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## Contributors to the May Issue/Notes/Editorial Board

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## CONTRIBUTORS TO THE MAY ISSUE

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## NOTES

MATTERS NOT PROTECTED BY COPYRIGHT.—When a man writes a book, a poem, or drama, or paints a picture, there is presumably some quality that sets it apart from all other books, poems, plays and pictures. It is this certain originality, or uniqueness, that the law seeks to protect by means of copyright law. Copyright may be accurately defined as the right granted by statute to the proprietor of an intellectual production to its exclusive use and enjoyment to the extent specified in the statute.<sup>1</sup> The law wishes to grant the author some privilege which he has earned by his intellectual labor which others can't share. This is the general purpose of copyright law.

Copyright law has been divided into common law copyright and statutory copyright. There is little similarity between the two, each providing for an entirely different stage of the publication of an intellectual work. Copyright at common law protected the author of a work from publication or plagiarism until he had published his writing, but once so published, this work was subject to copying by anyone so desiring. Statutory copyright on the other hand protects the author after his article has been published from misuse of his rights acquired under

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<sup>1</sup> 18 C. J. S. 138.

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that copyright. "The peculiar right conferred by statutory copyright is to multiply copies after publication to the exclusion of others."<sup>2</sup> When one refers to copyright, they usually mean the statutory right, and that is to what this article will be confined.

This copyright protection might easily be carried too far and protect matter not worthy of protection, perhaps thus stifling literary accomplishment by others. Lord Mansfield, in the old English case of *Sayre v. Moore*,<sup>3</sup> states this problem admirably. "We must take care to guard against two extremes equally prejudicial. The one that men of ability who have employed their time for the service of the community may not be deprived of their just merits and the reward of their ingenuity and labor; the other, that the world may not be deprived of improvements, nor the progress of the arts be retarded." If copyright is to attain the sought-for mean, it would seem that this field should be more closely defined to determine just what is subject to copyright protection, and it shall be the object of this article to show just what matter is not protected by copyright law.<sup>4</sup> This is a broad subject, and necessarily classification may be somewhat faulty, some points perhaps overlapping.

### 1. *Ideas, Systems, and Information*

It is a general proposition in copyright law that the protection of the statute may not be obtained for an idea, or a system, or for general information. The ideas or intellectual conceptions embodied in the copyright work are not protected by that work's copyright; it is only the particular phrasing, the author's arrangement of his ideas, or his style that is protected. The reason for this seems obvious, "The object of copyright is to promote science and useful arts. If an author, by originating a new arrangement and form of expressing certain ideas or conceptions could withdraw those ideas or conceptions from the stock of materials to be used by other authors, each copyright would narrow the field of thought."<sup>5</sup> And again, "A copyright does not give a monopoly in any incident of a play. Other authors have a right to exploit the facts, experiences, field of thought and general ideas, provided they do not substantially copy a concrete form in which the circumstances and ideas have been developed, arranged, and put into shape."<sup>6</sup> The right secured by copyright is not the right to the idea. In this statement, we have the necessary imputation that the plot of a play or book is not subject to copyright, nor is it protected in a copyrighted book,

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<sup>2</sup> *Palmer v. De Witt*, 47 N. Y. 532, 533.

<sup>3</sup> 1 East 361.

<sup>4</sup> U. S. C. A., Copyright Act of March 4, 1909, § 7. Also see AMDUR'S COPYRIGHT LAW AND PRACTICE.

<sup>5</sup> *Eichel et al. v. Marcin*, 241 F. 404 (1913).

<sup>6</sup> *Ibid.*

and this is borne out by the authorities.<sup>7</sup> In *London v. Biograph Company*,<sup>8</sup> Jack London, the author of "Just Meat," sued the defendant for the production of a motion picture entitled "Love of Gold," in which the plot was very similar to that of the book: in both two thieves commit their crime, and return to a common meeting place and discuss, with some heat, the disposition of their unlawfully gained spoils. Each succeeds unknown to the other in poisoning his comrade, and both die, with some variances in the specific instances which bring out this almost identical plot. However, the court held that there was no infringement of Mr. London's copyright, saying, "The copyright cannot protect the fundamental plot which was the common property long before the story was written. It will protect the embellishments with which the author added elements of literary value to the old plot." Again, in *Nichols v. Universal Pictures*,<sup>9</sup> the plaintiff had written and obtained a copyright on a play, "Abie's Irish Rose." The defendant produced a motion picture entitled "The Cohens and the Kellys." There was a great deal of similarity between the plots of the two works: both were built around antagonism between Irish and Jews, and a final reconciliation because of the love between their children. The court denied the plaintiff his relief, "There is no monopoly in such a background. The plaintiff discovered the vein, she could not keep it to herself; so defined, the theme was too general an abstraction from what she wrote. It was only an idea. A comedy based upon conflicts between Irish and Jews into which the marriage of their children enters, is no more susceptible of copyright than the outline of 'Romeo and Juliet.'"

Also, you cannot secure a copyright on a particular plan or system, nor is such plan or system in a copyrighted work, protected by that copyright. A system or method being but an intellectual conception is not protected by the copyright of a book in which it is set forth and explained. A leading case on this is *Guthrie v. Curlett*.<sup>10</sup> Here there were many freight tariff indexes on file with the Interstate Commerce Commission. The plaintiff wrote and copyrighted a pamphlet, entitled "Tariff Economics as Applied to the Tariff Index," explaining a rather complicated system of consolidation of freight tariffs. The defendant later prepared a consolidated freight tariff which the plaintiff claimed infringed his copyright. Both pamphlets relied largely for simplification and solution on a consolidation made possible by use of ruled columns and compound specific interest symbols. The court, in deciding there was no infringement, remarked, "This idea alone, apart from the means of expressing it, is not protected by his copyright." The copy-

<sup>7</sup> *Dymow v. Bolton*, 11 F. 2d 690 (1926); *Stodart v. Mutual Film Corp.*, 249 F. 597 (1917).

<sup>8</sup> 231 F. 696 (1916).

<sup>9</sup> 45 F. 2d 119 (1930).

<sup>10</sup> 36 F. 2d 694 (1929).

right was said to protect only the author's peculiar expression of his ideas, or rather, protect his ideas only when expressed as he expressed them.

"The intricate nature of the work, the subject involved and the result to be obtained, make it inevitable that within the scope of the works, the same information can be found, but the appellant has no monopoly upon information, or the purveying of information by a broad general method." Nor was a copyright on a book of a system of book-keeping infringed by a similar book, using a similar plan so far as results were concerned, but using a different arrangement of columns and column headings.<sup>11</sup> Nor was a system of piano salesmanship copyrightable;<sup>12</sup> nor the Ford Motor Company's plan of buying cars through weekly installments and deposits;<sup>13</sup> nor a new art or system of stenography;<sup>14</sup> nor a plan of medical instruction;<sup>15</sup> nor a method of selling.<sup>16</sup> A copyright cannot be obtained on a particular distribution of cards in problems of play or principles of contract bridge applicable to their solution;<sup>17</sup> nor is there literary property susceptible of copyright protection in the conventional rules of a game, as distinguished from the mode of expressing them.<sup>18</sup> A system of contract bridge playing is an idea, property in which cannot be secured by copyright law.<sup>19</sup> In line with the reasoning of these cases, are others: A "Bank-Nite" system which the plaintiff had originated and furnished to motion picture theatres by license could not be copyrighted;<sup>20</sup> no copyright was allowed in a pamphlet containing articles of association and the by-laws of a mutual burial association,<sup>21</sup> or in blank forms of liquor licenses.<sup>22</sup> The court, although holding there was an infringement by the defendant's forms for liquor licenses, said that anyone would be at liberty to prepare and publish such forms, but that here infringement existed because the defendant had actually copied the plaintiff's work, and thus had violated more than the idea or system.

An advertising system is not a fit subject of copyright. In *Ehret v. Pierce*,<sup>23</sup> the plaintiff had copyrighted certain advertising cards for the purpose of displaying paints and their various colors. The de-

<sup>11</sup> William Baker v. Elizabeth Selden, 101 U. S. 99, 25 L. Ed. 841 (1879).

<sup>12</sup> Stone & McCarrick v. Dugan Piano Co., 210 F. 399 (1914).

<sup>13</sup> Moore v. Ford Motor Co., 28 F. 2d 529 (D. C. S. D. N. Y., 1928).

<sup>14</sup> Griggs v. Perrin, 49 F. 15 (C. C. N. Y., 1890).

<sup>15</sup> Chautauqua School of Nursing v. National School of Nursing, 288 F. 151, 151 C. A. 227 (N. Y., 1916).

<sup>16</sup> Kaeser & Blair v. Merchants' Ass'n., 64 F. 2d 575 (Ohio, 1933).

<sup>17</sup> Russell v. Northeastern Publishing Co., 7 F. Supp. 571 (D. C. Mass., 1934).

<sup>18</sup> Whist Club v. Foster, 42 F. 2d 782 (D. C. N. Y., 1929).

<sup>19</sup> Downes v. Culbertson, 275 N. Y. Supp. 233, 153 Misc. 14.

<sup>20</sup> Affiliated Enterprises v. Gruber, 86 F. 2d 958 (C. C. A. Mass., 1937).

<sup>21</sup> Burk v. Johnson, 146 F. 209, 76 C. C. A. 567 (Kan., 1906).

<sup>22</sup> Brightley v. Littleton, 37 F. 103 (C. C. E. D. Pa., 1888).

<sup>23</sup> 10 F. 553 (S. D. N. Y., 1880).

fendant had similar advertisements, with of course, different words on the cards. The court said, "The real matter of plaintiff's complaint is, not that defendant has copied his card — that would occasion him no loss, but on the contrary, for it would be a gratuitous advertisement of his paints — but that defendant in advertising his wares, has adopted the same method pursued by him in advertising his wares, and his claim amounts in substance to claiming the exclusive right to employ that method in advertising. Such a method cannot in my opinion be acquired under copyright laws." However, see the case of *Ansel v. Puritan Pharmacal Co.*<sup>24</sup> where the plaintiff advertised a cosmetic known as "Vivani," and copyrighted his advertisement for it. The defendant also manufactured cosmetics and published a very similar advertisement. The court held that the expression of the two ideas was so close that there was an infringement.

"Copyright law protects the means of expressing an idea; and it is as near the whole truth as generalization can reach that, if the same idea can be expressed in a plurality of totally different manners, a plurality of copyrights may result and no infringement will exist. The plaintiff's copyright did not protect his ideas for an ad, 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 their own wording." This case is not really in conflict with the *Ehret Case*, because both state the fundamental proposition that the idea for an advertisement is not subject to copyright protection, but here the defendant had so closely copied the plaintiff's illustrations and language that it was an infringement of the actual expression of the idea, and not of the idea itself. After all, these questions are largely ones of fact, and generalizations regarding them must be reached carefully.

If information and ideas are not subject to copyright by statute, it would seem to follow logically that news, as such, is not copyrightable either. And this is the general rule, that the information element in news is not subject to copyright protection.<sup>25</sup> A leading case on the subject is *The Chicago Record-Herald v. Tribune Ass'n.*<sup>26</sup> Here the plaintiff had secured a copyright on an article stating news of Germany's hope of succeeding in the last World War by reason of a new fleet of submarines. The court said, "News as such is not subject to copyright, and if the defendant's publication were only a statement of the news in the plaintiff's article, the action would not lie. But the article involved authorship, literary quality, and style, apart from the

<sup>24</sup> 61 F. 2d 131 (1932). But see *Edwards & Deutch Lithographing Co. v. Boorman*, 15 F. 2d 35 (1926); *Deward & Rich et al. v. Bristol Savings and Loan Co.*, 29 F. Supp. 777 (D. C. Va., 1939).

<sup>25</sup> *International News Service v. Associated Press*, 248 U. S. 215, 39 Sup. Ct. 69, 2 A. L. R. 293 (N. Y., 1918).

<sup>26</sup> 275 F. 797 (C. C. A. 7th, 1921).

bare recital of facts, and was protected by copyright laws. The defendant copied the particular power of portrayal and felicity of wording and phrasing." Therefore it seems clear that news as such is not copyrightable, although the literary value of some particularly meritorious feature is protected, but not because of its news element. An English case, *Oldham Press v. London & Provincial Sporting News Agency*,<sup>27</sup> held that bookmakers odds were merely news and not subject to copyright, and an American case decided that news items relating to building and engineering construction work are not within the operation of the copyright statute.<sup>28</sup> An actual happening is within the public domain; thus where a play, "Dishonored Lady" and a movie, "Letty Lytton" were both based on the famous murder trial of Madeleine Smith in 1857, the court held the movie did not infringe the play's copyright because all the facts were in the public domain and not subject to copyright protection.<sup>29</sup>

It seems to be the universal rule that words are not copyrightable either. In *Lewys v. O'Neill*,<sup>30</sup> Lewys sued Eugene O'Neill for infringement of the former's book, "Temple of Pallas," by the defendant's "Strange Interlude;" the plaintiff showed certain similarities in phrases used by the characters — such as one actor in a particular scene calling another "an old fox." The court said that the plaintiff couldn't claim a copyright on words in the dictionary, or on usual English idioms. Thus copyright gives no exclusive right to the use of words, but rather protects the order in which they are employed to give expression to the author's ideas.<sup>31</sup>

## 2. Things of Practical Use

A thing which is intended solely to be put into practical use cannot be copyrighted, for this is really in the field of patent law. Articles designed for physical use rather than to convey information or intellectual conceptions are not copyrightable, and must be protected, if at all, under patent laws.<sup>32</sup> Copyright statute generally gives protection to books, but not so to books of the following types: blank books for use in business or carrying out any system of transacting affairs, such as record books, account books, memorandum books, blank diaries, or journals, bank deposit and check books; forms of contracts or leases which do not contain original copyrightable matters; coupons;

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<sup>27</sup> 153 L. T. R. (N. S.) 327 (1935). See 22 VA. L. REV. 587.

<sup>28</sup> *Gilmore v. Sammons*, 269 S. W. 861 (Texas Civ. App., 1925).

<sup>29</sup> *Sheldon v. Metro-Goldwyn Pictures Corp.*, 7 F. Supp. 837 (S. D. N. Y., 1934).

<sup>30</sup> 49 F. 603 (S. D. N. Y., 1931).

<sup>31</sup> *Park v. Warner Bros.*, 8 F. Supp. 37, (S. D. N. Y., 1934); *Jeffrys v. Boosey*, 4 H. L. C. 815; *Oliver Wendell Holmes v. Hurst*, 174 U. S. 82, 43 L. Ed. 904 (1899).

<sup>32</sup> 18 C. J. S. 173.



forms for use in commercial, legal, or financial transactions which are wholly or partly blank and whose sole value lies in their usefulness.<sup>33</sup> Rule 12 of the Copyright Office says that the following are utilitarian in purpose and are not subject to copyright; toys, games, dolls, advertising novelties, instruments or tools of any kind, glassware, embroideries, garments, laces, woven fabrics, or similar articles.<sup>34</sup> In agreement with this is Rule 8 of the Copyright Office which names the following as not being protected by the copyright law: dances, animal shows, scenery, stage properties, movie scenarios (unless in book form),<sup>35</sup> although there is a special provision in the copyright statute for dramatic performances.

*Amberg File & Index Co. v. Shea Smith & Co.*<sup>36</sup> is a leading case on this subject; here a system of indexes constituting a letter file, being designed for use and not for conveying information was not a proper subject of copyright. The court pointed out the fundamental difference between copyright and letters patent: the object of the former is explanation, while that of the latter is utility. An inventor who had applied for and obtained a patent could not get a copyright on the diagrams for his invention.<sup>37</sup> However, in *Kings Features v. Fleischer*,<sup>38</sup> the court allowed a copyright on a doll, named Sparky, which was modeled after the picture of the horse in the comic cartoon, "Barney Google and Spark Plug." The court said here that the form of the horse, embodying the sense of humor, was the essence of the cartoon, and the cartoon couldn't be copied by manufacturing a toy or doll, without taking the copyrightable form of the concept of the picture. And in *Falk v. Howell*,<sup>39</sup> a copyright of a photograph illustrating a musical composition of Yum Yum in Gilbert and Sullivan's "Mikado" was infringed by stamping this picture in raised figures on leather chair bottoms and back. Any attempt at reconciliation between these cases and the *Amberg File Case* probably must be done on the basis of just what is a thing of utility, and then decide that the utility of the articles in the *Sparky Case* and the *Falk Case* was outweighed by their artistic value. There have been attempts to secure a copyright on things of practical use by calling them reproductions of art, but courts have generally seen through this subterfuge.<sup>40</sup> A matter quite in point is that copyright of a pictorial illustration of an article conveys no exclusive monopoly in the making or selling of the article itself; the

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<sup>33</sup> Rule 5 of the Copyright Office. See AMDUR, COPYRIGHT LAW AND PRACTICE.

<sup>34</sup> Rule 12 of the Copyright Office. See *Adelman v. Sommers & Gordon*, 21 U. S. PAT. Q. 218.

<sup>35</sup> Rule 8 of the Copyright Office.

<sup>36</sup> 82 F. 314, (C. C. A. 7th, 1897).

<sup>37</sup> *Korsybylski v. Underwood and Underwood, Inc.*, 36 F. 2d 729 (C. C. A. 2nd, 1929).

<sup>38</sup> 299 F. 533 (C. C. A. 7th, 1924).

<sup>39</sup> 37 F. 202 (C. C. S. D. N. Y., 1888).

<sup>40</sup> *Horsman & Aetna Doll v. Kaufman*, 285 F. 373 (C. C. A. 2nd, 1922).

copyright merely protects the copying of the illustration into another illustration.<sup>41</sup> This would seem only to discredit further the findings in the *Sparky* and *Falk* cases, unless you decide that the doll was not a thing of utility, or that the leather seat cover was more a picture of Yum Yum than a seat cover.

### 3. Government Publications and Official Court Opinions

The Copyright Act of 1909 says, "No copyright shall subsist . . . in any publication of the United States Government, or any reprint, in whole or in part thereof,"<sup>42</sup> then stating that a government republication of a copyrighted work cannot be an abridgment of the copyright. From this it would seem clear that products of government publication are not property to be protected by copyright law. Thus, in *Woodman v. Lydiard-Peterson*<sup>43</sup> the court, citing the Act of March 4, 1909, Section 7, decided that no copyright could be obtained on the features of a map which had previously appeared on a government map, but that certain new features the plaintiff had added could be copyrighted. In *Du Puy v. Post Telegram*,<sup>44</sup> the plaintiff newspaper published and copyrighted an article entitled, "Peace Day in Uncle Sam's Schools," based on a peace day program as outlined in a government pamphlet of the United States Bureau of Education. The defendant newspaper had substantially copied the plaintiff's article, but the court denied the plaintiff relief, saying that the bulletin was an official public document, one which by its public character was by statute exempted from copyright appropriation. That which had been given to the public in an official bulletin could not afterwards be taken from that public in the guise of copyright, and an article based on the official reports of General Pershing could not be protected.<sup>45</sup> Also where the complainant had made a map of the principal cities of North America, largely copied from a government map, misplacement of some of the cities and use of three different kinds of symbols was too trivial a change to allow the validity of his copyright.<sup>46</sup>

There is some difficulty when it comes to official court reports, and other legal writings, for it has been the policy of the law to protect and grant copyright to the reporter in his compilation of the official opinions with his own syllabi; but it seems that he could secure no copyright for the official syllabus of the court. The courts in deter-

<sup>41</sup> *National Cloak Co. v. Standard Mail Order*, 191 F. 528 (S. D. N. Y., 1911); *Lamb v. Grand Rapids Furniture Co.*, 39 F. 474 (Mich., 1889); *National Cloak & Suit Co. v. Kaufman*, 189 F. 215 (C. C. M. D. Pa., 1911).

<sup>42</sup> Copyright Act of March 4, 1909, § 7. Also see *Fred Fisher, Inc. v. Dillingham*, 298 F. 145 (D. C. N. Y., 1924).

<sup>43</sup> 192 F. 67 (C. C. Minn., 1912).

<sup>44</sup> 210 F. 883, 127 C. C. A. 493 (1914).

<sup>45</sup> *Eggers v. Sun Sales Corp.*, 263 F. 373 (C. C. A. 2nd, 1920).

<sup>46</sup> *Andrews v. Guenther Pub. Co.*, 60 F. 2d 555 (D. C. S. D. N. Y., 1932).

mining whether there has been a copyright infringement in these cases have run into a good deal of trouble, and tread a tightrope that is precarious to say the least. The general rule seems to be that if the reporter or the publisher of the reports obtains a copyright, he is only protected from an actual copying of these reports by another — that another digester could not copy his work, but could use it for a guide in conducting his own investigations which would ultimately lead to practically the same result. But see *Banks Law Publishing Company v. Lawyers' Co-Op.*<sup>47</sup> where the court said, "Conceding the right of the official reporter of the Supreme Court of the United States to secure a copyright on his own work in volumes of published reports, the mere arrangement of cases and sequence and their paging and distribution into volumes are not features of such importance, as to entitle him to copyright protection of such details." Under the reasoning above, just what would a reporter have to add to official reports in the line of novel and original steps to obtain copyright protection? Official law reports are hardly open to literary elaboration. The Montana court in *State ex rel. Helena Allied Printing Council v. Mitchell*<sup>48</sup> makes the bald statement that anything contained in an opinion prepared and published by the court cannot be copyrighted. In accord with this decision are statutes in some states, among them New York,<sup>49</sup> which forbid the obtaining of any copyright or exclusive right of publication in the court reports. And in *Davidson v. Wheelock*,<sup>50</sup> the tribunal said that while a compilation of the statutes of a state may be so original as to entitle the author to a copyright on account of the skill and judgment displayed in the combination and analysis, he cannot obtain a copyright for the publication of the laws alone, nor can the legislature confer any such privilege upon him. "Materials for such publication are open to the world. They are public records, subject to inspection by anyone, under such rules as will secure their preservation." However, in *Banks v. McDivitt*,<sup>51</sup> a copyright infringement was decided for the complainant where the defendant had copied the Rules of Practice of the Supreme Court of the State of New York, because he had actually copied the plaintiff's work, not reaching his results from private investigation. It is questionable whether this result would be reached now in New York in the face of the New York statute previously cited.

It would seem from the cases cited in this section that copyright will not protect matters from a government publication, and will protect compilations of legal reports only in so far as these compilations have

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<sup>47</sup> 169 F. 386 (C. C. A. 2nd, 1909). Also *Edward Thompson Co. v. American Law Book Co.*, 122 F. 922, 62 L. R. A. 607 (C. C. A. 2nd, 1903).

<sup>48</sup> 74 P. 2d 417 (Mont., 1938).

<sup>49</sup> NEW YORK CONSOLIDATED LAWS, Ch. 31, § 442.

<sup>50</sup> 127 F. 61 (C. C. D. Minn., 1866).

<sup>51</sup> 13 Blatchf. 163, 2 F. Cas. 759, F. Cases 961 (C. C. S. D. N. Y., 1875).

some particular merit in the arranging and annotations, or in the reporter's own syllabus.<sup>52</sup> After all, about all of these legal reports are matters of common knowledge, at least supposedly among lawyers, and there should be something beyond their public nature to protect them from someone else using them.

#### 4. *Titles and Authors' Names*

Contrary to a rather popular impression, the title of a copyrighted work, apart from the work itself, is not protected by its copyright. Thus the fact that you have a copyright on a book will not prevent another from using the same title on another, but dissimilar, work. In *Osgood v. Allen*,<sup>53</sup> the title of a copyrighted publication was "Our Young Folks" and the plaintiff sought to restrain the use of the words, "our young folks" as a name for the defendant's periodical. The court said, "The title does not necessarily involve any literary composition; it may not be, and certainly the statute does not require it to be, the product of the author's mind. It is a mere appendage, which only identifies and frequently does not in any way describe, the literary composition itself." Thus, in *Patten v. Superior Talking Pictures*,<sup>54</sup> it was decided that the copyright to the "Frank Merriwell" books did not protect the title. However, the court granted the plaintiff relief on the grounds of unfair competition. The same line of reasoning was used in the case of *Warner Brothers, Inc. v. Majestic*,<sup>55</sup> where the plaintiff had secured a copyright on his motion picture and play, "The Gold Diggers," and "Gold Diggers of Broadway," both of which had enjoyed considerable successes. The defendant had produced a movie entitled, "Gold Diggers in Paris;" the court said that the copyright did not carry with it the protection of the title. But again relief was granted for the plaintiff not on a breach or infringement of his copyright, but on a liability under unfair trade practices, saying that the words "gold diggers" in the defendant's title would be unfair and misleading and would represent to the public that the picture was produced by Warner Brothers. It has been said that the copyright of a book does not prevent others from taking the same title for another book, although the copyright on that book has not expired; nor is a title in itself subject to a copyright.<sup>56</sup>

It can be seen from a perusal of these cases that the courts are eager to protect the author of the title on the basis of unfair trade —

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<sup>52</sup> *West Publishing Co. v. Edw. Thompson Co.*, 176 F. 833 (C. C. A. 2nd, 1910); *Mead v. West Pub. Co.*, 80 F. 380 (C. C. D. Minn., 1896); *West Publishing Co. v. Lawyer's Co-Op. Publishing Co.*, 64 F. 360, 25 L. R. A. 441 (C. C. N. Y., 1894).

<sup>53</sup> 18 F. Cas. 871, 1 Holmes 185 (C. C. Me., 1872).

<sup>54</sup> 8 F. Supp. 196 (D. C. N. Y., 1934).

<sup>55</sup> 70 F. 2d 310 (C. C. A. 2nd, 1934).

<sup>56</sup> *Glaser et al. v. St. Elmo*, (C. C. S. D. N. Y., 1909).

that the title must not be used as a false token to mislead the subsequent readers into the belief that the second work is that of the original owner of the copyright. Titles will especially be protected in this field of unfair competition where it has acquired a secondary significance in that the public has come to absolutely identify the particular work by its name. Thus in *Foundation Films v. National Pictures*,<sup>57</sup> while the plaintiff's copyright to his motion picture, "Blind Youth" was not infringed by the defendant using "Blindness of Youth" in his motion picture, the court decided there was unfair competition. It laid down a test of competition, ". . . that there must be a real present or prospective competition, that is, an endeavor to get the same trade from the same people at the same time and that endeavor on the defendant's part must be unfair, that is, with a wrongful intent to gain advantage of that celebrity." In *Atlas Manufacturing Co. v. O. G. Smith*,<sup>58</sup> although the plaintiff had issued a series of "dime novels" entitled the "Nick Carter" stories, and the defendant had filmed a picture called "Nick Carter, the Great American Detective, or Solving the \$100,000 Jewel Mystery" but took nothing of the plot or situations from any of the plaintiff's stories, it was held that there was no infringement of copyright, nor was there any unfair competition. In *Alonson v. Fleckenstein*,<sup>59</sup> the court refused to consider whether there was copyright infringement, because the important thing was to determine whether the defendant by his operetta was endeavoring to avail himself of the reputation made by the plaintiff. There has been some confusion of this issue in a few cases; thus, in *Paramore v. Mack Sennett*,<sup>60</sup> the court in considering whether there was an infringement of the copyright on plaintiff's poem, "Yukon Jake," by the defendant's piece with a similar title, decided there was an infringement, although all their reasoning seemed to lead to the more valid conclusion that recovery for the plaintiff could be allowed only on the idea of unfair competition.

In line with this matter of titles is the ruling that an author has no exclusive rights to the use of his name. The famous case illustrating this point is that of *Clemens v. Bedford (The Mark Twain Case)*<sup>61</sup> in which the court handed down a decision to the effect that copyright did not protect the author's name, nor his *nom de plume*. However, this does not mean that the author is left without recourse for an unwarranted and unsanctioned use of his name, for several states have statutes protecting the "right of privacy," thus prohibiting the unauthorized use of a name or portrait for advertising and other purposes.<sup>62</sup>

<sup>57</sup> 266 F. 208 (C. C. A. 2nd, 1920).

<sup>58</sup> 122 C. C. A. 568, 204 F. 398, 47 L. R. A. (N. S.) 1002 (1913).

<sup>59</sup> 28 F. 75 (C. C. Ill., 1886).

<sup>60</sup> 9 F. 2d 66 (D. C. Cal., 1925).

<sup>61</sup> 14 F. 728 (N. D. Ill., 1883). Also *Eliot v. Jones*, 120 N. Y. Supp. 789, 66 Misc. 95 (1910).

<sup>62</sup> *Ellis v. Hurst*, 128 N. Y. Supp. 145, 70 Misc. 122 (1910).

5. *Need of Merit*

A question that is sometimes propounded with regard to copyright law is: just what degree of merit is required to enable the author to secure a copyright? Must he be inventive; must his work meet with some established literary test; must it have a certain popular demand? Most authorities do not require inventive skill, and the author is entitled to copyright protection if the work is the result of only ordinary skill. Thus in *Jewelers' Circular Publishing Co. v. Keystone Publishing Co.*,<sup>63</sup> the court decided that a compilation of trade marks of various firms engaged in the jewelry and allied trades was a directory, subject to copyright.

"Right to copyright a book in which one has expended labor does not depend on whether the materials which he has collected consist of matters which are *publici juris*, or whether such materials show literary skill or originality, either in thought or language, or anything more than industrious collection."<sup>64</sup> Courts have said that all that was required to be worthy of copyright was that the material have some value to place it above mere worthlessness, and allowed a copyright on the plaintiff's topical song.<sup>65</sup> In *American Trotting Register Ass'n. v. Gocher*,<sup>66</sup> it was held that a mere compilation of facts may be protected as well as original matter showing invention.

However, any insignificant change which does not even require ordinary skill is not sufficient to endow a work with copyright protection. Thus in *Snow v. Laird*,<sup>67</sup> the plaintiff changed the negative of a photograph by putting a cane in the left hand of a reclining pictured man. The photograph had previously become public property and the question was whether this change was sufficient to make a new picture which could be copyrighted. The court decided that to allow such protection would be to encourage deceit and extortion. Such a small change would not be enough. Also, a colorable change solely for the purpose of retrieving abandoned copyright is insufficient, nor is mere aggregating of old material into a single publication sufficient amount of ordinary skill to lend copyrightability. A few cases have held that to allow a copyright there need not be ordinary skill, but only the expenditure of labor,<sup>68</sup> and there have been those to the contrary that are much stricter and require inventive merit.<sup>69</sup> Thus in *Motts Iron Works v. Clow*,<sup>70</sup> a priced catalogue illustrated with pictures of wares offered for sale was not a proper subject of copyright where the letter press

<sup>63</sup> 281 F. 83 (C. C. A. 2nd, 1922).

<sup>64</sup> *Ibid.*

<sup>65</sup> *Henderson v. Tompkins*, 60 F. 758 (C. C. Mass., 1894).

<sup>66</sup> 10 F. 237 (1895).

<sup>67</sup> 98 F. 813 (C. C. A. 7th, 1900).

<sup>68</sup> *Grey v. Russell*, 1 Story 11. See AMDUR, COPYRIGHT LAW AND PRACTICE.

<sup>69</sup> *Bullinger v. Mackay*, F. Cas. 2127, 4 F. Cas. 649.

<sup>70</sup> 82 F. 316, 27 C. C. A. 250 (Ill., 1897).

of the book was confined to a statement of the dimensions and prices, and had no literary value, and illustrations had no artistic worth. And in *George Bleistein v. Donaldson Lithographing Co.*,<sup>71</sup> the court decided that chromolithographs for the advertising of Wallace's circus, with pictures of men and women on bicycles was of sufficient merit for copyright. However, there was a strong dissent by Justice Harlow, "We are unable to discover anything useful or meritorious in the design copyrighted by the plaintiff in error other than advertisement of acts to be done or exhibited in Wallace's show. No evidence aside from deductions which are to be drawn from the prints themselves was offered to show that these designs had any original artistic qualities. No value or merit existed outside of advertising a show." Cigar labels, containing names and cuts of the faces of the dealers, together with fancy scroll work, were not "writings" subject to copyright protection.<sup>72</sup> Despite these last few cases however, the general rule remains the same, that courts will generally disregard the merit of the particular work copyrighted or to be copyrighted, and require little special skill to grant the statute's protection.

#### 6. *Illegal or Immoral Works*

No copyright can be acquired in a work which is inherently of an indecent or immoral character, or deceptive as to authorship or contents, or which is otherwise illegal.<sup>73</sup> This proposition seems to be almost too obvious to deserve mention, but there are certain questions as to what illegality or immorality would be required to vitiate chances of copyright. In *Richardson v. Miller*,<sup>74</sup> the fact that playing cards may be used for gambling, thus violating the laws against such games of chance, did not deprive them of the protection of copyright law. "Copyright will not protect the authors of immoral works. But where there is nothing immoral or improper in the prints themselves, the fact that the playing cards may be used by persons violating the laws against gambling does not deprive them of protection of the law. To do this it must appear either that there is something immoral, pernicious, or indecent in the things *per se*, or that they are incapable of any use except in connection with some illegal or immoral act." Undoubtedly copyright could not be obtained on pornographic or seditious literature or pictures. In *Egbert v. Greenburg*,<sup>75</sup> a form chart was copyrightable because it could be used by persons engaged in breeding, training, and racing horses, even though the chief use would be an illegal one, betting. A musical composition of immoral character of course could not be protected, but there is much matter for debate

<sup>71</sup> 188 U. S. 239, 47 L. Ed. 460 (1903).

<sup>72</sup> *M. B. Fahey Tobacco Co. v. Senior*, 247 F. 809 (U. S. C. A. N. Y., 1922)

<sup>73</sup> 18 C. J. S. 170.

<sup>74</sup> 20 F. Cas. 11,791 (C. C. Mass., 1877).

<sup>75</sup> 100 F. 447 (C. C. Cal., 1900).

as to just what is immoral. The word "hottest" as referring to a girl, in a song, "Dora Dean," was held to be vulgar and subject to indelicate meaning and therefore not copyrightable.<sup>76</sup> It is questionable whether the same result would be reached by courts today. Deceptive advertising will not be protected: misrepresentation of facts in an advertisement of a piano company vitiated a copyright,<sup>77</sup> and the same happened as to misrepresentations on the label of a whiskey bottle.<sup>78</sup> You cannot secure a copyright on material which has been pirated from someone else's copyrighted work. Thus a directory containing matter stolen from a prior directory is not copyrightable at least as to the matter pirated and which had been substituted in the directory without any independent investigation.<sup>79</sup> The whole field on this matter of illegal publications is largely factual, and the best general rule would seem to be that copyright will not be granted on material essentially illegal or subject to no other use than an evil one.

### *Conclusion*

Therefore, if a man writes a book and wishes to know just what in his work can be protected by obtaining a copyright thereon, let him not jump to the rash conclusion that he has secured a monopoly to everything that he has written. He will gain no protection for his theme, general idea, or source of information, or his title. And if the work is one whose main purpose is use rather than explanation, he will fail. The same applies if the subject is one taken from a government publication, or if much of the material is illegal or immoral. These different rules greatly qualify the protection afforded by the copyright statute.

*Leon L. Lancaster, Jr.*

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OIL AND GAS LAW — THE VALIDITY OF OIL AND GAS CONSERVATION LAWS INCLUDING THE OKLAHOMA WELL-SPACING STATUTE.—For years after petroleum was first discovered in paying quantities in Pennsylvania very little was known of its nature and origin. This ignorance of scientific facts about oil and gas resulted in the early Pennsylvania courts laying down the "Rule of Capture." This rule was based on the false assumption that petroleum was to be found in underground basins or lakes and on the belief that oil flowed as freely as subterranean waters. The rule was in reliance upon the inorganic theory that the supply was constantly being replenished through chemical processes.

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<sup>76</sup> *Broder et al. v. Zeno Mauvais Music Co.*, 88 F. 74 (C. C. Cal., 1898).

<sup>77</sup> *Stone & McGarrick v. Dugan Piano Co.*, 210 F. 399 (C. C. A., 1914).

<sup>78</sup> *Krauss v. Peebles's Sons Co.*, 58 F. 585.

<sup>79</sup> *Chicago Dollar Directory Co. v. Chicago Directory Co.*, 14 C. C. A. 213, 24 U. S. App. 636, 66 F. 977 (1895).



There is some dispute as to which case laid down the "Rule of Capture," but the first case of importance was probably *Westmoreland & Cambria Natural Gas Co. v. De Witt*,<sup>1</sup> in 1889.<sup>2</sup> The court there said: "Water and oil and still more strongly gas, may be classed by themselves, if the analogy be not too fanciful, as minerals *ferae naturae*. In common with animals, and unlike other minerals, they have the power and the tendency to escape without the volition of the owner. Their 'fugitive and wandering existence within the limits of a particular tract was uncertain' as said by Chief Justice Agnew in *Brown v. Vandergrift*.<sup>3</sup> They belong to the owner of the land and are part of it, so long as they are on or in it, and are subject to his control; but when they escape, and go into other land, or come under another's control, the title of the former is gone. Possession of the land therefore, is not necessarily possession of the gas. If an adjoining, or even a distant, owner, drills his own land, and taps your gas, so that it comes into his well and under his control, it is no longer yours, but his."

But to-day with modern scientific information at hand, the "Rule of Capture" is being rapidly discredited. The more modern and scientific rule of conservation is fast replacing the old rule by means of statutory provisions. The *Magna Carta* of this statutory oil and gas conservation is the Indiana case of *Ohio Oil Co. v. State of Indiana*.<sup>4</sup> This case in 1900 upheld an Indiana statute of 1893 giving the State of Indiana the right to restrict the waste of oil and gas by making it unlawful to permit oil or gas to escape into the open air, without being confined within the well or proper pipes or other safe receptacles, for more than two days after striking the oil or gas in a well. The United States Supreme Court held that the state could regulate the production of oil and gas and prohibit its waste, practically without limit; and in so doing the state was not restricted by the Fourteenth Amendment of the Federal Constitution or by the constitutional guaranties in favor of private property contained in the fundamental laws of the states.

In 1931 the United States Supreme Court further held in *Bandini Petroleum Co. v. Superior Court*<sup>5</sup> that the prohibition of waste was not contra to the due process clause of the Constitution under the police power of the state. The case upheld the principle of correlative rights and duties existing between oil operators. The following year in *Champlin Refining Co. v. Corporation Commission of Oklahoma*<sup>6</sup> Justice Butler recognized the principles of the Indiana statute case: "Every person has the right to drill wells on his own land and take

<sup>1</sup> 130 Pa. 235, 18 Atl. 724 (1889).

<sup>2</sup> The Statutory Spacing of Wells, an address by James A. Veasey, April 21, 1939, before the Louisiana Bar Association Annual Meeting, Alexandria, Louisiana, privately published.

<sup>3</sup> 80 Pa. 142 (1875).

<sup>4</sup> 177 U. S. 190, 20 Sup. Ct. 576, 44 L. Ed. 729 Aff'g., 150 Ind. 698, 50 N. E. 1125 (1900).

<sup>5</sup> 284 U. S. 8, 52 Sup. Ct. 103, 76 L. Ed. 136, 78 A. L. R. 826 (1931).

<sup>6</sup> 286 U. S. 210, 52 Sup. Ct. 559, 76 L. Ed. 1062, 86 A. L. R. 403 (1932).

from the pools below all the gas and oil that he may be able to reduce to possession including that coming from land belonging to others, but the right to take and thus acquire ownership is subject to the reasonable exertion of the power of the state to prevent unnecessary loss, destruction or waste. And that power extends to the taker's unreasonable and wasteful use of natural gas pressure available for lifting oil to the surface and the unreasonable depletion of a common supply of gas and oil to the injury of others entitled to resort to and take from the same pool."

Thus there can be seen a definite trend away from the "Rule of Capture" in the decisions of the United States Supreme Court. And it must be remembered that these decisions are backed by modern geology. When the early Pennsylvania cases were decided, geology was little known. And even in 1900 when the Indiana statute was declared valid, geology still hadn't come into its own, and that case was really far in advance of its time. It was not until about 1915 that geology really became generally accepted by the oil industry. In that year Oklahoma was the first state to adopt a comprehensive conservation and proration law. The Corporation Commission of Oklahoma was given the right to prohibit "underground waste." In 1920 George Otis Smith, Director of the Geological Survey said that implied covenants were the opposite of conservation, for the doctrine of implied covenants compels speedy drilling and full production by means of off-set wells to keep the underground oil from flowing away into wells on neighboring property.<sup>7</sup> Geology and practical experience together have proven that a prorated oil field will in the long run produce more oil from the same source of supply than would the same field if the "Rule of Capture" were to prevail and everyone tried to capture all of the oil as soon as possible.<sup>8</sup> Gas pressure has much to do with this fact, for it is important in the recovery of oil. If the gas-oil ratio is kept at a set figure (to be determined by experts) the recovery will be ultimately greater. But if the ratio is not observed and the gas pressure is wasted in the recovery of the oil, the ultimate result will be a loss in the recovery of the oil. Therefore, it can be seen that geology and conservation go hand in hand.

One of the fundamental practices of true conservation is scientific well-spacing. The 1935 Oklahoma well-spacing statute is a typical one: "In the event a producing well, or wells, is completed upon a unit where there are two or more separately owned tracts, any royalty owner or group of royalty owners, holding the royalty interest under a separately owned tract, shall share in one-eighth of all of the production from the well or wells drilled within the unit in the proration that the acreage of their separately owned tract bears to the acreage of the unit."<sup>9</sup>

<sup>7</sup> 15 NOTRE DAME LAWY. 229 (1940).

<sup>8</sup> *Op. cit. supra* note 2.

<sup>9</sup> Ch. 59, Article 1, Okla. Session Laws, 1935, 52 OKLA. ST. ANN. §§ 85-87, 136-138.

The validity of this statute was affirmed in *Patterson v. Stanolind Oil and Gas Co.*<sup>10</sup> Here the plaintiff's claim to the division of the profits of a ten-acre tract of oil land was based on the terms of his mineral deed, while the defendant oil company based its claim on the well-spacing statute and the Corporation Commission's ruling thereunder. The Commission's ruling was a typical one: "That the said well as above described is located in the approximate center of a ten-acre tract of land, and taking into consideration the depth of the well now producing in said common source, the nature and character of the reservoir energy, the formations encountered in the drilling of the well, and the history and productive characteristics of wells in other common sources of supply which have similar formations, and from other geological and scientific information and data as shown by the records, the Commission finds that a well-spacing and drilling unit of ten-acres and of uniform size should be established in the said North Wellston pool; that the same would tend to effect and would result in uniform withdrawal and in the greatest ultimate recovery of oil, and would best conserve reservoir energy, and would protect the relative rights of the leaseholders and royalty owners in said common source of supply." The plaintiff claimed under the "Rule of Capture" that it is fundamental oil and gas law that the owner is entitled to all such minerals that he is able to reduce to possession. But the defendant contended that the plaintiff's theory is not applicable to oil and gas derived from a source of supply common to adjoining tracts of land and that the production of the well in question was derived from such a common source of supply. The Oklahoma Supreme Court upheld both the statute and the Commission's ruling thereunder, thus agreeing with the defendant's contention. In so holding the court said: "The police power of the state extends to protecting the correlative rights of owners in a common source of oil and gas supply and this power may be lawfully exercised by regulating the drilling of wells into said common source of supply and distributing the production thereof among the owners of mineral rights in land overlying said common source of supply." The court also said that the plaintiff's property had not been confiscated, but its use had merely been restricted and qualified, which, of course, does not violate the due process clause of the Federal or Oklahoma State Constitution. So the plaintiff must submit to the police power of the state. The court reasoned that since the police power of the state may be exercised by the regulation of production,<sup>11</sup> why not regulate production by the regulation of the drilling of wells by means of well-spacing acts. It would be far better to restrict the drilling of wells than to restrict their production after they are drilled. It is known that too many wells will tap too quickly the common reser-

<sup>10</sup> 305 U. S. 376, 59 Sup. Ct. 259, 83 L. Ed. 231 Aff'g., 182 Okla. 155, 77 Pac. 2d 83 (1938).

<sup>11</sup> *Op. cit. supra* note 5.

voir and thus will waste the gas energy needed for the natural flow of the oil. The less the reservoir is punctured, the less the supply of reservoir energy is likely to be depleted. This "back-pressure" should not be wasted.

Thus the court got to the root of the problem, the number of wells themselves. By cutting down on the number of wells, each well that is drilled will be permitted to pump more oil than if there were a greater number of wells. Thus by limiting the wells, the same amount of oil can be produced while better preserving the gas pressure and while saving the cost of drilling additional unnecessary wells. The result is two-fold: the industry itself is served by lower-cost production, and the public is benefited by more reasonable prices for petroleum products.

The conservation theory is gaining so rapidly over the "Rule of Capture" that it is safe to say that it will soon replace it entirely. Today all but two of the larger oil producing states have united in an inter-state pact for the conservation of oil and gas. The only large oil producing states that have not as yet joined the pact are California and Illinois. But these two states are the second and third largest oil producing states, in the Union respectively, Illinois having just recently surpassed Oklahoma as the third ranking oil producing state. In August, 1939, when the states in the pact agreed to shut down production entirely in an effort to raise crude oil prices, California and Illinois refused to cooperate and continued to flood the market. It is such lack of cooperation as this that may eventually bring federal control of the industry. The "Cole Bill"<sup>12</sup> calling for such federal control by means of an Office of Petroleum Conservation was defeated recently, but it may be just a preliminary attempt to put the industry under federal control.

It is to be hoped that such states as California and Illinois will soon join the interstate pact, and will thus complete the triumph of the conservation theory over the "Rule of Capture" without the evils of federal control being included. Illinois in particular should beware, for the Illinois wells are noted for slipping rapidly in production. Unless another large field is discovered in the state, Oklahoma with its steady prorated production will soon take over its former place as the third largest oil producing state. But whether the triumph of the conservation theory comes by means of federal control or by fear of it, with the states taking the initiative, it is certainly coming soon.

*James H. Graham, Jr.*

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<sup>12</sup> *Op. cit. supra* note 2.

<sup>13</sup> H. R. 7372, The Petroleum Conservation Act of 1939, a bill to promote the conservation of petroleum.

TESTAMENTARY CAPACITY AND THE BURDEN OF PROOF.—As the statutes of most states require a testator to be of sound mind at the time he executes his will, it becomes important to discover just what constitutes "soundness of mind" as pertaining to the execution of a will. The courts are almost unanimous in holding that perfect sanity is not required. "To constitute a sound and disposing mind, it is not necessary that the mind should be wholly unbroken, unimpaired, and unshattered by disease or otherwise, or that the testator be in possession of all his reasoning facilities. . . ." <sup>1</sup> In an early case, the Indiana Supreme Court held, under a statute providing that no one of unsound mind could make a will, that absolute, perfect sanity was needed.<sup>2</sup> Later this ruling was expressly overruled in the case of *Burkhart v. Gladish*;<sup>3</sup> the court holding that "soundness of mind" as used in the statute had a relative meaning connoting sanity sufficient to execute a will. The Supreme Court of Maine in carrying out this idea stated: "In law, every mind is sound that can reason and will intelligently, in the particular transaction being considered; and every mind is unsound or insane who cannot so reason. The law investigates no further."<sup>4</sup>

The mental capacity to execute a will has been compared to the mental capacity to execute other acts. In an early case,<sup>5</sup> the Pennsylvania Supreme Court overruled a case on the instruction given to the jury that "A degree of incapacity less than enough to acquit a man for a criminal charge would invalidate a will." The difficulty with this test is at once apparent. Criminal capacity involves primarily the ability to distinguish between right and wrong, while testamentary capacity involves the ability to understand the estate to be disposed of, the proper objects of the testator's bounty and the nature of the testamentary act.<sup>6</sup>

Michigan has held that the incapacity to manage property is not proof of incapacity to make a will, but the power to make a contract is equivalent to the power to make a will.<sup>7</sup> Maryland<sup>8</sup> adheres to the view that if the individual was not of sound and disposing mind and capable of making a valid deed or contract, he was not in possession of that degree of mental competency required by law for the execution of a will. Illinois has held that a greater degree of mental capacity is required for the execution of contracts and the transaction of ordinary business. Mental strength to compete with antagonists and understanding to protect his own interests are essentials in the transaction of ordinary business, while it is sufficient for the making of a will that the

<sup>1</sup> *Campbell v. Campbell*, 130 Ill. 466, 22 N. E. 620, 622, 6 L. R. A. 167 (1889).

<sup>2</sup> *Noble v. Enos*, 19 Ind. 167 (1859).

<sup>3</sup> *Burkhart v. Gladish*, 123 Ind. 337, 24 N. E. 118 (1887).

<sup>4</sup> *Johnson v. Maine & N. B. Ins. Co.*, 83 Me. 182, 22 Atl. 107, 108 (1891).

<sup>5</sup> *McTaggart v. Thompson*, 14 Pa. 149, 154 (1850).

<sup>6</sup> PAGE ON WILLS, § 138.

<sup>7</sup> *Rice v. Rice*, 50 Mich. 448, 15 N. W. 545 (1883).

<sup>8</sup> *Lyons v. Townsend*, 124 Md. 163, 91 Atl. 704 (1914).

testator understand the business in which he is engaged, his property, the natural objects of his bounty, and the disposition he desires to make.<sup>9</sup> Other jurisdictions have laid down rules of similar effect: "In order to possess the mental capacity to make a will the law, based upon experience of mankind, does not require the testator to be able to carry on a complicated business."<sup>10</sup>

In the case of *Murphy v. Nelt*,<sup>11</sup> the Montana Supreme Court criticized the jurisdiction holding that mental capacity to carry on a business or to make contracts is equivalent to the mental capacity required to execute a valid will. The question there was whether a requested instruction to the effect that less degree of mind was required to execute a will than a contract was properly refused. The court stated, "With all due respect to these learned decisions, we think that in such matters comparisons are odious, and, for purposes of instructing the jury, wholly unnecessary. To make a will, or a contract implies more than merely signing it, and it contravenes human experience to say that the conception, ordering and comprehension of a will dispensing, with care and precision, extensive property, involving, it may be, charities and trusts of various kinds, requires less capacity than the purchase of a bar of soap; or that the same intellectual capacity is required for simple holographic, 'I leave all my property to my wife' and for the elaboration of a complex trade agreement designed to accomplish far reaching results. The conclusion of common sense is that it takes more mind to make some wills than to make some contracts, and vice versa and there is excellent authority for the rule, while contractual capacity implies *prima facie* the capacity to make a will, yet neither is a test for the other, and the presence or absence of one does not conclusively establish the presence or absence of the other." The general rule as laid down by Rollison, in his work on wills<sup>12</sup> is that in the absence of delusions, one who has capacity to contract or transact ordinary business has the capacity to make a will.

In formulating a test as to just what constitutes adequate mental capacity to execute a will, the following quotation from *Drum v. Capps*<sup>13</sup> must be kept in mind, "Clearly by reason of authority, therefore, each case must be largely judged in connection with its own special facts, circumstances and surroundings." Another admonishment is found in, *In re Vaughn's Estate*,<sup>14</sup> "Any definition of testamentary capacity is more or less arbitrary and subject to revision or modification as new combinations arise." In a majority of the jurisdictions<sup>15</sup> the

<sup>9</sup> *Coleman v. Marshall*, 263 Ill. 330, 104 N. E. 1042 (1912).

<sup>10</sup> *Burnhill v. Miller*, 114 Kan. 773, 217 Pac. 274, 275 (1923).

<sup>11</sup> *Murphy v. Nelt*, 47 Mont. 38, 130 Pac. 451, 455 (1913).

<sup>12</sup> ROLLISON ON WILLS, § 53.

<sup>13</sup> *Drum v. Capps*, 240 Ill. 524, 88 N. E. 1020, 1025 (1909).

<sup>14</sup> *In re Vaughn's Estate*, 137 Wash. 512, 242 Pac. 1094, 1095 (1926).

<sup>15</sup> ROLLISON ON WILLS, § 52. Also see, *In re Di Labeaga's Estate*, 165 Cal. 607, 133 Pac. 307 (1913); *Hart v. Hart*, 290 Ill. 476, 125 N. E. 366 (1923); *Rede-*

general rule is that the testator at the time of making his will must have had ability to understand: (a) the nature of the business in which he was engaged; (b) the property to be disposed; (c) his relation to the natural objects of his bounty; (d) the manner in which he wishes to dispose of his property.

There are several views as to whom has the burden of proof and as to the presumptions as to the testator's sanity in actions to probate and contest the probate of wills. "Burden of proof" as used by the courts is a vague term. It is used in three different senses; first, to indicate that one party must maintain the affirmative of the issue by a preponderance of evidence, secondly as indicating that one party has the duty of making out a *prima facie* case, third that at any stage in the introduction of evidence one party has supported the issue by so much evidence that he will win unless the adverse party furnishes evidence.<sup>16</sup> For the purposes here, "burden of proof" will be used as defined in the first and second definitions above.

The weight of authority places the burden of showing the statutory execution of the will and the mental capacity of the testator on the proponent.<sup>17</sup> Various reasons are given for this rule. "Whoever asserts a right dependent for its existence upon a negative must establish the truth of the negative by a preponderance of evidence. This must be the rule, or it must follow that rights of which a negative forms an essential element, may be enforced without proof."<sup>18</sup> The English Courts reason that the heirs at law rest securely on the statutes of descent and distribution until some legal act has been done by which their rights under the statute have been lost. For a will to be valid and derogate the statutes of descent and distribution the testator must have been mentally competent as required by the Statute of Wills.<sup>19</sup>

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man v. Ruff, 196 Ky. 471, 244 S. W. 910 (1924); Murphy v. Nelt, *supra*, note 11; 27 L. R. A. (N. S.) 1 n.; L. R. A. 1915A, 443 n.

<sup>16</sup> PAGE ON WILLS, § 685.

<sup>17</sup> *In re Gillman's Appeal*, 115 Conn. 724, 161 Atl. 845 (1932); *Cooper v. Shannon*, 165 Ga. 451, 141 S. E. 306 (1928); *Millage v. Noble*, 334 Ill. 315, 166 N. E. 50 (1929); *Breadheft v. Cleveland*, 184 Ind. 130, 108 N. E. 5, *aff'd*, 110 N. E. 662 (1915); *Holden v. Bennett*, 243 Ky. 667, 49 S. W. 2d 568 (1932); *Appeal of Martin*, 133 Me. 422, 179 Atl. 655 (1935); *In re Brulum's Estate*, 240 Mich. 393, 215 N. W. 299 (1927); *Guttings v. Howard*, 122 Miss. 355, 84 So. 240 (1920); *Soureal v. Wisner*, 321 Mo. 920, 13 S. W. 2d 548 (1929); *In re Boyer's Estate*, 119 Neb. 191, 227 N. W. 928 (1928); *In re Strang's Will*, 109 N. J. Eq. 523, 158 Atl. 489 (1932); *In re McClear's Will*, 214 App. Div. 683, 213 N. Y. Supp. 66, *aff'd*, 247 N. Y. 544, 161 N. E. 175 (1926); *Peace v. Peace*, 149 Okla. 123, 299 Pac. 451 (1931); *In re Rigg's Estate*, 120 Ore. 38, 250 Pac. 753 (1926); *In re Llewellyn's Estate*, 296 Pa. 74, 145 Atl. 810, 66 A. L. R. 222 (1929); *Hollingworth v. Kresge*, 48 R. I. 341, 137 Atl. 908 (1927); *Sutton v. Sadlier*, 3 C. B. (N. S.) 87, 140 Eng. Rep. 671 (1857).

<sup>18</sup> *Steinkuehler v. Wemper*, 169 Ind. 154, 160, 81 N. E. 482, 484, 15 L. R. A. (N. S.) 673 (1907).

<sup>19</sup> *Sutton v. Sadlier*, *supra*, note 17.

The right to make a will is neither a constitutional nor a common law right but one conferred by statute. Therefore one relying on a will must prove it conforms to the statute which gave the power under which it was made.<sup>20</sup>

The jurisdictions holding according to the above ruling are in conflict as to just how this "burden of proof" must be met or satisfied. Many courts have ruled that it is not necessary to prove the mental competency of the testator by affirmative evidence; that after proving the formal execution of the will the common law presumption that all men are sane comes into effect and a *prima facie* case is established in favor of the proponent.<sup>21</sup> The presumption that all men are sane is a very deep rooted principle of law. "Sanity, for example, being the normal condition of man, the courts will presume every man to be sane until the contrary is proved."<sup>22</sup> The general presumption of sanity applies to criminal acts, every one presumed to be sane and criminally responsible for his acts.<sup>23</sup> The law of contracts and conveyances also recognizes this presumption.<sup>24</sup> This presumption is not conclusive and may be overcome by competent evidence. "The presumption of sanity, cannot, we think be treated as merely artificial or legal presumption, but at the utmost, as a presumption of law and fact that is an inference to be made by the jury from the absence of evidence to show that a party does not enjoy that soundness which experience proves to be a general condition of the human mind."<sup>25</sup> Kentucky holds that the proponents must show more than the statutory formal execution of the will before the presumption comes into effect in the following: "The rule is if the will is rational and consistent on its face in its structure and language, the contestees [proponents] have shown statutory execution, the burden shifts to the contestants to establish the unsoundness of mind of the testator, but, if the will is so irrational or inconsistent as to be incompatible with the soundness of mind, then the introduction of evidence of mental soundness is necessary in the preliminary proof for the propounders."<sup>26</sup> So it is that the instrument is often the best evidence against itself.<sup>27</sup>

In Michigan, the rule that the proponent has the burden of proving testamentary capacity by affirmative evidence<sup>28</sup> was changed by stat-

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<sup>20</sup> Appeal of Martin, *supra*, note 17.

<sup>21</sup> Cooper v. Shannon, Millage v. Noble, Breadheft v. Cleveland, Holden v. Bennett, *In re Boyer's Estate*, *In re Strang's Will*, *In re Rigg's Estate*, *In re Llewellyn's Estate*, Hollingworth v. Kresge, Sutton v. Sadlier, *supra*, note 17.

<sup>22</sup> 10 R. C. L. (1929) § 25, 14 R. C. L. (1929) § 74.

<sup>23</sup> Sanders v. The State, 94 Ind. 147 (1884).

<sup>24</sup> Menkins v. Lightner, 18 Ill. 282 (1882).

<sup>25</sup> Sutton v. Sadlier, 3 C. B. (N. S.) 87, 140 Eng. Rep. 671, 675 (1857).

<sup>26</sup> Holden v. Bennett, *supra*, note 17.

<sup>27</sup> Jackson Excr's. v. Semmes, 266 Ky. 352, 99 S. W. 2d 505 (1937).

<sup>28</sup> Preveles v. Bates, 93 Mich. 234, 53 N. W. 153 (1892).



ute.<sup>28a</sup> In a holding subsequent to the taking effect of this statute, it was ruled that the common law presumption of sanity shall prevail in favor of the proponent.<sup>29</sup>

A few jurisdictions while placing the burden of proof of the mental capacity of the testator on the proponent hold that the mental capacity must be proved by affirmative evidence.<sup>30</sup> Some of these courts have held that the statutes that give the power to dispose of property by will are in derogation of the common law and therefore should be interpreted literally; that the provision in these statutes requiring the testator to be of sound mind at the time he executes the will repealed the common law presumption of sanity in such cases.<sup>31</sup> Connecticut courts<sup>32</sup> have reasoned that since the law requires witnesses to be present at the time of the execution of the will, it is necessary to have them testify as to the mental capacity at the time, and not only the formal execution of the will. These courts believe it is logical to place more faith in the observations of the witnesses than in the presumption of sanity.

Under a statute providing "the contestant is the plaintiff, and the petitioner is the defendant,"<sup>33</sup> in actions to probate wills, the Supreme Court of California has placed the burden of proof of testamentary capacity on the contestant.<sup>34</sup> The court stated that it was unable to see any good reason for the somewhat peculiar statutory provision as far as contest before probate is concerned but that it must take the law as it finds it.

Although Colorado,<sup>35</sup> Indiana,<sup>36</sup> and Washington<sup>37</sup> place the burden of proof on the proponent before probate, they shift the burden to the contestant after probate.<sup>38</sup> "The admission of a will to probate by a court having jurisdiction is a judicial act and like other valid judgments cannot be collaterally impeached for error or irregularity, but is binding until reversed or set aside according to law, and for that

<sup>28a</sup> COMP. LAWS, MICH. (1929) § 14212. "In proceedings for the probate of wills it shall not be necessary for the proponent in the first instance to introduce any proof to show the competency of the decedent to make a will but like presumption of mental capacity shall obtain as in other cases."

<sup>29</sup> Bereton v. Glazebys Estate, 250 Mich. 234, 231 N. W. 566 (1930).

<sup>30</sup> *In re Barber's Appeal*, 115 Conn. 724, 161 Atl. 845 (1935); *Fields v. Luch*, 335 Mo. 765, 74 S. W. 2d 35 (1934); *Mechen v. Mechen*, 17 W. Va. 683, 41 Am. Rep. 682 (1881).

<sup>31</sup> *Fields v. Luch*, *supra*, note 30.

<sup>32</sup> *In re Barber's Appeal*, *supra*, note 30.

<sup>33</sup> CAL. CODE, CIV. PROC., § 1312 (1937).

<sup>34</sup> *In re Latour's Estate*, 140 Cal. 414, 40 Pac. 1070 (1903).

<sup>35</sup> *Nelson v. Phillips*, 70 Colo. 196, 199 Pac. 481 (1921).

<sup>36</sup> *Breadheft v. Cleveland*, 184 Ind. 130, 108 N. E. 5; *aff'd.*, 110 N. E. 662 (1915).

<sup>37</sup> *In re Baldwin's Estate*, 13 Wash. 666, 43 Pac. 934 (1896).

<sup>38</sup> *In re Hayes' Estates*, 55 Colo. 340, 135 Pac. 449, Ann. Cas. 1914C, 531 (1913); *Steinkuhler v. Wemper*, 169 Ind. 154, 81 N. E. 482, 15 L. R. A. (N. S.) 673 (1907); *In re Adam's Estate*, 112 Wash. 379, 192 P. 887 (1920).