



5-1-1956

Copyrighting of Contributions to Composite Works: Some Attendant Problems

Alfred H. Wasserstrom

Follow this and additional works at: <http://scholarship.law.nd.edu/ndlr>



Part of the [Law Commons](#)

Recommended Citation

Alfred H. Wasserstrom, *Copyrighting of Contributions to Composite Works: Some Attendant Problems*, 31 Notre Dame L. Rev. 381 (1956).

Available at: <http://scholarship.law.nd.edu/ndlr/vol31/iss3/3>

This Article is brought to you for free and open access by NDLScholarship. It has been accepted for inclusion in Notre Dame Law Review by an authorized administrator of NDLScholarship. For more information, please contact lawdr@nd.edu.

THE COPYRIGHTING OF CONTRIBUTIONS TO COMPOSITE WORKS: SOME ATTENDANT PROBLEMS

The United States Copyright Code,¹ as is well known to those who have studied it and have had to apply its provisions, is, unfortunately, anything but a paradigm of careful legislative draftsmanship.² While the Code might be consigned to limbo it would not, despite a charitable appraisal, be entitled to a place in “. . . that lawyer's Paradise where all words have a fixed, precisely ascertained meaning. . . .”³ Quite to the contrary, the Code contains not only broad and indefinite so-called container-terms of critical import such as “writings,”⁴ “works of art,”⁵ “pub-

¹ 61 STAT. 652 (1947), 17 U.S.C. §§ 1-32, 101-116, 201-215 (1952). The basic copyright act of today went into effect on July 1, 1909, 35 STAT. 1075 (1909). It was thereafter amended as follows by: 37 STAT. 488 (1912); 37 STAT. 724 (1913); 38 STAT. 311 (1914); 41 STAT. 368 (1919); 44 STAT. 818 (1926); 45 STAT. 713 (1928); 53 STAT. 1142 (1939); 54 STAT. 51 (1940); 55 STAT. 732 (1941). Subsequently, in 1947, it was codified into positive law by 61 STAT. 652 (1947), and since then has been further amended by 62 STAT. 202, 869 (1948); 63 STAT. 153 (1949); 65 STAT. 710 (1951); 66 STAT. 752 (1952); and by 68 STAT. 1030 (1954), 17 U.S.C. §§ 9, 16, 19 (Supp. 1955).

² *M. Witmark & Sons v. Fred Fisher Music Co.*, 125 F.2d 949 (2d Cir. 1942), *aff'd*, 318 U.S. 643 (1943); *Shilkret v. Musicraft Records, Inc.*, 131 F.2d 929 (2d Cir. 1942), *cert. denied*, 319 U.S. 742 (1943); Chafee, *Reflections on the Law of Copyright: I*, 45 COLUM. L. REV. 503, 520 (1945); Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 473 (1955), where it is said of the Code: “. . . whose deficiencies have often been noted and lamented.”

³ THAYER, A PRELIMINARY TREATISE ON EVIDENCE AT THE COMMON LAW 428 (1898).

⁴ 17 U.S.C. § 4 (1952). This word is not to be read literally and will include at least those non-chirographic works specified in § 5 of the Code and that has been so since *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884), where a photograph was held to be copyrightable under the Act of June 18, 1874, c. 301, 18 STAT. 78, photographs having been first introduced as copyrightable subject matter in the Act of March 3, 1865, c. 124, 13 STAT. 540. § 5 states that its enumeration is not to “. . . be held to limit the subject matter of copyright as defined in section 4. . . .” The Supreme Court has never definitely fixed the outer limits of “writings.” In *Mazer v. Stein*, 347 U.S. 201 (1954), the majority of that Court refused to do so, being content to rest upon the assumption that a statue is a “writing.”

⁵ 17 U.S.C. § 5. The predecessor copyright acts had all specified which works were to be subject to copyright. However, the Code is deliberately

lication"⁶ and "infringement",⁷ to name a few at random, but also considerable ambiguous,⁸ loose⁹ and textually inconsistent¹⁰ language. That being so, it has devolved upon the courts, incident to their search for, and effectuation of, legislative meaning and purpose, to fill those containers with appropriate content and reasonably to clarify, tighten and harmonize that language.

Furthermore, since statutory copyright has been with us a long time, with the first congressional enactment in 1790¹¹ (and even before that, individual states, at the behest of the Continental Congress,¹² had passed copyright acts of their own¹³), many of the words which the legislative mind speaks and the judicial mind hears on the subject gather meaning, preforce, from ". . . their setting in history."¹⁴ Therefore, as persuasive aids, though not con-

⁵ *continued*

vague since it was considered desirable to substitute a general catch-all for artistic works rather than to identify them particularly. See the statement on this point made by the Librarian of Congress at that time, Herbert Putnam, Esq., before the House and Senate Committees on June 6, 1906, in connection with S.6330 and H.R. 19853.

⁶ 17 U.S.C. §§ 10, 13, 24, 26 (1952). This term, the meaning of which is crucial to the initiation of copyright under the Code, appears frequently therein. However, it is undefined, and has been said to be a word of ". . . no definite and fixed meaning." *Marx v. United States*, 96 F.2d 204, 206 (9th Cir. 1938).

⁷ 17 U.S.C. § 101.

⁸ *M. Witmark & Sons* case *supra* note 2, at 951.

⁹ *Shilkret* case *supra* note 2, at 932.

¹⁰ *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946), where the court, at 487, adverted to the undoubted ". . . textual difficulty in reconciling all the sections. . ." of the Code.

¹¹ 1 STAT. 124, approved May 31, 1790, and entitled, *An Act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.*

¹² The recommendation is found in the resolution of May 2, 1783, and was based upon the report of a committee consisting of Messrs. Madison, Izard and Williamson.

¹³ All of the original thirteen states did so with the exception of Delaware.

¹⁴ FRANKFURTER, *SOME REFLECTIONS ON THE READING OF STATUTES* 15 (1947). Meaning, of course, is also derived from ". . . the words themselves. . ." and ". . . their setting in a text. . ." *Ibid.*

clusive,¹⁵ to the interpretation of the Code resort has been had not only to the Code's own immediate legislative history, as evidenced by the report of the committees of the House and Senate which had proposed it,¹⁶ but also to the prior copyright acts and their history.¹⁷ Moreover, the following reflection of Mr. Justice Frankfurter on reading and construing statutes generally expresses with singular accuracy the judicial approach to the Copyright Code in particular: "If the purpose of [statutory] construction is the ascertainment of meaning, nothing that is logically relevant should be excluded."¹⁸

The Code is the Congress' present means by which fundamental copyright policy sanctioned by the Constitution, as articulated in the so-called copyright clause,¹⁹ is carried out. That clause generates a very broad grant of legislative power symbolized by such key concepts as the promoting of ". . . the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings. . . ." As a corollary, those concepts define the purpose of the Code and fix the dimensions of its valid functioning.

In the following paper it shall be our purpose to consider some of what are believed to be the more critical problems which confront authors and proprietors of copyrightable artistic and literary material, with special reference to the use thereof in composite works, including periodicals.

Taking first things first, chronologically as well as

¹⁵ *Mazer v. Stein*, 347 U.S. 201, 210 (1954).

¹⁶ H. R. REP. NO. 2222, 60th Cong., 2d Sess. 10 (1909). The Senate adopted this report as its own.

¹⁷ *Mazer v. Stein*, 347 U.S. 201 (1954); *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643 (1943).

¹⁸ FRANKFURTER, *op. cit. supra* note 14, at 23. The extent to which the Supreme Court has gone, disdaining "to hug the shores of the statute itself," was indicated, with perhaps no little ostentatious industry, in *Fred Fisher Music Co. v. M. Witmark & Sons*, *supra* note 17, at 658.

¹⁹ U. S. CONST., art. I, § 8, cl. 8.

logically, every copyright inquiry begins with intellectual creation or production, or at least with what passes as such, and with the common law's recognition of "a distinctive literary property" therein, arising instantly from creation or production.²⁰ For the common law the author is considered the primary and crucial man, and authorship the ultimate provenience of rights.²¹ Authorship necessarily implies originality,²² and must manifest itself in some concrete way, such as by means of a definite collocation of words, lines, colors or sounds, before the common law property will attach.²³ However, this is a particular species of hypostatic property in the "work" which exists apart from,²⁴ and is transferable independently of,²⁵ the thing or physical object embodying the work. Such property has been characterized as "ill-defined"²⁶ but various dicta have essayed to define it broadly.²⁷ Briefly and flexibly,

²⁰ This property is said to have been first recognized in "very early times" and although still frequently spoken of as "literary property," due to the accident and "momentum of history," it is no longer limited to literary material. *Werckmeister v. American Lithographic Co.*, 134 Fed. 321, 324 (2d Cir. 1904).

²¹ *Press Pub. Co. v. Monroe*, 73 Fed. 196 (2d Cir. 1896), *appeal dismissed for want of jurisdiction*, 164 U.S. 105 (1896); *Werckmeister v. Springer Lithographing Co.*, 63 Fed. 808 (C.C.S.D.N.Y. 1894); *Parton v. Frang*, 18 Fed. Cas. 1273, No. 10,784 (C.C.D. Mass. 1872); *Palmer v. DeWitt*, 47 N.Y. 532, 7 Am. Rep. 480 (1872).

²² *DeAcosta v. Brown*, 146 F.2d 408 (2d Cir. 1944), *cert. denied*, 325 U.S. 862 (1945); *Fendler v. Morosco*, 253 N.Y. 281, 171 N.E. 56 (1930); *DRONE, THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 110 (1879); *WEIL, LAW OF COPYRIGHT* 116 (1917). Originality in this context, as under the Constitution and the Code, means merely that the work is the author's own, that it "owes its origin" to him and is not "a mere copy of something else." *DRONE, op. cit. supra*, at 110; *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 102 (2d Cir. 1951); *Weil, op. cit. supra*, at 394.

²³ *Werckmeister v. American Lithographic Co.*, *supra* note 20, at 324; *Fendler v. Morosco*, *supra* note 22, at 60.

²⁴ *Stephens v. Cady*, 55 U.S. (14 How.) 528, 530 (1852).

²⁵ *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Werckmeister v. Pierce & Bushnell Manuf'g. Co.*, 63 Fed. 445 (C.C.D. Mass. 1894), *rev'd on other grounds*, 72 Fed. 54 (1st Cir. 1896).

²⁶ *Holmes v. Hurst*, 174 U.S. 82, 84 (1899).

²⁷ In *Harper & Bros. v. M. A. Donohue & Co.*, 144 Fed. 491 (N.D. Ill. 1905), *aff'd per curiam*, 146 Fed. 1023 (7th Cir. 1906) it is described as:

"The sole, exclusive interest, use, and control. The right to its

this common law property is said to be essentially, when conceived of negatively, “. . . a right to exclude, to a greater or lesser extent, others from making some or all use of the expressed thoughts of an author.”²⁸ In its affirmative aspects it includes among its attributes the exclusive right to duplicate and reproduce the work, to effect initial publication of it and to secure statutory copyright to it.²⁹

It is important to bear in mind that the property or right of which we are speaking is a pre-publication one, that is, one which does not survive the authorized publication of the work.³⁰ Once the work is so published,³¹ either

²⁷ *continued*

name, to control, or prevent publication. The right of private exhibition, for criticism or otherwise, reading, representation, and restricted circulation; to copy, and permit others to copy, and to give away a copy; to translate or dramatize the work; to print without publication; to make qualified distribution. The right to make the first publication. The right to sell and assign her interest, either absolutely or conditionally, with or without qualification, limitation, or restriction, territorial or otherwise, by oral or written transfer.” See also, *Parton v. Prang*, 18 Fed. Cas. 1273, 1277, No. 10,784 (C.C.D. Mass. 1872); *Stanley v. Columbia Broadcasting Inc.*, 208 P.2d 9 (Cal. 1949); *WELL*, *op. cit. supra* note 22, at 115.

²⁸ *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 662 (2d Cir. 1955).

²⁹ *Caliga v. Inter-Ocean Newspaper Co.*, 215 U.S. 182 (1909); *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469 (2d Cir. 1951); *Werckmeister v. Springer Lithographing Co.*, 63 Fed. 808 (C.C.S.D.N.Y. 1894); *Yuengling v. Schile*, 12 Fed. 97 (C.C.S.D.N.Y. 1882).

³⁰ *Mazer v. Stein*, 347 U.S. 201, 214 (1954); *Caliga v. Inter-Ocean Newspaper Co.*, 215 U.S. 182, 188 (1909). Distinction is made between a general publication and a limited publication. The former will destroy the common law property; the latter will not affect it. *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Werckmeister v. American Lithographic Co.*, 134 Fed. 321 (2d Cir. 1904).

³¹ That is, in such manner as under decisional law constitutes a “general” publication, one limited neither as to persons nor purposes. *White v. Kimmell*, 193 F.2d 744 (9th Cir. 1952). While the Code mentions “publication” without qualification by providing that: “any person entitled thereto . . . may secure copyright for his work by publication thereof with the notice required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the United States by authority of the copyright proprietor. . . .” 17 U.S.C. § 10, the word “general” has been read into that provision. See also *Henn, Magazine Rights—A Division of Indivisible Copyright*, 40 CORNELL L. Q. 411, 414 n. 12 (1954). However, the dichotomy

the panoply of statutory copyright protects it, if the requirements of the statute as to notice are at least substantially fulfilled,³² or the work passes from the private into the public domain, whence it can never be retrieved.³³

Section 2 of the Code³⁴ does not necessarily sanction or implement, but rather leaves undisturbed,³⁵ such "right" as ". . . the author or proprietor of an unpublished work . . . [has] . . . at common law or in equity, to prevent the . . . [unconsented to] . . . copying, publication, or use of such unpublished work . . . and to obtain damages therefor."³⁶ But that section together with section 10 of the

³¹ *continued*

between general and limited publication can be misleading and its abandonment has been urged. *WEL*, *op. cit. supra* note 22, at 125, since a "limited" publication is really no publication, for copyright purposes, and a "general" publication, for such purposes, may be spelled out by the authorized and unrestricted sale of but a single copy of the work. *Bobbs-Merrill Co. v. Straus*, 147 Fed. 15, 19 (2d Cir. 1906), *aff'd*, 210 U.S. 339 (1908); *Grandma Moses Properties, Inc. v. This Week Magazine*, 117 F. Supp. 348 (S.D.N.Y. 1953); *Joe Mittenenthal, Inc. v. Irving Berlin, Inc.*, 291 Fed. 714 (S.D.N.Y. 1923); *Stern v. Jerome H. Remick & Co.*, 175 Fed. 282 (C.C.S.D.N.Y. 1910); *Baker v. Taylor*, 2 Fed. Cas. 478, No. 782 (C.C.S.D.N.Y. 1848); *WEL*, *op. cit. supra* note 22, at 124.

³² *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947); *Hollywood Jewelry Mfg. Co. v. Dushkin*, 107 U.S.P.Q. 354 (S.D.N.Y. 1955). If copyright under the Code is secured, not a scintilla of the common law property remains, since the two are mutually exclusive. *G. Ricordi & Co. v. Haendler*, 194 F.2d 914 (2d Cir. 1952); *Photo-Drama Motion P. Co. v. Social Uplift Film Corp.*, 220 Fed. 448 (2d Cir. 1915); *Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Pub. Co.*, 155 N.Y. 241, 49 N.E. 872 (1898). *But cf.*, *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 216 F.2d 945 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955), as to non-includible character rights.

³³ *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *American Code Co. v. Bensinger*, 282 Fed. 829 (2d Cir. 1922); *Jewelers' Mercantile Agency, Ltd. v. Jewelers' Weekly Pub. Co.*, note 32 *supra*.

³⁴ 17 U.S.C. § 2 (1952).

³⁵ *Photo-Drama Motion P. Co. v. Social Uplift Film Corp.*, 220 Fed. 448, 450 (2d Cir. 1915).

³⁶ 17 U.S.C. § 2 (1952). Although the Congress, under the copyright clause of the Constitution, U.S. CONST. art. I, § 8, cl. 8, is, I submit, empowered to act substantively with regard not only to published, but also to all kinds of unpublished works (which are "writings"), it has not done so. This § 2 of the Code is the statutory "successor of R.S. § 4967, which was itself the

Code³⁷ show that, except for the historically anomalous right³⁸ accorded by section 12 thereof to certain specifically enumerated unpublished works,³⁹ the statute does not reach unpublished works, and that as to such works the authors or proprietors thereof must look to the common law for protection. Under our "erieantompkinated"⁴⁰ jurisprudence, that is tantamount to saying resort must be had to local or state, as distinguished from federal, law.⁴¹

³⁶ continued

successor of § 9 of the Act of February 3, 1831, 4 STAT. 438, and it is settled that that section only granted a remedy cumulative upon the state remedies and is not the basis of the author's 'common-law property.'" *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657, 666 (2d Cir. 1955) (dissenting opinion by L. Hand, C. J.).

³⁷ 17 U.S.C. § 10 (1952).

³⁸ *Shilkret v. Musicraft Records*, 131 F.2d 929 (2d Cir. 1942), cert. denied, 319 U.S. 742 (1943).

³⁹ 17 U.S.C. § 12 (1952). This section, submittedly for no sound reason, designates only certain kinds of works, as divergent as dramas and photographs or lectures and works of art, and permits claims to copyright for them to be registered if such works have not been reproduced in copies for sale. This section provides the only means within the statutory scheme by which a work may be protected under the Act in advance of its otherwise necessary initial publication. *Patterson v. Century Productions, Inc.*, 93 F.2d 489 (2d Cir. 1937). However, as Professor Chafee has remarked, the section contains specifically "labeled boxes," and, unless the work in question can be pressed into one of them, it is ineligible for protection in its unpublished state. Chafee, *Reflections on the Law of Copyright: I*, 45 COLUM. L. REV. 503, 521 (1945). Works such as novels, short stories, histories, articles and poems are ineligible.

⁴⁰ Clark, *State Law in the Federal Courts*, in JURISPRUDENCE IN ACTION—A PLEADER'S ANTHOLOGY 53, 61 (1953).

⁴¹ By force of *Erie R.R. v. Tompkins*, 304 U.S. 64 (1938). For a neat example not only of the application of the substantive state law of New York to a question of common law property in distinctive performances of musical compositions embodied in phonograph recordings, but also of how a federal court will resolve the usually complicated issue of the conflict of laws in this field "upon principle"—as a matter of general jurisprudence—by applying the substantive law of the forum or place where protection is sought, notwithstanding important contacts elsewhere, see *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657 (2d Cir. 1955). On the choice of law phase, see also *Ferris v. Frohman*, 223 U.S. 424 (1912). The prescription that federal courts should apply state law to matters involving common law literary property does not necessarily make inapposite those decisions rendered by federal courts during the pre-*Erie Railroad* dispensation. On the contrary, those determinations will continue to operate as cogently persuasive guides, and, absent contrary state holdings on the subject, they will control. *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944), cert. denied, 325 U.S. 862 (1945); *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86

Now let us assume that *A*, in the role of a novelist, short story writer or painter,⁴² has created an original work and that he has thereby acquired the property which the common law says he may have in and to it.⁴³ At this juncture, *A* stands in a dual relation to the work: he is both the author and the original proprietor of it. Up to this point none but the dotting eyes of *A*, and perhaps the more objective and therefore less dotting eyes of his wife and choice friends, among whom he has privately circulated it, have seen it. Up to this point the work is unpublished.

Well, what may *A*, our hypothetical author, do next vis-a-vis his work? Of course, he may stow it away or do nothing more extensive with it than heretofore, thus preserving, potentially in perpetuity, his literary property. But if he does only such, we should have done with him (and he with us). However, if he is more mundane-minded and desires to put his "work" to work, so to speak, a number of courses is open to him. Let us follow some of those, noting as we proceed their legal twists,

⁴¹ *continued*

(2d Cir. 1940), *cert. denied*, 311 U.S. 712 (1940). Of course, state courts will do likewise. *Pushman v. New York Graphic Soc., Inc.* 287 N.Y. 302, 39 N.E.2d 249 (1942).

⁴² *A* might have produced any kind of "writing," whether literary, artistic, photographic, dramatic or musical. We have cast *A* as a novelist, short story writer or painter merely by way of illustration. Of course, it should be borne in mind that a "writing" under the common law and also possibly under the copyright clause of the Constitution, may be more inclusive than a "writing" under the Code. *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F.2d 657 (2d Cir. 1955), and the dissent of L. Hand, C.J. at 664; Chafee, *Reflections on the Law of Copyright: II*, 45 COLUM. L. REV. 719, 735 (1945).

⁴³ We are assuming that none of the works in question has been created for hire or in execution of a commission for pay, in which case the common law property in the work would belong to the employer or to the patron or party for whom it had been created. *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28 (2d Cir. 1939); *Brown v. Molle Co.*, 20 F. Supp. 135 (S.D.N.Y. 1937); *Dielman v. White*, 102 Fed. 892 (C.C.D. Mass. 1900). For the same rule governing photographs as when one has his picture taken and pays the photographer for the photograph and for his services in taking it, see *Lumiere v. Robertson-Cole Distributing Corp.*, 280 Fed. 550 (2d Cir.), *cert. denied*, 259 U.S. 583 (1922); *Altman v. New Haven Union Co.*, 254 Fed. 113 (D.C. Conn. 1918).

turns and effects, for we are now virtually at the threshold of statutory copyright.

For one thing, *A* may submit and offer to sell the manuscript of his novel or short story⁴⁴ or the original of his painting to a potential purchaser. Such submission and offer are not tantamount to a publication divestitive of the common law literary property in the work.⁴⁵ Should the offer to sell ripen into an unconditional sale, one without express reservation of rights on *A*'s part, the purchaser will have acquired all of *A*'s common law literary property.⁴⁶ Although *A* may have intended to reserve certain of the rights, if the transfer contains no term or provision expressive of such reservation, the law will generally imply none,⁴⁷ and *A*'s purchaser will, consequently, stand full square in the author's place. The purchaser will have become the proprietor of all of the common law rights in the work, as well as the proprietor of the manuscript or original painting itself.⁴⁸

Suppose the situation is modified so that, instead of assigning by sale or otherwise the manuscript or original work of art without retention of rights, our author splits

⁴⁴ Or the work may be what in magazine publishing trade is called a "one shot"—something usually shorter than a novel but longer than a short story. MARQUAND, *THIRTY YEARS* 144 (1954).

⁴⁵ *Heim v. Universal Pictures Co.*, 154 F.2d 480 (2d Cir. 1946); *Allen v. Walt Disney Productions Ltd.*, 41 F. Supp. 134 (S.D.N.Y. 1941).

⁴⁶ *Yardley v. Houghton Mifflin Co.*, 108 F.2d 28 (2d Cir. 1939); *Grandma Moses Properties, Inc. v. This Week Magazine*, 117 F. Supp. 348 (S.D.N.Y. 1953); *Parton v. Prang*, 18 Fed. Cas. 1273, 1278, No. 10,784 (C.C.D. Mass. 1872); *Pushman v. New York Graphic Soc., Inc.*, 287 N.Y. 302, 39 N.E.2d 249 (1942). *Contra*, *Stephens v. Cady*, 55 U.S. (14 How.) 523, 530 (1852) (dictum).

⁴⁷ *Dam v. Kirk LaShelle Co.*, 175 Fed. 902 (2d Cir. 1910); *Nash v. Alaska Airlines, Inc.*, 94 F. Supp. 428 (S.D.N.Y. 1950). It should be noted, however, that the circumstances of the case may be such as to clearly indicate that the author intended to withhold the common law property, in which event the possession of the manuscript will not carry with it the incidents of that property. *Yardley v. Houghton Mifflin Co.*, *supra* note 46; *Chamberlain v. Feldman*, 300 N.Y. 135, 89 N.E.2d 863 (1949).

⁴⁸ *Werckmeister v. Springer Lithographing Co.*, 63 Fed. 808, 811 (C.C.S.D.N.Y. 1894).

this overall property in two by transferring title to the tangible article or physical object to one and by assigning the incorporeal common law literary property to another, as was done in the *Werckmeister* cases.⁴⁹ When an author so acts, the one to whom all literary property has passed, and not the mere owner of the original thing,⁵⁰ will qualify, qua proprietor or assignee, for statutory copyright under section 9 of the Code.⁵¹

In the foregoing suppositional situations the author parted with *all*, and we emphasize that term, of his literary property,⁵² with the result that he is no longer a legally

⁴⁹ *American Tobacco Co. v. Werckmeister*, 207 U.S. 284 (1907); *Werckmeister v. American Lithographic Co.*, 134 Fed. 321 (2d Cir. 1904); *Werckmeister v. Springer Lithographing Co.*, 63 Fed. 808 (C.C.S.D.N.Y. 1894).

⁵⁰ *Ibid.*; *Yuengling v. Schile*, 12 Fed. 97 (C.C.S.D.N.Y. 1882). However, as to disposition of rights, the "ownership of an unpublished composition presumptively includes all the rights which the common law recognized therein, among them being the privilege of publication and of securing a statutory copyright." *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159, 161 (2d Cir. 1927); *Houghton Mifflin Co. v. Stackpole Sons, Inc.*, 104 F.2d 306 (2d Cir. 1939), *cert. denied*, 308 U.S. 597 (1939).

⁵¹ 17 U.S.C. § 9 (1952); see cases cited in note 49 *supra*. Section 9 of the Code provides, *inter alia*, that "the *author* or *proprietor* of any work made the subject of copyright by this title, or his executors, administrators, or *assigns*, shall have copyright for such work. . . ." (Emphasis added.) Proprietor in this context, is a word of art freighted with historical meaning, indicating one who derives his rights from the author. The term "proprietor" appeared in the first copyright Act of May 31, 1790, c. 15, 1 STAT. 124, and subsequently in each of the major copyrighting acts—Act of April 29, 1802, c. 36, 2 STAT. 171; Act of Feb. 3, 1831, c. 16, 4 STAT. 436; Act of July 8, 1870, c. 230, 16 STAT. 198; Act of March 3, 1891, c. 565, 26 STAT. 1106; and of course, in the Act of March 4, 1909, c. 320, 35 STAT. 1075, 17 U.S.C. §§ 1-30, 101-215 (1952). Beginning with the Act of July 8, 1870, c. 230, 16 STAT. 198, the term has appeared in a substantially similar type of granting clause. Proprietors have ". . . practically . . . the same meaning as 'legal assigns' . . ."—proprietor and assignee becoming legal equivalents—so that one to whom the author's common law property (which includes the author's exclusive right to statutory copyright) has been assigned is the proprietor of the work and entitled to secure copyright to it. *Mifflin v. R. H. White Co.*, 190 U.S. 260, 262 (1903); *Public Ledger v. New York Times*, 275 Fed. 562 (S.D.N.Y. 1921), *aff'd*, 279 Fed. 747 (2d Cir. 1922); *Yuengling v. Schile*, 12 Fed. 97 (C.C.S.D.N.Y. 1882). That the term proprietor has the same significance under the Code as it had under prior law is supported by H. R. REP. No. 2222, 60th Cong. 2d Sess. (1909), where it is said that the first part of § 9 (then § 8) "makes no change in existing law." See HOWELL, *THE COPYRIGHT LAW* 253 (3d ed. 1952).

⁵² This property is probably more extensive than that inhering in statutory copyright inasmuch as no use, not even so-called "fair use," may

significant factor in the copyright picture, having been entirely replaced by the proprietor of that property.⁵³ The proprietor's derivative right to statutory copyright is soundly based, since he is able to trace his rights thereto to the author.⁵⁴ Accordingly, any attempt thereafter by the author to secure such copyright will prove ineffectual.⁵⁵

So far we have concerned ourselves with some of the simpler and more clear-cut relationships in which the legal positions of an author and his nondescript transferee are relatively definite and certain. However, let us now assume that, in lieu of selling or otherwise disposing of his common law property in toto, our author grants only limited and restricted rights in his copyrightable and therefore unpublished material to a publisher of a periodical⁵⁶ or composite work⁵⁷ who, pursuant to such rights,

⁵² *continued*

be made of that to which it attaches. *Stanley v. Columbia Broadcasting System Inc.*, 35 Cal. 2d 653, 221 P.2d 73 (1950); *WELL*, *op. cit. supra* note 22, at 115. Such broad coverage may be rationalized on the ground that, absent publication, there can be no implied consent of the author or his assignee arising therefrom fairly to use the work. This property will pass by testamentary disposition and descend by intestacy.

⁵³ *Werckmeister v. Springer Lithographing Co.*, 63 Fed. 808, 811 (C.C.S.D.N.Y. 1894).

⁵⁴ *Bosselman v. Richardson*, 174 Fed. 622 (2d Cir. 1909); *Kaplan v. Fox Film Corp.*, 19 F. Supp. 780 (S.D.N.Y. 1937).

⁵⁵ *Ripley v. Findlay Galleries, Inc.*, 155 F.2d 955 (7th Cir. 1946), *cert. denied*, 329 U.S. 775 (1946).

⁵⁶ A periodical may be a newspaper or a magazine or other media published at regular intervals. The Code treats periodicals as comprising a separate class of copyrightable works for registration purposes and redundantly speaks of "periodicals, including newspapers." 17 U.S.C. § 5(b) (1952). If a work is published more frequently than annually, it is considered a periodical under Regulation 202.3 of the Regulations of the Copyright Office wherein periodicals are defined as including ". . . newspapers, magazines, reviews and serial publications which appear at intervals of less than a year." If the work for which copyright is claimed under the Code does not possess the requisite periodicity of publication, it may and should be registered as a book. See also *Henn*, *supra* note 31, at 413 n. 11.

⁵⁷ A "composite work" is one "made up of distinct parts or elements. . . ." *MERRIAM-WEBSTER NEW INTERNATIONAL DICTIONARY* 548. It consists of distinguishable "matter drawn from various sources or contributed by different authors." *WELL*, *op. cit. supra* note 22, at 178. The distinctive characteristic of a composite, differentiating it from a "joint work" or from a thematically or textually interdependent or unified work, is that its parts are clearly discrete and readily capable of being used

generally publishes it or a separately copyrightable reproduction or other version of it.⁵⁸ As a point of departure for such discussion, we shall examine two recent statutory copyright infringement cases: *Leigh v. Gerber*,⁵⁹ and *Leigh v. Barnhart*.⁶⁰ These cases, though each a decision of a court of first instance, raise a goodly number of questions of varying nicety and import pertinent to our inquiry. Although different in procedural posture,⁶¹ the last adverted-to cases involve similar basic issues of substantive law, and may, therefore, be considered together.

⁵⁷ *continued*

or are "intended to be used separately and whose only unity is that they are bound together." *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944). See also, *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 221 F.2d 569, 570 (2d Cir. 1955). The Code contains significant references to composite works in 17 U.S.C. §§ 3, 5, 24 (1952). It has been held that the distinguishable components of composite works under the Code, though separately copyrightable, need not be separately authored. *Markham v. A. E. Borden Co.*, 206 F.2d 199 (1st Cir. 1953). While in terms of dictionary semantics, the *Markham* case appears correct in not strictly requiring that the distinct components of a composite work be contributed by different persons, nevertheless, the emphasis for Code purposes has been upon such independently authored contributions as constitutive of a composite. *Shapiro, Bernstein & Co. v. Bryan*, 123 F.2d 697, 699 (2d Cir. 1941). See also the dictum in *Harris v. Coca-Cola Co.*, 73 F.2d 370, 371 (5th Cir. 1934). And such is consonant with the intention of the Congressional Committee Report, H.R. REP. NO. 2222, 60th Cong., 2d Sess. (1909), where it is said relative to § 3 of the Code, that it ". . . does away with the necessity of taking a copyright on the contributions of different persons . . . included in a single publication." HOWELL, *op. cit. supra* note 51, at 263. For certain purposes, composite works and periodicals are considered alike, 17 U.S.C. §§ 3, 24 (1952), but are placed in different classes, the former being classified as a book. 17 U.S.C. § 5 (a) (1952).

⁵⁸ Reproductions of works of art are in a class by themselves, 17 U.S.C. § 5 (h) (1952), and accordingly are, under the statutory pattern, independently copyrightable if original. *Leigh v. Gerber*, 86 F. Supp. 320 (S.D.N.Y. 1949); 37 C.F.R. § 202.9 (Supp. 1955). Similarly, other original versions of copyrighted *literary* works are independently copyrightable as are other original versions of matter in the public domain or of copyrighted matter, 17 U.S.C. §§ 1 (b), 7 (1952). The same work may be copyrightable as a reproduction of a work of art and as another version thereof. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

⁵⁹ 86 F. Supp. 320 (S.D.N.Y. 1949).

⁶⁰ 96 F. Supp. 194 (D.N.J. 1951).

⁶¹ The *Gerber* case, *supra* note 59, was a determination of plaintiff's motion to strike the answer. The *Barnhart* case, *supra* note 60, was a determination after trial.

The material facts of the *Leigh* cases were as follows: The plaintiff, an artist, had produced an original⁶² painting, entitled *Struggle for Existence*, (a title which, incidentally, from the way the cases went, proved more ironically appropriate than the plaintiff had any reason to expect) and registered his claim to copyright in 1948 under then section 11, now section 12, of the Code.⁶³ The original (as distinguished from a copy) of the painting had been marked with plaintiff's copyright notice reading "W. R. Leigh 1947 (c)"; subsequently, he authorized *Parade*, a composite work in the form of a periodical distributed as a newspaper section or supplement, to publish, but only once, a reproduction of the painting. Thereafter, without any specific notice of copyright on the reproduction, *Parade* published the reproduction⁶⁴ in one of its

⁶² Originality, as indicated *supra* in note 22, is, under the Code, not to be confounded with novelty or equated with artistic merit. *Mazer v. Stein*, 347 U.S. 201 (1954); *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955). Since *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239 (1903), the courts have studiously declined to make their own value judgments or to play the part of critics so that even ". . . trivialities having pecuniary value," if original, may enter the house of copyright. *Eggers v. Sun Sales Corp.*, 263 Fed. 373, 375 (2d Cir. 1920). While indispensably necessary by reason of the authorship requirement of the Constitution and of the Code, "originality . . . 'means little more than a prohibition of actual copying.' No matter how poor artistically the 'author's' addition, it is enough if it be his own." *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103, (2d Cir. 1951); *Rushton v. Vitale*, *supra*. Of course, what we have said relative to originality for copyright purposes is not to be taken as any evaluation, and certainly not as a pejorative one, of the qualities of the particular painting now under discussion.

⁶³ 17 U.S.C. §§ 11, 12 (1952).

⁶⁴ We have been advised that the instant reproduction was in the form of a print on paper made from a photo-engraving of the painting. The photo-engraving technique of today, despite its improved tools and the employment of an acid resist in place of the hitherto dexterously operated burin in etching, is still an art demanding a high degree of skilled craftsmanship. That technique usually involves the following eight basic processes or steps: (1) photographing; (2) negative turning or stripping; (3) printing; (4) etching on metal, with copper used rather than zinc for greater color fidelity or tone gradations, and in this step an etching machine is used; (5) routing; (6) blocking; (7) finishing (here hand etching and burnishing take place); (8) proofing. SOUBIRAN, *THE ART & TECHNIQUE OF PHOTO-ENGRAVING* 18 (1952). Engravings, etchings, and prints as finished works (as distinguished from intermediate works) were first made copyrightable by the Act of April 29, 1802, c. 36, 2 STAT. 171. An engraving

copyrighted issues, that is, in an issue which carried in due form and position *Parade's* own general or blanket notice of copyright.⁶⁵ After such publication and without the consent of either the plaintiff or *Parade*, the defendants directly copied that reproduction and published their unauthorized copy in other media, disclaiming both access to and knowledge of the plaintiff's original painting and his copyright to it.⁶⁶ In neither of the cases did the plaintiff prevail, despite the patently deliberate, direct copying of the published reproduction and, perforce, the indirect and pro tanto copying of the original painting.⁶⁷ Should he have prevailed? We submit that he should, although such conclusion is by no means clearly compelled.⁶⁸

Upon analysis of the issues in the *Leigh* cases we find, in the first place, that the plaintiff-artist had availed himself, in an apparently atypical fashion, of section 12 of the

⁶⁴ *continued*

or a print taken from wood is usually called a woodcut. An engraving on metal, or a print made therefrom, is usually called an etching. The designs of such cuts or etchings may be original or derivative. A print may be any pictorial work "printed from something other than the substance on which" it "now appears." *Hills & Co. v. Austrich*, 120 Fed. 862, 863 (C.C.S.D.N.Y. 1903). Under the Code, engravings, etchings and woodcuts are not separately classified in 17 U.S.C. § 5 (1952). Accordingly, such works would appear to fall within class (g) of the section if they are in themselves original works of art; or, if they are derived from other works of art, then within class (h) as reproductions of works of art, provided, in the latter case, they "contain in themselves an artistic element distinct from that of the original work of art which has been" thus "reproduced." Prints together with pictorial illustrations come within class (k) of § 5 which covers "printed pictures, such as lithographs, photo-engravings etc." 37 C.F.R. § 202.12 (Supp. 1955).

⁶⁵ 17 U.S.C. §§ 3, 10, 19, 20 (1952).

⁶⁶ Neither the absence of direct contact with a protected work nor the innocence of the copyist will exonerate unauthorized copying. *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944), *cert. denied*, 325 U.S. 862 (1945). See also, *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191, 198 (1931) on the immateriality of an "intention to infringe."

⁶⁷ The most fundamental of the plurality of exclusive rights inhering in copyright under the Code, 17 U.S.C. §§ 1, 7 (1952), is the copyrightee's right to copy in whole or material part what is original in his work. *Mazer v. Stein*, 347 U.S. 201 (1954).

⁶⁸ These cases have been animadverted upon as unsound. *Henn, Magazine Rights—A division of Indivisible Copyright*, 40 CORNELL L. Q. 411, 459, 460 n. 197 (1954).

Code, which was open to him because of the kind and condition of his work—a work of art “. . . of which copies are not reproduced for sale. . . .”⁶⁹ When he deposited in the Copyright Office “an identifying reproduction” of his painting and registered his claim to copyright in pursuance of that section, he secured a statutory copyright to his work, thereby making the same bargain with the public as he would have made had he published copies of the painting with requisite notice under section 10 of the Code.⁷⁰ In other words, under such quid pro quo theory, the plaintiff exchanged his common law property for the statutory grant.⁷¹ “When the copyright . . .” came “. . . in, the common law right . . .” went “. . . out. . . .”⁷² Even though neither the deposit of the “identifying reproduction,” nor the registration of the claim to copyright, spelled out a publication of the work,⁷³ once such copyright was so secured its initial term began to run,⁷⁴ and this despite the Code’s own timetable providing that “the copyright . . . shall endure for twenty-eight years from the date of *first publication*. . . .”⁷⁵ (Emphasis added.) Furthermore,

⁶⁹ 17 U.S.C. § 12 (1952). This section provides the one method by which certain designated unpublished works may be copyrighted.

⁷⁰ 17 U.S.C. § 10 (1952). This section contains the basic and usual method by which copyright may be obtained to all works copyrightable under the Code. It provides for the investitive publication of works by stating that “any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title. . . .”

⁷¹ *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469 (2d Cir. 1951); *Werckmeister v. Springer Lithographing Co.*, 63 Fed. 808 (C.C.S.D.N.Y. 1894). One of the essential purposes of statutory copyright is to induce an author or proprietor to “bring out” his work, to make it accessible to the public.

⁷² *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 216 F.2d 945, 948 (9th Cir. 1954), *cert. denied*, 348 U.S. 971 (1955); See also, *Photo-Drama Motion Picture Co. v. Social Uplift Film Corp.*, 220 Fed. 448 (2d Cir. 1915).

⁷³ At least not the “publication” contemplated by 17 U.S.C. §§ 10, 13 (1952). Such publication comes about later when the work is “reproduced in copies for sale.” *Patterson v. Century Productions, Inc.*, 93 F.2d 489, 490 (2d Cir. 1937).

⁷⁴ *Marx v. United States*, 96 F.2d 204 (9th Cir. 1938).

⁷⁵ 17 U.S.C. § 24 (1952). See note 74 *supra*.

since a section 12 copyright is not initiated by publication, the plaintiff was not required to affix any notice of copyright either to the original or to the deposited "identifying reproduction"⁷⁶; therefore, his so doing upon the original was a supererogatory act, without legal consequence. Additionally, the erroneously dated notice⁷⁷ which the plaintiff had affixed contained a too-early rather than a too-late date so that, even if such notice had been necessary, the error would have been legally innocuous effecting only a shortening of the copyright term.⁷⁸

So far Mr. Leigh is on firm ground. However, when he thereafter authorized *Parade* to make and publish a reproduction of his painting and *Parade* acted in pursuance of the authorization but without specifically imprinting on the reproduction notice of the plaintiff's copyright, a cluster of questions, particularly perplexing to the probing mind of the court in the *Gerber* case, emerged. On this posture of the cases we should first consider the plaintiff's authorization to make and publish the reproduction. Manifestly, such authorization amounted to no more than a license because *Parade* was permitted to publish only once.⁷⁹ Had the plaintiff granted all reproduction rights

⁷⁶ 17 U.S.C. §§ 10, 19 (1952). See also the dictum in *Patterson v. Century Productions, Inc.*, 93 F.2d 489, 493 (2d Cir. 1937).

⁷⁷ 17 U.S.C. § 19 (1952). This section prescribes the form or content of the notice and does not require any year date for a work of art or for any of the works comprised within subsections (f) to (k) inclusive of 17 U.S.C. § 5 (1952). *Leigh v. Gerber*, 86 F. Supp. 320, 322 (S.D.N.Y. 1949).

⁷⁸ *American Code Co. v. Bensinger*, 282 Fed. 829 (2d Cir. 1922); *Leigh v. Gerber*, 86 F. Supp. 320 (S.D.N.Y. 1949); *Basevi v. Edward O'Toole Co.*, 26 F. Supp. 41 (S.D.N.Y. 1939); *Baker v. Taylor*, 2 Fed. Cas. 478, No. 782 (C.C.S.D.N.Y. 1848). It should be noted, however, that this rule, predicated upon a misdating in favor of the public, creates a lacuna during which there is probably no protection despite the running of the copyright term against the copyrightee. This anomalous situation was considered, in passing, in *Basevi v. Edward O'Toole Co.*, *supra*. Furthermore, if a work is of a "printed literary, musical or dramatic" nature, that is, one for which the Code requires the date of first publication in the prescribed notice, 17 U.S.C. § 19 (1952), the erroneously early date should be maintained in future notices because first publication has been thereby irremediably determined.

⁷⁹ *Public Ledger Co. v. Post Printing & Publishing Co.*, 294 Fed. 430

to his painting, the grant would have been equivalent to an assignment, *Parade* would have become a full-fledged proprietor of the independently copyrightable reproduction⁸⁰ which it had made, and, upon its publication, *Parade's* general copyright in its own name would have satisfied the notice requirements of the Code.⁸¹ A grant of such reproduction rights would have had the same effect if the original painting had not been copyrighted. While it is true that when one deals with statutory copyright he must contend with the consequences of notions of copyright solidity or indivisibility,⁸² especially as they clog matters of copyright notice; nevertheless, since copy-

⁷⁹ *continued*

(8th Cir. 1923); *Leigh v. Barnhart*, 96 F. Supp. 194 (D.N.J. 1951); *Quinn-Brown Pub. Corp. v. Chilton Co.*, 15 F. Supp. 213 (S.D.N.Y. 1936); *M. Witmark & Sons v. Pastime Amusement Co.*, 298 Fed. 470 (E.D.S.C. 1924); *Public Ledger v. New York Times*, 275 Fed. 562 (S.D.N.Y. 1921), *aff'd*, 279 Fed. 747 (2d Cir.), *cert. denied*, 258 U.S. 627 (1922); *New Fiction Pub. Co. v. Star Co.*, 220 Fed. 994 (S.D.N.Y. 1915). The crucial distinction is to be borne in mind between a license of limited rights, on the one hand and an assignment of sufficient rights to include copyright proprietorship on the other hand. See note 51 *supra*. Also HOWELL, *THE COPYRIGHT LAW* 157 (1952). Grants of considerably greater scope than Leigh's to *Parade* have been construed as mere licenses, as the last cited authorities demonstrate.

⁸⁰ 17 U.S.C. § 5(h) (1952). *Leigh v. Gerber*, 86 F. Supp. 320 (S.D.N.Y. 1949); *Home Art, Inc. v. Glensder Textile Corp.*, 81 F. Supp. 551 (S.D.N.Y. 1948). The instant reproduction, submittedly, was more than a mere copy of the painting. Since 1865 photographs have constituted independently copyrightable subject matter. *Altman v. New Haven Union Co.*, 254 Fed. 113 (D. Conn. 1918). On that basis alone this reproduction would appear sufficiently original in a copyright sense, vis-a-vis the painting, to have been likewise copyrightable. Admittedly, there is the inherent ambiguity in the word "reproduction." It may mean: (1) a mere duplicate or visible copy, or (2) a derivative likeness expressed in a different form or embodied in a different medium and possessing more than trivial original qualities distinct from its source. When the latter, it is entitled to its own copyright status. Moreover, by parity of reasoning, *Parade's* reproduction would have been so copyrightable whether considered a print or a variant or other version of a copyrighted work. 17 U.S.C. §§ 5(k), 7 (1952). *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

⁸¹ 17 U.S.C. § 3 (1952). *Mail & Express Co. v. Life Pub. Co.*, 192 Fed. 899 (2d Cir. 1912).

⁸² 17 U.S.C. § 43 (1952). *Henn*, *supra* note 68, at 428; HOWELL, *op. cit. supra* note 79.

right is comprised of separable exclusive rights out of which new copyrightable works may be derived,⁸³ the grant by the copyrightee of all of at least certain of those rights will suffice to constitute the grantee the proprietor of the new copyrightable work and the notice of copyright thereon in the grantee's name will comply with the Code.⁸⁴ However, as we have seen, Mr. Leigh had made no such grant to *Parade*, and the latter accordingly did not become the copyright proprietor of the reproduction. As a mere licensee, *Parade* might have carried a copyright notice in Leigh's name on the reproduction, and to have done so would have been the indubitably correct and prudent course, whether the reproduction be viewed as a work entitled to its own copyright or, a fortiori, as a mere copy of the original painting.⁸⁵

Inasmuch as such course was not followed, the court in the *Barnhart* case held that *Parade*, qua licensee, could not secure a valid copyright to the published reproduction; consequently *Parade's* general copyright did not cover it, and that particular reproduction passed into the public domain.⁸⁶ Thus premised, the court found no infringe-

⁸³ 17 U.S.C. §§ 1(b), 7 (1952).

⁸⁴ *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 139 F.2d 469 (2d Cir. 1951); *Photo-Drama Motion Picture Co. v. Social Uplift Film Corp.*, 220 Fed. 448 (2d Cir. 1915).

⁸⁵ To have done so would have preserved the subsisting copyright to the painting, on the theory that *Parade's* published reproduction was a mere duplicate or copy of the painting. 17 U.S.C. §§ 9, 10, 19 (1952). Furthermore, on the ground that the reproduction of the painting, which could have been validly made and published only with Leigh's consent, 17 U.S.C. § 7 (1952), qualified for a new copyright and since all of the rights thereto, excepting only the right of initial publication, had been retained by Leigh, such new copyright would belong to Leigh, and assuredly might have been initiated by publication of the reproduction and of copies thereof under specific notice in Leigh's name as proprietor. 17 U.S.C. §§ 5, 9, 10, 19 (1952).

⁸⁶ *Leigh v. Barnhart*, 96 F. Supp. 194, 195 (D.N.J. 1951). Without more, a licensee is ineligible for copyright. 17 U.S.C. § 9 (1952); *Mifflin v. R. H. White Co.*, 190 U.S. 260 (1903). See also the cases cited in note 89 *infra*. Despite its implication that the *Parade* reproduction was more than a mere copy of the painting, the rationale in the *Barnhart* case *supra*, failed

ment.⁸⁷ Parenthetically, the court left open whether the loss of copyright to the *Parade* reproduction entailed the forfeiture of plaintiff's copyright to his original painting.⁸⁸

Even though it is settled law that a mere licensee may not take out copyright under the Code,⁸⁹ an author may effectively authorize his licensee to secure copyright in the latter's name.⁹⁰ When copyright is so secured it will be held by the licensee not only to protect his rights thereunder, but also for the benefit, on a trust basis, of the author to protect the latter's ungranted or

⁸⁶ *continued*

to consider the possible application of § 7 of the Code, 17 U.S.C. § 7 (1952). Moreover such rationale should not have completely disregarded § 3 of the Code, 17 U.S.C. § 3 (1952), as will more fully appear hereafter. Compare the *Barnhart* case with approach of *Gerber*, 86 F. Supp. 320 (S.D.N.Y. 1949), relative to § 3 of the Code.

⁸⁷ The logic of the court's determination that copyright to the reproduction was forfeited required such finding even though the reproduction inescapably embodied some of the painting and the court failed to invalidate the copyright to the painting. By way of dictum, the court indicated that even if the published reproduction had been validly copyrighted by *Parade*, there had been no assignment of the reproduction copyright by it to Leigh. There would have been force to that dictum had the ownership of the reproduction copyright been equitably as well as legally in *Parade*. *Bracken v. Rosenthal*, 151 Fed. 136 (C.C.N.D. Ill. 1907); *Champney v. Haag*, 121 Fed. 944 (C.C.E.D. Pa. 1903). In our opinion, however, there was no such coalescing of title. See the analysis in note 85 *supra* and the authorities cited in notes 89 and 90 *infra*.

⁸⁸ If and to the extent that the reproduction was a "copy" of the painting, the failure to imprint upon authorized published copies of the former the copyright notice of the latter, there would be a forfeiture of the copyright to the painting. 17 U.S.C. § 10 (1952); *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951).

⁸⁹ 17 U.S.C. § 9 (1952). *Mifflin v. R. H. White Co.*, 190 U.S. 260 (1903); *Egner v. E. C. Schirmer Music Co.*, 139 F.2d 398 (1st Cir. 1943), *cert. denied*, 322 U.S. 730 (1944); *Public Ledger v. New York Times*, 275 Fed. 562 (S.D.N.Y. 1921), *aff'd*, 279 Fed. 747 (2d Cir.), *cert. denied*, 258 U.S. 627 (1922); *Saake v. Lederer*, 174 Fed. 135 (3d Cir. 1909); *Fraser v. Yack*, 116 Fed. 285 (7th Cir. 1902); *Morse v. Fields*, 127 F. Supp. 63 (S.D.N.Y. 1954); *Leigh v. Barnhart*, 96 F. Supp. 194 (D.N.J. 1951).

⁹⁰ *Bisel v. Ladner*, 1 F.2d 436 (3d Cir. 1924); *Public Ledger Co. v. Post Printing & Publishing Co.*, 294 Fed. 430 (8th Cir. 1923); *T. B. Harms & Francis, Day & Hunter v. Stern*, 229 Fed. 42 (2d Cir. 1916); *Quinn-Brown Pub. Corp. v. Chilton Co.*, 15 F. Supp. 213 (S.D.N.Y. 1936); *WELL, LAW OF COPYRIGHT* 320 (1917). Also, there is the significant intimation in *Mifflin v. R. H. White Co.*, *supra* note 89, at 262, that authority for this purpose, had it been supported by the evidence, would have sustained the copyright there in issue.

reserved rights.⁹¹ Authority for this purpose, that is, to empower and entitle one having but a restricted right of user in a copyrightable work to become the proprietor of the copyright to be obtained, should be firmly grounded in evidentiary fact, else it will not be legally sanctioned.⁹² It will not be inferred from the mere license to use.⁹³ Such actual authority however, from an author,⁹⁴ may be expressly⁹⁵ or impliedly⁹⁶ given. That being so, when found to exist in custom or established trade practice, the requisite authority should be equally efficacious,⁹⁷ absent of course, a provision in the license or conduct to the contrary.⁹⁸ And custom or trade practice of that nature has been judicially recognized.⁹⁹

⁹¹ *Press Pub. Co. v. Falk*, 59 Fed. 324 (C.C.S.D.N.Y. 1894). In *Quinn-Brown Pub. Corp. v. Chilton*, *supra* note 90, at 214, it is said: ". . . there is nothing extraordinary in the owner of a production authorizing another to obtain copyright on it, to be held for joint benefit." See also, *Bisel v. Ladner*, 1 F.2d 436 (3d Cir. 1924); *Brady v. Reliance Motion Picture Corp.*, 229 Fed. 137 (2d Cir. 1916); *Alexander v. Irving Trust Co.*, 132 F. Supp. 364 (S.D.N.Y. 1955); *Cohan v. Richmond*, 19 F. Supp. 771 (S.D.N.Y. 1937), *April Productions, Inc. v. G. Schirmer, Inc.*, 308 N.Y. 366, 126 N.E.2d 283, 289 (1955).

⁹² See note 91 *supra*.

⁹³ *Miffin v. R. H. White Co.*, 190 U.S. 260 (1903); *Leigh v. Barnhart*, 96 F. Supp. 194 (D.N.J. 1951); *Leigh v. Gerber*, 86 F. Supp. 320 (S.D.N.Y. 1949).

⁹⁴ That is, any person or party owning the common law property in the work.

⁹⁵ See note 91 *supra*. Also see, *Morse v. Fields*, 127 F. Supp. 63 (S.D.N.Y. 1954); *Henn*, *supra* note 68, at 433, where the author of this scholarly and encyclopedic article suggests a reconciliation of the cases on the basis of what he calls the "'manifested-intention-to-transfer-the-proprietaryship' test."

⁹⁶ *April Productions, Inc. v. G. Schirmer, Inc.*, 308 N.Y. 366, 126 N.E.2d 283, 289 (1955); *WEIL*, *op. cit. supra* note 90, at 320.

⁹⁷ *April Productions, Inc. v. G. Schirmer, Inc.*, *supra* note 96. *Warner Bros. Pictures, Inc. v. Columbia Broadcasting System, Inc.*, 102 F. Supp. 141, 145 (S.D. Cal. 1951), *aff'd*, 216 F.2d 945 (9th Cir. 1954).

⁹⁸ *Miffin v. R. H. White Co.*, 190 U.S. 260 (1903); *Western Union Tel. Co. v. American Communications Ass'n.*, C.I.O., 299 N.Y. 177, 86 N.E.2d 162 (1949).

⁹⁹ *Kaplan v. Fox Film Corp.*, 19 F. Supp. 780, 781 (S.D.N.Y. 1937); *April Productions, Inc. v. G. Schirmer, Inc.*, 308 N.Y. 366, 126 N.E.2d 283, 289 (1955). The *Schirmer* and *Kaplan* cases involved sheet music and magazine publishing respectively.

It is submitted that, particularly in the field of periodical publishing, it is the custom or established trade practice for authors who contribute their literary or artistic material to those media to authorize the publishers thereof to copyright the contributions in the names of the publishers, usually under blanket or general notices of copyright imprinted on the periodicals,¹⁰⁰ and to hold such copyrights for the authors to the extent that they have retained rights in the contributions.¹⁰¹

The facet of the rule of authority to which we have adverted seems to square with the realities of trade, at least insofar as certain forms of publishing are concerned, and, when given legal effect, the rule will operate to sustain copyrights which might otherwise be lost depending upon the intricacies and dialectical refinements by which licenses and assignments of rights are differentiated. But a note of caution must be interposed: this rule of authority applies only to works still in their common law state, only to matter upon which statutory copyright is to be secured in the first instance. Hence, it should be borne in mind that once copyright attaches, all copies¹⁰² of the work thereafter published in this country by the copyrightee or his

¹⁰⁰ In 17 U.S.C. § 20 (1952), it is provided, *inter alia*, that "one notice of copyright in each volume or in each number of a newspaper or periodical published shall suffice."

¹⁰¹ The writer's submission is predicated upon more than a score of years of legal representation of periodicals. Moreover, recently the writer posed certain questions to what is believed to have been a representative group of magazine and cartoon syndicate editors—nine in number. The substance of the questions asked was: (a) the extent to which authors request publishers to publish contributions under specific copyright notices in the authors' names, and (b) whether it is the established practice in the periodical publishing trade to cover by the periodicals' general copyright the contributions of individual authors rather than to cover them by the authors' own copyrights secured by means of specific notices. The consensus of the responding editors indicated: (a) that authors very infrequently ask for such specific notices and that is why they rarely appear, and (b) that the well-known trade practice, acquiesced in and approved by authors, is to cover and protect the contributions to a periodical by means of general copyright in the publisher's name secured on the whole of the periodical.

¹⁰² Other than those under 17 U.S.C. §§ 3, 7, or 21 (1952).

licensee (or even by the assignee of the copyright)¹⁰³ must carry the notice of copyright in the copyrightee's name—since there can be only one copyright on the same work¹⁰⁴—on pain of forfeiture of the copyright.¹⁰⁵

As we resume our consideration of certain aspects of the *Leigh* cases, we find, and this is passing strange, that no evidence appears to have been adduced by the plaintiff in support of what we take to be the settled trade practice by which *Parade* would have been authorized to copyright the reproduction as a new work.¹⁰⁶ Absent this evidence, it is understandably correct that the courts paid no heed to the practice.¹⁰⁷ Consequently, on that ground no new copyright to the reproduction could be validated. We might observe in passing that, had a good copyright been obtained by *Parade* to the reproduction and had the rights thereunder belonged to *Parade*,¹⁰⁸ such copyright, rather than Leigh's copyright to the painting, would probably have been held to be the only one invaded by the defendant's copying, and *Parade* the only party entitled to sue

¹⁰³ It is only after an assignment of copyright has been recorded that an assignee may substitute his name in the notice. 17 U.S.C. § 32 (1952). A substitution prior to recording renders the notice fatally defective. *Group Publishers, Inc. v. Winchell*, 86 F. Supp. 573 (S.D.N.Y. 1949).

¹⁰⁴ *Adventures in Good Eating, Inc. v. Best Places to Eat, Inc.*, 131 F.2d 809 (7th Cir. 1942); *Markham v. A. E. Borden Co.*, 108 F. Supp. 695 (D. Mass. 1952), *rev'd on other grounds*, 206 F.2d 199 (1st Cir. 1953). As a corollary, if the same copyrightable work is simultaneously first published in two or more separate media, such as newspapers or magazines, it may not be validly covered by the different copyrights to those media; the only safe and sound way to protect such work, whether an advertisement, a syndicated cartoon or comic strip or other matter, is by one copyright to it secured by specific notice of such copyright in the name of the proprietor thereof.

¹⁰⁵ 17 U.S.C. § 10 (1952); *Miffin v. Dutton*, 190 U.S. 265 (1903); *Wrench v. Universal Pictures Co.*, 104 F. Supp. 374 (S.D.N.Y. 1952).

¹⁰⁶ Only on such practice might Leigh have rested because apparently he had not otherwise authorized *Parade* to copyright the reproduction in its name for his benefit.

¹⁰⁷ *Miffin v. R. H. White Co.*, 190 U.S. 260 (1903).

¹⁰⁸ 17 U.S.C. § 101 (1952); *Field v. True Comics, Inc.*, 89 F. Supp. 611 (S.D.N.Y. 1950). Also, an exclusive licensee under copyright may vindicate his rights by suit for infringement by joining the copyright proprietor, and such joinder may be compelled. *Field v. True Comics, Inc.*, *supra*.

for infringement.¹⁰⁹

Now let us turn to sections 3 and 7 of the Code¹¹⁰ to see how they bear upon contributions to composites generally, and incidentally upon the remaining issues of the *Leigh* cases. We shall first consider all of section 3, noting that it deals in part expressly with composite works.

As judicially analyzed and applied, section 3 of the Code serves a retentive or preservative purpose rather than a creative one. Unless that fact is kept clearly in mind, the section can become a snare and a delusion. In its forefront, the section pertains to those components of a copyrighted work which constitute its copyrightable parts, and provides that the copyright to the whole shall protect all such parts. In a formal sense that is but another way of saying that the greater includes the less. However, critical substantive problems remain: has a valid copyright been secured on the work, and if so, which of the component parts are copyrightable under it? The section

¹⁰⁹ *McDaniel v. Friedman*, 98 F.2d 745 (7th Cir. 1938); *Champney v. Haag*, 121 Fed. 944 (C.C.E.D. Pa. 1903). DRONE, *THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 483 (1879). But the same act, we submit, might have actionably infringed both copyrights if what had been distinctively covered by each ("original" material) had thereby been tortiously copied; to the extent that the reproduction "reproduced," i.e., copied, the painting, the copyright to the painting would have been infringed.

¹¹⁰ 17 U.S.C. § 3 (1952), provides:

"The copyright provided by this title shall protect all the copyrightable component parts of the work copyrighted, and all matter therein in which copyright is already subsisting, but without extending the duration or scope of such copyright. The copyright upon composite works or periodicals shall give to the proprietor thereof all the rights in respect thereto which he would have if each part were individually copyrighted under this title."

17 U.S.C. § 7 (1952), provides:

"Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the copyright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works."

supplies no answer to these problems.¹¹¹ But if it be assumed that a good copyright to the whole has been obtained, then that *one* general copyright will be spread so as to copyright all those parts capable of being copyrighted and of which the work is composed.¹¹² Manifestly, that does not mean that every part is so covered because a work may contain parts which by their inherent nature are unentitled to copyright status,¹¹³ or parts which are in the public domain¹¹⁴ or which rest under copyright belonging to some one other than the proprietor of the copyright to the whole.¹¹⁵

In so spreading the copyright, the forepart of the section speaks of "component" rather than "constituent" parts, and while there is perhaps a nuance of difference between the precise dictionary meanings of those terms,¹¹⁶ it is believed that the phrase "component parts" in this context was intended to signify constituent or integral parts of the whole; otherwise, we think, the afterpart of the section becomes somewhat superfluous.¹¹⁷ Admittedly, however, the cases have not clearly distinguished the two

¹¹¹ *Eggers v. Sun Sales Corp.*, 263 Fed. 373 (2d Cir. 1920).

¹¹² In this manner the section seems merely to be declaratory of prior law, especially if the parts are interrelated. *DRONE*, *op. cit. supra* note 109, at 144. See also, *Dymow v. Bolton*, 11 F.2d 690 (2d Cir. 1926); *King Features Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924).

¹¹³ *Dorsey v. Old Surety Life Ins. Co.*, 98 F.2d 872 (10th Cir. 1938). A mere copy lacking as it does any originality is so unentitled: *Markham v. A. E. Borden Co.*, 108 F. Supp. 695, 701 (D. Mass. 1952), *rev'd on other grounds*, 206 F.2d 199 (1st Cir. 1953). See also, *HOWELL, THE COPYRIGHT LAW* 43 (3d ed. 1952).

¹¹⁴ 17 U.S.C. § 8 (1952). See also, H.R. REP. No. 2222, 6th Cong., 2d Sess. (1909); *HOWELL, op. cit. supra* note 113, at 202.

¹¹⁵ 17 U.S.C. § 3 (1952). But this section specifically provides that ". . . all matter therein in which copyright is already subsisting . . ." shall be protected, that is, preserved, note 110 *supra*.

¹¹⁶ "COMPONENT, CONSTITUENT, INGREDIENT, ELEMENT . . . CONSTITUENT . . . so far as it differs from COMPONENT (with which it is often exactly synonymous), connotes . . . the essential or formative character of the parts. . . ." *MERRIAM-WEBSTER INTERNATIONAL DICTIONARY* 547 (2d ed. 1934).

¹¹⁷ A construction of the Code which renders parts thereof mere superfluities is not favored. *Corcoran v. Montgomery Ward & Co.*, 121 F.2d 572, 573 (9th Cir. 1941).

parts of the section in this respect, and have read the phrase "component parts" into the composite works provisions of the section, in which latter provisions little or no interdependence or interrelation of parts is generally found or required.¹¹⁸

Also, within the forefront of section 3 is the clause, highly significant to our discussion, that the *one copyright* duly secured on the whole of the work will preserve under its subsisting copyright whatever matter of that nature is contained within the work.¹¹⁹ By virtue of that saving clause, the notice of subsisting copyright need not be affixed to the included matter, as it would but for the clause.¹²⁰

The instant saving clause of section 3, we submit, should have been applied in the *Barnhart* case¹²¹ to the *Parade* reproduction in order to preserve and vindicate the pre-existing copyright to the painting, although to have done so would have required Leigh to forego any new copyright to the reproduction. He had the right to so waive, thus escaping a dilemma. On the basis that *Parade's* licensed reproduction was a copy of the painting, as, of course, it was in certain significant respects, *Parade's* general copyright (concededly valid for a composite work) would have protected the copyrighted painting,¹²² and the defendants' unlawful copying of that copy would have been tantamount to the tortious copying of the painting.¹²³

¹¹⁸ *Markham v. A. E. Borden Co.*, 206 F.2d 199 (1st Cir. 1953); *King Features Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924); *Harry Alter Co. v. A. E. Borden Co.*, 121 F. Supp. 1941 (D. Mass. 1954).

¹¹⁹ See note 110 *supra*.

¹²⁰ If there is no interdependence of parts then each part should carry its own notice. *Patterson v. Century Productions, Inc.*, 93 F.2d 489 (2d Cir. 1937). Furthermore, if the work as a whole is not published with due notice of copyright, the included matter will not be protected. *Sieff v. Continental Auto Supply, Inc.*, 39 F. Supp. 683 (D. Minn. 1941).

¹²¹ 96 F. Supp. 194 (D.N.J. 1951).

¹²² See note 110 *supra*. *Henn, Magazine Rights—A Division of Indivisible Copyright*, 40 CORNELL L. Q. 460 n. 179 (1954).

¹²³ *De Acosta v. Brown*, 146 F.2d 408 (2d Cir. 1944).

We shall now examine the afterpart of section 3.¹²⁴ This part provides essentially a rule of convenience and economy whereby multiple specific copyright notices may, under certain circumstances, be dispensed with as to the copyrightable and distinguishable parts or elements making up a composite work or periodical. We have indicated that such parts or elements may be entirely unrelated one to another and such discreteness is usually the distinctive feature of a composite.¹²⁵ As the result of such separateness, specific notices would ordinarily be required.¹²⁶ However, by operation of the instant provisions, such specific notices may be omitted. But, and this is of overriding importance, the general copyright of the composite or periodical proprietor will only protect that which he can properly copyright.¹²⁷ Clearly, a proprietor can thereby copyright his original selection, ordering or arrangement of the composite or periodical as a whole.¹²⁸ He may also thereby effectively copyright those parts of which he is the author or the copyright proprietor.¹²⁹ However, section 3 does not change the rule that a general copyright on a composite work or periodical, secured by the work's proprietor, will not validly protect those parts with regard to which the proprietor is a mere licensee,¹³⁰ absent the requisite authority heretofore discussed.¹³¹ Hence, the

¹²⁴ See note 110 *supra*.

¹²⁵ See note 57 *supra*.

¹²⁶ *Patterson v. Century Productions, Inc.*, 93 F.2d 489 (2d Cir. 1937). *Contra*, *Ford v. Charles E. Blaney Amusement Co.*, 148 Fed. 642 (C.C.S.D. N.Y. 1906). That the afterpart of § 3 was designed to obviate this necessity as to independent contributions is shown by the commentary in H.R. REP. NO. 2222, cited and quoted in note 57 *supra*.

¹²⁷ WEIL, *LAW OF COPYRIGHT* 179 (1917).

¹²⁸ *Ibid.* *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir. 1926).

¹²⁹ *Dam v. Kirk La Shelle Co.*, 175 Fed. 902 (2d Cir. 1910); *Ford v. Charles E. Blaney Amusement Co.*, 148 Fed. 642 (C.C.S.D.N.Y. 1906).

¹³⁰ *Mail & Express Co. v. Life Pub. Co.*, 192 Fed. 899 (2d Cir. 1912); *Morse v. Fields*, 127 F. Supp. 63 (S.D.N.Y. 1954); *Kaplan v. Fox Film Corp.*, 19 F. Supp. 780 (S.D.N.Y. 1937). See also other cases cited in note 89 *supra*.

¹³¹ See notes 90-101 *supra*.

mere inclusion of copyrightable matter in a copyrighted composite or periodical does not necessarily mean that such matter rests safely under copyright.

Grant that a general copyright in the publisher's name has been secured upon a composite work or periodical and that such copyright will suffice to protect the parts of the work including those independently contributed. In such case, the composite works portion of section 3, as well as the component parts portion thereof, provides for the expansion of the one general copyright to each part,¹³² it does not, however, pluralize copyrights into as many separate ones as there are distinguishable parts.¹³³ The *Markham* case¹³⁴ in effect works such pluralization,¹³⁵ and in that regard we question its soundness.

Inasmuch as section 7 of the Code is, in certain particulars, germane to our central subject we shall limit our consideration of it to those respects. Preliminarily, it is to be noted that that section in part "reenacts existing law,"¹³⁶ but to an extent was intended to mark a departure therefrom by permitting "the copyrighting of abridge-

¹³² See note 110 *supra*. Copyrightable matter on a front cover of a periodical is a part of the periodical, and the general copyright should extend to such matter. *Conde Nast Publications, Inc. v. Vogue School of Fashion Modelling, Inc.*, 105 F. Supp. 325 (S.D.N.Y. 1952); *Kaplan v. Fox Film Corp.*, note 130 *supra*. *Contra*, *Fawcett Publications, Inc. v. Elliot Pub. Co.*, 46 F. Supp. 717 (S.D.N.Y. 1942).

¹³³ 17 U.S.C. § 3 (1952), quoted in full in note 110 *supra*. *Alter Co. v. A. E. Borden Co.*, 121 F. Supp. 941 (D. Mass. 1954). But the copyright to each separate work, such as a story or article, included within a periodical or composite and published under a general notice may be separately assigned. *Kaplan v. Fox Film Corp.*, 19 F. Supp. 780 (S.D.N.Y. 1937). And this could have been done under prior law. *Dam v. Kirk La Shelle Co.*, 175 Fed. 902 (2d Cir. 1910).

¹³⁴ *Markham v. A. E. Borden Co.*, 206 F.2d 199 (1st Cir. 1953).

¹³⁵ By treating each separate unit or item of a composite, rather than the one copyrighted whole, as the framework within which to measure materiality for infringement purposes. In that respect, the logic of the *Markham* rule seems to accord greater protection, improperly we believe, to a composite work, such as a trade catalogue, than to a novel or other thematically interdependent work.

¹³⁶ H. R. REP. No. 2222, 60th Cong. 2d Sess. (1909) on § 7 (then § 6) of the Code. HOWELL, *op. cit. supra* note 113 at 202.

ments and new versions of works, or works republished with new matter,"¹³⁷ without, however, enlarging or otherwise affecting ". . . the force or validity of any subsisting copyright upon matter employed . . ." in the new works contemplated by the section.¹³⁸

In operation the last mentioned section proliferates copyrights in that it treats the derivative works and the so-called new matter republications specified therein as subject to new copyright status. However, to justify the new copyrights, the consent of the subsisting copyrightee must be obtained,¹³⁹ and the new works must possess a requisite minimum degree of originality.¹⁴⁰ As a corollary,

¹³⁷ H.R. REP. No. 2222, *supra* note 136. That so-called "fair abridgements" had been earlier held not to constitute infringements of the copyrights to the abridged works, see Henn, *supra* note 122, at 425 n. 67. Furthermore, under prior law a substantially altered or revised edition or version of a previously copyrighted work was entitled to a new copyright, and upon publication of such edition or version the only notice of copyright entry called for was that of the new copyright. *West Pub. Co. v. Edward Thompson Co.*, 176 Fed. 833 (2d Cir. 1910).

¹³⁸ 17 U.S.C. § 7 (1952). See note 110 *supra*.

¹³⁹ Unless the source matter or the republished matter is in the public domain. Apart from the consent of the copyright proprietor needed to avoid infringement, it is submitted that such consent is required under the section when copyrighted matter is republished with new matter, although the section's literal wording does not so require.

¹⁴⁰ 17 U.S.C. § 9 (1952). *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469 (2d Cir.), *cert. denied*, 342 U.S. 849 (1951); *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F.2d 159 (2d Cir. 1927); *McCaleb v. Fox Film Corp.*, 299 Fed. 48 (5th Cir. 1924); *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 Fed. 83 (2d Cir.), *cert. denied*, 259 U.S. 581 (1922); *West Pub. Co. v. Edward Thompson Co.*, 176 Fed. 833 (2d Cir. 1910). See also notes 22 and 62 *supra*; HOWELL, *op. cit. supra* note 113, at 67; WEIL, *LAW OF COPYRIGHT* 178 (1917). The definite trend has been toward a less exacting kind and degree of originality necessary to support copyright. Whereas under prior law "mere improvements," such as alto parts added to songs the copyrights to which had expired, were held insufficiently original, *Cooper v. James*, 213 Fed. 871 (N.D. Ga. 1914), under the Code, additions or variations which are merely "distinguishable," or not ". . . too trivial to be noticeable by an ordinarily attentive reader or observer . . ." will satisfy the need for originality. *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, *supra* at 600. In determining whether a work qualifies for copyright under the instant section, it will not be disqualified merely because it is so similar to its copyrighted source as to be an infringement, absent the consent of the proprietor of the copyright to that source. *Ibid.*

the scope of the new copyrights thus engendered is to be limited to that which is original in the new works.¹⁴¹

Of the works which lie within the ambit of section 7, we need to be concerned only with compilations,¹⁴² new versions¹⁴³ and new matter republications.¹⁴⁴ When a proprietor of a copyrighted work contributes all or a part of it to a copyrightable composite, in the nature of a compilation or a new matter republication, or for the making of another copyrightable version of it, of what should he be especially wary? Quite obviously, prudence will dictate that he be assured that his copyright be maintained. To achieve that end, the proprietor may require that his contribution, if identifiable as published in the compilation, new matter republication or other version form, have affixed to it notice of his pre-existing copyright.¹⁴⁵ But the carrying of this specific notice may be impracticable, and, under this section, to do so is not necessary. As judicially construed, the section in question will operate to

¹⁴¹ *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, *supra* note 140; *G. Ricordi & Co. v. Paramount Pictures, Inc.*, *supra* note 140. Consequently, the duration of the new copyright neither affects nor is affected by the term of copyright to the basic work. *G. Ricordi & Co. v. Paramount Pictures, Inc.*, *supra*.

¹⁴² These will generally be composite works, and if not "mere aggregates" of other matter but evince some "originality" in the selecting or combining of compiled material, they will be copyrightable. *Hartfield v. Peterson*, 91 F.2d 998 (2d Cir. 1937); *Edwards & Deutsch Lithographing Co. v. Boorman*, 15 F.2d 35 (7th Cir. 1926). Moreover, since the copyrightee of a work has the exclusive right to make compilations of it, if another so compiles without his consent, despite the absence of copying, an infringement will be spelled out. *National Geographic Soc. v. Classified Geographic, Inc.*, 27 F. Supp. 655 (D. Mass. 1939).

¹⁴³ It is not clear, at least in an affirmative sense, just what is meant by "another version" under the Code. *Corcoran v. Montgomery Ward & Co.*, 121 F.2d 572 (9th Cir. 1941). Brief outlines or summaries of copyrighted operatic librettos have been held not to be infringing versions, *G. Ricordi & Co. v. Mason*, 210 Fed. 277 (2d Cir. 1913); but "mezzotints"—a form of metal engraving—of public domain matter have been considered to be "other versions" of such matter and entitled to copyright under § 7. *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

¹⁴⁴ *Markham v. A. E. Borden Co.*, 108 F. Supp. 695 (D. Mass. 1952), *rev'd on other grounds*, 206 F.2d 199 (1st Cir. 1953); *Wrench v. Universal Pictures Co.*, 104 F. Supp. 374 (S.D.N.Y. 1952).

¹⁴⁵ 17 U.S.C. § 10 (1952). *Miffin v. Dutton*, 190 U.S. 265 (1903).

protect the subsisting copyright under a valid general copyright to the new work, and such protection will be accomplished by means of the *one* blanket notice of copyright duly appearing on the copies of the new work.¹⁴⁶ If the last mentioned course is to be followed, then, in order to negative what would otherwise be the adverse consequences of the failure to secure a good general copyright on the new work,¹⁴⁷ the proprietor of the copyright to the contribution should condition his license to use it by the requirement that the compiler, other versioner or new matter republisher attach to the contribution the copyright notice prescribed by law.¹⁴⁸

Might Mr. Leigh have availed himself of the protective efficacy of section 7? We think not, albeit the issue of *Parade* was duly copyrighted and the reproduction contained therein regarded as a new version. What we have hitherto said militating against a valid reproduction-copyright applies to a new version one under section 7. Furthermore, since Leigh's painting had not been "pub-

¹⁴⁶ *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *Adventures in Good Eating, Inc. v. Best Places To Eat, Inc.*, 131 F.2d 809 (7th Cir. 1942); *West Pub. Co. v. Edward Thompson Co.*, 176 Fed. 833 (2d Cir. 1910); *Wrench v. Universal Pictures Co.*, 104 F. Supp. 374 (S.D.N.Y. 1952). *N.B.*, unless the new work is properly copyrighted, as by publication with due notice of its own copyright, the subsisting copyright on the employed or included matter will not be sustained, notwithstanding the provision in the section that ". . . the publication of any such new works shall not affect the force or validity of . . ." that copyright. 17 U.S.C. § 7 (1952); *Sieff v. Continental Auto Supply, Inc.*, 39 F. Supp. 683 (D. Minn. 1941). Dictum to the contrary in *Siewek Tool Co. v. Morton*, 128 F. Supp. 71, 74 (E.D. Mich. 1954), submittedly, is wrong as at variance with the Code's underlying principle that the public be given a notice of copyright. 17 U.S.C. §§ 10, 21 (1952).

¹⁴⁷ See note 146 *supra*. But see, *DRONE, THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 271 (1879).

¹⁴⁸ This does not mean that a specific notice must be attached, in the sense of juxtaposed, to the published copy of the contribution, if a general notice in the name of the proprietor of the new-work-copyright is properly applied to that work. But the conditioning will prevent the copyright to the contribution from being forfeited, absent such general and specific notices. *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *American Press Ass'n v. Daily Story Pub. Co.*, 120 Fed. 766 (7th Cir. 1902).

lished," *Parade's* copy of it did not constitute, we submit, republished matter; accordingly, the issue of *Parade* did not qualify in that regard as a new matter republication.¹⁴⁹

Before closing the instant discussion, we wish to make a few observations on the subject of the renewal of copyrights in contributions to composite works and periodicals.¹⁵⁰ Renewal of a copyright is provided for in section 24 of the Code where those who may renew, and the order in which they may renew, are specifically designated.¹⁵¹ Under that section, one who is the proprietor of the copyright to a periodical or other composite work originally secured by the proprietor of the work, may renew such copyright. The section further states, by way of proviso, ". . . that in the case of any other copyrighted work, including a contribution by an individual author to a periodical or . . . other composite work, the author of such work . . . shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years. . . ."¹⁵² Prior to the amendment of 1940¹⁵³ the quoted proviso had included the phrase ". . . when such contribution has been separately reg-

¹⁴⁹ 17 U.S.C. § 7 (1952). We are not unmindful of the fact that courts have variously construed, on a *pro hac vice* basis, the term "published" as it appears in the Code; nevertheless, there is, and we believe there was deliberately intended to be, a distinction between the publication and republication of a work under the Code. 17 U.S.C. §§ 7, 8 (1952). *Edward B. Marks Music Corp. v. Continental Record Co.*, 222 F.2d 488, 491 (2d Cir. 1955). But see, Henn, *supra* note 122, at 460.

¹⁵⁰ The general subject of renewal copyrights has been ably treated in Bricker, *Renewal and Extension of Copyright*, 29 So. CALIF. L. REV. 23 (1955), and also in Note, 44 COLUM. L. REV. 712 (1944).

¹⁵¹ 17 U.S.C. § 24 (1952). Renewal copyright is not a mere incident of original copyright but supplementary thereto. *Harris v. Coca-Cola Co.*, 73 F.2d 370, 371 (5th Cir. 1934), *cert. denied*, 294 U.S. 709 (1935). And ". . . a copyright renewal creates a new estate . . . [which] is clear of all rights; interests or licenses granted under the original copyright." *G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F.2d 469, 471 (2d Cir. 1951), *cert. denied*, 342 U.S. 849 (1951).

¹⁵² 17 U.S.C. § 24 (1952).

¹⁵³ Act of March 15, 1940, c. 57, 54 STAT. 51.

istered . . ." immediately following the words "composite work."

In view of the above referred-to renewal provisions, will a renewal of the copyright to a periodical or other composite work by the proprietor of the original copyright effect a renewal of the original copyrights to the independently authored contributions to the periodical or composite work? We submit that it will not, unless the proprietor of the original copyright to the periodical or composite is otherwise and specifically entitled to the renewal copyrights in those contributions.¹⁵⁴

In conclusion, despite the persistence of certain difficulties, is it noteworthy that the clearly perceptible trend has been toward the enlargement of copyrightable subject matter and the avoidance of overstrictness in construing the Code.¹⁵⁵ And that is as it should be. While some will always create because, like Beaudelaire, they "burn to paint," men in general need and should have the economic encouragement that copyright affords — encouragement which serves both public and private interest. At least such is the faith of our Constitution and the Code.¹⁵⁶

*Alfred H. Wasserstrom**

¹⁵⁴ It is doubted that the proprietor of the original copyright to the composite or periodical, qua such proprietor, could have done so prior to the said amendment. *Contra*, *Harris v. Coca-Cola Co.*, 73 F.2d 370, 371 (5th Cir. 1934), *cert. denied*, 294 U.S. 709 (1935). However that may be, the amendment laid such doubt to rest, so that now such proprietor may not properly renew for that purpose. Moreover there is the rule that rights to renewal copyright, as distinct from those to original copyright, will not be included within a grant of the latter unless therein specifically provided for. *Fred Fisher Music Co. v. M. Witmark & Sons*, 318 U.S. 643 (1943); *Edward B. Marks Music Corp. v. Borst Music Pub. Co.*, 110 F. Supp. 913 (D.N.J. 1953). That rule tends to support, we submit, the position that the renewal of the copyright to a periodical or composite by the proprietor thereof, nearly as such proprietor, did not before the 1940 amendment, nor will it thereafter, secure any renewal copyrights to the independent contributions.

¹⁵⁵ *Mazer v. Stein*, 347 U.S. 201 (1954); *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30 (1939); *Rushton v. Vitale*, 218 F.2d 434 (2d Cir. 1955); *National Comics Publications, Inc. v. Fawcett Publications, Inc.*, 191 F.2d 594 (2d Cir. 1951); *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161

155 *continued*

F.2d 406 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947); Trifari, Krussman & Fishel, Inc. v. Charel Co., 134 F. Supp. 551 (S.D.N.Y. 1955).

156 *Mazer v. Stein*, *supra* note 155, at 219 where it is said:

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

*Member of the firm of McCauley & Henry, New York City, N.Y. General Counsel to the Hearst newspapers and magazines. Author of articles in the field of Copyright Law. Member of the Board of Trustees and Executive Committee of the Copyright Society of the United States. B.S. 1930 University of Virginia; LL.B. 1933 Columbia University; LL.M. 1956 New York University.