 617, 32 L. ed. 547.

§ 1250
Stereotyping.

§ 1251
Salaries paid
defendants.

§ 1252
Resales.

§ 1253
Profits on
books, which
infringe in
part.

§ 1254
Cost of unsold
copies.

§ 1255
Production
cost of unsold
copies.

§ 1256
Advertising
receipts.

ance for the cost of making sales but it may well be questioned if this is not properly deductible, as was held in at least one instance.³⁵ The cost of stereotyping, where this is undertaken, since not a necessary incident of the printing and publishing of a book, the cost of editorial work on it and the amounts paid the defendants, as salaries, for their services in connection with the publication, are not deductible from the gross profits.³⁶

Profits are recoverable on each sale of a book which is sold several times by the infringer, after being repurchased by him.³⁶

If an infringing volume contain both copyrighted and uncopyrighted matter, the two necessarily go together on sale, being sold as a book, and not as fragments of a book, and, as profits result from the sale of the book as a whole, the owner of the copyright can recover the entire profits on the sale of such book.³⁷

The cost of unsold volumes, which are not returned, or offered to be returned, to the copyright proprietor is not deductible.³⁶

On the other hand, even though he does not sell all infringing copies printed by him, it has been held that the defendant is entitled to the deduction of all items comprised in the necessary cost of producing the infringing copies which would have been the same, irrespective of the number of copies sold, as for example, the expense of procuring copy, of obtaining type and cuts, and composition work in connection with the printing.³⁸

If the defendant realizes money by his infringement, in addition to the sale price of copies, as for example, from advertisements inserted in his work, he must account for such moneys.³⁸

35—Hartford Printing Co. v. Hartford Directory Co., 148 F. 470.

36—Callaghan v. Myers, 128 U. S. 617, 32 L. ed. 547.

37—Callaghan v. Myers, 128 U. S. 617, 32 L. ed. 547; Belford v. Scribner, 144 U. S. 488, 36 L. ed. 514.

Where the actual reasonable expense of producing the copies exceeded the gross receipts, the plaintiff was awarded the sum of six cents as profits.³⁸

§ 1257
Nominal profits.

For the purposes of such an accounting, the defendant may be compelled³⁶ to produce both his books and papers, unless he make oath that these have been destroyed.³⁹

§ 1258
Discovery.

The same rules obtain in the case of infringing performances. It has been held⁴⁰ that where such performances were spread over more than one theatrical season, the profits and losses should, in the absence of special circumstances, be calculated on the basis of each season, as a unit, so that losses incurred in a given season could not be charged against net profits of a different season. On such an accounting, the defendant is entitled to credit on the gross receipts all the direct expenses of presentation of a play, together with such a proportion of his general expenses, as is fairly to be appropriated to it. Under this rule, however, a defendant who is not the author of the infringing play, is not to be allowed royalties payable to the author, where the author has sold the play, nor anything for the use of the author's name, nor the whole purchase price of the play itself, but only the reasonable value of an exclusive license for the times of representation and, if a close corporation, not the salaries actually voted its officers but merely the proper proportional part of the reasonable value of their services. This case affords an illustration of the unfortunate effect the corporate fiction may have in cases of infringement, when contrasted with the opposite result reached in the case previously cited,⁴¹ where the infringers were partners, not a corporation.

§ 1259
Profits on infringement by performance.

§ 1260
Calculation of profits, by seasons.

§ 1261
Proportion of overhead deductible from gross profits.

§ 1262
Miscellaneous items allowed, or not, on such accounting.

38—Hartford Printing Co. v. Hartford Directory Co., 148 F. 470.

39—Gilmore v. Anderson, 43 F. 267 (this case is not law on its main point under the present Act).

40—Dam v. Kirk La Shelle Co., 189 F. 842.

41—Callaghan v. Myers, 128 U. S. 617, 32 L. ed. 547.

§ 1263
Commissions
as profits.

Commissions earned by merchants who sold a pirated article for the publisher were held profits for which they were compelled to account.⁴²

§ 1264
General
equitable
rules apply.

The general principles of equity apply to such accountings^{42a} and in doubtful cases, patent decisions dealing with questions of accounting may be consulted with profit.⁴³

§ 1265
Statutory rule
as to method
of proof on
accounting.

Great difficulties of proof are avoided by the provisions of the Act requiring the plaintiff merely to prove actual sales to show profits, leaving it for defendant to prove such items of cost as he claims to be properly deductible from the gross sales. Prima facie, therefore, under the Statute, the profits recoverable on proven infringement are the moneys representing the defendants' gross sales. This while technically merely a matter of the burden of proof, since it had been held sufficient for a prima facie case to show selling price and the usual manufacturer's cost, leaving it for defendant, if not satisfied, to undertake the burden of proving his actual legitimate expenses⁴⁴ nevertheless, marks a substantial remedial advance in the law applicable to such matters.⁴⁵

§ 1266
Fixed
damages.

Cases will frequently arise, however, where actual damages cannot be proven legally and where there were no profits. The frequency of such cases has been suggested to have occasioned the first copyright legislation.⁴⁶ But while proof of damage is difficult, infringement almost invariably results in actual injury.⁴⁷ To meet this situation, copyright legisla-

42—Stevens v. Gladding, 1 Curtis U. S. 608.

42a—Haas v. Leo Feist, Inc., 234 F. 105.

43—"There is such an analogy between actions under the patent laws and actions under copyright laws that like rules of practice should be applied in both cases," said Lacombe, J., in Scribner v. Straus, 130 F. 389.

44—Myers v. Callaghan, 24 F. 636.

45—Cf. Gilmore v. Anderson, 43 F. 267 (overruled by section).

46—Millar v. Taylor, 4 Burr. 2303.

47—Fishel v. Lueckel, 53 F. 499.

tion, from the earliest times, has provided for penalties, which, as legislators became more experienced with judicial doctrines of construction, in the case of penal statutes, have been changed to arbitrary, or fixed, damages. These, as fixed in the present Act, are expressly stated not to be penalties, and, although such a statement is not controlling on the courts, the result indicated will probably be reached, if the matter comes up for actual decision. The fact that the award of such damages is, expressly, made discretionary and that any amount, within indicated minimum and maximum limits, may be awarded would appear to lead to this result.⁴⁸ The discretion contemplated is, of course, a judicial one and not a merely arbitrary or capricious action. The rules which guide the Court in such a case are set forth in a recent decision.^{48a} Such damages, as distinguished from actual damages, appear recoverable in equity, as they are to be assessed by the Court, in "lieu of" accounting and damages. It may be doubted, accordingly, whether they may be recovered at law. This appears to change the prior rule that damages, as distinguished from penalties, were not recoverable in equity.⁴⁹

However, the Court may submit any question of fact in a suit for infringement, to a jury, for advisory action, or subject to setting the verdict aside, if it deem it unsatisfactory, as against the weight of evidence. It was so held with respect to issues of infringement and identity in one case,⁵⁰ and in another,⁵¹ it was held that the Court may allow a jury to assess damages, within the prescribed maximum and minimum limits. The jury in such

§ 1267
Not penalties
under present
Act.

§ 1268
Award dis-
cretionary.

§ 1269
Judicial
discretion.

§ 1270
Such damages
recoverable
in equity.

§ 1271
Submission of
question of
damages
to jury.

48—See *Brady v. Daly*, 175 U. S. 148, 44 L. ed. 109.

48a—*Gross v. Van Dyke Gravure Co.*, 230 F. 412.

49—*Chapman v. Ferry*, 12 F. 693.

50—*Maxwell v. Goodwin*, 93 F. 665.

51—*Mail and Express Co. v. Life Publishing Co.*, 192 F. 899.

§ 1272
Limits on
award of fixed
damages.

§ 1273
After notice.
Other
exceptions.

§ 1274
Discussion of
language of
the special
limitations.

§ 1275
“News-
paper.”

§ 1276
Degree of
proof of
innocent
infringement.

§ 1277
“Non-
dramatic
work.”

§ 1278
The special
limitation
in the case of
motion picture
manufac-
turers.

cases appears to act merely as an aid to the Court by expressing its view on the facts.

The limits put upon such fixed or arbitrary damages are general, except in case of infringement after written notice, where there is no limit, and in cases of newspaper reproduction of photographs, or of innocent infringement, by motion pictures, of undramatized or non-dramatic works.

It would seem that these exceptions, which appear arbitrary, should be strictly construed, from the very fact of being exceptions, in a section which Congress has studiously sought to render non-penal. Thus “newspaper” would not appear to include the usual magazine, pictorial, weekly, or similar periodical publications, even when largely devoted to commentaries on current events, as distinguished from narration of the events themselves. So an infringer by means of motion pictures who claims he was not aware that he was infringing an undramatized or non-dramatic work and could not reasonably have foreseen that he was infringing, should be held to very strict proof of diligent inquiry and good faith or much money may be earned with little compensation to the copyright proprietor. Whether “non-dramatic work” means non-dramatic in form or in essence, and whether undramatized work refers to all works in non-dramatic form or only to such literary works as are incapable of being put in that form, are questions that may well be left to the Courts.

Provision is made in the case of innocent infringement of a dramatic or dramatico-musical work, by a “maker” of motion pictures and “his distributing agencies,” for a somewhat different exception to the general rules laid down by the Act. The effect of innocent infringement where there is an inadvertent or accidental omission of copyright notices from one or more copies is discussed elsewhere.⁵² In every

52—See § 904 *et seq.*

other instance of infringement, each and every infringer is liable, personally, to the maximum limit of fixed or arbitrary damages, applicable to the particular infringement in question.⁵³ Since infringement is in the nature of a tort, the fact that an infringer acted as agent or employee for another, should be no defense to an action against him, if he personally actually participated in the infringing act.⁵⁴ This is in accordance with general rules of law and appears to follow from the express language of this section. It does not necessarily follow from this rule that more than one recovery may invariably be had in such a case of principal and agent, as in many instances, the law of joint tortfeasors would apply. The exception under discussion is designed, apparently, to cover a somewhat different situation. If *A* duplicated a copyrighted film and sells a copy to *B*, he infringes both by copying and by selling a copy. *B* participates in neither act of infringement. If, however, *B* were to resell the copy he would infringe and *A* would not participate in *B*'s infringing act. If *A* made a motion picture play from a novel or drama, he would not infringe by copying, although he might infringe rights of dramatization in the case of the novel. If he sold something that was not a copy, the bare fact of the sale would not be infringement; but if he must be taken to know the article so made and sold by him was made and sold in order to be used for public performance he would be an infringer, equally with the person who used the film for public performance.⁵⁵ It would seem, if analyzed, however, that his infringement and the infringement of the exhibitor are not on all fours. Whether the copyright proprietor could recover the maximum arbitrary damages separately, from each, even though the Court, in its discretion,

53—Gross v. Van Dyke Gravure Co., 230 F. 412.

54—See §§ 1188-1198.

55—See § 1189.

§ 1279
Multiple
recoveries of
fixed
damages.

might deem this just, may be considered an open question. Such cases however, are not covered by the exception under discussion, which relates to makers of films, and their agencies for distribution, not for exhibition. What the word "agencies" means as used here, has not been decided, and the exact scope of this exception is hence not yet determined. For the rest, it would appear more in harmony with the evident intention of the Act to hold that several recoveries of maximum damages may be had in all cases outside of the exception noted, against all infringers in all cases where they are not strictly joint infringers, actors in one and the same infringing transaction. The discretionary power, afforded the Court by the Act, to refuse any such recovery, in any case, where it would deem its allowance unjust, would furnish the needed check on such doctrine. It has been held that the "infringement" for which discretionary damages lie is that conduct of the defendant which, being one act or many, which constitutes a connected and fairly unitary invasion of the proprietor's rights, and that only one recovery for such "composite" infringement is permissible, altho the acts constituting it occur at separate times, when separate parts of the work appear.⁵⁶

§ 1280
Fixed dam-
ages cover all
prior infringe-
ment, except
of common
law copyright.

For the purposes of the section, in applying the minimum and maximum of fixed damages, the recovery permitted must be deemed to be for all infringing acts, prior to suit. Such recovery would not apply, however, to cases where there had been infringement before the statutory copyright vested. In an early case,^{56a} it was held that the taking out of a statutory copyright does not deprive an author of the right to sue for infringement of his common law copyright committed prior to publicatio:

56—L. A. Westermann Co. v. Dispatch Printing Co., 233 F. 609.
56a—Bouccicault v. Wood, 2 Biss. 34.

It has been deemed that the fixed damages can only be given once for a given act of infringement, no matter how many parties aggrieved thereby there may be. This seems sound and just.⁵⁷

§ 1281
Only one award of fixed damages for one infringing act.

It is further to be observed that the exceptions, made in this section, which have been noted, do not apply to cases where a copyright proprietor may elect to recover actual damages and profits. This follows from the grammatical structure, verbiage and evident intent of the section.

§ 1282
Limitations of section apply solely to arbitrary damages.

Under former Acts, the penalties or fixed damages as the case might be, for which those sections made provision, were collectible only with respect to copies found in the possession of the infringer.⁵⁸ The Courts held this phrase meant found in the possession of the infringer, by writ of seizure or some similar process, prior to suit brought for the penalties or fixed damages in question.⁵⁹ The mere fact that they were actually in the possession of one of his employees was not enough,⁶⁰ and if he had been fortunate enough to sell them and get them out of his hands, the copyright proprietor was remediless. One case even went so far as to hold a copy purchased from an infringer was not found in his possession.⁶¹ In another case, it was held that where simultaneous suits were brought, one for seizure and the other for penalties, the first rendered the latter premature.⁶²

§ 1283
In connection with what copies penalties allowed under prior Acts.

These rules were somewhat relaxed by later decisions.

Thus in one instance it was held⁶³ that under the

57—New Fiction Publishing Co. v. Star Co., 220 F. 994.

58—R. S. § 4965 as amended.

59—Thornton v. Schreiber, 124 U. S. 612, 31 L. ed. 577; Bolles v. Outing Co., 175 U. S. 262, 44 L. ed. 156, Hegeman v. Springer, 110 F. 374.

60—Thornton v. Schreiber, 124 U. S. 612, 31 L. ed. 577.

61—Child v. New York Times Co., 110 F. 527.

62—Falk v. Curtis Publishing Co., 102 F. 967, aff'd 107 F. 126; Child v. New York Times Co., 110 F. 527.

63—Stern v. Jerome H. Remick & Co., 164 F. 781.

prior statute, a writ of seizure and a summons might be obtained simultaneously and in another,⁶⁴ a writ obtained before the issuance of a summons was sustained.

§ 1284
The present law.

The present Act cures the difficulties which resulted from this interpretation of the law, as it provides for recovery not only for copies found in the infringer's possession but also for copies made or sold by him, or his agents, or employees.

§ 1285
Demand for damages.

No demand or refusal were held necessary to recovery penalties under R. S. 4965.⁶⁵

§ 1286
Discovery to lay basis for fixed damages.

If the damages in question are held not to be penalties, an infringer, doubtless, could be compelled, by subpoena, to produce his books to show how many infringing copies he had made or sold. The rule was to the contrary in actions for penalties under former statutes.⁶⁶

§ 1287
English rule as to who liable for penalties.

In an English case,⁶⁷ it was held that an author whose copyright was infringed was entitled to recover separate penalties from every infringer, principal or agent, master or servant.

§ 1288
Other cases under prior statutes.

Various decisions based upon the peculiar language of former statutes, appear to have no present importance. Thus in one case,⁶⁸ it appeared that a newspaper had been copyrighted as a book. It contained a cut or engraving, not copyrighted separately. There were two sections of the Revised Statutes 4964, 4965, which governed the award of damages and penalties on infringement. The first referred to books. The second referred to infringements taking place "after the recording of the title" of various other works including cuts or engravings. The one gave damages; the other, penalties. It was held that a defendant, who copied the cut or engrav-

64—Richardson v. A. C. Bosselman Co., 164 F. 781.

65—Hegeman v. Springer, 100 F. 374.

66—Johnson v. Donaldson, 3 F. 22; Chapman v. Ferry, 12 F. 693.

67—Baschet v. London Illustrated Standard Co., (1900) 1 Ch. 73.

68—Bennett v. Boston Traveler Co., 101 F. 445.

ing from the newspaper in question could not under the circumstances be held for penalties under R. S. 4965, although he could have been sued under R. S. 4964. In another instance,⁶⁹ the decision turned upon the fact that the statute gave penalties per "sheet" and not per copy, and, hence, only one penalty was awarded where 2,400 copies were printed on one sheet. In a third case⁷⁰ recovery was refused because the necessary judicial forfeiture had not taken place before the running of the Statute of Limitations. These cases are inapplicable under the present statute.

An infringer is further liable

Section 25 (Continued)

(c) To deliver up on oath, to be impounded during the pendency of the action, upon such terms and conditions as the Court may prescribe, all articles alleged to infringe a copyright;

§ 1289
The third remedy for infringement.

(d) To deliver up on oath for destruction all the infringing copies or devices, as well as all plates, molds, matrices or other means for making such infringing copies as the court may order.

§ 1290
Temporary or final, delivery up of infringing articles.

The first of these subdivisions deals with interlocutory relief; the second, with final relief. The latter may be disposed of the more briefly. Delivery of articles found to be infringing may be made either to the plaintiff or to the marshal, for destruction, as the Court may order. Such articles are no longer forfeited to plaintiff, as under the prior Act. The "means" for making infringing copies, to which reference is had in the section, would appear to mean such apparatus as is peculiarly adapted to reproduce the infringing matter and not to include apparatus capable of innocent use. This subdivision of the law is constitutional⁷¹ and largely declara-

§ 1291
Final relief.

§ 1292
Destruction of enumerated infringing articles.

69—Falk v. Heffron, 56 F. 299.

70—Wheeler v. Cobbey, 70 F. 487.

71—Universal Feature Film Co. v. Copperman, 206 F. 69.

§ 1293
Preliminary
seizure of
infringing
copies.

§ 1294
Practice.

§ 1295
The affidavit.

§ 1296
The bond.

§ 1297
Determination
of damages on
seizure bond.

tory, as a Court of Equity has been held to have inherent power, aside from statute, to order the destruction of infringing copies.⁷²

The interlocutory relief authorized is very sweeping. The Supreme Court of the United States, pursuant to the requirement of the concluding paragraph of this section, has adopted certain rules of procedure and practice in connection with the administration of the section. Nine, out of the thirteen Rules so adopted, deal with the subdivision of the section under discussion. The Rules provide that upon the institution of suit, or thereafter before final judgment, the plaintiff, or his agent, or attorney, may file, with the Clerk of any Court having jurisdiction, an affidavit stating, "upon the best of his knowledge, information and belief," the number and location and value, as near as may be, of the articles alleged to infringe and a bond, executed by at least two sureties, approved by the court or a commissioner thereof.⁷³ The bond is to be at least twice the reasonable value of the articles sought to be seized, the specific amount to be fixed by the Court.⁷⁴ It is to be conditioned for the prompt prosecution of the action, suit or proceeding; for the return of said articles to the defendant, if they, or any of them, are adjudged not to be infringements or if the action abates or is discontinued before they are returned to the defendant, and for the payment to the defendant of any damages which the court may award to him against the plaintiff or complainant.

In the only American reported case in point, where defendant was successful, the Court, after decision and prior to the entry of judgment, directed witnesses to be heard before it, on notice, upon the

72—Hole v. Bradbury, 12 Ch. 886.

73—Rule 5.

74—Rule 4.

question of damages.⁷⁵ The cause involved a motion picture photoplay and the damages awarded were the profits lost to defendant by reason of his being unable to exhibit the film after seizure.⁷⁶

Upon the filing of the affidavit and bond, and the approval of the bond, the Clerk issues a writ directed to the marshal of the District where the infringing articles are stated in the affidavit to be, which writ runs also generally to any marshal of the United States, directing such marshal forthwith to seize and hold such alleged infringing copies, subject to the order of the Court issuing the writ or of the Court of the District where the seizure is made. In practice, an order of the Court directing the Clerk to issue the writ and copies of the proposed writ prepared by the plaintiff's attorneys or solicitors should, in most districts, accompany the affidavit and bond to insure speedy action.

The affidavits requisite are simple. The affiant who swears to the value of the alleged infringing articles, must show some experience tending to furnish a basis for his valuation of the infringing articles, but the affidavits as to infringement may be, and usually are, of the scantiest description.

A copy of the affidavit, writ and bond are furnished, which the marshal serves, on making the immediate seizure required by the Rules.⁷⁷

Within three days after the seizure, the defendant may file notice of exceptions either to the amount of the bond, or the sureties, or both.⁷⁸ Unless such exceptions are filed within the time stated, the sufficiency of the bond cannot be questioned. If the exceptions are sustained, the Court may order a new bond filed and that, if this be not done within a time

§ 1298
The writ of
seizure.

§ 1299
Nature of
requisite
affidavits.

§ 1300
Service of
papers.

§ 1301
Exceptions to
security and
practice in
connection
therewith.

75—Universal Feature Film Co. v. Copperman, 218 F. 580.

76—See also Novello v. James, 5 De G. M. & G. 876.

77—Rule 5.

78—Rule 7.

named, that the property seized be returned to defendant.

Notice of justification of sureties must be given within ten days after notice of exception is filed.⁷⁹ If the defendant excepts to the bond, he may not thereafter, before final judgment, apply to the Court for the return of the articles seized.⁸⁰

§ 1302
Application
for return of
seized copies.

If he has not excepted to the bond, he may make such application upon an affidavit containing proof that the articles seized are not infringing.⁸¹ On such application, the Court may, in its discretion, and after such hearing as it may direct, order the return of the seized articles upon the filing of a satisfactory bond conditioned "for the delivery of said specified articles to abide the order of the Court."⁸²

§ 1303
Bond.

§ 1304
Practice on
such
applications.

Since the whole object of the writ of seizure is to prevent the use of alleged infringing articles or facilities and such use, if the articles are returned, is not a breach of the bond required for their return, it would seem, that such return should only be ordered in the clearest cases,⁸³ upon strong and satisfactory proof of non-infringement. This is the general practice in the Second Circuit, although reported decisions are not to be found, and such applications, founded on affidavits alone, are almost invariably denied. On the other hand, since the Rules authorize a summary hearing, it would seem that if the real question at issue between the parties is one of law as to the validity of the copyright, much expense and loss might be saved by determining this question on such hearing, where there is no dispute as to the facts. Issues of fact, however, cannot, profitably, be disposed of on such summary hearings and where they are involved such applications should be denied.

79—Rule 8.

80—*Universal Feature Film Co. v. Copperman*, 206 F. 69.

81—Rule 9.

82—Rule 10.

83—*Crown Feature Film Co. v. Bettis Amusement Co.*, 206 F. 362.

From the analogies to be drawn from cases dealing with bonds furnished in other provisional remedy proceedings, it may be doubted whether a successful defendant can recover any damages sustained by him in excess of the bond, or bonds, furnished on the seizure. These considerations, however, give force to the view that upon a reasonable showing, the bonds furnished by plaintiffs who have seized defendants' goods, should be increased, freely and liberally, to protect such defendants against loss. No one who invokes the radical remedy of seizure can justly complain against such a rule and by its application some little injustice may be prevented.

§ 1305
Amount of recovery by successful defendant.

Counsel fees where recoverable, are allowed as part of the successful party's costs,⁸⁴ not as damages within the meaning of that word,⁸⁵ as used in the bond for seizure.

§ 1306
Counsel fees costs, not damages.

Where a writ of seizure is vacated, defendant may recover the probable profits he has lost as a result of such seizure,⁸⁶ but where relief was refused plaintiff on the ground that his work was partially indecent, but infringement was proven, the defendant was not allowed the damages sustained by the issuance of a preliminary injunction in the cause.⁸⁷

§ 1307
State replevin laws.

The procedure on seizure is not in the nature of replevin and State replevin laws do not apply to it.⁸⁸

§ 1308
Attachments.

No attachment against property can issue in a copyright cause because the United States statutes limit its issuance to actions at law.⁸⁹

84—See judgment in *Universal Feature Film Co. v. Copperman*, 218 F. 578.

85—*Oelrichs v. Spain*, 15 Wall. 211, 21 L. ed. 43; *Ludberg v. Howard*, 146 F. 467.

86—*Universal Feature Film Co. v. Copperman*, 212 F. 580. Cf. *Novello v. James*, 5 De G. M. & G. 876.

87—*Broder v. Zeno Mauvais Music Co.*, 88 F. 74.

88—*Rinehart v. Smith*, 121 F. 148; *Gustin v. Record Publishing Co.*, 127 F. 603; *Hills & Co. v. Hoover*, 142 F. 904; *Richardson v. A. C. Bosselman & Co.*, 164 F. 781.

89—*Dixon v. Corinne Runkel Stock Co.*, 214 F. 418.

Section 25 provides further that

Section 25 (Continued):

§ 1309
Remedies for
infringement
of musical
copyright, by
mechanical
reproductions.

(e) Whenever the owner of a musical copyright has used or permitted the use of the copyrighted work upon the parts of musical instruments serving to reproduce mechanically the musical work, then in case of infringement of such copyright by the unauthorized manufacture, use, or sale of interchangeable parts, such as disks, rolls, bands, or cylinders for use in mechanical music-producing machines adapted to reproduce the copyrighted music, no criminal action shall be brought, but in a civil action an injunction may be granted upon such terms as the Court may impose, and the plaintiff shall be entitled to recover in lieu of profits and damages a royalty as provided in Section 1, subsection (e) of this Act: Provided also, That whenever any person, in the absence of a license agreement, intends to use a copyrighted musical composition upon the parts of instruments serving to reproduce mechanically the musical work, relying upon the compulsory license provision of this Act, he shall serve notice of such intention, by registered mail, upon the copyright proprietor at his last address disclosed by the records of the Copyright Office, sending to the Copyright Office a duplicate of such notice; and in case of his failure so to do the Court may, in its discretion, in addition to sums hereinabove mentioned, award the complainant a further sum, not to exceed three times the amount provided by Section 1, subsection (e), by way of damages, and not as a penalty, and also a temporary injunction until the full award is paid.

§ 1310
Discussion of
sub-section.

There appear to be no reported cases construing this subsection. Its precise scope is not readily apparent. On its face, it appears to provide a

special class of remedies for infringement of musical copyright by mechanical means, in cases which would fall within the compulsory license system, and to exclude cases of such infringement from the general provisions with reference to infringement found in the preceding subdivisions of the Section. The subdivision has no application to cases of infringement, where the compulsory license system established by Section 1, subdivision (e), does not apply. Aside from the remedy by injunction contemplated by the Section, the Section, apparently, is drawn to permit the recovery of a sum not exceeding three times the amount of royalties due, plus such royalties, in lieu of profits and damages, if the infringer has not filed the prescribed notice of intention to rely upon the compulsory license system with reference to mechanical music records. If he has filed such notice of intention, and he infringes, he need only pay the royalties due, "in lieu of damages and profits." Since an accounting is incident to injunction, and since the royalties are due irrespective of this Section, under Section 1, it should not be difficult for a party aggrieved to determine which method of procedure against such an infringer will probably net him larger returns. This subdivision must be compared with Section 1, subdivision (e). In view of the grave doubt as to the constitutionality of the latter subdivision, it is deemed no good purpose can be subserved by an extended discussion of the present subdivision.

In conclusion, Section 25 provides that

Section 25 (Concluded):

Rules and regulations for practice and procedure under this Section shall be prescribed by the Supreme Court of the United States.

§ 1311
Supreme
Court Rules of
Practice and
Procedure
under
Section 25.

The bulk of the Rules prescribed under this

§ 1312
Equity
practice
prescribed.

§ 1313
Proof of
copies
prescribed.

§ 1314
Pleading in
copyright
cases.

§ 1315
Allegations
essential to
complaint or
declaration.

Section have been discussed.⁹⁰ The remaining Rules of importance include the first rule, which makes the existing rules of equity practice, so far as they may be, applicable in proceedings under this Section and the second rule, which requires copies of the copyrighted work and of the infringing work, where feasible, to accompany the petition or their absence explained. The latter requirements need not be observed in cases of infringement by performance or public representation or in cases involving sculpture or similar works, but compliance in other cases may be compelled on motion.⁹¹

There are a number of decisions which involve questions of pleading under various provisions of copyright acts, past or present.

Copyright, if asserted, must, of course, be pleaded.⁹² It has been deemed essential to plead that the copyrighted work is the result of original, intellectual production, thought and conception.⁹³ A complaint must show that the person who took out a copyright was entitled to do so and owned the copyrighted work.⁹⁴ An allegation that the copyrighted work has been published, is essential in a complaint for infringement.⁹⁵ It has been held⁹⁶ a complaint for infringement of copyright must allege performance, in detail, of the acts which, by statute, are conditions precedent to the obtaining of a copyright and a mere general allegation that the copyright was taken out by plaintiff, previous to the publication of the work, in full compliance with the requirements of the laws of the United States, is

90—See § 1293 *et seq.*

91—*Lesser v. George Borgfeldt & Co.*, 188 F. 864.

92—*Stover v. Lathrop*, 33 F. 348.

93—*Falk v. City Item Printing Co.*, 79 F. 321.

94—*Ford v. Blaney Amusement Co.*, 148 F. 642.

95—*Bouccicault v. Hart*, 13 Blatch. 47.

96—*Trow City Directory Co. v. Curtin*, 36 F. 829; *Burnell v. Clow*, 69 F. 993; *Ford v. Charles E. Blaney Amusement Co.*, 148 F. 642.

insufficient, as a mere conclusion of law. An allegation that the plaintiff was "the author, inventor, designer and proprietor of a certain photograph and negative thereof, known and entitled" etc., was held sufficient without giving a detailed description of how the photograph was produced and although no copy was attached.⁹⁷

Pleading that a work was not duly registered, is a mere allegation of a conclusion of law.⁹⁸

An allegation that a song was "written or composed" by a given man is sufficient to satisfy the rule that there must be an allegation that the specific part of a work infringed was original.⁹⁹ It was said that, under the prior Act, no allegation was necessary in the complaint that books in which copyright was claimed, had been printed in the United States, but that if they had not, this was a matter for defense.¹

In a State court decision,² it was deemed necessary in an action by one joint author only against an alleged infringer, to plead that the latter was not a licensee of any of the co-owners of the copyright.

An averment that the plaintiff was the proprietor of a book prior to securing copyright, was held a sufficient allegation that he was the proprietor of an article and engraving therein.³ This seems a very liberal rule to apply in compilation or periodical cases, where the precise reverse, is, actually and notoriously, frequently the fact.

It has been held,⁴ in an action to recover penalties under R. S. 4965, that it was sufficient to plead generally that copies of the photographs were found, in the defendant's possession, within the Court's territorial jurisdiction. It was held unnecessary to

§ 1316
Registration.

§ 1317
Originality.

§ 1318
Domestic
manufacture.

§ 1319
Negating
license by
co-owner.

§ 1320
Pleading pro-
prietorship.

§ 1321
Averments to
recover fixed
damages and
as to juris-
diction.

97—Falk v. Shumacher, 48 F. 222.

98—Collette v. Goode, L. R. 7 Ch. D. 842.

99—Henderson v. Tompkins, 60 F. 758.

1—Osgood v. A. S. Aloe Co., 69 F. 29.

2—Herbert v. Fields, New York Law Journal, May 20th, 1915.

3—Lillard v. Sun Printing & Publishing Association, 87 F. 213.

4—Falk v. Curtis Publishing Co., 100 F. 77.

§ 1322
Deposit or
registration
under present
Act.

§ 1323
Assignees.

§ 1324
Alternative
averments.

§ 1325
Miscellaneous
cases on
pleading.

aver what specific officer or agent of defendant, if a corporation, had them, or that the precise time when found be specified or that it be alleged that infringement continued, at the time suit was instituted.

A bill under the present Act need not allege registration or entry of copyright, as this vests on the mere act of publication.⁵ A decision to the contrary,⁶ apparently failed to note the statutory changes involved. The case last cited is sustainable on the other points decided, however, that is, that the law remains unchanged, that an assignee must plead the facts, showing his right to copyright, and that facts showing that a work is copyrightable must also be pleaded.⁶

It has been held⁷ that an allegation, *in the alternative*, that the plaintiff deposited or mailed copies to the Librarian of Congress was insufficient to tender an issue and rendered the bill of complaint bad.

It has been held⁸ that an allegation that the defendant did not copyright a work, was not the equivalent of pleading he had no copyright in it, since he might have obtained copyright by assignment.

It was unnecessary to plead the names of the employees who made an encyclopedia, in a bill brought by its "author and proprietor," a corporation.⁹

It was held unnecessary to plead affirmatively special facts¹⁰ which might make an exhibition of a

5—National Cloak & Suit Co. v. Kaufman, 189 F. 215.

6—Crown Feature Film Co. v. Levy, 202 F. 805.

7—Falk v. Howell, 34 F. 739. Cf. Scribner v. Henry G. Allen Co., 43 F. 680 (where it was held that where a complaint alleges both a mailing and a filing of the copies required to be mailed or deposited, the plaintiff would neither be required to amend his bill by leaving out one of these allegations nor to elect upon which he would proceed); Brady v. Reliance Motion Picture Co., 232 F. 791.

8—Rigney v. Raphael Tuck & Sons, 77 F. 173.

9—Edward Thompson Co. v. American Law Book Co., 119 F. 218.

10—Werckmeister v. American Lithographic Co., 126 F. 244.

painting not a publication; these could be proven under a general denial of a plea of prior publication.

The Court may, in determining the validity of a copyright, take into consideration, facts affecting its validity which arise subsequent to suit, but prior to decree.¹¹ The normal equity rule in this respect governs such cases.¹¹

Thus, it has been held that a plaintiff might file a supplemental bill¹² alleging, if the facts warranted it, that subsequent to suit there has been further specific infringement of the same general character as that set forth in the original bill, and that, subsequent to suit, there has been a further assignment of copyright to plaintiff, in the nature of a confirmation or ratification of prior assignments under which it claimed title.

It has been held not to be multifarious to join in one complaint, a suit based on copyrights in cartoons and in a play based thereon.¹³ In another case¹⁴ it was held that several causes of action for penalties might be joined in one bill of complaint.

Where the copyrightability of a given production is challenged for want of originality, the Court will rarely, if at all, determine this, on demurrer, by taking judicial knowledge of other prior works.¹⁵

In one reported instance,¹⁶ however, a demurrer to a complaint charging infringement was sustained as to a copyrighted article, where by comparison of the original and alleged infringing works, both of which were filed with the bill, the Court deemed that the original, a description of a prehistoric animal, was evidently a compilation and had only been used to a fair extent. The demurrer was overruled, as

§ 1326
Validity of
copyright at
time of trial
controls.

§ 1327
Supplemental
bill, under
foregoing
rule.

§ 1328
Joinder of
causes of
action.

§ 1329
Demurrer for
want of
originality.

11—Record & Guide Co. v. Bromley, 175 F. 156.

12—Banks Law Publishing Co. v. Lawyers Cooperative Publishing Co., 139 F. 701.

13—Empire Amusement Co. v. Wilton, 134 F. 132.

14—Snow v. Mast, 65 F. 995.

15—Henderson v. Tompkins, 60 F. 758.

16—Lillard v. Sun Printing & Publishing Co., 87 F. 213.

to a picture or cut representing the animal which was part of both articles, even though the Court deemed it probable that it would appear, on final hearing, that this was not original with plaintiff. Where profert of a copyrighted work is made in a bill, it may be treated as part of the bill and examined on demurrer.¹⁷

§ 1330
Evidence as
to originality.

In a leading case,¹⁸ the Supreme Court, after pointing out that there is no provision in the copyright system for examination of works, prior to grant of copyright, as in the case of patents, says:

“It is therefore much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality of intellectual production, of thought and conception on the part of the author should be proved than in the case of a patent right.”

§ 1331
Copyright, as
evidence,
of authorship.

In one case,¹⁹ it was held a copyright was prima facie evidence, that he to whom it was issued was the author of the work involved and that the burden of proof to the contrary was on the defendant. No authority was cited for this ruling and it may well be doubted whether it is law.¹⁸

§ 1332
Proof of
publication
or non-
publication.

It may be necessary for the plaintiff to prove publication of the work to show that he has a valid copyright. Where an assignee sues for infringement of copyright, the burden is on him to prove that his assignor was the author of the work and that neither the assignee, nor the author, published the paintings before copyright.²⁰

On the other hand, defendant may seek to prove prior publication of the contents of a work, to prove that they were not copyrightable by plaintiff.

17—American Mutoscope etc. Co. v. Edison Mfg. Co., 137 F. 263.

18—Burrow-Giles Lithographing Co. v. Sarony, 111 U. S. 53, 59, 28 L. ed. 349, 351.

19—Reed v. Carusi, 1 Taney 73.

20—Bosselman v. Richardson, 174 F. 622.

The burden is on the defendant who claims a work was published, as a defence to infringement, not only to show it was published, but that this was done by authority of the proprietor.²¹ In the latter case, there had been a publication of a French play in Austria by a person to whom the author had sold the Austrian rights of representation, but it was not shown that such person was authorized to do anything, save to perform the play.

§ 1333
Burden of proof as to fact that prior publication authorized by plaintiff.

In an unreported case,²² the United States Circuit Court, in 1869, appears to have held that where it was shown pirated copies of a play were on public sale, this showing would shift the burden on the plaintiff to show they were not being sold with his assent.

Where the defendant seeks to prove prior publication of a work, in uncopyrighted circulars, newspapers or periodicals, etc., a copy thereof should be produced.²³

§ 1334
Proof as to such prior publication.

A defense of prior publication is not made out in a musical copyright case, merely because a subsequent composer has borrowed, in general, from the style of his predecessor, unless there is substantial identity to the ear of the average person.²⁴

The pendency of a suit for penalties, was held to be a bar to one for an injunction.²⁵

§ 1335
Pendency of other action.

Even if an injunction be refused for laches, Equity may retain jurisdiction to award profits, in a case of proved piracy.²⁶

§ 1336
Injunction refused: profits awarded.

In a decision under the prior Act (27), it was held immaterial, in an action for statutory penalties, whether or not the plaintiff had suffered actual damages and, hence, evidence of the effect of the infringement on plaintiff's sales was excluded. A

§ 1337
Evidence of actual damage in action for penalties.

21—*Bouccicault v. Wood*, 2 Biss. 208; *Shook v. Neuendorff*, 11 New York Daily Reg. 985.

22—*Palmer v. McDonough*. See *Drone*, p. 579.

23—See *Da Prato Statuary Co. v. Giuliani*, 189 F. 90.

24—*Hein v. Harris*, 175 F. 875.

25—*Schumacher v. Schwencke*, 25 F. 466.

26—*West Publishing Co. v. Edward Thompson Co.*, 176 F. 839.

§ 1338
Joinder of
parties.

charge in an action for infringement,²⁷ under prior statutes, is reproduced, in extenso, in the opinion.

In an English case,²⁸ it was held that the plaintiff cannot join persons not in privity with one another, as parties defendant, where separate and distinct piracies are involved.

§ 1338a
Interrogatories.

Interrogatories under Equity Rule 58 in copyright causes are discussed in a recent case.^{28a}

§ 1339
Judicial
powers conferred.

Section 26. That any Court given jurisdiction under Section 34 of this Act may proceed in any action, suit, or proceeding instituted for violation of any provision hereof to enter a judgment or decree enforcing the remedies herein provided.

§ 1340
Joinder of
remedies.

Section 27. That the proceedings for an injunction, damages, and profits, and those for the seizure of infringing copies, plates, molds, matrices, and so forth, aforementioned, may be united in one action.

§ 1341
Nature of action contemplated by Act.

These provisions refer to the judicial administration of the remedies for infringement provided by Section 25 of the Act.²⁹ The first section requires no comment. The latter section changes the previous law.³⁰ The Act contemplates one comprehensive action in Equity in a case of infringement. Whether an action at law may be brought to recover anything beyond actual damages may be considered doubtful, as the fixed or arbitrary damages, which are the only other item conceivably recoverable at law, by the express language of the Act, lie in the discretion of the Court and, hence, not of a jury.³¹

27—Springer Lithographing Co. v. Falk, 59 F. 979.

28—Dilly v. Doig, 2 Ves. Jr. 486.

28a—Rodman Chemical Co. v. E. F. Houghton Co., 233 F. 470.

29—See §§ 1227–1310 inclusive.

30—Trow City Directory Co. v. Curtin, 36 F. 829; Taft v. Stephens Lithographic Co., 3 L. R. A. 192, 38 F. 284. Cf. Schumacher v. Schwencke, 25 F. 466.

31—See §§ 1269–1271.

CHAPTER XVIII

CRIMINAL INFRINGEMENT

Section 28. That any person who wilfully and for profit shall infringe any copyright secured by this Act, or who shall knowingly and wilfully aid or abet such infringement, shall be deemed guilty of a misdemeanor, and upon conviction thereof shall be punished by imprisonment for not exceeding one year or by a fine of not less than one hundred dollars nor more than one thousand dollars, or both, in the discretion of the Court: Provided, however, That nothing in this Act shall be so construed as to prevent the performance of religious or secular works, such as oratorios, cantatas, masses, or octavo choruses, by public schools, church choirs, or vocal societies, rented, borrowed, or obtained from some public library, public school, church choir, school choir or vocal society, provided the performance is given for charitable or educational purposes and not for profit.

§ 1342
Criminal
infringement.

§ 1343
Certain per-
formances ren-
dered non-
infringing.

This section deals with two separate and distinct matters. First: It provides for criminal liability, in certain cases of infringement. Second: It legalizes certain otherwise unlawful performances.

The curiously inapt phraseology of the portion of the Section dealing with the latter is striking but its purpose is plain. The classes of dramatico-musical or musical compositions enumerated, if performed by any of the organizations enumerated, after having been obtained from any of the sources specified in the Section, will be no infringement of the copyright therein, if the performance be for educational or charitable purposes and not for personal pecuni-

§ 1344
Non-infring-
ing perform-
ances of
musical works
for charitable
or educational
purposes.

§ 1345
Concerts for
charity.

§ 1346
Reproduction
of copyrighted
matter in
school books.

§ 1347
Nature of
criminal re-
sponsibility
for infringe-
ment.

ary profit. In view of the language employed in this connection, and the unpleasant consequences of infringement, it cannot be safely advised, however, despite the general reference to secular works of the character indicated, that any such secular works may be safely performed, under the permissive provisions of this Section, unless they are purely musical, as distinguished from dramatico-musical or dramatic works, or unless they may be characterized as "cantatas" or "octavo choruses." This portion of the Section is discussed in a recent case³² where the Court said, by way of *dictum*, that it permitted high-class, religious and educational compositions to be performed, at public concerts, where an admission fee was charged, provided the proceeds were devoted to a charitable purpose.

The interest for musical education betokened by this Section emphasizes the omission, from the Act under discussion, of a provision similar to that found in the English Act, legalizing the publication, within carefully prescribed limits, of excerpts of copyrighted matter in school books.³³ It may be, however, that such a use might be deemed a fair one under the law of quotation.³⁴

The remaining portion of the Section deals with criminal liability for infringement. It is properly restricted to wilful infringement, which must also be for profit, for the Section to apply. Innocent infringers, or those who do not derive pecuniary, or other material, benefit from their violation of copyright, while they remain civilly liable for the consequences of their acts, do not come within this Section. It should also be noted that the Section does not apply to the case of infringement of musical copyrights by mechanical reproductions, specified in Section 25 (e).³⁵

32—John Church Co. v. Hilliard Hotel Co., 221 F. 229.

33—British Copyright Act, (1911) § 2, IV.

34—See §§ 1134–1139.

35—See § 1309.

CHAPTER XIX

FALSE NOTICES OF COPYRIGHT

Section 29. That any person who, with fraudulent intent, shall insert or impress any notice of copyright required by this Act, or words of the same purport, in or upon any uncopyrighted article, or with fraudulent intent shall remove or alter the copyright notice upon any article duly copyrighted shall be guilty of a misdemeanor, punishable by a fine of not less than one hundred dollars and not more than one thousand dollars. Any person who shall knowingly issue or sell any article bearing a notice of United States copyright which has not been copyrighted in this country, or who shall knowingly import any article bearing such notice or words of the same purport which has not been copyrighted in this country, shall be liable to a fine of one hundred dollars.

§ 1348
False notices
of copyright.

§ 1349
Removal or
alteration of
copyright
notices.

Section 4963 of the Revised Statutes, as originally enacted,³⁶ provided that any person who should insert, or impress, the notice of copyright prescribed in the Act, or words of the same purport, upon any article for which he had not obtained a copyright shall be liable to a penalty, half to go to the United States, and half to the person suing therefor. This provision was preserved in the amendatory Act of March 3, 1891. The latter Act was passed to overrule various decisions,³⁷ which had construed the pertinent earlier statutory provision. It extended the prohibition of the Section to insertion or impression of false claim of copyright on articles not subject to

§ 1350
History of
legislation
dealing with
false notices
of copyright.

36—Act of June 18, 1874.

37—See footnotes to this section.

copyright, made the knowing issuance, importation or sale of articles bearing false notice of copyright, unlawful, prohibited the importation of such articles and gave the Federal Courts jurisdiction to restrain violations of the Section by injunction, at the suit of any person complaining of such violation of the law.

§ 1351
Changes in
law effected
by present
Act.

It should be noted that the present Act strikes out much of the remedial portion of the latter amendment and changes the prior law radically in other respects. It provides that a fraudulent intent on defendant's part must be shown. It changes the liability it imposes from a civil, to a criminal, responsibility. It strikes out the provision empowering the granting of injunctive relief. It provides a different fine for the person inserting or impressing a false notice, from that to which one renders himself liable, if he issues, sells or imports a work bearing such notice.

§ 1352
False notices
on uncopy-
rightable
matter.

In other respects, this Section restores the law, in large degree, to the condition in which it was prior to the amendment of 1897. Prior to the passage of that amendatory Act, it had been held that the affixing of a false notice of copyright to articles which could not be copyrighted, was not actionable.³⁸

§ 1353
Notices on ad-
vertisements
of works in-
tended for
copyright.

§ 1354
Affixation
through third
persons.

It was held³⁹ that there was a violation of the statute where notice of copyright was attached to an uncopyrighted cut or print which was an imperfect reproduction of an original painting, which it was intended to copyright. The fact that this was printed in a trade paper, as an advertisement of the painting, for trade purposes, and that the defendant did not physically insert or impress such notice, where he caused it to be circulated, thus publishing it, did not alter the situation. But there was no violation of the statute where the painting was copyrighted, although the cut or print of it, to

§ 1355
Prints of
paintings.

38—Rosenbach v. Dre, luss, 2 F. 217.

39—Rigney v. Dutton, 77 F. 173.

which the notice was affixed was not copyrighted separately.

A false notice anywhere in a book violated the statute, its inhibition not being limited to notices on title pages.⁴⁰

If an article was copyrightable, it was held⁴¹ a violation of the statute to affix false notice of copyright, even though the author was not a person who could obtain copyright therein.

In one decision under the prior Act,⁴² it was held that the printing of many copies of a work, bearing false notice of copyright, was a single continuous act, though done on different days and that only one penalty might be recovered, but where such copies, although otherwise identical, were printed in batches, each lot bearing the name of a different firm, for use as advertising matter by it, the printing of each such batch was a separate violation of the law.⁴³

Pleadings in actions for such penalties were construed with great strictness. Thus where a complaint described a print, and showed it to be copyrightable, but alleged it was uncopyrightable, it was held that the latter allegation controlled and the complaint was bad.⁴⁴ Similarly, an allegation that defendant did not copyright the article on which he impressed the notice was held insufficient, as he might have obtained copyright in it by assignment.⁴⁴ The doctrine of these cases appears applicable to prosecutions under the present Act.

Since there is no extraterritorial effect to the statute, the affixing of a false notice of copyright abroad, was held to be no offense⁴⁵ but the importa-

§ 1356
Notices not
on title page.

§ 1357
Notices by
persons not
entitled to
copyright.

§ 1358
Single or sep-
arate viola-
tions of Act.

§ 1359
Cases under
penal provi-
sions of prior
Act.

§ 1360
Foreign affix-
ation of
notice.

40—Rigney v. Raphael Tuck & Sons Co., 77 F. 173.

41—Rigney v. Dutton, 77 F. 176.

42—Taft v. Stephens Lithographic Co., 3 L. R. A. 192, 38 F. 284.
But see Hildesheimer v. W. & F. Faulkner, (1901) 2 Ch. 552.

43—Taft v. Stephens Lithographic & Engraving Co., 39 F. 781.

44—Taft v. Stephens Lithographic Co., 3 L. R. A. 192, 38 F. 284.

45—McLoughlin v. Raphael Tuck Sons & Co., 191 U. S. 267, 48 L. ed. 178.

§ 1361
Importation
of forbidden
works.

§ 1362
Form of no-
tice forbidden.

§ 1363
Action on
case for false
claim of
copyright.

§ 1364
Estoppel from
false notice
to deny pub-
lication.

§ 1365
Intent essen-
tial to viola-
tion of Act.

§ 1366
Removal or al-
teration of
notices.

tion, knowingly of an article bearing such false notice, if the article is of a copyrightable nature, is within the present Act. The false notice, for the Section to apply, must be a notice which would be held a sufficient notice under the Act, if true.⁴⁶

In an English case⁴⁷ it was said that a civil action might enure in favor of a copyright proprietor against one who made a false claim of copyright on the work in question, if this was so phrased as to be a statement of fact and not a mere conclusion of law.

A further possible consequence of affixing a false notice was illustrated by a decision holding that a party who affixes a notice of copyright to a work, estops himself from claiming that the work has not been published, even though the notice be false.⁴⁸

It should be noted that there is no violation of this Section, unless a fraudulent intent in affixing the false notice can be proven, but that on the other hand, where such an intent can be shown, the removal or alteration of the notice is within the prohibition of the Section, equally with the affixing of a false notice. This represents a remedial change in the law.

46—Hoertel v. Raphael Tuck Sons & Co., 94 F. 844.

47—Dicks v. Brooks, L. R. 15 Ch. Div. 22.

48—Larowe-Lorsette v. O'Loughlin, 88 F. 891.

CHAPTER XX

IMPORTATION OF INFRINGING AND OTHER COPIES

Section 30. That the importation into the United States of any article bearing a false notice of copyright when there is no existing copyright thereon in the United States, or of any piratical copies of any work copyrighted in the United States, is prohibited.

§ 1367
Importation of piratical copies or those bearing false notices forbidden.

Section 31. That during the existence of the American copyright in any book the importation into the United States of any piratical copies thereof or of any copies thereof (although authorized by the author or proprietor) which have not been produced in accordance with the manufacturing provisions specified in Section 15 of this Act, or any plates of the same not made from type set within the limits of the United States, or any copies thereof produced by lithographic or photo-engraving process not performed, within the limits of the United States, in accordance with the provisions of Section 15 of this Act shall be, and is hereby, prohibited: Provided, however, That except as regards piratical copies, such prohibition shall not apply

§ 1368
Importation of copies not produced in accordance with manufacturing clauses of Act, forbidden.

§ 1369
Exceptions.

(a) To works in raised characters for the use of the blind;

§ 1370
Works for use of blind.

(b) To a foreign newspaper or magazine, although containing matter copyrighted in the United States printed or reprinted by authority of the copyright proprietor, unless such news-

§ 1371
Foreign periodicals, with authorized reprints.

§ 1372
Certain works
in foreign
tongues.

§ 1373
Authorized
copies, for
individual
use; for
United States,
or educational
purposes.

paper or magazine contains also copyright matter printed or reprinted without such authorization:

c) To the authorized edition of a book in a foreign language or languages of which only a translation into English has been copyrighted in this country;

(d) To any book published abroad with the authorization of the author or copyright proprietor when imported under the circumstances stated in one of the four subdivisions following, that is to say:

First. When imported, not more than one copy at one time, for individual use and not for sale; but such privilege of importation shall not extend to a foreign reprint of a book by an American author copyrighted in the United States;

Second. When imported by the authority or for the use of the United States;

Third. When imported, for use and not for sale, not more than one copy of any such book in any one invoice, in good faith, by or for any society or institution incorporated for educational, literary, philosophical, scientific, or religious purposes or for the encouragement of the fine arts, or for any college, academy, school or seminary of learning, or for any State, school, college, university or free public library in the United States;

Fourth. When such books form parts of libraries or collections purchased en bloc for the use of societies, institutions, or libraries designated in the foregoing paragraph, or form parts of the libraries or personal baggage belonging to persons or families arriving from foreign countries and are not intended for sale: Provided, That copies imported as above may not lawfully be used in any way to violate the rights of the proprietor of the American copyright or annul or limit the copyright protection secured by this Act,

§ 1374
Copies part of
personal ef-
fects of
travellers.

and such an unlawful use shall be deemed an infringement of copyright.

Section 32. That any and all articles prohibited importation by this Act which are brought into the United States from any foreign country (except in the mails) shall be seized and forfeited by like proceedings as those provided by law for the seizure and condemnation of property imported into the United States in violation of the customs revenue laws. Such articles when forfeited shall be destroyed in such manner as the Secretary of the Treasury or the Court, as the case may be, shall direct: Provided, however, That all copies of authorized editions of copyright books imported in the mails or otherwise in violation of the provisions of this Act may be exported and returned to the country of export whenever it is shown to the satisfaction of the Secretary of the Treasury, in a written application, that such importation does not involve wilful negligence or fraud.

§ 1375
Seizure and
disposition of
wrongfully
imported
copies.

Section 33. That the Secretary of the Treasury and the Postmaster General are hereby empowered and required to make and enforce such joint rules and regulations as shall prevent the importation into the United States in the mails of articles prohibited importation by this Act, and may require notice to be given to the Treasury Department or Post Office Department, as the case may be, by copyright proprietors or injured parties, of the actual or contemplated importation of articles prohibited importation by this Act, and which infringe the rights of such copyright proprietors or injured parties.

§ 1376
Joint Customs
and Postal
Rules to be
made to pre-
vent wrongful
importation.

§ 1377
Notice by in-
jured parties.

Of the Sections just cited, Sections 30, 32 and 33 are sections which refer, generally, to all classes of

§ 1378
Discussion of
foregoing
Sections.

copyrighted articles, while Section 31 refers only to books.

It is readily apparent that since copyright statutes, save by treaty, can have no extraterritorial effect, an act which would be an invasion of the copyright if done in the country under whose laws a copyright is obtained, would be no violation of the proprietor's rights if done without such country.⁴⁹ Copies might thus be made of any work not protected by domestic copyright, without infringing foreign copyright. But unless some provision were made to the contrary, a copyright proprietor would be damaged by the introduction of such copies into the country issuing his copyright, as his potential market would diminish with each copy so introduced. This situation has been recognized by appropriate preventative legislation.

§ 1379
Copyright Act
contemplates
both private
and public re-
lief for wrong-
ful importa-
tion.

Control over commerce and the gateways of a country is a governmental function. The necessary machinery for its supervision exists independently of copyright matter, but private activities may supplement its effective administration. While no express right is given copyright proprietors, to prevent the importation of any articles, infringing or otherwise, contravening private legal rights, and suitable provision is made, on the other hand, for governmental prevention of unlawful importation, it would seem that under Section 34 of the Act, appropriate relief may be granted the injured parties to whom reference is made in Section 33.

§ 1380
Copyright con-
fers no exclu-
sive right to
import.

No exclusive right of importation is given the author, for this, if unlimited, in the case of books at least, would contravene the settled governmental policy of requiring printing and binding to be done in the United States.

The importation of all piratical copies of a work is forbidden. "Piratical" is synonymous with "in-

19—See §§ 1071-1074.

fringing," in the law of copyright,⁵⁰ and, in so far as appertains to copies, is defined in the Treasury Department Circular of July 17, 1911, as meaning "the printing, reprinting, publishing, copying, or reproducing, without authority, of the copyright proprietor, of an article legally copyrighted and upon which the copyright is still in force."⁵¹

§ 1381
Meaning of
"piratical
copies" in
Sections.

"Piratical copies" cannot refer to copies piratical because of anything done abroad, as the Act can have no extraterritorial effect. The provision must, then, be deemed to mean copies which would be piratical had they been made within the United States, and to render such copies unlawful, if imported.

Lawful copies of any work, except books, may be imported, without let or hindrance, by the copyright proprietor or otherwise, subject only to general legislation, such as tariff laws, etc., applicable to imports in their character of imports. Lawful copies of books, whether authorized by the copyright proprietor, or not, can only be imported, if they conform to the requirements of the manufacturing clauses of the Act,⁵² save in the exceptional cases specified in Section 31. If imported for a lawful purpose, a copy of a book becomes infringing, if used for an unlawful purpose,⁵³ and the copyright proprietor has the same remedies with respect to it, as in any other case of infringement.

§ 1382
Importation
of lawful
copies.

§ 1383
Use of lawful
copies for un-
lawful pur-
poses.

The rights of the purchaser of books bought abroad and imported, depends on the law of the country into which he imports and not that of the place of sale.⁵⁴

§ 1384
Law of place
of importa-
tion, not pur-
chase, governs.

In a recent English decision,⁵⁵ it was held that even though the importation of mechanical music

§ 1385
Sale of law-
ful imported
copies, ren-

50—See § 1051.

51—Regulation 2.

52—See §§ 829, 845, 851.

53—See *Tuck & Sons v. Priester*, 19 Q. B. D. 629.

54—*Pitt-Pitts v. George & Co.*, (1896) 2 Ch. at 876.

55—*Monckton v. Pathe Freres Pathephone*, (1914) 1 K. B. 395.

dered unlawful by subsequent legislation.

records was lawful, when made, this would not prevent their subsequent sale from being unlawful after the passage of an act reserving the right to make such records to the proprietor of the copyright in the musical composition, placed upon such records.

The result of this decision appears harsh. Since no right was infringed when the records came into England, they were lawful property in the hands of their owner. It seems difficult to see how their status as such could be affected by subsequent legislation, without destroying their essential property characteristics. The United States Act contained a saving clause,⁵⁶ which obviated the possibility of a similar construction of the present Act, with respect to such records, but the same question might arise with respect to a copy purchased abroad and imported, before application for American copyright.

§ 1386
Unlawful importation, no bar to action for infringement.

A violation of Section 31 will not, it seems, necessitate the application of the doctrine that a plaintiff must come into equity with clean hands, so as to deprive a copyright proprietor of equitable relief.⁵⁷

The Treasury Circular, a portion of which has been quoted, and the Joint Treasury and Post Office Regulations, governing the administration of these Sections of the law, are set forth elsewhere.⁵⁸

§ 1387
Retroactive effect of Sections.

The Treasury Department, acting upon the opinion of the Attorney General of the United States,⁵⁹ has construed these Sections to apply to copyrights obtained both before, and subsequent, to the passage of the present Act. This is contrary to earlier Treasury Decisions,⁶⁰ but appears sound.

56—See § 134, Section 1 (e).

57—*Bentley v. Tibbals*, 223 F. 247.

58—See Appendix.

59—Treasury Decisions No. 30316.

60—Treasury Decisions No. 22781.

CHAPTER XXI

JURISDICTION IN COPYRIGHT CAUSES

Section 34. That all actions, suits or proceedings arising under the copyright laws of the United States shall be originally cognizable by the Circuit Courts of the United States, the District Court of any Territory, the Supreme Court of the District of Columbia, the District Courts of Alaska, Hawaii, and Porto Rico, and the Courts of first instance of the Philippine Islands.

§ 1388
Jurisdiction
of United
States Courts.

The cases contemplated by this Section are those where the validity, or violation of copyrights, or other rights under this Statute, are themselves directly involved and not matters where copyrights are merely incidental to the litigation, as for example, actions involving contracts, the subject matter of which is copyrights. In the latter class of actions, the United States Courts would be without jurisdiction, if this were sought to be invoked under this Section, unless some point as to the validity of the copyrights, their scope or infringement, were involved.

§ 1389
Subject mat-
ter of Federal
jurisdiction.

Thus it has been held that the United States Courts have no jurisdiction in a case where the bill alleges that the plaintiff was the author of a song, that the defendant without his knowledge and consent copyrighted it and prays an injunction and a decree compelling the assignment of the copyright to plaintiff.⁶¹ Similarly, where a copyright was held invalid, and the Court's jurisdiction was invoked under this Section, the bill must be dismissed for

§ 1390
Jurisdiction
where com-
plaints deny
validity of
copyrights.

61—Hoyt v. Bates, 81 F. 641.

§ 1391
Jurisdiction
where validity
of copyright,
in doubt.

§ 1392
Action to re-
strain State
Courts.

§ 1393
Exclusive jur-
isdiction, as
to published
works.

§ 1394
Federal juris-
diction in un-
fair competi-
tion cases.

§ 1395
Amendments
to confer jur-
isdiction, for
relief for un-
fair competi-
tion.

want of jurisdiction.⁶² But a suit for infringement is within the jurisdiction of the United States Courts, although it incidentally involves questions as to the validity, interpretation and effect of a contract through which the complainant derives title, and the contract may be properly set out at length, in the complaint, for the purpose of showing such derivation of title.⁶³ Actions in a State Court which involve the title to copyright cannot be restrained in a suit brought for that purpose in the Federal Courts, if there is no charge of infringement.⁶⁴

Where a work has once been published, State Courts have no jurisdiction to render relief either as to statutory or common law copyright claimed in it; but, otherwise, if unfair competition be shown.⁶⁵

The jurisdiction of the Circuit Courts has now been transferred to the United States District Courts and the Act should be read accordingly.

Of recent years, there has been a growing tendency to grant protection, where there is no valid copyright, on principles analogous to the law of unfair competition. Jurisdiction for this purpose, where it exists, must, however, be found outside of the provisions of the Copyright Act, under other provisions of the Judiciary Act,⁶⁶ such as diversity of citizenship, etc. If grounds for jurisdiction exist apart from the subject matter of the action, the Court can, of course, act.

Leave was given the plaintiff to amend his complaint by inserting allegations necessary to give the Court jurisdiction of a cause, as an action for unfair competition, where the Court deemed that the facts necessary to give it jurisdiction in such an

62—Larowe-Lorsette v. O'Loughlin, 88 F. 896.

63—Wooster v. Crane & Co., 147 F. 515.

64—Carl Laemmle Music Co. v. Stern, 209 F. 129.

65—Potter v. McPherson, 21 Hun 559.

66—Corbett v. Purdy, 80 F. 901.

action existed, although not pleaded, and it had held that there was no infringement of copyright.⁶⁷ Jurisdiction will not be assumed under guise of amendment, in every case, however. Leave was refused the plaintiff to amend the complaint, in an action brought under the prior Act, for the seizure of infringing copies and plates, by inserting a claim for penalties, where suit for the latter was barred by the statute of limitations, upon the ground that these claims involved independent causes of action.⁶⁸

§ 1396
Other jurisdictional amendments.

Extraterritorial jurisdiction would also not be assumed. Thus, in England,⁶⁹ it was held that an English Court had no jurisdiction to restrain infringement of a work outside of England, even though it had jurisdiction of the persons involved and no question was made as to the infringement.

§ 1397
Extraterritorial jurisdiction.

Section 35. That civil actions, suits or proceedings arising under this Act may be instituted in the district of which the defendant or his agent is an inhabitant, or in which he may be found.

§ 1398
Districts where suit may be brought.

This Section gives much needed flexibility to the Act. The summary nature of the preliminary relief available,⁷⁰ which is essential, if justice is to be done, in cases of infringement by persons not pecuniarily responsible, has been considered elsewhere.⁷¹ By permitting suits or proceedings to be brought in any district in which any defendant, or his agent, is an inhabitant, or may be found, Congress has manifested its further appreciation of the frequent necessity for quick action in such causes, and remedied a conflict in the decided causes.⁷²

§ 1399
Discussion of section.

§ 1400
Place of suit.

“Found” in this Section would appear to mean,

§ 1401
“Found.”

67—Bureau of National Literature v. Sells, 211 F. 379.

68—Hills & Co. v. Hoover, 211 F. 241.

69—“Morocco Bound” Syndicate v. Harris, (1895) 1 Ch. 534.

70—See § 1289.

71—See § 1293 *et seq.* See also § 1406 *et seq.*

72—Lederer v. Ferris, 149 F. 251; Fraser v. Barrie, 105 F. 787.

found judicially, that is, present, personally or by agent, so that a writ may be served. The Section does not dispense with the necessity for personal service, as it applies only to jurisdiction, not to procedure.

§ 1402
Several defendants.

If there be more than one defendant, it would seem that suit may be instituted in any district, in which any one of the proposed defendants is an inhabitant, or found.

§ 1403
Service on agent, not an infringer.

Service of process on an agent who did not participate in the infringing act of his principal, made in a district other than that in which the infringement occurred, has, however, been held bad.⁷³

73—Wagner v. Wilson, 225 F. 912.

CHAPTER XXII

INJUNCTIONS IN COPYRIGHT CAUSES

Section 36. That any such Court or Judge thereof shall have power, upon bill in equity filed by any party aggrieved, to grant injunctions to prevent and restrain the violation of any right secured by said laws, according to the course and principles of Courts of Equity, on such terms as said Court or Judge may deem reasonable. Any injunction that may be granted restraining and enjoining the doing of anything forbidden by this Act may be served on the parties against whom such injunction may be granted, anywhere in the United States, and shall be operative throughout the United States and be enforceable by proceedings in contempt or otherwise by any other Court or Judge possessing jurisdiction of the defendants.

§ 1404
Injunctions.

§ 1405
Their service,
scope and en-
forcement.

This section, in so far as it confers the power to issue injunctions, is a re-enactment of former R. S., Section 4970. Since the practice with respect to injunctions is, by express enactment, to be in accordance with the course and principles of Courts of Equity, the general principles of the law of Equity govern. These have been applied in a great variety of cases. Thus preliminary, or temporary, injunctions have been refused, where the plaintiff's rights were not clear;⁷⁴ that is, where there was, either, doubt as to the validity of the copyright,⁷⁵ as to the

§ 1406
When prelim-
inary injunc-
tion refused.

74—Savage v. Hoffman, 159 F. 584; Hoffman v. LeTraunik, 209 F. 375; Sheriff v. Coates, 1 Russ. & My. 159; Lowndes v. Duncombe, 2 Coop. Ch. R. 216.

75—Savage v. Hoffman, 159 F. 584; West Publishing Co. v. Edward Thompson Co., 169 F. 833 (modified on other points, 176 F. 839).

title of the alleged copyright proprietor,⁷⁶ or of asserted infringement;⁷⁷ where the alleged piracies were trifling, in comparison with the amount of original matter in a work;⁷⁸ where the probable injury to plaintiff was small, and the loss to defendant would be great,⁷⁹ if an injunction issued; or where the plaintiff did not come into Court with clean hands.⁸⁰

§ 1407
Effect of bare denials or claim of innocent reproduction.

Mere denials of the equities,⁸¹ or a claim of independent innocent duplication,⁸² if not resting in the probabilities, or corroborated by documentary proof,⁸³ will not defeat an application for an injunction.

§ 1408
Injunctions where presumption of general copying.

In cases where the presumption of general copying has arisen, as a result of unexplained mistakes, common to two works,⁸⁴ an injunction will issue embracing the entire infringing work,⁸⁵ with leave to the defendant to prove what is not infringing, if he can, and then obtain a modification accordingly.⁸⁶

§ 1409
Dramatic infringement.

It has been said that temporary injunctions issue more freely in cases involving dramatic copyright than in other causes.⁸⁷

§ 1410
Doubtful cases.

76—Lowndes v. Duncombe, 2 Coop. Ch. R. 216.

77—Photo Drama Motion Picture Co. v. Social Uplift Film Co., 213 F. 374; Howell v. Miller, 91 F. 129.

78—Record & Guide v. Bromley, 175 F. 156.

79—Dun v. Lumberman's Credit Association, 209 U. S. 20, 52 L. ed. 663.

80—T. B. Harms & Francis Day & Hunter v. Stern, 231 F. 744; Heine v. Appleton, 4 Blatch. 125.

81—Chicago Dollar Directory v. Chicago Directory Co., 66 F. 977.

82—Hein v. Harris, 183 F. 107; Chappell & Co. v. Fields, 210 F. 864.

83—Bobbs-Merrill Co. v. Equitable Motion Pictures Corporation, 232 F. 791. See § 1216.

84—See § 1210 *et seq.*

85—Encyclopedia Britannica Co. v. American Newspaper Association, 130 F. 460; *aff'd* 134 F. 831.

86—Williams v. Smythe, 110 F. 961; Park & Pollard v. Kellerstrass, 181 F. 431.

87—Chappell & Co. v. Fields, 210 F. 864.

issue in clear cases^{87a} or where the Court is not in doubt, on the whole, either as to the law or facts.⁸⁸ It should be noted, however, that the modern tendency is to issue temporary injunctions more freely than in earlier times, and that each case, really, at bottom, rests upon its own peculiar facts.

Thus, in one case, where infringement was conceded, the Court, in refusing a preliminary injunction, was influenced by the facts that the defendant was financially responsible, that the copyrighted work had been intended for gratuitous distribution, as an advertisement,⁸⁹ that, hence, no probable substantial damage to the work was shown, that the infringement was innocent⁹⁰ and that third persons, advertisers in defendant's publication, would have been affected by the injunction.⁹¹ Reference is made to this decision solely to show how far combinations of circumstances may affect a decision, none of which, standing alone, could justify the result.

Thus, it would appear, the ephemeral nature of the work would be a reason for granting,⁹² rather than for refusing an injunction, and that the inability to show substantial damage, or profits, should also (in the absence of a case calling for the application of the doctrine of *de minimis*) lead to the award of injunctive relief.⁹³

In another instance⁹⁴ the plaintiff had entered into a contract with an authoress by which she bound herself to furnish the manuscript of a proposed work and not to cause anything to be published

§ 1411
Combination of facts leading to denial of preliminary injunction.

§ 1412
Ephemeral works.

§ 1413
Inability to show substantial damage.

§ 1414
Breach of agreement as defense to preliminary injunction.

87a—See p. 513, note 74.

88—Benton v. Van Dyke, 170 F. 203; Nicol v. Stockdale, 3 Swan. 688; Littleton v. Fisher, 137 F. 684.

89—But see Farmer v. Elstner, 33 F. 494.

90—But see Chappell & Co. v. Fields, 210 F. 864.

91—Hansen v. Jacquard Jewelry Co., 32 F. 202.

92—Hildesheimer v. Dunn, 64 L. T. N. S. 452.

93—Farmer v. Elstner, 33 F. 494; Encyclopedia Britannica Co. v. American Newspaper Association, 130 F. 460; aff'd 134 F. 831.

94—Worthington v. Batty, 40 F. 479.

which might injure, or interfere with the sale of the work. He bound himself to publish this on a royalty basis and to use his best exertions and efforts to secure its speedy sale, etc. After he had ceased his efforts to push the work, and its sales had nearly or entirely, ended, the defendant published a copy, emanating from her, in a newspaper. On these facts, the Court, in its discretion, refused a preliminary injunction.

§ 1415
Injunction re-
fused where
no likelihood
of passing off
and amount
of copying un-
substantial.

Where some infringement was shown, but the later book was not a copy of the earlier one, no great amount of original matter was copied, just how much was copied was in doubt, the parties appeared responsible, there was no proof that the later work was likely to supersede the former, nor that anyone would be misled into buying the later work, believing it to be the other work, a preliminary injunction was refused.⁹⁵

§ 1416
Obsolete or
unsaleable
works.

Where a work from its nature becomes obsolete,⁹⁶ or unsalable,⁹⁷ during the suit, it was held no injunction would issue.

§ 1417
Innocent
infringement.

While innocence in infringement is no defense to an action,⁹⁸ it may be considered, it seems, on the question whether a preliminary injunction should issue.⁹⁹

Mere denials of knowledge that the work copied was copyrighted are, however, of course, no bar to an injunction.¹

§ 1418
Trifling in-
fringement.

That while ordinarily the doctrine of *de minimis* may be applied,² this is a circumstance affecting

95—White v. Bender, 185 F. 921.

96—Hartford Printing Co. v. Hartford Directory & Publishing Co., 146 F. 332.

97—West Publishing Co. v. Edward Thompson Pub. Co., 169 F. 833.

98—See § 1047.

99—Lawrence v. Dana, 4 Cliff. 1.

1—Chappell & Co. v. Fields, 210 F. 864.

2—Webb v. Powers, 2 Wood & M. 497; Baily v. Taylor, 1 Russ. & My. 73.

judicial discretion and not necessarily controlling, was shown in an English case,³ where an injunction was granted against infringement where only one piratical copy had been sold and there was no evidence of the existence of any other.

§ 1419
Sale of
single copy.

In various cases where infringement was proven, preliminary injunctive relief was refused, where monetary damages appeared adequate. Thus in a case where piracy was established, it was held that in view of the fact that the defendant was not attempting, in any way, to pass off his publication as the plaintiff's and this, a mercantile directory with credit standings and ratings, was of the class of works which rely for acceptance upon the reputation of their compilers and publishers, an injunction would only issue if the defendant did not file a bond to pay to the plaintiff all moneys, other than costs, ultimately decreed to him in the final judgment.⁴

§ 1420
Injunction
refused in
certain cases,
where mone-
tary damages
adequate and
bond filed.

In another directory case,⁵ in spite of a strong showing made on behalf of the plaintiff, and that defendant failed to furnish the testimony of the canvassers whose work was attacked or the lists they made, it was held, nevertheless, that since awarding a preliminary injunction would, in effect, have determined the action and worked irreparable injury to the defendant, such injunction would be refused, on condition that a bond be filed, as well as monthly sworn statements of sale, giving names and addresses of purchasers.

§ 1421
Bond and
sworn state-
ments re-
quired to pre-
vent injunc-
tion.

The Court may also make the denial of a motion for a preliminary injunction, contingent in a proper case, upon the giving of a bond for plaintiff's protection, if successful on final hearing, where it

§ 1422
Bond re-
quired, where
plaintiff's
rights doubt-
ful.

3—Butterworth v. Kelly, 4 T. L. R. 430.

4—Ladd v. Oxnard, 75 F. 703.

5—Trow Directory Printing etc. Co. v. Boyd, 97 F. 586.

refuses the injunction because it is doubtful, on the evidence before it, as to plaintiff's rights.⁶

§ 1423
Consent to preference required, to prevent injunction.

In some cases the Court may even go further. Thus where the work alleged to infringe was of an ephemeral nature, appealed to the taste of a public other than that to which the copyrighted work was addressed, and the defendant was, apparently, financially, responsible, an injunction *pendente lite*, was suspended on defendant's giving an appropriate bond, filing statements of sales, and assenting to a preference of the cause for early trial.⁷

§ 1424
Delay in applying for injunction.

Mere delay in bringing suit, if less than the statute of limitations, will not bar injunctive relief,⁸ where there is no proof of acquiescence, nor will failure to object to infringement do so, where there was no inducement to infringe, nor variation of liability by reason of plaintiff's acts.⁹ Where, however, defendant can be said to have changed his position, in apparent reliance on inaction by the copyright proprietor, and the latter has, or should have had,¹⁰ knowledge of the infringement, unexplained¹¹ delay in applying for injunctive relief, will lead to its denial.¹² Delay in the assertion of rights, coupled with probable damage to defendant, entirely out of proportion to any possible damage to plaintiff was deemed a ground for permitting defendant, in a case where, to a small extent, at least, similarity of language almost conclusively showed copying, to fill its contracts for the supply of its work, future sales being restrained and defendant required to give a

§ 1425
Laches.

6—Louis DeJonge & Co. v. Breuker & Kessler Co., 147 F. 763.

7—Boosey v. Empire Music Co., 224 F. 646.

8—Mawman v. Tegg, 2 Russ. 385.

9—Gilmore v. Anderson, 38 F. 846.

10—Lewis v. Chapman, 3 Beav. 133.

11—Buxton v. James, 5 De G. M. & G. 876; Mawman v. Tegg, 2 Russ. 385.

12—Baily v. Taylor, 1 Russ. & My. 73.

bond to keep account of prior sales, and to pay damages as finally awarded to plaintiff.¹³

Delay with knowledge that the defendant was altering his position and incurring heavy expenses in preparing for an operatic production, where defendant claimed a verbal license, and plaintiff admitted the pendency of negotiations for one, was deemed sufficient reason for refusing a preliminary injunction.¹⁴

Infringement furnishes the ground for injunctive relief. That it has ceased, may take away the necessity for, but not the right to it.¹⁵ The good resolutions of defendant may be confirmed by writ or judgment. Thus where copyright has been infringed, a promise not to do it again, is no bar to an injunction.¹⁶

A temporary injunction may issue although a copyright is soon to expire.¹⁷ It seems a preliminary injunction may even be made permanent after the expiration of a copyright,¹⁸ but such injunction, if granted should be so limited in terms, as not to foreclose the defendant from the exercise of any rights available to the public generally, after the expiration of the copyright.¹⁹

The doctrine of these decisions, is especially applicable where future wrongs may be prevented by injunction.²⁰

A copyright proprietor may preclude himself by his prior conduct, from applying for an injunction.

§ 1426
Injunction,
after infringe-
ment has
ceased.

§ 1427
Injunctions
near, or after
expiration of
copyright.

§ 1428
Estoppel.

13—*Encyclopedia Britannica Co. v. American Newspaper Association*, 130 F. 460.

14—*G. Riccordi & Co. v. Hammerstein*, 150 F. 450.

15—*West Publishing Co. v. Lawyers Cooperative Pub. Co.*, 53 F. 265.

16—*Savory v. The World of Golf*, (1914) L. R. 2 Ch. 566.

17—*Sheriff v. Coates*, 1 Russ. & My. 159.

18—*West Publishing Co. v. Edward Thompson Pub. Co.*, 169 F. 833 (semble).

19—*Dickens v. Lee*, 8 Jur. 183 (semble).

20—*West Publishing Co. v. Edward Thompson Pub. Co.*, 169 F. 833 (semble).

§ 1429
Limit of
doctrine.

Thus, permitting various other third persons to infringe,²¹ leaving a work for many years, without inquiry, in the hands of third persons, not in contractual privity with the owner,²² or proof of facts creating an estoppel,²³ will prevent an injunction. Such conduct, however, may only deal with specific works, and furnish no basis for permissive general infringement. Thus a magazine proprietor who has permitted copying of stories out of it, for a period of years, may end this, for the future, at any time he sees fit.²⁴

§ 1430
Threatened or
anticipated
infringement.

An injunction will not, it was held,²⁵ issue to stop a projected work, tho advertised, before actual printing and publication, but anticipated infringement may, in a proper case, be restrained.^{25a}

§ 1431
Attempted
vindication
of legal rights
at equity.

Some ground for the interposition of Equity must be shown in all cases. This follows from the language of the Section under discussion. In one case,²⁶ the plaintiff claimed that, by fraud and wrong, she had been deprived of the plates for publishing a manuscript and that this had been wrongfully published by defendants. She did not seek an injunction or claim any privity or contract between defendants and herself. It was held her only rights were at law and that she could not obtain an accounting. This decision would not appear, necessarily, to apply to cases of statutory copyright, but should be noted for its general bearing on the subject.

On a motion for a preliminary injunction, all dis-

21—Platt v. Button, 19 Ves. 437.

22—Southey v. Sherwood, 2 Merriv. 435 (The libellous nature of the work, Southey's "Wat Tyler," influenced the decision).

23—Rundell v. Murray, Jacob. 311.

24—Maxwell v. Somerton, 30 L. T. N. S. 11.

25—Brooke v. Chitty, 2 Coop. Ch. R. 216.

25a—Historical Publishing Co. v. Jones Bus, etc., Co., 231 F. 638.

26—Monk v. Harper, 3 Edw. Ch. 109.

puted, or doubtful, questions of fact must be resolved against the plaintiff.²⁷

A demurrable complaint will prevent a preliminary injunction.²⁸ The only allegations essential to confer jurisdiction upon the Court, in a bill seeking an injunction are, however, appropriate allegations showing that the plaintiff is the proprietor of a copyright and that it has been infringed by the defendant.^{28a}

The proof requisite to obtain a preliminary injunction where the copyrighted work is one dealing with common materials, was discussed in an English case.²⁹ It was there said the plaintiff's affidavits must satisfactorily show that the defendant's work was not produced by his own labor, employed on material and aided by information, common to him and to plaintiff but was, instead, actually copied, with perhaps colorable and evasive alterations, from plaintiff's work. To obtain a preliminary injunction, proof must be adduced that the work copied was a true copy of the copyrighted work.³⁰

Under an earlier statute, it was held that while, on application for a preliminary injunction, it was essential for plaintiff to plead and prove that all copies of the copyrighted work issued by him bore the statutory notice, when they left his hands, separate, distinct and specific proof as to each copy was not requisite for purposes of a prima facie case but that a general allegation, and general proof, were sufficient for the purposes of such prima facie case.³¹ This decision would probably be followed under the present Act, subject to the right of a

§ 1432
Disputed or
doubtful
facts.

§ 1433
Essentials of
bill of com-
plaint for
injunction.

§ 1434
Essentials of
affidavits to
procure tem-
porary in-
junction.

§ 1435
Proof as to
notice of
copyright.

27—Photo-Drama Motion Picture Co. v. Social Uplift Feature Film Co., 213 F. 374.

28—Ladd v. Oxnard, 75 F. 703.

28a—Photo-Drama Motion Picture Co. v. Social Uplift Feature Film Co., 213 F. 374.

29—Nichols v. Loder, 2 Coop. Ch. R. 217.

30—Humphreys Homeopathic Medicine Co. v. Armstrong, 30 F. 66.

31—Falk v. Gast Lithographing & Engraving Co., 40 F. 168.

plaintiff relying on the provisions of Section 20 of the Act, with respect to accidental or inadvertent omissions of notice, to frame his pleading and proof accordingly.

§ 1436
Proof of damage unessential to final injunction.

Final injunctions will issue even if there is no proof of damage,³² as this presumed,³³ or even if there was no substantial damage³⁴ to the plaintiff, it seems, if infringement be established.

§ 1437
Infringing matter expungable, or separable.

Where the Court apparently deemed infringing matter in a work might be expunged, it issued a special injunction restraining the sale of matter so found to be infringing and not a general injunction.³⁵

So where copyrighted matter was intermingled with uncopyrighted matter, an injunction issued on infringement should, it was held, only refer to the copyrighted matter,³⁶ but this is only true where the two are patently, and easily, separable.³⁷

§ 1438
Interlocutory decree for injunction and accounting.

A decree awarding a final injunction and ordering an account, was held interlocutory, and hence not *res adjudicata* between the parties.³⁸

§ 1439
Applications in aid of injunction.

While application may be made in aid of an injunction, to any court which would, under Section 34, have original jurisdiction at the time of application, if suit were desired to be brought in it rather than in the Court issuing the injunction, yet, proceedings to dissolve or modify the injunction, appear limited to the Court issuing it.

§ 1440
Dissolution or modification.

The question as to who is a person aggrieved, within the meaning of this Section, and hence entitled to injunctive relief, will now be considered.

§ 1441
Persons entitled to injunction.

§ 1442
Equitable proprietors.

32—Reed v. Holliday, 19 F. 325.

33—See §§ 1057, 1063.

34—Black v. Henry G. Allen Co., 56 F. 764.

35—Sampson & Murdock Co. v. Seaver Radford Co., 134 F. 890; (rev'd upon another point, 140 F. 539).

36—Da Prato Statuary Co. v. Giuliani, 189 F. 90.

37—See § 1215.

38—Hills & Co. v. Hoover, 142 F. 904.

a copyright was permitted to sue for injunctive relief, in his own name.³⁹ This was independently of any special statutory language.

It has been held the holder of the equitable title in a copyright may sue in his own name, for infringement, where the holder of the legal title is one of the infringers and hostile to him.⁴⁰ In another case,⁴¹ it was held that the holder of the legal title in a copyright could sue, although the beneficial ownership, or equitable title in it, were in another.

Both the legal and equitable owners may join as co-plaintiffs.⁴²

There are very few cases in the reports which deal with the question as to who can sue under the statute.

The term "person aggrieved" was used in the 5 & 6 Vict. c. 45 S. 14 and various English cases have construed it.⁴³

It seems a "person aggrieved," within the English statute to which reference was just made, was one who showed that an act of which he complained was inconsistent with some right he set up in himself, or some other person, or that such act really interfered with some intended action on his part⁴⁴ and that his complaint was substantial.⁴⁵

In an interesting matter,⁴⁶ decided in the District Court for the Western District of New York, it was held that the maker of music rolls which served mechanically to reproduce copyrighted music was a "person aggrieved," who could sue under this Section, where the music rolls were copied by a third

§ 1443
Joinder of
legal and
equitable
proprietor.

§ 1444
"Persons
aggrieved"
by infringe-
ment.

§ 1445
"Person
aggrieved"
under English
statutes.

§ 1446
Maker of
music rolls,
not proprietor
or assignee of
copyright—a
person
aggrieved.

39—Mawman v. Tegg, 2 Russ. 385.

40—Wooster v. Crane & Co., 147 F. 515.

41—Hansen v. Jacquard Jewelry Co., 32 F. 202.

42—Black v. Henry G. Allen Co., 9 L. R. A. 433, 42 F. 618.

43—See Chappell v. Purday, 14 M. & W. 303; Ex parte Hutchins & Romer, 4 Q. B. D. 483; Ex parte Davidson, 18 C. B. at 311.

44—Grave's Case, L. R. 4 Q. B. 715, 724.

45—Same, at p. 721.

46—Æolian Co. v. Royal Music Roll Co., 196 F. 926.

person, although the plaintiff was neither the owner of the copyright nor, as far as appeared, even a licensee. The decision appears erroneous. This Section does not create causes of action, or even remedies, but merely machinery for enabling remedies, elsewhere conferred, to be enforced. While there was clearly infringement in the case under discussion, and while the plaintiff had been injured, it may be questioned whether any legal right, vested in the plaintiff, under the copyright laws, had been invaded, and unless it had, it would seem he had no cause of action under the Act. It may be the plaintiff was a licensee, either contractual, or by operation of law, and hence had a cause of action, but non-exclusive licensees cannot sue in all cases.⁴⁷

§ 1447
Licensees.

§ 1448
Rights of non-exclusive licensee to sue for fixed damages and injunction distinguished.

§ 1449
Limitation on rights conferred on persons merely because aggrieved.

§ 1450
Right of licensee to accounting of profits.

It would seem quite clear that a non-exclusive licensee could not sue for arbitrary damages, on infringement, unless the copyright proprietor were a co-plaintiff, even though the licensee had an exclusive territorial license.^{47a} This is for the reason that such damages would be general and enure, primarily, to the copyright proprietor. It does not follow, however, that a licensee cannot sue for an injunction without joining the licensor.

It should be carefully noted that this Section which refers to "aggrieved parties," only deals with injunctions and that this phrase with its broad indefiniteness, does not, accordingly, refer to actions, or remedies, other than for, or by way of, injunction.

Whether profits can be recovered by a licensee, would seem to depend upon the nature and terms of the license. If exclusive and perpetual, it would seem as if all the profits earned would naturally go to such licensee. If non-exclusive, it would seem that this cannot be deemed to be true, as, even if partially exclusive and partially non-exclusive, as, for example, on a limited territorial basis, it is impos-

47—Tully v. Triangle Film Corporation, 229 F. 297.

47a—New Fiction Publishing Co. v. Star Co., 220 F. 994.

sible, accurately, to estimate the damage which infringement in a given territory may cause in other territory. Similarly, if the license is not perpetual, present infringement, theoretically at least, may diminish the value of a copyright, in the future, beyond the period of license. Such considerations indicate the justice of requiring that a licensor be joined as a party to the suit, so that neither the licensee's, licensor's or defendant's rights be neglected but that these be all measured and determined in one suit.

§ 1451
Parties to
action by
licensee.

The proprietor of a copyright and his territorial lessee may join, as parties plaintiff, in suing an alleged infringer.⁴⁸

§ 1452
Joinder of
parties plain-
tiff in such
cases.

In an action involving Charles Lamb's theretofore unpublished letters, it was held where both licensor and licensee were parties plaintiff, if either might sue, this would support a judgment against the defendant.⁴⁹

§ 1453
Effect of join-
der of licensor
and licensee.

In an English case,⁵⁰ it was held that one who has given exclusive territorial rights in a play, on a royalty basis, cannot sue in connection with infringement in that territory, without joining the territorial proprietor as a party. An exclusive territorial licensee of common law rights, in an unpublished opera, was held the proper party to sue for infringement, in his territory.⁵¹

§ 1454
Exclusive li-
censes: action
by licensor
or by licensee.

Where registration was erroneously made in the name of a mere agent, as distinguished from a trustee of the copyright, for the benefit of the owner, it was held, this was a fatal bar to an action, which was not obviated by the real party in interest joining in the action as a party plaintiff.⁵²

§ 1455
Erroneous
registration
incurable by
joinder real
proprietor,
as co-plaintiff.

The proprietor of a copyright in an article, published under license by third persons, need not

§ 1456
Action by pro-
prietor whose
licensee had

48—Gaumont Co. v. Hatch, 208 F. 378.

49—McMillan v. Dent, (1907) 1 Ch. 107.

50—Tree v. Bowket, 74 L. T. 77.

51—Aronson v. Fleckenstein, 28 F. 76.

52—Petty v. Taylor, (1896) 1 Ch. 465.

published
work.

§ 1457
Action by
“assignees”
of copyright
who had cov-
enanted not
to multiply
copies.

§ 1458
Form of
injunction.

§ 1458a
Cross-
injunctions.

§ 1459
Transmission
of certified
copy of in-
junction pa-
pers.

publish it himself, to obtain standing to enjoin an infringer.⁵³

In a decision⁵⁴ rendered by the High Court of Justice, Chancery Division, it appeared the owners of copyright in a painting assigned the British copyright to the plaintiffs, on the plaintiffs' agreement that they would not reproduce the pictures without the assignors' consent. The Court held the assignees could not sue an infringer, without joining the assignors as parties, as plaintiffs' rights,—copyright without the right to reproduce,—were too limited, even though called copyright, to be deemed copyright at all.

As to the form of an injunction, broad language may be inserted in the writ or order where the copyrightability of a work is established but its precise character is doubtful. Thus in an English case,⁵⁵ the Court was doubtful whether a work was a book or picture, it having been copyrighted as both. It was, however, clear that an injunction should issue and it, accordingly, simply described this article as a “work” in its writ.

Cross-injunctions may issue as where defendant is infringing and plaintiff violating its implied agreement not to diminish the value of a license granted defendant.^{55a}

Section 37. That the clerk of the Court, or judge granting the injunction, shall, when required so to do by the Court hearing the application to enforce said injunction, transmit without delay to said Court, a certified copy of all the papers in said cause that are on file in his office.

53—Johnson v. George Newnes Ltd., (1894) 3 Ch. 663.

54—Landeker & Brown v. Louis Wolff & Co., 52 Solic. Jour. 45.

55—Hildesheimer v. Dunn, 64 L. T. N. S. 452.

55a—Harper Brothers v. Klaw, 232 F. 609.

CHAPTER XXIII

APPEALS

Section 38. That the orders, judgments, or decrees of any Court mentioned in Section 34 of this Act arising under the copyright laws of the United States may be reviewed on appeal or writ of error in the manner and to the extent now provided by law for the review of cases determined in said Courts, respectively.

§ 1460
Appeals in
copyright
causes.

The first of these Sections requires no comment. The second approximates the question of copyright appeals to appeals generally in the Federal Courts. Any extended discussion of this subject would be without the scope of this work, and the practitioner interested, is referred to the standard works on Federal Practice.

CHAPTER XXIV

LIMITATION OF ACTIONS

§ 1461
Criminal
statute of
limitations.

Section 39. That no criminal proceeding shall be maintained under the provisions of this Act unless the same is commenced within three years after the cause of action arose.

§ 1462
Limitations of
time to sue
in civil causes.

There is no limitation prescribed as to the time within which civil suits under the statute must be brought, so it would seem the statutes of limitations of the particular state where a cause of action under the Act arose would apply.⁵⁶

§ 1463
Effect of ex-
piration of
copyright on
pending liti-
gation.

If, prior to final judgment, a copyright expires, it would seem that the only effect of such expiration upon a pending action would be to prevent the award of injunctive relief which would forbid the defendants from making such future use of the work, after it fell into the public domain, as anyone else was free to make. Except to this extent, the expiration of the copyright would, it seems, not affect pending litigation.

§ 1464
Proposed and
prior legisla-
tion as to
limitations.

The original drafts of the bill provided that all actions under the Act were to be brought within three years after accrual and R. S. 4968 provided for a two year limitation in cases of forfeitures and penalties. The latter Section is not applicable to the present Act.

56—McLaine v. Rankin, 197 U. S. 154, 49 L. ed. 702.

CHAPTER XXV

COSTS AND ATTORNEY'S FEES

Section 40. That in all actions, suits, or proceedings under this Act, except when brought by or against the United States or any officer thereof, full costs shall be allowed, and the Court may award to the prevailing party a reasonable attorney's fee as part of the costs.

§ 1465
Costs and
counsel fees.

The first portion of this Section changes the prior law which made full costs mandatory only in actions at law.⁵⁷ Under the present Act, full costs are to be allowed to the successful party, whether the action is at law, or in equity, and whether monetary damages are recovered or not. This view is emphasized by a comparison of early drafts of this Section,⁵⁸ which were intended to limit it to actions where there was a monetary recovery, with the Section as enacted.

§ 1466
Prior law.

§ 1467
Full costs to
successful
party.

This absolute requirement has, however, in some cases, been overlooked, or ignored, by the Courts.⁵⁹ The plaintiff in one action⁶⁰ had brought suit in connection with two separate and independent musical compositions. He succeeded with respect to one: was defeated with reference to the other. Each party was allowed half costs. This decision, if sound, apparently distinguishes between successful, and partly successful, parties.

§ 1468
Decisions un-
der present
Act refusing,
or cutting
down, costs.

57—See Act July 8, 1870, § 108; R. S. Title 13, Ch. 18, § 972; *Record & Guide Co. v. Bromley*, 175 F. 156.

58—See Copyright Office Bulletin No. 12, p. 56.

59—*Vernon v. Shubert*, 220 F. 694.

60—*M. Witmark & Sons v. Standard Music Roll Co.*, 221 F. 376.

§ 1469
Counsel fee
discretionary.

Counsel fee, on the other hand, is only to be awarded, if the court deem fit.

In discussing this Section, Hough, J., said:⁶¹

§ 1470
Fee to be com-
pensatory.

“The counsel fee provided for in the copyright Act is merely a revival of old practice. I am not informed that it is known what reasons induced Congress to revive old practice in respect to copyrights only. Having therefore nothing but the text of the law to guide me, I do not regard the congressional provision as punitive and assume that the intent of Congress was merely to compensate counsel for professional labors. Consequently, I inquire not only into the extent of professional labor known to the court, but the importance of the litigation both as to the principle involved and the pecuniary magnitude of the case. In my judgment the professional labor in this matter was out of all proportion to the principle or the amount of money involved.”

§ 1471
Rules for de-
termining
amount.

§ 1472
Discussion of
probable rea-
sons for per-
mitting award
of such fees.

It would seem that the last remark by the Court indicates quite clearly the underlying reason that undoubtedly influenced Congress in the enactment of the provision under discussion. The amount of money frequently involved in copyright litigation, especially on the part of the defendant, is trifling. The expense of any litigation is considerable. Unless, therefore, some provision is made for financial protection to a litigant, if successful, it may not pay a party to defend rights, even if valid, a situation opposed to justice. The Act is designed to furnish summary and drastic relief to those whose rights have been invaded, but not to afford means of oppression, based upon extraneous financial considerations. It is increasingly recognized that the person who forces another to engage counsel either

61—Universal Feature Film Co. v. Copperman, 218 F. 580.

to vindicate, or defend, a right should bear the expense of such engagement and not his successful opponent. To mulct the successful party for asserting his legal rights, by judicial action, is an anomalous condition wherever it exists. It would seem, then, that counsel fees should be granted in all such cases, except where the result would work a palpable injustice.⁶²

In the Copperman case, the lower Court allowed counsel \$250. An application for an increased fee was made to the Circuit Court of Appeals, after affirmance, but denied, without opinion. Whether the Appellate Court deemed the application should have been made to the lower Court, or that the Circuit Court of Appeals was without power to grant the application, does not appear. That Court had previously expressed its satisfaction⁶³ with the lower Court's ruling on counsel fee, which was designed by the lower Court to be compensatory of the work actually done. Subsequently counsel in the litigation was compelled to oppose an application, in the Supreme Court, for a writ of certiorari. No further application for counsel fee was made, so that the total counsel fee allowed was \$250. As this amount was necessarily intended by the lower Court to compensate counsel only for the work actually done to the date of its award, it would seem that further counsel fees should have been allowed, in conformity with the reasons advanced by the lower Court, in fixing the amount granted by it. It may be suggested that if a provision be inserted in the final judgment, giving the successful party the right to apply for further counsel fee, at the foot of the decree, if successful on appeal, that proceedings taken pursuant to such permission, might be conducive of a more equitable result.

§ 1473
Counsel fees
on appeal.

62—Cf. *Hene v. Samstag*, 198 F. 359, where counsel fee was refused as "unfair" in the light of the record.

63—*Universal Feature Film Co. v. Copperman*, 218 F. 578.

§ 1474
Counsel fees
on dismissal
without trial.

§ 1475
Instances
where plain-
tiff was
allowed coun-
sel fee.

Counsel fees have, since the rendition of the opinion cited, been allowed on dismissal of a bill of complaint without trial, in the Second Circuit, in at least two unreported causes.

Where the defendant put plaintiff's right to recover in issue in its answer, but conceded the right to some recovery on the trial, a counsel fee of \$75 was allowed, although defendant successfully defeated contentions of plaintiff which, if sustained, would have increased the amount of recovery⁶⁴ and in a recent case \$150 was allowed, because defendant contested the action.⁶⁵

64—*Strauss v. Penn Printing & Publishing Co.*, 220 F. 977.

65—*F. A. Mills v. Standard Music Roll Co.*, 223 F. 849.

CHAPTER XXVI

PROPERTY IN PHYSICAL OBJECT COPY- RIGHTED AND LAWFUL COPIES

Section 41. That the copyright is distinct from the property in the material object copyrighted, and the sale or conveyance, by gift or otherwise, of the material object shall not of itself constitute a transfer of the copyright, nor shall the assignment of the copyright constitute a transfer of the title to the material object; but nothing in this Act shall be deemed to forbid, prevent, or restrict the transfer of any copy of a copyrighted work the possession of which has been lawfully obtained.

This Section of the Act is, in great part, declaratory of prior law. As has been shown elsewhere, what we call copyright, exists in the group of intellectual concepts which constitute a given work. It is not limited to physical reproductions of the work, whether these be copies, or the actual, or theoretical, original from which the copies are made. It is an intangible property right. The property in the copies, however, is in their tangible being. The rights in the first are measured by the statute. The rights in the latter are created by force of general rules of law affecting personal property in chattels. The two forms of right are distinct. The two classes of property are individual and not, necessarily, dependent or interconnected. This has been recognized from the period of the early beginnings of copyright.

Thus in a leading case ⁶⁶ it was held that the sale,

§ 1476
The title to, and transfer of, material objects copyrighted and such copyrights.

§ 1477
The transfer of lawfully acquired copies.

§ 1478
Declaratory nature of Section.

§ 1479
The distinction between property in the object copyrighted and such copyright.

66—Stephens v. Cady, 14 How. 529, 14 L. ed. 528.

§ 1480
Rights acquired by purchase of copper plates on execution.

§ 1481
Rights on purchase of manuscript.

§ 1482
Reduction of copyrights to satisfaction of proprietor's debts.

§ 1483
Title to instrumentality for making copies.

§ 1484
Separate sales of painting and right to copyright it.

on execution, of a copper plate for printing a copyrighted map, conferred no right upon the purchaser to use it to print such maps, without the copyright proprietor's consent. The Court, incidentally, said that even the transfer of the manuscript of a book would not, at common law, carry with it a right to print and publish the work, without the express consent of the author, as the property in the manuscript, and the right to multiply the copies, were two separate and distinct interests.

The opinion contains a *dictum* to the effect that while copyrights cannot be seized on execution, they may be reached by a creditor's bill in equity. This is undoubtedly the law,⁶⁷ and, by analogy from patent cases,⁶⁸ it would seem reasonably clear that under statutes such as those, in New York, regulating proceedings supplementary to execution, a copyright proprietor may be compelled to assign his rights to a receiver of his property, by appropriate proceedings under such statutes.

The question decided in *Stephens v. Cady*,⁶⁹ was re-examined, and re-affirmed, in a later decision.⁷⁰ In that case, the Court also said it was lawful for anyone to make, own, or sell the copper plate. The doctrine of these decisions has been re-affirmed⁷¹ and has never been questioned.

In a more recent decision, the Supreme Court held,⁷² that an artist could assign the right to obtain a statutory copyright to one person, while selling the painting so to be copyrighted, to another. A writing stating that, for a given consideration, the author, an Englishman, "hereby transfers the copyright in my picture" (describing it), was there held to be a

67—*Cr. Ager v. Murray*, 105 U. S. 126, 26 L. ed. 942.

68—*Barnes v. Miner*, 3 Hun 703.

69—14 How. 529, 14 L. ed. 528.

70—*Stephens v. Gladding*, 17 How. 447, 15 L. ed. 155.

71—*Patterson v. J. S. Ogilvie Publishing Co.*, 119 F. 451.

72—*American Tobacco Co. v. Werckmeister*, 207 U. S. 384, 52 L. ed. 257.

complete transfer of the intangible property rights in connection with the picture, although the physical work itself was sold to a third person.

The effect of this Section of the Act, when interpreted in the light of the decisions cited, is, then, to crystallize the rule, in statutory form, that the copyright in a work subject to copyright and the ownership of the work itself, in any material form, are separate and distinct properties and that, in the absence of express agreement, to the contrary, the mere sale of either property will not, necessarily, carry the other with it. This suggests the need for proper precautions in the purchase of works of art, for example, or future advertising, with more or less faithful reproductions of the work purchased, may harass and confound the amateur.

It is to be noted that the Section provides that the sale of the material object copyrighted shall not of itself constitute a transfer of the copyright nor *vice versa*. It would seem, however, that unless the author had parted with the copyright, sale of the original would, *prima facie*, at least, if made, voluntarily, by the author, carry the right to copyright it with it.⁷³ This would appear implied, as in consonance with ordinary custom and usage.

The rule appears to be that what the rights of parties are, on a voluntary sale of a physical work, would be determined from the contract of sale and its attendant circumstances.⁷⁴

This would appear equally true where a work had been copyrighted and the property in the physical reproduction of the work and of the copyright were in the same person. In an English case,⁷⁵ electro-blocks of copyrighted designs were sold, with a view

§ 1485

The mere sale of work will not carry right to copyright it, with it.

§ 1486

Effect of such sale, where author has not previously parted with right to copyright.

§ 1487

The rights of parties in such case, depend on facts.

§ 1488

The foregoing rules apply to copyrighted works.

73—Dennison v. Ashdown, 13 L. T. 226; Parton v. Parton, 3 Cliff. 537.

74—Stephens v. Gladding, 17 How. 452, 15 L. ed. 157 (semble).

75—Cooper v. Stephens, (1895) 1 Ch. 567. See also to the same effect, W. Marshall & Co. v. A. H. Bull Ltd., 85 L. T. N. S. 77.

§ 1489
Sale of electro-blocks for printing: non-assignable license.

§ 1490
Taxation of copyrights.

§ 1491
Attempted restrictions on resale of lawful copies.

§ 1492
Such attempted restrictions, by affixing notices, ineffectual.

§ 1493
Effect of Section as rendering such copies simply subject to general rules of law.

to their use, for the reproduction of such designs, by the purchaser. It was held this sale imported a license for such use but that this was not assignable, and that only the original purchaser could use the blocks for the purpose of printing from them.

The distinction, to which reference is made in the opening portion of this Section, is illustrated by the law of taxation. Copyrights are not taxable by the States but the physical objects produced under a copyright are taxable.⁷⁶

The concluding portion of the Section provides that nothing contained in the Act shall be deemed to forbid, prevent or restrict, the transfer of a copyrighted work, the possession of which has been lawfully obtained. This is substantially declaratory of the law as laid down in such cases as *Bobbs-Merrill Co. v. Straus*.⁷⁷

These decisions are discussed elsewhere.⁷⁸ In a typical case, where publishers of a copyrighted book printed a notice on the title page that the retail price was one dollar, that no dealer was licensed, to sell it for less and that any resale, if made for less, would be an infringement of copyright, such notice was held⁷⁹ ineffectual to give the publishers any rights against subsequent purchasers under the copyright laws. They having once sold the copies, as distinguished from parting with their possession and retaining title, had exhausted their statutory rights of sole sale and could not annex conditions to resales.⁷⁸

It is to be noted, however, that the language used in this portion of the Section, while apparently very broad, is limited, by the use of the words "lawfully obtained," to such an extent, that it may well be

76—*People ex rel. A. J. Johnson Co. v. Roberts*, 159 N. Y. 71, 45 L. R. A. 126.

77—210 U. S. 339, 52 L. ed. 1086.

78—See § 165.

79—*Bobbs-Merrill Co. v. Snellenburg*, 131 F. 530.

deemed that the effect of this portion of the Section is simply to approximate questions of the devolution of title to copies of copyrighted works to the rules governing property generally and to deny any special rights, by virtue of the copyright laws, to the late proprietor of the copies, in connection with, or after, a transfer of the copies.

This appears to have been the law before the enactment of the Section. Thus in one case,⁸⁰ it appeared that a work was to be published by subscription. A canvass for subscribers was made by book agents who purchased copies, binding themselves, by contract, not to resell them to subscribers at less than the retail price. Some of their number, in violation of their contracts, agreed to sell at lower prices to the defendant, who, in turn, had agreed to resell to third persons in the regular course of trade. It was held that to entitle the plaintiff to injunctive relief, he must first show that the defendants had notice of the terms of the contract between himself and his agents, and that, in the absence of any notice of the contract, the defendant had a right to buy, or contract to buy, books from agents who lawfully obtained them by purchase from the plaintiff or his publishers and to sell such books at any price they saw fit.

In a subsequent case,⁸¹ it appeared that books were sold to subscribers through agents only. One of the agents, on terms, which violated his instructions, sold to a dealer from whom the defendant, in turn, purchased. The evidence, although not over satisfactory, was that the defendant did not know that the copies purchased by him had been sold in the manner indicated. It was held that no title was conferred by the sale made by the agent in violation of instructions and that, since the books bore notice

§ 1494
Limitation of
authority of
agents author-
ized to sell
copies: the de-
cisions dis-
cussed.

80—Clemens v. Estes, 22 F. 899.

81—Henry Bill Publishing Co. v. Smythe, 27 F. 914.

of copyright, it was the defendant's duty, at his peril, to communicate with the copyright proprietor, before purchasing, to ascertain whether this was a second hand copy, which had been sold by authority, or what the agent's actual authority was. The defendant not having done this, an injunction was ordered and he was compelled to account for his profits. The Court distinguished the preceding case on the ground that there, there had been a sale to the agent and that the copyright proprietor could not limit the title so conferred by restrictions on resale. The Court's opinion is an elaborate one, contains some very sweeping language, partly unsound, and endeavors logically to demonstrate that the copyright proprietor's exclusive right to sell necessarily implies that an act done by an agent in violation of orders contravenes this right and that a sale made in this manner is not, in the absence of estoppel, such a sale as would divest the copyright proprietor's title to the copies, the mere possession of copies for the purpose of sale, not being deemed to raise such an estoppel.

§ 1495
The question discussed as to whether purchasers must ascertain agent's actual authority.

It would seem, however, that this decision takes an unduly sweeping view of a copyright proprietor's rights. The proprietor of any material object has the sole right to its sale; but the rule is universal that where a principal not only entrusts the possession of the property to an agent but also clothes him with the apparent power of sale, he will not be permitted to deny the agent's authority, as against third persons who have dealt with him in good faith and with reasonable prudence, unless the purchaser has notice of the lack of authority.⁸²

The physical copies of a copyrighted work stand on the same basis as property generally and the general rules of law applicable to such property apply to such copies.⁸³ Apparent authority of an

⁸²—See cases collected in 2 C. J. 594-5, 598.

⁸³—See *Bobbs-Merrill Co. v. Straus*, 210 U. S. 339, 52 L. ed. 1086.

agent of a copyright proprietor may be quite effectual to bind his principal.⁸⁴ There is no suggestion in any other decision that a prospective purchaser of a material object must ascertain the actual authority of the agent who is endeavoring to sell it, merely because it bears evidence that the work of which it is a copy was copyrighted and the case last cited,⁸⁴ as well as other decisions,⁸⁵ appear to involve the contrary proposition. The Court, in the case under discussion, evidently failed to distinguish the authority of an agent to bind his principal from his instructions.⁸⁶ Actual knowledge by a prospective purchaser that an agent was exceeding his instructions would, of course, give him no rights under the doctrine of apparent authority.⁸⁷

The word "transfer," as used in this Section, when coupled with the use of the word "possession," appears broad enough to include, not only cases where there has been an absolute devolution of title but also to comprehend, and hence permit, those lesser uses to which a proprietor may put his property in connection with third persons, as, for example, renting or mortgaging such lawful copies. The effect of this portion of the Section, then, is to put the owner of a lawful copy of a work upon the same basis as the owner of other chattel property, in so far as concerns its lawful use.

It should be carefully borne in mind, however, that the effect of this Section is not to legalize dealings with property not permitted by general rules of law, nor by valid contracts, but, simply, to prevent the invocation of the copyright law in such connection. Thus it is no defense to a suit for infringement that the plaintiff has violated either federal or state

§ 1496

The renting, mortgaging, etc., of lawful copies.

§ 1497

Provisions of Section preventative and confer no rights.

§ 1498

Anti-trust Acts as affecting copyrights.

84—Authors etc. Association v. O'Gorman Co., 147 F. 616.

85—Harrison v. Maynard & Merrill Co., 61 F. 689.

86—2 C. J. 570.

87—Authors etc. Association v. O'Gorman Co., 147 F. 616 (semble).

anti-trust statutes,⁸⁸ but, on the other hand, the copyright Acts are no defense to proceedings under the Anti-Trust Acts.⁸⁹

§ 1499
Possession of lawful copies gives no right to their physical reproduction.

It should also be noted that there is nothing in the Section which confers permission upon persons, other than the copyright proprietor, to invade, or infringe upon, the sole rights secured to him by the statute. In a relatively recent case,⁹⁰ it appeared that a copyrighted book was published in the United States from plates made and type set in this country. The plates were then taken by the proprietor to England and an edition was published there which, intentionally, omitted notice of the United States copyright. A copy was brought to the United States and there reproduced. It was held,⁹⁰ overruling the contrary opinion of the lower Court,⁹¹ that although the foreign copy was a lawful one, its reproduction, in the United States was infringement.⁹²

§ 1500
Lawful physical use of copies and infringement distinguished.

This decision is illustrative of the difference between lawful physical use of a copy of a work and illicit infringement of the work itself, by copying it. That the agency or facilities used, here the lawful copy, were lawful, will not prevent the act which comprehended the copying from being forbidden. The lawful copy is no securer basis for protected infringement than a lawful printing press, or a lawful painting brush would be, if used for copying. The copyright proprietor's property rights in the copy (which includes copyright) have ceased, when

88—*Scribner v. Straus*, 130 F. 389.

89—*Bobbs-Merrill Co. v. Straus*, 15 L. R. A. (N. S.) 766, 147 F. 15, aff'd 210 U. S. 339, 52 L. ed. 1086; *Scribner v. Straus*, 147 F. 29; *Mines v. Scribner*, 147 F. 927; *Straus v. American Publishers Association*, 231 U. S. 222, 58 L. ed. 192, L. R. A. 1915 A, 1099; *Bauer et Cie. v. O'Donnell*, 229 U. S. 1, 57 L. ed. 1041, 50 L. R. A. (N. S.) 1185.

90—*G. & C. Morriam Co. v. United Dictionary Co.*, 143 F. 354, aff'd 208 U. S. 260, 52 L. ed. 478.

91—140 F. 768.

92—This case should be contrasted with *Bentley v. Tibbals*, 223 F. 247.

it lawfully becomes the property of another, but this is not equivalent to saying that his right to protect his copyright had been in any way diminished, because a copy of the work had been permitted to come into the hands of another.

This decision should not be misunderstood, however. It applies only to cases where the copyright proprietor has affixed the statutory notice to copies sold in the United States, or has made sales abroad and had a pre-existing copyright in the United States. It does not apply to cases where he imports copies, printed abroad and sells them, without the prescribed notice of copyright,⁹³ nor does it apply, necessarily, in the case of copies sold abroad, prior to copyright in the United States.⁹⁴

What are copies "lawfully obtained" is a question which in no way depends on the copyright laws. An unlawful copy has been defined to mean a copy made without the consent of the copyright proprietor,⁹⁵ so that a lawful copy would appear to mean merely one issued by, or with the authority of, the copyright proprietor. Interesting questions can arise in this connection. If copies of a work are seized on execution, can they be resold against the copyright proprietor's will? It would seem under the decision cited,⁹⁶ and the language of this Section, that such a question should be answered in the affirmative, that is, that such copies might be resold, but not copied. If a copyright be renewed by the author, and not by the proprietor of the original copyright, it would seem the latter, even after the expiration of the original copyright, might sell copies previously printed, their possession having been lawfully obtained. This result was

§ 1501

What are copies "lawfully obtained."

§ 1502

Lawful copy defined.

§ 1503

Resale of copies seized on execution.

§ 1504

Sale of lawfully printed copies by owner of copyright after renewal copyright by author.

93—Bentley v. Tibbals, 223 F. 247.

94—See § 755; and cf. Clementi v. Walker, 2 Barn. & Cr. 861.

95—Lord Esher., M. R., in Tuck v. Continental Printing Co., 3 T. L. R. 826.

96—See §§ 1480-1483.

§ 1505
Similar sales
of similar
copies after
expiration of
license.

§ 1506
Sale of copies
on foreclosure
of artisan's
lien.

reached in English cases, in the absence of express contract to the contrary, where a copyright was sold and the seller had lawfully printed copies left in his possession⁹⁷ and also where a license had expired, with reference to copies printed during the license period.⁹⁸ Mr. Drone's view,⁹⁹ that lawfully printed copies might not be sold by an assignee, after the period of assignment passes, is now overruled by the enactment of this Section. It did not represent the English law.⁹⁸

If a printer print on credit and properly refuse to deliver without payment, it would seem that on foreclosure of his artisan's lien, the copies would come under the protection of this Section. It is to be noted that one who does the mechanical work of making copies for a copyright proprietor has no more right than a stranger, to make or sell copies in excess of those ordered, either for his own use, or for that of others than the copyright proprietor, but, as all property is held under, and only, by virtue of the law, a legal sale will divest the owner of his property in this, as effectually as a private sale would, although the uses of such property permitted to a purchaser might be different in the two cases.¹

97—210 U. S. 339, 52 L. ed. 1086.

98.—Howitt v. Hall, 6 L. T. N. S. 348.

99—See Drone, p. 339.

1—Stephens v. Cady, 17 How. 447, 15 L. ed. 155.

CHAPTER XXVII

ASSIGNMENTS, LICENSES AND OTHER TRANSFERS OF COPYRIGHTS

Section 42. That copyright secured under this or previous Acts of the United States may be assigned, granted, or mortgaged by an instrument in writing signed by the proprietor of the copyright, or may be bequeathed by will.

§ 1507
The transfer and mortgage of copyrights.

A common law copyright may be assigned verbally² and so, it would seem, may a statutory copyright, except where such assignment is executed without the United States.³ It is impossible, however, to speak with any certainty on this point.

§ 1508
Verbal assignments of common law and statutory copyrights.

Early drafts of the present Act, not enacted by Congress, contained an unequivocal provision requiring all assignments of copyright to be in writing.⁴ Congress, unfortunately, it would seem, instead of adopting the suggested provision, or one to the precise contrary, chose to reenact the pertinent provision of the prior statute,⁵ in a manner which appears to have left the questions which existed under it, more doubtful, if possible, than they were before.

§ 1509
History of legislation with respect to assignments of copyright.

The prior statute⁵ provided:

§ 1510
The prior Act.

“Copyrights shall be assignable in law, by any instrument of writing and such assignment shall be recorded in the office of the Librarian of Congress, within sixty days after its execu-

2—Black v. Henry G. Allen Co., 9 L. R. A. 433, 42 F. 618; Parton v. Prang, 3 Cliff. 437.

3—Section 43.

4—See Copyright Office Bulletin, No. 12, p. 57.

5—R. S. 4955.

tion; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.”

§ 1511
Written assignments required by language of early statutes.

Still earlier statutes⁶ had been held to provide for written assignments, or licenses, by implication from the provisions contained in them, which required written consents in writing signed by the copyright proprietor before two witnesses, to prevent suits for infringement against anyone exercising any of the rights, other than dramatic ones, which were reserved to a copyright proprietor by the statute. The latter requirements are no longer law. But, instead of the former peremptory “shall” of the Revised Statutes, the present Act uses the permissive “may,” which lends color to the argument that its reference to written assignments is not to render verbal ones invalid, but, on the other hand, omits the language restricting it to law, as distinguished from equity, thus, apparently, closing a loop-hole available, in certain instances, under prior Acts.⁷

§ 1512
Changes in statutory language used in present Act.

§ 1513
The English law.

The English cases⁸ holding assignments of copyrights were required to be in writing, were founded on the language of early statutes requiring licenses to be in writing (7). The early *dicta* in the United States were based upon the similar language found in the Acts of 1790 and 1831.⁹

§ 1514
Verbal assignments deemed valid, in general.

Mr. Drone’s view¹⁰ that the prior statutes did not render verbal assignments invalid in all cases, but only ineffectual as against bona fide purchasers and mortgagees, appears sound. It has the sup-

6—Act of July 8, 1870, § 150.

7—See § 1550.

8—Rundell v. Murray, Jac. 314; Shepherd v. Conquest, 17 C. B. 427; Leyland v. Stewart, 4 Ch. D. 419; Power v. Walker, 3 Maule & S. 7; Davidson v. Bohn, 6 C. B. 456.

9—Stephens v. Cady, 14 How. 532, 14 L. ed. 529; Little v. Hall, 18 How. 171, 15 L. ed. 331. Cf. also Gould v. Banks, 8 Wend. 562.

10—Drone: Copyright, p. 302.

port of at least one adjudicated case.¹¹ It would probably be followed under the present Act.¹² It is true that unless an assignment is in writing, it cannot be recorded and that, unless recorded, it is ineffective as against a subsequent bona fide purchaser or mortgagee for value.¹³ But this, as Mr. Drone points out, is not the equivalent of enacting that unrecorded assignments are void, for all purposes. The question as to whether they are valid, as between the parties, or persons who have actual notice thereof, remains unaffected by the express language of these provisions. The Section will probably, then, be deemed merely permissive, in its reference to instruments in writing, except as concerns subsequent bona fide purchasers for value and mortgagees.

§ 1515
Verbal assignments not valid against bona fide purchasers and mortgages.

§ 1516
Section permissive.

The utmost confusion exists in the decisions and *dicta* with respect to the question as to whether there may be a partial assignment of a copyright. It is obvious that what may take place may be either that an attempt may be made to convey the entire copyright, for a limited time, or for a limited territory, or to convey part of the general copyright, either for its full term, or for a limited time, or to give a third person the exclusive, or non-exclusive, right to utilize any one, or more (not all, however) of the rights comprehended in the general copyright, either for the duration of the copyright, or for a lesser time. The decisions have a way of calling all such grants assignments, and this seems the root of the difficulty as many of them appear mere licenses.

§ 1517
Partial assignments of copyright.

If the test of the decisions,¹⁴ rendered under the patent statutes, be adopted, any assignment of a

§ 1518
Assignments defined and

11—Webb v. Powers, 2 Wood & M. 297.

12—See Parton v. Prang, 3 Cliff. 537.

13—Section 44.

14—Gayler v. Wilder, 10 How. 477, 494, 13 L. ed. 504, 511; Waterman v. Mackenzie, 138 U. S. 252, 34 L. ed. 923; Pope Manufacturing Co. v. Gormully & Jeffreys Co., 144 U. S. 248, 36 L. ed. 423.

distinguished
from licenses.

§ 1519
License de-
fined and dis-
tinguished
from assign-
ment.

§ 1520
Licensee not
permitted to
sue for in-
fringement.

§ 1521
Setting forth
contract for
judicial de-
termination
whether
license or as-
signment.

§ 1522
Differences
between pat-
ent and copy-
right Acts as
to partial as-
signments.

copyright which does not convey the entire and un-qualified monopoly of the copyright proprietor, or an individual share thereunder, is to be deemed a license rather than an assignment.

In a leading English patent decision,¹⁵ the difference between a license, even if exclusive, and an assignment, is brought out with great clearness. It was there held that the former was merely a leave to do a thing and a contract by the assignor not to permit anyone else to do it, but that, unless coupled with a grant, it conferred, no more than did any other license, no interest or property in the subject matter of the contract, and, hence, it was held a licensee could not sue, in his own name, for infringement.¹⁶

The uncertainties in these matters are illustrated by a decision which held,¹⁷ it was a proper form of equity pleading, to set out an agreement between an author and parties plaintiff and to allege that if this did not embody an assignment, that it conferred an exclusive license. The fact being pleaded, the conclusion to be drawn therefrom might be pleaded in the alternative.

Early drafts of the Act, not enacted by Congress contained a provision that each of the various rights given a copyright proprietor by the Act was to "be deemed a separate estate subject to assignment, lease, license, gift, bequest or inheritance."¹⁸ This provision was stricken out before enactment. The Copyright Act differs in language from the Patent Act. The latter expressly permits the assignment of a patent, or any interest therein. The pertinent language is:

"Every patent or any interest therein shall be assignable in law, by an instrument in writ-

15—Heap v. Hartley, 42 Ch. D. 461.

16—See § 1579 *et seq.* as to this under the present Act.

17—Black v. Henry G. Allen Co., 9 L. R. A. 433, 42 F. 618.

18—See Copyright Office Bulletin No. 12, p. 57.

ing, and the patentee or his assigns or legal representatives may in like manner, grant and convey an exclusive right under his patent to the whole or any specified part of the United States.”¹⁹

There is no need to enlarge upon the differences between this comprehensive language and that of the Section under discussion.

In England, assignments may be entire or partial, but they, as well as licenses, must be written.²⁰

Various *dicta*, in the books, deem a copyright an entirety, indivisible and hence not capable of partial assignment.²¹ This view, if properly limited, possesses great advantages of public and private convenience. Where there are several proprietors of a copyright, they have been held to be tenants in common.²² Either may make any use he pleases of the work, sell copies or grant licenses, without in any way consulting his co-proprietors and need not account to the others for any profits he may make out of such use of the copyright.²³ Such proprietors may, it would seem, sell their interests in the copyright, and if they may do so, it would seem, logically, the sole copyright proprietor, if sufficiently ill advised, or unfortunate enough to be compelled to put himself at another’s mercy, may sell or assign, an undivided part or share in the copyright.²⁴

The *dicta*²¹ that say that copyright cannot be divided were, however, all made in cases where it was not sought to assign an undivided interest in a

§ 1523
English statutory rules.

§ 1524
Indivisibility of copyright.

§ 1525
Theory as affected by joint owners.

§ 1526
Rights of such persons.

§ 1527
Undivided interests in copyrights.

19—R. S. § 4898 as amended by the Act of March 3, 1897; Comp. Stat. § 9444.

20—Part I, 5, § 21.

21—Jeffreys v. Boosey, 4 H. L. C. at 992; Shepherd v. Conquest, 17 C. B. at 436.

22—Powell v. Head, 12 Ch. 686; Carter v. Bailey, 64 Me. 458.

23—Carter v. Bailey, 64 Me. 458.

24—Black v. Henry G. Allen Co., 9 L. R. A. 433, 42 F. 618.

copyright but to assign the copyright, *in toto*, for a given country. They arose under statutes where copyright was, substantially, a single right and not an aggregation of rights, as under the present Act.

It is quite obvious that they did not contemplate the situations which frequently arise under the present Act where, as previously pointed out,²⁵ copyright represents an aggregation of rights rather than a single right.

§ 1528
Transfer of individual rights comprehended in copyright.

§ 1529
Rights of action of such transferee.

§ 1530
Grant of exclusive dramatic rights held an assignment.

§ 1531
The question raised whether such "assignments" are not licenses.

§ 1532
Transfer of exclusive rights comprehended in copyright, for

Where there is more than one right given by statute, the various rights may, it seems, be split up as the owner pleases.²⁶ Under the present Act, it has been held that each right given a copyright proprietor may be assigned separately.²⁷ This is in accordance with the doctrine of an earlier case,²⁸ where it was further held that each such assignee might sue, without joining his assignor, if the right so assigned to him were invaded. Under the present Act, no such right is "incidental" to any "general" copyright.²⁹ In the case last cited, a grant of the exclusive dramatic rights in a play and of its exclusive leasing, was held an assignment of the dramatic rights therein.³⁰

It may be questioned, however, whether such so-called assignments are not rather in the nature of licenses³¹ than in the nature of assignments, but this point is not discussed in the decisions.

In a leading case³² it was held that the exclusive right of printing, publishing, enacting, performing, representing and producing a work within, and

25—See § 137.

26—Press Publishing Co. v. Munroe, 51 L. R. A. 353, 73 F. 196.

27—Photo Drama Motion Picture Co. v. Social Uplift Film Co., 220 F. 448.

28—Roberts v. Myers, 20 F. C. 11906.

29—Photo Drama Motion Picture Co. v. Social Uplift Film Co., 220 F. 448.

30—213 F. 374.

31—See § 1519.

32—Palmer v. DeWitt, 47 N. Y. 532.

throughout, the United States would be deemed a license, rather than an assignment. The correctness of this view may be questioned,³³ just as the Court was clearly mistaken in its apparent view that the citizen assignee of an alien author might obtain copyright in the United States where his assignor could not.³⁴

United States, held an assignment.

Similarly, in an early American case,³⁵ an instrument assigning the right to perform a play, for one year, everywhere in the United States, save in five cities, was deemed an equitable assignment and the plaintiff was permitted to sue for an injunction, without joining the assignor as a party to the litigation. The result of this decision is sustainable under Section 36 of the present Act, but its view as to the technical effect of the instrument involved, which apparently conferred only a limited license, appears erroneous.

§ 1533
Such transfers when limited, in time and place, held equitable assignments.

A similar view of an analogous situation was taken in another early case,³⁶ where a partial assignment by a foreign author, was deemed inoperative, at law, except as a license, but held a valid assignment, in equity, to the extent permitted by its limitations.

The chief distinction, under the present Act, between assignments and licenses is with respect to the right to sue on infringement, or rather as to the extent of the relief obtainable in such actions,³⁷ and with respect to the right to re-assign.

§ 1534
Practical differences between license and assignment under present Act.

A license is usually deemed personal³⁸ and, hence, not transferrable, while, since all the assignor's

§ 1535
Licenses not transferrable.

33—Cf. *Pope Mfg. Co. v. Gormully & Jeffreys Co.*, 144 U. S. 248, 36 L. ed. 423.

34—*Bong v. Alfred S. Campbell Art Co.*, 214 U. S. 236, 53 L. ed. 979.

35—*Roberts v. Myers*, 13 Monthly L. J. 396 (U. S. C. C. Mass.).

36—*Kcene v. Wheatley*, 4 Phila. 157 (U. S. C. C. E. D. Pa.).

37—See § 1579 *et seq.*

38—*Lucas v. Moncrieff*, 21 T. L. R. 683; *Cooper v. Stephens*, (1895) 1 Ch. 567; *Stevens v. Benning*, 6 De G. M. & G. 223.

§ 1536
Re-assignments.
Sub-licenses.

§ 1537
Personal reliance, one test whether license or assignment.

§ 1538
Agreement by author to copyright negatives assignment.

§ 1539
Limitation of rights to publication in given form.

§ 1540
Serial rights.

§ 1541
Limitation to given edition, of rights of user.

rights are divested on assignment, an assignee may, of course, re-assign. A licensee may not grant sub-licenses unless authorized to do so by the licensor.³⁹ One of the tests, in doubtful cases, as to whether or not there has been assignment or license, is whether, on examination, the transaction appears to show reliance on the person, or character, of the party with whom the copyright proprietor has dealt, to such an extent that the right may be deemed a personal one. The fact that the licensee be a corporation will not of itself, overturn the presumption that the license was not intended to be assigned.⁴⁰

Where a contract between a foreign author and a theatrical manager granted the stage rights in a work for the United States to the latter, but the author agreed to copyright the play in this country, it was held (1) that such a contract involved the retention by the author of the right to copyright and an attempted copyright by the manager was held invalid. The manager's rights thus were in the nature of a license under a contemplated copyright.⁴¹ The grant of the sole and exclusive right of printing and publishing and of issuing musical compositions, in volume form, was held to be a license, not an assignment.⁴² Similarly, an assignment of "serial rights" in a play is a mere license.⁴³ On the other hand, in a leading case,⁴⁴ the Court held that a contract which provided that the defendant was only to use certain notes to a work, with a given edition of the work, and was not to use them in a new edition, without the author's consent, but that the author be given the right to make such use of them as he deemed fit, was the equivalent of a con-

39—Heine v. Liebler, 73 N. Y. A. D. 194.

40—Griffith v. Tower Publishing Co., (1897) 1 Ch. 21.

41—Saake v. Lederer, 174 F. 135.

42—In re Jude's Compositions, (1907) 1 Ch. 651.

43—New Fiction Publishing Co. v. Star Co., 220 F. 994.

44—Lawrence v. Dana, 4 Cliff. 1.

tract, enforceable in equity, to assign the legal title in the copyright in such notes, to the author.

In an English case, it appeared the parties had entered into an agreement by which the plaintiff-author's "Peg Woffington" was to be published by defendant, at the latter's own expense and risk, and after all expenses, including 10% on the gross sale, for commissions and bad debts, had been deducted, the profits on every edition published were to be divided, half and half.⁴⁵ It was held this agreement did not confer an irrevocable license to publish upon the defendant, but contemplated a joint adventure which the author might end at any time after publication of the first edition, as to any edition not then published, or in process of preparation. In another instance,⁴⁶ it was held that a sale of a short story to the publisher of a magazine and the acceptance of a check "in full payment for story," without further agreement, was a sale of the story and the right to copyright it, without reservation, carrying with it the right to dramatize it. The legal situation was deemed not to be affected by a claim made by the plaintiff, the author, suing as assignee of his assignor, in his original pleadings and papers, that the right to dramatize the story had been held in trust for him by the assignor, and that he had not sold this right to the assignor. The decisions thus cited appear to indicate that the rule indicated by the patent cases, *supra*, is the rule underlying adjudications in copyright causes also.

It is to be noted that licenses are nowhere mentioned in the Copyright Act, but may, as has been assumed, without discussion, be granted under it. Thus, a license of the dramatic rights in a series of cartoons, "Mutt & Jeff," was deemed valid and

§ 1542
Joint publishing venture, a revocable license.

§ 1543
Outright sale of short story to magazine: status of rights not affected by unfounded claims of assignor.

§ 1544
The right to grant licenses under copyrights.

45—Reade v. Bentley, 27 L. J. Ch. 254.

46—Dam v. Kirk La Shelle Co., 41 L. R. A. (N. S.) 1002, 175 F. 902.

§ 1545
Dramatic licenses in cartoons.

§ 1546
Possible reasons for omission of express right to license.

§ 1547
Creation of licenses and assignments.

§ 1548
General law of contracts applies.

§ 1549
Formalities unnecessary.

§ 1550
Assignments and agreements to assign distinguished.

§ 1551
Implied assignments.

the licensee protected against infringement.⁴⁷ In certain patent decisions, licenses have been deemed mere relinquishments of the rights of action, which would accrue in favor of the licensor, by reason of the acts of the licensees were it not for the license.⁴⁸ They rest primarily in the law of contract, and, for these reasons, it may be, or possibly because of their universal recognition, Congress may have deemed it unnecessary to confer an express power to license, or to regulate licenses.

The method of creation of licenses and assignments will now be considered.

Contracts governing the sale of copyrights, and such sales generally, are controlled by the same rules of law as are similar contracts and sales of other property.⁴⁹

In the absence of statutory provision, no particular words are necessary to constitute an assignment,⁵⁰ and since, as has been shown, this may be oral, it need not be by deed, or before witnesses, as some of the earlier statutes required.

A distinction is brought out in the English cases between assignments, and executory agreements to assign.⁵¹ The latter, while enforceable to a certain extent in equity,⁵² are inferior to a subsequent actual assignment to a third person.⁵³

It is to be noted that in certain of the cases cited the author's manuscript had been delivered to a third person with the intention that such third per-

47—Hill & Whalen v. Martell, Inc., 220 F. 359.

48—See Heaton Peninsular Button Fastener Co. v. Eureka Specialty Co., 35 L. R. A. 728, 77 F. 288.

49—Hubbard v. Thompson, 25 F. 188; aff'd 131 U. S. 123, 33 L. ed. 76.

50—Cf. Lacy v. Toole, 15 L. T. N. S. 512.

51—Leader v. Purday, (1849) 7 C. B. 4; Colburn v. Duncombe, 9 Sim. 151; Levy v. Rutley, (1871) L. R. 6 C. P. 523; London Printing & Publishing Co. v. Cox, (1891) 3 Ch. 291.

52—Sweet v. Cater, 11 Sim. 572; Sweet v. Shaw, 9 L. J. Ch. 216; Sims v. Marryat, (1851) 17 Q. B. 281; Thomblson v. Black, 1 Jur. 198.

53—Leader v. Purday, (1849) 7 C. B. 4.

son should acquire all rights in the work. These cases would probably not be followed at present, in so far as they do not hold this to be a sufficient assignment.

Actual words of assignment are not necessary to constitute an assignment.⁵⁴ Thus in a House of Lords case,⁵⁵ Lord Wensleydale deemed that a receipt in full payment for a song constituted an effectual assignment of the copyright therein. In another case, it was held that there might be such a course of dealing and of action on the part of the proprietor of a copyright that the Court would, without proof of an assignment of the copyright, draw the inference that there had been a valid assignment.⁵⁶

The author of a work had entered into an agreement with the plaintiffs by which the latter were to publish twenty-five hundred copies of his work. There was no express assignment of the copyright. It was held that to the extent of such copies, plaintiffs were the equitable assignees of the copyright and entitled to restrain defendants from infringing such copyright.⁵⁷ Similarly, a license may be implied from the acts of the parties.⁵⁸

There can, of course, be neither assignment nor license, where there is nothing to license or assign, since the rights of an assignee of a copyright are, of course, strictly limited to those of his assignor.⁵⁹

A contract giving the "sole and exclusive right to publish" a work, then being run serially in England, in the United States, "from advance sheets," these to be delivered two months prior to completion of the English publication, was held to confer a mere right

§ 1552
Words of assignment unnecessary.

§ 1553
Receipt as assignment.

§ 1554
Acts as evidencing assignment.

§ 1555
Implied equitable assignment.

§ 1556
Implied licenses.

§ 1557
Assignee or licensee stands in grantor's shoes.

§ 1558
Illustrations: cases where grantor cannot obtain, or has no, copyright.

54—Ward Lock & Co. Ltd. v. Long, (1906) 2 Ch. 550 at p. 557.

55—Kyle v. Jeffreys, 3 Macq. 611.

56—Dennison v. Ashdown, 13 L. T. 226.

57—Sweet v. Cater, 11 Sim. 572.

58—Cooper v. Stephens, (1895) 1 Ch. 567.

59—Davies v. Boes, 209 F. 53.

to use such advance sheets and no proprietary rights whatever. The Court's view was strengthened by the smallness of the consideration set forth in the contract and by the fact that the alien author of the novel could not have obtained its copyright in the United States at this time, in person or through an assignee.⁶⁰ Similarly, a license to use a work in a certain form, is, of course, ineffectual to confer an exclusive right where the licensor has no copyright.⁶¹

The proper construction, and scope, of licenses and assignments may next be discussed.

§ 1559
Licenses limited to expressed purpose.

A license will be limited strictly to its expressed purpose. Thus it has been held⁶² that a license to use copyrighted musical compositions in the manufacture of mechanical records, "in any form whatsoever," would not permit the separate printing of the words of songs, on paper, and their subsequent distribution.

§ 1560
Licenses presumptively non-exclusive.

A license will be presumed non-exclusive, unless expressly made exclusive.⁶³

§ 1561
Foregoing rule not affected by alleged custom.

Unless a license expressly states it is exclusive, it cannot be shown to be so, by proof of an alleged custom that such licenses be exclusive.⁶⁴

§ 1562
Intention of parties cannot control unequivocal language.

Where an assignment or license is unequivocal in its language, it will be construed in accordance with this, and the actual intention of the parties cannot be shown, as long as the instrument remains in its original form.⁶⁵

§ 1563
Rights of licensee as to manner of publication, in

It is necessary for the licensor to insert such provisions as he deems fit, for his own protection, in the license, or the licensor may publish in any manner

60—Fraser v. Mack, 116 F. 285.

61—Hene v. Samstag, 198 F. 359.

62—F. A. Mills v. Standard Music Roll Co., 223 F. 849.

63—Warne v. Rutledge, L. R. 18 Eq. 496; Hart v. Cort, 165 N. Y. A. D. 583.

64—Hart v. Cort, 165 N. Y. A. D. 583.

65—Ward v. Moss, New York Daily Register March 23, 1881.

he sees fit, so long as he remains within the general scope of the license.⁶⁶

absence of agreement.

§ 1564

A license may be limited in any manner not contravening public policy or positive statute, in accordance with general rules of the law of contracts. Thus, in one instance,⁶⁷ it was held that a license to publish prints in a periodical, would not permit the subsequent separate publication of the articles and illustrations.

Limited licenses.

§ 1565

Instances of limited licenses.

A license to publish a photograph in a paper authorized its publication as a supplement, on a separate sheet, provided this was sold as part of the paper, but not otherwise.⁶⁸

In an English case,⁶⁹ it was held that assignment of the right to produce an engraving of a painting, in a certain size, left the right of producing copies of the painting in other ways, or by engravings of other sizes, in the proprietor of the copyright in the painting, and that while the licensee had copyright in his engraving, he could not sue for infringement, in the absence of proof that defendant's work was copied from his work and not from the painting, etc.

In another instance, it was held that a license to publish a song in a compilation of songs comprehended the right to publish it in future editions of the work, even though some songs were added and others omitted in these, within fair limits, not inconsistent with the general tenor of the first work.⁷⁰

§ 1566

Reservation of rights, on sale of copyright.

An author in selling the right to vend, or publish, a work may retain the right to translate, or to dramatize it, but there can be no such reservation by implication, or in the absence of express reservation.⁷¹

§ 1567

Must be express.

66—*Brock v. Lloyd Ltd.*, 26 L. T. R. 549.

67—*Strahan v. Graham*, 16 L. T. 87.

68—*Guggenheira v. Lang*, 12 T. L. R. 491.

69—*Lucas v. Cooke*, L. R. 13 Ch. D. 872.

70—*Gabriel v. McCabe*, 74 F. 743.

71—*Dam v. Kirk La Shelle Co.*, 41 L. R. A. (N. S.) 1002, 175 F. 907 (seable). The dicta to the contrary in *Marsh v. Conquest*, 17

§ 1568
Non-exclusive
licenses.

§ 1569
Motion pic-
ture rights
comprised in
assignment
of dramatic
rights.

§ 1570
Rights of as-
signor after
assignment.

§ 1571
Breach of
contract con-
taining assign-
ment will not,
per se, work
re-assignment.

§ 1572
Rule not
varied because
assignor en-
titled to part,
of profits.

§ 1573
Rule not
varied by
breach of in-
dependent
stipulation, in
case of joint
copyright.

It has been said that the owner of a story after giving one the right to perform a particular dramatization, may give someone else the right to perform a different dramatization.⁷²

The assignment of dramatic rights has been held to carry with it the assignment of the motion picture rights in the work,⁷³ even though motion pictures were unknown at the time when the assignment was made.⁷⁴

After assignment, an author has of course, no more right to use the copyright work than a stranger has, unless he has reserved such right on making his assignment.⁷⁵

Breach of a contract which has provided for the sale and transfer of a copyright, and also regulated the future relations of the parties, will not revest title to the copyright in the assignor,⁷⁶ unless the contract so provides. In the absence of appropriate provision to that end, an author who assigns his copyright, cannot control the manner or extent of the use made of it by the assignee, even though he is to be compensated by a share of the future profits for making such assignment.⁷⁷

In an unusual case,⁷⁸ the Court had occasion to consider the situation arising from the breach of a contract which provided for a joint copyright, to vest in an author and a publisher, with exclusive territory to each. The publisher bound himself to print for the author at cost. This provision was held an independent stipulation, so that his failure

C. B. N. S. 418, 426, rest in the special language of the statutes there in question.

72—Harper Bros. v. Kalem Co., 169 F. 61.

73—Photo Drama Motion Picture Co. v. Social Uplift Film Co., 220 F. 448.

74—Frohman v. Fitch, 164 N. Y. A. D. 231.

75—Mackaye v. Mallory, 12 F. 328.

76—Thompson v. Hubbard, 131 U. S. 123, 33 L. ed. 76, Mackaye v. Mallory, 12 F. 328 (semble).

77—Mackaye v. Mallory, 12 F. 328.

78—Baldwin v. Baird, 25 F. 293.

to comply therewith was held not to justify an invasion of his exclusive territory.

A contract between author and publisher may be so drawn as to be personal only, even though the latter be a corporation and also so phrased as to give the author a right of reassignment of copyright, in the event of the publisher's default, which may be enforced as against the latter's trustee in bankruptcy.⁷⁹

§ 1574
Contractual rights to reassignment on default.

In an English case,⁸⁰ it appeared that the plaintiff had assigned his copyright upon the basis of a royalty to be paid him on each copy sold by the assignee. The latter permitted publication of the work in a newspaper not owned by it. The plaintiff sought to recover royalties on the sales of the newspaper. It was held he could not do so. The assignee, in the absence of express agreement, was not bound to publish the work at all, and was only bound to account for sales actually made by it, not for permissive sales by others.

§ 1575
Assignor's rights under contract for payment of royalties by assignee only: permissive sales.

Publication of a work by a licensee, without proper notice of copyright, will render it part of the public domain,⁸¹ unless such omission violates the contractual conditions licensing publication.⁸²

§ 1576
Effect of licensee's omission of copyright notices.

In the case last cited,⁸³ it was held that the owner of a copyrighted article did not lose any rights in connection with it, as a consequence of the fact that a limited territorial licensee, authorized to publish it on the express condition of affixing the usual copyright notice, had, inadvertently, failed to do so. This decision is discussed elsewhere.⁸⁴

79—In re D. H. McBride & Co., 132 F. 285.

80—Nicholas v. Amalgamated Press, (1907) Reported in 8 Halsbury's Laws of England, 159.

81—West Publishing Co. v. Edward Thompson Co., 169 F. 833.

82—American Press Publishing Co. v. Daily Story Publishing Co., 66 L. R. A. 444, 120 F. 766.

83—66 L. R. A. 444, 120 F. 766.

84—See §§ 883, 1051.

§ 1577

Warranties on sales of copyrights.

§ 1578

Implied warranty of right to publish.

§ 1579

Right of licensor to sue, for infringement.

§ 1580

Right of licensee to sue for fixed damages on infringement.

§ 1581

Right of assignee to sue, where assignment qualified by covenant, not to reproduce in copies.

§ 1582

Proof essential as basis of action by assignee.

The usual covenants implied on the sale of personal property will be deemed implied on a sale of copyright.⁸⁵ In an early case, a recovery appears to have been permitted against one who had represented that he had a right to permit a work to be printed, as a result of which the plaintiff incurred large expenditures for printing, and defending an unsuccessful law suit for infringement.⁸⁶

The English cases which hold that a copyright proprietor, who has given an exclusive license, cannot sue without the licensee,⁸⁷ do not appear to be law under Section 36 of the American Act, as far as injunctions are concerned.⁸⁸

A licensee has not, however, the right to sue solely for fixed, or statutory, damages under the present Act, as the statute, the Court deemed, was only designed to give these once, and, hence, to all the parties damaged by the infringement.⁸⁹

In an interesting English case,⁹⁰ it appeared that the owners of copyright in a painting assigned it to plaintiffs, upon the undertaking of the plaintiffs that they would not reproduce the picture, without the consent of the assignors. It was held an assignment, so qualified, was insufficient to allow a suit by the assignees, unless the assignors joined as parties plaintiff, as what was transferred—copyright without the right to copy—was nothing at all.

In a well considered decision,⁹¹ it was held that where an assignee sues for infringement of copyright, the burden is upon him to prove that his assignor was the author of the copyrighted work

85—Sims v. Marryat, 17 Q. B. 281 (semble).

86—Shebbeare v. Gwynn, 2 Eden. at 330.

87—Taylor v. Neville, 26 W. R. 299; Tree v. Bowkett, 74 L. T. 77; Heape v. Hartley, 42 Ch. D. 461; Neilson v. Horniman, 25 L. T. R. 188; London Printing & Publishing Alliance v. Cox, (1891) 3 Ch., 291.

88—See § 1447 *et seq.*

89—New Fiction Publishing Co. v. Star Co., 220 F. 994.

90—Landeker & Brown v. Louis Wolff & Co., 52 Solicitor's J., 45.

91—Bosselman v. Richardson, 174 F. 622.

and that neither assignee, nor assignor, published the original, before statutory copyright. It was further held that no certificate of the Librarian of Congress was sufficient to prove these facts. Subject to changes in the statute, the general doctrine of this case is undoubtedly the law.

§ 1583
Certificate of Copyright Office insufficient proof in such cases.

Under an assignment giving a proper power to that end, it may be that the cases⁹² holding that an assignee cannot sue in his own name, for infringement prior to the assignment, would not be followed, under the section of the Act cited. It would appear a safer practice, however, to join the assignor as plaintiff and to reserve the right to do so in instruments of assignment.

§ 1584
Action by assignees for infringement prior to copyright.

A further method of procedure was indicated in another case,⁹³ where it was held that a right of action at equity, for past infringement, might be assigned with the copyright.

§ 1585
Assignments of claims for prior infringement.

Where the copyright is vested in more than one person, any such person⁹⁴ may sue for infringement of the entire copyright.

§ 1586
Suits by joint proprietors.

In an early case,⁹⁵ it was held that where the right to English copyright was assigned abroad and, thereafter, before copyright in England, the assignor permitted a first publication of the work abroad, this prevented statutory English copyright, since the publication was said not to have been made by a wrongdoer but by one lawfully entitled to publish.

§ 1587
Effect of general publication by assignor, on rights of non-exclusive assignee.

In another early case,⁹⁶ on the other hand, it was held that where an author before composition of a work, sold the exclusive right to perform it in the United States, and, before publication, sent a copy

92—Dupuy v. Dilkes, 48 L. J. Ch. 682; Chappell v. Purday, 14 M. & W. 303.

93—Gilmore v. Anderson, 38 F. 846.

94—Lauri v. Renad, (1892) 3 Ch. 402, 413; Powell v. Head, 12 Ch. 686.

95—Chappell v. Purday, 14 M. & W. 303.

96—Goldmark v. Kreling, 35 F. 661.

§ 1588
Acts of assignee of foreign rights.

of the manuscript to the purchaser, the author could not thereafter sell the same right to another, nor dedicate the work to the public by a general publication, so as to defeat the rights of the first purchaser.

Where an author sells the American serial and book rights in a work to one firm, and the English rights to another, it has been held that the English proprietor's publication did not affect the plaintiff's rights, as there was said to be no privity between the two assignees.⁹⁷

§ 1589
The foregoing decisions discussed.

These decisions all refer to common law copyrights, or to the right to obtain statutory copyright. In such cases the test would appear to be whether there was an assignment, or a license. If an assignment, the assignor has ceased to have any rights under the copyright laws; and any act by him cannot affect the rights of the assignee. If on the other hand, there has merely been a license, the licensee's rights are purely contractual and are subject at all times to termination, as far as respects third persons, by act of the licensor, the copyright proprietor.

§ 1590
Effect of general publication by assignee, on rights reserved to assignor.

Where acting rights were reserved, but the exclusive right to publish the work, as well as the absolute ownership, or unconditional possession, of the work, were transferred, it was held that a publication by such transferee, ended any rights of the author, to prevent anyone who pleased, from acting the work.⁹⁸

§ 1591
Effect of licenses to use digest paragraphs.

A possible effect of the giving of licenses was illustrated in another decision⁹⁹ where it was considered that the giving of general licenses to use copyrighted materials contained in a digest, was to be deemed in the light of a sale of the labor represented in making the digest and, hence, to be an abandonment of the exclusive right to publish it, unless the terms of the licenses were such as to

97—Harper & Bros. v. M. A. Donohue & Co., 144 F. 491.

98—Wagner v. Conreid, 125 F. 798.

99—West Publishing Co. v. Edward Thomson Co., 169 F. 833.

ensure the insertion of the appropriate copyright notices wherever required by law, or unless the use contemplated by the licenses was so limited as to constitute quotation rather than republication. This view emphasizes the necessity for care in drawing licenses, to which attention has been directed elsewhere.¹

Copyright may, of course, be transferred in the interval between the time when it vests and when it is registered, as well as after copyright, or when inchoate, before copyright.²

Decisions with reference to the assignment of patents, and to licenses thereunder, are much more numerous than similar cases decided under the copyright laws. Many diverse aspects of this general subject will be found to have been discussed, or adjudicated, in such decisions. Such cases may be consulted, with profit, by the profession, in doubtful situations, provided that the difference between the copyright and patent statutes, in each instance, be remarked, and allowance made therefor in reading, and citing, such decisions. A detailed discussion of such cases is, obviously, without the scope of this work, as much as would be a compilation of cases bearing on licenses and assignments, under the general rules of law applicable to such instruments.

No cases appear to have arisen, as yet, involving mortgages of copyright. It is deemed probable, however, that such mortgages must conform to the rules of law applicable to mortgages of personal property in general; and would be governed as to form, validity, recording, etc., by the laws of the particular state where made.

Mortgages and licenses are not required to be recorded in the Copyright Office. The sections of the Statute applicable to recording follow.

§ 1592
Assignments
of inchoate
or unregis-
tered copy-
rights.

§ 1593
Patent cases
involving as-
signments.

§ 1594
Mortgages of
copyrights.

§ 1595
State laws
apply.

§ 1596
Recording
mortgages and
licences in
Copyright
Office.

1—See § 1563.

2—Grave's Case, L. R. 4 Q. B. 715.

§ 1597
Assignments
of copyright,
executed
abroad.

Section 43. That every assignment of copyright executed in a foreign country shall be acknowledged by the assignor before a consular officer or secretary of legation of the United States authorized by law to administer oaths or perform notarial acts. The certificate of such acknowledgment under the hand and official seal of such consular officer or secretary of legation shall be prima facie evidence of the execution of the instrument.

§ 1598
Effect of failure to comply with Section.

It is to be observed that this Section provides no penalty, in terms, for non-compliance with it. Hence, it would seem that, since its requirements are absolute, any failure to comply with its terms will invalidate the assignment in question, and that all assignments executed abroad, must be in writing and acknowledged as prescribed in this Section.

§ 1599
Foreign assignments must be written.

§ 1600
Recording assignments of copyright: effect of non-recording.

Section 44. That every assignment of copyright shall be recorded in the Copyright Office within three calendar months after its execution in the United States, or within six calendar months after its execution without the limits of the United States, in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded.

§ 1601
Unrecorded assignments valid except as to bona fide purchasers for value or mortgagees.

This Section differs from the preceding Section in prescribing the penalty for non-compliance therewith. The penalty, since prescribed, appears exclusive, and not absolute, but merely relative. Under it, it would appear, unrecorded assignments may be valid, as between the parties thereto, or against anyone who is not a purchaser for value, or a mortgagee, without notice of the assignment. This appears to be the law. So it has been held that an

unrecorded assignment of copyright is good as between the parties to it,³ and as against infringers.⁴

There is no requirement in the Act that licenses must be recorded. There appears no authority for the record of such instruments and it is probable that, in accordance with general rules of law, record of a license, if made, would not be constructive notice thereof to anyone.

§ 1602
Licenses not recordable.

The question therefore, arises, as to what effect an unrecorded license would have as against a subsequent assignee of the copyright, without notice of the license.

§ 1603
Effect of unrecorded licenses against assignees of copyright.

In England,⁵ it has been said that an assignee of the copyright takes it free and clear of licenses to use it, of which he has no notice.

In the United States, it has recently been held,⁶ that an unrecorded assignment of motion picture rights is void, as against a subsequent assignee, without notice.

§ 1604
Effect of unrecorded assignment of motion picture rights.

The Court in the case last cited, apparently considered the instrument before it an assignment. If it was one, its decision is unquestionable, under the very language of the Section under discussion. But it may well be questioned whether anything more than an exclusive, perpetual license was conferred in the instrument, involved in the case in question. The Court did not discuss the apparent distinction between licenses and assignments, to which attention has been directed elsewhere.⁷ It does not appear whether its attention was directed to this and how it would have decided the matter, if it had deemed the instrument a license. It may well be

3—Banks Law Publishing Co. v. Lawyers Cooperative Co., 169 F. 386 (see opinion of lower court).

4—New Fiction Publishing Co. v. Star Co., 220 F. 994.

5—London Printing & Publishing Alliance v. Cox, (1891) 3 Ch. 291.

6—Photo Drama Motion Picture Co. v. Social Uplift Film Co., 220 F. 448.

7—See § 1519 *et seq.*

that its decision would have been the same way,⁸ however, although it might have applied the doctrine of the English case cited.⁹

§ 1605
Certificates
of record of
assignments
and certified
copies thereof.

Section 45. That the Register of Copyrights shall upon payment of the prescribed fee, record such assignment, and shall return it to the sender with a certificate of record attached under seal of the Copyright Office, and upon the payment of the fee prescribed by this Act he shall furnish to any person requesting the same a certified copy thereof under the said seal.

§ 1606
Names of assignees in
copyright
notices.

Section 46. That when an assignment of the copyright in a specified book or other work has been recorded the assignee may substitute his name for that of the assignor in the statutory notice of copyright prescribed by this Act.

§ 1607
Recording
fees.

The fees for recording assignments will be found in the Appendix.¹⁰

§ 1608
Name of assignee in
notice after
record.

After the assignment has been recorded, but not before, the assignee may substitute his name for that of the assignor, in the statutory notices of copyright required by the Act.¹¹

§ 1609
Sections regulating admin-
istration of
Copyright
Office.

Sections 47 to 51 inclusive, 54 and 56-60 inclusive, relate to the administration of the Copyright Office and since they require no special comment, and have no general interest, are not reproduced at length in the text. They may be found set forth at length in the Appendix.¹²

8—Cf. *Gates Iron Works v. Fraser*, 153 U. S. 332 at 349, 38 L. ed. 734, 740. But see *Pratt v. Wilcox Mfg. Co.*, 64 F. 589.

9—*London Printing & Publishing Alliance v. Cox*, (1891) 3 Ch. 291.

10—See Appendix.

11—See §§ 730, 853.

12—See Appendix.

CHAPTER XXVIII

COPYRIGHT OFFICE ADMINISTRATION

(a) SEAL

Section 52. That the seal provided under the Act of July 8, 1870, and at present used in the Copyright Office, shall continue to be the seal thereof, and by it all papers issued from the Copyright Office requiring authentication shall be authenticated.

§ 1610
Copyright
Office seal.

§ 1611
Authentica-
tion of papers
by seal.

(b) RULES

Section 53. That, subject to the approval of the Librarian of Congress, the Register of Copyrights shall be authorized to make rules and regulations for the registration of claims to copyright as provided by this Act.

§ 1612
Authority of
Copyright Of-
fice to make
rules for
registration.

This Section is new, and without parallel in prior copyright legislation.¹³ Its enactment represents final legal sanction of the gradual assumption, by the Copyright Office, of the right to make rules in connection with the copyright of works.

The Rules made by the Register of Copyrights are printed in the Appendix. The narrow limits of the power here conferred, viz: to make rules for the registration of claims to copyright, should be borne in mind, in reading the present Rules, some of which as is pointed out elsewhere in this work,¹⁴ appear to exceed the limits of the authority conferred, and to take quite an incorrect view of various sections of the law.

§ 1613
Authority
limited to
rules and reg-
ulations for
registration
of claims of
copyright.

13—See Copyright Office Bulletin No. 12.

14—See § 546 *et seq.*, 1623.

§ 1614
Recent decision holding scope of copyright, under prior Act limited by application as a result of such Rules.

§ 1615
The decision criticized.

The confusion that such Rules may cause, unless their nature and limitations are correctly appraised, was forcibly illustrated in a very recent decision,¹⁵ other aspects of which are discussed elsewhere.¹⁶ The Court there considered the scope of a copyright as, in some unexplained way, limited by its description in the applicant's registration, because of the "practical interpretation," given by the Copyright Office, to the former statute, in its Rules.

"Under these Rules a copyrighted musical composition covered words and music, while, if the applicant intended to copyright only the words of a song, he must have designated his work under the classification of book, which has been construed to be a literary composition. *Littleton v. Oliver Ditson Co.*, 62 F. 597; *Hervieu v. J. S. Ogilvie Pub. Co.*, 169 F. 978," said the Court.¹⁷ These citations increase the feeling of surprise which the other portions of the opinion in the *Witmark* case are well calculated to inspire. The two decisions cited, construed the so-called manufacturing clause of the prior act, and held that, since this was penal in its nature, it would not be construed in its reference to books, to embrace either bound music or printed dramatic compositions. But it has not heretofore been doubted, since the earliest stages of copyright law, that, save under penal sections of the statutes, both of such classes of works were "books."¹⁸ What decisions construing penal statutes have to do either with the Rules of the Copyright Office, or with non-penal portions of the Act, is not readily apparent. For that matter, it may be questioned very decidedly where the Copyright Office derived authority to make rules prior to the passage of the present Act. There appears to have been nothing

15—*M. Witmark & Sons v. Standard Music Roll Co.*, 221 F. 376.

16—See §§ 472, 1010.

17—Page 380.

18—See citations, § 539.

in the prior statutes conferring any such authority, and its "practical interpretation" of Rules, it apparently had no legal right to make, would scarcely seem to furnish a safe basis for judicial reasoning.

(c) CERTIFICATES OF REGISTRATION

Section 55. That in the case of each entry the person recorded as the claimant of the copyright shall be entitled to a certificate of registration under seal of the Copyright Office, to contain the name and address of said claimant, the name of the country of which the author of the work is a citizen or subject, and when an alien author domiciled in the United States at the time of said registration, then a statement of that fact, including his place of domicile, the name of the author (when the records of the Copyright Office shall show the same), the title of the work which is registered for which copyright is claimed, the date of the deposit of copies of such work, the date of publication if the work has been reproduced in copies for sale, or publicly distributed, and such marks as to class designation and entry number as shall fully identify the entry. In the case of a book the certificate shall also state the receipt of the affidavit, as provided by Section 16 of this Act, and the date of the completion of the printing, or the date of the publication of the book, as stated in the said affidavit. The register of copyrights shall prepare a printed form for the said certificate, to be filled out in each case as above provided for in the case of all registrations made after this Act goes into effect, and in the case of all previous registrations so far as the Copyright Office record books shall show such facts, which certificate, sealed with the seal of the Copyright Office shall, upon payment of the prescribed fee, be given to any person making application for the same. Said

§ 1616
Certificates
to be furnish-
ed by Copy-
right Office.

§ 1617
Such certificates prima facie evidence.

§ 1618
Receipts.

§ 1619
The prior law as to official certificates.

§ 1620
The present law.

§ 1621
Burden of proof to show that work copyrightable and was copyrighted.

§ 1622
Effect of Section on proof in copyright suits.

certificate shall be admitted in any Court as prima facie evidence of the facts stated therein. In addition to such certificate the register of copyrights shall furnish, upon request, without additional fee, a receipt for the copies of the work deposited to complete the registration.

This Section is largely an innovation in copyright legislation.¹⁹ However, somewhat less comprehensive certificates appear to have been deemed competent prima facie evidence, even in the absence of statute, *as to facts*, stated therein.²⁰ Thus it was held that a certificate that copies have been deposited, given by the officer with whom they are deposited, is prima facie evidence of the fact of deposit.²¹

The present Section, however, provides for certificates which go far beyond those involved in the decisions cited. The law differs from the patent statutes in making no provision for any preliminary or tentative examination by any governmental official or agency as to whether, or not, one claiming copyright is, or is not, prima facie entitled to it.²² Hence, all well considered cases have held that one claiming copyright must prove both that such work was copyrightable,²³ and that there has been substantial compliance with the formalities incident to obtaining statutory copyright.²⁴

This is still, theoretically, law. Applications for registration of copyrights are not required to be made under oath. The Copyright Office is not given the right to examine into the correctness of the statements contained in the application. By this Section,

19—Copyright Office Bulletin No. 12, p. 63.

20—Blume v. Spear, 30 F. 629.

21—Callaghan v. Myers, 128 U. S. 617, 32 L. ed. 547.

22—Burrow Giles Lithographing Co. v. Sarony, 111 U. S. 53, 28 L. ed. 349.

23—See § 1330. Cf. Bosselman v. Richardson, 174 F. 622.

24—See § 147. Cf. Saake v. Lederer, 174 F. 135.

however, its restatement of the unverified statements contained in the application, is made prima facie evidence of the truth of such statements. It is also made evidence, but prima facie evidence only, of the facts connected with registration. The certificates issued by the Copyright Office go even beyond these drastic provisions.

The Copyright Office certifies in the form of certificate used by it, to the fact that the copies deposited are copies, as to which it can have no possible knowledge, that a work is, or is not, reproduced in copies for sale—as to which the same comment may be made—and that there has been compliance with the provisions of the law with respect to registration,²⁵ which appears an encroachment on the functions of the Courts. There seems no warrant in the law for any such insertions. In the one case²⁶ which has actually passed upon the Section, it was expressly held that statements in such certificates not authorized by the statute, were entirely ineffectual. Lacombe, J., said:

“The statement in the certificate that they were received ‘as copyright deposits’ indicates nothing more than that they were turned over to the office in attempted compliance with the copyright statute. The receipt of them by the Librarian does not involve any determination by him as to whether or not the deposit is made in time; he is not required to make any investigation when a copy is delivered to him or comes to him by mail as to what was the date of publication.”

Similarly, the certificate is insufficient to show that the work was unpublished before proceedings were begun for its copyright.²⁷

25—See certificate reproduced in *Universal Feature Film Co. v. Copperman*, 218 F. 588.

26—*Davies v. Boes*, 219 F. 178.

27—*Bosselman v. Richardson*, 174 F. 622.

§ 1623
Unauthorized
statements in
such certifi-
cates.

§ 1624
Such state-
ments ineffec-
tual for any
purpose.

§ 1625
Certificates
prima facie
evidence only.

The certificate is simply prima facie evidence as far as authorized. It does not relieve the plaintiff of the burden of proving his case,²⁸ but it may shift the burden of going forward upon defendant.

§ 1626
Contradiction
of certificate
by copyright
proprietor.

The importance of an early examination of the certificate issued in a given matter, is great, if an attack on the validity of the copyright be contemplated, for its sweeping language may otherwise frequently, and quite unexpectedly, shift the burden of going forward with the evidence upon defendant, by being used as plaintiff's main prima facie case.

The certificate is not conclusive even as against the copyright proprietor, who may show by common law evidence that the books were filed before the certificate says they were.²⁹

§ 1627
Signature of
certificates.
Receipts for
affidavits of
manufacture.

For such a certificate to be evidence, it must be signed at the end thereof; and matter inserted after the signature is admissible only as against the party who has written it, whoever that may be.³⁰

A receipt card to the effect that the affidavit required by Section 16 of the Act has been received by the Register of Copyrights is competent evidence.³¹

§ 1628
"Title," as
used in Sec-
tion, defined.

The title to which reference is made in the Section would appear to mean substantially the title³² by which a work is bought, sold or is inquired for in the speech of the people.

§ 1629
Certificates in
connection
with copy-
rights under
Section 11.

There appears to be an important limitation upon the issuance of certificates under this Section, which apparently has not been previously remarked. The Section provides for such certificates of the Copyright Office only "in the case of each entry" of a work. Section 54 of the Act provides for such entry

28—Saake v. Lederer, 174 F. 135.

29—Black v. Henry G. Allen Co., 56 F. 764.

30—Merrill v. Tice, 104 U. S. 557, 26 L. ed. 854.

31—Chautauqua School of Nursing v. National School of Nursing, 211 F. 1014.

32—Daly v. Webster, 56 F. 483; Black v. Henry G. Allen Co., 56 F. 764.

only where a copy of a work is deposited in the Copyright Office. The certificate is to contain the date of such deposit of copies. But copies are not required to be deposited where proceedings are had under Section 11 of the Act.³³ It may, accordingly, be deemed a doubtful question, whether such certificates may legally be issued in connection with copyrights secured under Section 11 of the Act.

(d) FEES

Section 61. That the register of copyrights shall receive and the persons to whom the services designated are rendered shall pay, the following fees: For the registration of any work subject to copyright, deposited under the provisions of this Act, one dollar, which sum is to include a certificate of registration under seal: Provided, That in the case of photographs the fee shall be fifty cents where a certificate is not demanded. For every additional certificate of registration made, fifty cents. For recording and certifying any instrument of writing for the assignment of copyright, or any such license specified in Section 1, subsection (e), or for any copy of such assignment or license, duly certified, if not over three hundred words in length, one dollar; if more than three hundred and less than one thousand words in length two dollars; if more than one thousand words in length, one dollar additional for each one thousand words or fraction thereof over three hundred words. For recording the notice of user or acquiescence specified in Section 1, subsection (e), twenty-five cents for each notice if not over fifty words, and an additional twenty-five cents for each additional one hundred words. For comparing any copy of an assignment with the record of such document in the Copyright

§ 1630
Fees of Copy-
right Office.

33—See §§ 765-766.

Office and certifying the same under seal, one dollar. For recording the extension or renewal of copyright provided for in Sections 23 and 24 of this Act, fifty cents. For recording the transfer of the proprietorship of copyrighted articles, ten cents for each title of a book or other article, in addition to the fee prescribed for recording the instrument of assignment. For any requested search of Copyright Office records, indexes or deposits, fifty cents for each full hour of time consumed in making such search: Provided, That only one registration at one fee shall be required in the case of several volumes of the same book deposited at the same time.

§ 1631
Method of
payment of
fees.

The Copyright Office Rules provide that remittances should be sent by money order or bank draft, *certified* checks, coin or currency (the latter two being sent at remitter's risk). Stamps and uncertified checks are not accepted. Provision is made for advance deposits by publishers against which registrations are charged.

§ 1632
Fees for regis-
tration of
commercial
labels.

If prints or labels designed to be used for articles of manufacture are governed by the Act of June 18, 1874, the registration fee is six dollars "which shall cover the expense of furnishing a copy of the record" "to the party entering the same."³⁴

34—See § 594 *et seq.*

CHAPTER XXIX

DEFINITIONS

Section 62. That in the interpretation and construction of this Act "the date of publication" shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority, and the word "author" shall include an employer in the case of works made for hire.

§ 1633
Definition of date of publication of works reproduced in copies.

§ 1634
Authors defined to include employers.

The first portion of this Section has been fully discussed elsewhere.³⁵ The concluding provision is largely declaratory of prior law.³⁶

§ 1635
Employers as authors of works made for them, for hire.

An employer, in a proper case, is deemed the author of the work of his employee. Employers, accordingly, should copyright the works made for them, in their own name as author, and not as obtained in a derivative capacity.³⁷

§ 1636
Copyrights by employer.

It is to be noted in connection with this Section, however, that the mere fact that the relation of employer and employee exists, is not sufficient to vest title to copyrightable works in the employer, in

§ 1637
Employment must relate to work in question.

35—See § 311.

36—Little v. Gould, 2 Blatch. 165; Heine v. Appleton, 4 Blatch. 125; Lawrence v. Dana, 4 Cliff. 1 (semble). The decision in Binns v. Woodruff, 4 Wash. C. C. 48, contra, rested in the special language of an early statute.

37—The decisions under prior statutes which were concerned with the technical theoretical question of how title to the employee's works vested in the employer have ceased to have any present importance. See Jones v. Thorne, 1 N. Y. Legal Obs. 408; Grace v. Newman, L. R. 19 Eq. 623; Keene v. Wheatley, 4 Phila. 157.

the absence of an express agreement to that end, or unless the employee is employed for the express purpose of producing such, or similar, works.³⁸ This subject is partly discussed elsewhere.³⁹

§ 1638

Question as to whether work belongs to employer one of fact.

The question whether the copyright in articles written by an employee belongs to the employer is one of fact, to be determined from the nature of the employment, and all the surrounding circumstances.⁴⁰

§ 1639

Presumption as to such works.

Prima facie, where employment and payment for a work are shown, the inference is that it is to belong to the employer.⁴¹

§ 1640

No presumption from bare fact of employment.

It cannot, however, be inferred from the mere fact of employment. Thus in one case,⁴² an actor and stage manager of defendant's theater wrote a play, on the understanding that it should be performed as long as it could run at the theater at which he was employed. It was held under such an agreement, the property on the play remained in the employee, for despite his general employment, he was not employed to write the play and no circumstances existed to show, by implication, that it was to become defendant's property.

§ 1641

The employee's claim of copyright insufficient to overturn the presumption.

In another case,⁴³ it was held that where an artist was commissioned to execute a work of art, not in existence at the time when the commission is given him, the burden of proving that he retains a copyright therein rested "heavily" upon him, there being a "very strong implication," that the work of art was to belong unreservedly, and without limitation, to the patron. In that case, the plaintiff had been commissioned to design, furnish and put in place, mosaics in the Congressional Library.

38—Roberts v. Myers, 13 Monthly L. J. 396.

39—See §§ 411, 429, 702, 716.

40—Lawrence & Bullen v. Alfalo, L. R., (1903) A. C. 17.

41—Lamb v. Evans, (1893) 1 Ch. 218; Sweet v. Benning, 16 C. B. 484; Lawrence & Bullen v. Alfalo, L. R., (1903) A. C. 17.

42—Bouccicault v. Fox, 5 Blatch. 87.

43—Dielman v. White, 102 F. 892.

After making cartoons for the mosaics, he affixed notice of copyright to these and had them approved by the government architect, and the mosaics when completed, were put in place bearing a similar notice. The defendant took photographs of the mosaics, with the consent of the Federal authorities. The Court held that in the absence of express reservation of the right to copyright in the work, in the plaintiff's contract with the government, and "considering the nature of governments, and the habits of government officers, which are matters of common knowledge," there was insufficient proof of acquiescence to overthrow the presumption (which arose out of the nature of the transaction) that copyright in the work was to be in the government.

Where what is paid for is not for the work but for its publication, a different result follows. Thus where an advertiser paid for the publication of an advertisement and a translation was made for this purpose, copyright in the translation was held to be in the translator, not in the advertiser.⁴⁴

In an English case,⁴⁵ it was held there could be no copyright by a photographer of photographs taken by him, for hire, and paid for by the sitters, although the rule is, of course, otherwise, where the sitting is gratuitous.⁴⁶

In a somewhat curious case, it was held that where the solicitor for a corporation wrote a letter apparently on its behalf, he had no such property in it, as would enable him to prevent its publication, although he swore it was written in a private, individual capacity.⁴⁷

In an English case⁴⁸ it appeared an original picture had been prepared for one firm only, for the

§ 1642
Employment to publish a work, not to compose it.

§ 1643
Employment involved in taking photographic portraits.

§ 1644
Effect of assertion that work written in representative capacity was individual.

§ 1645
Painting made as basis for supplying

44—Byrne v. Statist Co., (1914) 1 K. B. 622.

45—Ellis v. Ogden, 11 T. L. R. 50.

46—Ellis v. Marshall, 11 T. L. R. 522.

47—Howard v. Gunn, 32 Beav. 462.

48—Levi v. Champion, 3 L. T. R. 286.

advertising
labels.

purpose of being reproduced on advertising labels. Large orders were given for these to the proprietor. It was held, that having been made for this express purpose, the picture became the property of the customer and the original owner could not print similar labels for anyone else, in the absence of a reservation of the right to do so.

§ 1646
Composition
of incidental
stage music,
for employer.

In another case,⁴⁹ the defendant, a theatrical manager was reviving one of Shakespeare's plays. He employed plaintiff to compose the incidental music for it, on the distinct understanding, as found by the Court, that the music should become part of the entertainment and thereafter belong to defendant. It was held that it thereby became defendant's property.

§ 1647
Composition
of similar
music by in-
dependent
contractor.

This decision, not defensible on other points, is supportable only on the theory that the plaintiff, as an employee of the defendants obtained no independent right to his work, but that this, under the contract of employment, vested, on composition, in his employer. The subsequent and much criticised case of *Wallenstein v. Herbert*⁵⁰ where the manager of an orchestra whose duty it was to provide incidental music for plays in the theatre in which he was employed, which music he might either select or compose, and which was played by musicians employed and paid by him, was held to have no property in music so composed by him, differed from the former⁴⁹ in that *Wallenstein* was shown to have been an independent contractor rather than a mere employee and that no such contract as existed between *Hatton* and *Kean*, subsisted between himself and *Herbert*, or could reasonably be implied. The authority of these cases has been much shaken.⁵¹

“Employer” under this Section includes a cor-

49—*Hatton v. Kean*, 7 C. B. N. S. 268.

50—15 L. T. N. S. 364; aff'd 16 L. T. N. S. 453.

51—See *Eaton v. Lake*, 20 Q. B. D. 378.

porate employer.⁵² Various English cases decided under the language of the 5 and 6 Vict., c. 45 held that for an employer to be deemed the proprietor of a copyright, he must not only have agreed to pay for the work, but actually have paid therefor.⁵³ Whether the doctrine of these decisions applies to the present Act is an open question. It is difficult to reconcile the result of these decisions, save as a matter of statutory language, however, with another decision where it was held that if a work be executed at the request of another, the law may imply a promise to pay for it, if the circumstances warrant, sufficient to vest copyright in the work in the employer.⁵⁴

Where the title to a work has vested in the employer, the author-employee's rights in connection with it are purely contractual.⁵⁵

Thus, in a case involving this point,⁵⁶ it was held that where it was the contractual duty of a salaried employee to compile, prepare and revise certain matter, he had no more right than any other stranger to copy or reproduce such matter, which became his employer's property as produced, but he was not debarred from making a new compilation, from the same sources, after termination of his employment nor from, in doing so, using such experience or information as he might have acquired while in his employer's service.

The question whether a domestic employer can obtain copyright, in the work of an employee, who, if unemployed, would not be entitled to copyright because of alienage, must be deemed an open one. Since such employer would, under the present

§ 1648
Corporate
employers.

§ 1649
Necessity for
payment by
employer.

§ 1650
Implied prom-
ise to pay,
as result of
employment.

§ 1651
Rights of
employee.

§ 1652
Copyright by
domestic em-
ployers in
works of
alien employ-
ees.

52—National Cloak & Suit Co. v. Kaufman, 189 F. 215.

53—Brown v. Cooke, 16 L. J. R. N. S. Ch. 140; Richardson v. Gilbert, 1 Sim. N. S. 336; Bishop of Hereford v. Griffin, 16 Sim. 190.

54—Boucas v. Cooke, (1903) 2 K. B. 227.

55—Mallory v. Mackaye, 86 F. 123.

56—Colliery Engineer Co. v. United Correspondence Schools Co., 94 F. 152.

statute be the "author" of the work, it is deemed the alienage of the employee could not affect his right, the employee in such case not being an "author" in the sense contemplated by the present statute.

CHAPTER XXX

REPEALING CLAUSE OF PRESENT ACT

Section 63. That all laws or parts of laws in conflict with the provisions of this Act are hereby repealed, but nothing in this Act shall affect causes of action for infringement of copyright heretofore committed now pending in courts of the United States, or which may hereafter be instituted; but such causes shall be prosecuted to a conclusion in the manner heretofore provided by law.

§ 1653
Laws repealed
by Act.

No schedule of laws repealed by the Act was appended to it. Conflict with its provisions is made the test of repeal. It is not perhaps surprising therefore that various open questions exist as to the effect of this repealing clause.

§ 1654
No schedule
of laws re-
pealed an-
nexed.

The effect of this Section has been recently considered in a case⁵⁷ where it appeared that a copyright had been obtained prior to the passage of the present Act, in a song, consisting of words and music. The defendant reproduced the music mechanically, as he lawfully might, under the copyright involved in the case, but also had the words of the song printed separately and distributed copies of such words with his mechanical music records. This was held to be no infringement, for reasons partially considered elsewhere.⁵⁸ One of the plaintiff's contentions was that he was protected under Section 3 of the present Act,⁵⁹ in that the prior Acts governing the measure of his rights had been con-

§ 1655
The prior
Acts held un-
repealed with
respect to
copyrights
created under
them.

57—M. Witmark & Sons v. Standard Music Roll Co., 221 F. 376.

58—See §§ 472, 1010, 1614.

59—See § 472.

solidated into, and superseded by, the present Act. The Court, however, construed Section 63 to exclude the repeal of such prior statutes, and the application of the present Act to cases where there had been a violation, after 1909, of the copyright secured under the statutes which existed prior to July 1, 1909. That is to say, it was apparently the view of the Court that the prior statutes still remain unrepealed in so far as they may bear upon the scope of copyrights issued under them and upon the question as to actions brought for their infringement.

§ 1656
The decision
criticized.

§ 1657
Effect of pre-
sent Act as
one of con-
solidation.

It is deemed that this view is demonstrably erroneous. The Act of 1909 is entitled "an act to amend and consolidate the Acts respecting copyright." In the first Section of the statute, which greatly enlarged the scope of a copyright proprietor's rights,⁶⁰ Congress specifically enacted with respect to the enlarged right as to mechanical reproduction, "provided, That the provisions of this Act, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after this Act goes into effect." No such saving clause will be found anywhere else in the Act, with respect to any right or provision contained in it. It would appear to follow necessarily, that the prior copyright Acts have been amended and consolidated into the present Act, with possible exceptions considered elsewhere in this work,⁶¹ which do not bear on the point under discussion. It would further appear to follow that the rights of proprietors of copyrights obtained prior to the passage of the present Act have been enlarged, with the single express exception noted, to correspond to the rights of proprietors of copyrights obtained under the present Act, that is, that after the

60—See § 134 (e).

61—See § 1660.

passage of the present Act, there was only one statutory copyright as far as scope was concerned, independently of the time when such copyright was granted. Unless there is something in Section 63 of the Act to lead to a contrary result, it is difficult to see how the prior Acts relating to copyright, after being amended and consolidated into the present Act, can continue in being in their original form, for the purpose of measuring and defining the extent of the rights which inhere in copyrights obtained under them. The Court, in the decision under discussion, took the view, however, that there was language in Section 63 which led to this result.

On examining Section 63 it will be noted that it provides that "nothing in this Act shall affect causes of action for infringement of copyright heretofore committed, now pending in Courts of the United States, or which may hereafter be instituted; but such causes shall be prosecuted to a conclusion in the manner heretofore provided by law." It would seem plain that this portion of the Section was intended to be a saving clause for the protection of copyrights, granted prior to the passage of the Act. Its language perhaps lacks clarity, but, if so, to a limited extent only. But its purpose is manifest. It refers solely to infringements heretofore committed, that is, prior to the passage of the Act. This is the only possible meaning of the language used as "causes of action" cannot well be "committed," and infringement cannot well be "instituted." The language, then, refers to pending, or future, suits, for infringement, antecedent to the passage of the present Act and to nothing more.

Its language does not refer to the scope of copyrights but only to their violation. Unless it were limited to infringements preceding the present statute, one mode of procedure would be outlined for future violation of rights embraced in prior statutes and another mode for violations of the supplemen-

§ 1658

The exception to the general repeal effected by Section.

§ 1659

The view advanced that exception refers only to prior infringement.

tary rights conferred by the present statute upon the same copyright proprietor. This undesirable and illogical result appears neither intended, nor enacted by the language used. The draughtsmen of the Section apparently said to themselves, "We must save pending litigation," and enacted appropriate provisions for this. They then apparently said to themselves, "But if we repeal the earlier statutes conferring copyright and such copyright has been infringed, unless we make suitable provision, causes of action for such infringement, unless pending, will be lost unless saved by our provision." They therefore added a provision to cover these and since it would appear just that all cases of infringement under a given statute should stand on the same basis, wherever provided for, this resulted in the saving clause finally enacted. The Section does not purport to deal with substantive rights. Section 1 does that. It purports to deal with present and future remedies for the violation of past rights, only. Its language and purpose both appear to lend themselves to this construction and to no other. If these views are correct, the views of the Court in the *Witmark Case*,⁶² are clearly incorrect.

The Court, in that case said:⁶³

"We may concede that the great purpose in the enactment of the Copyright Law of 1909 was to bring together all the statutes applicable to the subject of copyright, and in many instances to enlarge the protection, secured by copyright, particularly by protecting the works of authors and composers which had theretofore been regarded as insufficiently protected. Yet notwithstanding this purpose, we must construe Section 63 as limiting the remedy in instances where the cause of action for infringement arose

62—*M. Witmark & Sons v. Standard Music Roll Co.*, 221 F. 376.

63—Page 379.

prior to July 1, 1909, or where causes were then pending, *or to instances where there has been a violation of the statutes which existed prior to July 1, 1909, but which might not be prosecuted until after that date.*"

"Appellant urges, however, that Section 3 of the Copyright Law of 1909 will give it protection. . . . The difficulty with this contention is that the statute reached only copyright provided by the Act of 1909; whereas in the present instance, the musical composition was copyrighted under an earlier Act, which gave a cause of action, *the remedy for which was preserved, as already said, by the provisions of Section 63 of the Act of 1909.*"

The italics in these quotations are inserted by the author of this work to direct attention to the words italicized. No reasons are advanced for the views thus expressed by the Court. It appears from the opinion⁶⁴ that the infringement in question took place at some time in, or after, 1912. It appears clear then, that the Court deemed that the effect of Section 63 was to keep the prior statutes in force, as far as concerned future infringement of the rights, which comprised copyright under such statutes. The bearing of Section 3 of the Act upon these questions is discussed under that Section⁶⁵ and need not be repeated here.

The Court's view, as expressed, was, apparently, that the past Acts were amended and consolidated into the present Act. If so, they ceased to exist. The statutes did not give a cause of action. They could not do so, if non-existent. They did not do so if existent. The cause of action arose out of the defendant's violation of the statute, not out of the statute itself. The right invaded arose out of the

64—Page 378.

65—See § 474.

statute. It is true, of course, that if it were not for statute, such Act would not be actionable but the remedy and the right must not be confused. The Court appears to have done this, for while it recognizes Section 63 deals with remedies only, the effect of its decision is to make it deal with substantive rights. It may be doubted whether the apparent injustice of the decision will be perpetuated elsewhere than in the Circuit where adopted, or whether the opinion with its statements of conclusions, without reasons in support thereof, and misapprehension of authorities, will commend itself to other judicial tribunals.

§ 1660
Possible unre-
pealed Sec-
tions.

Possible important open questions under the Act are (a) whether the Act has repealed the provisions of prior law requiring labels and prints relating to articles of manufacture to be filed in the Patent Office,⁶⁶ and (b) the provisions with respect to ad interim copyrights of books printed in foreign languages⁶⁷ discussed elsewhere.

Other Sections, which may, or may not, be held repealed, follow. Only those which do not appear on their face to conflict with the Act are printed.

§ 1661
Manuscripts.

“Every person who shall print or publish any manuscript whatever, without the consent of the author or proprietor first obtained, shall be liable to the author or proprietor for all damages occasioned by the injury.”⁶⁸

This Act may be traced back to Section 6 of the Copyright Act of 1790. Declaratory as it is of the common law, it is of interest chiefly from the point of view of a jurisdictional aspect, where Federal Courts may be asked for relief in cases covered by its provisions, if unrepealed.

66—Act of June 18, 1874. See § 594 *et seq.*

67—Act of March 5, 1905. See § 810, 929 *et seq.*

68—Act of March 3, 1891.

“In all actions arising under the laws respecting copyrights the defendant may plead the general issue and give the special matter in evidence.”⁶⁹

§ 1662
Pleading.

Whether this Section of the former Act is still in force, is an open question. Various possible defenses to a bill of complaint in copyright suits such as abandonment, prior publication, improper registration or non-registration, etc., require affirmative allegation in the absence of a rule as laid down in the statute under discussion. In the absence of a decision on the point, the careful practitioner will, doubtless, set out affirmative defenses at length, in addition to pleading the general issue.

So much of R. S. 4959 as provides for the deposit of a “copy of every subsequent edition wherein any substantial changes shall be made” within ten days after publication,⁷⁰ covers a situation not expressly mentioned in the Act. It is, however, probably repealed.

§ 1663
Deposit of
copies of sub-
sequent edi-
tions.

Section 64. That this Act shall go into effect on the first day of July, Nineteen Hundred and Nine.

§ 1664
Date on which
Act of 1909
became
effective.

69—R. S. 4969 Revision of Dec. 1, 1873.

70—Revision of 1873.

APPENDIX

APPENDIX A.

THE COPYRIGHT LAW OF THE UNITED STATES OF AMERICA

*Being the Act of March 4, 1909
(In Force July 1, 1909)*

*As Amended by the Acts of August 24, 1912,
March 2, 1913, and March 28, 1914*

*Together with Rules for Practice and Procedure
under Section 25 by the Supreme Court
of the United States*

AN ACT TO AMEND AND CONSOLIDATE THE ACTS RESPECTING COPYRIGHT

*Be it enacted by the Senate and House of Representatives
of the United States of America in Congress assembled,*
That any person entitled thereto, upon complying with the
provisions of this Act, shall have the exclusive right:

(a) To print, reprint, publish, copy, and vend the copy-
righted work;

Exclusive right
to print, pub-
lish, and vend.

(b) To translate the copyrighted work into other lan-
guages or dialects, or make any other version thereof, if it
be a literary work; to dramatize it if it be a nondramatic
work; to convert it into a novel or other nondramatic work
if it be a drama; to arrange or adapt it if it be a musical
work; to complete, execute, and finish it if it be a model or
design for a work of art;

Exclusive right
to translate,
dramatize, ar-
range, and
adapt, etc.

(c) To deliver or authorize the delivery of the copy-
righted work in public for profit if it be a lecture, sermon,
address, or similar production;

Exclusive right
to deliver lec-
tures, sermons,
etc.

(d) To perform or represent the copyrighted work pub-
licly if it be a drama or, if it be a dramatic work and not
reproduced in copies for sale, to vend any manuscript or

To represent
dramatic
works, or make
record, or ex-
hibit or per-
form, etc.

any record whatsoever thereof; to make or to procure the making of any transcription or record thereof by or from which, in whole or in part, it may in any manner or by any method be exhibited, performed, represented, produced, or reproduced; and to exhibit, perform, represent, produce, or reproduce it in any manner or by any method whatsoever;

To perform music and make arrangement, setting, or record.

(e) To perform the copyrighted work publicly for profit if it be a musical composition and for the purpose of public performance for profit; and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced:

Act not retroactive.

Provided, That the provisions of this Act, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after this Act goes into effect, and shall not include the works of a foreign author or composer unless the foreign state or nation of which such author or composer is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States similar rights: *And provided further, and as a condition of extending the copyright control to such mechanical reproductions*, That whenever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of instruments serving to reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of two cents on each such part manufactured, to be paid by the manufacturer thereof; and the copyright proprietor may require, and if so the manufacturer shall furnish, a report under oath on the twentieth day of each month on the number of parts of instruments manufactured during the previous month serving to reproduce mechanically said musical work, and royalties shall be due on the parts manufactured during any month upon the twentieth of the next succeeding month. The payment of the royalty provided for by this section shall free the articles or devices for which such royalty has been paid from further contribution to the copyright except in case of public performance for profit: *And provided further*, That it

Music by foreign author.

Control of mechanical musical reproduction.

Royalty for use of music on records, etc.