Topic Area 2

Material Subject to Copyright

A. Introduction, Key Concepts

A.1. What's the question? What's the topic?

This portion of our exploration of copyright law concerns what can be embraced within the exclusive privilege of copyright. In other words: *What is copyrightable subject matter?*

Another way of putting it is that we are after the answer to the question that laypersons often phrase as, "Can that be copyrighted?" But please don't phrase the question like that yourself. There's a whole slew of problems that come with using "copyright" as a verb. (Also, it tends to be a mark of someone who is totally unfamiliar with copyright law.)

To be fair, the verb compunction is understandable. The adjective "copyrightable" makes it sound like "copyright" would be a verb. After all, "copyrightable" would seem to mean "capable of being copyrighted," in which case one might reasonably infer there's some way "to copyright" something. Yet that's not right. Though counterintuitive, you must understand that the word "copyrightable," as used by courts and lawyers, does not imply the possibility of undertaking some action.

And that's why "copyright" isn't a verb. "Verbs are action words," said thousands of grade school teachers just last year. And there's no action associated with making a *copyrightable* work into a *copyrighted* work. Crucially,

U.S. copyright law causes something to be copyrighted the instant it is copyrightable.

Thus, "copyrightable" just means "capable of being subject to an exclusive right of copyright law."

And to be "capable of being subject to an exclusive right of copyright law," a thing has to be original, creative expression, authored by a human being that is fixed in some tangible form from which it can be later reproduced or absorbed as a communication by a reader/viewer/listener.

What does "original" mean? What does "creative" mean? "Authored"? "Fixed"?

Well, of course, the answer is: It's complicated.

A.2. A general, non-technical explanation of copyrightable subject matter

Pre-reading notes

The following was cobbled together from text written and published by the U.S. Copyright Office and the Congressional Research Service. The USCO and CRS wrote what they wrote for a non-specialist audience – members of the general public and non-lawyers in government. Thus, this is an accessible synthesis of a complex and sometimes hazy area of law. For law students, it makes for a good introduction to the subject.

Explanation of copyright protection basics

What is copyright?

Copyright is a form of protection provided by the laws of the United States to the authors of "original works of authorship" that are fixed in a tangible form of expression. An original work of authorship is a work that is independently created by a human author and possesses at least some minimal degree of creativity. A work is "fixed" when it is captured (either by or under the authority of an author) in a sufficiently permanent medium such that the work can be perceived, reproduced, or communicated for more than a short time.

Today, copyright protection in the United States exists automatically from the moment the original work of authorship is fixed. (Before 1978, federal copyright was generally secured by publishing a work with an appropriate copyright notice. At that time, publishing without the notice put the work permanently into the public domain.)

Examples of copyrightable works include:

- Literary works
- Musical works, including any accompanying words
- Dramatic works, including any accompanying music
- Pantomimes and choreographic works
- Pictorial, graphic, and sculptural works
- Motion pictures and other audiovisual works
- Sound recordings, which are works that result from the fixation of a series of musical, spoken, or other sounds
- Architectural works

The above categories should be viewed broadly for the purposes of protectability. For example, computer programs and certain "compilations" can be registered as "literary works"; maps and technical drawings can be registered as "pictorial, graphic, and sculptural works."

Copyright does not protect:

- Ideas, procedures, methods, systems, processes, concepts, principles, or discoveries
- Works that are not fixed in a tangible form (such as a choreographic work that has not been notated or recorded or an improvisational speech that has not been written down)
- Titles, names, short phrases, and slogans
- Familiar symbols or designs
- Mere variations of typographic ornamentation, lettering, or coloring
- Mere listings of ingredients or contents

Originality and Fixation Requirements for a Copyrightable Work

To be copyrightable, a work must be original and fixed in some tangible form.

To be original, a work must be independently created (i.e., not copied from another person) and have at least a minimal degree of creativity. For example, neither an unoriginal collection of facts (such as an ordinary telephone number directory) nor a work copied entirely from a previous work is copyrightable.

A work must also be fixed in a tangible medium of expression to be copyrightable. This means that a work has to be recorded in some way so that it can be later perceived, communicated, or reproduced. For instance, a live musical performance is not fixed unless someone records it, such as by taking a video of the performance on a smartphone or by writing it down in musical notation.

In all cases, even if some work is "copyrightable," copyright protection applies only to the work's creative expression. It does not extend to the ideas, processes, systems, discoveries, or methods of operation that may be described in the work. For example, while copyright might prevent others from copying the words in a book verbatim, another person could still explain the idea communicated by the book using different words.

A.3. Statute: 17 U.S.C. §102 – Subject matter of copyright: In general

Pre-reading notes

This statute is the current basic statutory provision on copyrightability. It was originally enacted as part of the Copyright Act of 1976.

In part, §102 is truly *statutory* in nature – as in law that was laid down by the legislature. For instance, the section was amended in 1990 to add "architectural works." And once that amendment was made, the law changed so that architectural works were henceforth susceptible to copyright protection.

But it is also true that §102 provision is large part a vessel for court-made common law. Long before 1976, the federal courts developed doctrine about what is copyrightable and what is not. Now, some of that caselaw about

copyrightability springs from the Constitution itself, and thus Congress couldn't change that law through legislation even if it wanted to. But it is also true that much of the law of copyrightability, as developed by the courts, was meant to be undisturbed by Congress when it re-worked copyright statute. And in this way, §102 represents Congress giving its blessing to the courts to continue to develop the law of copyrightable subject matter. (And that is why cases from the 1800s continue to be important today to understanding what is copyrightable.)

Thus, as you read §102, be aware that this statute, by its language, is the final answer as to some legal questions in this area, but as to other legal questions, it leaves the matter up to the courts.

Statute text

17 U.S.C. §102 – Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

(3) dramatic works, including any accompanying music;

(4) pantomimes and choreographic works;

(5) pictorial, graphic, and sculptural works;

(6) motion pictures and other audiovisual works;

(7) sound recordings; and

(8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

A.4. The foundational concepts of copyrightability considered together

From the statute and the explanations above, you can see that there are a number of concepts that are crucial to copyrightability, including "originality," "creativity," "authorship," "fixation," and "expression" – particularly "expression" as distinguished from facts, from ideas, and from procedures/processes/systems/methods and expression.

It would be convenient if each of those were a crisply separate concept, each with its own crisply articulated test. But reality is messier.

These meaning of these concepts – what's in, what's out, and how to know – is not prescribed by statute. Instead, it's left up to the caselaw. And there aren't clear tests that come out of the caselaw. To understand the concepts, you have to understand the cases themselves. That means understanding the facts, knowing the outcome, and understanding how the court reasoned from the facts to the outcome.

What's more, there are multiple cases that are important to understanding each concept. And there are often multiple concepts dealt with in each case. That complicates learning the law in this area, and it complicates the matter of organizing a casebook. If there were a one-to-one correspondence of copyrightability doctrine and controlling U.S. Supreme Court case, that would make things easy. But alas, that's not the situation. Newer cases don't replace older cases in explaining the concepts. Instead, they build upon them and provide an additional layer of articulation.

The concepts foundational to copyrightability are interrelated. Leading cases tend to talk about more than one at a time. It's fair to say the caselaw of copyrightability exists as a giant tangle. But a gentler way of thinking about it is that the cases form a sort of woven braid, one that starts in the 1800s continues through the 1900s, and is being lengthened even today.

So instead of trying to impose rigid order upon the caselaw by forcing them into a compartmented doctrinal schematic, this casebook presents the cases in an order based on where each successive case makes a good follow-on to the case before it. The same way a disc jockey would make a setlist or a BFF would make a mixtape: These three songs go together, and these two go together, and these four work well in a succession – and you try to link them

up in overlapping sets of similarities. That's the explanation for the ordering of the cases, and it works out to being very close to chronological.

Working through the cases this way, you may come to perceive that all these requirements and distinctions – fixation, originality, the idea/expression divide – are all just tools for describing something deeper: a singular, unified, underlying concept of what can qualify as copyrightable subject matter. One potentially useful way to think about the law is this: When a court understands, at some gut level, that a plaintiff is claiming a copyright over something that doesn't fit the copyrightability mold, then court will employ whatever doctrinal concepts there are that are useful to articulating a rationale for rejecting the claim.

A.5. Field guide to copyrightability concepts and terms

Realism about the interrelatedness of copyrightability concepts and cases can be very helpful to understanding. But we don't want to go from clear-eyed to misty-eyed in talking about how copyrightability concepts and cases form some kind of eternal woven torsade of jurisprudence. Lawyers don't want to explain a legal argument in a way that makes a judge's eyes roll.

Inevitably, courts and commentators tend to speak about things like originality, creativity, and authorship, for instance, as independent requirements. Even if arguably they aren't. That's a practical and maybe even a necessary analytical approach for lawyer work – writing a brief, drafting a memo, answering a question from the bench and so on.

Thus, as you go through the case, keep in mind the following doctrines (i.e., developed and relied-upon legal concepts). And use the cases to help you fill out your understanding of how to explain these and use them in forming arguments:

- ***expression*** – To be copyrightable, a work must be an expressive work.
- ***fixation*** – To be copyrightable, a work must be fixed in some tangible medium. This rules in works written on paper, captured on photographic film, recorded to audio tape, or captured as text/video/audio to computer memory. The fixation requirement rules out works solely existing in human memory or those

communicated solely in an ephemeral form such as spoken out loud, said over phone lines, or broadcast over radio without being recorded or captured in some way from which they could be later perceived or reproduced.

- ***originality*** – To be copyrightable, a work must be original – the independent intellectual product of an author reflecting some modicum of creativity.
- ***creativity*** – To be original, a work must have some "modicum of creativity." As the caselaw shows, a "modicum" isn't much.
- ***human authorship*** – To be copyrightable, a work must be a work of authorship, and the author has to be a human one.
- ***fact/expression distinction*** – Facts are not copyrightable; thus, facts must be distinguished from expression, which is copyrightable.
- ***idea/expression distinction*** – Ideas are not copyrightable; thus, ideas must be distinguished from expression, which is copyrightable.

And keep in mind these concepts which go to recurring circumstances and situations encountered in the cases.

- ***works*** – The work is the "thing" of copyrightability. A poem, a film, an illustration, a novel – each of those is a work, and "a copyright" attaches to "a work." The work is distinguished from any material object in which it is fixed. A poem can be printed on paper, but the poem's existence as a work is independent of the paper upon which it may be printed.
- ***collective works*** – A "collective work" is a copyrightable work made up of multiple contributions – each of which constitutes a separate and independent work itself – where those contributions are assembled into a collective whole. Newspaper issues, magazine issues, anthologies, encyclopedias are examples.
- ***compilations*** – A compilation is one kind of work. A compilation is formed by collecting and assembling preexisting materials, facts, points of data, etcetera, and then those things – by virtue of their selection, coordination, or arrangement – end up constituting original work of authorship. An original work of authorship consisting of arrangement of uncopyrightable facts will be a

copyrightable compilation. The term "compilation" embraces collective works. So all collective works are compilations. But not all compilations are collective works. Compilations are copyrightable – but only if they meet the regular requirements of copyrightability. So if something is a compilation, consider issues such as: Is there enough additional copyrightable content in the arrangement to meet the originality requirement? If so, what is it? The answers might narrow or eliminate the scope of the plaintiff's rights.

- ***derivatives*** – A "derivative work" is a work based on one or more preexisting works. Examples include a translation of a literary work into a different language, a new musical arrangements of a preexisting composition, a screenplay based on a book, and a motion picture based on a screenplay that was based on a book. A derivatives of another work is copyrightable itself – though, interestingly, not if it is an unauthorized derivative of a copyrighted work. Even if authorized, however, a derivative work raises important questions similar to those with compilations: Is there enough new copyrightable expression to meet the originality requirement? And if so, what is it? Considering those issues is necessary to understand the scope of the plaintiff's valid copyright entitlement.
- ***copies*** – copies are material, tangible objects in which a work is fixed. Thus, a "copy" is something that exists in the material world. A "work" has an existence independent of the material world.

A.6. Consider the stakes – and copyright's neighbors

In reading cases about copyrightability – cases that are determining whether something will be protected by copyright – it's helpful to think about the stakes. At issue is what the law is going to allow to be the exclusive domain of one person (as their legal entitlement, their "intellectual property") and what's going to be left open and unfenced for humanity at large. Consider that a copyright lasts for about 100 years. If the law, in favoring one particular plaintiff, draws the line in the wrong place, there will be significant consequences. Those consequences may include frustrating everyone's ability

to innovate, to communicate, to learn, and perhaps even to think clearly about certain things.

What's more, just because something isn't "copyrightable" doesn't mean it's not "protectable" or that the creator can't profit from their creation.

Tort law offers protection useful to authors and innovators – defamation claims for slurring their name, and various causes of action for stealing secrets, invading privacy, and betraying confidences.

There's also other intellectual property law. Systems, procedures, methods of operation, and the like may be protectable by a utility patent – if the requirements of patentability set out by Congress are met. Similarly, ornamental designs can be generally protected by design patents. Words, phrases, shapes, and designs – if they serve as an indication of the commercial source of goods or services – can be protected by trademark law. Sometimes, if there's no intellectual property right that fits, you can ask for, and receive one, from Congress. For instance, boat manufacturers did just that a few decades ago and received a niche IP right for vessel hulls.

And IP protection isn't the only way to profit from producing new products of the mind. Writing, publishing, being read, "making an impact" – that's a path to clamoring clients, lucrative job offers, consulting gigs, and even speaking fees. Writing and recording music people love creates demand for live performances. (*Pssst!* Dirty secret: Recording artists tend to make a lot more money from concert ticket sales than from record royalties.) And businesses that are the first to create something new and take it to market generally get a powerful economic incentive with what economists and business-management scholars call "first mover advantage" – even when copyists soon follow. Why buy from the imitator when you can buy from the innovator?

All of that context matters when courts have to decide whether to provide exclusive rights to one plaintiff at the expense of a very long period of exclusion for everybody else.

B. Foundational Cases, 1879–1903

B.1. Lead-in

Three old cases loom large in defining the limits of what is copyrightable. They all start with a B. *Baker v. Selden* (U.S. 1879) held that copyright would not protect a new and clever system of bookkeeping. *Burrow-Giles v. Sarony* (U.S. 1884) held that copyright could protect photographs – as creative works, not merely a factual record of the physical world captured on a light-sensitive plate. And *Bleistein v. Donaldson* (U.S. 1903) upheld copyright in illustrations in circus advertisements, establishing that copyright has no requirement of artistic virtue.

The current copyright law is the Copyright Act of 1976. Thus, as will be as will be obvious from their dates, all three of these cases were not decided under the current law. They weren't even decided under the '76 Act's immediate predecessor, which was the Copyright Act of 1909. Nevertheless, these cases continue to be looked to as the foundation of modern concepts of copyrightability.

B.2. Case: Baker v. Selden (U.S. 1879)

Pre-reading notes

In *Baker v. Selden,* 101 U.S. 99 (1879), the creator of new and useful bookkeeping/accounting system sought to use copyright to so as to be the sole supplier of blank form books using the system. Copyright was denied. From thenceforth to today, tracking expenses has been less of an expense.

Editing notes

The following case abridgement/edit is by EEJ. Many liberalities were taken for readability. It contains many unmarked departures from the original, including – for the convenience of the reader – changing the names and words used to refer to the litigants and other persons. Some edits, however, were marked. Here's a key:

˜ means material deleted (like three dots ... , but meant to be less obtrusive)

< and > set off text taken from footnotes and placed inline in the body text

{ and } denote an insertion (and maybe a co-incident deletion) by the casebook editor (as opposed to the court)

¶ identifies the place of an editor-inserted paragraph break

Opinion

Baker v. Selden (U.S. 1879)

Supreme Court of the United States
101 U.S. 99 (1879)

MR. JUSTICE BRADLEY delivered the opinion of the court.

Charles Selden˜ in the year 1859 took the requisite steps for obtaining the copyright of a book, entitled 'Selden's Condensed Ledger, or Book-keeping Simplified,' the object of which was to exhibit and explain a peculiar system of book-keeping. In 1860 and 1861, he took the copyright of several other books, containing additions to and improvements upon the said system. The bill of complaint was filed against the defendant, Baker, for an alleged infringement of these copyrights. {Baker} contends on the argument that the matter alleged to be infringed is not a lawful subject of copyright.

The˜ various books of the complainant, as well as those sold and used by Baker, were exhibited before the examiner, and witnesses were examined to both sides. A decree was rendered for the complainant, and Baker appealed.

The book or series of books of which the complainant claims the copyright consists of an introductory essay explaining the system of book-keeping referred to, to which are annexed certain forms or banks, consisting of ruled lines, and headings, illustrating the system and showing how it is to be used and carried out in practice. This system effects the same results as book-keeping by double entry; but, by a peculiar arrangement of columns and headings, presents the entire operation, of a day, a week, or a month, on a single page, or on two pages facing each other, in an account-book. Baker uses a similar plan so far as results are concerned; but makes a different arrangement of the columns, and uses different headings.¶

If Selden had the exclusive right to the use of the system explained in his book, it would be difficult to contend that Baker does not infringe it, notwithstanding the difference in his form of arrangement; but if it be assumed that the system is open to public use, it seems to be equally difficult to contend that the books made and sold by Baker are a violation of the copyright of the complainant's book considered merely as a book explanatory of the system.¶

Where the truths of a science or the methods of an art are the common property of the whole world, any author has the right to express the one, or explain and use the other, in his own way. As an author, Selden explained the system in a particular way. It may be conceded that Baker makes and uses account-books arranged on substantially the same system; but the proof fails to show that he has violated the copyright of Selden's book, regarding the latter merely as an explanatory work; or that he has infringed Selden's right in any way, unless the latter became entitled to an exclusive right in the system.

The evidence of the complainant is principally directed to the object of showing that Baker uses the same system as that which is explained and illustrated in Selden's books. It becomes important, therefore, to determine whether, in obtaining the copyright of his books, he secured the exclusive right to the use of the system or method of book-keeping which the said books are intended to illustrate and explain.¶

It is contended that Selden has secured such exclusive right, because no one can use the system without using substantially the same ruled lines and headings which he was appended to his books in illustration of it. In other words, it is contended that the ruled lines and headings, given to illustrate the system, are a part of the book, and, as such, are secured by the copyright; and that no one can make or use similar ruled lines and headings, or ruled lines and headings made and arranged on substantially the same system, without violating the copyright. And this is really the question to be decided in this case. Stated in another form, the question is, whether the exclusive property in a system of book-keeping can be claimed, under the law or copyright, by means of a book in which that system is explained? The complainant's bill, and the case made under it, are based on the hypothesis that it can be.

It cannot be pretended, and indeed it is not seriously urged, that the ruled lines of the complainant's account-book can be claimed under any special class of objects, other than books, named in the law of copyright existing in 1859. The law then in force was that of 1831, and specified only books, maps, charts, musical compositions, prints, and engravings. An account-book, consisting of ruled lines and blank columns, cannot be called by any of these names unless by that of a book.

There is no doubt that a work on the subject of book-keeping, though only explanatory of well-known systems, may be the subject of a copyright; but, then, it is claimed only as a book. Such a book may be explanatory either of old systems, or of an entirely new system; and, considered as a book, as the work of an author, conveying information on the subject of book-keeping, and containing detailed explanations of the art, it may be a very valuable acquisition to the practical knowledge of the community. But there is a clear distinction between the book, as such, and the art which it is intended to illustrate. The mere statement of the proposition is so evident, that it requires hardly any argument to support it. ¶

The same distinction may be predicated of every other art as well as that of book-keeping. A treatise on the composition and use of medicines, be they old or new; on the construction and use of ploughs, or watches, or churns; or on the mixture and application of colors for painting or dyeing; or on the mode of drawing lines to produce the effect of perspective,—would be the subject of copyright; but no one would contend that the copyright of the treatise would give the exclusive right to the art or manufacture described therein.¶

The copyright of the book, if not pirated from other works, would be valid without regard to the novelty, or want of novelty, of its subject-matter. The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the

examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.

The difference between the two things, letters-patent and copyright, may be illustrated by reference to the subjects just enumerated.¶

Take the case of medicines. Certain mixtures are found to be of great value in the healing art. If the discoverer writes and publishes a book on the subject (as regular physicians generally do), he gains no exclusive right to the manufacture and sale of the medicine; he gives that to the public. If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book. So of all other inventions or discoveries.

The copyright of a book on perspective, no matter how many drawings and illustrations it may contain, gives no exclusive right to the modes of drawing described, though they may never have been known or used before. By publishing the book, without getting a patent for the art, the latter is given to the public. The fact that the art described in the book by illustrations of lines and figures which are reproduced in practice in the application of the art, makes no difference. Those illustrations are the mere language employed by the author to convey his ideas more clearly. Had he used words of description instead of diagrams (which merely stand in the place of words), there could not be the slightest doubt that others, applying the art to practical use, might lawfully draw the lines and diagrams which were in the author's mind, and which he thus described by words in his book.

The copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires.¶

The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be

considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application.

Of course, these observations are not intended to apply to ornamental designs, or pictorial illustrations addressed to the taste. Of these it may be said, that their form is their essence, and their object, the production of pleasure in their contemplation. This is their final end. They are as much the product of genius and the result of composition, as are the lines of the poet or the historian's period.¶

On the other hand, the teachings of science and the rules and methods of useful art have their final end in application and use; and this application and use are what the public derive from the publication of a book which teaches them. But as embodied and taught in a literary composition or book, their essence consists only in their statement. This alone is what is secured by the copyright. The use by another of the same methods of statement, whether in words or illustrations, in a book published for teaching the art, would undoubtedly be an infringement of the copyright.

Recurring to the case before us, we observe that Charles Selden, by his books, explained and described a peculiar system of book-keeping, and illustrated his method by means of ruled lines and blank columns, with proper headings on a page, or on successive pages. Now, whilst no one has a right to print or publish his book, or any material part thereof, as a book intended to convey instruction in the art, any person may practise and use the art itself which he has described and illustrated therein.¶

The use of the art is a totally different thing from a publication of the book explaining it. The copyright of a book on book-keeping cannot secure the exclusive right to make, sell, and use account-books prepared upon the plan set forth in such book.¶

Whether the art might or might not have been patented, is a question which is not before us. It was not patented, and is open and free to the use of the public. And, of course, in using the art, the ruled lines and headings of accounts must necessarily be used as incident to it.

The plausibility of the claim put forward by the complainant in this case arises from a confusion of ideas produced by the peculiar nature of the art described in the books which have been made the subject of copyright. In describing the art, the illustrations and diagrams employed happen to correspond more closely than usual with the actual work performed by the operator who uses the art. Those illustrations and diagrams consist of ruled lines and headings of accounts; and it is similar ruled lines and headings of accounts which, in the application of the art, the book-keeper makes with his pen, or the stationer with his press; whilst in most other cases the diagrams and illustrations can only be represented in concrete forms of wood, metal, stone, or some other physical embodiment. But the principle is the same in all.¶

The description of the art in a book, though entitled to the benefit of copyright, lays no foundation for an exclusive claim to the art itself. The object of the one is explanation; the object of the other is use. The former may be secured by copyright. The latter can only be secured, if it can be secured at all, by letters-patent.˜

The conclusion to which we have come is, that blank account-books are not the subject of copyright; and that the mere copyright of Selden's book did not confer upon him the exclusive right to make and use account-books, ruled and arranged as designated by him and described and illustrated in said book.

The decree of the Circuit Court must be reversed, and the cause remanded with instructions to dismiss the complainant's bill; and it is

So ordered

B.3. Case: Burrow-Giles v. Sarony (U.S. 1884)

Pre-reading notes

In *Burrow-Giles v. Sarony,* 111 U.S. 53 (1884), the relatively new technology of photography collided with copyright doctrine built around printing presses, moveable type, and engraved plates. Was the photograph just a factual record? Or what is a work of creative authorship? The photographer

won. And a century and a half later, parents are skipping date night again to pay for awkward band photos.

Opinion

Burrow-Giles v. Sarony (U.S. 1884)

Supreme Court of the United States
111 U.S. 53 (1884)

Mr. Justice Miller delivered the opinion of the court.

This is a writ of error to the Circuit Court for the Southern District of New York.

Plaintiff is a lithographer and defendant a photographer, with large business in those lines in the city of New York.

The suit was commenced by an action at law in which Sarony was plaintiff and the lithographic company was defendant, the plaintiff charging the defendant with violating his copyright in regard to a photograph, the title of which is "Oscar Wilde No. 18." A jury being waived, the court made a finding of facts on which a judgment in favor of the plaintiff was rendered for the sum of $600 for the plates and 85,000 copies sold and exposed to sale, and $10 for copies found in his possession, as penalties under section 4965 of the Revised Statutes.

Among the findings of fact made by the court the following presents the principal question raised by the assignment of errors in the case:

"3. That the plaintiff about the month of January, 1882, under an agreement with Oscar Wilde, became and was the author, inventor, designer, and proprietor of the photograph in suit, the title of which is 'Oscar Wilde No. 18,' being the number used to designate this particular photograph and of the negative thereof; that the same is a useful, new, harmonious, characteristic, and graceful picture, and that said plaintiff made the same at his place of business in said city of New York, and within the United States, entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines,

arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by the plaintiff, he produced the picture in suit, Exhibit A, April 14th, 1882, and that the terms 'author,' 'inventor,' and 'designer,' as used in the art of photography and in the complaint, mean the person who so produced the photograph."

Other findings leave no doubt that plaintiff had taken all the steps required by the act of Congress to obtain copyright of this photograph, and section 4952 names photographs among other things for which the author, inventor, or designer may obtain copyright, which is to secure him the sole privilege of reprinting, publishing, copying and vending the same. That defendant is liable under that section and section 4965 there can be no question, if those sections are valid as they relate to photographs.

Accordingly, the two assignments of error in this court by plaintiff in error, are:

1. That the court below decided that Congress had and has the constitutional right to protect photographs and negatives thereof by copyright.

The second assignment related to the sufficiency of the words "Copyright, 1882, by N. Sarony," in the photographs, as a notice of the copyright of Napoleon Sarony under the act of Congress on that subject.

With regard to this latter question, it is enough to say, that the object of the statute is to give notice of the copyright to the public, by placing upon each copy, in some visible shape, the name of the author, the existence of the claim of exclusive right, and the date at which this right was obtained.

This notice is sufficiently given by the words "Copyright, 1882, by N. Sarony," found on each copy of the photograph. It clearly shows that a copyright is asserted, the date of which is 1882, and if the name Sarony alone was used, it would be a sufficient designation of the author until it is shown that there is some other Sarony.

When, in addition to this, the initial letter of the Christian name Napoleon is also given, the notice is complete.

The constitutional question is not free from difficulty:

The eighth section of the first article of the Constitution is the great repository of the powers of Congress, and by the eighth clause of that section Congress is authorized:

> "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."

The argument here is, that a photograph is not a writing nor the production of an author. Under the acts of Congress designed to give effect to this section, the persons who are to be benefited are divided into two classes, authors and inventors. The monopoly which is granted to the former is called a copyright, that given to the latter, letters patent, or, in the familiar language of the present day, *patent right*.

We have, then, copyright and patent right, and it is the first of these under which plaintiff asserts a claim for relief.

It is insisted in argument, that a photograph being a reproduction on paper of the exact features of some natural object or of some person, is not a writing of which the producer is the author.

Section 4952 of the Revised Statutes places photographs in the same class as things which may be copyrighted with "books, maps, charts, dramatic or musical compositions, engravings, cuts, prints, paintings, drawings, statutes, statuary, and models or designs intended to be perfected as works of the fine arts." "According to the practice of legislation in England and America," says Judge Bouvier, 2 Law Dictionary, 363, "the copyright is confined to the exclusive right secured to the author or proprietor of a writing or drawing which may be multiplied by the arts of printing in any of its branches."

The first Congress of the United States, sitting immediately after the formation of the Constitution, enacted that the "author or authors of any map, chart, book or books, being a citizen or resident of the United States, shall have the sole right and liberty of printing, reprinting, publishing and vending the same for the period of fourteen years from the recording of the title thereof in the clerk's office, as afterwards directed." 1 Stat. 124, 1.

This statute not only makes maps and charts subjects of copyright, but mentions them before books in the order of designation. The second section of an act to amend this act, approved April 29, 1802, 2 Stat. 171, enacts that from the first day of January thereafter, he who shall invent and design, engrave, etch or work, or from his own works shall cause to be designed and engraved, etched or worked, any historical or other print or prints shall have the same exclusive right for the term of fourteen years from recording the title thereof as prescribed by law.

By the first section of the act of February 3d, 1831, 4 Stat. 436, entitled an act to amend the several acts respecting copyright, musical compositions and cuts, in connection with prints and engravings, are added, and the period of protection is extended to twenty-eight years. The caption or title of this act uses the word copyright for the first time in the legislation of Congress.

The construction placed upon the Constitution by the first act of 1790, and the act of 1802, by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed during a period of nearly a century, it is almost conclusive.

Unless, therefore, photographs can be distinguished in the classification on this point from the maps, charts, designs, engravings, etchings, cuts, and other prints, it is difficult to see why Congress cannot make them the subject of copyright as well as the others.

These statutes certainly answer the objection that books only, or writing in the limited sense of a book and its author, are within the constitutional provision. Both these words are susceptible of a more enlarged definition than this. An author in that sense is "he to whom anything owes its origin; originator; maker; one who completes a work of science or literature." Worcester. So, also, no one would now claim that the word writing in this clause of the Constitution, though the only word used as to subjects in regard to which authors are to be secured, is limited to the actual script of the author, and excludes books and all other printed matter. By writings in that clause is meant the literary productions of those authors, and Congress very properly has declared these to include all forms of writing, printing,

engraving, etching, &c., by which the ideas in the mind of the author are given visible expression. The only reason why photographs were not included in the extended list in the act of 1802 is probably that they did not exist, as photography as an art was then unknown, and the scientific principle on which it rests, and the chemicals and machinery by which it is operated, have all been discovered long since that statute was enacted.

Nor is it to be supposed that the framers of the Constitution did not understand the nature of copyright and the objects to which it was commonly applied, for copyright, as the exclusive right of a man to the production of his own genius or intellect, existed in England at that time, and the contest in the English courts, finally decided by a very close vote in the House of Lords, whether the statute of 8 Anne, chap. 19, which authorized copyright for a limited time, was a restraint to that extent on the common law or not, was then recent. It had attracted much attention, as the judgment of the King's Bench, delivered by Lord Mansfield, holding it was not such a restraint, in Miller v. Taylor, 4 Burrows, 2303, decided in 1769, was overruled on appeal in the House of Lords in 1774. Ibid. 2408. In this and other cases the whole question of the exclusive right to literary and intellectual productions had been freely discussed.

We entertain no doubt that the Constitution is broad enough to cover an act authorizing copyright of photographs, so far as they are representatives of original intellectual conceptions of the author.

But it is said that an engraving, a painting, a print, does embody the intellectual conception of its author, in which there is novelty, invention, originality, and therefore comes within the purpose of the Constitution in securing its exclusive use or sale to its author, while the photograph is the mere mechanical reproduction of the physical features or outlines of some object animate or inanimate, and involves no originality of thought or any novelty in the intellectual operation connected with its visible reproduction in shape of a picture. That while the effect of light on the prepared plate may have been a discovery in the production of these pictures, and patents could properly be obtained for the combination of the chemicals, for their application to the paper or other surface, for all the machinery by which the light reflected from the object was thrown on the prepared plate, and for all

the improvements in this machinery, and in the materials, the remainder of the process is merely mechanical, with no place for novelty, invention or originality. It is simply the manual operation, by the use of these instruments and preparations, of transferring to the plate the visible representation of some existing object, the accuracy of this representation being its highest merit.

This may be true in regard to the ordinary production of a photograph, and, further, that in such case a copyright is no protection. On the question as thus stated we decide nothing.

In regard, however, to the kindred subject of patents for invention, they cannot by law be issued to the inventor until the novelty, the utility, and the actual discovery or invention by the claimant have been established by proof before the Commissioner of Patents; and when he has secured such a patent, and undertakes to obtain redress for a violation of his right in a court of law, the question of invention, of novelty, of originality, is always open to examination. Our copyright system has no such provision for previous examination by a proper tribunal as to the originality of the book, map, or other matter offered for copyright. A deposit of two copies of the article or work with the Librarian of Congress, with the name of the author and its title page, is all that is necessary to secure a copyright. It is, therefore, much more important that when the supposed author sues for a violation of his copyright, the existence of those facts of originality, of intellectual production, of thought, and conception on the part of the author should be proved, than in the case of a patent right.

In the case before us we think this has been done.

The third finding of facts says, in regard to the photograph in question, that it is a "useful, new, harmonious, characteristic, and graceful picture, and that plaintiff made the same . . . entirely from his own original mental conception, to which he gave visible form by posing the said Oscar Wilde in front of the camera, selecting and arranging the costume, draperies, and other various accessories in said photograph, arranging the subject so as to present graceful outlines, arranging and disposing the light and shade, suggesting and evoking the desired expression, and from such disposition, arrangement, or representation, made entirely by plaintiff, he produced the picture in suit."

These findings, we think, show this photograph to be an original work of art, the product of plaintiff's intellectual invention, of which plaintiff is the author, and of a class of inventions for which the Constitution intended that Congress should secure to him the exclusive right to use, publish and sell, as it has done by section 4952 of the Revised Statutes.

The question here presented is one of first impression under our Constitution, but an instructive case of the same class is that of Nottage v. Jackson, 11 Q.B.D. 627, decided in that court on appeal, August, 1883.

The first section of the act of 25 and 26 Victoria, chap. 68, authorizes the author of a photograph, upon making registry of it under the copyright act of 1882, to have a monopoly of its reproduction and multiplication during the life of the author.

The plaintiffs in that case described themselves as the authors of the photograph which was pirated, in the registration of it. It appeared that they had arranged with the captain of the Australian cricketers to take a photograph of the whole team in a group; and they sent one of the artists in their employ from London to some country town to do it.

The question in the case was whether the plaintiffs, who owned the establishment in London, where the photographs were made from the negative and were sold, and who had the negative taken by one of their men, were the authors, or the man who, for their benefit, took the negative. It was held that the latter was the author, and the action failed, because plaintiffs had described themselves as authors.

Brett, M. R., said, in regard to who was the author: "The nearest I can come to, is that it is the person who effectively is as near as he can be, the cause of the picture which is produced, that is, the person who has superintended the arrangement, who has actually formed the picture by putting the persons in position, and arranging the place where the people are to be -- the man who is the effective cause of that."

Lord Justice Cotton said: "In my opinion, 'author' in volves originating, making, producing, as the inventive or master mind, the thing which is to be protected, whether it be a drawing, or a painting, or a photograph;" and Lord Justice Bowen says that photography is to be treated for the purposes of the

act as an art, and the author is the man who really represents, creates, or gives effect to the idea, fancy, or imagination.

The appeal of plaintiffs from the original judgment against them was accordingly dismissed.

These views of the nature of authorship and of originality, intellectual creation, and right to protection confirm what we have already said.

The judgment of the Circuit Court is accordingly affirmed.

B.4. Case: Bleistein v. Donaldson (U.S. 1903)

Pre-reading notes

In *Bleistein v. Donaldson* (U.S. 1903) copyright was claimed in illustrations for circus advertisements. These illustrations – so commercial, so base, so banal, so dissevered from the lofty sphere of the fine arts – could they possibly qualify as works fit for copyright? The court decided that judges of law won't be judges of artistic worth. Copyright for common commercial illustrations upheld. Forever afterward, just because a book, movie, photograph, illustration, or teenage angst poem is terrible – that doesn't make it uncopyrightable.

Statements of the case published with court opinion

***Mr. Ansley Wilcox* and *Mr. Arthur von Briesen* for plaintiffs in error:**

This action comes here upon writ of error to the Circuit Court of Appeals for the Sixth Circuit, which court heard it on writ of error directed to the United States Circuit Court for the District of Kentucky. The Circuit Court, at the close of plaintiffs' case, instructed the jury to find a verdict for defendant, which was done and judgment entered thereon. The Circuit Court of Appeals affirmed said judgment.

There were three causes of action which were all based upon sec. 4965 of the Revised Statutes, quoted on page 60. By order of the Circuit Court, dated June 10, 1899, the marshal seized 10,590 eight-page prints and 13,205

four-page prints, described in the writ, and also five metal electrotype plates, all of which he found in the defendant's possession (page 13).

The action was tried at Covington, Kentucky, on December 12 and 13, 1899, before Hon. Walter Evans, sitting as Circuit Judge, and a jury.

At the outset of the trial, during the direct examination of the first witness, the court anticipated the question upon which it afterwards took the case away from the jury and decided it, by the following remark: "The real controversy will be whether this is a subject of copyright, whether it comes within the copyright law."

At the close of the plaintiffs' case, defendant moved for "peremptory instructions for the defendant." The court said, "State why, in a word," to which defendant's counsel answered: "In the first place I want to say with reference to the Statuary Exhibit. . . . It is alleged in the petition, and is in fact copyrighted on the 18th of April, and the publication plainly shows it was prior to that. That is a specific objection to that one upon that ground specifically -- that is the Statuary.

"The Court: Now as to the other two.

"Counsel: The specific objection to this one, the Ballet, is that it is an immoral picture.

"And the general objection that I make to them all is that they are none of them subject matter of copyright. They are all mere matter of advertising."

The next day the court delivered a written opinion which concludes as follows:

"The case must turn upon the others (other question), and especially upon the general proposition that the things copyrighted in this case were by no means such as either the Constitution or the legislation of Congress intended to protect by the privilege of copyright. The court cannot bring its mind to yield to the conclusion that such tawdry pictures as these were ever meant to be given the enormous protection of not only the exclusive right to print them, but the additional protection of a penalty of a dollar each for reprints from them.

"As previously stated, they are neither 'pictorial illustrations' nor 'works connected with the fine arts' within the meaning of section 4952. Not being

so, there was no authority to grant the copyrights, whether the Constitution authorizes Congress to promote the fine arts or not.

"The judgment of the court is, that the plaintiffs' on their own showing, are not entitled to recover, and for that reason the motion of defendant will be granted, and Il will instruct the jury to find a verdict for it."

The jury, in accordance with said instruction, returned a verdict for the defendant.

There is no question as to the fact of infringement.

The sheets in evidence, made by defendant, contain reproductions by means of cheap electrotype plates of each of the plaintiffs' designs. These reproductions are not in colors.

The principal questions are:

First. Whether on the question of artistic merit or value of these lithographic prints or chromos, the Circuit Court was justified in taking the case from the jury, and condemning them entirely as not being fit subjects for copyright.

Second. Whether the copyrights were obtained for these prints in accordance with the Constitution and laws of the United States, and are valid copyrights.

The second question involves the inquiries: Whether the copyrights were properly taken out by the plaintiffs, in their trade names of "The Courier Co." and "The Courier Lithographing Co.," and, incidentally, whether plaintiffs have the right to sue in their individual names for infringement of these copyrights; and whether the Statuary Act Design was copyrighted before it was published.

The three pictures in question are show-bills or circus bills, also called posters and, more definitely, picture-posters. They are colored lithographs or chromolithographs, commonly called "chromos." They were designed primarily to be sold to the proprietors of circuses and other shows, and by them to be used for advertising; but they could be sold to any one, or used for any purpose for which they were adapted.

They were made in the plaintiffs' lithographing establishment under a special contract with the proprietor of a circus, by which the plaintiffs agreed to design and get up certain representations of scenes supposed to be exhibited at the show, the plaintiffs reserving rights of design and of copyright, and with the usual understanding that so long as the proprietor of the circus used these designs he had the right to them, but if he ceased to use any of them, the plaintiffs could sell the design or the pictures which embodied it, to any one.

The fundamental question of the right to copyright such show-bills or posters, is a question of great importance, involving the protection of an immense industry. The foundation of the copyright law is in the provision of the Constitution (art. 1, sec. 8), which authorizes Congress --

"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."

It is settled that the words "authors" and "writings," in this section, are not confined to literary writers and their works, but include, among others, designers, engravers and lithographers, as well as photographers. Burrow-Giles Litho. Co. v. Sarony, 111 U.S. 53; Trade Mark Cases, 100 U.S. 82. Picture-posters or show bills, such as these chromolithographs were, are not designed for close inspection or long-continued study, like an oil painting, a steel or wood engraving, or an etching, and they are not to be judged by the same standards. They are intended to catch the eye of the passer on the street, or any one who merely glances at them, and to challenge his attention, -- if possible to compel him to look again, so that he will observe what is the subject of the poster and have this forced upon his mind, and will be attracted by it. Their function is to illustrate something, and to advertise it by appealing quickly to the imagination, and conveying instantly a strong and favorable impression. Thus, to be successful, they require artistic ability, and above all things creativeness or originality of a high order, but peculiar. They must be designed boldly, and executed on broad lines, with not much attention to detail, so that the spirit of the picture will stand out at once, and almost leap at you, and will not be lost in a mass of details and minor features.

Such is the ideal picture-poster, a special and peculiar branch of pictorial art, and one into which many gifted artists, highly successful in other fields, have ventured with greater or less success. Charles Hiatt's work entitled "Picture Posters," published in 1895 by George Bell & Sons, London; "The Modern Poster," by Alexandre and others, published in 1895 by Charles Scribner's Sons.

Certainly it does not lie in the mouth of the pirate, who has stolen and copied them at some expense and considerable risk, to deny that they have merit and value.

I. The designs were proper subjects of copyright and each of these picture-posters was a proper subject of copyright, within the language and the spirit of the copyright law. There was abundant evidence of originality of design, of artistic merit, and of practical value and usefulness, as to each of the pictures.

If any of these qualities was seriously questioned by the defence, it became the duty of the court to send the case to the jury.

All of the pictures are new and original designs and involve new and original conceptions and creations. There was enough evidence on this subject to require to case to be submitted to the jury if any question was raised about it, citing, and in some instances distinguishing, as to definition of author, writings, etc., The Trade Mark Cases, 100 U.S. 82; Lithograph Co. v. Sarony, 111 U.S. 53; Nottage v. Jackson, 11 Q.B. Div. 627; Brightly v. Littleton, 37 Fed. Rep. 103; Carlisle v. Colusa County, 57 Fed. Rep. 979; Drury v. Ewing, Fed. Cases, No. 4095.

If any one of the pictures was sufficiently proved to be new and original, this was enough to carry the case to the jury upon this question; they were all proved to be new and original.

II. As to artistic merit and value. The pictures being original designs, we maintain that they are of sufficient artistic merit and of sufficient value and usefulness to be entitled to copyright. At least there was enough evidence of this to require the case to be submitted to the jury, if any question was raised about it, -- and furthermore no such question was raised by the defence.

"If a copyrighted article has merit and value enough to be the object of piracy, it should also be of sufficient importance to be entitled to protection." Drone on Copyright, p. 212, cited with approval in Henderson v. Tomkins, 60 Fed. Rep. 758, 765; Church v. Linton, 25 Ont. Rep. 121; Hegeman v. Springer, 110 Fed. Rep. 374; Bolles v. Outing Co., 77 Fed. Rep. 966; 175 U.S. 262; Richardson v. Miller, Fed. Cases, No. 11,791.

We have nothing to do with cases involving attempts to copyright mere catalogues or price lists, or labels, sometimes containing pictures, reproduced by photographic or other mechanical processes, of articles intended for sale, but which obviously have no artistic merit or originality. These decisions, whether condemning or upholding such copyrights, do not touch the questions involved in the case at bar. Distinguishing Mott Iron Works v. Clow, 82 Fed. Rep. 216; also citing Yuengling v. Schile, 12 Fed. Rep. 97, 101; Schumaker v. Schwencke, 25 Fed. Rep. 466; Lamb v. Grand Rapids School Furniture Co., 39 Fed. Rep. 474; Drone on Copyright, 164, 165; Grace v. Newman, L.R. 19 Eq. Cases, 623; Maple v. Junior Army & Navy Stores, L.R. 21 Ch. Div. 369; Church v. Linton, 25 Ont. Rep. 131; Carlisle v. Colusa County, 57 Fed. Rep. 979.

"The degree of merit of the copyrighted matter the law is not concerned with. Any is legally enough. To use it or not use it, is voluntary on the part of the public."

III. The copyrights were properly taken out by the plaintiffs in their trade names of "The Courier Co." and "The Courier Litho. co.," and the plaintiffs have the right to sue in their individual names for infringement of these copyrights.

That copartners in business, who are the proprietors of a copyrighted article, may take out a copyright in either of their copartnership or trade names, is well settled. Scribner v. Clark, 50 Fed. Rep. 473; affirmed as Belford v. Scribner, 144 U.S. 488; Callaghan v. Myers, 128 U.S. 617; Scribner v. Allen Co., 49 Fed. Rep. 854; Werckneister v. Springer Lith. Co., 63 Fed. Rep. 808; Rock v. Lazarus, Law Rep. 15 Eq. Cases, 104; Weldon v. Dicks, Law Rep. 10 Ch. Div. 247; Fruit-Cleaning Co. v. Fresno Home Packing Co., 94 Fed. Rep. 845.

Finally, the plaintiffs were the "proprietors" of each of the copyrighted prints, and as such were authorized to take out the copyrights by the express language of the copyright law, Rev. Stat., sec. 4952, which includes "proprietors" with "authors, inventors (and) designers." Colliery Eng. Co. v. United etc., Co., 94 Fed. Rep. 152.

No formal assignment of the right to a copyright is necessary. Consent is sufficient to constitute one the proprietor. Carte v. Evans, 27 Fed. Rep. 861. See also Schumacher v. Schwencke, 25 Fed. Rep. 466; Little v. Gould, Fed. Cases, No. 8395; Lawrence v. Dana, Fed. Cases, No. 8136; Sweet v. Benning, 81 Eng. Com. Law Rep. 459; 16 Com. Bench Rep. 459; Gill v. United States, 160 U.S. 426, 435.

All of the pictures, and particularly the Statuary Act Design, were copyrighted before publication.

The law is well settled that there was no publication of these prints when they were shipped from Buffalo on April 11, or when they were received by Mr. Wallace at Peru, Indiana, on or about April 15. There was no publication until they were exposed to the general public, so that the public, without discrimination as to persons, might enjoy them. This must have been some time after April 15, when the last copyright was surely completed.

Publication is a legal conclusion which follows from certain acts. Drone on Copyright, p. 291; Jewelers Merc. Agency v. Jewelers Pub. Co., 84 Hun (N.Y. Sup. Ct.), 12, 16; Callaghan v. Myers, 128 U.S. 617; Black v. Henry G. Allen Co., 56 Fed. Rep. 764; Belford v. Scribner, 144 U.S. 488; Garland v. Gemmill, 14 Canada Sup. Ct. Rep. 321; Prince Albert v. Strange, 2 De Gex & Smale, 652; 1 MacNaghten & Gorden; 47 Eng. Ch. Rep. 25. The representation of a play upon the stage regularly at a theatre, does not constitute a publication. Tompkins v. Halleck, 133 Massachusetts, 32; Palmer v. De Witt, 47 N.Y. 532; Boucicault v. Hart, Fed. Cases, No. 1692.

The use by a teacher of his manuscript and allowing pupils to make copies for the purpose of obtaining his instruction, does not amount to a publication. Bartlett v. Crittenden, Fed. Cases, Nos. 1076 and 1082. The printing of copies of an operetta and distributing them to artists, for private use only in learning their parts, and the representing of the operetta on the stage, is not a publication. French v. Kreling, 63 Fed. Rep. 621; Reed v.

Carusi, Fed. Cases, No. 11,642; Blume v. Spear, 30 Fed. Rep. 629; Exch. Tel. Co. v. Cent. News, Law Rep. 2 Ch. Div. 48.

***Mr. Edmund W. Kittredge*, with whom *Mr. Joseph Wilby* was on the brief,** for defendant in error, contended that the plaintiff in error was not entitled to copyright. The evidence established that these three prints were ordered by B.E. Wallace, proprietor of the circus known as the "Wallace Shows," under contract with him as an advertisement for his show, and they have never been made for anybody else. All of these pictures purported to be representations of acts to be done in the Wallace Shows, and all were made under a representation by Wallace, expressed on the face of the pictures, that his show was going to do these things. All these posters contain reading matter indicating that these were pictures of acts to be done in the Wallace Shows, and they all included pictures of Mr. Wallace himself.

They were prints and the copyright inscription was insufficient. But for the provision in the first clause of this act the inscription, "Copyright, 1898, Courier Litho. Co., Buffalo, N.Y.," would have been fatal to the plaintiffs' right of action. Thompson v. Hubbard, 131 U.S. 123. The inscription prescribed by section 4962 of the Revised Statutes was otherwise indispensable to the maintenance of an action for the infringement of a copyright. The notice given on each one of these pictures was that authorized by the act of June 18, 1874. Having thus availed themselves of the provisions of this act, clearly the plaintiffs are not in position to claim that the pictures are not covered by its provisions. Again, if these pictures were chromos, and not prints, cuts or engravings, then under the allegations of the petition they were not admissible in evidence because they were not in support of the allegations of the petition. As to what a chromo is and how statute should be construed, Yuengling v. Schile, 12 Fed. Rep. 107; Bolles v. Outing Company, 175 U.S. 262; Thornton v. Schreiber, 124 U.S. 612; Rosenbach v. Dreyfuss, 2 Fed. Rep. 217; Ehret v. Pierce, 10 Fed. Rep. 554; S.C., 18 Blatch. 302; Schumacher v. Wogram, 35 Fed. Rep. 210; Higgins v. Kueffel, 140 U.S. 428. As to advertisements and copyrights, citing Cobbett v. Woodward, L.R. 14 Eq. 407, cited with approval by this court in Baker v. Selden, 101 U.S. 106;

Clayton v. Stone & Hall, 2 Paine, 392; Mott Iron Works v. Clow, 82 Fed. Rep. 216.

There was no evidence tending to show that the plaintiffs themselves, or either of them, were the authors of these prints. It was claimed that they were the proprietors because, as they also claimed, the design or conception was that of their employes, working for them, under salaries, and that their designs were the property of the employer. If they were not themselves the authors, then it was incumbent upon them to allege how they acquired title as proprietors from the author, inventor or designer. Lithographic Co. v. Sarony, 111 U.S. 53; Nottage v. Jackson, 11 Q.B.D. 627; Atwell v. Ferret, 2 Blatch. 46; Bimms v. Woodworth, 4 Wash. C.C. Rep. 48; Black v. Allen Co., 42 Fed. Rep. 618; S.C., 56 Fed. Rep. 764; Press Pub. Co. v. Falk, 59 Fed. Rep. 524; Pollard v. Photograph Co., 40 Ch. Div. 345; Moore v. Rugg, 46 N.W. 141; Dielman v. White, 102 Red. Rep. 892; Parton v. Prang, 3 Clifford, 537; Little v. Good, 2 Blatch. 166.

It is incumbent upon the plaintiffs, in a case like this, for the recovery of penalties, to allege and to prove as alleged, every fact essential to the validity of their copyright. Jones v. Van Zandt, 5 How. 372.

The copyright law does not protect what is immoral in its tendency. A print representing unchaste acts of scenes calculated to excite lustful or sensual desires in those whose minds are open to such influences, and to attract them to witness the performance of such scenes, is manifestly of that character. It is the young and immature and those who are sensually inclined who are liable to be influenced by such scenes and representations, and it is their influence upon such persons that should be considered in determining their character. Broder v. Zeno Mauvais Music Co., 88 Fed. Rep. 74; Dunlop v. United States, 165 U.S. 501; Martinetti v. Maguire, Fed. Cases, No. 9173, The Black Crook case.

Opinion

Mr. Justice Holmes delivered the opinion of the court.

This case comes here from the United States Circuit Court of Appeals for the Sixth Circuit by writ of error. Act of March 3, 1891, c. 517, § 6, 26 Stat. 828. It is an action brought by the plaintiffs in error to recover the

penalties prescribed for infringements of copyrights. Rev. Stat. §§ 4952, 4956, 4965, amended by act of March 3, 1891, c. 565, 26 Stat. 1109, and act of March 2, 1895, c. 194, 28 Stat. 965. The alleged infringements consisted in the copying in reduced form of three chromolithographs prepared by employes of the plaintiffs for advertisements of a circus owned by one Wallace. Each of the three contained a portrait of Wallace in the corner and lettering bearing some slight relation to the scheme of decoration, indicating the subject of the design and the fact that the reality was to be seen at the circus. One of the designs was of an ordinary ballet, one of a number of men and women, described as the Stirk family, performing on bicycles, and one of groups of men and women whitened to represent statutes. The Circuit Court directed a verdict for the defendant on the ground that the chromolithographs were not within the protection of the copyright law, and this ruling was sustained by the Circuit Court of Appeals. *Courier Lithographing Co.* v. *Donaldson Lithographing Co*., 104 Fed. Rep. 993.

There was evidence warranting the inference that the designs belonged to the plaintiffs, they having been produced by persons employed and paid by the plaintiffs in their establishment to make those very things. *Gill* v. *United States*, 160 U.S. 426, 435; *Colliery Engineer Company* v. *United Correspondence Schools Company*, 94 Fed. Rep. 152; *Carte* v. *Evans*, 27 Fed. Rep. 861. It fairly might be found also that the copyrights were taken out in the proper names. One of them was taken out in the name of the Courier Company and the other two in the names of the Courier Lithographing Company. The former was the name of an unincorporated joint stock association formed under the laws of New York, Laws of 1894, c. 235, and made up of the plaintiffs, the other a trade variant on that name. *Scribner* v. *Clark*, 50 Fed. Rep. 473, 474, 475; S.C., *sub nom. Belford* v. *Scribner*, 144 U.S. 488.

Finally, there was evidence that the pictures were copyrighted before publication. There may be a question whether the use by the defendant for Wallace was not lawful within the terms of the contract with Wallace, or a more general one as to what rights the plaintiffs reserved. But we cannot pass upon these questions as matter of law; they will be for the jury when the case is tried again, and therefore we come at once to the ground of decision in the

courts below. That ground was not found in any variance between pleading and proof, such as was put forward in argument, but in the nature and purpose of the designs.

We shall do no more than mention the suggestion that painting and engraving unless for a mechanical end are not among the useful arts, the progress of which Congress is empowered by the Constitution to promote. The Constitution does not limit the useful to that which satisfies immediate bodily needs. *Burrow-Giles Lithographi*c *Co.* v. *Sarony*, 111 U.S. 53. It is obvious also that the plaintiffs' case is not affected by the fact, if it be one, that the pictures represent actual groups – visible things. They seem from the testimony to have been composed from hints or description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. *Blunt* v. *Patten*, 2 Paine, 397, 400. See *Kelly* v. *Morris*, L. R. 1 Eq. 697; *Morris* v. *Wright*, L.R. 5 Ch. 279. The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

If there is a restriction it is not to be found in the limited pretensions of these particular works. The least pretentious picture has more originality in it than directories and the like, which may be copyrighted. Drone, Copyright, 153. See *Henderson* v. *Tomkins*, 60 Fed. Rep. 758, 765. The amount of training required for humbler efforts than those before us is well indicated by Ruskin. "If any young person, after being taught what is, in polite circles, called 'drawing,' will try to copy the commonest piece of real *work*,—suppose a lithograph on the title page of a new opera air, or a woodcut in the cheapest illustrated newspaper of the day,—they will find themselves entirely beaten." Elements of Drawing, 1st ed. 3. There is no reason to doubt that these prints in their *ensemble* and in all their details, in their design and particular combinations of figures, lines and colors, are the

original work of the plaintiffs' designer. If it be necessary, there is express testimony to that effect. It would be pressing the defendant's right to the verge, if not beyond, to leave the question of originality to the jury upon the evidence in this case, as was done in *Hegeman* v. *Springer*, 110 Fed. Rep. 374.

We assume that the construction of Rev. Stat. § 4952, allowing a copyright to the "author, inventor, designer, or proprietor . . . of any engraving, cut, print . . . [or] chromo" is affected by the act of 1874, c. 301, § 3, 18 Stat. 78, 79. That section provides that "in the construction of this act the words 'engraving,' 'cut,' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts." We see no reason for taking the words "connected with the fine arts" as qualifying anything except the word "works," but it would not change our decision if we should assume further that they also qualified "pictorial illustrations," as the defendant contends.

These chromolithographs are "pictorial illustrations." The word "illustrations" does not mean that they must illustrate the text of a book, and that the etchings of Rembrandt or Steinla's engraving of the Madonna di San Sisto could not be protected to-day if any man were able to produce them. 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 articles of manufacture." Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use -- if use means to increase trade and to help to 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. And if pictures may be used to advertise soap, or the theatre, or monthly magazines, as they are, they may be used to advertise a circus. Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.

Finally, the special adaptation of these pictures to the advertisement of the Wallace shows does not prevent a copyright. That may be a circumstance

for the jury to consider in determining the extent of Mr. Wallace's rights, but it is not a bar. Moreover, on the evidence, such prints are used by less pretentious exhibitions when those for whom they were prepared have given them up.

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. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value -- it would be bold to say that they have not an aesthetic and educational value -- and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be out hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights. See *Henderson* v. *Tomkins*, 60 Fed. Rep. 758, 765. We are of opinion that there was evidence that the plaintiffs have rights entitled to the protection of the law.

The judgment of the Circuit Court of Appeals is reversed; the judgment of the Circuit Court is also reversed and the cause remanded to that court with directions to set aside the verdict and grant a new trial.

Dissent

Mr. Justice Harlan, with whom concurred Mr. Justice McKenna, dissenting.

Judges Lurton, Day and Severens, of the Circuit Court of Appeals, concurred in affirming the judgment of the District Court. Their views were thus expressed in an opinion delivered by Judge Lurton: "What we hold is this: That if a chromo, lithograph, or other print, engraving, or picture has no other use than that of a mere advertisement, and no value aside from this

function, it would not be promotive of the useful arts, within the meaning of the constitutional provision, to protect the 'author' in the exclusive use thereof, and the copyright statute should not be construed as including such a publication, if any other construction is admissible. If a mere label simply designating or describing an article to which it is attached, and which has no value separated from the article, does not come within the constitutional clause upon the subject of copyright, it must follow that a pictorial illustration designed and useful only as an advertisement, and having no intrinsic value other than its function as an advertisement, must be equally without the obvious meaning of the Constitution. It must have some connection with the fine arts to give it intrinsic value, and that it shall have is the meaning which we attach to the act of June 18, 1874, amending the provisions of the copyright law. We are unable to discover anything useful or meritorious in the design copyrighted by the plaintiffs in error other than as an advertisement of acts to be done or exhibited to the public in Wallace's show. No evidence, aside from the deductions which are to be drawn from the prints themselves, was offered to show that these designs had any original artistic qualities. The jury could not reasonably have found merit or value aside from the purely business object of advertising a show, and the instruction to find for the defendant was not error. Many other points have been urged as justifying the result reached in the court below. We find it unnecessary to express any opinion upon them, in view of the conclusion already announced. The judgment must be affirmed." *Courier Lithographing Co.* v. *Donaldson Lithographing Co*., 104 Fed. Rep. 993, 996.

I entirely concur in these views, and therefore dissent from the opinion and judgment of this court. The clause of the Constitution giving Congress power to promote the progress of science and useful arts, by securing for limited terms to authors and inventors the exclusive right to their respective works and discoveries, does not, as I think, embrace a mere advertisement of a circus.

MR. JUSTICE MCKENNA authorizes me to say that he also dissents.

C. Mid-Century Classics, 1951-1967

C.1. Lead-in

These two cases – *Alfred Bell v. Catalda Fine Arts* (2d Cir. 1951) and *Morrissey v. Procter & Gamble* (1st Cir. 1967) – show copyrightability being pulled in different directions. Both are leading cases, and both are included in many casebooks. Each offers up some picturesque language. *Alfred Bell v. Catalda* has the "clap of thunder." *Morrissey* has the "game of chess."

C.2. Case: Alfred Bell v. Catalda Fine Arts (2d Cir. 1951)

Pre-reading notes

Authored by a famous and revered jurist, Judge Jerome Frank, the case of *Alfred Bell v. Catalda Fine Arts*, 191 F.2d 99 (2d Cir. 1951) stands for copyrightability as having an extremely low threshold for originality in authorship. That low bar is marked by the case's teaching that the even the jostle of a hand caused by a "clap of thunder" is enough to turn a mere copyist into an author.

Opinion

[Footnotes have been omitted, but not the footnote references. –Ed.]

Alfred Bell v. Catalda Fine Arts (2d Cir. 1951)

United States Court of Appeals for the Second Circuit
191 F.2d 99 (1951)

FRANK, Circuit Judge.

1. Congressional power to authorize both patents and copyrights is contained in Article 1, Sec. 8 of the Constitution.[1] In passing on the validity of patents, the Supreme Court recurrently insists that this constitutional provision governs. On this basis, pointing to the Supreme Court's consequent requirement that, to be valid, a patent must disclose

a high degree of uniqueness, ingenuity and inventiveness, the defendants assert that the same requirement constitutionally governs copyrights. As several sections of the Copyright Act- e.g., those authorizing copyrights of 'reproductions of works of art,' maps, and compilations- plainly dispense with any such high standard, defendants are, in effect, attacking the constitutionality of those sections. But the very language of the Constitution differentiates (a) 'authors' and their 'writings' from (b) 'inventors' and their 'discoveries.' Those who penned the Constitution,[2] of course, knew the difference. The pre-revolutionary English statutes had made the distinction.[3] In 1783, the Continental Congress had passed a resolution recommending that the several states enact legislation to 'secure' to authors the 'copyright' of their books.[4] Twelve of the thirteen states (in 1783-1786) enacted such statutes.[5] Those of Connecticut and North Carolina covered books, pamphlets, maps, and charts.[6]

Moreover, in 1790, in the year after the adoption of the Constitution, the first Congress enacted two statutes, separately dealing with patents and copyrights. The patent statute, enacted April 10, 1790, 1 Stat. 109, provided that patents should issue only if the Secretary of State, Secretary of War and the Attorney General, or any two of them 'shall deem the invention or discovery sufficiently useful and important'; the applicant for a patent was obliged to file a specification 'so particular' as 'to distinguish the invention or discovery from other things before known and used '; the patent was to constitute prima facie evidence that the patentee was 'the first and true inventor or discoverer of the thing so specified.'[7] The Copyright Act, enacted May 31, 1790, 1 Stat. 124, covered 'maps, charts, and books'. A printed copy of the title of any map, chart or book was to be recorded in the Clerk's office of the District Court, and a copy of the map, chart or book was to be delivered to the Secretary of State within six months after publication. Twelve years later, Congress in 1802, 2 Stat. 171, added, to matters that might be copyrighted, engravings, etchings and prints.

Thus legislators peculiarly familiar with the purpose of the Constitutional grant by statute, imposed far less exacting standards in the

case of copyrights. They authorized the copyrighting of a mere map which, patently, calls for no considerable uniqueness. They exacted far more from an inventor. And, while they demanded that an official should be satisfied as to the character of an invention before a patent issued, they made no such demand in respect of a copyright. In 1884, in Burrow-Giles Lithographic Co. v. Sarony, 111 U.S. 53, 57, the Supreme Court, adverting to these facts said: 'The construction placed upon the constitution by the first act of 1790 and the act of 1802, by the men who were contemporary with its formation, many of whom were members of the convention which framed it, is of itself entitled to very great weight, and when it is remembered that the rights thus established have not been disputed during a period of nearly a century, it is almost conclusive.' Accordingly, the Constitution, as so interpreted, recognizes that the standards for patents and copyrights are basically different.

The defendants' contention apparently results from the ambiguity of the word 'original'. It may mean startling, novel or unusual, a marked departure from the past. Obviously this is not what is meant when one speaks of 'the original package,' or the 'original bill,' or (in connection with the 'best evidence' rule) an 'original' document; none of those things is highly unusual in creativeness. 'Original' in reference to a copyrighted work means that the particular work 'owes its origin' to the 'author.'[8] No large measure of novelty is necessary. Said the Supreme Court in Baker v. Selden, 101 U.S. 99, 102-103: 'The copyright of the book, if not pirated from other works, would be valid without regard to the novelty, or want of novelty, of its subject-matter. The novelty of the art or thing described or explained has nothing to do with the validity of the copyright. To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government. The difference between the

two things, letters-patent and copyright, may be illustrated by reference to the subjects just enumerated. Take the case of medicines. Certain mixtures are found to be of great value in the healing art. If the discoverer writes and publishes a book on the subject (as regular physicians generally do), he gains no exclusive right to the manufacture and sale of the medicine; he gives that to the public. If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book. So of all other inventions or discoveries.'

In Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250 252, the Supreme Court cited with approval Henderson v. Tompkins, C.C., 60 F. 758, where it was said, 60 F.at page 764: 'There is a very broad distinction between what is implied in the word 'author,' found in the constitution, and the word 'inventor.' The latter carries an implication which excludes the results of only ordinary skill, while nothing of this is necessarily involved in the former. Indeed, the statutes themselves make broad distinctions on this point. So much as relates to copyrights is expressed, so far as this particular is concerned, by the mere words, 'author, inventor, designer or proprietor,' with such aid as may be derived from the words 'written, composed or made,' . But a multitude of books rest safely under copyright, which show only ordinary skill and diligence in their preparation. Compilations are noticeable examples of this fact. With reference to this subject, the courts have not undertaken to assume the functions of critics, or to measure carefully the degree of originality, or literary skill or training involved.'[9]

It is clear, then, that nothing in the Constitution commands that copyrighted matter be strikingly unique or novel. Accordingly, we were not ignoring the Constitution when we stated that a 'copy of something in the public domain' will support a copyright if it is a 'distinguishable variation';[10] or when we rejected the contention that 'like a patent, a copyrighted work must be not only original, but new', adding, 'That is not the law as is obvious in the case of maps or compendia, where later

works will necessarily be anticipated.'[11] All that is needed to satisfy both the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.'[12] Originality in this context 'means little more than a prohibition of actual copying.'[13] No matter how poor artistically the 'author's' addition, it is enough if it be his own. Bleistein v. Donaldson Lithographing Co., 188 U.S. 239, 250.

On that account, we have often distinguished between the limited protection accorded a copyright owner and the extensive protection granted a patent owner. So we have held that 'independent reproduction of a copyrighted work is not infringement',[14] whereas it is vis a vis a patent. Correlative with the greater immunity of a patentee is the doctrine of anticipation which does not apply to copyrights: The alleged inventor is chargeable with full knowledge of all the prior art, although in fact he may be utterly ignorant of it. The 'author' is entitled to a copyright if he independently contrived a work completely identical with what went before; similarly, although he obtains a valid copyright, he has no right to prevent another from publishing a work identical with his, if not copied from his. A patentee, unlike a copyrightee, must not merely produce something 'original'; he must also be 'the first inventor or discoverer.'[15] 'Hence it is possible to have a plurality of valid copyrights directed to closely identical or even identical works. Moreover, none of them, if independently arrived at without copying, will constitute an infringement of the copyright of the others.'[16]

The difference between patents and copyrights is neatly illustrated in the design patent cases.[17] We have held that such a patent is invalid unless it involves 'a step beyond the prior art', including what is termed 'inventive genius.' A.C. Gilbert Co. v. Shemitz, 2 Cir., 45 F.2d 98, 99. We have noted that, as in all patents, there must be a substantial advance over the prior art. Neufeld-Furst & Co. v. Jay-Day Frocks, 2 Cir.,112 F.2d 715, 716. We have suggested that relief for designers could be obtained if they were permitted to copyright their designs, and that, until there is an amendment to the copyright statute, 'new designs are open to all, unless

their production demands some salient ability.' Nat Lewis Purses v. Carole Bars, 2 Cir., 83 F.2d 475, 476. We have noted that if designers obtained such a statute, it would give them 'a more limited protection and for that reason easier to obtain. ' White v. Leanore Frocks, Inc., 2 Cir.,120 F.2d 113, 115.[18]

2. We consider untenable defendants' suggestion that plaintiff's mezzotints could not validly be copyrighted because they are reproductions of works in the public domain. Not only does the Act include 'Reproductions of a work or art',[19] but- while prohibiting a copyright of 'the original text of any work in the public domain'[20] - it explicitly provides for the copyrighting of 'translations, or other versions of works in the public domain'.[21] The mezzotints were such 'versions.' They 'originated' with those who make them, and- on the trial judge's findings well supported by the evidence- amply met the standards imposed by the Constitution and the statute.[22] There is evidence that they were not intended to, and did not, imitate the paintings they reproduced. But even if their substantial departures from the paintings were inadvertent, the copyrights would be valid.[23] A copyist's bad eyesight or defective musculature, or a shock caused by a clap of thunder, may yield sufficiently distinguishable variations.[24] Having hit upon such a variation unintentionally, the 'author' may adopt it as his and copyright it.[25]

Accordingly, defendants' arguments about the public domain become irrelevant. They could be relevant only in their bearing on the issue of infringement, i.e., whether the defendants copied the mezzotints.[26] But on the findings, again well grounded in the evidence, we see no possible doubt that defendants, who did deliberately copy the mezzotints, are infringers. For a copyright confers the exclusive right to copy the copyrighted work- a right not to have others copy it. Nor were the copyrights lost because of the reproduction of the mezzotints in catalogues.[27]

3. We think the defendants did not establish the anti-trust 'unclean-hands' defense: (1) The Guild's price-fixing provision was explicitly confined to Great Britain and Ireland, and did not affect sales in the

United States. (2) As to the Guild agreement to restrict output,[28] there are some considerations: Of some 600 or 700 members, according to the testimony only 'one or two' are in this country, for all that the slender proof shows, their participation in Guild activities may have been limited to the receipt of Guild catalogues; the plaintiff has no office or assets here, and there is no evidence that it acted here on behalf of the Guild. So far as the evidence discloses, the output restriction was not imposed with sales in the United States in mind. Accordingly, we take it that the restriction was meant to have, and did have, at most, only an incidental, peripheral, reference to sales in the United States of America.[29] All the foregoing is important since recently the Supreme Court, in similar contexts, has given the 'unclean hands' doctrine a somewhat narrowed scope. Kiefer-Stewart Co. v. Joseph E. Seagram & Sons, Inc., 340 U.S. 211, 214,[30] . We have here a conflict of policies: (a) that of preventing piracy of copyrighted matter and (b) that of enforcing the anti-trust laws. We must balance the two, taking into account the comparative innocence or guilt of the parties, the moral character of their respective acts, the extent of the harm to the public interest, the penalty inflicted on the plaintiff if we deny it relief. As the defendants' piracy is unmistakably clear, while the plaintiffs' infraction of the anti-trust laws is doubtful and at most marginal, we think the enforcement of the first policy should outweigh enforcement of the second.[31]

4. The trial judge did not 'abuse' his discretion as to the allowance or amount of attorneys' fees. We agree with his rulings, and his reasons therefor, concerning the items of accounting for profits- with but one exception: We think he erred in allowing defendants to deduct their income taxes. He said, 'The nature of defendants' acts is, of course darkened somewhat by the use of a false copyright label, by sales after notice, and by the defendant Lithograph's apparent unconcern over the validity of the plaintiff's copyright, so long as defendants Catalda Company and Catalda were willing to indemnify Lithograph'; he also said that defendants 'were not innocent of knowledge of the claimed copyright by the plaintiff of the subjects in suit.' Nevertheless, he held that

'their villainy is not of the deepest dye in that the copying was open, and with no attempt at concealment, under a good-faith claim of a right to copy because of the claimed invalidity of the plaintiff's copyright.' With that last conclusion we disagree. Open and unabashed piracy is not a mark of good faith; and we think the 'claimed invalidity' unjustified.[32] In these circumstances, the deduction of the taxes was improper.[33] To that extent only, the judgment is modified; otherwise it is affirmed.

C.3. Case: Morrissey v. Procter & Gamble Co., 379 F.2d 675 (1967)

Pre-reading notes

This case goes in a completely different direction than *Alfred Bell*. The plaintiff loses their bid to protect their creation through copyright. Not a thunder-clap jostle, nor quite a bit more, will seem to do. In pushing back on easy copyrightability, the *Morrissey* court seems to suggest it is protecting the public from the well-lawyered and the powerful. And maybe so. But this is a one of those little-guy-versus-big-guy cases. A very little guy, in fact, versus a very, very big guy – the mighty Proctor & Gamble, the king of soap and the creator of the disposable diaper, in the prime of its corporate life. And the little guy lost.

Opinion

Morrissey v. Procter & Gamble (1st Cir. 1967)

United States Court of Appeals for the First Circuit
379 F.2d 675 (1967)

Frank Morrissey, plaintiff and appellant.
The Procter & Gamble Company et al., defendants and appellees.
Before ALDRICH, Chief Judge, McENTEE and COFFIN, Circuit Judges.

ALDRICH, Chief Judge.

This is an appeal from a summary judgment for the defendant. The plaintiff, Morrissey, is the copyright owner of a set of rules for a sales

promotional contest of the 'sweepstakes' type involving the social security numbers of the participants. Plaintiff alleges that the defendant, Procter & Gamble Company, infringed, by copying, almost precisely, Rule 1. In its motion for summary judgment, based upon affidavits and depositions, defendant denies that plaintiff's Rule 1 is copyrightable material, and denies access. The district court held for the defendant on both grounds.

Taking the second ground first, the defendant offered affidavits or depositions of all of its allegedly pertinent employees, all of whom denied having seen plaintiff's rules. Although the plaintiff, by deposition, flatly testified that prior to the time the defendant conducted its contest he had mailed to the defendant his copyrighted rules with an offer to sell, the court ruled that the defendant had 'proved' nonaccess, and stated that it was 'satisfied that no material issue as to access ... lurks ... [in the record.]'

The court did not explain whether it considered defendant's showing to have constituted proof overcoming the presumption of receipt arising from plaintiff's testimony of mailing, or whether it felt there was an unsatisfied burden on the plaintiff to show that the particularly responsible employees of the defendant had received his communication. Either view would have been error. A notice to the defendant at its principal office, as this one assertedly was, is proper notice. There is at least an inference that the letter reached its proper destination. Even if we assume that if, at the trial of the case, it should be found that the particular employees of the defendant responsible for the contest were in fact without knowledge of plaintiff's rules, defendant would be free of a charge of copying, cf. Pinci v. Twentieth Century-Fox Film Corp., S.D.N.Y., 1951, 95 F.Supp. 884; Dezendorf v. Twentieth Century-Fox Film Corp., S.D.Cal., 1940, 32 F.Supp. 359, aff'd, 9 Cir., 118 F.2d 561, on a motion for summary judgment a plaintiff should not have to go to the point of showing that every employee of a corporate defendant received his notification. Nor can it be said that no issue of fact as to access 'lurks' merely because it seems to the court that plaintiff's own proof has been satisfactorily contradicted. Nothing is clearer than this on a motion for summary judgment; if a party has made an evidentiary showing warranting a favorable inference, contradiction cannot eliminate it. Summary judgment may not be granted where there is the 'slightest doubt as

to the facts.' Peckham v. Ronrico Corp., 1 Cir., 1948, 171 F.2d 653, 657; Arnstein v. Porter, 2 Cir., 1946, 154 F.2d 464, 468. Defendant's argument misreads Dressler v. MV Sandpiper, 2 Cir., 1964, 331 F.2d 130. The presumption arising from mailing remained in the case.[1]

> [1] The court did not discuss, nor need we, the additional fact that the almost exact following of plaintiff's wording and format in an area in which there is at least some room for maneuverability, might be found of itself to contradict defendant's denial of access. Cf. Arnstein v. Porter, supra.

It is true that we have, on rare occasion, held that even though there is some slight evidence favoring a plaintiff, the evidence contrary may be so overpowering that a verdict for the plaintiff cannot be permitted, and judgment must be ordered for the defendant. Dehydrating Process Co. v. A. O. Smith Corp., 1 Cir., 1961, 292 F.2d 653, cert. den. 368 U.S. 931; see Magnat Corp. v. B & B Electroplating Co., 1 Cir., 1966, 358 F.2 794. We have never suggested that such a principle is applicable to a motion for summary judgment, and we do not now.[2] Cf. Robbins v. Milner Enterprises, Inc., 5 Cir., 1960, 278 F.2d 492, 496-497.

> [2] Defendant seeks to attach weight to thirteen letters introduced through its witness who testified he had received them from thirteen other companies in contradiction of plaintiff's testimony that he had sent copies of his rules to them, as well as to the defendant. In the first place, in spite of defendant's elaborate argument, the letters so introduced were rank hearsay as to the truth of their content, in contravention to Rule 56's fundamental requirement that the party's position be sustained by competent and admissible evidence. Fed.R.Civ.P. 56(e). But even more elementary, had they been admissible affidavits of thirteen bishops they could not have varied the principle that issues of fact are not to be resolved on summary judgment.

The second aspect of the case raises a more difficult question. Before discussing it we recite plaintiff's Rule 1, and defendant's Rule 1, the italicizing in the latter being ours to note the defendant's variations or changes.

{Plaintiff Morrissey's Rule 1}

> '1. Entrants should print name, address and social security number on a boxtop, or a plain paper. Entries must be accompanied by boxtop or by plain paper on which the name is copied from any source. Official rules are explained on packages or leaflets obtained from dealer. If you do not have a social security number you may use the name and number of any member of your immediate family living with you. Only the person named on the entry will be deemed an entrant and may qualify for prize.
>
> 'Use the correct social security number belonging to the person named on entry wrong number will be disqualified.'

(Plaintiff's Rule)

{Defendant Proctor & Gamble's Rule 1:}

> '1. Entrants should print name, address and Social Security number on a Tide boxtop, or on (a) plain paper. Entries must be accompanied by Tide boxtop (any size) or by plain paper on which the name 'Tide' is copied from any source. Official rules are available on Tide Sweepstakes packages, or on leaflets at Tide dealers, or you can send a stamped, self-addressed envelope to: Tide 'Shopping Fling' Sweepstakes, P.O. Box 4459, Chicago 77, Illinois.
>
> 'If you do not have a Social Security number, you may use the name and number of any member of your immediate family living with you. Only the person named on the entry will be deemed an entrant and may qualify for a prize.
>
> 'Use the correct Social Security number, belonging to the person named on the entry— wrong numbers will be disqualified.'

(Defendant's Rule)

The district court, following an earlier decision, Gaye v. Gillis, D.Mass., 1958, 167 F.Supp. 416, took the position that since the substance of the contest was not copyrightable, which is unquestionably correct, Baker v. Selden, 1879, 101 U.S. 99; Affiliated Enterprises v. Gruber, 1 Cir., 1936, 86 F.2d 958; Chamberlin v. Uris Sales Corp., 2 Cir., 1945, 150 F.2d 512, and the substance was relatively simple, it must follow that plaintiff's rule sprung directly from the substance and 'contains no original creative authorship.' 262 F.Supp. at 738. This does not follow. Copyright attaches to form of expression, and defendant's own proof, introduced to deluge the court on the issue of access, itself established that there was more than one way of expressing even this simple substance. Nor, in view of the almost precise similarity of the two rules, could defendant successfully invoke the principle of a stringent standard for showing infringement which some courts apply when the subject matter involved admits of little variation in form of expression. E.g., Dorsey v. Old Surety Life Ins. Co., 10 Cir., 1938, 98 F.2d 872, 874, 119 A.L.R. 1250 ('a showing of appropriation in the exact form or substantially so.'); Continental Casualty Co. v. Beardsley, 2 Cir., 1958, 253 F.2d 702, 705, cert. denied, 358 U.S. 816 ('a stiff standard for proof of infringement.').

Nonetheless, we must hold for the defendant. When the uncopyrightable subject matter is very narrow, so that 'the topic necessarily requires,' Sampson & Murdock Co. v. Seaver-Radford Co., 1 Cir., 1905, 140 F. 539, 541; cf. Kaplan, An Unhurried View of Copyright, 64-65 (1967), if not only one form of expression, at best only a limited number, to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated. Cf. Baker v. Selden, supra.

Upon examination the matters embraced in Rule 1 are so straightforward and simple that we find this limiting principle to be applicable. Furthermore, its operation need not await an attempt to

copyright all possible forms. It cannot be only the last form of expression which is to be condemned, as completing defendant's exclusion from the substance. Rather, in these circumstances, we hold that copyright does not extend to the subject matter at all, and plaintiff cannot complain even if his particular expression was deliberately adopted.

Affirmed.

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