

“WHAT IF? IN COPYRIGHT”
by Stanley Rothenberg*

What If “Don Quixote” Had Been Copyrighted?

What If Spain had a copyright law in the 1600s which protected an author’s distinctive literary characters (which it did not)?¹ The answer has a significant bearing on Miguel de Cervantes’ world famous novel “Don Quixote de la Mancha,” which was first published in 1605,² prior to the first copyright law in Europe for the protection of authors, England’s Statute of Anne passed in 1709.³ Incidentally, said statute served as the basis for the state copyright laws issued under the Articles of Confederation and the first United States copyright law, enacted in 1790.⁴

But getting back to Spain and Cervantes, Spain’s true copyright laws date back to 19th century laws which “were strongly influenced by the seminal French laws of 1791 and 1793, enacted during the French Revolution.”⁵ However, Spain did have laws requiring a Royal Privilege or license from the King’s Council (on behalf of the King) to print a book, which license was conditioned upon a reading of the book, which in the case of “The Second Part of Don Quixote de la Mancha” ascertained that “it does not contain anything contrary to the faith or good morals, but rather offers much wholesome entertainment intermingled with much moral philosophy.” The Privilege was for ten years, from March 30, 1615, and provided that “during

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¹ See Paul Geller & Melville Nimmer, *International Copyright Law and Practice* (2001), Alberto Bercovitz, Germán Bercovitz and Milagros del Corral, Spain §1[1][a].

² Benét’s *Reader’s Encyclopedia* (3d ed. 1987) at p. 268.

³ 8 Anne, c. 19. See Harry Ransom, *The First Copyright Statute: An Essay on An Act for the Encouragement of Learning, 1710* (1956).

⁴ Barbara Ringer, “Two Hundred Years of American Copyright Law” in *Two Hundred Years of English & American Patent, Trademark and Copyright Law* (American Bar Association, 1977) at p. 121.

the said space of time no person may without [Cervantes'] permission print or sell the book, and whosoever shall so print or sell it shall lose whatever copies of it he may have in his possession along with the type and the forms, and shall in addition incur the penalty of a fine of fifty thousand maravedis for each offense, one third of the said fine to go to our Chamber, one third to the judge who shall sentence him, and the remaining third to the plaintiff.”⁶

Notwithstanding the Royal Privilege of exclusivity to print and sell the book, it did not mention derivative works or otherwise extend to a sequel, i.e., the use of the characters in new and different adventures. In fact, unauthorized sequels were a common practice at the time.⁷ Thus Don Quixote, one of the most enduring and best loved characters in world literature, and his sidekick Sancho Panza, were free for the taking by any free-loading novelist. And so, along came Alonso Fernández de Avellaneda (pseud.) in 1614 with publication of his unauthorized sequel.⁸

Cervantes was furious, but what could he do to put a stop to any further kidnapping of his distinctive, clearly delineated character? Cervantes used the only lawful tool available to him. Cervantes, who had already been writing Part II of “Don Quixote”, to be published in 1615,⁹ used the opportunity to kill off his famous protagonist.¹⁰ (“Although ten years separated

⁵ Geller & Nimmer, *supra* note 1.

⁶ Miguel de Cervantes, *Don Quixote De La Mancha* (trans. by Samuel Putnam, Modern Library ed. 1998) at pp. 588-589. The Royal Privilege given September 26, 1604 in respect of Part I, which was erroneously entitled by the printer, “The Ingenious Gentleman of La Mancha,” was also for “the time and space of ten years current from the day and date of this scroll.” The error consisted of the omission of “Don Quixote” after the word “Ingenious.” *Id.* at p.9.

⁷ Jean Canavaggio, *Cervantes* (1990) at p. 279.

⁸ Benét, *supra* note 2.

⁹ *Ibid.*

¹⁰ Canavaggio, *supra* note 7 at pp. 296-297 does not believe that was the reason for Don Quixote’s death. He may be right, but I think my suggestion is more romantic. In fact, I believe I received the suggestion from the late John T. Winterich, a former editor of *The American Scholar*, a contributing editor to *The Saturday Review of Literature* and author of, among others, *The Romance of Great Books and their Authors* (1929) (first published under the title *Books and the*

publication of Parts I and II of ‘Don Quixote,’ the halves are too closely joined to be considered separately” and have, in fact, been published as a single work.)¹¹

Thus if Spain had had a true and effective copyright law in the 1600s, instead of a Stationers’ Company type licensing law,¹² it is less likely that Avellaneda would have written and published his spurious sequel¹³ and thus it is more likely that “Don Quixote de la Mancha” may have been somewhat shorter, and perhaps its leading character would not have been killed off, but would have survived for further appearances in legitimate sequels written by Cervantes himself (or, more likely, written by others, authorized by his estate to do so).¹⁴ Of course, Cervantes would not write any further adventures of Don Quixote since the author died in 1616, four months after he killed off his beloved Don Quixote in Part II.¹⁵

Man) and Twenty-Three Books and the Stories Behind Them (my Lippincott edition: 1939 on the title page, and 1938 in the copyright notice).

¹¹ William Byron, *Cervantes, A Biography* (1978) at p. 423.

¹² See Benjamin Kaplan, *An Unhurried View of Copyright* (1967) at pp. 2-7 for a description of England’s Stationers’ Company. “The generic name for printers, publishers, and booksellers was formerly *stationers*. Their guild in London was the Stationers’ Company...The publisher was the entrepreneur who purchased the manuscript, took the risk of publication, paid the printer, owned the copyright, sold the book in his own shop, and sold the book wholesale to other booksellers.” Leo Kirschbaum, *Shakespeare and the Stationers* (1955) at p. 25.

¹³ This assumes of course that the Spanish courts would have decided the theft of a distinctive, clearly delineated literary character in favor of the original author to the detriment of the secondary author as first suggested by Judge Learned Hand in *Nichols v. Universal*, 45 F.2d 119 (2d Cir. 1930), *cert. denied*, 282 U.S. 902 (1931). Interestingly, character copyright infringement cases generally involve graphic characters from comic strips, e.g., *King Features Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924) (“Sparky”), comic books, e.g., *Detective Comics v. Bruns*, 111 F.2d 432 (2d Cir. 1940) (“Superman”) and movies, e.g., *Metro-Goldwyn-Mayer, Inc. v. American Honda Motor Co.*, 900 F. Supp. 1287 (C.D. Cal. 1955) (“James Bond Agent 007”) rather than literary characters. Even the literary characters involved in copyright infringement actions, such as “Tarzan,” *Burroughs v. Metro-Goldwyn-Mayer, Inc.*, 683 F.2d 610 (2d Cir. 1982) and cowboy “Hopalong Cassidy,” *FilmVideo Releasing Corp. v. Hastings*, 668 F.2d 91 (2d Cir. 1981) also appeared in comic strips and movies (albeit not initially), thus indirectly providing a graphic element.

¹⁴ Consider the six authorized James Bond Agent 007 novels written by Raymond Benson decades after Bond’s creator Ian Fleming’s death and the authorized Philip Marlowe detective novels written by Robert Parker several decades after the death of Marlowe’s creator, Raymond Chandler.

¹⁵ Canavaggio, *supra* note 7 at p. 304.

It must be noted that Spain was not the only country in which unauthorized sequels were not uncommon. H.M. (Harry Major) Paul in his wonderful work entitled “Literary Ethics: A Study in the Growth of the Literary Conscience” (1928) writes that because Paul Bunyan learned that “a pirate was about to bring out a continuation of the ‘Pilgrim’s Progress’” (1678), he wrote the second part (1684).¹⁶ Paul goes on to state that “[v]ery possibly, the publication of a continuation of ‘Robinson Crusoe’ [1719] by a pirate may have led [Daniel] Defoe to write his second part. Similarly ‘Gulliver’s Travels’ [1726] were issued with spurious additions.”¹⁷ Samuel Richardson’s “Pamela” was published in 1740. In 1741 he heard that a publisher had commissioned John Kelly to continue “Pamela.” Kelly wrote his continuation and “[i]n self-defense, Richardson wrote a continuation himself; but Kelly’s version, ‘Pamela’s Conduct in High Life,’ came out in September, 1741, whilst Richardson’s ‘Second Part’ did not appear till three months later.”¹⁸ Richardson’s rival, Henry Fielding “was a fellow-sufferer. After ‘Tom Jones’ [1749] had taken the public by storm an impudent sequel appeared, ‘Tom Jones in his Married State.’”¹⁹ In fact, one secondary author had the audacity to justify his action in writing an unauthorized continuation on the ground that the original “book ended so abruptly as to claim a sequel.”²⁰ An unauthorized sequel to Charles Dickens’ “Pickwick Papers” (1836-1837) “under the title of ‘The Pickwicks Abroad’ by G.W.M. Reynolds was published in twenty parts in 1839; and a writer in The Times Literary Supplement (13th April, 1922) stated that it ‘was still in print up to a few years ago.’”²¹ Unauthorized prologues, or prequels, were also not unknown.²²

¹⁶ Paul at p. 67.

¹⁷ Id. at p. 68.

¹⁸ Ibid.

¹⁹ Ibid.

²⁰ Id. at p. 69.

²¹ Ibid.

²² “In 1926 a novel, Porto-Bello Gold, by A.H. Smith was published, relating how the treasure of ‘Treasure Island’ [1883] came to be secreted, and introducing Silver, Pew and the rest of [Robert

What If “The Maltese Falcon” Had Been Decided 100 Years Earlier?

Curiously, a little more than 250 years after Cervantes’ death Louisa May Alcott ran into a variation on the “Don Quixote” sequel issue. After the success of her novel “Little Women” in 1868, her publisher, Thomas Niles of Roberts Brothers, asked her to write a sequel.²³ Alcott refused, saying she had already written about those characters, she would rather do something different. Her publisher said alright, he would get someone else to write it, whereupon Alcott said never mind, she would write the sequel, or second volume of “Little Women,” which was published in 1869.²⁴ Quere whether that is how and why the reading public got not only the second volume of “Little Women” but also its sequel novels, “Little Men” in 1871 and “Jo’s Boys” in 1886.²⁵ But What If Alcott had challenged her publisher and said, you cannot use my characters in novels written by others? And What If neither party backed down and the dispute ended up in court, who would have won? In the first instance, the court would probably have looked to the publishing contract. (In the second instance, the court would probably have looked to applicable decided cases, of which, I submit, they would have found none.) Presumably the contract would have given the publisher the exclusive right under copyright to publish the novel without making any reference to its characters or to sequels, and certainly not to prequels.

In a comparable situation, the author Dashiell Hammett in 1930 granted a motion picture producer, Warner Brothers, the exclusive motion picture, radio and television rights under copyright to his novel “The Maltese Falcon” containing the original “hard-boiled” private detective, Sam Spade. Years later the author granted radio rights in the characters from the novel

Louis] Stevenson’s pirates. The objections to sequels set out in this chapter naturally apply with equal force to prologues.” *Id.* at p. 70.

²³ Cornelia Meigs, *Invincible Louisa* (1951) at pp. 213 and 215. “In fact the country was so taken with Louisa’s story that her publisher begged for a second volume.” <http://www.online-literature.com/alcott/>

²⁴ The source for this information is a conversation with the late John T. Winterich, *supra* note 10.

to the CBS radio network, which produced “The Adventures of Sam Spade”, a radio serial using the Sam Spade and Effie Perine (his loyal secretary) characters, with their names, from the novel. In the lawsuit that followed, the United States Court of Appeals for the Ninth Circuit held that the contract did not grant character or sequel rights to the motion picture producer, and that Mr. Hammett, the author, was free to use those characters and their names in other stories in motion pictures, radio and television.²⁶ Assuming that Alcott’s publishing contract did not give the publisher character or sequel rights or the copyright, then I think it is fair to say that based on the law as it stands today, Louisa May Alcott would have prevailed and the public may not have had the benefit of the sequels to “Little Women,” which, incidentally, are still in print today.

But What If pursuant to her publishing contract Alcott had granted the publisher the copyright in “Little Women”? Would the publisher have been free, as a matter of copyright law, to use the characters from the novel in other stories, in sequels, and in dramatic versions of the sequels for stage and screen? Or would the contract be interpreted, as it was in “The Maltese Falcon” case, to restrict the publisher to the particular story of the novel being conveyed? Bear in mind, that Warner Brothers acquired exclusive radio rights under copyright in the novel and yet was restricted to using the characters in the particular story of the novel. Assuming a stranger to Alcott and her publisher (the copyright owner for purposes of our hypothetical) infringed the novel with an unauthorized sequel, as per Avellaneda’s use of Don Quixote, would Alcott have had standing to sue the infringer? If Alcott’s contract with the publisher provided for royalties for each copy published, Alcott would be deemed a beneficial owner of the copyright under the current Copyright Act²⁷ which would give her standing to sue pursuant to

²⁵ Meigs, supra, note 23.

²⁶ Warner Bros. v. Columbia Broadcasting System, 216 F.2d 945 (9th Cir. 1954), cert. denied, 348 U.S. 971 (1955).

²⁷ See Cortner v. Israel, 732 F.2d 267 (2d Cir. 1984).

§501(b) thereof. What If the book publisher/copyright owner did not register the copyright? If the question arose today, could Alcott register the copyright in the publisher's name so that there will have been compliance with §411(a) of the Copyright Act which requires registration of the copyright claim in a United States work as a condition of institution of an action for copyright infringement? Yes, provided she is a beneficial owner.²⁸ If Alcott did not have a royalty arrangement but, for example, had sold her copyright for a flat sum, as was not uncommon in the 1860s, or even in 1909,²⁹ she would not qualify as a beneficial owner and thus would not have standing to commence the copyright litigation. In fact, why would Alcott want to sue an infringer if she was not, at a minimum, a royalty participant? Perhaps, Alcott might wish to sue an infringing third party for violation of her droit moral, or "moral right"?³⁰

For the equitable disposition between publisher and author of an author's recovery in the absence of any applicable contractual provision, consider McClintic v. Sheldon³¹, in which playwrights, Edward Sheldon and another (collectively "Sheldon"), and a theatrical stage producer, Guthrie McClintic, agreed to share the proceeds "from a sale or other disposition" of the motion pictures rights in Sheldon's play entitled "Dishonored Lady" produced by the theatrical producer for the live stage. Instead of engaging in a purchase, which was barred by the Will Hays censors group, M-G-M, the prospective purchaser/motion picture producer infringed

²⁸ Similarly, an assignee of an author's copyright renewal expectancy has been held to possess an implied power of attorney to apply in the author's name to register the claim to the author's renewal copyright. Rossiter v. Vogel, 134 F. 2d 908, 911 (2d Cir. 1943). Note, however, that if the work involved is not a "United States work" then the Copyright Act does not require registration of the copyright claim as a condition of institution of a copyright infringement action. See 17 U.S. Code §101 (1999) for the definition of "United States work."

²⁹ "It not infrequently happens that the author sells his copyright outright to a publisher for a comparatively small sum." H.R. Rep. No. 2222, 60th Cong., 2d Sess. (1909) commenting on then §23 (term of copyright) in enacting the Copyright Act of 1909.

³⁰ See Gilliam v. American Broadcasting Companies, 538 F.2d 14 (2d Cir. 1976) ("Monty Python"), the leading U.S. moral rights case.

³¹ 269 A.D. 356, 55 N.Y.S. 2d. 879 (1st Dept. 1945).

the play with the production of its movie entitled “Letty Lynton”, based on the novel of the same title based, in turn, on the same celebrated murder trial as was Sheldon’s play “Dishonored Lady.”³² Sheldon thereupon successfully sued M-G-M for copyright infringement.³³ However, Sheldon refused to share the monetary recovery with McClintic. The latter sued, and won, notwithstanding the absence of any reference in the Sheldon/McClintic contract to sharing proceeds from a recovery for copyright infringement,³⁴ and the absence from the 1909 Copyright Act of a beneficial owner provision similar (or even not similar) to §501(b) of the Copyright Act of 1976.

What If Winner Took All?

The “Letty Lynton” case is of interest for more than an interesting plagiarism holding, which is outside the scope of this paper. Prior thereto the Second Circuit took the 1909 Copyright Act literally when it stated that the prevailing plaintiff in an infringement action was entitled to all of the defendant’s profits derived from the infringement of the plaintiff’s work.³⁵ Thus, the district court on remand to determine damages, being bound by the Dam v. Kirk La Shelle decision, held that the plaintiff playwright (Sheldon and another) whose work was infringed was entitled to all of defendant movie company’s profits derived from defendant’s infringing motion picture, notwithstanding that a significant portion of defendant’s profits were

³² See Sheldon v. Metro-Goldwyn-Pictures Corp., 81 F.2d 49 (2d Cir.), cert. denied, 298 U.S. 669 (1936) (“Letty Lynton”).

³³ Ibid.

³⁴ McClintic, supra note 31.

³⁵ Dam v. Kirk La Shelle Co., 175 F.902 (2d Cir. 1910); “§101 INFRINGEMENT. – If any person shall infringe the copyright in any work protected under the copyright laws of the United States such person shall be liable: * * * (b) DAMAGES AND PROFITS...-- To pay to the copyright proprietor such damages as the copyright proprietor may have suffered due to the infringement, as well as all the profits which the infringer shall have made from such infringement, and in proving profits the plaintiff shall be required to prove sales only, and the defendant shall be required to prove every element of cost which he claims, * * *” (emphasis added). 17 U.S.C. §101(b) (1947). The substance of the 1909

attributable to defendant's noninfringing contribution to the motion picture, including the cinematic performances of leading lady Joan Crawford and screen star Robert Montgomery. Other substantial filmic contributions by M-G-M to the motion picture and, consequently, to the profits defendant earned, but unrelated to Sheldon's play, included other cast members' performances, the work of the producer and director, the noninfringing portions of the screenplay, the cinematography, the film editing, the music, set and costume design, etc. Thus awarding all the profits derived from the infringing work to the successful plaintiff/copyright owner was the law, until Judge Learned Hand's "Letty Lynton" decision on the damages issue,³⁶ in which Judge Hand decreed apportionment, as a matter of equitable reason, thereby reducing the district court's 100% award (in excess of \$500,000) to 20% thereof. Judge Hand similarly reduced the district court's award of attorneys fees from \$55,000 to \$33,000. And the Supreme Court affirmed.³⁷

But What If "Letty Lynton" simply followed Kirk La Shelle, relied upon (unsuccessfully) by the plaintiff? The infringing motion picture in "Letty Lynton" cost \$1,067,664 to produce, distribute and exhibit, and grossed \$1,655,269 from sales and exhibition, yielding almost \$600,000 (before deducting over \$50,000 for income taxes) in profits for M-G-M.³⁸ Today, on the other hand, motion pictures cost 40 to 50 times or more the cost in 1936 to make a movie. Also, the movie grosses today run as high as several hundred million dollars. The profits, in

Copyright Act was codified and enacted as Title 17 U.S. Code by the Act of July 30, 1947 (61 Stat. 652).

³⁶ Sheldon v. Metro-Goldwyn Pictures Corporation, 106 F.2d 45 (2d Cir. 1939), aff'd, 309 U.S. 390 (1940).

³⁷ 309 U.S. 390 (1940).

³⁸ Sheldon v. Metro-Goldwyn Pictures Corporation, 26 F. Supp. 134, 40 USPQ 238, 240 (S.D.N.Y. 1938). The costs and grosses are those of the production company, Metro-Goldwyn-Mayer Corporation (M-G-M), the M-G-M distribution company and the Loew theatres, as well as other subsidiary and affiliated companies. Sheldon separately sued and recovered from a large New York City

turn, as determined according to GAAP (Generally Accepted Accounting Principles) (as distinguished from contractual definitions between movie companies and profit participants),³⁹ can, in turn, run into tens of millions of dollars. Without allocation between infringing and noninfringing contributions to the infringing motion picture, a reasonable (and appropriately financed) copyright infringement action should, generally, make the reasonable possibility of a megamillion dollar award a strong force for settlement, which inducement is simply not present (at least not to anywhere near the same extent) in settlement negotiations under the “Letty Lynton” allocation formula. Of course, even prior to the arrival of the megamillion dollar movie budgets, megamillion dollar grosses and megamillion dollar profits, the Copyright Act of 1976 adopted the “Letty Lynton” formula. Section 504(b) provides:

The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing damages. In establishing the infringer’s profits, the copyright owner is required to present proof only of the infringer’s gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work. (emphasis added)

17 U.S. Code §504(b)

Thus if Judge L. Hand had not refused to follow Kirk La Shelle, and if the Supreme Court went along with the “all the profits” formula, and if the “Letty Lynton” apportionment decision were not codified in the Copyright Act of 1976, then copyright infringement plaintiffs and their lawyers would have much more lucrative prospects than they do today and, possibly,

movie theatre (not owned by Loew’s Inc., M-G-M’s parent company) which exhibited the infringing movie. Sheldon v. Moredall Realty Corporation, 29 F. Supp. 729 (S.D.N.Y. 1939)

³⁹ See Schuyler Moore, *The Biz: The Basic Business, Legal and Financial Aspects of the Film Industry* (2000) at pp. 115-130; Pierce O’ Donnell and Dennis McDougal, *Fatal Subtraction: the inside story of Buchwald v. Paramount* (1992) at Appendices A, B and C.

the fear (where justified) of such large monetary awards would result in fewer copyright infringements and thus in fewer copyright infringement actions.

What If *Childress v. Taylor* Had Been Decided The Other Way?

What If *Childress v. Taylor*⁴⁰ in the Second Circuit Court of Appeals held (contrary to its actual holding) that two persons could be co-authors even though one of them did not create and contribute copyrightable material, but rather only contributed material gathered via research and interviews, as did actress Clarice Taylor, the unsuccessful would-be joint author⁴¹ in the aforesaid case? Would that also mean that an “idea person” could be a co-author with the writer who gives literary expression to the “ideas” of the other? At what point would the nonwriter’s contribution be so minimal in the copyright sense so as to preclude his or her being able to become a joint author?

Even if our hypothetical version of Childress permitted such minimal nonwriting contribution to qualify its nonwriter as a joint author,⁴² Childress had a second requirement for joint authorship, namely, that the writer had to have the state of mind that she and the nonwriter were co-authors of the work. So what if, instead of contributing research material or ideas as in Childress, the nonwriter, being a popular recording artist or radio disc jockey, “trades” (by written agreement) recording or playing the writer’s song in exchange for co-ownership status and co-authorship credit (as was allegedly done in the distant past by well known recording artists and disc jockeys)?

Assuming the written agreement and the performance by the nonwriter satisfy the requirement that the writer (and the nonwriter) had the state of mind required by Childress that

⁴⁰ 945 F.2d 500 (2d Cir. 1991)

⁴¹ “co-authors” and “joint authors” are used interchangeably.

they were co-authors of the work, would not that require a closer examination of whether the recording artist/disc jockey nonwriter's contribution could sustain the minimal contribution (even if not a copyrightable contribution) of a joint author? To what extent would morality, or ethics in the business place, enter into the equation, that is, influence the decision? Thus, if Childress were decided differently, wouldn't we reach a point where a new playwright (and of lesser stature than an Arthur Miller) would be told that the price of being produced on stage is to accept the producer (or one of his kin) as a co-owner of the copyright and co-author of the work? It is one thing for an author to sell a one-half interest in a copyright, it is quite another to anoint a nonwriter as a co-author of a work, because of the privileges that attach to authorship (as distinct from ownership) such as authorship (or co-authorship) credit, the right of termination of transfer (in the United States)⁴³ and the moral right outside the United States, and even to some extent in the United States, although sometimes under labels other than moral rights, such as unfair competition, passing off or violation of Section 43(a) of the Lanham Act, 15 U.S.C. §1125(a).⁴⁴

I submit that because of the ease with which the second prong of the Childress joint authorship test could be met or evaded, that it would be disastrous for many authors if we did not also require the first prong of the Childress joint authorship formula, namely, a copyrightable contribution to the joint work.⁴⁵

What If The "Uncle Tom's Cabin" Case Had Been Decided The Other Way?

What If Stowe v. Thomas, 23 Fed. Cas. 201 (No. 13514) (C.C.E.D. Pa. 1853), which held that an unauthorized German language translation of Harriet Beecher Stowe's best-selling novel

⁴² Of course the court held, *inter alia*, that "[i]t seems more consistent with the spirit of copyright law to oblige all joint authors to make copyrightable contributions, leaving those with non-copyrightable contributions to protect their rights through contract." 945 F.2d at 507.

⁴³ See 17 U.S.C. §§203 and 304(c) and (d).

⁴⁴ See Gilliam, *supra* note 30. Gilliam has also been referred to as a moral rights decision clothed in the Federal Trademark Act, the federal counterpart to state unfair competition laws.

“Uncle Tom’s Cabin, or, Life Among the Lowly,”⁴⁶ was not a copyright infringement because it was not a copy, was decided differently? What If the Stowe court held (which it did not) that a translation was a copy and thus a copyright infringement?

The court said an examination of the two works alongside one another made it quite clear that one was not a copy of the other. Ms. Stowe’s novel was also lawfully and widely dramatized without her consent, the performances becoming a staple of theatrical touring companies.⁴⁷

It was not until five years after the end of the Civil War, which Ms. Stowe’s novel was often said to have ignited,⁴⁸ that Congress amended the copyright law so as to confer upon the copyright owner the exclusive rights to translate and to dramatize his or her copyrighted work.⁴⁹ Stowe v. Thomas could have anticipated Congress and could have held that a translation was a copy, albeit in a foreign language, much like a “clever paraphrase” will not escape a charge of infringement.⁵⁰

Similarly, copyright litigation could have held a dramatization to be a form of copying similar to a translation. Morris Ebenstein spoke of literal copies and mental copies, finding them both copies for infringement purposes.⁵¹ Translations and dramatizations fall into the mental content category in that the secondary copy is not found on the printed page but in the reader’s

⁴⁵ See note 42 *supra*.

⁴⁶ “Before the book was a year old more than three hundred thousand copies had been sold in America alone – the equivalent, on a basis of proportionate population, of a million and a half copies [in 1929].” John T. Winterich, *The Romance of Great Books and Their Authors* (1929) at p. 88

⁴⁷ *Id.* at 100.

⁴⁸ See President Lincoln’s statement in 1862 when he met Ms. Stowe: “So you are the little woman wrote the book that created this great war!” Joan D. Hedrick, *Harriet Beecher Stowe: A Life* (1994) on bookjacket; “So you’re the little woman who wrote the book that made this great war.” Philip B. Kunhardt, Jr., Philip B. Kunhardt III and Peter W. Kunhardt, *Lincoln, an illustrated biography* (1992) at p. 235.

⁴⁹ Act of 1870, c. 230, 16 Stat. 212.

⁵⁰ Marshall Leaffer, *Understanding Copyright Law* (3d ed. 1999) at p. 388.

mind. Thus, if Stowe v. Thomas was decided in favor of Ms. Stowe, there would have been no need for the Act of 1870.

More importantly, the famous case of White-Smith Music Publishing Co. v. Apollo, 209 U.S. 1 (1908), which held that a piano roll was not a copy of a musical composition, may have been decided differently, using a differently decided Stowe v. Thomas as precedent. In fact, years later, and without the benefit of specific statutory language, Judge Learned Hand protected a plot (in Sheldon v. Metro-Goldwyn-Pictures Corp.⁵²) against unauthorized nonliteral use in a second work.

If White-Smith Music Publishing Co. v. Apollo had found in favor of the music publisher, arguably there would not have been a push (certainly not by the music publishers) or a need (by said music publishers) to include in the 1909 Copyright Act protection against mechanical reproduction (whether by means of piano rolls or phonograph records) since the music publishers would have already had such protection by way of their exclusive right to reproduce or copy their copyrighted musical compositions. In the absence of such a push or need for legislation, arguably, the “compulsory license” would not have surfaced or, having surfaced, might not have succeeded in being enacted, or at least not in the form in which it was enacted. What a different landscape would have unfolded in the following years. Imagine, from 1909 until 1978, for almost seven decades, record companies could and did pay only 2¢ per unit per recorded musical composition (without adjustment for inflation!) provided the owner of the composition had already licensed its recorded use and such licensed recording was manufactured and distributed.⁵³ The Copyright Act of 1976, on the other hand, provides for frequent rate

⁵¹ Morris Ebenstein in his Introduction to Stanley Rothenberg, *Copyright Law: Basic and Related Materials* (1956) at pp. xxii ff.

⁵² Supra, note 32.

⁵³ Copyright Act of 1909, §1(e).

adjustments. 17 U.S.C. § 115(c)(2) (2000). Today the rate is 8¢ or 1.55¢ per minute playing time or fraction thereof, whichever is greater. Commencing January 1, 2004, the rate shall be 8.5¢ and 1.65¢ playing time or fraction thereof, whichever is greater. 1977 Mechanical Rate Adjustment Proceeding, at <http://www.copyright.gov/carp/m200a.html> (last visited May 15, 2003).

But if a piano roll had been ruled a copy of the music, wouldn't a phonograph record equally have been a copy of the recorded performance? What consequences might that have had?

What If Phonograph Record Distribution Was a Publication?

What If protection under state statutory law and state common law (including cases brought under the unfair competition label) (hereinafter collectively “the common law”) of sound recordings, prior to the enactment in 1971 of federal statutory protection,⁵⁴ terminated upon publication (which it did not)? It has been a matter of black letter law that upon publication of a work the common law rights ended and unless the work was invested at such time with statutory copyright, the work entered the public domain.⁵⁵ Notwithstanding, in 1908 the Supreme Court held that a piano roll (and by extension a phonograph record) was not a “copy” of the musical composition embodied therein, and therefore its unauthorized publication was not a copyright infringement of the musical composition. White-Smith Music Publishing Co. v. Apollo Co., 209 U.S.1, 18 (1908) (“even those skilled in the making of these rolls are unable to read them as musical compositions”).

⁵⁴ February 15, 1972 is the effective date of the first statute providing Federal copyright protection in sound recordings fixed on and after said date and before January 1, 1975. Act of October 15, 1971, Pub. L. 92-140, 85 Stat. 391. The January 1, 1975 “ceiling” was removed in 1974. Pub. L. No. 93-573, 88 Stat. 1873 (Dec. 31, 1974). “With respect to sound recordings fixed before February 15, 1972, any rights or remedies under common law or statutes of any State shall not be annulled or limited by this title until February 15, 2067.” 17 U.S.Code §301(c) (1999).

Relying on that artificial distinction, or strained interpretation, five decades later the United States Court of Appeals for the Second Circuit held that the distribution (i.e., publication) of phonograph recordings did not terminate the common law rights in the recordings per se so that unauthorized duplicates of them were the equivalent of common law copyright infringement, Capital Records v. Mercury Record Corp., 221 F.2d 657, 105 U.S.P.Q. 163 (2d Cir. 1955) (L. Hand, dissenting), albeit under the rubric of unfair competition (even though this was not a case of record “piracy” or counterfeiting). Judge Learned Hand did not endorse the Capital Records decision. He would have placed the recordings in the public domain because in his words, “[t]hat is indeed a harsh limitation, since [plaintiff] cannot copyright them; but I am not satisfied that the result is unjust, when the alternative is a monopoly unlimited both in time and user.” (emphasis added) 221 F.2d at 667. Judge Learned Hand was not alone on this position.

In Goldstein v. United States, 412 U.S. 546, 93 S.Ct. 2303 (1973) (J. Douglas, dissenting), the Supreme Court in upholding the validity of a California statute making it a criminal offense to copy recordings without permission, treated the statute interchangeably with a state copyright, 93 S.Ct. at 2310. (State protection of master recordings fixed on or after February 15, 1972 were not at issue.) Justice Douglas dissented on the same grounds as had Judge Learned Hand in Capital Records, saying “California extends her monopoly into perpetuity.” (emphasis added) 93 S.Ct. at 2318.

If Judge Learned Hand’s and Justice Douglas’s view prevailed, the “what if” would have resulted in countless pre-February 15, 1972 recordings having entered the public domain, recordings by Bing Crosby, Judy Garland, Elvis Presley, The Beatles, Duke Ellington, Glenn Miller, Louis Armstrong and scores of other musical icons. In such event, anyone wishing to reproduce and distribute the recordings (or any derivative work thereof) would have only needed

⁵⁵ Leaffer, supra note 50 at pp. 146 ff.

a license from the owner of the copyright in the musical composition embodied in the recording. And if the musical compositions were also in the public domain, such as Irving Berlin's "Alexander's Ragtime Band" (1911) and "A Pretty Girl Is Like A Melody" (1919)⁵⁶, the entire recording could be appropriated (albeit nonexclusively) royalty-free without anyone's consent.

If Capitol Records and Goldstein had been decided in accordance with the Judge Learned Hand and Justice Douglas dissents, placing countless recordings (not yet named "sound recordings" and "phonorecords") in the public domain, would the recording companies and their recording artists have been able to persuade Congress to abrogate the two decisions? The music publishing companies were able to do so, in a comparable situation, after the United States Court of Appeals for the Ninth Circuit in La Cienega Music Co. v. ZZ Top, 53 F.3d 950 (9th Cir.), cert. denied, 516 U.S. 927 (1995), held that the distribution of the pre-February 15, 1972 recordings without a copyright notice put the musical compositions embodied therein (without a prior copyright registration or publication of the sheet music with a copyright notice) into the public domain. Congress promptly enacted saving legislation to reverse La Cienega. Pub. L. No. 105-80, 111 Stat. 1534 (1997) (codified in 17 U.S.C. §303(b)) ("The distribution before January 1, 1978 of a phonorecord shall not for any purpose constitute a publication of the musical work embodied therein."). Presumably Congress would have done no less for the recording industry. I leave you with the question of whether such legislation could, constitutionally, retroactively change the ground rules, as distinguished from simply changing the law going forward.⁵⁷

As you can see, "What If" has presented an opportunity to visit lots of nooks and crannies of copyright. I have found it to be fun as well as informative. I hope you agree.

⁵⁶ Edward Jablonski, *Irving Berlin: American Troubadour* (1999) at pp. 337 and 345.

⁵⁷ See 1 Melville Nimmer & David Nimmer, *Nimmer on Copyright* §4.05[B][8] (2002).