



5-1-1941

Extent of Copyright Protection for Advertising

John E. Savord

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



Part of the [Law Commons](#)

Recommended Citation

John E. Savord, *Extent of Copyright Protection for Advertising*, 16 Notre Dame L. Rev. 298 (1941).

Available at: <http://scholarship.law.nd.edu/ndlr/vol16/iss4/2>

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 EXTENT OF COPYRIGHT PROTECTION FOR ADVERTISING

Dictatorship? Not in the American government! But everyday American consumers are more and more directed to the goods they purchase by signs, slogans, and advertisements. In many cases, the tradenames of the most widely advertised products have erased from the minds of all the actual name of the product. Who, for instance, does not have to think twice before he can state the real names of some of our popular beverages or well known bathing suits? One portion of the questionable heritage left us by the "Roaring Twenties" was the rise from the day of the sign painter to the era of the commercial artist. In 1940 alone, there were forty-four business concerns which spent more than a million dollars apiece for advertisements in magazines, farm papers, and on the radio.¹ The pressure of business competition has found a new outlet in this field, and in turn such advertising has become the support of our magazines² and newspapers, and looked to to provide the bulk of the entertainment on our radios.

With the growth of advertising into an institution of economic importance, the problem has arisen as to how to protect the works of those who bid the consumers to use the soap that floats or to eat the foods of the fifty-seven varieties. The United States Congress has been empowered by the Constitution:

"To promote the Progress of Science and useful arts, by securing for limited Times To Authors and Inventors the exclusive Right to their respective Writings and Discoveries."³

With this as a basis for the granting of copyrights, legislation has been acted upon from time to time since 1790, our

¹ NEW YORK TIMES, January 30, 1941.

² One widely read weekly collected \$27,000,000 in advertising fees in 1940. BUSINESS WEEK, January 18, 1941.

³ U. S. Constitution, Art. I, § 8, cl. 8.

present copyright act being embodied as Title 17 of The United States Code and its amendments.⁴ There is no word in the statute itself as to the copyrightability of advertising material.⁵ Very little text matter has been written on the subject, and a search for a means of protection for advertisers must be directed to the cases. It is the purpose of this paper to analyze the decisions in which the copyright act has been applied to advertisers so as to provide a "jumping off" place for those seeking information on this subject.

I.

Prior to the decision of the United States Supreme Court in the case of *Bleistein v. Donaldson Lithographing Co.*,⁶ it was the tendency of the courts to hold that advertising matter could not be the subject of a copyright. The early American judges were of the opinion that advertisements possessed neither the originality nor the artistic element necessary for a copyright.⁷ The earliest American case, that of *Collender v. Griffith*,⁸ denied the validity of a copyright on engravings of billiard tables offered for sale. The engravings were declared not to be works of art nor prints having any

⁴ The present copyright act was enacted in 1909.

⁵ 17 U. S. C. A. § 5, reading:

"The application for registration shall specify to which of the following classes the work in which copyright is claimed belongs:

- a. Books, including composite and cyclopedic works, directories, gazetteers, and other compilations;
- b. Periodicals, including newspapers;
- c. Lectures, sermons, addresses (prepared for oral delivery);
- d. Dramatic or dramatico-musical compositions;
- e. Musical compositions;
- f. Maps;
- g. Works of art; models or designs for works of art;
- h. Reproductions of a work of art;
- i. Drawings or plastic works of a scientific or technical character;
- j. Photographs;
- k. Prints and pictorial illustrations;
- l. Motion-picture photoplays;
- m. Motion pictures other than photoplays;

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

⁶ 188 U. S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1903).

⁷ 18 C. J. S. 138.

⁸ 11 Blatchf. 212, Fed. Cases 3000 (D. C., N. Y., 1873).

value or use as such. "It is a mere copy of what the complainant has patented as a design, and constitutes the mode in which the complainant advertises his tables."

Whether the familiar chart exhibiting the colors of various paints could be the subject of a copyright was the question in *Ehret v. Pierce*.⁹ Plaintiff sought to restrain defendant from publishing a certain form of advertising cards devised for the purpose of displaying paints of various colors, upon the ground that it infringed upon his copyright. The subject of his copyright consisted of a sheet of paper, painted in various colors, each square having a different color, and each being numbered. The squares were surrounded by lithographic work in the nature of advertising. The court denied that this chart could be the subject of a copyright, being neither a book, map, chart (referring to a form of a map), print, cut, nor engraving, as required by the Act of 1831.¹⁰ It was said:

"True, it has lithographic work upon it, and also words and sentences; but it has none of the characteristics of a work of art, or of a literary production. It is an advertisement, and nothing more. Aside from its function as an advertisement of the Morris paints, it has no value."

A manufacturer of church furniture was denied a copyright on a book of engravings illustrating his goods, and containing a price list thereof.¹¹ The court said that the book was published for trade purposes in aid of sales, but that a different question would have been presented if it could have been shown that the books had a value independent of their use as advertisements.

The Supreme Court of the United States had occasion to pass on this question in *Higgins v. Keuffel*.¹² Mr. Justice Field, in declaring that a label on an ink bottle, describing

⁹ 18 Blatchf. 302, 10 F. 553 (D. C., N. Y., 1880).

¹⁰ 4 U. S. St. at L. 436.

¹¹ *Lamb v. Grand Rapids School Furniture Co.*, 39 F. 474 (D. C., Mich., 1889).

¹² 140 U. S. 428, 11 S. Ct. 732, 35 L. Ed. 470 (1891).

the ink as "waterproof drawing ink," was not copyrightable, wrote:

"To be entitled to a copyright, the article must have by itself some value as a composition, at least to the extent of serving some purpose other than as a mere advertisement or designation of the subject to which it is attached."

The last in the line of cases flatly denying advertisements to be proper subjects for copyright was that of *Mott Iron Works v. Clow*.¹³ The publication under consideration was a circular showing the products of a manufacturer of bathroom appliances of a useful or ornamental nature. It was concluded that:

"They (illustrations of plumbing ware offered for sale) are mere advertisements of appellant's wares, with nice cuts or illustrations of the goods accompanying and forming part of the advertisement, as an allurements to customers. The question, therefore, which confronts us, is, were such things intended to be protected by the constitutional provision in question? The object of that provision was to promote the dissemination of learning, by inducing intellectual labor in works which would promote the general knowledge in science and the useful arts. It is not designed as a protection to traders, in the particular manner in which they might shout their wares. It sought to stimulate original investigation, whether in literature, science or art, for the betterment of the people."

These decisions are treated at such great length in order to give the reader a fair view of the early thoughts of the American jurists on the question of copyrighting advertising material. Ever fearful of decisions that might be construed as the basis of something undesirable at a later date, the judges were very hesitant about recognizing the possibilities of art and skill as embodied in advertisements.

But with the growth of American business, and the resulting stimulus to greater and more artistic advertising, there appeared in the two decades preceding the *Bleistein* case¹⁴ scattered decisions attempting to break from the cases holding that advertisements were not subject to copy-

¹³ 82 F. 316 (C. C. A., 1897).

¹⁴ *Supra*, note 6.

right. The first American case on this new tangent was that of *Yuengling v. Schile*.¹⁵ There the plaintiff, a lager-beer brewer, sought to protect a chromo, in the center of which was a conspicuous figure of King Gambrinus,¹⁶ his left arm resting upon a keg of lager, and his right holding aloft a foaming glass of that beverage. On either side of him were a dozen figures of persons representing various classes in life, into whose eager hands his page was distributing the drink. After listening to plaintiff's contention that he intended to distribute these chromos among his customers, the court suggested that since the obvious artistic qualities rendered the chromos fairly subjects of copyright, regard need not be made to the use to which the plaintiff had made or intended to make of them.

*Schumacher v. Schwencke*¹⁷ followed, and considered the copyright of a painting called "Telegram" showing the head of a newsboy, with a number of papers on his shoulder, and the waste end of a cigar in his mouth. It was contended that a copyright could not be granted, since the painting was designed as a label for cigar boxes. The court presented a convincing argument in overruling this contention, saying:

"The fact that copies may be utilized for advertising purposes does not change the character of the original. If the painting itself is to be considered a label because copies may be so used, no masterpiece would escape such desecration. It will hardly do to call the Sistine Madonna, or the Aurora, labels because by the sacrilege of modern enterprise copies of Raphael's Cherubs or Guido's Goddess may be transferred to a blacking box or a perfumery bottle."¹⁸

While these last cases only decided that the fact that the subject might later be used in advertising would not prevent the original from being copyrighted, the stage was set for the decision that advertising material as such could be the subject of copyright.

¹⁵ 12 F. 97 (S. D., N. Y., 1882).

¹⁶ According to an old German legend, it was King Gambrinus, while King of Flanders, who invented lager beer, and first used it as a potion or draught.

¹⁷ 25 F. 466 (S. D., N. Y., 1885).

¹⁸ See also: *Mutual Advertising Co. v. Refo*, 76 F. 961 (D. C., S. C., 1896).

The tide turned in the case of *Bleistein v. Donaldson Lithographing Co.*¹⁹ The pictures involved were ordinary circus posters with little, if any, recognizable artistic merit. Gaudily portrayed were a ballet, a group of men and women performing on bicycles, and a group of persons whitened to represent statues. In the Circuit Court of Appeals,²⁰ these posters were declared to be improper subjects for copyright, but this decision was reversed by the United States Supreme Court. The court, speaking through Mr. Justice Holmes, said:

“Again, the act, however construed, does not mean that ordinary posters are not good enough to be considered within its scope. The antithesis to ‘illustrations or works connected with the fine arts’ is not works of little merit or of humble degree, or illustrations addressed to the less educated classes; it is ‘prints or labels designed to be used for any other article of manufacture.’ Certainly works are not the less connected with the fine arts because their pictorial qualities attract the crowds, and therefore gives them a real use, — if use means to increase trade and to help make money. A picture is none the less a picture, and none the less a subject of copyright, that it is used for an advertisement. . . . It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”

Only once since this decision has this question been before the Supreme Court, and then it was not specifically passed upon.²¹ The advertisement there in question contained pictorial illustrations of styles in women’s apparel. The fact that the court assumed the validity of the copyright, however, indicates its adherence to the standard set in the *Bleistein* case.²² And so, illustrated advertising matter — our present day commercial art — received the protective mantle of the copyright laws.

¹⁹ *Supra*, note 6.

²⁰ This case was tried in the lower courts under the title of *Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 F. 993 (C. C. A., 1900).

²¹ *Westermann Co. v. Dispatch Printing Co.*, 249 U. S. 100, 39 S. Ct. 194, 63 L. Ed. 499 (1919).

²² *Supra*, note 6.

The march was on, and, in case after case in the lower Federal courts, these decisions were followed. An injunction was granted against the infringement of a copyright of a catalogue containing pictures and cuts of statuary.²³ An attempt was made to distinguish the principal case from that of the *Clow* case²⁴ on the ground that the objects there illustrated were very different from those illustrated here, but once the full import of the decision in the *Bleisten* case²⁵ is recognized, a copyright cannot be denied a catalogue simply because the illustrations therein are of goods, which, though necessities, may be soft-pedaled in living-room society.

A book containing cuts of the latest styles in dress for women was held a subject of copyright in *National Cloak and Suit Co. v. Kaufman*.²⁶ Later decisions allowed these advertising materials to be protected by copyright: advertising catalogue, containing cuts of brass goods, such as trimmings for electric light fixtures;²⁷ figure of a young man clad in a suit of underwear;²⁸ catalogue cuts of orthopedic devices;²⁹ catalogue containing information concerning piston rings;³⁰ and bottle labels, containing recipes, a fanciful emblem, and other printed advertising.³¹

Among the later cases, that of *Ansehl v. Puritan Pharmaceutical Co.*³² contains an excellent discussion of the problem. In that case a newspaper advertisement, composed of a

²³ *Da Prato Statuary Co. v. Giuliani Statuary Co.*, 189 F. 90 (D. C., Minn., 1911).

²⁴ *Supra*, note 13. The catalogue involved contained cuts of a wash basin, slop jar, soap dish, and other bathroom accessories.

²⁵ *Supra*, note 6.

²⁶ 189 F. 215 (D. C., Pa., 1911).

²⁷ *White Manufacturing Co. v. Shapiro*, 227 F. 957 (S. D., N. Y., 1915).

²⁸ *Golden Rule, Inc. v. B. V. D. Co.*, 242 F. 929 (C. C. A., 1917).

²⁹ *Campbell v. Wireback*, 269 F. 372 (C. C. A., 1920), affirming 261 F. 391 (D. C., Md., 1919).

³⁰ *No-Leak-O Piston Ring Co. v. Norris*, 277 F. 951 (C. C. A., 1921), affirming 271 F. 536 (D. C., Md., 1921).

³¹ *Fargo Mercantile Co. v. Brechet & Richter Co.*, 295 F. 823 (C. C. A., 1924).

³² 61 F. 2d 131 (C. C. A., 1932), cert. denied: 287 U. S. 666, 53 S. Ct. 224, 77 L. Ed. 574 (1932).

photograph of cosmetic and toilet articles, bearing the owner's trade-name and reading and descriptive matter, was held a proper subject of copyright. Likewise, an advertising card, distributed free to customers of merchants, and designed to promote the sales of sets of dishes, was classified as a "book" and declared copyrightable.³³ The worth of the card was not in its intrinsic value but in the value which it possessed to promote the sale of dishes.

The zenith in the subject of advertising matter receiving the protection of the copyright laws was involved in *Vinick v. Charm Publications, Inc.*³⁴ In this case, the plaintiff, who had delivered a series of radio lectures, entitled "Lessons in Loveliness" and marked by the commercial viewpoint so common on the radio today, received damages for an infringement by a beauty magazine of one of these copyrighted talks. The opinion is interesting, not only for the law involved, but also for the fact that the presiding judge gave vent to the feelings of those who believe that the radio is plagued with this sort of "advertising twaddle."

A particular arrangement of the subject may be sufficient to justify a copyright, and the fact that the finished product possesses little artistic merit will not prevent the proprietor from obtaining a copyright.³⁵ The proprietor is not entitled to be protected in his ideas, but he is entitled to be protected in his expression of illustrations or his ideas.³⁶ Finally, while printed advertisements can be made the subject of a valid copyright although simple and brief where the wording is attractive and the arrangement designed to arrest attention,³⁷ it is well settled that the mere aggregation of old

³³ *Sebring Pottery Co. v. Steubenville Pottery Co.*, 9 F. Supp. 384 (D. C., Ohio, 1934).

³⁴ 35 F. Supp. 275 (S. D., N. Y., 1940).

³⁵ *Stecher Lithographic Co. v. Dunston Lithograph Co.*, 233 F. 601 (D. C., N. Y., 1916).

³⁶ *Ansehl v. Puritan Pharmaceutical Co.*, 61 F. 2d 131 (C. C. A., 1932), cert. denied: 287 U. S. 666, 53 S. Ct. 224, 77 L. Ed. 574 (1932).

³⁷ *Deward & Rich, Inc. v. Bristol Savings & Loan Corp.*, 29 F. Supp. 777 (D. C., W. Va., 1939).

material does not amount to ordinary skill sufficient to lend copyrightability.³⁸

Thus it is plain that advertising material, as such, which meets the other requirements of the statute for originality and distinctiveness, may be a proper subject for copyright. To conclude this portion of the discussion, only one word further is necessary. The right guaranteed by the law does not extend to the exclusive right to employ a particular method of advertising,³⁹ nor may a manufacturer of unpatented articles practically monopolize their sale by copyrighting a catalogue containing illustrations of the wares.⁴⁰ The copyright extends only to the material, not to the method of advertising nor to the articles displayed.

II.

In answer to the question "To whom does the copyright belong?", the statute provides:

"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 under the conditions and for the terms specified in this title."⁴¹

This provision has been construed as being broad enough to include corporations as proper persons to secure copyrights on materials designed for use in advertising.⁴² That a partnership may obtain a copyright in the firm name, even if that name indicated a corporation, seems to be assumed, if not directly held, in a number of cases.⁴³

³⁸ Jackson v. Quicksip, Inc., 27 F. Supp. 338 (D. C., N. Y., 1939), affirmed: 110 F. 2d 731 (C. C. A., 1940).

³⁹ Ehret v. Pierce, 10 F. 553 (D. C., N. Y., 1880).

⁴⁰ National Cloak & Suit Co. v. Standard Mail Order Co., 191 F. 528 (D. C., N. Y., 1911).

⁴¹ 17 U. S. C. A. § 8.

⁴² Schumaker v. Schwencke, 25 F. 466 (D. C., N. Y., 1885); National Cloak & Suit Co. v. Kaufman, 189 F. 215 (D. C., Pa., 1911).

⁴³ Bleistein v. Donaldson Lithographing Co., 188 U. S. 239, 23 S. Ct. 298, 47 L. Ed. 460 (1930); Stecher Lithographic Co. v. Dunston Lithograph Co., 233 F. 601 (D. C., N. Y., 1916); Campbell v. Wireback, 261 F. 391 (D. C., Md., 1919), affirmed: 269 F. 372 (C. C. A., 1920).

It is further provided that the word "author" should include an employer in case of works made for hire.⁴⁴ In *Brown v. Mollé Co.*,⁴⁵ the plaintiff worked under a contract with an advertising agency hired by the defendant corporation to arrange a radio program advertising the defendant corporation's shaving cream. He concocted a jingle praising the product and set the words to the music of the "West Point Caisson Song." The court held that the plaintiff had no copyrighted property in the words of the song, and stated that the case fell within the rule that where an employee creates something as a part of his duties under his employment, the thing created is the property of his employer. Here the words belonged to the advertising agency in trust for the defendant manufacturer.

III.

"Infringement is the doing by any person, without the consent of the owner of the copyright, of anything the sole right to do which is conferred by the statute on the owner of the copyright."⁴⁶

Turning our discussion from a consideration of what may be the subject of copyright and to whom the right belongs, we turn now to a study of what an infringement or a violation of this right consists in. One of the first cases on this particular point within the field of advertising material was that of *Falk v. Brett Lithographing Co.*⁴⁷ Suit was brought for the infringement of the copyright of a picture of a mother and her child. Defendant had copied the position, features, and most of the photograph by reversing it and revising some minor details, for the purpose of "creating" advertising lithographs. Plaintiff was awarded the judgment, as the defendant had used the plaintiff's photograph as a guide and had substantially copied it. "The appropriation

⁴⁴ 17 U. S. C. A. § 62.

⁴⁵ 20 F. Supp. 135 (D. C., N. Y., 1937).

⁴⁶ 18 C. J. S. 212.

⁴⁷ 48 F. 678 (S. D., N. Y., 1891).

of a substantial portion of another's copyrighted work constitutes infringement."⁴⁸

It is not necessary, in order to effect an infringement, that the infringing composition shall be identified with that which is infringed. In the *Ansehl v. Puritan Pharmaceutical Co.* case,⁴⁹ there was a contest over similar advertisements of toilet articles. In concluding, the court said:

"The plaintiff's copyright did not protect his ideas for an advertisement, but it did protect his illustration and expression of those ideas in pictures and language. The defendants might appropriate the ideas and express them in their own pictures and in their own language, but they could not appropriate the plaintiff's advertisement by copying his arrangement of material, his illustrations and language, and thereby create substantially the same manner, without subjecting themselves to liability for infringement."

While the defendant, in order to infringe a copyright, must have actually copied or "pirated" the production of the plaintiff, and not merely, while ignorant of it, have made something similar,⁵⁰ yet the intention to copy is held to be immaterial if infringement otherwise appears. And where intention does appear, it is a valuable fact to consider.⁵¹ A use of copyrighted advertising material without authority is not excused where the use was made under the belief and impression that such use did not constitute an infringement.⁵²

Closely allied with the question of intent in the problem of infringement is the matter of the notice of the copyright required by the statute to be placed on the copyrighted material.⁵³ A notice of the copyright, so small that it was visible only through a microscope, was held not to be sufficient to

⁴⁸ *Meccano v. Wagner*, 234 F. 912 (D. C., Ohio, 1916), reopening authorized: 235 F. 890 (C. C. A., 1916), modified on other grounds: 246 F. 603 (C. C. A., 1918). See also: *Da Prato Statuary Co. v. Giuliani Statuary Co.*, 189 F. 90 (D. C., Minn., 1911).

⁴⁹ *Supra*, note 32.

⁵⁰ *White Dental Co. v. Sibley*, 38 F. 751 (D. C., Pa., 1889).

⁵¹ *Meccano v. Wagner*, 234 F. 912 (D. C., Ohio, 1916), reopening authorized: 235 F. 890 (C. C. A., 1916), modified on other grounds: 246 F. 603 (C. C. A., 1918).

⁵² *Norm Co. v. John A. Brown Co.*, 26 F. Supp. 707 (D. C., Okla., 1939).

⁵³ 17 U. S. C. A. § 18.

meet the statutory requirement.⁵⁴ On the other hand, the defendant will not be excused where the print is very small, if it still be large enough to have put upon inquiry any reasonably careful person who obtained the advertising material on a contractual basis.⁵⁵

The use of two clever defenses failed the defendant in the case of *Henry Holt & Co. v. Liggett & Myers Tobacco Co.*⁵⁶ Plaintiffs were the publishers of a copyrighted book "The Human Voice, its Care and Development." Defendants, manufacturers of a popular brand of cigarettes, published a pamphlet entitled "Some Facts About Cigarettes," and, under the heading "Do Cigarettes Affect the Throat?" reprinted, without permission, portions of the copyrighted book. In a copyright infringement suit, the defendant manufacturer attempted to excuse the infringement on the ground that the source from which the material was taken had been acknowledged. The court overruled this defense, and did likewise to the plea that the defendant was doing no more than making a fair use of a scientific work, as permitted by law. The court declared that the pamphlet was not a publication in the same field of science as the book, and that, rather than being a scientific treatise or a work designed to advance human knowledge, the pamphlet had only a purely commercial purpose — the promotion of the sale of cigarettes.

It has also been determined that illegal acts by the proprietor of the copyright, not affecting that particular right, will not bar his remedy for infringement. This was the result in the case of *Cory v. Physical Culture Hotel*,⁵⁷ where-

⁵⁴ *Smith v. Wilkinson*, 19 F. Supp. 841 (D. C., N. H., 1937), affirmed: 97 F. 2d 506 (C. C. A., 1938). See also: *Deward & Rich, Inc. v. Bristol Savings & Loan Corp.*, 34 F. Supp. 345 (D. C., W. Va., 1940).

⁵⁵ *Advertisers Exchange Inc. v. Laufe*, 29 F. Supp. 1 (D. C., Pa., 1939). See also: *Deward & Rich, Inc. v. Bristol Savings and Loan Corp.*, 29 F. Supp. 777 (D. C., W. Va., 1939).

⁵⁶ 23 F. Supp. 302 (D. C., Pa., 1938).

⁵⁷ 14 F. Supp. 977 (D. C., N. Y., 1936), affirmed: 88 F. 2d 411 (C. C. A., 1937).

in it was contended that the proprietor of the copyrighted photograph of defendant's hotel taken from the air, had lost his right to redress the infringement by defendant in its advertisements, because he had flown too low while taking the photograph.

IV.

The remedies of one whose right to the exclusive use of his copyright has been infringed in some manner are two-fold: he may seek an injunction or bring an action for damages. The section of the Federal Copyright Law relating to remedies for infringements reads:⁵⁸

"If any person shall infringe the copyright in any work protected under the copyright laws of the United States, such person shall be liable:

a. To an injunction restraining such infringement;

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 just. . . ."

The injunction which will be granted will not apply to all parts of the defendant's advertisement, but will be limited to the cuts or portions which constitute an infringement of plaintiff's copyright.⁵⁹ Furthermore, the fact that the defendant has ended the insertions of the infringing material and has destroyed the plates from which the prints were made does not constitute a bar to injunctive relief.⁶⁰ Proof of actual damage to the plaintiff is not necessary for the issuance of such an injunction if actual infringement appears and damage may probably follow.⁶¹

⁵⁸ 17 U. S. C. A. § 25.

⁵⁹ *Supra*, note 23.

⁶⁰ *Cory v. Physical Culture Hotel*, 14 F. Supp. 977 (D. C., N. Y., 1936), affirmed: 88 F. 2d 411 (C. C. A., 1937).

⁶¹ *Henry Holt & Co. v. Liggett & Myers Co.*, 23 F. Supp. 302 (D. C., Pa., 1938).

No one is unaware of the fact that at times advertisers go beyond the bounds of truth in representing the quality of their goods to the buying public. The question of "puffing" was considered in the case of *Stone & McCarrick, Inc. v. Dugan Piano Co.*⁶² Plaintiff had prepared a copyrighted book of advertisements to be used by dealers in selling plaintiff's pianos. To state that the advertisements went beyond the limits of exaggeration is to put the matter mildly. Plaintiff was refused an injunction against the infringement of the advertisements, the equitable requirement of "clean hands" being introduced in this connection for the first time. The court wrote:

"Extravaganzas may be indulged in by a writer for the purpose of illustration and to accomplish the end in view, as exemplified by Don Quixote and others of a similar nature, and as thus employed they carry conviction to the reader and lend charm and interest to the story. But advertisements by dealers of their wares, in order to insure the protection of the law, should reflect the truth and avoid representations which mislead and deceive the people. If their tendency be misleading and deceptive, they will find the doors of a court of equity barred against their admission."

The question of an award of money damages requires more consideration. Provisions are made for awarding either actual or statutory damages. The statutory damages are to be such as to the court shall appear to be just and are to be awarded in cases where the damages are indirect and not capable of ascertainment.⁶³ The United States Supreme Court, in the *Westermann Co. v. Dispatch Printing Co.* case,⁶⁴ discussed this point:

⁶² 220 F. 837 (C. C. A., 1915).

⁶³ The following cases deal with the awarding of statutory damages on occasions wherein the courts have found infringements of copyrighted material in the advertising business: *Campbell v. Wireback*, 261 F. 391 (D. C., Md., 1919), affirmed: 269 F. 372 (C. C. A., 1920); *No-Leak-O Piston Ring Co. v. Norris*, 271 F. 536 (D. C., Md., 1921), affirmed: 277 F. 951 (C. C. A., 1921); *Fargo Mercantile Co. v. Brecht & Richter Co.*, 295 F. 823 (C. C. A., 1924); *Sebring Pottery Co. v. Steubenville Pottery Co.*, 9 F. Supp. 384 (D. C., Ohio, 1934); *Lindsay & Brewster, Inc. v. Verstein*, 21 F. Supp. 265 (D. C., Maine, 1937); *Elliot v. Geare-Marston, Inc.*, 30 F. Supp. 301 (D. C., Pa., 1939); *Vinick v. Charm Publications, Inc.*, 35 F. Supp. 275 (D. C., N. Y., 1940).

⁶⁴ 249 U. S. 100, 39 S. Ct. 194, 63 L. Ed. 499 (1919).

"The fact that these damages are to be 'in lieu of actual damages' shows that something other than actual damages is intended — that another measure is to be applied in making the assessment. . . . In other words, the court's conception of what is just in the particular case, considering the nature of the copyright, the circumstances of the infringement and the like, is made the measure of the damages to be paid, but with the express qualification that in every case the assessment must be within the prescribed limitations, that is to say, neither more than the maximum nor less than the minimum. Within these limitations the court's discretion and sense of justice are controlling."

This statement by Mr. Justice Van Devanter succinctly defines the interpretation of the provision for statutory damages.

Furthermore, in a case wherein statutory damages are awarded, the amount awarded should be small if the amount of damage, though incapable of definite ascertainment, appears to be trifling.⁶⁵ Where an award within the limits of the statute has been made, there being no legitimate basis for recovery of any definite amount, such award should not be disturbed by an appellate court without much hesitation.⁶⁶

In assessing damages for the use of copyrighted advertising material without permission, a problem arises as to whether repeated printings of the material amount to a single infringement or to several violations of the statute. Again the leading case is that of *Westermann Co. v. Dispatch Printing Co.*,⁶⁷ which along with the *Bleistein* case,⁶⁸ forms the foundation stones for the application of the copyright statute to advertisers. Plaintiff designed and produced pictorial illustrations of styles in women's apparel, and supplied these to dealers in such apparel for use in advertising their goods. Exclusive licenses for use of these illustrations were granted, each license being restricted to a particular locality. A dealer in Columbus, Ohio, was given

⁶⁵ *Insurance Press v. Ford Motor Co.*, 255 F. 896 (C. C. A., 1918).

⁶⁶ *Wells v. American Bureau of Engineering*, 285 F. 371 (C. C. A., 1922).

⁶⁷ *Supra*, note 64.

⁶⁸ *Supra*, note 6.

such an exclusive license, but the defendant, a publisher of a daily newspaper, without the consent of the plaintiff or his licensee, reproduced and published six of plaintiff's copyrighted illustrations. Five were published once and the other one twice, the illustrations being used in each instance as part of an advertisement by some competitor in trade of plaintiff's licensee. The two advertisements having the same illustration were by different advertisers and were separated by an interval of twenty-six days.

The Circuit Court of Appeals for the Sixth Federal District held that the defendant's acts mounted to only one infringement of plaintiff's copyright.⁶⁹ It was argued that the various illustrations related to a single subject, and that plaintiff had tied them together by uniting the six cuts into his season's service. His right, so reasoned the court, "was the exclusive right to publish in Columbus this group of pictures for the season; and this was in substantial effect one right."

This case was appealed to the Supreme Court of the United States where it was determined that the defendant publishing company was guilty of seven distinct infringements.⁷⁰ Mr. Justice Van Devanter, after quoting the minimum-damage clause of the copyright statute, wrote:

"The statute says that the liability thus defined is imposed for infringing 'the copyright' in 'any copyrighted work.' The words are in the singular, not the plural. Each copyright is treated as a distinct entity, and the infringement of it is a distinct wrong to be redressed through the enforcement of this liability. Infringement of several copyrights is not put on the same level with infringement of one. On the contrary, the plain import of the statute is that this liability attaches in respect of each copyright that is infringed. Here six were infringed, each covering a different illustration. Thus there were at least six cases on infringement in the sense of the statute."

In other words, the court found that there had been six cases of infringement because each of the six copyrighted

⁶⁹ 233 F. 609 (C. C. A., 1916).

⁷⁰ *Westermann Co. v. Dispatch Printing Co.*, 249 U. S. 100, 39 S. Ct. 194, 63 L. Ed. 499 (1919).

pictures was printed once without the permission of the copyright owner or his licensee. The learned Justice then went on to discuss the case of the copyrighted illustration which appeared on two occasions. Each time the illustration was used in a different advertisement, and was published at the instance of and for the benefit of a different advertiser. For this reason, the two publications were found to be distinct infringements. Whether the republication of the same piece of material for the same advertiser would constitute one or more infringements was not decided, for the opinion closed with:

“Whether it would be otherwise if that publication had been merely a continuation or repetition of the first, . . . , are matters which we have no occasion to consider now. They are mentioned only to show that no ruling thereon is intended.”

During the interim between the decisions in the *Westermann Company* case, the case of *Sauer v. Detroit Times Company*⁷¹ was decided. It was held that there had been one infringement under the minimum-damage provision where a newspaper, without the permission or assent of the copyright owner, published a copyrighted map in its afternoon edition, and republished it in the noon edition of the following day. While this second edition was in some respects identical with that of the previous day, a considerably less number of copies were printed, material was rearranged to make room for new items, and a different class of subscribers was reached. However, since the same map was republished, there was held to be only one infringement.

Where a hotel owner used a copyrighted aerial photograph of his hotel, without the consent of the copyrighting photographer, in magazine advertisements, it was held that the insertions constituted separate infringements.⁷² The determining features here were that the series of advertisements could be discontinued at any time, the text of the advertisements varied, and a special key number was given to each

⁷¹ 247 F. 687 (D. C., Mich., 1917).

⁷² *Supra*, note 60.

publication of the advertisement to enable the defendant to identify the replies to the advertisements with each particular issue. Undoubtedly, the separate printings constituted as much separate infringements as if the copyright material had been used for the benefit of several advertisers.⁷³

The opinion in the *Westermann Company* case was given much consideration in *Doll v. Libin*.⁷⁴ The Federal District Court in Montana recognized that the opinion in the *Westermann Company* case never determined the status of repetitions of the same piece of copyrighted material; but, relying on the general principles set out in that opinion, decided that five publications of the same copyrighted material violated only one right and amounted to only one infringement.⁷⁵

These considerations lead to the conclusion that the answer to the problem of whether republications of the same piece of copyrighted material constitute one or several infringements is that there is only one infringement where the republication is in substantially the same manner and for the same purpose; but if all the circumstances are changed, there are several infringements. One case did decide that repetitions of the same copyrighted material constituted more than one infringement,⁷⁶ but the effect of this decision is qualified in that the advertising consisted of quoted portions of a copyrighted magazine article, rather than material primarily designed for advertising, and in that the publications were made on two occasions some eight months apart. And in any event, only one suit to claim damages should be brought, regardless of whether the infringements are one or several.⁷⁷

⁷³ In accord: *Lindsay & Brewster, Inc. v. Verstein*, 21 F. Supp. 264 (D. C., Maine, 1937).

⁷⁴ 17 F. Supp. 546 (D. C., Mont., 1936).

⁷⁵ Contra: *Zuckerman v. Dickson*, 35 F. Supp. 903 (D. C., Pa., 1940), wherein the Federal District Court in Pennsylvania erroneously assumed that the Supreme Court in the *Westermann Company* case decided that reprints of the same material amounted to separate infringements.

⁷⁶ *Eliot v. Geare-Marston, Inc.*, 30 F. Supp. 301 (D. C., Pa., 1939).

⁷⁷ *Lindsay & Brewster, Inc. v. Verstein*, 21 F. Supp. 264 (D. C., Maine, 1937).

V.

Provision is also made in the copyright statute for the awarding of costs and attorney's fees to the prevailing party.⁷⁸ The award of the former is mandatory upon the court, while the latter are given only if and when the court sees fit.⁷⁹

In relation to the right to sue for an infringement, a copyright is an indivisible thing, and cannot be split up and partially assigned either as to time, place, or particular rights or privileges, less than the sum of all the rights comprehended in the copyright. While the statute authorizes the assignment of a copyright,⁸⁰ such an assignment can not be partial. Exclusive rights limited as to time, place, or extent of privileges which the grantee may enjoy are considered to operate as licenses. Hence, the party to sue for an infringement is the proprietor of the copyright or his licensee, and the burden of proof rests upon such plaintiff to establish the case by a fair preponderance of the evidence.⁸¹ And where a licensee has continued to make use of the copyrighted material after the termination of the contract under which he held permission to utilize the material in advertising, it has been held that the proper action is for the infringement of the copyright rather than an action on the theory of breach of contract.⁸²

Everything considered, the tendency of the courts is towards a liberal construction of the copyright laws. The jurists realize that the basis of these statutes is in the promotion of the arts and sciences. Such promotion is accomplished through a recognition of what is considered liberal rather

78 17 U. S. C. A. § 40.

79 *Sebring Pottery Co. v. Steubenville Pottery Co.*, 9 F. Supp. 384 (D. C., Ohio, 1934); *Lindsay & Brewster, Inc. v. Verstein*, 21 F. Supp. 264 (D. C., Maine, 1937); *Vinick v. Charm Publications, Inc.*, 35 F. Supp. 275 (S. D., N. Y., 1935).

80 17 U. S. C. A. § 42.

81 *Supra*, note 76.

82 *Doll v. Libin*, 17 F. Supp. 546 (D. C., Mont., 1936).

than by worshipping the conventional and shunning the new and different. The transition has been made, advertisements, as such, possessing the least degree of originality and artistic merit, are copyrightable, and Johnny the pageboy in the cigar store window and Aunt Jemima in her plaid bandanna are protected!

John E. Savord.

College of Law, University of Notre Dame.