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“Publication,” Musical Compositions, and the Copyright Act of 1909:

Almost a century ago, in *White-Smith v. Apollo*,² the Supreme Court faced the issue of how to treat player-piano rolls under the then-existing Copyright Act of 1897. Specifically, the court confronted whether player-piano rolls constituted unauthorized “copies” of the musical composi-

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By Michael B. Landau¹

tions embodied therein, thereby making the manufacturers of the rolls liable for copyright infringement.³

Interestingly enough, the issue of whether player-piano rolls—a mechanical reproduction of an underlying musical composition—were “copies” led to an age-old disagreement among the courts regarding another form of mechanical reproduction of musical compositions: “phonograph

The resolution of the issue of what constitutes a publication had profound implications for the music business. Since the Supreme Court refused to hear the case, prior to Congressional action in 1997, the copyright status of thousands of songs recorded before January 1, 1978 — the effective date of the 1976 Copyright Act — was in question. Because of the inter-circuit split, depending upon where an action was initiated, many of the pre-1978 songs were either in the public domain, and therefore free for all to use, or still protected by copyright. The split of authority also called into question the validity of thousands of license agreements and assignments of ownership related to musical works created before 1978. The issue was especially relevant because of the popularity of “reissues” and the ever-increasing nostalgia for the music of “days gone by.” In fact most of the “classic rock” of the 1960s and early 1970s fell into this category, not to mention most, if not all, “jazz standards.”

issue regarding musical compositions and distributed phonorecords . . . by amending §303 of the 1976 Act. That revision, however, was not the end of the controversy

Thus, the issue of “publication” of underlying works is once again hot.

tion, a similar and related issue — whether the “publication” of a motion picture also publishes the incorporated or underlying story and/or soundtrack — has come before the courts within the last two years. Thus, the issue of “publication” of underlying works is once again hot.

This Article will first examine whether the sale and distribution of phonograph records or other sound recordings constituted a “publication” of the underlying musical compositions for purposes of investiture¹³ or divestiture¹⁴ of federal copyright protection under the 1909 Copyright Act.

The analysis examines precedent, the statutory language and legislative history behind the 1909 and 1976 Acts, United States Copyright Office Practice and Procedure, music industry practice and commentary from the time, and relevant considerations of harmonizing international copyright law throughout the past century. After briefly discussing the new legislation, the Article then progresses to discuss the impact of post-amendment cases.

Obtaining Copyright Protection

In terms of statutory analysis, the requirement of publication of pre-1978 musical works is especially interesting because it involves interpretation of the 1909 Copyright Act, and not of the Copyright Act of 1976.¹⁰ Although provisions of the current 1976 Act¹¹ address many issues relating to works created before the Act took effect, several important issues relating to threshold requirements and standards of copyright protection of

Under the 1909 Act, federal copyright protection for an author’s work applied only after certain legal formalities were met. From the time that an original work was created until federal protection attached, the work was protected by common law copyright. Common law copy-

right protection was perpetual until publication or registration, granting the author the exclusive rights of first publication. Therefore, if an author wrote a manuscript and kept it in his desk drawer, or even stored it in his attic for years without publishing or registering it, it would have been protected by common law copyright.

Common law copyright was expressly abolished by §303(a) of the Copyright Act of 1976. Section 303(a) of the 1976 Copyright Act provides federal protection for “works created but not published” prior to January 1, 1978.¹⁵ In addition, §301 of the 1976 Act expressly preempts any state law equivalent cause of action. The abolition of common law copyright and whether the work was “published” or “unpublished” therefore determines not only the duration of protection, but also which provisions of the Copyright Act of 1976 apply to the work. The new copyright act did not apply to material that had already entered the public domain. Thus, the gateway to protection was the concept of “publication.”

There were two methods for obtaining federal copyright protection under the Copyright Act of 1909: “publication” of “copies” with proper copyright notice pursuant to §10¹⁶ or registering and depositing copies of an unpublished work with the United States Copyright Office pursuant to §12.¹⁷ Prior to federal protection, the work was covered by common law copyright. In the event that “copies” of the work were “published” without proper copyright notice as required by §10, the work would fall through the cracks of the law and into the public domain.¹⁸

The copyright clause of the United States Constitution empowers Congress “[t]o 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.”¹⁹ The purpose of copyright law is to strike a balance between the public’s desire to have free access to information and authors’ rights to protection of their private works.²⁰ Common law copyright somewhat reflects this balance by providing the author with perpetual protection until *first* publication. Federal copyright law, however, with its more limited duration for protection, better balances these competing interests.²¹ Once the author “publishes” a work, he or she reaps personal benefits from distributing copies.²² In return for these personal benefits, the author’s rights to the work are automatically subject to federal copyright protection. Federal protection balances an author’s rights against the public’s desire to freely use the work by providing copyright protection of a shorter duration

than the perpetual common law protection.²³ The trigger event that extinguishes common law protection and activates the federal “balancing” scheme is “publication.”

“Publication” is a legal term of art, and is at the center of many of the current controversies. Interestingly, the Copyright Act of 1909 did not itself provide a definition of “publication.” Although “publication” was not expressly defined²⁴ in §26 of the 1909 Act²⁵, guiding language appeared within the 1909 Act’s definition of “date of publication.” Section 26 of the Act provided as follows:

In the interpretation and construction of this title, “the date of publication” shall in the case of a work in which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition are placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority. . . .²⁶

The date of publication was especially important under the 1909 Act because:

it was intended to fix the date from which the term of copyright should begin to run for such a work. . . .The importance of the actual date of publication — the day, month, and year — arose because, in the case of every work copyrighted in the first five instance by publication with notice, the first term of 28 years began to run from that date; hence any error on the part of the applicant could have serious consequences, especially in connection with applications for renewals of copyright which had to be made “within one year prior to the expiration of the original term of copyright.”²⁷ (This problem was avoided in the 1976 Act by the calendar year ending of all terms, including renewals.)²⁸

Despite the language above, there have been numerous disputes regarding what actually constitutes a publication. Therefore, courts have developed the doctrines of “general publication” and “limited publication.” These two doctrines lead to very different protection as it is only a “general publication” that triggers the federal statutory scheme of protection with respect to pre-1978 works.

The type of publication considered to be a legal “publication” for purposes of triggering federal copyright protection under the 1909 Act was a “general publication.” A general publication could occur when the work was made available to indiscriminate members of the public, with-

out regard for what they intended to do with it.²⁹ Phrased another way, “[a] general publication occurs when any interested party could have a copy.”³⁰ The key issue with respect to “general publication” is the availability of the work to members of the general public, not the number of copies available. Therefore, a very small number of copies — even one — made available to the public may be sufficient to trigger the federal scheme of protection. “The common-law right is lost by the general publication or unrestricted sale of a single copy.”³¹

On the other hand, the distribution of “copies” of a work, even large numbers, to a “(1) ‘definitely selected group,’ and (2) for a limited purpose, without the right of further reproduction, distribution, or sale”³² is not a general publication, but is a limited publication which is insufficient to trigger the federal scheme of protection. Even if the dissemination of the work was categorized as a “limited publication,” common-law copyright protection was preserved until the author engaged in a “general publication” or registered a copy of the work with the Copyright Office.

Under the 1909 Act, there was a tendency in the courts to apply different standards for purposes of obtaining copyright than for losing it. Courts at times stretched the law to arrive at a finding of “limited publication” when an accused infringer was challenging the validity of the copyright. For example, in King v. Mister Maestro, Inc.,³³ numerous copies of the text of Martin Luther King, Jr.’s now famous “I Have A Dream” speech were distributed to the media to allow the press “to use the speeches in whole or in part for their news value.”³⁴ Despite the large numbers of advance copies distributed, the court still found the distribution to be a “limited publication” based upon the specific group of recipients and specific purpose of the distribution.³⁵ Likewise, in Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc.,³⁶ the distribution of “Oscar” statuettes without copyright notice to recipients of the Academy Awards was held to be a limited publication, insufficient to divest the academy of its copyright protection. Similarly, in Mills Music, Inc. v. Cromwell Music, Inc.,³⁷ the distribution of mimeographed copies of the sheet music to a chorus for purposes of performing the music was held to be a limited publication.³⁸

In addition, the acts of third parties that are contrary to the wishes of an author of a “limited publication” will not turn the subsequent distributions into a “general publication.” For example, in Burke v. National

Broadcasting Company,³⁹ an amateur photographer sent film footage of a zebra mare defending itself against a lion attack to a professor in Germany, Bernhard Grzimek, who was also the host of a German public television program about wildlife.⁴⁰ The film was sent to the professor specifically for “use personally in lectures and on a television program.”⁴¹ While Burke’s film was in possession of Professor Grzimek, Survival Anglia Limited (“SAL”), a British nature film company, asked him to make a copy of the film.⁴² SAL included the segments of the film in one of its productions and subsequently sold the film to NBC. NBC broadcast the film in the United States in 1977. Burke sued NBC for copyright infringement. In upholding the validity of Burke’s common law copyright, the court held that the release of the film to Professor Grzimek was solely for his specific educational purpose and was therefore a “limited publication” despite the widespread publication of it by NBC.⁴³ NBC’s unauthorized broadcast did not commit the footage to the public domain.

Under current copyright provisions, publication no longer serves as the gateway from common law protection to statutory protection.⁴⁴ Federal statutory protection now “subsists” when a work is “fixed in any tangible medium of expression.”⁴⁵ The 1976 Act’s definition of “publication” includes “the distribution of copies or phonorecords of a work to the public by sale” or the “offering to distribute copies or phonorecords.”⁴⁶ Thus, the distribution of phonorecords is expressly a form of publication under the current copyright statute. This distinction is further evidenced by the language of §102, which delineates the subject matter covered by the 1976 Act.⁴⁷ Publication retained its importance under the 1976 Act, however, with reference to works published with proper notice prior to the effective date of the 1976 Act (January 1, 1978).⁴⁸ Also, as previously stated, the 1976 Act does not apply retroactively to works in the public domain at the time the 1976 Act took effect.⁴⁹

The 1976 Act’s legislative history demonstrates that language requiring a work to be fixed in a “tangible medium of expression,” in a medium now “known or later developed,” and capable of being “communicated, either directly or with the aid of a machine or device,”⁵⁰ was intended to abrogate the White-Smith doctrine, but *only* for works created after January 1, 1978.⁵¹ Presumably, Congress chose not to “fix” the problem created when a musical work, which had no copyright on its sheet music, was sold in phonorecord form without meeting notice

specifications. The legislative history of the 1976 Act's statutory preemption provision indicates that Congress' purpose was to clear up the confusing unpredictable results⁵² created by the concept of publication under the 1909 Act. Congress intended to implement the "limited times" provision of the Constitution by not allowing perpetual protection for fixed works that had been "disseminated by means other than publication."⁵³ Hence, the sale of phonorecords under the 1976 Act clearly constitutes publication, but the issue was left unresolved for works prior to January 1, 1978.

A Performance is Not a Publication

According to one commentator, "Copyright law, precisely because it has taken shape around the model of a book communicated to the public by multiplication of copies, has experienced difficulty, not to say frustration, with cases where the communication is by performance or representation."⁵⁴ There was, therefore, the question of whether or not a live performance of an unpublished written play or noted musical composition or a broadcast constituted a "publication" for purposes of the statute. This question, too, is not answered by the text of the 1909 Act itself. It has, however, been addressed numerous times by the courts.

The first time that the issue of whether a performance constituted a "publication" for purposes of triggering federal copyright and extinguishing common law copyright was addressed was in Ferris v. Frohman.⁵⁵ The facts of Ferris are quite complicated and involve issues of English copyright law as well. The pivotal issue, however, was whether the public performance of a play whose script had been neither printed nor published constituted a legal "publication" and therefore extinguished common law rights. The Supreme Court answered with a resounding "no":

The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right, save by operation of statute. At common law, the public performance of a play is not an abandonment of it to public use. . . . So, where a dramatic performance has been allowed by the author to be acted at the theater, no person has a right to pirate such performance, and to publish copies of it surreptitiously; or to act it at another theater without the consent of the

author or proprietor; for his permission to act it at a public theater does not amount to an abandonment of title to it, or to a dedication of it to the public at large.

Accordingly, the "Ferris rule" holds that a "performance" is not a "publication."⁵⁶ The rule has been applied, by analogy, to performances in various forms other than plays.⁵⁷ In McCarthy v. White⁵⁸ and in Heim v. Universal Pictures Co.,⁵⁹ for example, it was applied to the public performance of musical compositions. In DeMille v. Casey,⁶⁰ it was applied to the exhibition or projection of a motion picture. In Nutt v. National Institute, Inc.,⁶¹ it was applied to the delivery of lectures and speeches. In Uproar Co. v. National Broadcasting Co.,⁶² the Ferris Rule was applied to radio broadcasts. In King v. Mister Maestro, Inc.,⁶³ the rule also applied to television broadcasts.⁶⁴ Thus, "the principle that public performance does not constitute a publication of the work is well established in the American Law of Copyright."⁶⁵

Application of the Ferris rule, however, can lead to some strange and counterintuitive results. For example, assume that in 1910 one wrote a play, only distributed copies of the script to the essential actors and director, and never offered copies of the script to the public. As discussed above, this would not constitute "general publication" but rather a limited publication of the written script for the play, which preserves common law copyright. Assume the play is then first performed in the same year, and every year since. Under the Ferris rule, performances of the play were not "publications," and therefore did not lose common law protection. If the script itself were never published, it would have been protected by common law copyright until the 1976 Act took effect on January 1, 1978. On that date, pursuant to §303(a) of the new 1976 Act, federal protection would have started, and the play would be protected at least until December 31, 2002, and if published after 1978, at least until December 2047.⁶⁶ This scheme gives the playwright protection for a term of at least 137 years. Had the play been "published" in the year that it was first written and performed, however, the maximum protection would have been for 56 years. The same analysis would, of course, be true with respect to a musical composition. Provided that the sheet music was never published, the composer could have his song protected for quite a long time.⁶⁷

The issue gets a bit trickier with respect to sound recordings. Clearly, the performance of the song is not a

publication. But is the recording of a “copy” and its widespread distribution a publication? Or is a recording more like a performance, albeit captured in time and in tangible form? The term “copy” is not defined in the statute, and, as discussed below, is the source of the inter-circuit split of authority. The issue of whether a pre-1978 “mechanical reproduction” of a musical composition is a “copy” was first addressed in the context of player piano rolls in White-Smith Publishing Co. v. Apollo Co.⁶⁸

White-Smith Publishing Co. v. Apollo Co.⁶⁹

In 1908, the Supreme Court addressed the issue of whether a “mechanical reproduction” of a musical composition was a “copy” of the underlying musical composition in White-Smith Publishing Co. v. Apollo Co. In this case, the plaintiff held the copyrights to two musical compositions, “Little Cotton Dolly” and “Kentucky Babe.”⁷⁰ The defendant, Apollo, was engaged in the manufacture and sale of perforated player-piano rolls and had created and sold piano rolls of the two songs at issue.⁷¹ The plaintiff alleged that these were unauthorized “copies” of the underlying musical composition, and that they therefore infringed the copyrights to the underlying protected songs.⁷²

In determining whether the piano rolls were infringing “copies,” the Court looked to earlier cases from the district courts,⁷³ English common law⁷⁴ and the Berne Convention for guidance.⁷⁵ The Supreme Court held that the perforated piano rolls were not “copies” under copyright law because they were not visibly intelligible reproductions of the musical notation:

“A copy is that which comes so near to the original as to give every person seeing it the idea created by the original. . . .” [A] copy of a musical composition [is] “a written or printed record of it in intelligible notation” When the combination of musical sounds is reproduced to the ear it is the original tune as conceived by the author which is heard. These musical tones are not a copy which appeals to the eye. In no sense can musical sounds which reach us through the sense of hearing be said to be copies as that term is generally understood, and as we believe it was intended to be understood in the statutes under consideration.⁷⁶

The Court continued: “A musical composition is an intellectual creation which first exists in the mind of the composer. . . . It is not susceptible of being copied until it

has been put in a form which others can see and read.”⁷⁷

In addition, the Court observed that mechanical means for the reproduction of music—such as the “cylinder of a music box,” “record of the gramophone,” and the “pipe organ operated by devices similar to those in use in the pianola”⁷⁸—had been widely known when the relevant copyrights acts and amendments were passed. Congress could have included them or provided that their use constituted infringement but did not. “As the Act of Congress now stands,” concluded the Court, “we believe it does not include these records”⁷⁹ as copies or publications of the copyrighted music involved in these cases.⁸⁰ Based upon the finding that the rolls were not legal “copies” or “publications” of the underlying musical compositions, the Court held that there was no infringement.

Justice Holmes concurred “in view of the facts and opinions in this country and abroad,”⁸¹ but added the admonition, “On principle anything that mechanically reproduces that collocation of sounds ought to be held a copy, or if the statute is too narrow ought to be made so by a further act, except so far as some extraneous consideration of policy may oppose.”⁸²

Under the holding of White-Smith, it is clear that a “mechanical reproduction” — whether a piano roll, a music box cylinder, or a phonograph record — is not a “copy” of the underlying musical composition. By extension, it follows that the sale or distribution of the mechanical reproduction cannot be a “publication,” for “publication” entails the distribution of “copies.”⁸³

The Legislative History of the 1909 Act

White-Smith was decided prior to the enactment of the Copyright Act of 1909. The question then arises as to whether Congress changed the law in response to the Supreme Court’s holding that “mechanical reproductions” were not copies under prior copyright law. In order to answer that question, one must look to both the language and the legislative history of the 1909 Act.

The issue of mechanical reproductions of music took “more of the time of the committee than any other provision of the bill” that was eventually enacted.⁸⁴ The spotlight of the debate actually centered on whether composers should have control over, and receive compensation for, the newly evolving mechanical reproductions of their musical compositions.⁸⁵ Several issues came into play as the statute evolved. The first was whether such protection would create a monopoly for companies able to

purchase the rights to a majority of compositions.⁸⁶ The second was whether such protection would invade the machine manufacturers' patent rights.⁸⁷ The third was whether the United States should take action that other countries had refrained from taking.⁸⁸ At this point, it should be clear that much of this debate centered on the outcome of the White-Smith case.⁸⁹ In fact, the Committee on Patents at one point proposed that "further legislation regarding this matter should be postponed" until the case was resolved.⁹⁰ Although Congress did not extend protection to the "mechanical reproductions themselves,"⁹¹ the issues delineated above are worthy of some discussion.

As to the possibility of a monopoly, lawmakers voiced concerns that the proposed protection for composers was designed for the Aeolian Company so that it could obtain a monopoly in the music roll business.⁹² The Music Publishers' Association had made contracts with the Aeolian Company to establish these rights and contended that the contracts depended upon the outcome of the then-pending White-Smith case, and not on proposed legislation.⁹³ Regardless of its source, those opposed were concerned that no law should effectively cede control over the music roll and the piano business (that obviously depended on these rolls) to one company.⁹⁴ Proponents of the change argued that the rights of private contract and the protection of composers' works would be incentives to create such material for the machine manufacturers to utilize.⁹⁵ The proponents also asserted that antitrust laws would provide protection against any actual monopoly.⁹⁶ In order to resolve this issue, Congress set out to provide protection for the composer without creating a monopoly.⁹⁷

In the end, the concern that protection of musical reproductions would invade the patent protection of the player machines was ruled out.⁹⁸ Although patent law provided protection to the inventors for their machines or for "the device for reproducing musical sounds,"⁹⁹ patent

protection does not further extend to musical works, which are the sole creation of the composer.¹⁰⁰

The lawmakers also examined how the European countries were treating this new form of music.¹⁰¹ The legislative history indicates that Italy was the only country at the time to extend protection to such mechanical reproductions.¹⁰² It was further noted that Germany, England, Switzerland and France had all refrained from offering such protection.¹⁰³ Proponents advocated that the United States should be the leader "in the promotion of the arts,"¹⁰⁴ while opponents countered that the United States "should not lead precipitously in enacting such a broad statute" when other countries had rejected such protection.¹⁰⁵

Interestingly, the legislative history further reveals that European countries were likely influenced by Switzerland's economic interest in the music box, which was an important Swiss industry.¹⁰⁶ This influence was also reflected in the Berne Convention's provisions that excluded mechanical reproductions of musical compositions from claims of infringement.¹⁰⁷ Proponents of new protection in the United States distinguished the main feature of a music box, which was an unchangeable mechanism playing only one melodic set of music, from the newer devices

that could play a multitude of compositions.¹⁰⁸ The legislative history further noted, with great foresight, that this form of music might replace sheet music.¹⁰⁹ Further, the proponents asserted that the composers would be "encouraged in their efforts" through such control over their musical compositions, and that this autonomy would promote the arts.¹¹⁰ Proponents argued that allowing others to exploit the author's work with no accountability would neither encourage the authors nor promote the arts.¹¹¹ They called for legislative action rather than awaiting the outcome of the White-Smith case, believing that its holding would ultimately be limited to its "precise issue."¹¹²

These particular issues were finally resolved in House

The issue of mechanical reproductions of music took "more of the time of the committee than any other provision of the bill" that was eventually enacted.

(the 1909 Act)

Report 2222,¹¹³ in which Congress sought to provide “an adequate return” to the composers while at the same time avoiding monopolies that would harm the public.¹¹⁴ Section 1(e) of the 1909 Act, the final embodiment of these concerns, provided the authors exclusive protection over their compositions until the owners used or allowed mechanical reproductions to be made of their works, at which time anyone could use the work upon the payment of a royalty.¹¹⁵

However, this provision did not resolve whether the distribution of mechanical devices constituted publication. By the time of the 1909 Act’s enactment, the White-Smith case had been decided, but the 1909 Act did not change its result when it gave the composer control over the “manufacture and use of such devices”¹¹⁶ as opposed to the “mechanical reproductions themselves.”¹¹⁷ The 1909 Act provided protection to the composer without “equating mechanical reproduction with ‘copy.’”¹¹⁸

The Sound Recording Act of 1971

The Sound Recording Act extended protection to the sound recordings *themselves* as opposed to the “tangible medium of fixation” or “reproductions of sound recordings.”¹¹⁹ This protection was intended for the “aggregation of sounds” created by the record producers or the performers “whose performance is captured.”¹²⁰ The statute’s legislative history indicates that its purpose was to stop the “unauthorized reproduction of phonograph records and tapes” by “record pirates;” the legislation was only to be effective until December 31, 1974, at which time the next copyright revision could possibly provide permanent protection.¹²¹ This protection was included as copyrightable subject matter in the 1976 Copyright Act as §102.¹²²

For the purposes of this Article, it is important to realize that the 1976 Act’s legislative history reveals *no* intent to address the issue of whether the sale of phonorecords constitutes publication of their underlying musical compositions.¹²³

Sound Recording “Publication” Cases After White-Smith

The issue concerning whether the sale of phonorecords constituted publication under the 1909 Act first arose as dicta in Shapiro, Bernstein & Co. v. Miracle Records Co.,¹²⁴ a 1950 opinion written by Judge Igoe.¹²⁵

After ruling that no infringement had occurred on other grounds, Judge Igoe noted that the plaintiff “abandoned his rights” by selling phonorecords of the respective composition prior to obtaining a statutory copyright.¹²⁶ The court made no distinction between the sale of sheet music and the distribution of phonorecords and further stated that publication should not turn on a “technical definition” of the word “copy.”¹²⁷ In this case, the court ignored the “perpetual” monopoly that would result by failing to recognize this distribution to the “general public” as a publication of the musical composition.¹²⁸ Thus, a sale of a phonorecord was seen as a publication.

This new conception was raised again as dicta in 1954 in Mills Music, Inc. v. Cromwell Music, Inc.¹²⁹ Here, although there was no respective sale of phonograph records failing to meet notice requirements, the judge noted that such a sale “would” have constituted publication.¹³⁰ The judge went even further, however, by stating that “the weight of legal authority seems to support that view.”¹³¹

Interestingly, the issue arose again in McIntyre v. Double-A-Music Corp.,¹³² wherein a court also found no infringement when the defendant had “issued a revised edition of the sheet music” of a song that the plaintiff had sold in the form of phonorecords.¹³³ In that case, the plaintiff had authorization to “record mechanically the composition from the copyright owner” of the original arrangement, but the plaintiff failed to copyright his own arrangement.¹³⁴ The court stated that the subsequent sale of records constituted a general publication that “destroyed whatever rights he had in the arrangement under the common law of copyrights.”¹³⁵ However, the court held the plaintiff’s version of the original composition was not worthy of any protection at all because the plaintiff’s contributions were only “de minimis.”

Professor Alan Latman has described this “judicial thought in the 1950s” as the genesis of the idea that “the sale of phonorecords should be considered divestitive publication.”¹³⁶ The traditional viewpoint was raised again in 1964, when a court held that copyright formalities do not apply to the sale of phonorecords that are not copies of a musical composition, and that such a sale does not constitute a publication.¹³⁷

The Inter-Circuit Split: Rosette v. Rainbo Mfg. Corp.

In Rosette v. Rainbo Mfg. Corp.,¹³⁸ a composer (the

established principles in this “technical field.”¹⁴² The court further referenced reluctance “to cast into the public domain thousands of works” that had “been distributed on phonograph records without statutory copyright in reliance upon the rule of law that a distribution of phonograph records is not a publication.”¹⁴³

The court especially relied on the holding in White-Smith that mechanical reproductions are not “copies,” noting that although the 1909 Act was a “comprehensive revision of the Copyright Law,”¹⁴⁴ it did not extend copyright protection to these reproductions.¹⁴⁵ While expressing a distaste for allowing authors to maintain a “petual monopoly” on such works, the court further reasoned that the Universal Copyright Convention limited

its definition of publication to the distribution of copies that could be “read” or “visually perceived.”¹⁴⁶ Although the court mentioned that this definition was derived less by theory and more by the motive to secure the United States’ approval of the Convention, the court upheld this rationale.¹⁴⁷ Additionally, the court cited a Copyright Office Regulation¹⁴⁸ for the proposition that phonorecords are not deemed to be copies of musical compositions for registration purposes.¹⁴⁹

The Rosette court criticized prior case law such as Mills Music, Shapiro, Bernstein & Co., and McIntyre for failing to make any reference to the White-Smith doctrine or to the 1909 Act’s treatment of it.¹⁵⁰ The court noted that it would have been “simple” for Congress “to

The Sound Recording Act extended protection

to the sound recordings themselves as opposed to the “tangible medium of fixation” or “reproductions of sound recordings.”

Thus, the court placed a limit on common law protection, but held that “the sale of phonograph records is not a divestment of common law rights.”¹⁵⁵ In 1976, the Second Circuit Court of Appeals affirmed this ruling, although it recognized in a footnote that the 1976 Copyright Act expressly included the distribution of phonorecords in its definition of publication.¹⁵⁶

In a subsequent district court case, Jones v. Virgin Records, Ltd.,¹⁵⁷ the plaintiffs alleged that the popular rock star, Boy George, had infringed upon their 1960 song, “Handyman.”¹⁵⁸ The defendants raised the defense that the 1960 version of the song was in the public domain because the song had been sold in record form without copyright protection.¹⁵⁹ The court, noting that Congress had left the concept of publication under the 1909 Act to judicial interpretation and acknowledging that such judicial results had not been uniform, was compelled to follow Rosette, and held that the recording and selling of a phonorecord does *not* constitute publication of the underlying musical work.¹⁶⁰

La Cienega Music Co. v. ZZ Top

In January 1995, the Ninth Circuit Court of Appeals decided the case of La Cienega Music Co. v. ZZ Top.¹⁶¹ holding that the sale of records *constitutes* publication.¹⁶²

This holding is contrary to the Second Circuit's Rosette opinion.¹⁶³ La Cienega involved an infringement action against the blues-rock group, ZZ Top, concerning their popular song, "La Grange," which was written in 1973.¹⁶⁴ La Cienega claimed that "La Grange" infringed a 1948 song written by Johnny Lee Hooker and Bernard Besman entitled "Boogie Chillen."¹⁶⁵ Almost one million records of "Boogie Chillen" were sold in 1948, and it was subsequently released in both 1950 and 1970.¹⁶⁶ The issue rested on whether or not "Boogie Chillen" was in the public domain under the 1909 Act at the time that ZZ Top wrote "La Grange."¹⁶⁷ The court was primarily concerned with the 1970 version of the song because the earlier versions would have fallen into the public domain through a failure to renew, if not through a publication without notice.¹⁶⁸

La Cienega argued that the song was protected by common law until it published the song by filing notice with the Copyright Office in 1967, 1970, and 1992; the court, however, held that publication actually *occurred* when phonorecords of the song were *sold* in the respective years.¹⁶⁹ The court remanded the case for a determination if La Cienega complied with notice requirements regarding the 1970 version of the song.¹⁷⁰ Absent such compliance, the song was in the public domain and ZZ Top did not infringe.¹⁷¹ The court adopted a less restrictive definition of the term "copy" and endorsed the policy that by selling phonorecords, an author exploits his work and *must* seek statutory protection.¹⁷² The court further warned against a protectionist policy that would "encourage artists to delay compliance with the Copyright Act's requirements and thereby receive 'longer copyright protection.'" ¹⁷³ The court specifically declined to follow Rosette's holding, which it deemed the minority rule:¹⁷⁴

We decline to follow Rosette. First, Rosette is the minority rule; our research fails to find any other circuit which has followed it. The majority rule, as noted by the district court, has been articulated by Nimmer. The courts in applying the 1909 Act were in most instances unpersuaded by the argument that no publication occurs by virtue of the sale of a phonorecord because the record is not a "copy" of the work recorded. On the contrary, the relatively few courts which considered the issue were almost unanimous¹⁷⁵ in determining that public sale or other distribution of phonorecords does constitute a publication and, hence, a divestiture

of common law rights in the works recorded. This conclusion is certainly consistent with the common understanding of the word "copy."¹⁷⁶

Had the Ninth Circuit been thorough in its research, it would have found an earlier Ninth Circuit case, Corcoran v. Montgomery Ward & Co.,¹⁷⁷ which follows White-Smith and holds that a phonograph recording is not a copy. In addition, even overlooking Corcoran, the court's statement is disingenuous. There are no circuit court cases following Rosette, not because it is a minority opinion, but because no other appellate courts had the opportunity to address the issue. In addition, the district court precedent to which La Cienega refers consists of opinions from lower courts *within* the Second Circuit. Those opinions, therefore, would have been overruled when the Second Circuit decided Rosette.

Judge Fernandez, concurring and dissenting, agreed that the case should be remanded to determine whether statutory protection was obtained for the 1970 version of Boogie Chillen.¹⁷⁸ In opposition to the majority, however, he believed that the White-Smith doctrine was based on sound reasoning and could identify no way to "convert a recorded performance into a publication of the underlying work."¹⁷⁹ Judge Fernandez acknowledged that such a rule appears to give the "common law copyright holder . . . greater rights than a person who has actually registered his copyright under the 1909 Act."¹⁸⁰ Yet he reasoned that because an author cannot receive royalties or "recover for another's use of the work" until the work is registered, "the author who does not register in a timely fashion cannot artfully extend the time during which he can exploit the work."¹⁸¹

The Effect of the Ninth Circuit's La Cienega Decision

The Supreme Court denied *certiorari* for La Cienega, leaving the courts split on what constitutes a publication of a musical work.¹⁸² In a news article published pending the *certiorari* decision, Besman's attorney, Alan Dowling, warned that "[t]he decision under appeal impacts the copyright in virtually every recorded song released before 1978 by threatening to make those songs public domain works."¹⁸³ Dowling further warned that the Ninth Circuit's holding could potentially "stir the waters" in music licensing organizations such as Broadcast Music Inc. (BMI) and American Society of Composers, Authors and Publishers (ASCAP) due to the

uncertainty about ownership of songs created prior to 1978.¹⁸⁴ Presumably, the Supreme Court did not share Mr. Dowling's concerns.

Prior to the 1997 Congressional amendment of the Act to overrule La Cienega, there was clear disagreement regarding "publication" and "copies" with respect to musical compositions and sound recordings under the 1909 Act. Thousands of works that were thought to be protected by copyright may now be in the public domain—at least if the validity of their copyrights is challenged in the Ninth Circuit, and probably the Sixth. As was noted in the Petition for *Certiorari*:

In its decision, the majority of the Ninth Circuit panel has called into question the copyright in, and therefore clouded the title of, the vast majority of musical compositions created over a period of as much as five decades, up to 1978 — literally hundreds of thousands of songs. Many of these are owned or administered by music publishers who (or which) are successors, several generations removed from the original publishers / copyright owners / authors, due to assignments, sales, and inheritance of rights over several decades. In the event of any dispute calling into question any of their copyrights, they would have to determine the entire history of each disputed song, including date and circumstances of composition, recording, first distribution of recordings, each and all subsequent exploitations, existence (or absence) of notice of copyright on any and all recordings (and accuracy of such notice), date of registration, identity of registrant, filing of notice of use, and the like, much of which may be extremely difficult and expensive, or even impossible, to ascertain (or ascertain accurately) at this late date.

Undeniably, numerous contracts, involving literally billions of dollars have been entered into over the years, based upon the presumption (and generally the express contractual warranty and representation) that the original, and all subsequent, music publishers had valid copyright in the compositions, where they acted consistently with music industry custom and practice over the years. Not only have many millions of dollars been spent buying and selling entire catalogues, but numerous

millions have been paid as royalties based upon the presumed validity of those catalogues and the contractual terms relating thereto. Literally every such contract relating to each such composition may be deemed rescindable due to mutual mistake of fact and material failure of consideration, and the rights in hundreds of thousands of songs would be forfeited to the public domain (with no way to tell, readily, on the face of it, which songs).¹⁸⁵

As previously discussed, a work may fall into the public domain in two ways: through general publication without proper copyright notice,¹⁸⁶ and through expiration of the copyright term.¹⁸⁷ Related to expiration of the term of copyright is the failure to file a renewal application in a timely manner. In essence, failure to renew causes the work to fall into the public domain at the expiration of the first 28-year term.¹⁸⁸

Under the La Cienega theory of "copy" and "publication," many pre-1978 underlying musical compositions would have fallen into the public domain in one of two ways. Because the Ninth Circuit held that phonograph records (sound recordings) are "copies," the sale of the records constituted "publication" for federal copyright purposes. If the recordings were sold without copyright notice, the underlying musical compositions would have fallen into the public domain upon their release to the public. However, even if the records were sold with copyright notice — which was highly unlikely because United States copyright law did not recognize sound recordings as copyrightable subject matter until 1972¹⁸⁹ — they would have fallen into the public domain for failure to renew in a timely manner.

In order to secure the renewal term, the renewal application must be filed in the last year of the first term of the copyright. The problem created by La Cienega was one of timing and the trigger date. Based upon the prior precedent and the policies of the Copyright Office, which considered the sound recording not to be a copy, the only ways to obtain federal copyright protection for the musical composition was either through the sale of sheet music (readable musical notation) with notice or the registration of the sheet music with the Copyright Office along with a claim of copyright. The common practice for many in the music industry, including the plaintiffs in La Cienega, was to release the phonograph record first, and then register the work with the Copyright Office years later. Shortly after registration, the applicant would

tied to the date of registration would be late. By not counting the date of sale as the “trigger date,” many copyright holders would have forfeited their copyrights to the public domain. Because large numbers of copyright holders released the records prior to registration, the copyright status of countless numbers of musical compositions was in jeopardy, at least in the Ninth Circuit, and in any other jurisdiction that decided to follow the Ninth Circuit, as did the Middle District of Tennessee in Mayhew v. Gusto Records.¹⁹⁰

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Ninth Circuit

publisher viewed the recording itself as a legal “copy,” the Copyright Office did not. Therefore, if a party attempting to register a work sent a recording of the musical composition to the Copyright Office along with the registration documents, the Copyright Office would have returned it and requested that a copy of the musical notation be sent instead. Therefore, even if one had the clairvoyance to anticipate the Ninth Circuit’s holding, one could not have complied with its definition of publication due to then existing Copyright Office regulations.

reproduction in tangible form and the general distribution to the public of copies of a work from which it can be read or otherwise visually perceived.”¹⁹² Interestingly, this definition was based upon an understanding by the delegates that the issuance of phonograph records does not amount to publication under United States law. “It was believed that a contrary provision in the Convention would require an amendment of the United States Copyright Law unlikely to be accepted by Congress.”¹⁹³ In fact, three of the four American delegates to the Conference in 1952 who participated in the drafting of the Convention are said to have stated the view that the sale of records is not a publication of the underlying musical work.¹⁹⁴ At the time that the 1909 Act was being drafted, Germany, England, Switzerland, and France did not extend copyright protection to mechanical reproductions of music.¹⁹⁵ The Berne Convention of 1886 provides in pertinent part: “It is understood that the manufacture and sale of instruments serving to reproduce mechanically the airs of music borrowed from the private domain are not considered as constituting musical infringement.” It, therefore, was the prevalent world view at the time that “mechanical reproductions” of music were non-entities as far as either protection or infringement was concerned.¹⁹⁶

“Under common music industry practices, the release of a phonorecord was not a publication of the musical work.”¹⁹⁷ In 1955, after the 1909 Act had been in force for over 40 years, Benjamin Kaplan (then a professor at Harvard Law School) noted that “lawyers of exceptional ability” as well as the “practical conduct of business” did not treat the release of records as publications:

Records have frequently been issued at the outset in order to test the public reaction, and sheet music may not be published at all if the record fails to catch on. . . . [S]tatutory copyright need not be resorted to unless sheet music is issued.¹⁹⁸

According to Nimmer, other commentators agreed with Kaplan. “Many eminent members of the Copyright Bar as well as the music industry generally long maintained that public distribution of phonograph records (or phonorecords) did not constitute a publication of the works embodied therein.”¹⁹⁹ Nimmer continues:

Copyright owners under the 1909 Act . . . frequently failed to obtain statutory copyright of musical compositions before selling records of the compositions. This was often a deliberate omission on advice of counsel who concluded . . . that sale of a phonorecord would not constitute a surrender of common law rights in the work.²⁰⁰

Prior to 1978, parties in the music business who were operating under assumptions or advice of counsel regarding the 1909 Act, usually did not register the musical compositions until *after* the recordings were sold. Indeed, ASCAP, BMI, the National Academy of Songwriters, and the Songwriters Guild of America all took the position in their *amici* briefs to La Cienega that:

[T]he Ninth Circuit’s holding is completely opposite to this industry’s understanding and the law upon which it was based; consequently this decision threatens to take away copyright protection from all who relied upon the well grounded industry practices.²⁰¹

If there were any questions regarding the law at the time, competent counsel would have advised their clients to register the musical compositions as “unpublished works” prior to the release of the sound recordings in order to avoid the extreme penalty of total copyright forfeiture in the future.

The United States Copyright Office has always taken the position that the sale of a phonograph record prior to January 1, 1978 did not constitute a publication for purposes of obtaining a copyright. U.S. Copyright Office Circular No. 50, “Sound Recordings” states this clearly:

Prior to 1978, musical compositions were considered published when copies (not phonorecords) were sold, placed on sale, or publicly distributed under the authority of the copyright owner. Works first published before 1978 can be registered only if the published copies bore a copyright notice in the prescribed form and location. . . .

Phonorecords were not considered “copies” of musical compositions under the law in effect through December 31, 1977. The sale or public distribution of phonorecords, therefore, did not publish the musical composition that was embodied in them.²⁰²

In addition, the standard form “Certificate of Registration of a Claim of Copyright” issued by the United States Copyright Office stated on the second page of each certificate:

Sound Recordings. Phonograph Records, tape recordings and other *sound recordings are not regarded as “copies” of the musical compositions recorded on them*, and are not acceptable for copyright registration.²⁰³ [emphasis added]

Furthermore, the federal regulations regarding registration and deposit of samples under the 1909 Act²⁰⁴ also clearly state that registration of musical compositions must be made “in the form of visible notation.”²⁰⁵ Other regulations confirmed that recordings were not proper “copies” for registration and deposit purposes:

(b) A Phonorecord such as a disk, tape, or other reproduction of a sound recording is not considered a “copy” of the musical composition or literary or dramatic work recorded on it and is *not acceptable as a deposit copy* for the musical composition or literary or dramatic work.²⁰⁶ [emphasis added]

Therefore, under Copyright Office Regulations in effect during the 1909 Act, if one submitted a form for copyright registration and included a recording of the song instead of a “form of visible notation,”²⁰⁷ the application would be rejected and an actual sample of the

musical notation would be required. In short, there was no possible way in which one could have complied with what was to become the Ninth Circuit's view of the law in La Cienega.

Even after the Ninth Circuit's La Cienega decision, the Copyright Office has steadfastly maintained that pre-1978 sound recordings are not "copies" of the underlying musical compositions and sales of sound recordings of the musical compositions are not "publications" of the underlying songs. In a November 17, 1995 letter to Rep. Howard Coble of the House Judiciary Committee's Subcommittee on Courts and Intellectual Property, Register Mary Beth Peters reiterated this position:

For many years, the Copyright Office has espoused the view that recordings sold before January 1, 1978, i.e., those that were released under the 1909 Act, were not copies of the musical compositions embodied on them, and therefore the distribution of recordings did not constitute publication under the federal copyright statute. Moreover, if by chance a recording bore an appropriate notice for the musical composition embodied on it and registration of the music was sought on this basis, registration was refused. The Office would state that copies had to be visually perceptible, e.g., sheet music copies, and unless such copies had been sold, placed on sale, or offered to the public, registration for the music as a published work was not possible. The Office would suggest registration for the work as an unpublished work²⁰⁸ and ask for the deposit of a lead sheet. In 1972 when sound recordings were added to the statute,²⁰⁹ the law made it clear that phonorecords constituted copies of only the sound recording—they *were not copies of the musical compositions embodied on them*.²¹⁰

In any case, the Office refused registration of these works as published works. Many of these works were instead registered as unpublished works; as mentioned above this is what the Copyright Office suggested. Renewal registrations based on these unpublished registrations may have been made. Later published sheet music editions may have been made, and renewals and renewals based on these registration(sic) may also have been made. Despite all of this, copyright for these

works could now be considered to be lost by publication of recordings at any time before January 1, 1978.

It seems incongruous that at the time when Congress is considering lengthening the copyright term for musical compositions²¹¹ that we are faced with the possibility that many of these works will be found in the public domain under the logic of the Ninth Circuit.

If the Copyright Office did not consider a phonograph record to be a "copy" for purposes of registration under §12 of the 1909 Act,²¹² or the sale of sound recordings with proper notice to be "publications" for the purposes of obtaining copyright protection under §10 of the 1909 Act,²¹³ how can a court find that sale of records without proper notice divests one of protection, or that the renewal date is to be tied to the date of the sale of the record, and not to the date of the registration of the unpublished work? The Ninth Circuit's opinion in La Cienega, while it might make sense in today's commercial marketplace, does not make sense based upon the rules under which composers and publishers had to play at the time that the musical compositions were written and at the time that the sound recordings—usually as phonorecords—were released to the public. The effective result of La Cienega is a retroactive "changing of the rules."

Legislation to Rectify the La Cienega Problem

On June 19, 1997, Rep. Howard Coble, introduced a bill amending the Copyright Act to overrule La Cienega and to affirm the long-standing position of the United States Copyright Office that the pre-1978 distribution of phonorecords did not constitute a publication of the underlying musical composition. Similar legislation, introduced in 1996, died in Congress.²¹⁴

Under the Coble Bill, the current language at §303 of Title 17 entitled "Duration of copyright: Works created but not published or copyrighted before January 1, 1978," has changed. A new §303(b) reads as follows:

The distribution before January 1, 1978, of a phonograph shall *not for any purpose* constitute a publication of the musical work embodied therein [emphasis added].²¹⁵

On October 7, 1997, the bill was approved by the House Judiciary Committee, and was placed on the "fast track." On November 13, 1997, President Clinton signed Pub. L. 105-80 into law, officially amending the

Post Section 303(b) Amendment Cases

After Congress amended the Act by adding §303(b),²¹⁷ there were questions regarding the *retroactive* applicability of the statute. Because the change affected parties who created works prior to 1978, the argument was raised that changing the rules that were in effect was constitutionally impermissible.²¹⁸ This uncertainty was addressed in Mayhew v. Allsop,²¹⁹ a recent Sixth Circuit case.

In Mayhew, the plaintiff asserted that the defendant had infringed the copyrights in the song, "A Big Ball in Cow Town," written in the 1940s by Hoyle Nix. The defendant countered that the song was in the public domain, by virtue of the publication of the sound recording that embodied the composition. In September of 1997, shortly before the new statute was enacted, the district court, in an unpublished opinion, agreed with the defendant, and granted summary judgment.

In 1999, on appeal, the Sixth Circuit reversed and held in favor of the plaintiff by applying §303(b). Addressing the issue of retroactive application, the court found no constitutional problem in applying the new statute to pending cases:

When Congress has unambiguously specified the temporal reach of a new statute, there is no conflict between the presumption against statutory retroactivity and the rule that a court should apply the law in effect at the time of its decision. It is clear from the language employed that §303(b) should be applied to pending cases. First, the subsection obviously applies to pre-enactment conduct. In fact, it only applies to the distribution of records prior to January 1, 1978. Thus applying the statute to pending cases has no impact on the conduct

that is the subject of the subsection. Second, the subsection provides that the distribution of phonorecords "shall not for any purpose constitute a publication." This court would be defying the express mandate of the statute if we were to decide on *de novo* review that the phonorecord constituted publication. Finally, the presumption against retroactive application of statutes is based, in part, on a hesitancy to reverse settled expectations. In enacting §303(b), however, Congress has resolved a problem of unsettled expectations that had arisen from the circuit split. We conclude that §303(b) should be applied in resolving the present appeal.²²⁰

Having resolved the applicability issue, the court held that the underlying musical compositions were still protected by copyright contrary to La Cienega.

As a result of the passage of §303(b) and the interpretation in Mayhew, the issue of whether the publication of a sound recording prior to the enactment of the 1976 Act has been settled: The release of

sound recordings is not a "publication" of the underlying musical compositions! That, however, is not the end of the "publication" issue. In 1998 and 1999, the courts entertained the related issue of whether or not the publication of a motion picture constitutes the publication of its underlying common law copyright component parts, such as the screenplay and the musical compositions in the soundtrack. In the motion picture setting, the courts make a distinction between the protection afforded to a federally copyrighted work and that afforded to a common law work when the motion picture enters the public domain, most often through failure to renew.

In Dolman v Agee,²²¹ the Ninth Circuit examined whether the publication of a motion picture also constituted publication of its soundtrack. In Dolman, the plaintiff had acquired the copyrights to songs that were

The release of sound recordings is not a "publication" of the underlying musical compositions!
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originally written pursuant to a contract with Hal Roach Studio for inclusion in Laurel & Hardy movies. The movies were released in the early 1930s, and were registered by Metro-Goldwyn-Mayer (“MGM”). The songs were registered separately after the movies were released.²²² Plaintiff Dolman acquired his interest through a series of assignments.²²³

Defendant Agee did business under the name L & H Records and distributed the “Music Box” containing renditions of the songs at issue. In 1990, when Dolman learned of the distribution of the recordings, he contacted Agee stating that Agee required a license. Agee did not respond to the letters until 1993, when he acknowledged Dolman’s ownership of the copyrights to the songs. He did not agree to take a license, however.²²⁴ Dolman then commenced a copyright infringement action.

In an unpublished opinion, the district court granted summary judgment in favor of Dolman. The Court rejected, as a matter of law, the defendant’s argument that the publication of the motion picture, without separate copyright notice for the songs, caused the underlying songs to fall into the public domain. The court awarded \$23,333.33 plus costs, and enjoined Agee from further infringing.²²⁵

On appeal, the Ninth Circuit took up the issue regarding the “publication” of the motion picture.²²⁶ The court had to address whether the Laurel & Hardy motion pictures had been “published.” If the films were never published, then there was no need to determine whether the underlying songs fell into the public domain as a result. The court looked to prior case law for a definition of “publication.” “[P]ublication occurs when by consent of the copyright owner, the original or tangible copies of a work are sold, leased, loaned, given away, or otherwise made available to the general public.”²²⁷ The court continued, “[h]owever, ‘mere performance of or exhibition of a work does not constitute a publication of a work. . . . [A] motion picture exhibition where the viewing audience is merely permitted to see the work is not itself a publication.’”²²⁸ The court also reiterated the proposition that stronger affirmative steps are needed to divest one of copyright protection than to invest one with protection.²²⁹

The court, therefore, found that the copyrights in the songs were valid and infringed. While the Ninth Circuit affirmed the lower court’s holding, it did not fully resolve the status of the musical compositions had the motion pictures been “published”; it was able to skirt the issue by finding that the Laurel & Hardy movies had *not* been published.

If sound recordings cannot be “copies” of the underlying musical compositions because they are not in “human-readable form,” by analogy the same should apply to motion pictures. If the only way that musical compositions could have been published (or registered for copyright protection, for that matter) under the 1909 Act was in musical notation, then the inclusion of music in a motion picture should not be a publication of the underlying song.

The issue of “publication” of underlying works has been a troubling and confusing issue for most of the last century. After disagreement among the appellate courts, and refusal by the Supreme Court to resolve an issue that had profound effects upon one of the major industries in the United States, it took an act of Congress to merely reinforce the *status quo* in the case of sound recordings and musical compositions. Courts have attempted to apply “marketplace logic” instead of following the statutory guidance.

The same problem is occurring now with respect to motion pictures. Statutory language, Copyright Office internal procedures, and industry practice and expectations lead to the conclusion that an unpublished musical work and a motion picture that incorporates the work should have separate protection. Just as a registered underlying or incorporated work does not fall into the public domain upon the expiration of the derivative work, neither should the unpublished work. Consistency and symmetry with respect to musical compositions is extremely important. The Courts’ inability to apply these principles to the law of music publication has forced Congress to “clarify” what the law has actually been for years. Even with Congressional action, however, the elusive concept of publication still promises to generate future problems in other media. ♦

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² White Smith v. Apollo, 209 U.S. 1 (1908).

³ White-Smith v. Apollo is discussed in detail. See id.

⁴ Interestingly, although the specific subject matter at issue in White-Smith was player- piano rolls, the opinion refers to the rolls as “records” and also includes “record of the graphophone” within its purview. Id. at 30.

⁵ La Cienega v. Z.Z. Top Music Co., 53 F.3d 950 (9th Cir. 1995), *cert. denied*, 516 U.S. 927 (1995).

⁶ See Rosette v. Rainbo Record Mfg. Corp., 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff’d per curiam*, 546 F.2d 461 (2d Cir. 1976).

⁷ See La Cienega, 53 F.3d 950.

⁸ 516 U.S. 927 (1995).

⁹ See Copyright Act of 1976, 17 U.S.C. §303(b) (1976).

¹⁰ The Copyright Act of 1976 became effective on January 1, 1978.

¹¹ See 17 U.S.C. §101 *et seq.*

¹² It is therefore imperative that one who practices or follows copyright law in 1997 must be conversant in the 1976 Act as well as the 1909 Act.

¹³ “Investiture” is the term that is used when the “publication” triggers federal copyright protection and extinguishes common law copyright protection.

¹⁴ “Divestiture” is the term that is used when the “publication” is without copyright notice and causes the work to fall into the public domain, also extinguishing the protection under common law copyright.

¹⁵ Section 303(a) of the 1976 Copyright Act provides as follows: Copyright in a work created before January 1, 1978, but not theretofore in the public domain or copyrighted, subsists from January 1, 1978, and endures for the term provided by section 302. In no case, however, shall the term of copyright in such a work expire before December 31, 2002; and, if the work is published on or before December 31, 2002, the term of copyright shall not expire before December 31, 2047.

Section 303(a) was amended on October 28, 1998 by Pub. L. 105 - 298 (“The Sonny Bono Copyright Term Extension Act”). Protection was extended twenty years from 2027 to 2047. Copyright Act of 1976, 17 U.S.C. §303(a) (1976) (amended 1998).

¹⁶ Section 10 of the Copyright Act of 1909 provides as follows: Any person entitled thereto by this title may secure copy-

right for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy published thereof published or offered for sale in the United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title.

¹⁷ Section 12 of the Copyright Act of 1909 provides as follows: Copyright may also be had for the works of an author, of which copies are not reproduced for sale, by the deposit, with claim of copyright, of one complete copy of such work if it be a lecture or similar production of a dramatic-musical, or dramatic-musical composition; of a title and description, with one print taken from each scene or act, if the work be a motion-picture photo play; of a photographic print if the work be a photograph; of a title and description, with not less than two prints taken from different sections of a complete motion picture, if the work be a motion picture other than a photoplay; or a photograph or other identifying reproduction thereof. If it be a work of art or a plastic work or drawing. But the privilege of registration of copyright secured hereunder shall not exempt the copyright proprietor from the deposit of copies, under sections 13 and 14 of this title, where the work is later reproduced in copies for sale.

Copyright Act of 1909, 17 U.S.C. § 12 (1909) (amended 1947).

¹⁸ Under legislation that went into effect on January 1, 1996, as a result of the United States signing the GATT, foreign works that are protected in their home or “source” countries that have fallen into the public domain in the United States through failure to comply with a statutory technicality, such as affixation of copyright notice, may have their protection in the United States restored pursuant to §104A of the Copyright Act of 1976. 17 U.S.C. §104A (1996).

¹⁹ U.S. CONST. art. I, § 8, cl. 8.

²⁰ PAUL GOLDSTEIN, COPYRIGHT § 3.2.2, at 236-37 (1989). Professor Goldstein further comments that the concept of publication under the 1909 Act was a tradeoff between these competing interests and that “[an] author could enjoy perpetual protection for her work so long as she did not seek economic rewards though the work’s dissemination.” Id.

²¹ Id. Professor Nimmer states that “[t]he Constitutional means of adjusting these conflicting demands was found in permitting authors a limited monopoly.” MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 4.03, at 4-18 (1999).

²² GOLDSTEIN, *supra* note 20.

²³ Id.

²⁴ Nimmer suggests that a definition of “publication” was deliberately left out of the 1909 Act because of “the difficulty of defining the term with respect to works of art where no copies are reproduced.” See NIMMER, *supra* note 21, at §4.04, 4-20 n.5.

²⁵ Copyright Act of 1909, 17 U.S.C. §26 (1909).

²⁶ Id. The use of “by the proprietor or copyright or under his

authority” was used to make it clear that an unauthorized distribution by a third party was not a publication. Therefore, the unauthorized distribution of copies without the copyright notice should not have a divestiture effect to the proprietor’s detriment under section. 22. This is also an issue in Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211 (11th Cir. 1999) (case remanded for a determination of whether Dr. King authorized the inclusion of the text of his “I Have A Dream” speech in the Southern Christian Leadership Conference (“SCLC”) newsletter).

27 Section 24 of the Copyright Act of 1909 provides:

The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author’s true name or is published anonymously or under an assumed name: Provided, That in the case of any posthumous work or of any periodical, encyclopedia, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: And provided further, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to an encyclopaedia or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author’s executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: And provided further, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

Copyright Act of 1909, 17 U.S.C. § 24 (1909) (amended 1947).

28 ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT FOR THE NINETIES: CASES AND MATERIALS 361 (4th ed. Michie 1993) [hereinafter “Gorman & Ginsburg”] (*citing* Cardinal Film Co. v. Beck, 248 F. 368 (S.D.N.Y. 1918)).

29 Academy of Motion Picture Arts and Sciences v. Creative House Promotions, Inc., 944 F.2d 1446 (9th Cir.1991) (*citing* Burke v. National Broadcasting Co., 598 F.2d 688, 691 (1st. Cir), *cert. denied*, 444 U.S. 869 (1979)).

30 *See* Burke 598 F.2d at 692; *see also* White v. Kimmell, 193 F.2d 744 (9th Cir. 1952) (“[The author’s] only apparent purpose was to enable any persons interested to obtain a copy of the manuscript. No other motive is discernible. Such a purpose, we think, is too broadly

general and indefinite to satisfy the test of a limited publication”); Jewelers’ Mercantile Agency Ltd. v. Jewelers’ Weekly Publ’g Co., 49 N.E. 872 (N.Y. 1898).

31 *Id.*

32 *See* Academy of Motion Picture Arts and Sciences, 944 F.2d at 1452 (*quoting* White v Kimmell, 193 F.2d at 746-47).

33 King v. Mister Maestro, 224 F. Supp. 101 (S.D.N.Y. 1963).

34 *Id.* at 107.

35 *Id.* at 108; *cf.* Public Affairs Associates v. Rickover, 284 F.2d 262, 270-71 (D.C. Cir. 1960) (advance distribution of text of speech to both the press and to anyone who desired a copy was held to be a general, not a limited publication). Dr. King’s “I Have a Dream” speech became the subject of copyright litigation again when Dr. King’s estate sued CBS over including live film footage of the speech in its documentary series, Twentieth Century With Mike Wallace. *See* Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., 194 F.3d 1211 (11th Cir. 1999). It should also be noted that there was also a “performance” issue both in King v. Mister Maestro and Estate of Martin Luther King, Jr., Inc. v. CBS, Inc., owing to the fact that the speech was presented live to an audience of over 200,000 in Washington, D.C. and millions of others via the various media.

36 944 F.2d 1446 (9th Cir. 1991).

37 126 F. Supp. 54 (S.D.N.Y. 1954). In Mills Music, however, the sale of the recordings was deemed by the District Court to be a divesting publication. Mills Music, being a case from the Southern District of New York, was effectively overruled with respect to the issue of publication resulting from the sale of records by the Second Circuit in Rosette v. Rainbo Record Mfg. Corp., 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff’d per curiam*, 546 F.2d 461 (2d Cir. 1976), discussed *infra*.

38 *See* Mills Music, 126 F.Supp. at 63.

39 598 F.2d 688 (1st Cir. 1979).

40 *Id.* at 690.

41 *Id.* at 693.

42 *Id.* at 690.

43 *Id.* at 693-94, distinguishing Rickover, *supra* note 35.

44 GOLDSTEIN, *supra* note 20, at 253-54.

45 17 U.S.C. § 301 (1994).

46 *Id.* at § 101.

47 *Id.* at § 102. The Act protects “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.” *Id.*

48 *Id.* at § 304. “Any copyright, the first term of which is subsisting

on January 1, 1978, shall endure for 28 years from the date it was originally secured.” Id.

49 Transitional and Supplementary Provisions of 1976 Copyright Act Section 103, 90 Stat. 2599 (1976).

50 H.R. REP. NO. 94-1476, 52. The House Report further states that a work’s fixation would no longer be dependent on its “form, manner, or medium.” Id.

51 Transitional and Supplementary Provisions of 1976 Copyright Act Section 103, 90 Stat. 2599 (1976).

52 H.R. Rep. No. 1476, at 130. The history further stated that § 301 would provide the limited protection called for by the Constitution, without the distortion created by the “traditional concept of ‘publication.’” Id. This provision is found in 17 U.S.C. § 301 (1994).

53 Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 473 (1955) (hereinafter “Kaplan”).

54 Id.

55 223 U.S. 424 (1912).

56 See Kaplan, *supra* note 54, at 479.

57 See Gorman & Ginsburg, *supra* note 28, at 361 for a discussion of the Ferris Rule.

58 259 F. 364 (S.D.N.Y. 1919).

59 154 F.2d 480 (2d. Cir. 1946).

60 12 Misc. 78, 201 N.Y.S. 20 (N.Y. Sup. Ct. 1923).

61 31 F.2d 236 (2d Cir. 1929).

62 8 F.Supp. 358 (D. Mass. 1934).

63 224 F.Supp. 101 (S.D.N.Y. 1963) (live delivery and radio and television broadcasts of Dr. Martin Luther King, Jr.’s “I Have A Dream” speech was not a “publication”).

64 Though performances are not protected, live events are protected by simultaneous videotaping or filming. This is the primary means of protecting the broadcast of sporting events.

65 224 F. Supp. at 107 (*citing* Melville Nimmer, *Copyright Publication*, 56 COLUM. L. REV. 185, 195 (1956). Professor Nimmer does, however, in the same article admit that the issue of the sale of recordings is a subject of “serious debate.” Id.

66 When the 1976 Act took effect, it contained provisions eliminating common law protection and providing federal protection beginning on January 1, 1978 for works that were created but neither published nor copyrighted. Section 303 of the 1976 Act provides: “Copyright in a work created before January 1, 1978, but not theretofore in the public domain or copyrighted subsists for the term provided by section 302. [life of the author plus 70 years] In no case, however, shall the term of

copyright in such work expire before December 31, 2002; and if the work is published on or before December 31, 2002, the term of copyright shall expire not before December 31 2047.” 17 U.S.C. §303(a) (amended by Pub. L. 105-298 (October 28, 1998)).

67 The language of §303 of the 1976 Copyright Act does not provide any retroactive cut-off date. Thus, it appears as though any unpublished work protected by common law copyright would now be protected until at least 2001, and 2027 if later published. This means that unpublished letters or manuscripts from the 1700s and 1800s could potentially be protected. Because of § 303, one should never assume that a work has fallen into the public domain merely because it is old.

68 209 U.S. 1 (1908).

69 Id.

70 The copyrights were duly obtained on March 17, 1897. Id. at 9.

71 Interestingly, piano rolls are similar to a prototype of computer punch cards. By having perforations placed in strategic locations on the roll, the player-piano operates under a binary format similar to that of computer programs.

72 The case was brought under §4952 of the Copyright Act as amended in 1897, which was the predecessor Act to the 1909 Act. (See 3 U.S. Comp. Stat. Sup. 1907, 1021). Under §4952, “the author, inventor, designer or proprietor of any book, map, chart, dramatic or musical composition [has] the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same.” White-Smith, 209 U.S. at 9.

73 See White-Smith, 209 U.S. at 12 (*citing* Kennedy v. McTammany, 33 F. 584 (“I cannot convince myself that these perforated sheets of paper are copies of sheet music within the meaning of the copyright law. They are not made to be addressed to the eye as sheet music, but they form part of a machine. They are not designed to be used for such purposes as sheet music, nor do they in any sense occupy the same field as sheet music.”)); see also Stearn v. Rosey, 17 App. D.C. 562 (“We cannot regard the reproduction, through the agency of a phonograph, of the sounds of musical instruments playing the music composed and published by the complainants, as the copy or publication of the same within the meaning of the act. The ordinary signification of the words ‘copying,’ and ‘publishing,’ etc., cannot be stretched to include it.”).

74 See Boosey v. Whight, 1 Ch. 122, 81 L.T.R. 265 (1900) (“The plaintiff’s rights are not infringed except by an unauthorized copy of their sheets of music. . . . The only question we have to consider is whether the defendants have copied the plaintiff’s sheets of music.”).

75 The Berne Convention of 1886 provides in pertinent part: “It is understood that the manufacture and sale of instruments serving to reproduce mechanically the airs of music borrowed from the private domain are not considered as constituting musical infringement.” The Berne Convention for the Protection of Literary and Artistic Works (“Berne Convention”) provides reciprocal protection and rights to member signatory states. The United States officially became a member of the Berne Convention in 1989.

76 See White-Smith, 209 U.S. at 17.

- 77 Id.
- 78 Id. at 17-18.
- 79 It is interesting to note that the Court referred to the player piano rolls as “records.”
- 80 Id. at 18.
- 81 Id. at 18-19.
- 82 Id. at 20.
- 83 White-Smith’s holding that a mechanical reproduction was not a “copy” was later directly applied to sound recordings, albeit of spoken words instead of musical compositions, in Corcoran v. Montgomery Ward & Co., Inc., 121 F.2d 572 (9th Cir. 1941), *cert. denied*, 314 U.S. 687 (1941). It is interesting to note that Corcoran is a Ninth Circuit case. The Ninth Circuit, in creating the inter-circuit split in La Cienega, 53 F.3d 950 (9th Cir. 1995), *cert. denied*, 516 U.S. 927 (1995), ignored its own earlier precedent.
- 84 H.R. REP. NO. 60-2222, at 4 (1909).
- 85 S. REP. NO. 59-6187, at 2, 3 (1907). The Senate Report reads as follows:
It seems obvious to this committee that if the musical composition is entitled to protection it is not only against the reprinting of a musical score, but against any publication or reproduction of the composer’s work. The musical composer’s work is meant to be uttered in sound, and if science has discovered a method of reproducing that sound, thus taking possession of the very soul and essence of a musical composer’s work without the medium of actual printing, the musical composer is entitled to protection against this new and more complete form of appropriation. Id. at 4.
- 86 Id. at 3.
- 87 S. REP. NO. 59-6187, pt. 2, at 4 (1907), *reprinted in* 6 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, R4 (1976).
- 88 Id. at 3.
- 89 H.R. REP. NO. 59-7083, at 3 (1907), *reprinted in* 6 LEGISLATIVE HISTORY OF THE 1909 COPYRIGHT ACT, P3 (1976).
- 90 Id. at 9.
- 91 H.R. REP. NO. 60-2222, at 9.
- 92 S. REP. NO. 59-6187, pt. 2, at 1-2.
- 93 Id. at 2-3.
- 94 Id. at 2.
- 95 S.R. REP. NO. 6187, at 3-4..
- 96 Id.
- 97 H.R. REP. NO. 60-2222, at 7.
- 98 H.R. REP. NO. 59-7083, pt. 2, at 7.
- 99 Id.
- 100 Id.
- 101 Id. at 4.
- 102 Id. at 5.
- 103 Id. at 4-5.
- 104 Id.
- 105 S.R. REP. NO. 59-6187, pt. 2, at 3.
- 106 H.R. REP. NO. 59-7083, pt. 2, at 4.
- 107 Id.
- 108 Id.
- 109 Id. at 2-3. It was further stated that “[t]he extensive use of automatic musical instruments is by far the most important change in the conditions affecting the workings of the copyright law.”
- 110 Id.
- 111 Id.
- 112 Id.
- 113 H.R. REP. NO. 60-2222, at 6-7 (1909).
- 114 Id.
- 115 17 U.S.C. § 1(e) (repealed January 1, 1978).
- 116 H.R. REP. NO. 60-2222, at 9.
- 117 Id.
- 118 ALAN LATMAN, THE COPYRIGHT LAW 119 (5th ed. 1979).
- 119 H.R. REP. NO. 92-487, at 1570 (1984). The Sound Recording Act did extend the definition of copies to include phonorecords, but only to constitute protection for the sound recording and not for the underlying musical work.
- 120 Id.
- 121 H.R. REP. NO. 92-487, at 1566-67.
- 122 17 U.S.C. §102 (1994). Further, the legislative history of §301, dealing with common law preemption, of the current act reveals that Congress intended to both prevent pre-1972 sound recordings from enjoying “perpetual protection” under common law and to prevent such works from immediately falling into the public domain. H.R. REP. NO. 1476, at 133.

- 123 H.R. REP. No. 92-487, 1566-1568.
- 124 91 F. Supp. 472, 475 (N.D. Ill. 1950).
- 125 Id. at 475.
- 126 Id.
- 127 Id. Judge Igoe, commenting on the nature of the mass distribution of phonorecords, stated that “[w]hen phonorecords of a musical composition are available for purchase in every city, town and hamlet, certainly the dissemination of the composition to the public is complete, and is as complete as by sale of a sheet music reproduction of the composition.”
- 128 Id.
- 129 126 F. Supp. 54, 69 (S.D.N.Y. 1954).
- 130 Id. at 69-70. Judge Leibell stated that “[t]he manufacture and sale of phonograph records in this country by a person or corporation duly authorized . . . would have constituted a publication of his composition.” Id. It should be noted that Mills Music was a Southern District of New York case, and therefore would have been overruled by Rosette v. Rainbo Record Mfg. Corp., 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff’d per curiam*, 546 F.2d 461 (2d Cir. 1976), over twenty years later.
- 131 Mills Music, 126 F. Supp. at 70. At that point, the judge cited to RCA Mfg. Co. v. Whiteman, 114 F.2d 86 (2d Cir. 1940), *cert. denied* 311 U.S. 712 (1940), and also to Shapiro Bernstein & Co. Id. In Whiteman, which actually concerned performance, Judge Learned Hand made references to the sale of records as a possible publication. Whiteman, 114 F.2d at 88.
- 132 166 F. Supp. 681 (S.D. Cal. 1958).
- 133 Id. at 682.
- 134 Id.
- 135 Id. at 682-83.
- 136 LATMAN, *supra* note 118, at 119 (5th ed. 1979).
- 137 Nom Music, Inc. v. Kaslin, 227 F. Supp 922, 926 (S.D.N.Y. 1964), *aff’d*, 343 F.2d 198 (1965).
- 138 354 F. Supp. 1183 (S.D.N.Y. 1973), *aff’d per curiam*, 546 F.2d 461 (2d Cir. 1976).
- 139 Id. at 1185, 1188.
- 140 Id. at 1188. The plaintiff contended that it was “not a publication but a performance of an unpublished work.”
- 141 Id.
- 142 Id. at 1189.
- 143 Id.
- 144 Id. at 1190.
- 145 Id. at 1189-90.
- 146 The Universal Copyright Convention, to which the United States is a party, provides that “works of nationals of any Contracting State shall enjoy in each other Contracting State the same protection as that other State accords to works of its own nationals, as well as the protection specifically granted by the Convention.” See Universal Copyright Convention, Article II.
- 147 Rosette, 354 F. Supp. at 1189.
- 148 Id.
- 149 37 C.F.R. § 202.8(b)(1975).
- 150 Rosette, 354 F. Supp. at 1192. Registration is another of the formalities in copyright law; under the 1909 Act, publication of the work with proper notice triggered statutory protection. However, once a work was published with notice, § 13 of the 1909 Act required the prompt deposit of “two complete copies of the best edition then published” in the Copyright Office. 17 U.S.C. § 13 (amended through 1976). Statutory protection for unpublished works was also available by way of depositing “one complete copy of such work.” Id. at § 12.
- 151 Rosette, 354 F. Supp. at 1190-91.
- 152 Id. at 1191.
- 153 Id.
- 154 Id. at 1192-93. These “royalty provisions” concerning the mechanical reproduction of underlying musical compositions were as follows under the 1909 Act:
[W]henever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of instruments serving to reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of 2 cents on each such part manufactured.
17 U.S.C. § 1(e) (1909 Act).
- 155 Rosette, 354 F. Supp. at 1193. Professor Nimmer has criticized the Rosette court’s conclusion that such a limit could be placed on common law protection when “the explicit language of Section 2 of the 1909 Act” provides that “ ‘nothing in this title shall be construed to . . . limit’ common law copyright in an unpublished work.” NIMMER, *supra* note 21, at § 4.05[B], 4-28.
- 156 Rosette, 546 F.2d at 462-63 n.1 (2d Cir. 1976).
- 157 643 F. Supp. 1153 (S.D.N.Y. 1986).
- 158 Id. at 1154.

- 159 Id. at 1156.
- 160 Id. at 1158-59. The court noted that Rosette was not followed in other circuits but stated that only the Court of Appeals could change the law in its circuit.
- 161 53 F.3d 950 (9th Cir.), *cert. denied*, 516 U.S. 927 (1995).
- 162 Id. at 953.
- 163 546 F.2d 461 (2d Cir. 1976).
- 164 La Cienega, 53 F.3d at 952.
- 165 Id.
- 166 Id. Bernard Besman is the “sole proprietor” of La Cienega. Johnny Lee Hooker assigned all rights to “Boogie Chillen” to Mr. Besman. Id.
- 167 Id. at 953.
- 168 Id. at 954. The court, commenting that a failure to renew at the end of the 28 years of statutory protection places a work in the public domain, noted that the 1948 and 1950 versions would have fallen into the public domain in 1976 and 1978, respectively. Id.
- 169 Id. at 953.
- 170 Id. at 954.
- 171 Id.
- 172 Id. at 953.
- 173 Id.
- 174 Id. The court cited Professor Nimmer as identifying the Rosette holding as the minority view.
- 175 Isn’t “almost unanimous” when applied to a “few” an oxymoron?
- 176 La Cienega, 53 F.3d at 953.
- 177 Had the court been thorough in its research, it would have found an earlier Ninth Circuit case, Corcoran v. Montgomery Ward & Co., 121 F.2d 572 (9th Cir), *cert. denied*, 314 U.S. 687 (1941), which followed White-Smith, and held that a phonograph recording was not a copy. In addition, even overlooking Corcoran, the court is being disingenuous about the statement. It did not find any circuit court cases other than Rosette, because no other appellate courts had the opportunity to address the issue.
- 178 La Cienega, 53 F.3d at 955.
- 179 Id.
- 180 Id.
- 181 Id.
- 182 64 U.S.L.W. 3262, 3270 (1995) (No. 95-72).
- 183 Donna Petrozzello, *Supreme court asked to rule on copyrights. (music)*, BROADCASTING & CABLE, Vol. 125, No. 39, at 39.
- 184 Id.
- 185 Petition for A Writ of Certiorari (July 12, 1995), at 14-15. The petition was denied at 516 U.S. 927, (1995); see also Brief *Amici Curiae* of the National Music Publishers’ Association *et al* (July 14, 1995) at 14 (“sellers of catalogs of copyrights in musical works could face claims by purchasers for alleged breach of representations and warranties.”).
- 186 See 17 U.S.C. §§10, 19 (1909) (repealed by Copyright Act of 1976).
- 187 See 17 U.S.C. §24 (1909) (repealed by Copyright Act of 1976).
- 188 In July of 1992, renewal became automatic. Therefore, the need to actively file a renewal in order to prevent the work from falling into the public domain was eliminated. The change applies to all works that were created between 1964 and the end of 1977. The legislative change was not, however, retroactive. United States works created prior to 1964 that had not been renewed and were in the public domain would remain there forevermore.
- 189 See The Sound Recording Act of 1971, Pub. L. No. 92-140, 85 Stat. 391.
- 190 960 F. Supp. 1302 (M.D. Tenn 1997).
- 191 The position of the Copyright Office is discussed in detail below.
- 192 Universal Copyright Convention, Article IV.
- 193 Id. (*citing* Borsch, Universal Copyright Convention, 83 (1958)).
- 194 See Arthur E. Farmer, “Report to Section of Patent, Trademark and Copyright Law of American Bar Association,” September 15, 1952, at p. 11; John Schulman, “A Realistic Treaty,” *The American Writer*, Vol. 1, No. 218, at p. 23 (November, 1952); Sydney M. Kaye, “Duration of Copyright and the Concept of Dedication,” *Bulletin of the Copyright Society of the U. S. A.*, Vol. 2, No. 4, p. 93 at pp. 95-96 (February, 1955).
- 195 See Legislative History of the 1909 Act, *supra* notes 84-118.
- 196 The United States has not always followed suit with other nations. It took the United States years before it changed to a “life of the author”-based term of copyright. In addition, despite it being a long tradition under the Berne Convention, the United States did not adopt any “moral rights” protection until it passed the Visual Artists Rights Act of 1990, adding §106A to the Copyright Act of 1976.
- 197 See Motion of National Music Publishers Association, Inc. *et al*, for Leave to File Brief *Amici Curiae* in Support of Petition and Brief *Amici Curiae* (July 14, 1995) at 6 (hereinafter “Brief”).
- 198 Benjamin Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 472 n.20 (1955).

- 199 NIMMER, *supra* note 21, at §4.05[B] at 4-27 (Matthew Bender 1994) [hereinafter “Nimmer.”]
- 200 *Id.* at § 4-35.
- 201 ASCAP Amicus Brief, *supra* note 199, at 3.
- 202 U.S. Copyright Office Circular No. 50, Musical Compositions.
- 203 Certificate of Registration of a Claim of Copyright (*quoted in* Petition for a Writ of Certiorari, Attorneys for Plaintiff (July 12, 1995) at 22 [hereinafter “*Cert. Petition.*”]).
- 204 37 C.F. R. §202.8 was repealed when the 1976 Act became effective. Under the registration requirements effectuated by the 1976 Act, either a “copy” — meaning musical notation — or a “sound recording” may be used for registration and deposit purposes. *See* United States Copyright Office Circular 50, Musical Compositions.
- 205 37 C.F.R. §202.8(a).
- 206 *Id.* at. §202.8(b).
- 207 *Id.* at §202.8(a).
- 208 *See* 17 U.S.C. § 12 (1909).
- 209 *See* Act of Oct. 15, 1971, Pub. L. No. 92-140, 85 Stat. 391.
- 210 Emphasis added.
- 211 The Register of Copyrights is referring to legislation that would increase the term of copyright protection by an additional twenty years. On October 28, 1998, President Clinton signed Pub. L. 105 - 298, “The Sonny Bono Copyright Term Extension Act,” adding an extra twenty years of protection to works. Works created after January 1, 1978 are now protected for life-plus-seventy years. Works copyrighted under the 1909 Act are now protected for a total of 95 years (28 + 67).
- 212 17 U.S.C. §12 (1909) (repealed in 1978 when the Copyright Act of 1976 took effect).
- 213 17 U.S.C. §10 (1909) (repealed in 1978 when the Copyright Act of 1976 took effect).
- 214 *See* 54 PT CJ (BNA) 178 (June 26, 1997).
- 215 17 U.S.C. § 303(b).
- 216 *See* 55 PTCL (BNA) 56 (November 20, 1997).
- 217 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.”).
- 218 There is a difference between “changing” and “clarifying” or “correctly interpreting.” It is the author’s view that in the 1997 amendment to section 303(b), Congress correctly interpreted what was thought to be the law.
- 219 166 F.3d 821 (6th Cir. 1999).
- 220 *Id.* at 830 (internal citations omitted).
- 221 157 F.3d 708 (9th Cir. 1998).
- 222 *Id.* at 710.
- 223 *Id.* at 710-11.
- 224 *Id.* at 711.
- 225 *Id.*
- 226 *Id.* at 708.
- 227 *Id.* (*citing American Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1027 (9th Cir. 1981)).
- 228 *Id.* (*citing American Vitagraph*, 659 F.2d at 1027); *see also* NIMMER, *supra* note 21, at §4.11(A), 4-53.
- 229 *Id.* at 714. (“It takes more in the way of publication to invalidate any copyright, whether statutory or common law than to validate it.”) (*quoting American Vitagraph*, 659 F.2d at 1027).