

COPYRIGHT LAW REVISION

---

STUDIES

PREPARED FOR THE

SUBCOMMITTEE ON  
PATENTS, TRADEMARKS, AND COPYRIGHTS

OF THE

COMMITTEE ON THE JUDICIARY

UNITED STATES SENATE

EIGHTY-SIXTH CONGRESS, SECOND SESSION

PURSUANT TO

S. Res. 240

STUDIES 17-19

17. The Registration of Copyright
18. Authority of the Register of Copyrights To  
Reject Applications for Registration
19. The Recordation of Copyright Assignments and  
Licenses



Printed for the use of the Committee on the Judiciary

---

UNITED STATES  
GOVERNMENT PRINTING OFFICE

## COMMITTEE ON THE JUDICIARY

JAMES O. EASTLAND, Mississippi, *Chairman*

ESTES KEFAUVER, Tennessee	ALEXANDER WILEY, Wisconsin
OLIN D. JOHNSTON, South Carolina	EVERETT MCKINLEY DIRKSEN, Illinois
THOMAS C. HENNINGS, Jr., Missouri	ROMAN L. HRUSKA, Nebraska
JOHN L. McCLELLAN, Arkansas	KENNETH B. KEATING, New York
JOSEPH C. O'MAHONEY, Wyoming	NORRIS COTTON, New Hampshire
SAM J. ERVIN, Jr., North Carolina	
JOHN A. CARROLL, Colorado	
THOMAS J. DODD, Connecticut	
PHILIP A. HART, Michigan	

---

## SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS

JOSEPH C. O'MAHONEY, Wyoming, *Chairman*

OLIN D. JOHNSTON, South Carolina	ALEXANDER WILEY, Wisconsin
PHILIP A. HART, Michigan	

ROBERT L. WRIGHT, *Chief Counsel*  
JOHN C. STEDMAN, *Associate Counsel*  
STEPHEN G. HAASER, *Chief Clerk*

## FOREWORD

---

This committee print is the sixth of a series of such prints of studies on "Copyright Law Revision" published by the Committee on the Judiciary Subcommittee on Patents, Trademarks, and Copyrights. The studies have been prepared under the supervision of the Copyright Office of the Library of Congress with a view to considering a general revision of the copyright law (title 17, United States Code).

Provisions of the present copyright law are essentially the same as those of the statutes enacted in 1909, though that statute was codified in 1947 and has been amended in a number of relatively minor respects. In the half century since 1909 far-reaching changes have occurred in the techniques and methods of reproducing and disseminating the various categories of literary, musical, dramatic, artistic, and other works that are subject to copyright; new uses of these productions and new methods for their dissemination have grown up; and industries that produce or utilize such works have undergone great changes. For some time there has been widespread sentiment that the present copyright law should be reexamined comprehensively with a view to its general revision in the light of present-day conditions.

Beginning in 1955 the Copyright Office of the Library of Congress, pursuant to appropriations by Congress for that purpose, has been conducting a program of studies of the copyright law and practices. The subcommittee believes that these studies will be a valuable contribution to the literature on copyright law and practice, that they will be useful in considering problems involved in proposals to revise the copyright law, and that their publication and distribution will serve the public interest.

The present committee print contains the following three studies: No. 17, "The Registration of Copyright," by Prof. Benjamin Kaplan, of the Harvard Law School; No. 18, "Authority of the Register of Copyrights To Reject Applications for Registration," by Caruthers Berger, Attorney-Adviser of the Copyright Office; and No. 19, "The Recordation of Copyright Assignments and Licenses," by Alan Latman, formerly Special Adviser to the Copyright Office, assisted by Lorna G. Margolis and Marcia Kaplan, of the Copyright Office.

The Copyright Office invited the members of an advisory panel and others to whom it circulated these studies to submit their views on the issues. The views, which are appended to the studies, are those of individuals affiliated with groups or industries whose private interests may be affected by copyright laws, as well as some independent scholars of copyright problems.

It should be clearly understood that in publishing these studies the subcommittee does not signify its acceptance or approval of any statements therein. The views expressed in the studies are entirely those of the authors.

JOSEPH C. O'MAHONEY,  
*Chairman, Subcommittee on Patents, Trademarks and Copyrights,  
Committee on the Judiciary, U.S. Senate.*

## COPYRIGHT OFFICE NOTE

---

The studies presented herein are part of a series of studies prepared for the Copyright Office of the Library of Congress under a program for the comprehensive reexamination of the copyright law (title 17 of the United States Code) with a view to its general revision.

The Copyright Office has supervised the preparation of the studies in directing their general subject matter and scope, and has sought to assure their objectivity and general accuracy. However, any views expressed in the studies are those of the authors.

Each of the studies herein was first submitted in draft form to an advisory panel of specialists appointed by the Librarian of Congress, for their review and comment. The panel members, who are broadly representative of the various industry and scholarly groups concerned with copyright, were also asked to submit their views on the issues presented in the studies. Thereafter each study, as then revised in the light of the panel's comments, was made available to other interested persons who were invited to submit their views on the issues. The views submitted by the panel and others are appended to the studies. These are, of course, the views of the writers alone, some of whom are affiliated with groups or industries whose private interests may be affected, while others are independent scholars of copyright problems.

ABE A. GOLDMAN,  
*Chief of Research,  
Copyright Office.*

ARTHUR FISHER,  
*Register of Copyrights,  
Library of Congress.*

L. QUINCY MUMFORD,  
*Librarian of Congress.*

## STUDIES IN EARLIER COMMITTEE PRINTS

---

**First print:**

1. The History of U.S.A. Copyright Law Revision From 1901 to 1954
2. Size of the Copyright Industries
3. The Meaning of "Writings" in the Copyright Clause of the Constitution
4. The Moral Right of the Author

**Second print:**

5. The Compulsory License Provisions in the U.S. Copyright Law
6. The Economic Aspects of the Compulsory License

**Third print:**

7. Notice of Copyright
8. Commercial Use of the Copyright Notice
9. Use of the Copyright Notice by Libraries
10. False Use of Copyright Notice

**Fourth print:**

11. Divisibility of Copyrights
12. Joint Ownership of Copyrights
13. Works Made for Hire and on Commission

**Fifth print:**

14. Fair Use of Copyrighted Works
15. Photoduplication of Copyrighted Material by Libraries
16. Limitations on Performing Rights

## CONTENTS

---

Study No.	Page
17. The Registration of Copyright.....	ix
Comments and Views Submitted to the Copyright Office.....	67
18. Authority of the Register of Copyrights To Reject Applications for Registration.....	81
Comments and Views Submitted to the Copyright Office.....	99
19. The Recordation of Copyright Assignments and Licenses.....	107
Comments and Views Submitted to the Copyright Office.....	127

---

STUDY NO. 17  
THE REGISTRATION OF COPYRIGHT  
BY PROF. BENJAMIN KAPLAN  
August 1958

---

# CONTENTS

---

	Page
I. British experience: decline and fall of registration.....	1
A. From the Statute of Anne (1710) to the rule of <i>Beckford v. Hood</i> (1798).....	1
B. The pattern prior to the Act of 1911.....	4
C. The Act of 1911.....	6
D. The present British Act.....	8
E. Comment on the British development.....	8
II. United States experience: persistence of registration and other formalities.....	9
A. From the first National Act (1790) to the rule of <i>Wheaton v. Peters</i> (1834).....	9
B. Legislation 1831-1867.....	11
C. Legislation 1870-1905.....	13
D. The act of 1909.....	15
E. The <i>Washingtonian</i> case (1939).....	20
F. Effects of adherence to the UCC.....	25
G. Status of unpublished works generally.....	26
III. Some problems in the interpretation of present deposit and registration provisions.....	27
A. Register's discretion.....	27
B. The prima facie provisions.....	28
C. Misstatements in the application and certificate.....	30
D. Lengthy delays in registration in relation to the "no action" provision.....	30
E. Deposit without registration?.....	31
F. Proper claimant in case of assignment.....	32
IV. Operations of the Copyright Office relating to registration.....	33
A. The works deposited and registered.....	33
B. The time of deposit.....	34
C. Applications and deposits; office examination.....	35
D. Copyright Office records.....	36
E. Disposal of deposited copies.....	37
F. Uses of copyright records.....	38
V. A consideration of the values of the present registration system.....	40
A. Registration as a means of enforcing compliance with other provisions of the act.....	41
B. Registration as a means of enhancing information publicly available.....	41
C. Values of registration to proprietors and users.....	42
D. Values of registration as an aid to title search.....	43
E. Values of a prima facie evidence provision.....	45
F. Values of deposit.....	45
G. General comments.....	45
VI. Alternate schemes.....	46
A. Compelling registration within a stated period: an early attempt to overcome the <i>Washingtonian</i> case; the recent "Ornamental Designs" bill.....	46
B. "Optional" registration: principal general revision bills (1924-1940); the current Canadian law.....	48
C. No registration: the position in Berne countries, particularly the United Kingdom.....	60
VII. Recapitulation of major issues; concluding observations.....	64
A. Major issues.....	64
B. Concluding remarks.....	65

## THE REGISTRATION OF COPYRIGHT\*

### I. BRITISH EXPERIENCE: DECLINE AND FALL OF REGISTRATION

#### A. FROM THE STATUTE OF ANNE (1710) TO THE RULE OF BECKFORD *v.* HOOD (1798)

A full account of our subject would seek the roots of registration and deposit in the royal privileges granted to printers, the imprimatur system designed to suppress heretical and seditious doctrine, the Register of the Stationers' Company, the famous decrees of Star Chamber, and the Licensing Acts. Passing over the early history, we can say that registration and deposit, or rather their lineal ancestors, had become so far associated with book publication that a copyright statute drafted in the 1700's would quite naturally have had something to say about these devices even though their exact analytical relationships to copyright might remain obscure.<sup>1</sup>

##### 1. *Legislation of 1710*

The Statute of Anne, 8 Anne, Ch. 19 (1710), begins by lamenting the impoverishment of "authors" and "proprietors" of books through unconsented-to traffic by printers, booksellers and others, and declares for the future<sup>2</sup> that the "author" and his "assignee or assigns" shall have "the sole liberty of printing and reprinting \* \* \* for the term of fourteen years, to commence from the day of the first publishing \* \* \*, and no longer; \* \* \*" (§ I). Those who invaded this "sole liberty" without written consent of the proprietor of the copy were to forfeit offending books and sheets to the proprietor "who shall forthwith damask and make waste paper of them"; and they were also to forfeit a penny a sheet, of which one-half was to go to the Queen and the other half to "any person or persons" who should sue for the same (§ I).

Next comes the provision for registration. The purpose is stated in the preamble to section II as follows:

And whereas many persons may through ignorance offend against this act, unless some provision be made whereby the property in every such book, as is intended by this act to be secured to the proprietor or proprietors thereof, may be ascertained, as likewise the consent of such proprietor or proprietors for the printing or reprinting of such book or books may from time to time be known;

Therefore it was enacted that the statute should not be construed to subject any infringer—

\* \* \* to the forfeitures or penalties therein mentioned, \* \* \* unless the title to the copy of such book or books hereafter published shall, before such publication

\*The author acknowledges with thanks assistance received from Paul Bender and Arthur R. Miller of the Harvard Law School classes of 1957 and 1958, respectively.

<sup>1</sup> For the early history, consult BIRRELL, SEVEN LECTURES ON THE LAW AND HISTORY OF COPYRIGHT IN BOOKS, c. I-IV (1899); 6 HOLDSWORTH, HISTORY OF ENGLISH LAW, 360-79 (1924); PARTRIDGE, THE HISTORY OF THE LEGAL DEPOSIT OF BOOKS, c. I-IV (1938); RANSOM, THE FIRST COPYRIGHT STATUTE (1956). See also POTTINGER, THE FRENCH BOOK TRADE IN THE ANCIENT REGIME, 1500-1791, c. XI (1958).

<sup>2</sup> For the provision for books already printed, see § 1 of the Act.

be entered, in the register-book of the Company of Stationers, in such manner as hath been usual, \* \* \* and unless such consent of the proprietor or proprietors be in like manner entered, as aforesaid, \* \* \* (§ II).

Then follow details of the fees to be charged for making the entries and provision for the issuance of certificates of entry by the clerk of the Company (§ II; see also § III).

Section IV of the statute dealing with deposit of printed copies for the use of libraries is not preceded by an explanatory "whereas." The text is:

Provided always, \* \* \* That nine copies of each book or books, upon the best paper, that \* \* \* shall be printed and published, as aforesaid, or reprinted and published with additions, shall, by the printer and printers thereof, be delivered to the warehouse-keeper of the said Company of Stationers for the time being, at the hall of the said Company, before such publication made, for the use of [nine named libraries]; \* \* \*

"[A]ny proprietor, bookseller or printer" who defaulted in delivering the printed copies "shall forfeit, besides the value of the said printed copies, the sum of five pounds for every copy not so delivered, as also the value of the said printed copy not so delivered, the same to be recovered" by the authorities of the libraries to which the copies were destined (§ V).

Finally the statute enacts that after expiration of the fourteen year term, "the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years" (§ XI).

## 2. Structural problems under the Act

A number of basic, somewhat intertwined questions arose with respect to the Statute of Anne. The first was whether common-law protection was available to a published book after the expiration of the periods of protection given by the statute. *Donaldson v. Becket*, 4 Burr. 2408, 98 Eng. Rep. 257, 2 Bro. Parl. Cas. 129, 1 Eng. Rep. 837 (H.L. 1774),<sup>3</sup> must be taken to have answered this question in the negative. Another question was whether common-law sanctions, apart from the forfeitures and penalties laid down in the statute, were available against an infringer during the statute-granted periods of protection; and especially if the copy had not been registered. Yet another question was whether the duty to deposit printed copies of books for the libraries arose only with respect to books that had been registered at Stationers' Hall.

The trade considered the deposit requirement to be an unjustified imposition, and resisted it over a period of decades. It appears that many publishers deliberately omitted to register, or registered only parts of published works, on the assumption that deposit for libraries extended only to such works as were fully registered or perhaps only to so much of a work as was registered. If omitting full registration endangered the copyright, the publishers were apparently prepared to risk it.

The Universities Copyright Act of 1775, (15 Geo. III, ch. 53), after securing—in reaction to *Donaldson v. Becket*—perpetual rights to certain universities in books of which the copy was given or bequeathed to them (§ I), proceeded to strengthen the provisions of the Statute of Anne in respect to deposit. It reenacted the requirements of the

<sup>3</sup> A further account of this case appears in 17 Cobbett's Parliamentary History 954-1003 (1813).

latter statute on deposit and the penalties for default therein, and said (§ VI):

\* \* \* whereas the said provision has not proved effectual, but the same hath been eluded by the entry only of the title to a single volume, or of some part of such book or books so printed and published, or reprinted and republished, as aforesaid; \* \* \*

Therefore it enacted that "no person or persons whatsoever shall be subject to the penalties in the said act mentioned" for infringement, unless (i) "the title to the copy of the whole of such book, and every volume thereof" shall have been registered, and (ii) "nine such copies of the whole of such book or books, and every volume thereof printed and published, or reprinted and republished, as therein mentioned," shall have been delivered for the libraries (§ VI).

Full prepublication registration and full prepublication deposit were thus expressly made conditions of maintaining suit for penalties on account of infringement. But the act of 1775 did not make either requirement an express condition of securing copyright. Nor did it speak of the effect of a failure to register or deposit on the available remedies, if any, apart from a suit for penalties.

### 3. *The Beckford and Bryer cases*

In this state of affairs there arose the case of *Beckford v. Hood*, 7 T.R. 620, 101 Eng. Rep. 1164 (K.B. 1798). This was an action on the case for damages (not a suit for penalties) for the piracy in 1796 of a book published in 1781 and published in further editions in 1782 and 1784. The plaintiff-author was still living at the time of the action and had not disposed of his interest. There had been no registration of the title to the copy. (It is not stated whether there was also a failure to deposit.) The court held that the action could be maintained. Publication without more was conceived to vest the copyright; during the periods of protection provided by the Statute of Anne an action for damages could be brought although no such action was specifically given by the statute; and failure to register did not affect such an action although it would prevent a suit for the statutory penalties. Lord Kenyon said in part (7 T.R. at p. 627):

\* \* \* But their meaning [i.e. of the legislature] in creating the penalties in the latter part of the clause in question certainly was to give an accumulative remedy: nothing could be more incomplete as a remedy than those penalties alone; for without dwelling upon the incompetency of the sum, the right of action is not given to the party grieved, but to any common informer. [In the colloquy with counsel (p. 625), and again in the opinion of Grose, J. (p. 629), it is suggested that not even a suit for penalties was given by the statute for infringement during the renewal term.] \* \* \* But there was good reason for requiring an entry to be made at Stationers' Hall, which was to serve as notice and warning to the public, that they might not ignorantly incur the forfeitures or penalties before enacted against such as pirated the works of others: but calling on the party who has injured the civil property of another for a remedy in damages cannot properly fall under the description of a forfeiture or penalty \* \* \*.<sup>4</sup>

Full prepublication registration and full prepublication deposit were thus expressly made conditions of maintaining suit for penalties on account of infringement. But the act of 1775 did not make either requirement damages, while preserving forfeiture of offending books and sheets and the suit for penalties for infringement, increased to 3 pence per sheet (§ 1). The result of *Beckford v. Hood* appears to

<sup>4</sup> See *infra* note 22 for the attempt of McLean, J. in *Wheaton v. Peters*, 9 Pet. 591 (1834), to discredit *Beckford v. Hood* by reference to the earlier English case of *Blackwell v. Harper*.

be accepted in the express statement that there should be no liability for the penalty of 3 pence per sheet where prepublication registration had not been made (§ VI) leaving the implication that no other remedy of the proprietor was impaired by failure to register. The decision in the *Beckford* case and its confirmation in the act of 1801, of course, weakened the incentive to register; and especially would this be so if failure to register also relieved the trade of the obligation to make deposit for the benefit of libraries. (The beneficiary libraries were increased to 11 by the same act, § VI.)

*Chancellor, Masters, & Scholars of the University of Cambridge v. Bryer*, 16 East 317, 104 Eng. Rep. 1109 (K.B. 1812), was a test case on the latter question, namely, whether registration was linked with deposit in the sense that a library could recover the statutory penalty for failure to deposit only if the book had been registered. Here the trade lost out: it was held that the statutory penalty could be exacted at the library's suit even if the book had not been registered. For the defendant printer it was argued, among other things,<sup>5</sup> that the recital in the Universities Copyright Act that deposit had been "eluded" through imperfect registration implied that there was no requirement of deposit unless a proper registration had been made; and in the case at bar there had been no registration. The court, however, read the whole complex of legislation as requiring deposit of copies of any book as to which copyright attached on publication under the statutes.

#### 4. Summary

Thus at an early date in England copyright of published books was conceived to attach on publication without formality. The failure to register prevented an action for penalties against an infringer, but did not exclude other and more important remedies; and so the incentive to register was slim. Published books had to be deposited in libraries on pain of fine, and this without regard to whether title to the copy thereof had been registered.

### B. THE PATTERN PRIOR TO THE ACT OF 1911

#### 1. An attempt at enforcement of registration by fine

A statute of 1814 (54 Geo. III, ch. 156), evidently sought further to insure that the libraries would obtain the deposits. Here the purpose of registration is stated to be "to ascertain what books shall be from time to time published" (§ V) rather than to warn intending copyists. Registration was required to be made within stated times after first publication and was to be accompanied by delivery of one printed copy to the British Museum. Failure to register entailed a money penalty (§ V).

Registration was not a condition of the libraries' right to printed copies, but facilitated pursuit of publishers who had neglected to deposit them. For it was provided that the warehouse keeper of the Stationers' Company was to transmit lists of entries at intervals of 3 months to an authorized representative of the 11 beneficiary libraries (§ VI). Demand for the printed copies could be made within 12 months of publication (§ II). Failure to deposit was again sanctioned by penalty

<sup>5</sup> The opinions of Lord Ellenborough, C. J. and Le Blanc, J. go extensively into the interpretation of the statutes of George III.

(§ II). But it was expressly provided that "no failure in making any such entry [i.e. to register; the same would no doubt apply to failure to deposit] shall in any manner affect any copyright, but shall only subject the person making default to the penalty aforesaid under this Act" (§ V). So far as appears, a failure to register did not even prevent an action by the proprietor for penalties against an infringer; (Incidentally, the term of copyright of books was by this act made 28 years from publication and if the author was alive at the end of the period, then "the residue of his natural life," § IV.)

*2. Basic legislation of 1842: registration a condition of actions for enforcement of copyright*

Enforcement of registration by means of a money penalty fell out of the next legislation of general importance, the statute of 1842 (5 and 6 Vict., ch. 45) which, as Copinger and Skone James say, "remained the governing statute as to literary copyright"<sup>6</sup> until it was repealed by the act of 1911. The 1842 legislation assimilated maps, charts, etc., as "books" (§ II) and gave a term of life plus 7 years, or 42 years from first publication, whichever was longer (§ III). Copyright in published works was invested without formality, as before; but registration was made a precondition of the proprietor's maintaining "any action or suit, at law or in equity, or any summary proceeding, in respect of any infringement of such copyright, \* \* \*" (§ XXIV). The most consequential point is that it was sufficient that registration be accomplished at any time before commencement of court proceedings; such a registration was effective even with respect to prior infringements.<sup>7</sup>

The registry books at Stationers' Hall were open not only to the entry of claims of proprietorship of copyright but of assignments and licenses thereof (§ XI).<sup>8</sup> A certified copy of an entry "shall be received in evidence in all courts, \* \* \* and shall be prima facie proof of the proprietorship or assignment of copyright or license as therein expressed, but subject to be rebutted by other evidence, \* \* \*" (§ XI). False entry or the tendering in evidence of a false copy of entry was made a crime (§ XII).

Deposit of printed copies was separately dealt with. A printed copy of every published book and of any subsequent edition with additions or alterations must be delivered at the British Museum within stated times after publication (§ VI). Further, upon demand within 12 months of publication the publisher was required to make four additional copies available to the Stationers' Company for the use of named libraries (§ VIII). Default could involve a penalty of 5 pounds plus the value of the undelivered book (§ X).

This pattern established for books by the act of 1842 seemed to look to registration as a means of fortifying somewhat a proprietor's claim of ownership, and correspondingly as a means by which the trade could sometimes check on claims. Self-interest might lead a publisher to register without regard to impending litigation for in-

<sup>6</sup> Copinger & Skone James, *LAW OF COPYRIGHT* 11 (9th ed. by F. E. & E. P. Skone James, 1958).

<sup>7</sup> Copyright Commission: *The Royal Commissions and the Report of the Commissioners, 1878* (Cmd. 2036), para. 132, pp. xxii-xxiii; DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 278-79 (1879).

<sup>8</sup> As to the assignment of a previously registered work by entry on the register, see § XIII; regarding transfer of performance rights in dramatic and musical compositions, see § XXII. See also the Schedules to the Act setting forth the forms of requiring entry of proprietorship of copyright; of the original entry on the register; of requiring entry of an assignment of a book previously registered; and of the entry of such an assignment on the register.

fringement, but the practical incentive to do so seems to have been very weak. According to evidence taken before the Royal Commission on Copyright of 1875-78, few books were in fact being registered;<sup>9</sup> and a judge in 1889 said: "It is well known that registration is only necessary as a condition precedent to suing; and the almost universal practice on the part of large publishers notoriously is that they do not register until just on the eve of taking some proceeding: then they take care to register their copyright, and sue upon it" (North, J., in *Cate v. Devon & Exeter Const. News. Co.*, L. R. 40 Ch. Div. 500, 506).

Deposit of printed copies was not organically connected with registration—no printed copy need be submitted to Stationers' Hall at the time of registration. Deposit served only the purpose of enriching libraries.

We have centered attention on the provisions for books of domestic origin because these were the heart of the system, but we should add that—taking 1875 as a midway point to the act of 1911—there was a scattering of other arrangements for other works.<sup>10</sup> For example, registration was not required for an engraving, print, or lithograph, but no action for infringement could be maintained unless the name of the owner and date of publication appeared on the work. For further example, registration of photographs, drawings, and paintings was mandatory in the sense that an action to enforce the copyright must not only have been preceded by registration but could succeed only as to infringements postdating the registration. Registration was not needed to secure performance rights in dramatic works nor to base an action for infringement of those rights.

#### C. THE ACT OF 1911

##### 1. *Royal Commission on Copyright, 1875-78*

This Commission took considerable evidence on the subject of registration, although this was not the most urgent matter that the Commission had to consider. Summarizing the arguments presented for and against registration, the Commission wrote:

136. Those persons who suggest the abolition of registration have argued that it is of no practical utility;—that it cannot, as in the case of shares, ships, or land, be conclusive evidence of title; that it cannot prove that the book registered was written by the person who registers it, or that it is not a piracy;—and that the owner can assert and prove his right quite as well by extrinsic evidence as by means of a registry. Those, on the other hand, who advocate registration, say that it is a useful system, because copyright is a species of incorporeal property, of which some visible evidence of existence is desirable;—that it may on occasions be a matter of public utility to know to whom certain books belong, and that by means of registration the public are enabled to ascertain the fact, and whether copyright in a book does exist. They argue further that another advantage which can and ought to be derived from registration is that the register might be made conclusive evidence of transfer or devolution of title;—and that it might afford to the country a complete list of all literary works brought out in this country. It is also said to be very probable that in the absence of registration English authors might find it difficult to enforce their rights in other countries. It is admitted to be a convenience to an author to be able, under an international convention, to produce as evidence a copy of the register, instead of being obliged to prove by witnesses his authorship and right.<sup>11</sup>

<sup>9</sup> Minutes of the Evidence Taken Before the Royal Commission on Copyright, 1878 (Cmd. 2036-I), Qs 340, 1958-59, 5501-02.

<sup>10</sup> See the summary in DRONE, *op. cit. supra* note 7, at 280-83; and the "Digest of the Law of Copyright" by Sir James Stephen, annexed to Copyright Commission, etc., 1878, *supra* note 7, at p. lxxvii.

<sup>11</sup> Copyright Commission, etc., 1878, *supra* note 7, at p. xxiii. The discussion of "Registration of Copyright and Deposit of Copies" under the general heading "Home Copyright" is at paras. 128-159, pp. xxii-xxvi.

The Commission felt that the arguments in favor of registration preponderated; and it recommended that registration should be made mandatory for books of domestic origin, as it was under existing law for photographs, drawings, and paintings:

154. We therefore recommend that proprietors of copyright should not be entitled to maintain any proceedings in respect of any thing made or done before registration, nor in respect of any dealings subsequent to registration with things so made or done before registration. But as this provision might in some cases operate harshly, we think it should not apply if registration is effected within a limited time, say 1 month, after publication.<sup>12</sup>

It was a significant part of the Commission's plan that "the two acts of registration and deposit of the copy of a book at or for the British Museum should be combined"—thus eliminating the divorcement of deposit from registration which had been a serious administrative weakness of the English system from its beginning.<sup>13</sup>

The recommendations of the Royal Commission proved abortive. A bill introduced in 1879 by the Commission's chairman, Lord Manners, languished and petered out. Lord Monkswell introduced a bill in 1891 and again in 1897 on the lines of the recommendations of the Royal Commission, and the Monkswell bill together with other legislation was considered by a select committee of the Lords in 1898, 1899, and 1900. There is then a lapse of 8 years.<sup>14</sup>

## 2. *Berlin Revision of Berne Convention; the Gorell committee*

In 1908 the Berlin Revision of Berne was promulgated with provisional adherence by Britain. This revision adopted the principle that authors, the subjects of any member nation, must enjoy copyright in other member nations without formality. A Board of Trade committee under Lord Gorell sat in 1909 to consider how far British copyright law must be changed to allow adherence. The committee went perhaps beyond its exact province and, taking little evidence on the question of registration, recommended the abolition of the requirement even as to domestic works. The committee report (Cmd. 4976) says:

On general principles there seems to be no reason why owners of copyright should be required to comply with formalities which are not imposed in most other cases of ownership of personal property. Anyone who copies the products of an author's genius ought to be taken to be doing so at his own risk (p. 12).

After characterizing existing British provisions on registration as "anomalous, uncertain, and productive of great disadvantage and annoyance to authors with little or no advantage to the public," the committee says that systems of registration are "particularly onerous in the case of foreign authors, and if abolished for them should equally be abolished for authors of our own country" (p. 12). Only 1 of the 16 members of the committee dissented from these views, stressing the difference between copyright and ordinary personal property, urging an alleged similarity between copyright and patent, and arguing that registration was needed to "enable the public to know exactly when the property passes into the public domain" (pp. 32-33).

<sup>12</sup> *Id.*, at p. xxvi.

<sup>13</sup> See *id.*, para. 145 ff. The British Museum had expressed itself as opposed to assuming the registration function.

See also the partial dissent of Commissioners Manners, Wolf and Smith, at p. xlv; the separate report of Commissioner Jenkins, at p. lviii; the partial dissent of Commissioner Trollope, at p. lix; and the notes appended to the signature of Commissioner Daldy, at p. lx.

<sup>14</sup> For an examination in detail of the work of the Royal Commission of 1875-78 and following events, see the unpublished paper by Samuel A. Olevson, Harvard Law School class of 1957, "English Experience with Registration and Deposit" (1957), on file in the Harvard Law Library.

*3. Terms of the 1911 Act*

At one stage the Government proposed voluntary registration at Stationers' Hall, a certificate of entry to have prima facie evidential effect, but in the course of the evolution of the 1911 act this proposal was thrown out on the assumption that voluntary registration would be futile. In the end the Copyright Act, 1911 (1 and 2 Geo. V, ch. 46), adopting the principle of a copyright term of life plus 50 years, making other significant changes in copyright law, and bringing most of the law into a single consolidated statute, omitted all provision for copyright registration and copyright notice. Nor did it make any provision for public recordation of transfers of interests in copyright. Deposit, however, was as a general rule required of books published in the United Kingdom: one copy must be deposited by the publisher at the British Museum within a month of publication; and four or five additional copies must be delivered for the use of beneficiary libraries if demanded within 12 months of publication. This duty was sanctioned by fine (§ 15).

## D. THE PRESENT BRITISH ACT

Between 1951 and 1956 British copyright law underwent a thorough-going reexamination and restatement with a view to its general modernization and its accommodation to the Brussels Revision of Berne (1948) and the Universal Copyright Convention. The resumption of registration requirements was not seriously considered, although we do find in the report of the copyright committee, 1951, to the president of the Board of Trade, and by him presented to Parliament in October 1952 (Cmd. 8662), some acknowledgment of the possible values of registration. Speaking of the Berne Convention, the committee says:

\* \* \* The enjoyment of these rights is not subject to formalities, which in administrative practice can result in the erection of obstacles to the establishment and exercise of rights, whose existence is, in principle, not in question. The insistence on the enjoyment of rights without the need to comply with any formalities is not without its difficulties, although we accept that these difficulties are of minor significance compared with the importance of the principle itself. A formality such, for example, as the registration of a work, would in some instances provide valuable information as to the origin and continuance of a right. But the Berne Union proceeds on the assumption that the right subsists without formalities \* \* \* (p. 2).

Plainly the committee did not seriously envisage the possibility of marking a difference between domestic and foreign works, requiring formalities for the former but not for the latter; or of encouraging the accomplishment of formalities without requiring it.

The present Copyright Act, 1956 (4 and 5 Eliz. II, ch. 74), like its predecessor, the act of 1911, contains no provisions for registration of copyright or recordation of transfers of interest in copyright. The provisions for deposit of books contained in the 1911 act were not repealed, and continue in force (see also Cmd. 8662, pp. 22-29, and British Museum Act, 1932, 22 and 23 Geo. V, ch. 34).

## E. COMMENT ON THE BRITISH DEVELOPMENT

Early hostility of British publishers to the deposit requirements infected their attitude toward registration: they sought to "elude" deposit by avoiding registration. A mighty blow was struck against

registration by the decision of *Beckford v. Hood* in 1798, which reduced registration to the level of a technical prerequisite to suit for statutory penalties, perhaps the least of the legal sanctions against piracy. The publishers did not succeed in ridding themselves of deposit, but registration never flourished as an effective general procedure. In the mid-1800's registration became a technical antecedent to any suit for infringement. Drone's view that the utility of this arrangement "is not apparent"<sup>15</sup> seems to have been shared by the British. Certainly publishers in large numbers did not consider the benefits of registration sufficiently large to make compliance worthwhile otherwise than for purposes of suit. The proposal of the Royal Commission of the 1870's to tighten registration was not strenuously pushed, and by the 1900's the "Berne influence" not only opposed itself to a strengthening of registration but worked toward its complete elimination.

The British have never had a strong public registration system. This certainly suggests that an effective copyright law does not stand or fall on public registration. At the same time it must be acknowledged that the doubts of the values of a registration system sometimes voiced by British specialists are not based on any intimate experience with such a system.<sup>16</sup>

## II. U.S. EXPERIENCE: PERSISTENCE OF REGISTRATION AND OTHER FORMALITIES

### A. FROM THE FIRST NATIONAL ACT (1790) TO THE RULE OF WHEATON V. PETERS (1834)

#### 1. Acts of 1790 and 1802

We pass over early State legislation<sup>17</sup> and come to the act of 1790 (1 Stat. 124; 1st Cong., 2d Sess., c. 15). "[T]he sole right and liberty of printing," etc., maps, charts and books was given to the "author and authors" and their representatives for a term of 14 years "from the recording the title thereof in the clerk's office \* \* \*" (§ 1).<sup>18</sup> Section 3 stated that "no person shall be entitled to the benefit of this act" unless he registered; and this process was to consist of lodging a printed copy of the title of the work, prior to publication, in the clerk's office of the district court where the author or proprietor resided. The clerk on payment of a fee was to record the title in prescribed words<sup>19</sup> in a record book. (§ 3) Within 2 months the author or proprietor was to cause a copy of this record "to be published in one or more of the newspapers printed in the United States, for the space of four weeks." (§ 3) Finally he was to deliver a copy of the work, within 6 months of publication, to the Secretary of State. (§ 4) A renewal term of 14 years was granted if the author was alive at the

<sup>15</sup> DRONE, *op. cit. supra* note 7, at p. 278.

<sup>16</sup> See Barker, *Books for All: A Study of International Book Trade* 49-50 (UNESCO 1956). The Registered Designs Act, 1949, 12, 13 & 14 Geo. VI, c. 88, contains elaborate provisions on registration, but it proceeds on a patent rather than a copyright principle. See also the Copyright Act, 1956, § 10 and First Schedule; Report of the Copyright Committee, 1951 (Cmd. 8682), p. 82 ff.

<sup>17</sup> This legislation is collected in Copyright Laws of the United States of America, 1783-1957 issued by the Copyright Office in 1957, at pp. 1-21.

<sup>18</sup> For the provision for works already printed, see § 1.

<sup>19</sup> The prescribed words of entry were:

"District of ..... to wit: *Be it remembered*, that on the ..... day of ..... in the ..... year of the independence of the United States of America, A. B. of the said district, hath deposited in this office the title of a map, chart, book or books, (as the case may be) the right whereof he claims as author or proprietor, (as the case may be) in the words following, to wit: [here insert the title] in conformity to the act of the Congress of the United States, intitled 'An act for the encouragement of learning, by securing the copies of maps, charts, and books, to the authors and proprietors of such copies, during the times therein mentioned.' C. D. clerk of the district ..... (§ 3).

expiration of the first term, "provided" the title was again recorded and the record published in newspapers within the last 6 months of the first term. (§ 1) Infringing copies were to be forfeited to the author or proprietor, who was to destroy the same; and the act gave him a penalty action for 50 cents per offending sheet, of which one-half was to go to him as successful plaintiff and one-half to the United States.

The act of 1802 (2 Stat. 171; 7th Cong., 1st Sess., c. 36), stated to be "supplementary" to the act of 1790, provided that any author or proprietor seeking to obtain copyright—

before he shall be entitled to the benefit of the act [of 1790], \* \* \* shall, in addition to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information by causing the copy of the record, which, by said act he is required to publish in one or more of the newspapers, to be inserted at full length in the title-page or in the page immediately following the title \* \* \*; and if a map or chart, shall cause the following words<sup>20</sup> to be impressed on the face thereof, \* \* \* (§ 1)

(The act extended protection to certain prints, §§ 2,3.)

Thus by 1802 the American copyright system envisaged registration (i.e. recording of title in the clerk's office), imprinted notice, published announcement, and deposit of a copy of the work in a public place.

## 2. *The Wheaton case (1834): formalities held conditions of copyright*

The great case of *Wheaton v. Peters*, 8 Pet. 591 (1834), raised the question whether an action for general relief—not an action for penalties—could be maintained during the statutory term of copyright where the formalities of registration and imprinted notice had been complied with, but the proprietor had omitted to publish in newspapers and to deposit with the Secretary of State.<sup>21</sup> This was a narrow question which could have been decided in the plaintiff's favor (i) by applying the principle of *Beckford v. Hood* that compliance with formalities was only a condition of maintaining a suit for statutory penalties,<sup>22</sup> or (ii) by distinguishing registration and imprinted notice from the two other, seemingly less important formalities, and holding only the former to be prerequisites of investing and maintaining copyright and bringing an action for general relief. Mr. Justice McLean's opinion for the majority, however, insisted that all the four formalities of the statutes were of equal importance and that compliance with all was essential to maintain copyright.

The opinion was animated by general views about the nature of copyright. The arguments of distinguished counsel also took a wide reach. Mr. Justice McLean in effect reargues *Donaldson v. Becket*, questioning the correctness of the Second Resolution of that case, which found that there was a pre-Statute of Anne, common-law,

<sup>20</sup> These words were: "Entered according to act of Congress, the ..... day of ..... 18 .. (here insert the date when the same was deposited in the office) by A.B. of the State of (here insert the author's or proprietor's name and the State in which he resides)." (§ 1.)

<sup>21</sup> The Supreme Court's mandate in the *Wheaton* case required the Circuit Court to order an issue of fact to be tried by jury on whether *Wheaton*, as author, or any other person as proprietor, had complied with the third and fourth sections of the Act of 1790, more particularly whether there had been publication in newspapers and delivery of a copy to the Secretary of State. 8 Pet. at 698-99.

<sup>22</sup> Mr. Justice McLean attacks the decision in *Beckford v. Hood* by referring (8 Pet. at 666) to the remarks of Lord Chancellor Hardwicke in *Blackwell v. Harper*, 2 Atk. 93, 95, 26 Eng. Rep. 458, 459 (1740), discussing the registration provisions of the Statute of Anne. It is, however, fairly clear that the report in 2 Atkyns is garbled. See *Blackwell v. Harper*, *Barnardiston* Ch. 210, 212, 27 Eng. Rep. 616, 617; and *DRONE*, *op. cit.* *supra* note 7, at 273 n. 2.

The Justice refers briefly and inadequately to the English law on the formalities then provided for copy-righting engravings, and concludes that "it is believed that no settled construction has been given to any British statute, in all respects similar to those under consideration, which is at variance with the one now given. If, however, such an instance could be found, it would not lessen the confidence we feel in the correctness of the view which we have taken." (8 Pet. at 667).

“perpetual” proprietary right after publication. Then, assuming *arguendo* the correctness of that resolution as a statement of English law, the opinion inquires whether a like common-law right was recognized in Pennsylvania, the *locus in quo*, and concludes that it was not. (The opinion denies the existence of a national common law.) Having thus disposed of the contention that there was a common-law right “accumulative” to the statutory right, the *Wheaton* opinion bears down on the precise wording of the statutes. While perhaps not hostile to copyright as such, the majority certainly view copyright of published works as a legislative grant, not a “natural” right—from which the majority apparently feel that it follows as a kind of corollary that all statutory requirements must be meticulously complied with. It is perhaps a curiosity of the majority opinion that it does not deny that where copyright was properly secured under the statutes in compliance with prescribed formalities, a common-law remedy for infringement might be given during the statutory period, i.e. a remedy beyond and apart from the actions for forfeitures and penalties given by the statutes. Yet if copyright in published works was purely statutory, is there not some difficulty in finding a basis for an infringement action for damages or an injunction? <sup>23</sup>

*Wheaton v. Peters* has an importance far beyond its strict holding. It is poles apart from the British attitude toward formalities. It set the tone of American legislation and decision for about a hundred years: compliance with formalities continued—and to some extent still continues—to be taken as prerequisite to copyright in published works.<sup>24</sup>

#### B. LEGISLATION 1831-1867

##### 1. Summary

In this period, the requirement of prepublication registration with the clerk of court was continued, as was the requirement of imprinted notice. Post-publication deposit at the clerk's office of a copy of the work (for transmission to the State, later the Interior Department) was also continued as a requirement. In addition, post-publication deposit at the Library of Congress was called for; this was not a condition of copyright, but it was enforceable by a demand of the Librarian; upon refusal of the demand, copyright was forfeited. Publication in newspapers was abandoned so far as initial securing of copyright was concerned; but newspaper publication as well as a repetition of other formalities were required for renewal of copyright. Recordation of assignments was inaugurated. The Interior Department was substituted for the State Department in the statutory scheme, with some centralization of record-keeping.

##### 2. The legislation in detail

An act of 1831 (4 Stat. 436; 21st Cong., 2d Sess., c. 16) repealed the acts of 1790 and 1802 and restated the law. It extended copyright to musical compositions and somewhat recast the formalities for all copyrightable works. The initial term, now 28 years, was still to be measured from the time of registering the title in the office of the clerk of the district court prior to publication. (§§ 1, 4) The pro-

<sup>23</sup> This point is raised by Thompson, J. in his dissenting opinion. Baldwin, J. also dissented.

<sup>24</sup> That compliance with various formalities was a condition of copyright under all the American statutes preceding the Act of 1909 was firmly stated by Black, J. dissenting in *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30, 42 (1939). This point was not disputed in the majority opinion, which argued that the principle had been modified in certain respects by the 1909 legislation.

cedures for lodging the printed copy of the title of the work and the entry thereof in the record book were about the same as before. (§ 4) Deposit of a copy of the work was now to be made with the clerk within 3 months after publication (§ 4), and he was in turn to transmit copies so deposited with him, together with certified copies of his records, at least once yearly to the Secretary of State, to be preserved in the latter's office. (§ 4) "Information of copyright" was still required to be given by notice<sup>25</sup> imprinted on all copies of a work published and distributed. (§ 5) A renewal term of 14 years was given not only if the author was alive at the expiration of the first term but also if a widow or a child survived to that date, provided the formalities prescribed for initial copyright were again carried out during the 6 preceding months. (§ 2) There was no requirement of publishing in newspapers upon initial copyright, but newspaper publication was required in connection with renewal. (§ 3)

In 1834 it was enacted (4 Stat. 728; 23d Cong., 1st Sess., c. 157) that deeds "for the transfer or assignment of copyrights" might be recorded in the clerk's office, and that deeds not so recorded within 60 days of their execution should be void against subsequent purchasers and mortgagees for value without notice. An act of 1846 (9 Stat. 106; 29th Cong., 1st Sess., c. 178, § 10) added the requirement that within 3 months of publication a copy of each copyrighted work be delivered to the Smithsonian Institution, and another copy to the Library of Congress, "for the use of said libraries." In 1855 Congress inaugurated the policy of free mailing for such copies. (10 Stat. 685; 33d Cong., 2d Sess., c. 201, § 5.) By an act of 1856 (11 Stat. 138; 34th Cong., 1st Sess., c. 169), the copyright of dramatic compositions (as books) was to comprehend exclusive performance rights "on any stage or public place"; but formal requirements for obtaining copyright of such works were not affected. In 1859 the records and copies of works theretofore deposited in the Department of State were ordered removed to the Interior Department, which assumed the duties previously cast on State. (11 Stat. 380; 35th Cong., 2d Sess., c. 22, § 8.) An act of 1865 (13 Stat. 540; 38th Cong., 2d Sess., c. 126) extended copyright to photographs (§ 1); and with respect to all works "for which a copyright shall be secured under said acts" continued the requirement of deposit of one printed copy at the Library of Congress: the time for this deposit was now 1 month following publication. (§ 2.) If a proprietor omitted to make this deposit, the Librarian was obliged to demand it within 12 months of publication, and upon continued failure to deliver for 1 month, "the right of exclusive publication secured to such proprietor under the acts of Congress respecting copyright shall be forfeited." (§ 3.) This made clear what had already been decided under the act of 1846,<sup>26</sup> that deposit at the Library was not a condition of securing copyright; failure to make such deposit could however result in a forfeiture of the copyright previously secured. Herein deposit at the Library differed from the other three formalities on initial copyright—registration, deposit of a copy of the work with the clerk of court, and imprinted notice on the work, all essential to securing copyright.<sup>27</sup> The

<sup>25</sup> The notice was as follows: "Entered according to the act of Congress, in the year ....., by A. B., in the clerk's office of the district court of ....., (as the case may be)." (§ 5)

<sup>26</sup> *Jolie v. Jaques*, 1 Blatch. 618, 13 Fed. Cas. 910, No. 7,437 (C.C.S.D.N.Y. 1850).

<sup>27</sup> See the discussion in *DRONE*, *op. cit. supra* note 7, at 262 ff.

same act of 1865 construing the word "book" provided that only such subsequent editions as contained additional matter need be deposited at the Library; nor need any book "not the subject of copyright" be thus deposited. (§ 4.) An act of 1867 (14 Stat. 395; 39th Cong., 2d Sess., c. 43) gave the Librarian a penalty action against the proprietor of any copyrighted work who failed to make the deposit at the Library within 1 month of publication.

#### C. LEGISLATION 1870-1905

##### 1. Summary

Early in this period, the clerks of court were displaced as agencies of registration and deposit. Administration of the copyright system was centralized in the Librarian of Congress; the Library became the sole place of registry and the sole place of deposit. Official publication of copyright entries was required by legislation of 1891. In 1897 the office of the Register of Copyrights was created within the Library of Congress. By the end of this period, registration of the title and deposit of two copies of copyrighted works were required to be accomplished in the typical case on or before the day of publication. The device of compelling deposit for the benefit of the Library by demand, with forfeiture of copyright for refusal of the demand, was abandoned, for deposit, now to be made only at the Library, was a condition of securing copyright. The notice requirement was continued. Renewal of copyright still required a repetition of formalities, and in addition publication in newspapers. New formalities were prescribed in connection with certain foreign works to which copyright was extended. Recordation of assignments was continued.

##### 2. The legislation in detail

Legislation of 1870 (16 Stat. 212; 41st Cong., 2d Sess., c. 230, §§ 85-111) transferred records and responsibility from the clerks of court and the Interior Department to the Librarian of Congress. (§§ 85, 109-110.) A major part of the 1870 legislation was amalgamated into the Revised Statutes, 1873, the relevant provisions of which may be summarized as follows:

Section 4952 of the Revised Statutes extended copyright to an enlarged group of works. Copyright included the privilege of reserving dramatization and translation rights in works amenable to such transformation, and in the case of dramatic compositions was to comprise the right of public performance (§ 4952).<sup>28</sup> The original term of copyright ran for 28 years from the time of registration (§ 4953), which was to be accomplished by delivering to the Librarian, before publication, a printed copy of the title of the work (or in certain cases a description of the work) (§ 4956). Further, two copies of the work (or in some cases a prescribed substitute) must be deposited at the Library within 10 days from publication (§ 4956). The Librarian was to record the name of the author and other details in a record book (§ 4957).<sup>29</sup> The requirements of both registration and deposit

<sup>28</sup> The language of Rev. Stat. § 4952 regarding "reservation" of dramatization and translation rights was eliminated in the 1891 amendments of the Revised Statutes, 26 Stat. 1106. As amended, the section stated that authors should have the "exclusive right" to dramatize and translate.

<sup>29</sup> The entry was to be as follows: "Library of Congress, to wit: Be it remembered that on the ----- day of -----, A. B., of -----, hath deposited in this office the title of a book, (map, chart, or otherwise, as the case may be, or description of the article,) the title or description of which is in the following words, to wit: (here insert the title or description,) the right whereof he claims as author, (originator, or proprietor, as the case may be,) in conformity with the laws of the United States respecting copyrights. C. D., Librarian of Congress." (§ 4957)

were clearly expressed as conditions of securing copyright § (4956). Section 4959 restated the section 4956 requirement of post-publication deposit as a duty of the proprietor, and added a duty of depositing "every subsequent edition wherein any substantial changes shall be made." Section 4960 gave a penalty action to the Librarian for a failure to comply with section 4956 or 4959. A notice requirement was continued by section 4962: "No person shall maintain an action for the infringement of his copyright" unless he gave notice thereof "by inserting [a prescribed legend]<sup>30</sup> in the several copies of every edition published, on the title page or the page immediately following" (or in a variant way in the case of certain works). Although section 4962 thus spoke of notice as a prerequisite of maintaining an action, it appeared to operate as a condition of copyright, for the right to sue apparently depended on imprinting the notice of the first copies published. A renewal term of 14 years was given to the author alive at the expiration of the initial term, or if the author was dead then to his surviving widow or children, upon registering the title a second time "and complying with all other regulations in regard to original copyrights" within 6 months before such expiration and causing a copy of the record to be published in a newspaper for 4 weeks within 2 months of the date of renewal (§ 4954).

Copyright was stated to be assignable by instrument in writing, "and such assignment shall be recorded in the office of the Librarian of Congress within 60 days after its execution," otherwise it was void against a subsequent purchaser or mortgagee for value without notice (§ 4955).

The actions which could be maintained by a proprietor of a copyrighted work in case of infringement were spelled out in some detail (§§ 4964-4966).

Fees for recording, giving certified copies of entries, etc., were restated and the Librarian was charged with making an annual report to Congress of copyright entries (§§ 4958, 4951).

An act of 1874 (18 Stat. 78; 43d Cong., 1st Sess., c. 301) dealt with the form of the prescribed notice (§ 1).<sup>31</sup> It also vested administration of the copyrighting of commercial prints and labels in the Patent Office (§ 3). The notice for articles of pottery and the like was dealt with in an act of 1882 (22 Stat. 181; 47th Cong., 1st Sess., c. 366).

The act of 1891 (26 Stat. 1106; 51st Cong., 2d Sess., c. 565) was primarily designed to extend copyright protection to foreigners (§ 13). A "manufacturing clause" with attendant formalities here made its appearance (§ 3, amending Rev. Stat. § 4956). For purposes of policing imports and foreign mail, the act provided for transmittal of copyright information to the Treasury Department; it further directed the printing and distribution of catalogs by Treasury (§ 4, amending Rev. Stat. § 4958). There were two significant general changes of the law: (i) registration (i.e., delivery of the printed title or description of the work to the Librarian) must take place "on or before the day of publication in this or any foreign country"; (ii) deposit (delivery to the Librarian of the two copies of the work or substitute) must take place

<sup>30</sup> The notice was as follows: "Entered according to act of Congress, in the year ....., by A. B., in the office of the Librarian of Congress, at Washington." (§ 4962)

<sup>31</sup> The permitted forms were: "Entered according to act of Congress, in the year ....., by A. B., in the office of the Librarian of Congress, at Washington;" or, at his option, the word 'Copyright,' together with the year the copyright was entered, and the name of the party by whom it was taken out; thus — 'Copyright, 18...., by A. B.'" (§ 1)

“not later than the day of publication thereof in this or any foreign country” (§ 3, amending Rev. Stat. § 4956).

To relieve against loss of copyright occasioned by late deposit of works, an act of March 3, 1893 (27 Stat. 743; 52d Cong., 2d Sess., c. 215) restored rights if deposit, although tardy, had been accomplished before March 1, 1893. Here is an indication that stiff formal requirements were causing trouble.

In 1897, civil remedies and criminal penalties for unlawful public performance of dramatic and musical compositions were laid down (29 Stat. 481; 54th Cong., 2d Sess., c. 4, amending Rev. Stat. § 4966); but there was no change of formalities in regard to these works. In the same year the office of the Register of Copyrights was created (29 Stat. 545; 54th Cong., 2d Sess., c. 265, “Copyright Department”). By an act of 1904 (33 Stat. 4; 58th Cong., 2d Sess., c. 2) a kind of ad interim protection was accorded to works intended for exhibition at the Louisiana Purchase Exposition which had been previously published abroad “but not registered for copyright protection in the U.S. copyright office”: upon complying with special formalities the proprietor would secure American protection for 2 years; and he might thereafter on certain conditions obtain extended protection. A statute of 1905 (33 Stat. 1000; 58th Cong., 3d Sess., c. 1432, amending Rev. Stat. § 4952) provided special formalities by which American copyright could be secured for books first published abroad.

#### D. THE ACT OF 1909

##### 1. *Dissatisfaction with the pre-1909 scheme; the logic of the 1909 revision*

After more than a century of national regulation of copyright, the old pattern was unbroken: securing copyright depended on compliance, and exact compliance, with formalities—notice, registration, and deposit. But whereas some space of time after publication had been allowed in the legislation up to 1891 for accomplishing the last formality of deposit, this grace period had now been eliminated. Not only was it fatal to commence publication without notice; both registration and deposit must be accomplished by the date of publication.

In his report to the Librarian of Congress of December 1, 1903, the Register of Copyrights, Mr. Thorvald Solberg, left no doubt of his dislike of this scheme, which could punish trifling omissions with loss of substantial rights. Mr. Solberg said:

\* \* \* [A] system has gradually grown up under which valuable literary rights have come to depend upon exact compliance with these statutory formalities which have no relation to the equitable rights involved, and the question may very well be raised whether this condition should be continued. \* \* \*

Mr. Solberg became the leading spirit in the attempt to rationalize the formalities; many felt as he did, but perhaps none as keenly.

The history of the 1909 revision will not be detailed here. By way of rough summary of the views held during the period of revision, we may say: Continuance of a notice requirement, to serve the purpose of warning copyists, was pretty well assumed. Registration, in the sense of a public record of basic information furnished by the applicant more or less in conjunction with deposit, was generally although not universally thought to be advisable and important. The minutes of

<sup>22</sup> *Report on Copyright Legislation by the Register of Copyrights* (1904), at p. 25.

the Conference of 1905 and 1906 indeed contain a rather full statement of the advantages that can be claimed for a system of registration.<sup>33</sup> Recordation of assignments was also apparently assumed to be valuable. Most important, there was general agreement with Mr. Solberg's view that formalities should in some way be softened to avoid unintended loss of rights.

Any critical examination of the copyright scheme just prior to 1909 must point to the elimination of a requirement of newspaper publication (an incident of securing renewal, but not original copyright). This was abandoned in the 1909 act. Nor could much sense be made of the separation of the requirement of delivering a copy of the title of a work from the requirement of delivering copies of the work itself, especially as both operations came to rest in the same place, the Copyright Office. Mr. Solberg's 1903 report had spoken convincingly to this point.<sup>34</sup> The 1909 act correlated the application for registration with the deposit of copies, although not with perfect clarity. The further question was when deposit (to which the application for registration would be ancillary) was to be carried out. Some leeway, it was thought, should be allowed for completion of this process following publication of the work. At one stage it was proposed that a definite time, following publication, be set within which deposit should be accomplished. This was supplanted by the idea of a looser post-publication period: hence the words "promptly deposited" appearing in section 13<sup>35</sup> of the act.

If deposit with accompanying registration could be deferred for some indeterminate time after publication, the start of a term of copyright protection for published works, especially a term measured by a period in gross, would naturally be the date of publication. And if a notice requirement was to be continued, then it was plausible to provide that copyright should be invested upon publication with notice (even though this recreated the old danger of unintended forfeiture by publication without notice). The legislation followed this line in section 10.

If deposit-registration was not to be a condition of investing copyright, the question still remained as to how this requirement should be otherwise policed. In an early bill setting a specific period of time following publication for accomplishing the formality, it was provided that after expiration of the period no action could be brought for infringement of a work until deposited and registered, and failure to make deposit on the Register's demand was punished by fine.<sup>36</sup> There was no suggestion here that a copyright could be irrevocably lost for failure to deposit or register. In a later bill calling for "prompt" deposit the no-action provision was continued and, further, failure to

<sup>33</sup> References were made to registration as an aid to the protection of unpublished works, as a means of determining date of publication and copyright term, as protection against "innocent" infringement, as a way of tracing title, as a means of proof through a *prima facie* provision, as contributing to the creation of a place of record where the public could go for information.

<sup>34</sup> Report, *supra* note 32, at 30-31. Mr. Solberg notes that many titles were filed in advance of publication and, further, that many titles were filed "which are not the titles of works printed or even written, but merely contemplated works, many of which are never produced." The latter practice was of course an abuse. But it appears that prepublication filing of the title was in some cases resorted to in a rather vague effort to fortify the protection of works "produced" but unpublished in the sense of being in unprinted manuscript—*e.g.* dramatic works. Section 12 of the present act arose in part at least as a means of meeting this problem of securing better protection of unpublished works.

<sup>35</sup> Here, and hereafter, in referring to sections of the 1909 act we use for convenience, unless otherwise noted, the parallel Section of the present Act. Thus the Section 13 referred to in the text was Section 12 of the 1909 Act.

<sup>36</sup> S. 6330, H. R. 19853, May 31, 1906, 59th Cong., 1st Sess.

comply with the Register's demand worked a loss of copyright.<sup>37</sup> But the relevant House report stated: "Not until he [the proprietor] has intentionally declined to deposit in compliance with this written demand is his copyright forfeited."<sup>38</sup> The final text of the act of 1909 combines the no-action provision with a provision for loss of copyright and a fine in case of failure to deposit after Register's demand (§§ 13, 14). Infelicities of drafting as well as a dubious statement in the House and Senate reports<sup>39</sup> on the final bill gave rise to the question whether late deposit could in itself, apart from refusal to comply with the Register's demand, in effect void a copyright previously invested through publication with notice by rendering the copyright entirely nonactionable (or impair the copyright to the extent of preventing suits for infringement antedating the late deposit). This was the question in *Washingtonian Pub. Co. v. Pearson*, 306 U.S. 30 (1939), analyzed below. The decision favorable to the copyright seems to derive some support from an understanding examination of the evolution of the act of 1909.

## 2. Terms of the 1909 act

The 1909 act restated the subjects of copyright and the scope of protection accorded to them.<sup>40</sup> The manner of securing copyright for a published work was described thus: "Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; \* \* \*" (§ 10). With respect to deposit of copies of works copyrighted under section 10, the act said: "After copyright has been secured by publication of the work with the notice of copyright \* \* \*, there shall be promptly deposited in the copyright office \* \* \*, two complete copies of the best edition thereof then published, \* \* \*" (§ 13)<sup>41</sup> (which copies must in certain cases comply with the provisions for domestic manufacture and be accompanied by an affidavit attesting to such manufacture, §§ 13, 16, 17).<sup>42</sup> As to registration: "Such person" (referring somewhat ambiguously to section 10) "may obtain registration of his claim to copyright by complying with the provisions of this title, including the deposit of copies, and upon such compliance the Register of Copyrights shall issue to him the certificates provided for in section 209 of this title" (§ 11). A "claim of copyright" (in practice an application for registration) is to accompany the deposit (§ 13). "[W]henver deposit has been made in the copyright office of a copy of any work under the provisions of this title he [the Register] shall make entry thereof" (§ 208), and "In the case of each entry the person recorded as the claimant \* \* \* shall be entitled to a certificate of registration \* \* \*" (§ 209).

The application for registration must specify the "class" in which the work belongs (§ 5), but further details of the application were not prescribed; rather the Register, subject to the approval of the Librarian, was authorized "to make rules and regulations for the regis-

<sup>37</sup> S. 8190, H.R. 25133, January 29, 1907, 59th Cong., 2d Sess.

<sup>38</sup> H. R. REP. NO. 7083, January 30, 1907, to accompany H. R. 25133, p. 8.

<sup>39</sup> H. R. REP. NO. 2222, February 22, 1909, 60th Cong., 2d Sess., to accompany H. R. 28192, which is the same as S. REP. NO. 1108, March 1, 1909, 60th Cong., 2d Sess., to accompany the companion bill, S. 9440. The statement referred to is the one which speaks of formalities other than notice as "conditions subsequent" (see *infra*, discussion of Black, J.'s dissent in the *Washington* case).

<sup>40</sup> See especially § 1 (exclusive rights as to copyrighted works); § 5 (classification of works for registration).

<sup>41</sup> If the work was a contribution to a periodical for which special registration was requested, one copy of the pertinent issue could be deposited. § 12 of the 1909 act (prior to amendment).

<sup>42</sup> See also § 18 (making false affidavit).

tration of claims to copyright as provided by this title" (§ 207). However, the content of a certificate of registration was prescribed (§ 209),<sup>43</sup> casting a kind of backward light on what the application would have to contain. A certificate similar to that issued to the copyright claimant must apparently be given to any person applying for the same. (§ 209) "Said certificate shall be admitted in any court as prima facie evidence of the facts stated therein" (§ 209). This last was a new provision.

Policing of the deposit registration system was expressly treated in two places. "No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with" (§ 13). And "should the copies called for by section 13 of this title not be promptly deposited as provided in this title," the Register might at any time after publication of the work, upon actual notice, make demand on the proprietor to deposit them; in default whereof for stated times<sup>44</sup> the proprietor became liable to a fine of \$100 and to pay twice the retail price of the work, and the copyright became void (§ 14).

Notice must be affixed, in prescribed forms and places,<sup>45</sup> to each copy of a work published or offered for sale in the United States (§§ 10, 19, 20).<sup>46</sup> An ameliorating provision dealt with "the omission by accident or mistake of the prescribed notice from a particular copy or copies \* \* \*" (§ 21).

Renewal for a second term of 28 years after expiration of an initial term of the same duration could be had if application for renewal was made and registered in the Copyright Office within 1 year prior to the expiration of the first term. The persons entitled to this renewal were "the author of such work, if still living," otherwise named persons in a stated order of precedency. It was expressly provided that "in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of 28 years from first publication" (§ 24).

Such was the basic scheme of formalities applicable to American and qualified foreign authors and proprietors (§ 9).<sup>47</sup> It remains to note that there was an ad interim provision with certain special formalities for books published abroad in the English language before publication in this country (§§ 22, 23); and special formalities also applied to a compulsory license for issuance of phonograph records of copyrighted musical compositions (§§ 1(e), 101(e)).<sup>48</sup>

With respect to unpublished works, there was first a section saving the common-law rights of authors and proprietors (§ 2), and then a

<sup>43</sup> As to the present content of certificates of registration, see *infra* Part III, B.

<sup>44</sup> The period for deposit after demand is three months "from any part of the United States, except outlying territorial possessions of the United States," and six months from such a possession or from any foreign country. (§ 14)

<sup>45</sup> The notice was to consist of the word "Copyright" or the abbreviation "Copr." accompanied by the name of the copyright proprietor and if the work was a printed literary, musical or dramatic work the notice was to include the year in which copyright was secured by publication. For the classes of maps, works of art, drawings, photographs and prints (§ 5(l)-(k)) the notice might consist of a C-in-a-circle accompanied by the initials, etc. of the copyright proprietor; but the name must appear on "some accessible portion" of copies of such works or on the margin, back, etc. § 18 of the 1909 Act. (prior to amendment).

<sup>46</sup> See also § 105 (fraudulent notice of copyright); § 106 (importation of article bearing false notice).

<sup>47</sup> Compare, however, article 3 of the Buenos Aires Convention, August 11, 1910, ratified March 12, 1911, proclaimed July 13, 1914: "The acknowledgement of a copyright obtained in one State, in conformity with its laws, shall produce its effects of full right in all other States without the necessity of complying with any other formality, provided always there shall appear in the work a statement that indicates the reservation of the property right." See also Universal Copyright Convention, article XVIII, and remarks by Kaminstein in *UNIVERSAL COPYRIGHT CONVENTION ANALYZED* 37-38 (Kupferman & Foner ed. 1955).

<sup>48</sup> This paper touches only incidentally upon these two sets of formalities; nor do we deal with the filing under section 109.

new section, considered to be optional, for securing statutory copyright of certain of such works, i.e. lectures, dramatic or musical compositions, photographs or works of art or plastic works or drawings, by depositing a copy<sup>49</sup> with claim of copyright (§ 12). But in case of later publication sections 13 and 14 must be complied with (§ 12).

As to disposal of copies deposited under the act, the Librarian was to determine which copies should be transferred to the permanent collections of the Library of Congress, or placed in the reserve Library collections for sale or exchange, or transferred to other governmental libraries in the District of Columbia (§ 213). Copies not thus disposed of, "together with all titles and correspondence relating thereto," might be periodically destroyed upon joint determination of the Librarian and the Register, unless reclaimed by interested parties after public notice of the decision to destroy; but copies of unpublished works could not be destroyed during their term of copyright without specific notice to the proprietor of record of his right to reclaim (§ 214).

Copyright might be "assigned, granted, or mortgaged" by instrument in writing, or bequeathed by will (§ 28; see § 29). Every assignment must be recorded in the Copyright Office within 3 or 6 months (depending on the place of execution), "in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose assignment has been duly recorded" (§ 30). The Register was directed to record assignments and issue certificates thereof (§ 31). When an assignment was recorded the assignee might substitute his name for that of the assignor in the notice of copyright (§ 32).

The Register was to keep "such record books \* \* \* as are required to carry out the provisions of this title, \* \* \*" (§ 208). He was to index all copyright registrations and assignments and print catalogs of the titles of works deposited and registered, with suitable indexes, and at stated intervals he was to print complete and indexed catalogs for each class of copyright entries and thereupon, if expedient, destroy the original cards (§ 210). "The current catalog of copyright entries and the index volumes herein provided for"—like certificates of registration—"shall be admitted in any court as prima facie evidence of the facts stated therein as regards any copyright registration" (§ 210).

The printed current catalogs as issued were to be made available for public sale and to be distributed to collectors of customs and postmasters dealing with foreign mail (§ 211) in order to assist in carrying out the import limitations of the act (§§ 106, 107, 108, 109). The Copyright Office record books and indexes and the works deposited and retained in the Copyright Office were to be open to public inspection, and copies might be taken of the copyright entries in such books, subject to regulations (§ 212).

Finally there were detailed provisions on fees to be charged by the Register, including the charge for "any requested search of copyright office records, indexes or deposits" (§ 215).

<sup>49</sup> As originally enacted, section 12 called for the deposit of one complete copy of the work if it was a lecture or similar production or a dramatic or musical composition; of a print if the work was a photograph; of a photograph or other identifying reproduction if it was a work of art or a plastic work or drawing.

### 3. *Minor amendments of the 1909 act, 1912-26*

Congress made no vital changes of the statute law regarding formalities prior to the landmark decision of the *Washingtonian* case in 1939. An act of 1912 (37 Stat. 488; 62d Cong., 2d Sess., c. 356) added motion pictures to the "classes" of copyright works in section 5 and correspondingly amended section 12 to specify what must be deposited to secure their copyright as unpublished works.<sup>50</sup> Section 209 was amended in 1913 (37 Stat. 724; 62d Cong., 3d Sess., c. 97) to provide for certain additions to the content of the certificate of registration. An act of 1914 (38 Stat. 311; 63d Cong., 2d Sess., c. 47) amended section 13 to specify the deposit requirement for a work by a foreigner published in a foreign country.<sup>51</sup> The ad interim provision of section 22 was altered somewhat in 1919 (41 Stat. 368; 66th Cong., 2d Sess., c. 11), and the manufacturing provisions of section 16 were changed in a minor respect in 1926 (44 Stat. 818; 69th Cong., 1st Sess., c. 743). Various changes of the fees chargeable by the Register were made in 1928 (45 Stat. 713; 70th Cong., 1st Sess., c. 704).

#### E. THE WASHINGTONIAN CASE (1939)

##### 1. *Cases foreshadowing Washingtonian*

Not until the Supreme Court's 1939 decision did it become clear just how far the 1909 act had broken with historic American policy; for until that time it remained at least arguable that prompt deposit remained a true condition, although a condition subsequent, of securing copyright. A few lower court cases, however, had skirted the problem.

In *Lumiere v. Pathe Exchange, Inc.*, 275 Fed. 428 (2d Cir. 1921), the plaintiff published photographs with proper notice of copyright in June 1918. Infringement occurred in April 1919. In August 1919 plaintiff made deposit and applied for and secured a registration certificate but the application and certificate were for an unpublished copyright under section 12. Then he brought suit. Applying the "no action" clause of section 13 the court dismissed the action, for that clause looks to accomplishment of both deposit and registration before action is brought, and here registration had not been truly accomplished because the application and certificate were not of the proper type. But the dismissal was without prejudice, even though it was assumed that the requirement of prompt deposit had not been complied with. "The plaintiff's copyright was established by the publication with notice of copyright as against the world \* \* \* and could not be declared void because not 'promptly' followed by deposit of copies as required by the act except by action of the Register of Copyrights under section [14], which was not taken" (p. 430). Judge Hough agreed with the opinion, but stated that he did not wish to be concluded on the question whether in the circumstances the plaintiff should not be relegated to law, and the further question whether in any form of action the plaintiff could recover for infringements committed before he had both deposited the requisite number

<sup>50</sup> The 1912 Act required the deposit "of a title and description, with one print taken from each scene or act, if the work be a motion-picture photoplay"; "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." (The term "dramatico-musical" was introduced into section 12 by the Act of 1912.)

<sup>51</sup> The foreigner could deposit "one complete copy of the best edition then published in such foreign country."

of copies and obtained proper registration. The court was thus agreed that tardy deposit did not in itself defeat a copyright, but the question of recovery for an infringement prior to such deposit was not squarely decided. See also *Rosedale v. News Syndicate Co., Inc.*, 39 F. Supp. 357 (S.D.N.Y. 1941).

Suppose deposit; then publication; then the issuance of a certificate of registration as for a published work. Section 13 looks to deposit after publication, but Judge L. Hand was prepared to overlook the improper sequence of events and to allow an action on the copyright. *Joe Mittenhal, Inc. v. Irving Berlin, Inc.*, 291 Fed. 714 (S.D.N.Y. 1923). "The time of deposit," he said, "is clearly of secondary importance. Even a failure to deposit promptly does no more under section [14] \* \* \* than subject the owner to a demand, failure to comply with which exposes him to a fine of \$100 and the cost of the two copies which he should have furnished. He may mend his case even in the event of a long delinquency. Why should he suffer by too great expedition?" (p. 715). See also: *No-Leak-O Piston Ring Co. v. Nunis*, 277 Fed. 957 (4th Cir. 1921); *United States v. Backer*, 134 F. 2d 533 (2d Cir. 1943). The case of *Davenport Quigley Exp., Inc. v. Century Prod., Inc.*, 18 F. Supp. 974, s.c., 32 U.S.P.Q. 608, 21 Copy. Dec. 65 (S.D.N.Y. 1937), contains a broad dictum about the unimportance of prompt deposit. Judge Patterson's language in *Freedman v. Milnag Leasing Corp.*, 20 F. Supp. 803 (S.D.N.Y. 1937), is in the same vein. *Ebeling & Ruess, Inc. v. Raff, Collector*, 28 U.S.P.Q. 366 (E.D. Pa. 1935), is a dubious case; perhaps it can be read as more insistent than the others on prompt deposit.

2. *The Washingtonian decision: deposit held a prerequisite to suit but not a condition of copyright*

In December 1931 plaintiff published with proper copyright notice an issue of its monthly magazine the *Washingtonian*—as it happened, this was the last issue of the magazine ever published. No effort was made to deposit or register that issue at the time. In August 1932 the defendants published and copyrighted a book, *More Merry-Go-Round*, which copied an article from the December *Washingtonian*. With a view to suit, plaintiff on February 21, 1933—more than 14 months after magazine publication and about 6 months after the alleged infringement—deposited copies of the December issue together with an application for registration; and it obtained a certificate of registration. On March 8, 1933, plaintiff commenced its action for infringement in the Supreme Court of (later the U.S. District Court for) the District of Columbia. The defense was that the article in suit had been dedicated by the failure to make deposit "promptly" (or alternatively that the failure to deposit promptly at least prevented suit for an infringement occurring prior to the time of deposit).

At the conclusion of trial Judge E. Dickinson Letts filed a memorandum holding for the defendants (U.S. Sup. Ct., Transcript of Record p. 23). He thought copyright was secured upon publication with notice but, considering that rights are "determined and measured by the provisions of the statute only" (p. 24), and that prompt deposit is by the statute made a condition of enforcing the copyright, he believed that the suit must fail because the condition had not been complied with. Indeed he viewed compliance with the condition of prompt deposit as a jurisdictional matter (p. 25). Upon motion for

rehearing, however, Judge Letts' attention having been directed to the *Lumiere* case and some English authority, he reversed himself, granted the motion and held for the plaintiff, enjoining further infringement and referring the case to an auditor to take an account (p. 26).

On appeal to the U.S. Court of Appeals for the District, the decision was reversed (98 F. 2d 245). Judge Miller for himself and Judge Groner (Judge Stephens concurring in the result) begins with defendants' concession that plaintiff "obtained a copyright" (p. 246). But deposit had not been prompt; therefore section 13 had not been satisfied. On plaintiff's part it was argued that failure to deposit promptly could only cause the accrual of the "penalty" of section 14.

Some support for this argument can be found by giving the word *until* [in Section 13] one of its common meanings; by reading it without careful consideration of the rest of the language of Section [13]; and by disregarding the major purposes of the Act. But when the word *until* is considered in its context, not only in the Section but in the light of the whole Act \* \* \*, as it should be, an entirely different result is reached, and a different meaning is properly ascribed to it (pp. 247-248).

Quoting Weil's treatise, Judge Miller says that registration is intended to enable third parties to determine whether a proposed publication will violate a statutory copyright (no mention is here made of the copyright notice), and that deposit is intended to provide information of the subject matter in which copyright is claimed and to obviate infringement. A purely secondary object of deposit is to enrich the Library. To read "promptly" out of the statute in the manner proposed by the plaintiff would be to make the 1909 act, like the English statute of the mid-1800's, "a mere snare for the unwary, who were foolish enough to rely upon absence of registration as showing absence of copyright" (p. 249). (In the course of the opinion Judge Miller suggests that failure to deposit, perhaps especially when accompanied by discontinuance of publication of the magazine, is an indication that a proprietor has "abandoned" or "dedicated" the work.) The judge accommodates section 13 to section 14 on the theory that the former section merely prevents suit in case of non-prompt deposit while the latter section goes further and may result in voiding a copyright. Judge Miller attempts to fend against the argument that there would be nothing left worth voiding under section 14 if all right to bring an action had already been lost under section 13. The escape is to say that while right of action is lost as to infringements preceding a tardy deposit, it is preserved for subsequent infringements. Judge Miller does not squarely adopt this reading but leaves open the question of remedy for infringements occurring after late deposit (p. 250).

Upon certiorari to the Supreme Court of the United States, the Court of Appeals was in turn reversed by a divided Court and the action thereby reinstated (306 U.S. 30). Speaking for the majority, Mr. Justice McReynolds begins, like Judge Miller, with defendants' concession that plaintiff secured copyright upon publication with notice (p. 35). Dealing textually with the question whether prompt deposit is prerequisite to an action for infringement antedating deposit, the opinion says that defendants are seeking to read the last sentence of section 13 "as though it contained the word 'promptly' also 'unless' instead of 'until'" (p. 39). Sections 13 and 14 are to be read together: an action for infringement may not be maintained

until deposit is made, and a copyright may be voided if the Register's demand for deposit is refused; but no purpose is disclosed to deprive the copyright proprietor of remedy—in effect to void the copyright if all remedy is cut off—merely for tardy deposit. The Committee report on the 1909 legislation indeed shows that there was some feeling that voiding copyright for refusing the Register's demand was too drastic (pp. 41-42).<sup>52</sup> To make the subsistence of copyright depend on prompt deposit would be especially awkward because "prompt" is nowhere defined.

The opinion rests heavily on the general legislative purpose, again shown by the Committee report, to soften the rigid requirements of the old law as to deposit. There is some consideration of the objectives of deposit. Sections 213 and 214 "show clearly enough that deposit of copies is not required primarily in order to insure a complete, permanent collection of all copyrighted works open to the public" (p. 38), for these sections authorize the destruction or distribution of deposited copies; and "this is incompatible with the notion that the copies are now required in order that the subject matter of protected works may always be available for information and to prevent unconscious infringement" (pp. 38-39). On the other hand, section 14 is "adequate for punishment of delinquents and to enforce contributions of desirable books to the Library" (p. 41). There is only an incidental mention of registration as differentiated from deposit. "[P]roper publication gives notice to all the world that immediate copyright exists. One charged with such notice is not injured by mere failure to deposit copies. The duty not to infringe is unaffected thereby. A certificate of registration provided for by [section 209] apparently may be obtained at any time and becomes evidence of the facts stated therein" (pp. 40-41).

Finally the majority opinion draws from the September 17, 1938, Letter of the Register to the Librarian a statement that Copyright Office practice was to accept deposit at any time subsequent to publication with notice, "thus, in effect, attaching no significance to the word 'promptly'; \* \* \*." The Letter acknowledged some doubt on the point and recommended eliminating "promptly" from section 13.<sup>53</sup>

Mr. Justice Black's dissenting opinion (in which Roberts and Reed, JJ. joined) undertook first to show that there was no novelty in the idea that copyright, or rather a copyright "interest," might be invested by a particular formality but divested if a later formality was not complied with. (The reader will recall from our foregoing account that this was the effect of the decision in *Wheaton v. Peters*.) The act of 1891 required deposit by the date of publication and this was thought too drastic: therefore the act of 1909 called for prompt deposit after publication. But this is not to say that copyright invested on publication can persist if deposit is not promptly made. Here Mr. Justice Black seizes upon a remark in the Committee report characterizing the "other formalities" (after notice) as "conditions subse-

<sup>52</sup> " \* \* \* It was suggested that the forfeiture of the copyright for failure to deposit copies was too drastic a remedy, but your committee feel that in many cases it will be the only effective remedy: certainly the provision for compelling the deposit of copies by the imposition of a fine would be absolutely unavailing should the copyright proprietor be the citizen or subject of a foreign state."

<sup>53</sup> Letter to the Librarian of Congress Concerning Certain Aspects of the Copyright Act of March 4, 1909 (1938), at p. 20.

quent,"<sup>54</sup> and reads these words in a real-property sense as connoting divestment.

The notion that the Register's demand under section 14 provides the only measure for failure to make prompt deposit ignores, according to the dissent, the dual purposes of deposit. The "primary" (p. 49) purpose of deposit (viewed apparently together with registration) is "to record publicly full and complete information about a work for which copyright is claimed and to make that work continuously available for public inspection in order that the extent and boundaries of the monopoly may be understood by the public at all times during the life of the copyright" (pp. 48-49). Copyright notice does not itself "show the boundaries" for it does not reveal the exact beginning date of the "monopoly" and in certain cases does not even show the year of beginning. This object of creating a continuous "public record for the public's benefit" (p. 43) is frustrated by the decision of the Court. Deposit is in the second place intended to enrich the national store of books and other works. The section 14 demand procedure is evidently viewed by the dissent as directed more to the second than the first purpose and perhaps in all events as an inadequate measure to safeguard the public record.

The dissent then argues narrowly from the text of section 13. If "No action \* \* \* shall be maintained \* \* \* until the provisions of this title with respect to the deposit of copies and registration of such work shall be complied with," and prompt deposit is a provision of the act, then no action can be maintained if prompt deposit is not made (and surely an action cannot be maintained for an infringement preceding a late deposit). As to sections 213 and 214, the dissent calls attention to the fact that even though deposited copies are destroyed, public records remain in the registration files, catalogs and indexes.

The Register's 1938 Letter is scouted as being inconsistent with regulations of the Office in force since 1910, and for other reasons. Finally the dissent says that as copyright has now been extended to include "almost every conceivable type of production of the human mind" (p. 54), it is all the more important that a complete public record be maintained.<sup>55</sup>

### 3. *Comment on the effect of Washingtonian*

The decision does not reduce American registration to the status of English registration of published books in the mid-1800's, as has sometimes been loosely said. Deposit (probably with accompanying application for registration)<sup>56</sup> can be ultimately compelled by the Register's demand under section 14. And the statute holds out the prima facie effect of the registration certificate as an inducement to deposit and register. Still, the decision removes part of least at the incentive to deposit and register promptly. This must to some extent

<sup>54</sup> "Section [10] points out the preliminaries which must be complied with in order to obtain copyright. Under existing law the filing of title and deposit of copies on or before the date of first publication are conditions precedent, and any failure to comply with them works a forfeiture of the copyright. It is proposed under this bill to so change this as to have the copyright effective upon publication with notice, and the other formalities become conditions subsequent \* \* \*."

<sup>55</sup> Upon defendants' petition for rehearing (denied at 306 U.S. 668), the United States as *amicus* filed a supporting brief arguing that as a result of the court's decision the Library of Congress was likely to lose substantial revenues and to be deprived of the deposit of a large number of published works; and, further, that the Treasury Department would be impeded in enforcement of the import prohibitions, since the Department relied on the catalog of entries furnished to it under section 211. Plaintiff in reply set out the entry in the catalog covering the issue of *The Washingtonian* magazine. This did not specifically identify the article "The Mill of the Gods," the contribution to the magazine reproduced in defendants' book. See *infra* text to note 86.

<sup>56</sup> For the later proceedings in the *Washingtonian* case, see 140 F. 2d 465 (C.A.D.C. 1944).

<sup>57</sup> See *infra* Part III, E, "Deposit Without Registration"

impair the efficacy of both processes. Moreover, the decision creates the anomaly that a copyright claimant can by registering become entitled to the prima facie evidential benefits of section 209 even though registration occurs long after publication and just in advance of a suit for infringement in which the facts set out in the certificate may come in question. The decision however works against unintended loss of rights and in that sense is faithful to a professed general design of the 1909 draftsmen.

#### F. EFFECTS OF ADHERENCE TO THE UCC

##### 1. *Legislation 1939 to date*

There have been a number of changes of the statute since the decision of the *Washingtonian* case, of which the more notable are the vesting in the Copyright Office of jurisdiction over prints and labels used for articles of manufacture (53 Stat. 1142; 76th Cong., 1st Sess., c. 396); the reconstitution of the statute in 1947 as new title 17 of the United States Code (61 Stat. 652; 80th Cong., 1st Sess., c. 391); the liberalization in 1949 of the scope of the ad interim copyright and the remission of the registration fee where the foreign proprietor of a work of foreign origin deposited two copies of the work with a prescribed catalog card (63 Stat. 153; 81st Cong., 1st Sess., c. 171); the 1952 amendment of section 1(c) to grant recording and performing rights in nondramatic literary works (66 Stat. 752; 82d Cong., 2d Sess., c. 923); the amendment of sections 9, 16, and 19 of the statute in 1954 to accommodate to United States adherence to the Universal Copyright Convention (68 Stat. 1030; 83d Cong., 2d Sess., c. 1161); the allowance in 1956 of optional deposits of photographs in lieu of copies of certain published works (70 Stat. 63; 84th Cong., 2d Sess., c. 109);<sup>57</sup> and, finally, the prescription in 1957 of a period of limitations for civil actions (71 Stat. 633; 85th Cong., 1st Sess., Public Law 85-313).

##### 2. *Terms of the legislation relating to UCC works*

Important to our theme are the 1954 amendments connected with American adherence to and the coming into effect of the Universal Copyright Convention. For the UCC puts limits on the formalities that the United States may require in according copyright protection to a large and—with added adherences of nations to the Convention over the years—an increasing volume of foreign works.

Passing over some details, the UCC provides that a contracting state which under its domestic law imposes requirements of deposit, registration, notice, manufacture, etc. as conditions of obtaining initial copyright shall regard these requirements as satisfied with respect to works, protected in accordance with the Convention and first published outside its territory, of which the author is not one of its nationals, if a simple notice is placed on all copies of the work from the time of first publication (art. III, 1).<sup>58</sup> The contracting state remains free to lay down procedural requirements, such as deposit, for the commencement of suit on such works, provided these are also

<sup>57</sup> If the work falls within Section 5 (g), (h), (i), or (k) and deposit of copies is impracticable because of size, etc., a photograph or other identifying reproduction may be deposited in lieu of copies, as provided in rules and regulations.

<sup>58</sup> On the problem of the relation between the doctrine of *Heim v. Universal Pictures*, 154 Fed. 480 (2d Cir. 1946), and the UCC notice, see Kaminstein's comment in *UNIVERSAL COPYRIGHT CONVENTION ANALYZED* (Kupferman & Foner ed. 1955), at pp. 32-33.

applied to its own nationals (art. III, 3). The securing of a renewal term of copyright may however be burdened with formal preconditions of deposit, registration, etc. if the duration of the initial term of copyright satisfies a standard laid down in the Convention (art. III, 5).<sup>59</sup> And the Convention further provides that in each contracting state there shall be legal means of protecting without formalities the unpublished works of nationals of other contracting states (art. III, 4).<sup>60</sup>

In framing domestic legislation to comply with the convention obligations, the American draftsmen had theoretically a considerable latitude. What they did in fact, so far as here pertinent, was to put UCC published works under substantially the *Washingtonian* regime, but with this difference, that they eliminated with respect to UCC works—as the convention presumably obliged them to do—the provision requiring deposit upon a demand by the register. Inscribing the simplified UCC notice on all copies from the time of first publication now operates as an exemption from regular requirements of deposit, registration, manufacture and notice for works first published in the territory of another contracting state by any foreign national, or first published outside the United States by a national of another contracting state—specifically excepting works of citizens or domiciliaries of the United States regardless of the place of first publication, and works first published in the United States (sec. 9(c)). However, deposit and registration of these UCC works must apparently be made as a “procedural” precondition of maintaining an action on the copyright in an American court. The 1954 amendments do not themselves indicate any relaxation of formal requirements for securing renewal of copyright of UCC works, but it appears that the Copyright Office will require no more than a signed statement that the notice requirements of the UCC were met at the time of first publication.<sup>61</sup> And it seems that to secure (optionally) an “unpublished” section 12 copyright for a UCC work, the usual deposit and registration formalities must be complied with, the term of such a copyright commencing as usual with registration. Yet it has been argued that if a UCC work, copyrighted as a section 12 unpublished work, is later “reproduced in copies for sale,” it would not be required to undergo deposit and registration as a published work as prescribed for domestic works.<sup>62</sup>

#### G. STATUS OF UNPUBLISHED WORKS GENERALLY

Statutory copyright may be obtained for some types of unpublished works under section 12; but it has been assumed for many years that an author or proprietor is in no case required to obtain such a statutory copyright so long as the work remains unpublished: he may claim common-law protection under State law by virtue of the saving language of section 2; and it has been often pointed out that this common-law protection may for certain purposes be preferable to that given under section 12. *Ferris v. Frohman*, 223 U.S. 424 (1912), holds that public performance of a dramatic work does not “publish” it, and courts have applied like reasoning to other types of works capable of exploitation by public performance. There is even some question

<sup>59</sup> See *infra* note 61.

<sup>60</sup> Note the definition of publication in UCC., Article VI.

<sup>61</sup> See Kaminsteln, *supra* note 58, at pp. 35-36.

<sup>62</sup> See Sherman, *The Universal Copyright Convention*, 55 COLUMBIA L. REV. 1137, 1156 (1955).

whether a motion picture distributed and exhibited in the usual way is published thereby, or if it is published, then at what moment of time. The effect of television broadcasts, especially from kinescope or film, is in some doubt, and there is conflicting authority and conflicting opinion on whether sale and distribution of phonograph records publish the underlying musical composition. In any event there is a considerable mass of material which is exploited commercially but is thought by the proprietors to be "unpublished" and is not brought under the statute. Consequently it is not deposited or registered and transfers of interests are made without reference to the recordation provisions of the statute.<sup>63</sup>

### III. SOME PROBLEMS IN THE INTERPRETATION OF PRESENT DEPOSIT AND REGISTRATION PROVISIONS

A most far-reaching question of interpretation was answered in the *Washingtonian* case. We set out here a few additional general problems having a bearing on the present administration of the deposit-registration provisions and on possible revision of the act.

#### A. REGISTER'S DISCRETION

Over the years the Register has had to decide how far he can justifiably take it upon himself to refuse a registration certificate where he believes the claim of copyright is invalid. (As will be seen later, the Examining Division does, within limits, consider some questions of validity as an aspect of its examining function.) Section 11 refers to the "complying with the provisions of this title, including the deposit of copies" as a prerequisite of obtaining "registration of \* \* \* claim to copyright." Section 208 states that "whenever deposit has been made in the Copyright Office of a copy of any work under the provisions of this title [the Register] shall make entry thereof." Section 209 provides that "In the case of each entry the person recorded as the claimant of the copyright shall be entitled to a certificate of registration \* \* \*." By section 207 the Register is given a rulemaking power "for the registration of claims to copyright as provided by this title." These provisions do not make it clear how far the Register is entitled to exercise judgment in issuing or refusing particular certificates or in defining by general regulations what are registrable works, what are suitable deposits for registrable works, etc. The Register has naturally been aware that his administrative decisions may have considerable practical importance to claimants and others even though these decisions are not conclusive on the courts. He has also had to consider that issuance of a certificate gives the claimant some procedural advantage under the prima facie provisions of sections 209 and 210.

The present position of the Register, reached in the light of court decisions, including those in the well-known cases of *Bowé v. Twentieth Century-Fox Film Corp.*, 122 F. 2d 51 (C.A.D.C. 1941), and *Kings Features Syndicate, Inc. v. Bowé* (48 U.S.P.Q. 237 (D.C.D.C. 1940)), has been thus expressed:

\* \* \* [I]nstead of requiring an applicant to prove his case, the examiners are prepared to prove a case for rejection before they make such a recommendation.

<sup>63</sup> The problems of policy raised by the class of unpublished but exploited works are considered in Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. of P. L. REV. 469 (1955); Strauss, *Protection of Unpublished Works* (Copyright Office 1958) [to appear in a subsequent Committee Print, in the present series of Copyright Law Revision Studies].

We will register material which we feel a court *might* reasonably hold to be copyrightable, even though, personally, we feel that it is not subject to copyright.<sup>64</sup>

This passage relates to Copyright Office decisions made with respect to particular submissions by claimants. The Register has also made general determinations. These are embodied, in part, in the Copyright Office Regulations. It is not clear whether the Register has taken the same generous attitude in making these general determinations as he has in ruling on particular submissions.<sup>65</sup>

The *Twentieth Century* case, above cited, states that—

the act establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept. The formula which he must apply is a more difficult one than that of the Recorder of Deeds, upon which appellee relies by way of analogy (p. 53).<sup>66</sup>

This statement was made with respect to the Register's refusal to accept as suitable certain deposits for works which in their nature were clearly copyrightable; the holding of the case was that the Register's determination was erroneous. Some feeble light is thrown by the court's statement on the question of the weight that a court ought to attach to a determination by the Register; for the Register's "discretion" is naturally connected with a limit on the court's power to overrule the Register. There are also expressions in recent Supreme Court opinions acknowledging that interpretations by the Copyright Office—especially if long-continued—are entitled to weight with a court. See *Mazer v. Stern*, 347 U.S. 201, 211-213 (1954); *De Sylva v. Ballentine*, 351 U.S. 570, 577, 578 (1956). Still there is no articulated body of decisions dealing with the extent to which the courts should attach weight or a presumption of correctness to the Register's determinations. Although ultimately expressed in the issuance or denial of an original or renewal certificate, these determinations cover a wide range, from decisions on whether a notice is in the right place to decisions on copyrightability of large classes of works. If it should be thought advisable to define the courts' proper attitude toward Register's determinations, distinctions might be taken in terms of the kinds of decisions involved.

#### B. THE PRIMA FACIE PROVISIONS

Somewhat related to the question just considered is the problem of the meaning which should attach to the prima facie provisions of the statute, sections 209 and 210. The certificate of registration is now required by section 209 to contain name and address of claimant, country of which the author is a subject (in the case of a domiciled alien, his place of domicile), author's name (where the Copyright Office records show this), title of work, date of deposit of copies, date of publication (if any), class designation and entry number, and (in the case of a book) statement of receipt of affidavit of manufacture and date of completion of printing or publication date as stated in the affidavit. "Said certificate shall be admitted in any court as prima facie evidence of the facts stated therein" (§ 209; see also § 210).

<sup>64</sup> Library of Congress, Departmental & Divisional Manuals, No. 7, "Copyright Office" (1950), at p. 38. See also Fisher, *The Copyright Office and the Examination of Claims to Copyright*, in 1953 COPYRIGHT PROBLEMS ANALYZED (1953), at p. 16.

<sup>65</sup> This is to say that some of the general determinations may proceed on interpretations of the law which are more restrictive than a court "might reasonably" adopt.

<sup>66</sup> This language has been quoted with approval in the recent case of *Baillie v. Fisher*, C.A.D.C., May 29, 1958. The court goes on to say, "The Register's discretion is not uncontrolled, but is subject to judicial review and correction."

In the great majority of cases the certificate simply accepts and repeats the assertions of the application; the Copyright Office can make only a very limited check of the correctness of these assertions. But, following the statutory language, the courts say that prima facie effect must be given to the statements in the certificate, whether or not within the Register's "personal knowledge." See *Jerry Vogel Music Co. v. Forster Music Publishers, Inc.*, 147 F. 2d 614, 615 (2d Cir. 1945). It is said that this evidentiary effect is to be given only to the statements set out in the certificate. See *Kraft v. Cohen*, 117 F. 2d 579, 581 (3d Cir. 1941); *Harms, Inc. v. Pure Milk Assn.*, 37 U.S.P.Q. 575, 576 (N.D. Ill. 1938); cf. *Booth v. Haggard*, 184 F. 2d 470 (8th Cir. 1950). Yet in quite a few cases courts have spoken broadly of the certificate being prima facie evidence of the validity of the copyright, or of the claimant's title. See, e.g., *Wihlton v. Wells*, 231 F. 2d 550, 553 (7th Cir. 1956); *Freudenthal v. Hebrew Publishers Co.*, 44 F. Supp. 754, 755 (S.D.N.Y. 1942); *Edward B. Marks Music Corp. v. Borst Music Pub. Co.*, 110 F. Supp. 913, 917 (D.N.J. 1953); *Remick Music Corp. v. Interstate Hotel Co.*, 58 F. Supp. 523, 531 (D. Neb. 1944), *aff'd*, 157 F. 2d 744 (8th Cir.), *cert. denied*, 329 U.S. 809 (1947); *Home Art, Inc. v. Glensder Textile Corp.*, 81 F. Supp. 551, 552 (S.D.N.Y. 1948); *Edward B. Marks Music Corp. v. S'asny Music Corp.*, 49 U.S.P.Q. 553, 554 (S.D.N.Y. 1941); *Edward B. Marks Music Corp. v. Wonnell*, 61 F. Supp. 722, 725 (S.D.N.Y. 1945); *Berlin v. Evans*, 300 Fed. 677, 679 (E.D. Pa. 1924); *M. Witmark & Sons v. Calloway*, 22 F. 2d 412, 413 (E.D. Tenn. 1927).

There is indeed a certain difficulty in discerning what is meant by the "facts stated" in the certificate. One of such "facts" is the name of the "author." But does not "author" connote "originality" of the work? In the *Remick* case, *supra*, the court thought it did. The expression "prima facie" is itself of dubious meaning, as a reference to 9 Wigmore, Evidence § 2494 (3d ed. 1940) will show.

On an incomplete search we have found no case in which the court dealt squarely with the effect of the prima facie provision where plaintiff and defendant held conflicting certificates on the same work. Cf. *Edward B. Marks Music Corp. v. Borst Music Pub. Co.*, 110 F. Supp. 913 (D.N.J. 1953); *Gordon v. Weir*, 111 F. Supp. 117 (E.D. Mich. 1953), *aff'd*, 216 F. 2d 508 (6th Cir. 1954); *De Sylva v. Ballentine*, 351 U.S. 570 (1956). The question has arisen whether a plaintiff who puts a certificate forward as the basis of his action can himself rebut or contradict any of the "facts stated" therein. Judge Rifkind evidently thought the plaintiff might do so, at least where the defendant had not been misled by what appeared of record. *Baron v. Leo Feist, Inc.*, 78 F. Supp. 686, 692 (S.D.N.Y. 1948), *aff'd*, 173 F. 2d 288 (2d Cir. 1949). The facts were that the certificate indicated the claim covered only an arrangement, whereas the claimant as plaintiff in the action was asserting ownership of the basic melody as well.

One is inclined to say that something on the order of the prima facie provisions is worth having in order to regulate the proof in infringement actions: this is brought sharply to mind when one examines cases under earlier statutes which contained nothing comparable to the present prima facie provisions. See *Bosselman v. Richardson*, 174 Fed. 622 (2d Cir. 1909); *Lederer v. Saake*, 166 Fed. 810 (E.D. Pa. 1909); cf. *Fred Fisher, Inc. v. Dillingham*, 298 Fed. 145

(S.D.N.Y. 1924). A problem nevertheless remains as to the scope and strength of any "presumption" which should attach to the certificate, a problem that is aggravated if registration can be made on the eve of suit, years after initial vesting of copyright.<sup>67</sup>

#### C. MISSTATEMENTS IN THE APPLICATION AND CERTIFICATE

To what extent may proved misstatements in the application and certificate be destructive of the claimant's rights? Suppose the notice inscribed on the work gives the correct year date but the application and certificate state that publication occurred later than it did in fact. Courts, although not without occasional misgivings, see Clark, C. J. concurring in *Heim v. Universal Picture Co.*, 154 F. 2d 480, 490 (2d Cir. 1946), have taken a severe attitude toward postdated notices, but dating errors in the application and certificate have been dealt with mildly in the few recent cases. *Ziegelheim v. Flohr*, 119 F. Supp. 324 (E.D.N.Y. 1954); *Advisers, Inc. v. Wiesen-Hart, Inc.*, 238 F. 2d 706 (6th Cir. 1956), *cert. den.*, 353 U.S. 949 (1957). See also *United States v. Backer*, 134 F. 2d 533 (2d Cir. 1943); *Campbell v. Wireback*, 269 Fed. 372 (4th Cir. 1920); *Turner & Dahnken v. Crowley*, 252 Fed. 749 (9th Cir. 1918); *Southern Music Pub. Co. v. Bibo-Lang, Inc.*, 10 F. Supp. 972 (S.D.N.Y. 1935); *Sebring Pottery Co. v. Steubenville Pottery Co.*, 9 F. Supp. 383 (N.D. Ohio, 1932); *Meccano, Ltd. v. Wagner*, 234 Fed. 912 (S.D. Ohio, 1916). The courts have inquired whether the defendant was really prejudiced. A case could perhaps come up where a plaintiff would be held "estopped" by a gross misstatement relied on by the defendant, or even deprived of the benefit of his copyright; but no such case has been found. Section 201.5 of the Copyright Office Regulations now allows correction of a registration by a new application in "exceptional cases." See the *Advisers* case, *supra*.

#### D. LENGTHY DELAYS IN REGISTRATION IN RELATION TO THE "NO ACTION" PROVISION

In *Washingtonian* deposit and registration occurred 14 months after publication of the work sued on. Suppose a very substantial delay; is the copyright still safe and may an action still be maintained for infringements antedating the deposit? The logic of *Washingtonian* has been held to extend even to such cases; we find instances where actions for antecedent infringements were maintained although the registration certificate was obtained 9, 13, and 27 years after publication. *Ziegelheim v. Flohr*, 119 F. Supp. 324 (E.D.N.Y. 1954); *Silvers v. Russell*, 113 F. Supp. 119 (S.D. Calif. 1953); *Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, 161 F. 2d 406 (2d Cir. 1946, 1947).<sup>68</sup> Old cases seem to suggest that an action begun without a certificate is to be dismissed without prejudice even where the certificate could be obtained shortly, see *Lumiere v. Pathe Exchange, Inc.*, 275 Fed. 428 (2d Cir. 1921); *New York Times Co. v. Star Co.*, 195 Fed. 110 (S.D.N.Y. 1912); *New York Times Co. v. Sun Printing & Pub.*

<sup>67</sup> The recent Canadian Commission on Copyright recommends repeal of a provision of Canadian law paralleling our *prima facie* provision. See *infra* Part VI, B, 4, b.

<sup>68</sup> We take it that *Washingtonian* logic also applies to the tardy registration of a work as a published work where it has been previously registered as an unpublished work. A contrary inference can possibly be drawn from *Patterson v. Century Productions, Inc.*, 93 F. 2d 489 (2d Cir. 1937), but that was decided before *Washingtonian*. Cf. *Hirshon v. United Artists Corp.*, 243 F. 2d 640 (C.A.D.C. 1957).

*Assn.*, 204 Fed. 586 (2d Cir. 1913); but a court might today allow the plaintiff time to obtain the certificate and permit him to amend his complaint or file a supplemental pleading. See *Algonquin Music, Inc. v. Mills Music, Inc.*, 93 F. Supp. 268 (S.D.N.Y. 1950); *Rosedale v. News Syndicate Co., Inc.*, 39 F. Supp. 357 (S.D.N.Y. 1941); but cf. *Guild v. Thompson's Industries, Inc.*, 84 U.S.P.Q. 224 (D. Mass. 1950) (judgment entered on the merits for defendant where plaintiff had not obtained certificate; but perhaps it was clear that plaintiff would in no event be able to obtain one).

Section 13 in terms requires that deposit and registration be carried out as a prerequisite to maintaining an infringement action. Surely this cannot mean that a claimant is altogether barred from an infringement action where the Register has wrongfully refused to issue a certificate; for it is agreed that the Register's determination is not conclusive. Does the section mean that where a claimant has made a full submission to the Register and the Register has refused the certificate, the claimant is thereupon free to sue for infringement, or must he rather compel the Register to issue the certificate as a condition of maintaining suit? This question was recently considered by Judge Dimock, but without his having to reach a decision on it. *Vacheron & Constantin-Le Coultre Watch Co. v. Benrus Watch Co.*, 155 F. Supp. 932 (S.D.N.Y. 1957).<sup>\*</sup> See also *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247 (1st Cir. 1911) (suggesting action can be maintained without certificate).

#### E. DEPOSIT WITHOUT REGISTRATION?

The opinions in the *Washingtonian* case do not bring out clearly the formal relationship between deposit and registration. Must an application for registration in all cases accompany deposit? With respect to deposits made without compulsion of the Register's demand under section 14, we may rely on the language of section 13, which speaks of deposits both of published and unpublished works, "accompanied in each case by a claim of copyright." "Claim of copyright" can be read as referring to something in the nature of an application for registration,<sup>89</sup> the details of which (subject to the mandate of section 5 that the "class" shall be specified) may be prescribed by "rules and regulations for the registration of claims to copyright" promulgated by the register with the approval of the Librarian of Congress under section 207. So the Register could presumably refuse registration where a deposit was not accompanied by an application for registration. It is true that the register is required by section 208 to make "entry" "whenever deposit has been made \* \* \* under the provisions of this title"; this does not, except possibly by indirection, refer to an application for registration. But section 209 says that "In the

<sup>\*</sup>An appeal in the *Vacheron* case was decided after the present paper had been prepared. 119 U.S.P.Q. 189 (2d Cir., October 21, 1958). Judge Hand voted to dismiss a count for copyright infringement and appears to go the whole way in holding that the plaintiff cannot maintain an infringement action without having procured a registration certificate. (The plaintiff had twice applied for a certificate and been refused on the ground that the work—an ornamented watch—was not a proper subject of copyright.) Judge Hand did not suggest that the action might be retained on the calendar while the plaintiff sought to compel the issuance of the certificate. Judge Lumbard concurred in dismissing the copyright count, but did not state his reasons. Chief Judge Clark, dissenting, said, "I doubt if the ministerial grant of a certificate is a condition precedent to suit for copyright," but in any event thought the plaintiff was at least entitled to maintain the action (and, on the particular facts, to secure interim injunctive relief pending his applying for mandamus against the Register).

<sup>89</sup>It was suggested by plaintiff in the *Washingtonian* case that "claim of copyright" might refer to the notice, and stress was laid on the opening words of § 11: "Such person may obtain registration \* \* \*"

The meaning of section 13 is somewhat obscured by the fact that it appears to repeat much of section 12.

case of each entry the person recorded as claimant \* \* \* shall be entitled to a certificate of registration" containing statements of fact that must in part at least come from the claimant. This perhaps supports the position that application for registration must accompany a deposit. (See also the language of sec. 17 regarding the affidavit to accompany deposit of copies, and the language of sec. 18 prescribing a penalty for the making of a false affidavit for the purpose of obtaining registration.)

Coming to section 14 dealing with the register's demand, we find no reference to any accompanying claim of copyright; the language is all in terms of requiring deposit of copies.<sup>70</sup> Would it be a proper compliance with the register's demand to tender copies but to refuse to turn in an application for registration and correspondingly to refuse to pay the fee? If the answer to this question is in the affirmative, then it is not until a proprietor undertook to sue for infringement that he would be obliged to fill out an application form and pay the fee. But considering the awkwardness of this result and the argument that can be built on sections 207-209, we may be justified in saying that the register could refuse a naked deposit following a demand under section 14 and regard the copyright as forfeited.

Present section 202.3(b) (1) and (2) of the Copyright Office Regulations looks to refusal of a deposit not accompanied by an application for registration and the fee; but it does not appear to deal with the case of a deposit following a demand under section 14. Certainly it is administratively convenient to tie registration and deposit together in all cases.

#### F. PROPER CLAIMANT IN CASE OF ASSIGNMENT

An intending assignee of a copyright, finding that the work has not been registered, would be well advised to require the original proprietor to register before the assignment is executed; he would then take and record the assignment. This makes a consecutive and tidy record. Suppose, however, an assignment is given while the work remains unregistered. (This situation is likely to arise under the *Washingtonian* rule which allows late registration with possibilities of transfers of interest in the copyright in the meanwhile.) If it is then proposed to register the work, should the proprietor of copyright at time of publication appear as claimant in the application and registration, or should it be the assignee? The problem involves an interpretation of section 11 in its relation to section 10, and the answer is doubtful. Apparently the Copyright Office once took the view that the assignee should appear as the claimant; the Office now holds, at least as a preferred rule, that the proprietor at time of publication should be shown as the claimant.<sup>71</sup> See Copyright Office Regulations, § 202.3(b)(3). The latter solution probably produces the better record.

There is nothing to prevent an assignee from recording his assignment in the absence of a registration of the work to which the assignment relates, even though this immediately complicates the record. For the Copyright Office evidently believes that it has no "discretion" to refuse recordation of an instrument purporting to be an assignment

<sup>70</sup> Compare the statement of Black, J. dissenting in *Washingtonian* that the penalty for failing to comply with the demand may be imposed "whether the claimed copyright is valid or invalid." 306 U.S. at 51.

<sup>71</sup> This change of view can be traced through Copyright Office memoranda.

of a copyright. On the other hand it appears that the Office will not register a renewal unless the work has previously been deposited and registered for the initial term of copyright (which may of course occur a moment before the renewal is registered). This practice encourages a consecutive record, but it would be hard to find any clear justification for it in the text of section 24. In any event the Copyright Office will not require that initial deposit and registration of a U.C.C. work be carried out as a condition of permitting renewal registration of such a work.<sup>72</sup>

#### IV. OPERATIONS OF THE COPYRIGHT OFFICE RELATING TO REGISTRATION

##### A. THE WORKS DEPOSITED AND REGISTERED

It is a matter of common observation that a very great amount of material published domestically and capable of copyright is not in fact published with notice and passes at once into the public domain without ever touching the Copyright Office. Much informational material—e.g., newspapers, State publications, financial reports—thus loses copyright protection, as do many journals issued by scientific, technical, and professional societies and institutions.

The Copyright Office believes that it receives for deposit and registration 90 percent or more of trade material in books, periodicals, maps, music, and motion pictures. On the other hand scripts for broadcasting by radio and television, and paintings, sculptures, fine prints, and photographs frequently remain undeposited and unregistered.

As to works published abroad, excepting those which must reach the Copyright Office to claim *ad interim* copyright, there is no ready means of telling what percentage of those to which U.S. copyright attaches remains undeposited and unregistered. Compliance demands have not been made in respect to foreign works. Works published abroad protected here by virtue of the UCC are of course exempt in the first instance from deposit and registration:<sup>73</sup> it is too early to tell what falling off of deposits and registrations will occur in this category. As already noted, there is no official compulsion to deposit or register unpublished works domestic or foreign. In sum, the present deposit and registration system does not serve to bring in all the works that are under some form of copyright protection in this country, nor even all the works under statutory protection here. And it must be recognized that U.S. adherence to the UCC imposes a limit on any attempt to strengthen the system with respect to foreign works.

Notwithstanding gaps in the system, and despite the *Washingtonian* decision, a very sizable number of registrations are made, and made voluntarily. There were 225,807 registrations in fiscal 1957,<sup>74</sup> the peak number in a gradual climb since 1953. Of this number only 12,514 came in through compliance efforts (which incidentally rarely need go to the extent of formal demands). Total registrations from 1898 through fiscal 1957 came to 9,188,314. The registrations no

<sup>72</sup> See Kaminstein, *supra* note 58, at pp. 35-36.

<sup>73</sup> And see *supra* note 47 (provision of the Buenos Aires Convention).

<sup>74</sup> Figures are taken from the ANNUAL REPORT OF THE REGISTER OF COPYRIGHTS FOR THE FISCAL YEAR ENDING JUNE 30, 1957, except for figures on assignments which were separately supplied.

doubt comprise a high percentage of all published works of any importance produced in the United States.

Particular interest attaches to the following figures for fiscal 1957. Seventy-six percent of registrations were for books and pamphlets, periodicals, and musical compositions. In class A, "Books," including pamphlets, leaflets, etc., and contributions to newspapers and periodicals but excluding "periodicals (numbers)," there were 52,025 registrations for works printed in the United States; as against 2,915 registrations for works "printed abroad in a foreign language," and 1,777 "English books registered for ad interim copyright." (British adherence to the U.C.C. became effective in September 1957, after the close of fiscal 1957.) Registrations for "unpublished works" totaled 46,636. Renewals of all classes numbered 21,473. Assignments and related documents recorded were 8,134; the individual titles concerned were 36,284.

#### B. THE TIME OF DEPOSIT

Under *Washingtonian* it is open to the copyright owner of a published work to delay application for registration until a lawsuit is in the offing or the Copyright Office seeks him out and sends him a letter. To what extent are applications for original registrations actually delayed beyond the date of publication? A study carried out by the Copyright Office in 1956 with respect to a total of 22,513 works of all types received for registration shows that copies of 15,143 of these works (67.26 percent) came in within 1 month of publication; 6,264 (27.77 percent) from 1 month to 6 months thereafter; 606 (2.69 percent) from 6 months to 1 year; 494 (2.19 percent) from 1 to 27 years; 6 (0.02 percent) during the 28th year. If we look to the time-rate of deposit for the several categories of works (corresponding to the application forms) we find considerable variations. Thus for category "B" (periodicals) the percentages, corresponding to the percentages above given, were: 87.1 percent, 10.5 percent, 1.9 percent, 0.5 percent, 0.0 percent; whereas for category "Ef(a)" (foreign music with registration fee paid), the percentages were: 2.5 percent, 5.4 percent, 9.4 percent, 81.0 percent, 1.7 percent. The percentages representing the arithmetic means of the percentages recorded for the several categories ran as follows: 40.6 percent, 40.0 percent, 7.2 percent, 8.7 percent, 0.9 percent; and the medians: 50.25 percent, 41.5 percent, 4.0 percent, 5.1 percent, 0.9 percent.

Putting to one side the variations in the time-rate of deposit as among the several categories, and considering the figures and percentages first above given, we may say that on an overall basis the current system succeeds in bringing applications in reasonably quickly (95.03 percent within 6 months). This may be attributable in part to ignorance of the *Washingtonian* decision, to the fact that Copyright Office literature publicly distributed states there is a duty to deposit promptly (as indeed there is despite *Washingtonian*), and to the fact that major publishers are aware that the Copyright Office may catch up with them anyway. But probably more impelling motives are a desire to lay down promptly a record of ownership; an awareness that in case of later transfers of rights in the work the transferee will be happier if the record seems regular; in instances where Berne protection is sought by "simultaneous" publication, a feeling that it would be well to have the publication date shown in the U.S. registration

certificate. Beyond reasoned motivation, there is the force of established routine. (In the case of trade books, the Copyright Office and the Library of Congress have pressed for deposit even in advance of announced publication date. Publishers have responded, realizing that early issuance of Library of Congress cards is helpful to them, for example in increasing sales to libraries.)

The registration of unpublished works under section 12 is probably actuated in some cases by a desire to establish evidence of the existence and content of the work. Registration means access to a Federal court and statutory remedies but also imposes certain limits on the rights of the owner.

#### C. APPLICATIONS AND DEPOSITS; OFFICE EXAMINATION

##### 1. *Record material*

The chief record material flowing into the Copyright Office in consequence of the various provisions of the act consists of applications for original registration and works (or substitutes) deposited therewith; applications for renewal of copyright; assignments and related documents; notices of use and notices of intention to use. The records of the Copyright Office are built fundamentally upon this submitted material. Library of Congress collections are fed from the deposited copies.

##### 2. *Application forms*

Applications for original registration as now prescribed by the Register call for little more information than is required to appear on the certificate of registration whose contents, as dictated by section 209, have already been described. Indeed the certificate form is physically set up as a copy of the application (without the instructions given on the application for its completion). Without going into a detailed analysis of the application forms now in use, it may be said that the chief additional information called for in the applications (i.e., information not required by section 209 to appear on the certificates) is "previous publication," and in some cases "previous registration" as well. But "previous publication" looks only to "a brief general statement of the nature of the new matter in this version." Very likely the Register under the present act could make a case for requiring some further information from claimants, but he has not unnaturally used the section 209 items—those "facts" appearing in the certificate to which prima facie effect is given by the same section—as a guide to what he demands in the applications. The form of application for registration of a claim to renewal copyright is also narrowly confined in scope.

##### 3. *Examination of applications and deposits*

When applications are received in the Copyright Office, the Examining Division scrutinizes them together with the accompanying deposited copies. The check is for compliance with law, but the examiner does not and cannot investigate at large; he generally confines himself to the application and the deposited copies; occasionally, when put on inquiry by this internal examination, he may go elsewhere to relevant records of the Copyright Office. He is certainly not expected to check whether the work duplicates a previously copyrighted work or a work in the public domain. He checks for adequacy of the notice of copy-

right; agreement in dates, names, etc., between the application and the deposited copies; propriety of the "class" in which copyright is claimed; evident copyrightability of the work, and some other matters. The various forms of letters sent to claimants calling attention to errors spotted by the examiners, and usually soliciting corrections by the claimants, are revealing of the kind of examination that is conducted, as is section 202.2 of the Copyright Office regulations, listing common defects in the notice.

The Register has stated <sup>75</sup> that an examiner is expected to deal with about 40 registrations per day. With respect to perhaps 15 percent of the applications correspondence with the claimant becomes necessary. As to rejections, the Register's annual report for fiscal 1957 says:

Approximately 3 percent of the applications filed during the fiscal year were rejected \* \* \*. Most rejections were in connection with published works lacking notice of copyright, uncopyrightable items, and works other than books, periodicals, or musical compositions, although many renewal applications had to be rejected because of untimely filing (p. 2).

Reasons are given for rejections and claimants are permitted to present arguments in writing and orally. There is no formally established procedure by which a claimant or other interested party can secure review of a decision within the Copyright Office; but apparently informal "appeal" lies to the Chief or Assistant Chief of the Examining Division, with final resort to the Register. The policy of the Office, as we have seen, is to be liberal in registering claims.

Assignments and related instruments appearing on their face to relate to copyrights and to be properly executed are not checked but are immediately recorded. Renewal applications are checked and in ordinary cases will not be registered unless original registration has been accomplished.

#### D. COPYRIGHT OFFICE RECORDS <sup>76</sup>

The data as to claims considered admissible for registration are cataloged and indexed. These data consist of copyright information based primarily on the applications, and (for original registrations) minimal identification information based primarily on the deposited copies.

Central to the whole system of recordkeeping is the "Copyright Card Catalog" which is maintained in time segments, without division into "classes." Each work registered is represented by a catalog card summarizing the data. The cards are arranged under title of work, name of author, name of claimant if it differs from that of the author. To facilitate finding, certain cards are referenced in additional ways: under real name, if known, as well as pseudonym; under area for maps, etc. (At the close of fiscal 1957 there were approximately 20 million cards in the Catalog relating to approximately 9 million registrations.) The applications themselves are preserved in their numerical places within their respective "classes" in "record books"; the certificates are returned under seal of the Copyright Office to the claimants.

<sup>75</sup> Fisher, *The Copyright Office and the Examination of Claims to Copyright in 1953* COPYRIGHT PROBLEMS ANALYZED (1953), at pp. 11, 13.

<sup>76</sup> We have had the benefit of a Copyright Office memorandum of June 17, 1957, entitled "A Brief Description of Copyright Office Records."

Assignments and related documents are given location numbers (volume and page), copied for Office record, and the original together with a certificate is returned to the sender. The assignment indexes are based on title of the work (if shown in the document submitted), and names of assignor and assignee.

Under sections 210 and 211 the Office is required to publish copyright data. This is accomplished by means of a "Catalog of Copyright Entries," a semiannual publication covering both original and renewal applications (but not assignments and related documents), set up according to "class" divisions, with indexes. The entries duplicate the cards making up the "Copyright Card Catalog." Because of the fact that published catalogs appear at short intervals, search by means of these books is difficult unless the date of registration of the work is already known with a fair degree of accuracy. For thorough searches the preferred source is the "Copyright Card Catalog" in the Copyright Office. Searches for motion pictures between 1894 and 1949, and for dramas between 1870 and 1916, can, however, be efficiently carried out by resort to special cumulated catalogs.

Copies of selected groups of entries covering music, as filed into the "Copyright Card Catalog," are being currently supplied on a subscription basis, at cost, to ASCAP, BMI and CAPAC (Composers, Authors and Publishers Association of Canada, Ltd.). Similar services covering material in other categories are supplied to the Brylawski office (Washington) and Johnson & Tannenbaum (New York) who provide for their clients an information service concerning, among other things, the copyright status and ownership of works.

This account of present-day cataloging, recordkeeping and record publishing is rudimentary and incomplete. Older practices were different and as one goes backward in time the records vary in form and utility.

#### E. DISPOSAL OF DEPOSITED COPIES

Under section 213, the Librarian of Congress determines what deposited copies shall be transferred to permanent collections of the Library or other places. A very large amount of published material is so transferred, but relatively few unpublished items. Although marketings are made on copies transferred to the Library to show that they were deposits for purposes of copyright registration, it is possible for these copies to be lost or mutilated in the course of time.

Pursuant to section 214, the Librarian and the Register acting jointly may, in certain events, cause deposited copies, not transferred under section 213, to be destroyed. Copyright Office practice is to hold unpublished items during the copyright term and even beyond. Untransferred published items (consisting of material of minimum appeal to libraries) are held for at least 3 years before the procedure for destruction is applied.

Motion pictures are specially treated. After registration as published works, deposited copies are returned to the claimants for commercial use under an agreement by which one copy may be recalled for the Library within 2 years. Some 30 percent of copyright films—the more meritorious ones—are so recalled.

Some general figures on retentions and disposals of deposits are given in the appended note.<sup>77</sup>

#### F. USES OF COPYRIGHT RECORDS

What use is made of the voluminous records built up by the Copyright Office on the basis of deposits and registration?

##### 1. *Work of Reference Search Section*

First, there are particular inquiries put to the Reference Search Section of the Copyright Office which necessitate resort in some form to the Office records, here called "searches." A study of 453 "search reports" completed by the Section during a period of 20 days in early 1957, as extrapolated for a calendar year, is here used as a basis of information.<sup>78</sup> Estimated total inquiries and corresponding searches for the year were roughly 6,500.

The primary findings of this study were as follows:

\* \* \* In brief, [regarding searches made by the Copyright Office in response to inquiries] copyright records are used primarily (measured quantitatively) (1) by creators and marketers (2) [through persons located] in New York City and Washington, D.C. (3) to secure information for the purpose of disposing of, or obtaining, rights in (4) certain specific works, and also in all the works of specific authors or claimants—works (5) which are newly produced or which may be available for reissue or adaptation.

Breakdown of the data reveals the following:

(a) *Sources of inquiries.*—The largest source is "Government," 27.3 percent, of which the largest component is Library of Congress, 19.4 percent. Next comes "Marketers" (music and book publishers, most prominently), 23.4 percent; then "Creators" (songwriters and authors, most prominently), 21 percent; then "Attorneys," 11 percent. Other inquiries identifiable as to source account for 4.4 percent; "Unknown," 12.8 percent.

A restatement of sources in terms of industries or like groups (e.g. combining under "Music" music publishers, songwriters, composers, recording companies) shows "Music," 27 percent; "Books and Periodicals," 11.2 percent; "Attorneys," 11 percent; "Drama," 2.1 percent; "Miscellaneous Commercial Interests," 1.5 percent; "Motion Picture Interests," 1.3 percent; "Art," 0.9 percent. These make up a total of 55 percent from the group generically called "Copyright Interests." "Cultural Institutions" account for 1.6 percent; "Heirs of Authors," 1.8 percent. "Government" and "Unknown" remain at 27.3 percent and 12.8 percent respectively.

(b) *Purposes of inquiries.*—These are broken down as "Economic," 75.8 percent, of which the larger components are "exploit work in public domain," 19.9 percent; "verify or complete personal record," 13 percent; "negotiate contract," 11 percent; "legal," 11.2 percent; "secure permission," 6.6 percent; "verify or complete company record," 5.9 percent; "locate an author," 4.9 percent. "Other than Economic" purposes accounted for 13.1 percent of inquiries; "Unknown," 10.8 percent.

<sup>77</sup>\* \* \* [O]f the deposits received between 1902 and 1957 [both published and unpublished], 64% have been retained either in the Library of Congress or in the Copyright Office. Of the 36% disposed of, 2% were transferred to other libraries, 11% were returned to claimants, and 23% were transferred to the Library in bulk for disposal by transfer, exchange, or donation to libraries in all parts of the world, or for disposal as waste paper after all efforts to place the material in libraries have proved to be ineffective." Data supplied to the writer by the Copyright Office.

<sup>78</sup>This study is embodied in a Copyright Office memorandum of May 13, 1957 entitled "Uses of Copyright Records and Catalogs." (The study does not, of course, attempt to say whether or how comparable information could have been obtained without resort to Copyright Office records.)

(c) *Types of searches.*—The total of approximately 6,500 searches, requiring reference to a total of 24,673 registrations (including renewal registrations), are broken down as follows: 5.1 percent of the searches called for the status of all the works of one author or claimant, and involved reference to 45.3 percent of the registrations. Here “personal and corporate names represent the basic finding and identifying element”; 89.1 percent of the searches called for status of individual works, and involved reference to 52.6 percent of the registrations. Here “titles of the works represent the basic finding and identifying element.” Searches for all works under one title accounted for 3.1 percent of all searches and required reference to 2 percent of the registrations. “Other” searches were 2.6 percent of the total, with reference to 0.1 percent of the registrations. About one-quarter of all the inquiries and corresponding searches involved also the furnishing of copies of copyrighted records or deposited works.<sup>79</sup>

(d) *Registrations referred to in searches.*—Analysis of the registrations to which reference was made in searches shows heaviest interest in registrations falling in the first 7-year period, i.e. the 7-year period preceding the time of search (1950–57, 30.3 percent of all registrations referred to in searches); then, in descending order, fifth 7-year period (1922–28, 16.5 percent); fourth (1929–35, 16.1 percent); second (1943–49, 11.1 percent); third (1936–42, 8.7 percent; eighth (1901–7, 5.4 percent). Registrations referred to dated after January 1, 1956, comprised 12.7 percent of all registrations canvassed in the searches; and the heaviest concentration in this registration period was on registrations dated from 1 to 5 months prior to the time of the searches. The searches involving registrations in the fifth 7-year period were evidently actuated in part by an interest in works released for use by failure to renew. Searches in the fourth 7-year period were no doubt attributable in part to claimants’ interest in making renewal registration.

(e) *Geographical distribution of inquirers.*—Inquirers were heavily concentrated in Washington and New York City (commercial users often work through representatives or lawyers in these places), but there was a scattering in other States and outside continental United States.

(f) *Time devoted to these searches.*—Time devoted by Copyright Office personnel to the searches here considered is not given in the study. However, the Register’s Report for fiscal 1957 shows “fees for searches made” for that period to have been \$11,733. At the statutory rate of \$3 per hour, this yields 3,911 hours. This figure presumably represents time consumed in searches made for non-governmental inquiries, and even in this category it may be assumed incidental services are rendered for which no charge is made.

## 2. Other uses of copyright records

The foregoing summarizes the use of Copyright Office records by Office personnel at the request of outsiders. In addition there is extensive use of segments of the records by subscribers to the card services; a limited use of the public files of the Office by persons who

<sup>79</sup> A memorandum of the Copyright Office adds the comment (April 17, 1958) that recently developed information shows that, quantitatively, the principal copyright uses of all deposits retained in the Copyright Office are: (1) Securing photocopy of deposit—1,100 per year, of which “unpublished music” accounts for 79%. (2) Inspecting deposit copies, principally for copyright-related purposes—500 per year, of which the largest elements are “commercial prints and labels,” 34%; “unpublished music,” 20%. (3) Securing certified copies for legal action—150 per year. Copyright uses of deposits transferred to the Library of Congress would add 85 certified copies (principally of periodical articles) to the 150 in category (3).

appear at the Office and conduct their own searches; and an unascertainable amount of use of the printed catalogs sold to individuals, firms and societies or made available at libraries.

#### V. A CONSIDERATION OF THE VALUES OF THE PRESENT REGISTRATION SYSTEM

Debate on the question of formalities, including the issue of registration, has often proceeded on a high level of abstraction. Those for whom copyright is a "natural" right have regarded formalities as repugnant to such a right and therefore offensive in their nature; while those who think of copyright as a State-granted, limited "monopoly" have tended to look upon formalities as somehow the proper or even the necessary accompaniment of the grant.<sup>80</sup> To the view that formalities of notice, registration and the like are no more intrinsic to a copyright scheme than they are to the body of law governing ordinary personalty, others oppose the view that since works of the mind are not reducible to "possession," they peculiarly require some special earmark to be provided by imprinted notice, recordation, etc.

Arguments of this kind have their place, but it seems proper to forego them here, descend to particulars, and ask what are the benefits and countervailing disadvantages or demerits of a registration scheme on the present American lines.

The present scheme of formalities, of which registration forms a part, is actually an amalgam of fully compulsory features (e.g. notice, registration to obtain renewal copyright), semicompulsory features (recordation of assignments, which is strongly sanctioned), and permissive features with incentives and penalties (here we could instance original registration, which is on the one hand induced by the prima facie value of the certificate, the preconditioning of infringement actions upon securing registration, and other things, and may on the other hand be ultimately compelled by Register's demand). A thoroughly compulsory system could maximize certain values but would cause hardship by threatening forfeitures for venial omissions. The present system is a compromise attaining various public and private advantages at some price both to the public and to private parties. It is hard to do exact justice to each element in the aggregate of "pleasures and pains." Judgments, favorable or unfavorable, are judgments of degree to which no precise values can be assigned. And, in focusing on registration, we must recognize that this is intertwined with other features of the act (e.g. notice, term of copyright, publication, "divisibility," deposit, recordation of transfers) so that it is hardly possible to reach a judgment on registration without implicating a variety of judgments about the rest of the act. The following discussion, which cannot pretend to exhaust the matter, will we hope be suggestive of the main factors upon which an appraisal of the present scheme can be intelligently made.

<sup>80</sup> Here we find reflected the age-old dispute between those who regard copyright as "Property" and those who view it as "Privilege." See BIRRELL, *op. cit. supra* note 1, c. I.

A. REGISTRATION AS A MEANS OF ENFORCING COMPLIANCE WITH OTHER PROVISIONS OF THE ACT

When a claimant files his application and makes deposit he is in effect submitting himself to an official determination of whether he has complied with the law. The check carried out by the Examining Division is a means of enforcing both formal and substantive requirements including provisions or standards governing notice, copyrightability, manufacturing, import, etc. As a practical matter this check is perhaps the chief official instrument of law enforcement. Were it not for administrative surveillance "at the source," a considerable number of works belonging in the public domain would circulate with notice of copyright inhibiting access to the works. In many cases the check serves to advise or warn claimants about legal requirements with which they are then quite willing to comply.<sup>81</sup> The fact that applications are officially examined puts a certain pressure on claimants to examine and attempt to comply with the law before attempting registration.<sup>82</sup>

Administrative examination of claims to copyright is however far from complete. It is necessarily limited in the great majority of cases to a check of obvious points arising on the claimants' *ex parte* submissions. Invalid claims may slip by; and when they do, they carry a kind of official imprimatur which may itself operate unjustly in creating a preserve that is practically effective although legally unjustified.

The Copyright Office policy of registering doubtful claims can be objected to on the ground that it fosters "monopolies" which are in last analysis illegal. On the other side, objection has been voiced to any administrative decisions of invalidity. As these decisions are not conclusive on the courts, it has been argued that the Office should abandon the whole effort to examine claims and register all claims as such, so that the contentions of interested parties regarding particular works will be disclosed of record, giving users and others a better basis for deciding how they should act.

B. REGISTRATION AS A MEANS OF ENHANCING INFORMATION PUBLICLY AVAILABLE

The registration process adds to the information publicly available regarding works claiming statutory copyright. Data presented in the applications, and carried forward into the catalog cards, the published catalog books, and the indexes and other records, supplement and enhance the information supplied by the notice. This is plainly true in cases where the notice is abbreviated as permitted by section 19.<sup>83</sup> Registration is a particularly important source of information as to unpublished works coming in under section 12. To the informa-

<sup>81</sup> A claimant may be advised to register in a "class" which may be to his better advantage.

<sup>82</sup> Some marginal pressure may be exerted by the "fraudulent notice" provisions, §§ 105, 106.

<sup>83</sup> And it will be recalled that phonograph records carry no notice of copyright of the underlying musical composition.

A technically proper notice of copyright on a work may be quite unrevealing, and even misleading, as a guide to what is under copyright and who owns and can deal with the copyright. This appears from an examination of the rules which have grown up around the notice provision, particularly the rules defining the "proprietor" for purposes of notice and rules about composite works. See Doyle, Cary, McCannon & Ringer, *Notice of Copyright* [Study No. 7 in the present series of Committee Prints]. The registration papers may help to elucidate the notice. Notice may be viewed first as a warning, second as a kind of starting point for tracing copyright information through the official registry system. *Cf. infra* note 90.

tion furnished through registration, a considerable further store is added by the related deposits, recordations of assignments and like documents, and other filings. The assembled body of information is of value to users and others. It has general bibliographical value. It is a source, supplementing the works themselves, from which some part of the cultural history of the nation can be written.

Within limits already alluded to, the examination of submitted papers and deposits carried on in the Copyright Office helps to secure a trustworthy body of information. This examination is not so much directed to detecting and preventing fraud as simply to clarifying and rationalizing the information collected.

A few points can be mentioned here that may possibly command general agreement. Looking forward to a time when works may be exploited in new forms which will not conveniently admit of extended notices, we can see added values in registration. Within the structure of the present act, the classes of registrable unpublished works might be added to,<sup>84</sup> thus eliciting information at an early stage as to works often traded in prior to publication. Application forms could be enlarged, without casting a substantially heavier burden on claimants, in order to bring in further useful information (e.g. further information about works from which the instant work is derived).

In dispraise of registration it may be said that information now obtained from that and related processes is in considerable part available from other sources: the notices, the works themselves, standard bibliographies and other standard reference works, trade reference books, and other trade collections and sources. Moreover information can be obtained direct from authors, publishers, proprietors, licensees, and their agents. The information collected by the Copyright Office is based essentially on ex parte submissions and is subject to infirmity notwithstanding the official check.

#### C. VALUES OF REGISTRATION TO PROPRIETORS AND USERS

Changing the point of vantage somewhat, we can describe some of the claimed advantages to those directly concerned with copyright properties. Record material built up in the Copyright Office assists authors and proprietors in protecting their works against unauthorized use, in establishing priority of authorship (especially is this true in the field of unpublished works), in managing and disposing of their properties whether singly or in a bundle. Similar assistance is given to heirs and other successors to copyright properties who also find in the records of original registration the basis and time limits for renewal applications. There are particular advantages in registration such as establishing more or less firm proof of "simultaneous" publication for purposes of Berne and meeting possible defenses of "innocent" infringement. A readier market can be found for works registered in the usual course because the assignees or licensees have greater confidence in the proprietors' titles and the validity of the copyrights. Correspondingly, the records to the extent that they promote confidence in title and validity (or indicate that works are unprotected) have advantages for prospective users; and it must be noted that there has been a great multiplication of possible uses of copyrighted works and,

<sup>84</sup> Extension of registration to further categories of unpublished works has often been urged by author-groups and is a feature of a number of the general revision bills.

therefore, of prospective users. In a few categories of works (e.g., unpublished dramas) the records are sometimes scanned by users looking for suitable material; here the records serve not merely as a help in determining the status of particular works but as a means of finding out what is on the market.

These values of registration and connected records are again subject to discount to the extent of the inadequacies and infirmities of the information contained in them. Authors and proprietors have sometimes argued that it is not important to provide record safeguards for persons who intend to copy; that it is up to copyists to assure themselves of their right to do so. It has even been charged that an elaborate record system is a hunting ground for cagey copyists seeking to find legal means of getting something for nothing. In the degree that the registration system creates possibilities of unintended forfeitures (as it still does, for example, in the case of renewal registrations) it is open to plain objection by the proprietor class.

#### D. VALUES OF REGISTRATION AS AN AID TO TITLE SEARCH

Bearing down on one highly important use of the records, we must ask how far the system provides a satisfactory basis for determining who owns what interests in respect to any copyrighted work at any particular moment of time. Search for ownership implicates all the records and ultimately the deposited copies.

Careful assessment of the practical strength of searches based on copyright records would involve a detailed study of the system for recording assignments<sup>85</sup> and of other features of the act to which this paper is not primarily addressed. We offer some observations, necessarily incomplete.

In past discussions of legislative revisions some experienced people have said that the copyright records cannot be seriously relied on. Others have asserted that in the great majority of cases the records are thoroughly dependable. These statements may be reconcilable in the sense that the minority of cases may be those raising complicated questions of ownership and these may have been foremost in the minds of those who have expressed sweepingly denigrating opinions of the system.

That the system is very far from perfect must be conceded on all hands. Registration may be and has sometimes been obtained for works actually in the public domain, or for plagiarisms; and such initial defects would, of course, infect the entire subsequent record. So also a registration often does not reveal the particular portion or aspect of the work as to which copyright can properly be claimed, and it may leave in the dark the prior history of the registered work or of works from which the registered work derives—matters of high importance. Registrations of periodicals or other works containing contributions of more than one author are often insufficiently revealing

<sup>85</sup> Note the stress laid on the recordation of transfers of interests in copyright in the Shotwell bill, *infra* note 136; and the like stress in the recent report of the Canadian Commission on Copyright, *infra* Part VI, B, 4, b. It has been suggested that registration of a work is not needed or useful until and unless a transfer of some interest occurs, when data on both the work and the transfer would be placed on record, the record to be supplemented as further transfers are made. But a record may be useful even if no transfer occurs, e.g. to provide evidence in case of infringement. And if the recordation of data on a work is deferred until a transfer is made, there may be a danger that pertinent information about the work will become unavailable: a contemporaneous record is likely to be the best one. (The latter point is also an objection to any system which does not place a short and definite time limit on original registration.) The question of the recordation of transfers in relation to original registration is, of course, tied up with the issue of "divisibility" of copyright.

and to trace ownership of the component works may prove to be difficult or impossible.<sup>86</sup> Changes of the name of a work can create serious embarrassments for the searcher. Instruments of transfer are recorded almost automatically, and there may be no adequate tieback to original registrations. It is not at all clear that the type of recordation system for transfers selected by the 1909 draftsmen and embodied in section 30 is well suited for the purpose.<sup>87</sup> The Copyright Office will accept for recording virtually any instrument purporting to transfer an interest in copyright, but as section 30 speaks only of "assignments," the status of any transfer short of an assignment, recorded or unrecorded, may be obscure.<sup>88</sup> Although the deposited copies may need to be consulted as a check on the other official records, the present practices sanctioned by statute of transferring and destroying deposits can result in mutilation or permanent loss of this element of the record.<sup>89</sup> To this list of troubles many more can be added.<sup>90</sup> Some result from inadequacies of the statute. Some may possibly result from weaknesses in the prescribed forms. Others may be ineradicable, for we are dealing with a form of property that is intrinsically hard to earmark and trace. It is perhaps a sign of the shortcomings of the present system that the private organizations most actively and intensively engaged in making reports of the status of copyrighted works feel it advisable to assemble and collate vast amounts of nonofficial data. (It is fair to add that these organizations collect and supply information on matters other than copyrights, and that they view the nonofficial data not as substitutes for but as supplements to the official records; they use the official records constantly and also secure search reports from the Copyright Office in cases of doubt.) Copyright Office searches are often also carried beyond the official records into bibliographical sources on matters of identification and relationship between works.

Answers to general questions put in 1957 to some of the larger users of Copyright Office records showed wide agreement that the records are helpful; there were indeed few if any important recommendations for changes in methods of recordkeeping. The fact, if it be a fact, that major users are generally satisfied with the present records would certainly be an argument for continuing something on the order of the present system. But it would not mean that the present system ought to be preserved in all its parts. Indeed it would not of itself prove that any system of recordkeeping should be retained, for major users have probably never fully considered, and therefore have little basis for judging, the efficacy of the steps that would be taken privately in reaction to the abolition of public recordkeeping.

An undeniable advantage of the present system lies in the fact that the Copyright Office is a single office of registry for copyrighted works,

<sup>86</sup> See *supra* note 55.

<sup>87</sup> Some of the difficulties, both textual and theoretical, with section 30 appear in the paper by Leon Kaplan, *Literary and Artistic Property (Including Copyright) as Security: Problems Facing the Lender*, 19 LAW & CONTEMP. PROB. 254 (1954).

<sup>88</sup> See Kaministeln, *Divisibility of Copyright* 15-16 [Study No. 11 in the present series of Committee Prints]; *Photo-Drama Motion Picture Co., Inc. v. Social Uplift Film Corp.*, 213 Fed. 374 (S.D.N.Y. 1914), *aff'd* 220 Fed. 448 (2d Cir. 1915).

<sup>89</sup> See *Gerlach-Barklow Co. v. Morris & Bendien, Inc.*, 23 F. 2d 159 (2d Cir. 1927), where deposited copies were returned to the copyright owner and destroyed before suit. Note that deposits of motion pictures under Section 12 may be of less than the whole work.

Any consideration of deposits would, of course, have to take in the whole question of storage and preservation as well as the interests and functioning of the Library.

<sup>90</sup> For example: The registration, like the notice, see *supra* note 83, may fail to reveal where the beneficial ownership of the copyright lies. Existence of commonlaw (unregistered) copyright in one or more works and registered statutory copyright in one or more related works (*cf. G. Ricordi & Co. v. Paramount Pictures, Inc.*, 189 F. 2d 469 (2d Cir. 1951)) may make a Copyright Office search ineffective or even misleading.

an advantage heightened by the fact that the basic card catalog is so maintained that searches can be conveniently made ranging through all classes of these works. Private recordkeeping by the several trades could hardly match this particular benefit.

#### E. VALUES OF A PRIMA FACIE EVIDENCE PROVISION

The prima facie evidence provision may be viewed as an incentive to register and as a rule for the management of infringement actions. We have already remarked that it seems advisable to have some procedural rule, and one's expectation that countries having no registration system would still be forced to establish some rules of order is borne out when one examines the present British law.<sup>91</sup> Details of the American prima facie scheme can be challenged on a number of grounds intimated above, including the ground that it permits the self-manufacture of proof in anticipation of suit. We have seen, however, that registrations are by and large made fairly soon after publication and we should suppose that in few cases are the applications biased by anticipation of particular litigation.

#### F. VALUES OF DEPOSIT

Deposit is now used as a material aid and support to the registration process. At the same time it works to maintain and enrich the national collections of published works. And from the deposits of unpublished works the Library takes into its collections some music and a few important works in other classes that it would otherwise find it hard or impossible to acquire, other unpublished deposits remaining available in the Copyright Office during the term of copyright.

At least in recent years there seems to have been little feeling that deposit is an undue burden on authors or copyright proprietors. Deposit appears to meet with general acceptance.

Two things can be predicated of deposit. (i) If deposit is required or encouraged for any reason, for example, enrichment of the Library, it is no untoward imposition on authors or proprietors simultaneously to fill out and file an application form calling for readily ascertainable information: even a bare deposit would have to be accompanied by some kind of covering letter or form giving minimal information. (ii) Combining deposit with registration has administrative advantages if the examining process is to be maintained.

#### G. GENERAL COMMENTS

Against the values of a registration system may be set the expenditures of time, effort, and money involved in running the system. (A fully rational analysis would inquire whether it is right and feasible to distribute the costs of a system in proportion to benefits received: thus authors and publishers who have no intention of transferring rights might plausibly contend that they ought not be obliged to pay full registration fees or any fees at all.) A system is valuable or not in terms of the uses made of it; but the uses themselves involve further expenditures of time, effort, and money. While resort to a registry

<sup>91</sup> See *infra* Part VI, C, 2, p. 62.

may "facilitate" transactions in the sense of making them legally more secure, it may embarrass transactions by slowing them down.

Ultimate judgments about registration must take into account the possible alternatives. What legal provision can be made to obtain the values of registration by other means? Are there possible advantages in abandoning registration for some classes of works but retaining it for others? What industrial practices would emerge, and at what cost and with what effort, if registration were abandoned? Investigations of the status of copyrighted works would still be made, and these would entail costs and difficulties to be measured against results in terms of legal security and speed of transactions. When we come to consider Berne countries having no official registration systems and observe that private organizations feel obliged to maintain extensive records, we may conclude that the choice is not between an official system and no system of any sort, but rather a choice among a variety of systems involving varying costs differently distributed and attaining varying levels of efficiency.

## VI. ALTERNATE SCHEMES

This part considers various proposed or going solutions of the registration problem different from the pattern now embodied in our copyright law. In describing these solutions this part in effect provides a checklist of possibilities that will claim attention in a revision of the law.

We begin by mentioning an abortive effort by the Copyright Office shortly after the decision of the *Washingtonian* case to compel deposit and registration within a stated period on pain of loss of copyright. To this we subjoin a statement about the recent bill for protection of "ornamental designs" which provides for loss of protection under the bill if registration is not made known within a prescribed time after the design is "made known." We then describe the principal general revision bills introduced in Congress from 1924-40 so far as they dealt with registration and related matters. None of these bills sought to eliminate registration; most of them attempted to create an "optional" system. The present Canadian system, also of an "optional" type, will be briefly examined. Then we consider the "no formality" position taken by most Berne countries, with particular attention to the case of the United Kingdom.

### A. COMPELLING REGISTRATION WITHIN A STATED PERIOD: AN EARLY ATTEMPT TO OVERCOME THE "WASHINGTONIAN" CASE; THE RECENT "ORNAMENTAL DESIGNS" BILL

#### 1. *Lanham bill (1939)*

Within a month of the Supreme Court's decision of the *Washingtonian* case, Representative Lanham at the request of Col. C. L. Bouvé, Register of Copyrights,<sup>92</sup> had introduced a bill "further to secure the prompt deposit of copyrightable material into the Library of Congress and prompt registration of claims of copyright in the Copyright Office."<sup>92</sup> A short hearing at which Colonel Bouvé was

<sup>92</sup> H.R. 4433, 76th Cong., 1st Sess., February 23, 1939.

the only witness was held a month later.<sup>93</sup> The following day Representative Lanham introduced an amended bill.<sup>94</sup>

Colonel Bouvé frankly stated "it is not plain to me how the [*Washingtonian*] decision could have been other than it was." The Supreme Court, he said, had in no way denied that the copyright owner was under a duty promptly to deposit and register; but "[t]he difficulty with the entire situation lies in the fact that the sanctions provided by the act are insufficient to enforce the performance of this duty."<sup>95</sup> He proposed to tighten the sanctions.

The amended Lanham bill proposed a change of section 13 of the act to provide that deposit "shall" be made within 60 days after publication in the case of works published in the United States or within 120 days in other cases. The "no action" clause of section 13 would remain intact. But that section would go on to provide that "No action or proceeding shall be maintained for any loss or damage suffered between the date of expiration of the sixty [or one hundred twenty] days' period, \* \* \* and the date on which \* \* \* deposit has been made [,] due to an infringement of copyright" in the interim. Section 14 would be amended to provide that the Register could at any time following publication, on notice, require the proprietor of copyright "to make deposit and application<sup>96</sup> for registration," and upon default for 2 or 4 months the proprietor became liable to a fine of \$100 and to pay twice the retail price of the work, and the copyright was voided. Besides this voiding of copyright for refusal of the Register's demand, copyright was to be automatically voided, under a new paragraph to be added to section 105, for failure to deposit and apply for registration within 6 months following publication, with a fine corresponding to that under the proposed section 14:

*Provided, however,* That this paragraph shall not apply if, subsequent to the expiration of the said six months' period, such person shall make deposit and application for registration, and it shall appear to the Register of Copyrights that failure to make such deposit and application within the prescribed time was due to causes beyond the control of the applicant.

The effect of the amended Lanham bill would thus have been by severe sanction to compel deposit and registration within 6 months, or sooner if the Register chose to make early demand; and delay in depositing and registering beyond 60 or 120 days would in all events entail some loss of rights against infringers.

The bill made no further progress. It is said that Colonel Bouvé received some assurance that publishers would not unduly delay deposits under protection of the *Washingtonian* decision.

## 2. *Willis bill (1957)*,<sup>97</sup>

This proposed legislation regarding ornamental designs is briefly summarized here because it has a certain kinship with the theory of the Lanham bill. Protection under the bill commences upon the earlier of these dates: the date when the design is first "made known" (through exhibition, distribution, offering for sale, or sale) with the

<sup>93</sup> *Hearings Before the House Committee on Patents, Subcommittee on Copyrights*, 76th Cong., 1st Sess., on H.R. 4433, March 24, 1939.

<sup>94</sup> H.R. 5319, 76th Cong., 1st Sess., March 24, 1939.

<sup>95</sup> *Hearings*, *supra* note 93, at p. 6.

<sup>96</sup> *Cf. supra* Part III, E.

<sup>97</sup> H.R. 8873, 85th Cong., 1st Sess., July 23, 1957, drafted by a Coordinating Committee (Designs) of the National Council of Patent Law Associations.

prescribed design notice, or on the date of filing of an application for registration of the design (§ 4). This protection ordinarily would continue for 5 years, with renewal for a further 5-year period (§ 5(a)), but it is lost if before registration issues the design is made known without the design notice, or if application for registration is not made within 6 months after the design is made known (§ 6(a)). "The proprietor of a protected design shall have remedy for infringement by civil action instituted after the issuance of a certificate of registration of the design" (§ 21). However, section 30 provides that—

Nothing in this Act shall annul or limit (1) common law or other rights or remedies, if any, available to or held by any person with respect to a design which has not been made known as provided in section 4(b) or registered under this Act, \* \* \*

The bill contains interesting provisions on the application for registration (§ 10); issuance of and content of certificates of registration (§§ 13, 14); maintenance of lists and indexes of registered designs (§ 15); correction of errors in certificates (§ 19); cancellation of certificates by order of court (§ 24).

An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration without notice, unless it is recorded in the Office of the Administrator within 3 months from its date of execution or prior to the date of such subsequent purchase or mortgage (§ 20(c)).<sup>98</sup>

B. "OPTIONAL" REGISTRATION: PRINCIPAL GENERAL REVISION BILLS (1924-1940); THE CURRENT CANADIAN LAW

1. *Predicates of the general revision bills*

The background and chief designs of these bills are given in Mr. A. A. Goldman's historical paper.<sup>99</sup> In considering the features of this mass of proposed legislation which bear on registration, we would do well to keep in mind the biases of the bills, that is, the assumptions on which they went and their approach to other problems which must necessarily affect their approach to registration. The purpose of most of the bills was to accommodate American law to the requirements of Berne. Thus compulsory formalities must be eliminated for Berne works. The draftsmen in some cases at least may have assumed without any particular deliberation that compulsory formalities should be correspondingly eliminated for domestic works. In any event the prevailing pattern of the bills was to recede from compulsory notice and to make registration optional for both domestic and Berne works with various provisions furnishing incentives or inducements to register. (The bills nevertheless retained deposit, compelled at least by fine, for domestic works.) Other motifs recurring in the bills and impinging on registration were to obliterate distinctions of treatment as between published and unpublished works, to create "divisible" copyright, and to base the copyright term on life plus years.

Recent experience with the UCC shows that it is possible to work out an international scheme of copyright protection which preserves some compulsory formalities for domestic works while minimizing them for foreign works. Whether it is wise to continue such split treatment remains open to question and our future relationship to

<sup>98</sup> See also § 25 (liability for action on registration fraudulently obtained), § 27 (penalty for false registration); § 8 (effect of omission of notice after registration).

<sup>99</sup> *The History of U.S.A. Copyright Law Revision* [Study No. 1 in the present series of Committee Prints].

Berne is of course also an open issue. Other predicates of the revision bills, such as the practical effacement of the line between published and unpublished works, cannot be taken for granted in the current revision effort. The UCC provision regarding copyright notice will be viewed by some as a reason for retaining some provision for notice as a feature of American law; but it should be remembered that a number of countries reluctantly yielded to the UCC compromise on formalities with the hope that the United States would ultimately recede from any requirement of notice.

The upshot of all this is that in examining the revision bills with a view to considering possible changes of the present law, one must be conscious that the background of those bills was not the same as that of the current revision effort.

*2. Points of interest in a scheme of optional registration*

Anticipating the detail of the revision bills, we call attention to some of the questions faced by the draftsman of an "optional" registration scheme, questions which can serve as a means of classifying the contents of the several bills. With respect to registration proper: (i) Who can apply for registration? (ii) What claims to copyright or to interests in copyright are admissible to registration? (iii) To what extent are unpublished works brought into the registration plan? (iv) When may registration be applied for? (v) If a transferee of any interest in copyright may apply for registration, is he obliged to record the instrument of transfer? (vi) What is the relationship between registration and deposit? (vii) How is registration sanctioned or encouraged: are remedies for infringement affected by registration; is registration a prerequisite to suit; what if any presumptions are raised in favor of a registrant by giving evidential effect to the certificate, by providing that registration is "constructive notice," by removing or embarrassing defenses of "innocent" infringement where the work is registered; or otherwise? (viii) What details as to the form of applications, books of registry and indexes are prescribed? With respect to recordation of transfers, similar questions arise about the identity of persons who may record, the transfers admitted to record, and the time of recordation. In addition: (i) May recordation of a transfer be effected in the absence of registration, or is registration a prerequisite to recording a transfer? (ii) How is recordation sanctioned or encouraged: are remedies for infringement affected by recordation; is recordation a prerequisite to suit by a transferee; how far does recordation of a transfer cut off unrecorded interests; what if any presumptions are raised in favor of a recorded transfer? (iii) Must transfers be in writing to be valid either as to outsiders or the parties to the transfer? (iv) What if any prescriptions are made as to the content of a proper instrument of transfer? (v) What is the form of recordation, including the nature of the return made to the party applying for recordation, and the interconnection of recordation with registration on the books of the Copyright Office? With respect to deposit, questions arise on the nature of the deposits to be called for, the time of deposit (particularly in connection with time for registration), and sanctions for failure to deposit, and the handling of the deposits, including provisions for transfers and destruction of deposits. Further questions relate to the possibility of correcting registrations and recordations; discretion of the Register to refuse registration or recordation; pre-

sumptions as to ownership of a work arising otherwise than through registration.

### 3. *The revision bills in detail*

(a) *Dallinger bill (1924)*.<sup>100</sup>—This bill attempted a general revision while retaining a good deal of the language of the act of 1909. It “authorized” United States adherence to Berne; sought to bring within one exclusive national system both published and unpublished works;<sup>101</sup> adopted in general a single term of copyright of life plus fifty years;<sup>102</sup> went far in the direction of divisibility of copyright; and made notice of copyright optional.

The treatment of foreign authors nominally conformed to Berne:

\* \* \* the enjoyment and exercise by such foreign authors \* \* \* of the rights and remedies afforded by this Act shall not be subject to the performance of any formalities in order to secure copyright, and such foreign authors shall not be required to publish with notice of copyright, deposit copies, register claims of copyright, or manufacture within the limits of the United States, save under the optional provisions of this Act (§ 13).

It is not clear from the rather turgid text of the bill how far foreign authors were obliged to comply with mandatory provisions not related to the securing of copyright, e.g., recordation or registration of assignments as a condition of maintaining suit.

Concern for the collections of the Library of Congress was shown in the provision stating that if the publisher of a book (as defined) published in the United States omitted to register it within one month of its publication, the Register could demand deposit of two copies; and if the publisher failed to comply, he incurred a fine—but the copyright was unaffected (§ 62). With respect to works other than books, deposits were merely invited or cajoled through the optional registration provisions applying to all works.

Copyright was to vest in the author immediately on creation of a work without need for registration (§ 45(a)). But it was open to “the author, publisher, proprietor, or any other person interested in a copyright, deriving his interest in a copyright from or through the author” to obtain registration of a claim to copyright or “any of the rights comprised therein” (§ 14). There was no stated time limit for obtaining registration. The applicant was to furnish prescribed information (§§ 15, 58),<sup>103</sup> and also to deposit copies (the details of deposit varied, depending in part on whether the work was published or unpublished; and it should be noted that even the manuscript of a book could be registered as an unpublished work) (§ 16), whereupon a certificate would issue (§ 58). As already appears from the quoted language of section 14, and as was more explicitly stated in other sections of the bill (§ 47, see also § 15) not only an original proprietor but an assignee or licensee was entitled to register his claim; but it seems that in lieu of registering, a transferee could simply record the instrument under which he held. The bill is obscure on the differences in the consequences which attached to recordation by a transferee as distinguished from registration by him; and we shall not attempt to trace this matter in detail. By section 26(a), a plaintiff in an infringement action was limited to an injunction if the defendant

<sup>100</sup> H. R. 9137, 68th Cong., 1st Sess., May 9, 1924. For the exact place of this and the other bills to be considered in the history of attempted revision, see Goldman, *supra* note 92.

<sup>101</sup> See § 5 (works for which copyright can be secured).

<sup>102</sup> See § 22 (provision for “reversionary interest”).

<sup>103</sup> The first line of § 15 is garbled.

proved he was not aware he was infringing and had acted in good faith; but this did not apply "in the event of registration of copyright or of any instrument affecting the same" prior to the defendant's entering upon the infringement; the failure either to register a work or to affix notice was not to be probative of the defendant's innocence.<sup>104</sup> Further, a certificate of registration was to be admitted "in any court as prima facie evidence of the facts stated therein" (§ 58).<sup>105</sup> Thus registration of a claim to any interest in copyright had practical advantages. Transferees of interests in copyright had stronger motives for laying down a record in the Copyright Office. Under section 47(b) the instrument of transfer—for a transfer must be in writing (§ 45(c))—was declared "void" against subsequent transferees for value unless filed in the Copyright Office within 60 or 90 days; if registered, the instrument cut off prior unrecorded interests (§ 47(c)). Finally it was provided that no transferee "shall maintain any action under this Act unless the instrument \* \* \* under which he claims shall have first been recorded or registered" (§ 47(d)).<sup>106</sup> The recordation-registration machinery was thus not altogether a voluntary one. Here we should note also that the filing of the affidavit of manufacture for "non-Berne" books worked as a stringent formality (see § 19); and the formalities of notice of use (§ 1(i)) and notice of intention (§ 25(e)) in respect to music mechanically recorded continued much as in the 1909 act.

It is difficult to describe the exact relation between section 58, the prima facie provision, and the provisions of section 29(1) creating various "presumptions." The latter section stated that in actions for infringement the work was to be presumed one in which copyright subsisted and the plaintiff presumed to be the owner of the copyright unless the defendant put these questions in issue, and "where any such question is in issue," the person whose name appeared on the work as author should be presumed the author, or, if an author's name did not appear, then the person whose name appeared as "publisher or proprietor" should be presumed to be the "owner" of the copyright in the work.<sup>107</sup>

(b) *Perkins bill (1925)*.<sup>108</sup>—This general revision bill was drafted by Mr. Thorvald Solberg, faithfully reflects his well-known opposition to compulsory formalities and, proceeding from principle, was simply written. The bill "authorized" adherence to Berne; to a considerable extent effaced any operative distinction between published and unpublished works; in general adopted life-plus-years as a single term of copyright; adopted (but perhaps not so far as the Dallinger bill) the principle of divisibility of copyright; and made notice optional.

There was some uncertainty about the reach of the provision (§ 72) that "Berne works" should not be subject to formalities, a question which might arise in connection with recordation of instruments of transfer.

The bill sharply distinguished between registration intended for record purposes and deposit for enrichment of the Library. As to the latter, it provided (§ 49) that whenever a literary, dramatic, musical or artistic work was published, "it shall be obligatory" to

<sup>104</sup> Cf. § 28(d) (registration imputes knowledge that imported work infringes).

<sup>105</sup> See also § 59 (current catalogs as *prima facie* evidence).

<sup>106</sup> See also § 49 (return of the instrument with certificate; substitution of name in statutory notice).

<sup>107</sup> See also § 29(2) (ownership of manuscript acquired under testamentary disposition of author to be *prima facie* proof of ownership of copyright therein).

<sup>108</sup> H. R. 11253, 68th Cong., 2d Sess., January 2, 1925.

make prompt deposit in the Copyright Office of copies, "not as a condition for securing copyright but for the use of the Library of Congress." (Excepted were "Berne works" other than books republished under certain conditions in the United States.) If copies were not promptly deposited the Librarian of Congress might demand deposit by the copyright owner who on default became liable to a fine (§ 51).

Copyright was secured for all writings of authors "from the time of the making of their works, whether unpublished or published," and was not to depend upon "any conditions or formalities whatever"; but "for the purposes of preserving evidence and facilitating transfers of copyright and rights thereunder, any author or his executors, administrators, or assigns may obtain registration for such work upon complying with the provisions of this Act, and the certificate of such registration \* \* \* shall be admitted in any court as prima facie evidence of the facts stated therein" (§ 1).<sup>109</sup> Under section 45, "The author \* \* \* or the owner of the copyright \* \* \* may, if he so desires, obtain registration" by deposit of a suitable application accompanied by one copy of the work (or identifying matter). The Register after making record of the copyright claim was to return the copy "with a certificate attached" (§ 47). If registration was delayed to the time of publication, application therefor could be made in connection with the obligatory deposits (§ 49).

Transfers of interests in copyright must be in writing to be valid (§ 15) and could be recorded (§ 17).<sup>110</sup> Force was put behind this formality by the provision that "no action shall be maintained for the infringement of the copyright in any work, or of any separate right thereunder, by an assignee of the copyright or of such rights, until the instrument under which he claims shall have been recorded" (§ 17),<sup>111</sup> and by a further provision making transfers unrecorded within 3 or 6 months void as against "a subsequent purchaser for a valuable consideration, without notice, whose assignment has been duly recorded" (§ 18).

Where action was brought for infringement of an unregistered<sup>112</sup> work, copyright was presumed to exist; if an author's name appeared on the work, it was presumed he was the author; if the work was anonymous or pseudonymous, the publisher whose name appeared "shall be entitled to protect the rights of the author" (§ 35).

No manufacturing provisions appeared in the bill, and as mechanical recording rights, in music were not trammelled by a compulsory license, no notice of use or notice of intention to use was provided for.

(c) *Vestal bill* (1931).<sup>113</sup>—This general revision bill envisaged adherence to Berne; covered published and unpublished works in a single comprehensive scheme; in general adopted a single term of 70 years from the date of copyright; embraced the principle of divisibility of copyright;<sup>114</sup> and made notice optional but encouraged it.

With certain exceptions "Berne works" were covered into the bill with other works, so that provisions such as those governing recorda-

<sup>109</sup> See also § 54 (contents of certificate; provision for furnishing receipt for copies of works deposited receipt given *prima facie* effect); § 55 (current catalogs given *prima facie* effect).

<sup>110</sup> See also § 65 (instrument of transfer to be returned after recordation with certificate of record attached).

<sup>111</sup> See also § 34 (appears in part to repeat § 17).

<sup>112</sup> Compare our last paragraph of text discussing the Dallinger bill.

<sup>113</sup> SEN. REP. NO. 1732, February 17, 1931 (calendar day, February 23, 1931), 71st Cong., 3d Sess., reporting H. R. 12549 with amendments.

<sup>114</sup> See § 22 ("vouching in" provisions).

tion of assignments and other transfers would presumably apply to "Berne works."

The bill made it obligatory for the publisher of any literary, dramatic, dramatico-musical, musical, or artistic work published in book, pamphlet, or like form (excepting certain "Berne works") to deposit copies within 30 days of publication (§ 39; see §40 regarding newspapers). On default, the Librarian of Congress could demand deposit, and on continuing default, the publishers could be fined \$100 and twice the retail value, but this would not affect the validity of the copyright (§ 41).

Copyright was granted to authors from and after creation of their works "in all their writings, published or unpublished, in any medium or form or by any method through which the thought of the author may be expressed," without compliance with any conditions or formalities (§ 1). If he so desired, an author or other owner of copyright or of any right, title or interest therein might obtain registration of a claim to copyright in the work or in any such interest upon deposit in the Copyright Office of a copy of the work (or identifying matter) and an application, but if a person other than the author applied, he must at the same time record the instrument under which he claimed (§ 34). Application could be made for registration of any work published or unpublished, and might be sought at the time of the obligatory deposit of copies for the Library (§ 39). The Copyright Office was to have no discretion to refuse to receive an application or to refuse registration (§ 34). Registration inured to the benefit of the author as well as to persons claiming through him (§ 34) and served as constructive notice (§ 43). Prima facie weight attached to the facts stated in the certificate of registration (§ 44).<sup>115</sup> Inducement to register—as well as to affix notice and record instruments of transfer—also arose from a number of provisions shaping remedies for copyright infringement in the light of whether these formalities had been carried out in respect to the work in suit (§ 14(d)(e), cf. § 14(f)(g), § 16).<sup>116</sup>

Transfers of interests in copyright were denied validity except as between the parties unless in writing (§ 9). Then it was provided that "Every assignment of copyright or any right or rights comprised therein shall be recorded" within prescribed times, failing which it was to be void "against any subsequent purchaser or mortgagee for a valuable consideration, without notice, whose instrument has been duly recorded" (§ 10).<sup>117</sup> The Copyright Office was given no discretion to refuse to record a transfer (§ 56). It must return the instrument after recordation with certificate attached (§ 56), and index it by the name of the author, transferor and transferee and by title of the work (§ 10). Recordation served as constructive notice (§ 43). Apparently there was no requirement of recordation of an instrument as a condition of maintaining suit.

A manufacturing clause appeared for books of U.S. authorship; the filing of an affidavit of manufacture was required and within certain limits was made a condition of suit by any person who "might have filed" it (§ 27).<sup>118</sup> No notice of use or notice of intention was

<sup>115</sup> *Prima facie* effect was also given to the receipt for deposited copies, § 44.

<sup>116</sup> The beginning provisions of § 14 are apparently missing.

<sup>117</sup> See the elaborate provisions of this § 10.

<sup>118</sup> See also § 28 (registration and deposit in relation to seizure of importations).

provided for as mechanical recording rights in music were not put on a special footing.

(d) *Sirovich bill (1932)*.<sup>119</sup>—This looked forward to adherence to Berne, although not singling out Berne by name;<sup>120</sup> it covered works whether “publicly presented”<sup>121</sup> or not in a general scheme; adopted a term commencing upon the creation of the work and terminating 56 years after the date of first public presentation (§ 7);<sup>122</sup> enacted “divisible” copyright; and made notice optional but strongly encouraged it.

Foreign works were in general covered into the bill with other works and the main regulatory provisions applied equally to all works.<sup>123</sup>

Two copies of all “copyright works” printed in the United States must be deposited in the Copyright Office within 90 days of publication in this country, with penalties for failure to deposit after Register’s demand. The deposit might be made in connection with registration (§ 36).

The author or an assignee or licensee in the name and on behalf of the author might at any time obtain registration by filing application and depositing two copies of the work if “published in printed form” or one copy (or identifying matter) in other cases (§ 19). The certificate of registration carried prima facie weight as to the facts stated therein (§ 29).<sup>124</sup> Failure to register was not to impair rights (§§ 19, 8), except that in regard to infringements “in good faith” prior to the date of registration of copyright of a work not publicly presented, or more than 30 days prior to registration of copyright of a work publicly presented before the registration, the remedy was confined to an injunction or (in certain cases) to a recovery equivalent to a reasonable license fee not exceeding \$2,500 (§ 8).

Written transfers of interests in copyright could be recorded<sup>125</sup> but the copyright work must first have been registered—that could be accomplished if need be at the time of recording the transfer (§ 17). As between conflicting transfers, “the instrument first recorded shall prevail, except where the party first recording had knowledge of any prior conflicting” transfer (§ 17). Failure to record was not to impair rights (§§ 17, 8), except that a transferee suffered a considerable shrinkage of his remedies for “good faith” infringements prior to recordation (§ 8). Failure to affix notice also affected remedies (§ 9). In general the bill showed a great deal of concern over innocent or nonculpable infringements.

The bill continued a manufacturing requirement for certain domestic works: the owner of any right or license to print or publish in the United States was deprived of his action for infringement where the manufacturing provision was not complied with or the affidavit of manufacture had not been placed on file prior to suit (§ 34). The section 1(e) license of the 1909 act for musical recordings was to continue until 1934 (§ 40(b)); thereafter it was eliminated, and with it the formal provisions for notice of use and notice of intention.

<sup>119</sup> H. R. 12094, 72d Cong., 1st Sess., May 16, 1932.

<sup>120</sup> See § 5(d)(2)(B).

<sup>121</sup> See § 7.

<sup>122</sup> See § 7 (registration deemed a public presentation for purposes of this section; provision for “reversionary interest”).

<sup>123</sup> Cf. § 34 (on manufacture).

<sup>124</sup> See also § 31 (current catalogs as *prima facie* evidence).

<sup>125</sup> See also § 30 (detail on recording; certificates and certified copies of record *prima facie* evidence that assignment or license was recorded on date specified).

(e) *Duffy bill (1935)*.<sup>126</sup>—The general design of this bill was to retain the structure of the 1909 act but to make amendments of it adjusted to United States adherence to Berne “authorized” by the bill. “Divisibility” of copyright was, however, adopted, as was the principle of a 56-year term; some other changes of law crept in; and by the time the bill passed the Senate, special provisions for protection of certain industrial designs had been added (§§ 1(d), 10).

The effect of the bill was to create a fairly sharp difference of treatment between “Berne works” and others. “Berne works” were relieved of formalities (§§ 6, 29), i.e., given “automatic” copyright; they need not in any case carry notice; they need not be registered as a condition of maintaining an action (§ 10). But it may be that remedies for infringement were intended to be cut down if “Berne works” had not been registered or copies circulated in the United States had not carried notice at the time of infringement (§ 17). While the bill reflected Berne in protecting “moral” rights (§ 23), as passed by the Senate it carried a manufacturing clause for works distributed in the United States which was probably unacceptable by Berne standards (§ 11).

Coming to non-Berne works, the bill continued the general features of the 1909 act, which need not here be repeated. It seems copyright could be lost by publication without notice (§ 7) although the specific requirements of the notice were ameliorated (§§ 12, 13). An “unpublished” copyright could be obtained for books as well as other works by deposit with claim of copyright,<sup>127</sup> but this “privilege of registration” did not exempt the proprietor from further deposit when the work was later published (§ 9). The statement of the term of copyright became complex: 56 years from the date of first publication, “or, in case of unpublished works, from the date of creation of the work as shown in the records of the Copyright Office and as indicated by the copyright notice affixed to such work if and when published, or, in the absence of such notice and record, as otherwise proved” (§ 15). As already intimated, registration continued to be a prerequisite to maintaining an action upon non-Berne works (§ 10); and the remedies in infringement actions were confined to an injunction, or the amount of a fair license not in excess of \$1,000, or both, if at the time of infringement the work had not been registered or in the case of published works copies had been circulated in the United States without notice (§ 17).<sup>128</sup>

The provisions regarding acknowledgment and recordation of assignments were extended to all transfers of lesser interests in copyright (§ 24).

An attempt was made to correct difficulties with “portmanteau” works such as periodicals comprising a number of contributions by separate authors (§§ 2, 8, 12). As in some other revision efforts, provision was made for correction of incorrect registration entries (§ 25).

(f) *Daly bill (1936)*.<sup>129</sup>—This followed pretty much the lines of the Duffy bill, but the addition of “performer’s rights” necessitated various changes and addenda. A special ad interim clause was worked into the bill to cover “radio broadcast of any rendition or

<sup>126</sup> S. 3047, 74th Cong., 1st Sess., as it passed the Senate July 29, 1935 (calendar day August 7, 1935).

<sup>127</sup> Section 2 of the 1909 Act (the equivalent of present § 2) was apparently left untouched.

<sup>128</sup> Reconciliation of § 17 with §§ 7, 12, 13 appears to present some difficulties.

<sup>129</sup> H.R. 10632, 74th Cong., 2d Sess., January 27, 1936.

performance" (§ 17, see § 12). The unpublished copyright did not extend to books (§ 11). A "reversionary interest" was created somewhat in derogation of the 56-year term (§§ 19, 25).

(g) *Thomas (Shotwell) bill (1940)*.<sup>130</sup>—This bill was drawn with a view to American entry into Berne (§ 7(1)(c)), but if the bill is hereafter used as an aid in drafting it should be carefully reexamined to determine whether Berne standards were in fact met. Common law protection of unpublished works was preserved, but upon "election" of the author or other owner to come under the act, the provisions of the act became exclusively applicable, and the election was "deemed" made upon any of a number of events (§ 45).<sup>131</sup> The preservation of common law protection required a certain gloss to be put on the opening provision of the bill that "Subject to the provisions of this Act \* \* \*, authors shall have copyright in all of their writings, whether published or unpublished, from and after the creation thereof, without compliance with any conditions or formalities" (§ 2); in the case of unpublished works as to which no "election" was made, it was presumably the common law, not the bill, that provided the protection "from \* \* \* creation." "Divisibility" of copyright was achieved in considerable degree (§ 13, cf. § 21). The duration of copyright was based upon a single term of life plus 50 years (§ 6).<sup>132</sup> Although the bill at one point refers to "publish[ing] any work with notice of copyright" (§ 17(3)), it appears to have made no requirement of affixing notice.

The draftsmen believed strongly in deposit of copies to the end that "the Library of Congress [shall] preserve a complete record of national achievement in literary and artistic works \* \* \*" (88 Congressional Record Appendix 1688). Accordingly they provided that publishers of works distributed in the United States—there is some textual difficulty in determining precisely what works were here intended<sup>133</sup>—must deposit two copies in the Copyright Office within 90 days of their being offered for sale in this country, which in case of works required to be printed here must be accompanied by an affidavit of domestic printing (or the equivalent) (§ 14(1)). Upon publisher's default, the Register might make demand within 2 years after the offering for sale, and on continued default and failure of the publisher to file a "relinquishment and dedication" of the publication right, the publisher became subject to a fine of \$100 (§ 14(1)(b)(c)). "In the absence of timely deposit of copies of any published work," the publisher was deprived of statutory damages<sup>134</sup> for infringements occurring after the 90-day period and prior to the date of deposit (§ 14(4)(a)). "The author of any work protected under this Act, whether published or unpublished, or the owner of any exclusive rights therein" was permitted to deposit a complete copy or manuscript of such work (§ 14(2)) (or identifying matter, § 14(3)); in the absence of deposit "of a copy or manuscript of a completed unpub-

<sup>130</sup> S. 3043, 76th Cong., 3d Sess., January 8, 1940.

<sup>131</sup> The election was deemed to have been exercised by and to be binding only upon an author or other owner who had made or authorized: publication of the work; deposit of the work in the Copyright Office as provided in the bill; the filing of an application for registration in the Copyright Office as provided in the bill; recordation of a grant; commencement of a court action based on any claim to copyright under the bill; the assertion of any claim to copyright under the bill or of any right to remedies for infringement of any such right. (§ 45)

<sup>132</sup> See also § 13(4) (reversionary interest).

<sup>133</sup> See §§ 14(1), 20(1).

<sup>134</sup> See § (19)(3). Statutory damages were to be such as would, in the opinion of the court, be sufficient to prevent their operating as a license to infringe, etc.

lished work within ninety days after completion," those permitted to make the deposit were likewise deprived of statutory damages for any nonwillful infringement occurring after the stated period and before deposit (§ 14(4)(b)).

Registration of a work could be secured in connection with a section 14 deposit (§ 14(5)); and independently of section 14, "[t]he author or any grantee of any copyright or of any right therein secured by this Act" could, if he desired, obtain registration of a work or of any right therein, whether the work was published or unpublished, by making application and a deposit "in the manner provided by section 14 \* \* \*, if such deposit has not already been made" (§ 17(2)). If a grantee applied for registration, the instruments under which he claimed must be recorded in the Copyright Office (§ 17(2)). The information to be supplied in the application was rather more extensive than that required by the 1909 act, and the certificate was correspondingly enlarged (§ 17(2)(a)).<sup>135</sup> Registration if made was to "inure to the benefit of the author, the grantees, and any other persons" (§ 17(2)), and the facts stated in the certificate of registration were given prima facie evidential effect (§ 17(2)(b)).

Omission to register, as distinguished from failure simply to deposit, apparently entailed no loss of statutory damages for infringement; registration, however, called for accompanying deposit, and deposit would no doubt be frequently accompanied by an application for registration.

The Committee sponsoring the bill expressed the view that to assure a good record of ownership stress should be laid on recordation of grants rather than on registration of original ownership.

1. Recordation of grants to use a copyrighted work on [sic: read "or"] rights therein. The provisions of the bill in this respect are of greater advantage to users than the formalities of the act of 1909 providing for a notice of copyright, deposit, and registration. In view of the great variety of uses to which a work can be put at the present time, it is not the original ownership of copyright that is really important but rather a complete record available to the public and users of rights granted by the author, and this is provided for by the recordation of grants in section 16. \* \* \* (86 Congressional Record 77).<sup>136</sup>

According to section 16, "grants" of interests in copyright, which in most cases must be in writing, signed by the grantor, to be "valid" (§ 13(2)), could be recorded if properly embodied in an instrument, the Register being required to return the instrument after recordation "with a certificate of recordation attached" (§ 16(1)). Section 16(2) prescribed what the instrument "shall" contain.<sup>137</sup> Recordation put all persons on notice of the grant to the extent of the statements therein contained, provided the instrument—

contains such sufficient statement therein for the purposes of indexing under section 37 \* \* \* that if fully indexed by the Register \* \* \* as therein provided the recordation of such \* \* \* instrument would be revealed upon reasonable search of the indexes and records of the Copyright Office (§ 16(4)).

<sup>135</sup> The application and certificate must state the "class" to which the work belonged; date of creation title of the work registered, and if the work had theretofore been published or registered under another title, then that other title; name of author; nationality of author; certain data regarding the author if an alien domiciled or residing in the United States at time of creation or first publication; name and address of applicant and if a corporation, the state of incorporation and address of principal office or place of business; if applicant not the author, identification of instruments submitted for recordation and under which ownership was claimed.

<sup>136</sup> See *supra* note 85.

<sup>137</sup> It was to contain name of author or grantor and of grantee; a statement whether it included rights in works thereafter to be created or owned by author or grantor; nature of the grant; date of beginning and duration of the grant; when the grant specifically enumerated individual works, a description of works included in the grant, such as the titles and nature thereof; when the grant included specific rights in any or all works of a particular author, those facts were to be stated.

A grantee, for a valuable consideration who records a grant or other written instrument in good faith without notice of a prior conflicting grant, shall prevail from and after the date of the recordation thereof over the grantee in any such prior conflicting grant regardless of priority as to the date of execution of such grants (§ 16(4)).<sup>139</sup>

Section 37 provided for full indexing of deposits, registrations, grants, and other instruments under a number of captions or headings.<sup>139</sup> Incorrect entries could be corrected by filing "a new and correct application" (§ 35), and "[i]n case of a dispute as to the ownership of copyright" the court "may order the cancellation or correction of any entry" (§ 35).

The elaborate manufacturing and import provisions (§§ 29-31) need not detain us.

#### 4. Canadian law

(a) *Current provisions.*—The present Canadian law may be taken as an example of "optional" registration. Canada is a Berne country basing the term of copyright on life plus 50 years. (See Rev. Stat., 1952, c. 55, § 5; § 12(5) for reversionary interest.) It adopts to a large extent the principle of divisibility of copyright and has no general provisions as to notice.<sup>140</sup> The provisions governing registration of a work or of a grant of interest in a copyright appear to apply equally to all works covered by the legislation including foreign works.

"The author or publisher of, or the owner of, or other person interested in the copyright in any work may cause the particulars respecting the work to be entered in the register" (§ 37(2)). An application "for the registration of a copyright" may be made in the name of the author by any person purporting to be his agent (§ 38(1)), with provision for recovery of damages for fraudulent or erroneous assumption of such authority (§ 38(2)). A certificate of registration "of copyright in a work" is made "prima facie evidence that copyright subsists in the work and that the person registered is the owner of such copyright" (§ 36(2)).<sup>141</sup> Where the defendant in an infringement action proves that he had no reasonable grounds for suspecting that copyright subsisted, the plaintiff is entitled to no remedy other than an injunction; but if at the date of infringement "the copyright" was registered, the defendant "shall be deemed to have had reasonable grounds for suspecting that copyright subsisted in the work" (§ 22).

"Any grant of an interest in a copyright, either by assignment or license"—which must be in writing to be "valid" (see § 12(4),—"may be registered \* \* \*, upon production to the Copyright Office of the original instrument and a certified copy thereof, \* \* \*" (§ 40(1)). The certified copy is retained at the Copyright Office and the original returned to the depositor—

with a certificate of its registration endorsed thereon or affixed thereto (§ 40(2));

Any grant of an interest in a copyright, either by assignment or licence, shall be adjudged void against any subsequent assignee or licensee for valuable consideration without actual notice, unless such prior assignment or licence is registered \* \* \* before the registering of the instrument under which such subsequent assignee or licensee claims (§ 40(3)).

<sup>139</sup> The certificate of recordation was made *prima facie* evidence that a grant or other instrument was recorded on the date specified therein (§ 16(5)); and the receipt for a deposit was given *prima facie* effect as to the facts stated therein. (17(1)).

<sup>140</sup> The indexing was to be "by the following data to the extent disclosed": date of filing, deposit, or recordation; other data corresponding to § 16(2)—"to the end that searches in respect thereof may be readily made by the public."

<sup>141</sup> See, however, § 14(10). As to deposits, see Fox, *The Canadian Law of Copyright* 537 (1944).

<sup>142</sup> See also 36(1).

If the defendant in an infringement action puts in issue the existence of the copyright or the plaintiff's title thereto, then, unless the contrary is proved, (i) the work is presumed to be under copyright and the author is presumed the copyright owner, and (ii) where an assignment or license has not been registered, the person named on the work as the author is presumed to be such, or, failing such indication on the work, the person whose name appears on the work as publisher or proprietor is presumed to be the copyright owner (§ 20(3)).

The Canadian act looks to the issuance by Government authority of rules and regulations prescribing forms of application, methods of recordkeeping and indexing, and the like. There is provision for rectification of entries in the registry books upon application by the Registrar of Copyrights or an aggrieved person to the Exchequer Court (§ 40(4)).

(b) *Report on Copyright (August 1, 1957) of the Royal Commission on Patents, Copyright, Trade Marks, and Industrial Designs.*—This recent Canadian report does not dwell on how the registration features of the present Canadian law have been working out in practice, but nevertheless recommends repeal of the basic relevant provisions. Section 36 of the law (prima facie provisions) is objected to as unfairly shifting the "burden of proof" in infringement actions to the defendants—unfairly, because a registration certificate may issue on the ex parte statement of an applicant (report, p. 37). If section 36 is to be repealed, as the Commission recommends, then it is thought that the provisions relating to registration "may as well be repealed," and the Commission so recommends (p. 37).<sup>142</sup> Section 22 (regarding innocent infringement) is also disapproved: "we could not recommend the maintenance of a registry merely for the purpose of making it impossible for a defendant in an infringement action to prove that he had no reasonable ground for suspecting or believing that copyright subsisted in a work" (p. 38). The Commission further recommends repeal of the present provisions for registration of assignments. It was of the opinion that "the only provision that would be helpful in any substantial degree would be a provision making the enforceability of an assignee's copyright conditional on registration before the act of infringement complained of" (p. 38); this would be "an exceedingly useful provision" because "most copyrights are owned by assignees (e.g., the assignees of performing rights in musical works)," and the provision "would enable any member of the public to ascertain definitely the owner of any assigned copyright work" (p. 38). But in addition to being "expensive in its operation," such a provision "might be regarded by some as of doubtful consistency with one or both of the conventions with which we think Canada should comply," namely, the Rome Convention and the Universal Copyright Convention (so far as they limit formalities). Accordingly the Commission does not recommend enactment of any provision in substitution for the present sections dealing with registration of assignments which are recommended for repeal.<sup>143</sup>

In an earlier passage of its report the Commission had taken note of an argument that present section 40(3) (unregistered grant of an interest in copyright void as against subsequent bona fide grantee for value) conflicts with the Rome Convention and the Universal Copy-

<sup>142</sup> See Report, p. 37, for comments on other presumptions created by the present Canadian statute.

<sup>143</sup> See Report, pp. 114, 115, for further remarks on assignments and licenses.

right Convention. If that were so, said the Commission, then a provision making enforcibility of an assignee's copyright, dependent on registration prior to infringement would a fortiori offend against the convention. The Commission however, concluded: "If we were called upon to express an opinion, we would, we think, say that such a provision would not offend against either convention and it may be that at some future time Parliament will take this view and wish to enact such a provision" (p. 36). More generally, discussing the question "Should Canada remain a member of the Berne Union?" (p. 17), the Commission stated:

Specifically, there is reason to believe that the ownership of copyright in a work, or the partial ownership, or rights to use a work in various ways, arising out of assignments, partial assignments, licensing agreements, etc., ought to be ascertainable with greater certainty and less difficulty than is now possible. It is not difficult to foresee a time when suitable provision for registration of such rights would be in the general interest.

If Canada is to remain a party to the convention, we believe our representatives should bring these and related matters forward when revisions of conventions are under consideration (p. 18).

#### C. NO REGISTRATION: THE POSITION IN BERNE COUNTRIES, PARTICULARLY THE UNITED KINGDOM

As appears from our summary of Canadian law, it is open to a Berne country to maintain a system of "optional" registration for all works, domestic and foreign. Indeed, adherence of a country to Berne is consistent with its imposing even compulsory formalities on domestic works. In a large number of Berne countries, however, there is no provision of law for any official registration or recordation.

##### 1. Sources of information concerning copyright

How do authors and users get along in countries which altogether dispense with these devices? Inquiries made by the Shotwell Committee resulted only in its securing a number of inconclusive opinions. A June 1957 memorandum of the Copyright Office, based primarily on material issued by authors' and publishers' societies, approaches the problem in a promising way, but quite understandably does not exhaust it.

The memorandum, entitled "Survey of Substitutes for a Registration System Used in Berne Union Countries," describes the sources to which one may go in those countries to satisfy himself about the status of a work or to locate the person having the power to make a particular copyright grant. Aside from usual library materials, there are said to be three main sources: performing rights societies (and in one or two countries other societies of authors), publishers, and *dépôts légaux* (which may provide the basis for national bibliographies).

Various performing rights societies in Europe—together comprising an extensive network—collate, file, and index information received from members or gathered from other quarters. The methods employed and the coverage achieved by these societies vary considerably. SACEM (Société des Auteurs, Compositeurs, et Editeurs de Musique) is an example of an organization having an elaborate and effective system of recordkeeping. Summarizing the "elements of a registration system" inherent in SACEM's system, the Copyright Office memorandum lists:

\*\*\* deposit of the work both as an unpublished manuscript and as a published work together with a document identifying the work; authentication by

the seal of the society of the unpublished work as a means of proof of ownership; examination by the society to avoid unfounded or infringing elements in the work; use of notice as a warning to the public on works to be distributed in other countries; validation of assignments and transfers of ownership to heirs; and a permanent file or catalog of the works controlled by means of which information about the ownership and status of the work can be given to persons interested in the property (pp. 9, 10).

It is reported that "in several countries" registration of a work with a performing rights society is accepted as "prima facie proof of ownership" (p. 10). The extent to which users are given access to the records of the societies for purposes of verifying facts of status or ownership does not appear from the literature. Nor do we know how far the societies are prepared to warrant or guarantee the status or ownership of works in their repertories or their own power to grant rights in these works on behalf of the owners. Perhaps we can take it that where a strong performing rights society purports to control a particular work, an intending user can deal with the society with fair assurance that status and ownership will be correctly represented.

In the large field of works to which the activities of these performing rights societies do not extend, users are obliged to go to publishers, authors, and authors' agents for necessary information. Users can request copies of documents evidencing prior transactions so far as disclosed and consult the parties to those transactions. Authors' and publishers' associations, although not ordinarily empowered to deal with members' works, may collect trade information and make it available to members and perhaps to outsiders.

Many Berne countries seek to maintain in their national libraries collections of works domestically produced or published. These libraries may be constituted *dépôts légaux*, that is, publishers, printers, or others may be required by law to deposit designated types of works in the libraries at or near the time of their production or publication. The deposit systems are not associated directly with the copyright law. Although the deposit requirements may be enforceable by fine or penalty of some kind, it seems that the libraries generally are reluctant to attempt legal action; they may however use other means of suasion. Where deposits form the basis of national bibliographies, authors and publishers have a clear motive for making deposits. In the principal countries we may expect the collections to be reasonably complete for books, periodicals, maps, and music. It should be emphasized that the legal deposit requirements do not cover all classes of works—in the United Kingdom, for example, works of the graphic arts, motion pictures, and phonograph records are outside the compulsory deposit system.

The main purpose of the collections and bibliographies is, of course, to preserve the national cultural achievement. A large body of information useful in finding and tracing copyright data is, however, incidentally afforded by the deposited works, the library records, the receipts given for deposited works, and the bibliographies; and the library or its "receipt office" may in time become a place to which users regularly apply for help in copyright matters. Such inquiries are made in large numbers at the British Museum.<sup>144</sup>

<sup>144</sup> Stationers' Hall in London still carries on a registration function, but this is unofficial and we understand that few items are registered there.

## 2. Rules of law helping to locate ownership

If a copyright system with "optional" registration and recordation feels some pressure to build up a set of complementary regulations to aid in the efficient determination of the person in whom copyright or some interest therein subsists at a particular time—as is shown, for example, by Canadian law—the pressure toward regulations of this type might be expected to be at least equally strong where a copyright system abandons formalities altogether. It is difficult and hazardous to answer for any foreign system how far such regulations exist. Very likely they will not be found solely in the text of the copyright statutes but also in principles of bona fide purchase, implied and express warranty, etc.<sup>145</sup>

The new British statute attempts at several places to define who is the copyright proprietor upon the initial creation of various kinds of work. (See §§ 4, 12(4), 13(4), 14(2), 15(2).) Section 20, on "proof of facts in copyright actions," sets up a number of presumptions as to copyright status and ownership. An illustrative provision is as follows: Copyright is presumed to subsist in a work if the defendant does not put the matter in issue; and where the subsistence of copyright is thus presumed (or proved or admitted), the plaintiff is presumed the owner according to his claim if the defendant does not put ownership in issue (§ 20(1)). Subject to this rule, where in the case of a literary, dramatic, musical, or artistic work an author's name appears on the copies published or made, he is presumed the author and (with possible exceptions) the proprietor (§ 20(2)).

"No assignment of copyright (whether total or partial) shall have effect unless it is in writing signed by or on behalf of the assignor" (§ 36(3)).<sup>146</sup> There does not appear to be any specific provision about conflicting assignments. But section 36(4) states with regard to licenses:

A licence granted in respect of any copyright by the person who, in relation to the matters to which the licence relates, is the owner of the copyright<sup>147</sup> shall be binding upon every successor in title to his interest in the copyright, except a purchaser in good faith for valuable consideration and without notice (actual or constructive) of the licence or a person deriving title from such a purchaser; and references in this Act, in relation to any copyright, to the doing of anything with, or (as the case may be) without, the licence of the owner of the copyright shall be construed accordingly.<sup>148</sup>

"Prospective ownership of copyright" is regulated by section 37. False attribution of ownership is elaborately treated in section 43.

An "innocent" infringer is relieved of damages in these terms:

Where in an action for infringement of copyright it is proved \* \* \* (a) that an infringement was committed, but (b) that at the time of the infringement the defendant was not aware, and had no reasonable grounds for suspecting, that copyright subsisted in the work \* \* \*, the plaintiff shall not be entitled under this section to any damages \* \* \*, but shall be entitled to an account of profits \* \* \* whether any other relief is granted under this section or not (§ 17(2); see also § 18(2)).

This provision is probably not as broadly exculpatory as it may seem to be since copyright arises without formality and the defendant in

<sup>145</sup> See *Report on Transfers of Copyright* in 2 UNESCO Copyright Bull., Nos. 2, 3, at 104 (1949).

<sup>146</sup> See also § 19(9) as to exclusive licenses.

<sup>147</sup> See also §§ 19, 49(5)(7).

<sup>148</sup> The clause "except a purchaser \* \* \* such a purchaser" in this § 36(4) is explained in the Canadian Report as "based on English case law which regards a license \* \* \* as creating an equitable interest." (p. 115) The Report objects to treating a license as an equitable rather than a legal interest and therefore recommends against adopting this clause.

the usual case may well be held to have "reasonable grounds for suspecting."

As has been already remarked, it is hard for an outsider to form judgment about the total effect of these provisions and of common-law principles in facilitating determination of copyright status and location of ownership.

### 3. *A note on conversations in England*

Judging only from a few very sketchy conversations which the present writer had with employees of the BBC and the Publishers' Association in London during the summer of 1956, it is doubtful whether any sentiment could be found in England for creating a compulsory system of registration or recordation, and it is probable that even an "optional" system would meet considerable opposition.<sup>149</sup> Apparently few if any practical difficulties were encountered in acquiring rights from performing rights societies. As to acquisition of rights not within the purview of these societies, no particular need seemed to be felt for improving on the customary method of consulting reference aids and communicating direct with publishers, authors and authors' agents and making such inquiries of these people and others as the situation might require. It was recognized that these procedures involved risks. Problems could be met in some cases by exacting warranties, although it appeared that BBC insisted on warranties in few cases apart from those where fresh unpublished material was to be used. (It would be interesting to inquire among American users of foreign works how often the absence of European official registry systems embarrassed transactions.)

One of the men interviewed said that he had seen American Copyright Office searches and thought them admirably complete. He was not disposed to talk down the American registry system. He said, however, that if there were an official registry in England, lawyers would naturally insist that full searches be made; these on the one hand would slow down operations and on the other hand could not in the nature of things solve the marginal cases presenting hard legal questions. Moreover he felt—here echoing the copyright committee report—that some price of uncertainty of legal relationships could well be paid for a system which avoided all formalities and therefore all possibilities of slipups forfeiting copyright.

The somewhat idyllic British picture just given is based on very inadequate investigation and fails to take account of many obvious considerations. For example, does the present English procedure hinder exploitation of works not falling in the repertoires of performing rights societies? of literary works not published by prominent publishers whose say-so about copyright status would be accepted by users?

In all events, in the United Kingdom, as elsewhere, there is a considerable amount of private recordkeeping and invariably there is a concern with establishing the status of works. The question is whether an official registry of one or another type brings better results at a reasonable cost.

<sup>149</sup> Compare, however, an exchange between Mr. Herman Finkelstein and Mr. F. G. Skone James, Jr. 26, 1957 (Section of Patent, Trademark and Copyright Law of the American Bar Association, 1957 Summary of Proceedings, New York and London, p. 53): "Mr. Herman Finkelstein asked why the British law did not provide for voluntary registration to simplify keeping of records. Mr. Skone James replied that this would be desirable."

## VII. RECAPITULATION OF MAJOR ISSUES; CONCLUDING OBSERVATIONS

As has already been emphasized, a proposal about registration can be evaluated only if one knows the legal complex (not only national but international) into which it is to be fitted. Further, the acceptance of a particular proposal "in principle" may still leave open a number of questions of detail which are of no small importance. Some of the relevant details have been mentioned in the course of this study and these could be proliferated.

At some risk of putting questions which can only be satisfactorily answered on the basis of elaborate and varying assumptions about the rest of the copyright law, or which are insufficiently detailed to be entirely meaningful, we may summarize the major issues to which the draftsmen will have to respond.

### A. MAJOR ISSUES

1. Should the copyright law provide for an official system for registering claims to copyright?
2. What are the major facts which should be elicited by registration? (Particular attention should be paid here to the facts that ought to be elicited upon registration of a "derivative" work.)
3. Saving all cases where particular regulations for foreign works are forbidden or are determined by our international commitments, should registration be "mandatory" or "optional"? A mandatory system is here taken to be one in which to an important extent copyright protection is lost if registration is not timely made.
4. If the system is to be a mandatory one:
  - (a) Should registration be a condition of investing copyright?
  - (b) Should copyright be divested if registration is not made by a stated time?
  - (c) Should there be a loss of all remedy for all or certain types of infringement occurring prior to a late registration?
5. If the system is to be optional, how far should registration thereunder be induced by relatively mild sanctions or encouraged by special advantages:
  - (a) Should registration (or official refusal of registration) be required in order to maintain an action for infringement?
  - (b) Should the availability of statutory damages or other special remedies for infringement be contingent on registration by a stated time or registration prior to the particular infringement or action for infringement?
  - (c) Should registration by a stated time prior to the infringement defeat altogether or on stated conditions a defense of a so-called innocent infringement?
  - (d) Should copyright be divested if an ultimate official demand to register has not been complied with?
  - (e) Should registration be required as a prerequisite to recording transfers of interests in the copyright?
6. What degree of evidential strength should be accorded to the certificate of registration, and with respect to what facts or issues?

## B. CONCLUDING REMARKS

It does not seem likely that the United States will revert to a system in which registration is a condition of investing copyright. The practical choices range from a requirement of registration ultimately sanctioned (except as to foreign works where international arrangements forbid) by loss of copyright previously secured, through registration encouraged or impelled by various advantages and mild sanctions, to the abolition of registration altogether. If some form of "optional" registration is to be adopted, there will be particular need for decision about the stage at which incentives and sanctions should be made to converge so as to bring about the desired registration.

Points not much stressed in the present paper but deserving attention are the possibility of modulating the registration system to accord with any special needs of particular classes of works while at the same time preserving the benefits of unified records which will give access to all works for a single author and all works deriving from a given work; the sanctions to attach to a false or erroneous registration (or recordation); presumptions as to ownership and other matters which might attach apart from registration; warranties upon the transfer of interests in copyright.

Cutting across registration as well as other subjects now under study is the breadth of the rulemaking and other powers to be vested in the Register of Copyrights. Shall the framing of application forms and certificates, the design and management of records, be regulated in detail by the statute or left to the Register to work out under general standards? To the extent to which the Register is given power, the question of affording administrative hearings within the Copyright Office is naturally presented. This question of hearings was discussed by the Register as early as 1938<sup>150</sup> and will probably have to be faced as a broader issue in the current revision effort.

Problems in the field of copyright have customarily been considered as specialties unconnected with other branches of law. If the present paper breaks only slightly with this parochial tradition, it is only because of limits of time on research. We should assume until the contrary is shown that studies of registration and recordation systems outside the copyright field would throw light on the system to be applied to copyright. Especially would this assumption seem justified with respect to registry systems for interests in intangibles. Finally we can only point to possibilities which may lie ahead in the use of machine methods for registration, recordation and search.

<sup>150</sup> See *Letter to the Librarian of Congress Concerning Certain Aspects of the Copyright Act of March 4, 1909* (1938), at pp. 64-72.

---

COMMENTS AND VIEWS SUBMITTED TO THE  
COPYRIGHT OFFICE  
ON  
THE REGISTRATION OF COPYRIGHT

---

## CONTENTS

---

Comments and views submitted by—	Page
George E. Frost.....	71
Samuel W. Tannenbaum.....	72
Robert Gibbon.....	73
Ralph S. Brown.....	73
Edward A. Sargoy.....	74
Walter J. Derenberg.....	77
Elisha Hanson.....	79
Ellen Jane Lorenz.....	79

## COMMENTS AND VIEWS SUBMITTED TO THE COPYRIGHT OFFICE ON THE REGISTRATION OF COPYRIGHT

By *George E. Frost*

OCTOBER 5, 1958.

A few comments on the Patent Office examining procedure and experience may have some value in connection with the subject of copyright registration.

There was a period—from 1793 to 1836—when patents were issued on a registration system somewhat similar to the present copyright registration procedure. An intolerable situation resulted, with overlapping and conflicting issued patents and a considerable number of fraudulent patents. See the report of the Ruggles Committee of the Senate in 1836, reprinted at 18 JI. Pat. Off. Soc. 853. In 1836 the registration system was superceded by the present examination system. Despite the criticism that has been made of the Patent Office, there is essentially universal agreement that the examination system has been successful and that it is essential to a practical patent system in this country.

The main emphasis in the patent examination is the "prior art" and the search by which the examiner locates that art. Similarly in the case of trademark registration applications the principal emphasis is on the search of prior uses of the same or a similar mark. Both of these are, of course, irrelevant to a consideration of copyright registration, for the originality concept of the copyright law makes "prior art" immaterial.

In other respects, however, the Patent Office experience bears consideration. The Office never has confined its attention to the matter of prior art. Rather, it has a long history of interpreting the patent and trademark law. Perhaps the most vivid example occurred during the time when the patent registration system was being followed. Impressed by the practical need to correct issued patents, the Secretary of State issued reissue patents even though the statutes were silent on the subject. In the classic case of *Grant v. Raymond*, 31 U.S. 208 (1832), the Supreme Court sustained a reissue. Later in that same year a statute providing for reissues was passed.

More recently, the Patent Office has been the source of creative doctrine on the subject of patentable subject matter. An excellent example is found in *ex parte Scherer* (103 U.S.P.Q. 107), where the Commissioner and essentially all members of the Board of Appeals determined that letters patent could issue for a method of treating the human body. In *ex parte Haig and Haig* (118 U.S.P.Q. 229), Assistant Commissioner Leeds recently held that a bottle configuration could be registered on the principal register of the 1946 Trademark Act. In both the patent and trademark field the Patent Office has taken the position that it is responsible for determining in the first instance whether there is or is not proper subject matter.

Another facet of the Patent Office examination procedure warrants consideration. This is the effect of the examination in fixing the scope of the patent or trademark registration. In the patent field the "file wrapper estoppel" doctrine is the most vivid example of this effect. See *Exhibit Supply Co. v. Ace Patents Corp.* (315 U.S. 126). In the trademark field the best example is the formal "disclaimer." See *P. D. Beckwith's Estate v. Commissioner* (252 U.S. 538 (1920)).

When we turn to a consideration of the Copyright Office operations, we find the rudiments of both the examination as to subject matter and the idea that the subject matter of the copyright should be defined. In both instances, however, the matter is handled gingerly and often with a disclaimer by the Office of any responsibility. This may be sound policy—and it apparently does please a segment of the bar. But the above comparison with the Patent Office history at least raises the question of whether the copyright system might be more effective if the Office took a different approach.

In *Mazer v. Stein* the Copyright Office did take a forthright and definite position and could point to a history of registration practice going back almost to 1870 to support its position. In my opinion the Office was a real source of creative

doctrine in this instance and was performing a function of the kind it is especially equipped to perform.

In the *Ballentine* case the Office took a different approach. It disclaimed any intent to interpret the law and characterized its practice as mere expediency in view of doubt as to the law. What would have happened if—when the matter first arose many years ago—the Office had (1) taken the firm position that children are entitled to renew during the lifetime of the widow or (2) taken the opposite position and refused such renewals? In the latter instance we presumably would have had a court action and a decision one way or the other. *Cf. Brown v. Warner* (161 F. (2d) 910). In the former instance we would have had the Office backing up its position in the Supreme Court. In either event the Office would have filled the gap in an ambiguous statute in a way that would appear to be in the public interest.

Turning now to the issues listed at page 64 of the Kaplan piece, it seems to me that the answers to them might be as follows:

1. There should be a registration system.
2. Insofar as possible the data supplied on registration should enable others to determine what is and what is not the subject matter of the copyright. This includes, for example, specifying sources from which a work is derived.
3. With the exception indicated, registration should be mandatory.
4. My own feeling is that a time limit along the lines of the proposed ornamental designs bill would be desirable. At the very least, sanctions must be adequate to assure registrations and some time period more definite than that now in the law should be used. One possibility—if the fixed limit of the designs bill is considered too rigid—is that of providing for “intervening rights” along the lines applicable to reissue patents. See 35 U.S.C. 252.
5. No answer required.
6. My own feeling is that the present prima facie rule should continue to apply.

Sincerely yours,

GEORGE E. FROST.

---

*By Samuel W. Tannenbaum*

OCTOBER 7, 1958.

Prof. Benjamin Kaplan's study, “The Registration of Copyright,” is a comprehensive and scholarly exposition of the origin and historical development of registration in the law of copyright in the United States and foreign jurisdictions. In addition to the detailed reservoir of reliable data, it crystallizes the essential elements which must be considered in the program for revision of the U.S. copyright law.

In my opinion, based upon my daily experience in the field of copyright, as consultant and adviser to creators and users of intellectual properties, the principal features of the existing provisions of copyright registration should remain undisturbed and the practical aspects of registration, in the light of existing uses and trade practices should be carefully considered.

I am, however, opposed to any mandatory requirement of registration as a condition for securing copyright protection. The practical benefits of registration with deposit of copies have been demonstrated over the years. Section 12 of the Copyright Act, which provides that registration with deposit of copies should be a condition precedent for actions or proceedings for infringement should be preserved. It requires a claimant to establish a public record where litigants and prospective users can identify the particular work. It also facilitates the search to determine the essential data, such as the origin of the copyright, the date of publication (which is synonymous with the date of copyright), the work protected, the copyright claimant and other important information. It furnishes a point of commencement from which the record can be searched to ascertain the chain of title, the dates and owners of the renewals of copyright, and the last copyright proprietor of record. In short, a clear picture of the U.S. copyright status of a work is readily obtainable.

It has all the advantages of the recording acts pertaining to real property. On the other hand, private recordkeeping would be chaotic and unreliable. It would not have the stamp of official authority which has long existed under our present Copyright Act. While the foreign system of private recordkeeping may be adequate, as the volume of copyrightable material produced and the uses thereof are small, such system would be inadequate for the needs of American industry.

In litigation, the public recording system also makes for facility of proof of the essentials. By the continuance of the present system, making such public record

and entries in the U.S. copyright catalogues prima facie evidence, the first step in judicial proof is made available and a great deal of time and expense is saved. I do not maintain that certain features in the content of registrations should not be improved. I would restore the inclusion of the reference to the prior title of a work previously published in a foreign country. While this practice was followed to a great extent during the regime of Register of Copyrights Thorvald Solberg, it has been abandoned for some time, in the interest of economy. Then, too, for a time, up to 1953, extensive surplus information such as summary of plots of motion pictures, credits, casts of actors, etc., were included in the U.S. copyright catalogues. Nowhere in the Copyright Act had there been, nor is there now, any authority for the inclusion of such matter. (See Secs. 209, 210.) If the copyright catalogue is "prima facie evidence of the facts stated therein," an incomplete or inaccurate summary of the plot prepared by the Copyright Office staff in the catalogue might be prejudicial to the copyright proprietor seeking judicial relief. It might require a copyright proprietor to establish proof to negate the incorrect and unauthorized matter in the catalogue.

To abandon the long-established system of registration would cause great havoc and confusion.

It should not be overlooked that the system of registration with the deposit of copies of the work is an invaluable source of material for the Library of Congress. Virtually all reputable publishers seek to register works they publish at the earliest possible moment, in spite of the *Washingtonian* case. As a result, the Library receives, free of cost, a vast amount of important literary work.

Very truly yours,

SAMUEL W. TANNENBAUM.

---

*By Robert Gibbon*

(The Curtis Publishing Co.)

OCTOBER 24, 1958.

*Registration of Copyright.*—So long as there is provision for registration of copyright, there will be formalities and procedures to be followed by the proprietor in order to obtain statutory protection. It is our belief that it is essential for the formalities and procedures to be spelled out in such detail that any conscientious person can follow them easily and with the assurance that he has properly protected his interests. Similarly, we believe that there is no reason why the law should create doubt as to the status of a copyright if any of the formalities or procedures are not fulfilled. It should not be necessary to deprive a person of copyright protection because of his own inadvertence unless by his failure some innocent party has been injured or exposed to loss. The requirements for registration and deposit of copies are not unreasonable, and we agree that a statutory time limit should be established to resolve the doubt created by the *Washingtonian* case.

ROBERT GIBBON.

---

*By Ralph S. Brown*

NOVEMBER 12, 1958.

\* \* \* Professor Kaplan's \* \* \* [study is] \* \* \* unusually helpful and \* \* \* has the added advantage of combining depth of scholarship with a very careful identification and criticism of the numerous alternatives. My own attitude toward registration is conditioned by a preference for the retention of some kind of required claim to statutory copyright, as opposed to the concept of automatic copyright on either creation or dissemination. However, in the light of our experience and that of other countries, I am persuaded that, for published works, registration should not be a necessary condition for the creation of copyright, nor should continued failure to register have any divestitive effect. The only area where there appears to be any case for requiring investitive registration is in connection with subjects of copyright that can carry only very abbreviated forms of notice. This problem is confined almost entirely to matters covered by the proposed Design Bill, and could be left to that legislation for disposition.

Registration appears to be essential as a means of claiming statutory copyright in unpublished works (if we are to retain any formalities at all). It appears to be desirable in order to provide both copyright owners and users with some formal

record of the claims with respect to any kind of work, and to serve as an initial link in the "chain of title" provided by a recordation system.

The problem then is to provide sufficient incentives for registration, or sanctions against nonregistration, without going so far as to create forfeitures of copyright. Professor Kaplan's study directed my attention toward the provisions of the Shotwell Bill (pp. 56-58 of the study) as establishing a reasonable middle ground. Particularly, we might encourage the registration of unpublished works by giving their authors access to the statutory forum and remedies for all classes of such works if they were registered. The deposit of published works might be induced by continuing the present prima facie effect of registration of such works (with perhaps the added requirement that "prompt" registration be required). Registration as a condition precedent to litigation, under the *Washingtonian* doctrine, seems to me about the feeblest sanction, and one that unduly tolerates delayed registration.

It seems to me that the requirement of registration of the work as a starting point for recordation of transfers of any interests in the work is an effective way to encourage registration for its own sake and to strengthen the recordation system. One need not go so far as to compel registration by the original author if he is unavailable or uncooperative at the time when an attempted recordation of a transfer creates a need for registration. Ordinarily, however, it would appear to be to the author's advantage to see to it that his own first transfer of any substantial interest was properly connected to registration of the work.

\* \* \* \* \*

RALPH S. BROWN.

By *Edward A. Sargoy*

NOVEMBER 13, 1958.

I have read with the keenest interest Professor Benjamin Kaplan's pervasive and thoroughgoing historical and comparative study of the position of registration, with particular reference to the British, United States, and Canadian experience. He has indicated some of the problems in the interpretation of present deposit and registration provisions, has explored to some extent the values of the present U.S. system, and has given us a very informative description of the operations of the Copyright Office relating to registration. He has also discussed various alternate schemes as presented in the experience of our own and other countries.

Some of our panel members have long urged, as you know, that registration, like other major aspects of copyright, cannot be considered in a vacuum. As Professor Kaplan most aptly puts it, any proposals about registration can be evaluated only if one knows the national as well as international complex into which it is to be fitted. To answer the questions put at the end of Professor Kaplan's study, there must be some assumptions, as he points out, about what we think the rest of the copyright law ought to be.

In such regard, then, I refer to certain basic concepts of a Federal copyright system which, with others, I have felt might reasonably underlie general revision in principle, although not necessarily in detail. These concepts were drafted by me for the Report of the Committee on Program for Revision of the Copyright Law, presented at its 1957 annual meeting in New York City to the section of Patent, Trademark, and Copyright Law of the American Bar Association. This Report was, as you will recall, for general informational and study purposes without, however, committing the Committee or any of its members signing the Report to any position thereon. As a frame of reference, it is a good springboard of underlying assumptions for a new copyright law from which I can personally leap to the questions posed by Professor Kaplan, since I am in general sympathy in principle with such views although not unequivocally committed to them or to details that may be presented in their support, if the panel studies should indicate the advisability of other courses. I merely quote the following summary statement of the above report as to each point as sufficient for the purposes of this commentary, although each of such points is more fully outlined in the Report.

"1. *Automatic Protection From Creation.*—There should be Federal statutory protection, without mandatory formalities conditioning either the recognition or the continued enjoyment of the right, automatically from creation, before as well as after publication.

"2. *An Exclusive Federal System.*—A single system of protection and enforcement, under Federal law exclusively, should be provided for the incorporeal

property in literary and artistic works expressed within the constitutional meaning of "writings," including transactions where the incorporeal property is mortgaged or otherwise given as security or collateral, and the foreclosure of such liens.

"3. *Permissive Formalities.*—Notice of copyright need not be mandatory for published works and a strong system of deposit and registration in a central office, but without conditioning the basic right, should be provided, with powerful incentives under the statute, to provide general registration and deposit.

"4. *Divisibility and Recordation of Grants.*—Divisibility should be recognized in the enforcement of rights, as well as in the permissive recordation of general or limited grants thereunder so as to be effective notice to third parties, with careful and detailed provision for an exclusive Federal system of recordation, conveying, and searching.

"5. *Renewal and Duration.*—The renewal concept should be abandoned as outmoded and confusing, and termination of protection should be predicated upon a stated period (preferably the end of the 50th calendar year), after death for individual authors, and after first public presentation, or deposit and registration, in the case of authors for hire and anonymous and pseudonymous authors.

"6. *Remedies.*—The principles found so efficacious under the Act of 1909 in providing a system of sanctions and remedies, for the incorporeal property created by the statute, to deter piracies of use and insure licensing of large and small rights, by its criminal and administrative provisions, as well as in the civil remedies of injunction, seizure, impounding, destruction, and monetary recoveries by way of actual damages, should be substantially preserved, with appropriate safeguards to prevent unduly harsh recoveries against multiple innocent secondary infringers who are unaware of the primary infringement committed by the originating source of the infringing presentation."

I will proceed now to the major issues presented at page 64 of Professor Kaplan's study.

1. I feel very strongly that the copyright law should provide for an official system for registering claims to copyright. Professor Kaplan has made it abundantly clear that some system is necessary to ascertain wherein rights under copyright lie, and how they may be marketed. A combination of private, unofficial, public, and semipublic places exist in European countries whereby this information may be obtained from author societies or performing rights societies, libraries, museums, agents, and attorneys representing owners of rights. Our author and performing rights societies in the United States do not have the semiofficial status that exists for them in certain European countries; indeed, we have here competing societies in the same field. There is usually, also, a single city in a comparatively small country geographically to which one can resort in Europe, such as London, Paris, or Rome. It would be infinitely better that we have one central official place in our very large country, and there is no more logical place than the experienced Copyright Office in Washington, D.C., as a department of the Library of Congress and the Government.

2. I think that, generally, the major facts to be elicited by registration should be those which bear upon the nature, description, validity, and ownership and registration of the copyright in the United States. I personally would prefer all such facts to appear in a registration, and on a certificate of registration, as would be sufficient to establish a prima facie case of ownership of a valid copyright, if such were not genuinely in question, so that the issue in a copyright infringement action involving essentially unlicensed small use, would be narrowed down to whether the right had been exercised, and if so, whether or not it had been appropriately licensed.

I think this is a matter of great importance in the economy of copyright. There are millions of small licensed uses of copyrights annually which are handled in the normal course of business by way of small fees ranging from fractions of a penny to a few dollars per licensed use. Tremendous investments of labor, time, and money may have been made in the creation of the copyright so marketed, which investment can only be recouped from mass licensing of small uses. Tens of thousands of small performing uses, publicly for profit, may be given of a copyrighted song daily, for example, and hundreds of daily such uses of a copyrighted motion picture. In the aggregate, millions of such uses of music are given annually for which the fee is measured in pennies, and millions of motion picture exhibitions at theaters for which the daily license fee is less than \$20. Innumerable publications of copyrighted advertisements are given for small license fees. There are many other copyrighted works where small licensed uses are involved. As pointed out in my respective comments on Prof. Ralph Brown's study on "The Operation of the Damage Provisions of the Copyright

Law" and William Strauss' study of "The Damage Provisions of the Law", it is only under the copyright statute and its sanctions against nonlicensing users, that the availability of the necessary mass markets for small and generally ephemeral rights exercised under copyright, can be assured under our American system of law. It would be an anomaly to permit such nonlicensing users who have evaded payment of the small, if not actually nominal license fees, to put in question the entire validity of the copyright by a denial of lack of knowledge or information sufficient to form a belief as to the allegations in respect thereof, when the only genuine issue is whether they did in fact exercise the small right without license or payment. The copyright proprietor is put to the tremendous expense of producing a variety of witnesses, or taking depositions in various parts of the world, perhaps many decades after the copyright was obtained, when witnesses are dead, and evidence difficult or the facts unavailable, to prove each of the many facts involved in establishing the valid ownership of a copyright or certain exclusive rights thereunder, when the only real issue is whether the user obtained the necessary permission for his use which could have been purchased for a few pennies or dollars.

As to the major facts to be elicited on registration, I think Chap. II (Secs. 15-17) of the so-called Shotwell bill introduced by Senator Thomas (S. 3043, 76th Cong., 3d Sess. Jan. 8, 1940), gives some excellent ideas. Among others, I would suggest: the class of work; date of creation; whether published or unpublished; title of the work for which registration is claimed, and if theretofore published or registered under another title or titles, a statement thereof; name of the author; country of which the author is a citizen or subject at the time of making the application for registration; the same for the time of creation; the same for the time of first publication; the date and place of publication, and whether all copies published from and after first publication, under authority of the owner, bore a notice of copyright, and if so, the nature and location of such notice on the published copies; if the author was an alien domiciled or residing in the United States at the time of the creation or first publication of the work, a statement of such fact, including the time and place of first publication, and the address and domicile or residence of such alien; the name and address of the applicant, and if a corporation, the State of incorporation as well as the address of its principal place of business; if the applicant is not the author, an identification of the instruments submitted for recordation and under or through which ownership is claimed; the date of the deposit, if any, of a copy or copies in the Copyright Office, and/or of identifying photographs, materials or description; the date of application and of the receipt of registration fee; the registration class and number assigned.

If a grantee shall apply for registration, recordation in the Copyright Office shall be necessary, at or prior to such application, of any written instrument or instruments under or through which such grantee claims ownership of such copyright or any right therein. A system of recordation in the Copyright Office should of course be provided, including provision for short form types of recordation containing the essential facts in respect thereto, along such lines as are provided, for example, in Section 16 of the above Thomas bill, and the certificate of recordation, or a certified copy thereof, shall be admitted in any court as prima facie evidence that such grant or other instrument had been recorded on the date specified therein.

Provisions can also be made for the correction of entries in the records of the Copyright Office. Certified copies should be obtainable by any person, upon payment of an appropriate fee, of any receipt, certificate of recordation or registration, of any grant, application for registration, or other instrument filed in the Copyright Office, or any entry in the records or record books of the Copyright office, or any extract therefrom, and such copy shall be admitted in any Court as evidence with like effect as the production of the original record, grant, or instrument from which taken. Provision should also be made for making available to public inspection of the record books and indices of the Copyright Office, copies of the copyright entries made in such record books, and of copies of deposited works, subject to such safeguards and regulations as may be made by the Register and approved by the Librarian of Congress.

3 and 4. I feel that a registration system should be optional or permissive rather than mandatory. Accordingly, registration should not be a condition of investing copyright; nor should copyright be divested if registration is not made by a stated time; nor should there be a loss of all remedy for infringement occurring prior to a late registration.

5. I feel that registration, with deposit as its concomitant, should be strongly encouraged, by special advantages, and some mild sanctions.

(a) Registration might be procedurally required (or official refusal of registration) as a condition precedent to an infringement action.

(b) I would be inclined to make statutory damages unavailable unless registration has been effected by a stated time prior to the alleged active infringement (e.g., perhaps 60 or 90 days), unless the owner of the right infringed shall establish that the infringement was willful.

(c) I would be inclined generally to have registration by a stated time prior to the infringement defeat altogether a defense of a so-called innocent infringement. This observation is subject, however, to how the problem of the innocent secondary user (e.g., the hundreds of individual stations in a network broadcast of infringing material, or the thousands of theatres showing a motion picture plagiarizing on some literary or musical material) is handled. This problem was referred to in my comments on the Latman and Tager study "Liability of Innocent Infringers of Copyright"; the Strauss study on "Damage Provisions of the Copyright Law"; and the Brown study on "The Operation of the Damage Provisions of the Copyright Law."

(d) I do not think there should be provision for the divestment of copyright based upon refusal to comply with an official demand to register, and do not see any occasion calling for provisions permitting such official demands. Consideration might be given, though, to requiring a deposit or deposits of published copies, for enrichment of the Library of Congress, which perhaps can be made punishable for failure of compliance, by way of a small fine only, without divesting copyright.

(e) While I have already indicated, in discussing item 2, that if a grantee should apply for registration, a recordation of the rights under which he claims shall be required either before or at the time of such application for registration, I would look sympathetically upon a requirement that registration be required as a prerequisite to recording transfers of interests in the copyright. However, there might be practical difficulties in calling upon grantees of small or partial interests in a particular right under a copyright, such as a limited exclusive territorial licensee, etc., who may not know or have access to the basic facts concerning the copyright, author or other owner, etc., to effect a registration as a prerequisite to recording the transfer to him of his own small interest.

6. I would give a *prima facie* degree of evidential strength to the certificate of registration. I consider such use of the copyright certificate of the greatest importance in respect of the mass of potentially licensable small uses in the copyright economy, as indicated in my comments on item 2. I would have the certificate be *prima facie* evidence of all the necessary facts to establish validity and ownership of the copyright, where such is not genuinely in dispute, and the primary issue relates to licensing. I have outlined some of the facts to be stated in the application for registration, and in the certificate of registration, in my comments on item 2.

There could well be considered the experience of other countries with regard to presumptions of authorship and ownership, as well as other matters, which might attach apart from registration. If copyright were to survive the death of the author by 50 years, for example, it might be extremely difficult for the owner to prove authorship without some presumptions.

There might also well be considered criminal sanctions, along the lines of Section 18 of the above-mentioned Thomas bill, such as making it a misdemeanor: to willfully infringe any right secured by copyright for profit, or knowingly aid or abet such infringement; to insert, impress, or affix any notice of copyright upon any article with knowledge that such notice is false; to knowingly issue, publish, sell, distribute, or import into the United States any such article containing such false notice; to remove or alter with fraudulent intent the copyright notice upon any article duly affixed by the persons entitled to do so; to register or cause to register a pirated work with knowledge that such work is pirated; to record or cause to be recorded a false or fraudulent grant with the knowledge that such grant is false or fraudulent; to knowingly make a false and fraudulent statement in any affidavit or other writing filed in the Copyright Office.

Sincerely yours,

EDWARD A. SARGOY.

---

By *Walter J. Derenberg*

NOVEMBER 26, 1958.

I have read with a great deal of interest the elaborate study on "Registration of Copyright," prepared by Professor Kaplan, and I agree with him that it seems difficult to take a position on this aspect of copyright revision without considering

the problem in the focus of other basic changes which should be made in the overall structure of our Copyright Act of 1909.

While my own thinking has always tended against any form of mandatory registration system, certain recent judicial developments serve to deepen my conviction that the present registration system, to the extent it may be considered compulsory, will lead to unsatisfactory and anomalous results. I am referring particularly to the recent case of *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Company, Inc.* (119 USPQ 189 (CCPA 1958)). The case involved, inter alia, an issue of copyright infringement of certain artistic features of a watch. Your Office refused to register the plaintiff's claim to copyright on the ground that what was sought to be registered did not qualify for registration even under the liberal definition of "work of art" in your present regulations. Being thus unable to register its claim in your Office, plaintiff, nevertheless, sued for copyright infringement (and design patent infringement) and the Court was faced with the question whether a plaintiff who had sought unsuccessfully to comply with the registration requirements of the Act of 1909 had standing to sue and have the court pass upon the issue of copyrightability, or whether it would be necessary for the plaintiff in such circumstances first to bring a mandamus proceeding against the Register. Judge Learned Hand, in the majority opinion, took the view that the copyright was "unenforceable" and that for that reason, plaintiff's cause of action based on copyright infringement was subject to dismissal. Chief Judge Clark, in dissent, expressed the view—which, in my opinion, is sound—that under the rule of the early leading case of *White-Smith Music Pub. Co. v. Goff* (187 Fed. 247), a plaintiff who attempted fully to comply with the requirements of the law should have the right to sue for copyright infringement without the necessity of having to go through a mandamus proceeding against the Register of Copyrights.

Be that as it may, it seems to me that we should attempt, in revising our domestic law, to live up to the spirit of the Universal Copyright Convention by eliminating all formality requirements which may appear to make registration a condition precedent to copyright protection. It is true, of course, that even today under Article 3, subdivision 3, of the UCC and under Section 13 of our Act of 1909, registration is deemed to be a procedural requirement only for purposes of bringing suit for infringement, but, as interpreted by the Court in the *Vacheron* case, the provision of Section 13 comes pretty close to a denial of substantive copyright protection and for that reason would seem to me to be an undesirable impediment in our efforts toward further unification of international copyright.

On the other hand, I am, of course, aware that a registration system may have considerable practical advantages and that we should probably not eliminate registration of copyright altogether but should provide for an optional registration system, which would provide sufficient incentives to copyright claimants to register their claims for the purpose of seeking certain specific statutory advantages which should not be available without registration. We have such a system today, as you know, in the field of trademark protection. Registration of trademarks in the Patent Office is not mandatory—it probably could not be made so without a constitutional amendment because our Federal trademark legislation is based upon the commerce clause—but the advantages offered by Federal registration are sufficiently important to induce the owners of the vast majority of trademarks to register under the registration statute of 1946 and not to rely on their common law rights without registration.

With that in mind, it seems to me that an optional registration system should be recommended, which might not even go as far as the present Section 13 goes in making registration a condition precedent to the instituting of a lawsuit but which may vest registration of copyright with some or all of the following specific statutory advantages:

1. Statutory damages should not be available unless the work alleged to have been infringed is registered at the Copyright Office. It may be suggested that such registration must have occurred prior to the time of infringement.
2. The Customs protection regarding importation of piratical copies may be limited to registered works (as it is in the case of trademarks).
3. The prima facie effect of the registration certificate may well be strengthened beyond the meager effect it has under the present law.
4. Criminal sanctions may be available with regard to registered works which would not attach with regard to works protected only by the common law or to works generally published without registration.

5. As in the law of trademarks, registration may be vested with a certain effect of "constructive notice" so as to deprive an infringer of the defense of "innocent" infringement.

These are but a few thoughts that come to mind in connection with providing for an optional registration system.

I may add that, since the "demand" provision of Section 14 of the Act of 1909 no longer applies with regard to those persons who claim the protection of the Universal Copyright Convention, we should abolish this demand provision also in our domestic law. In other words, failure to register should under no circumstances lead to a forfeiture of the copyright. Furthermore, failure to deposit the prescribed number of copies of the work with the Library of Congress also should not vitiate the copyright; it should be sufficient to provide that failure to comply with the Register's demand or failure to make the required deposit may constitute a misdemeanor and subject the copyright owner to a fine.

Generally speaking, it is my view that in revising our domestic Copyright Act, we should make a determined effort to confer the same benefits upon our own authors and citizens which we afford to citizens of Convention countries and to works first published in such countries. At the present time, the manufacturing provisions, the provision in Section 14, with regard to the Register's demand and other similar provisions discriminate against our own authors and against works by foreign authors first published in the United States. Our aim should be to confer upon U.S. citizens and domiciliaries the same benefits which are provided for in the Universal Convention and not to continue to impose upon our own citizens burdensome requirements which we have eliminated with regard to works of foreign authors and works first published in a Convention country.

Sincerely yours,

WALTER J. DERENBERG.

---

*By Elisha Hanson*

DECEMBER 31, 1958.

Any revision of the Copyright Law should require the registration of claims to copyright.

A mandatory system of registration is in the interest not only of the users of copyrighted works but of the creators thereof.

Inasmuch as copyright is made possible for the broad public interest, a proprietor who desires to protect his copyright should be required to seek registration of the work and to make a deposit of copies within a specified period of time after publication or, in default thereof, suffer the loss of all remedies thereafter. The period of time specified should be reasonable in length but the filing of the application for registration should be required for all works within not more than 6 months after publication and, preferably, within a shorter period of time.

The harshness of the provision for the loss of all remedies could be modified by a further provision restoring the proprietor's entitlement to remedies for infringements upon compliance with the requirements in respect of registration, provided that the proprietor should have no remedies whatever for infringements which occurred during the period in which he was in default as to the registration requirements.

If an official system of registration is to be retained, it should be meaningful. Registration should be required within a specified time and the public record of such should be as reliable and as complete as is practicable. Notice of copyright is only a warning that a claim is made. The claim may or may not be valid. Registration within a specified time is essential in any controversy arising over such a claim.

A copyright confers important rights upon its proprietor. Accordingly, it is entirely equitable to require that he make an effort within a reasonable length of time to register that claim in an official record, or suffer the consequences. Twenty-eight years is not a reasonable time for registration.

Sincerely yours,

ELISHA HANSON.

---

*By Ellen Jane Lorenz*

MAY 15, 1959.

Your office was kind enough to express an interest in the opinions evolved through a discussion on copyright problems at the annual convention of the Church and Sunday School Publishers Association. After a review of your 1958-59 studies, the [following] questionnaire was sent to each of our member companies, with the resulting vote recorded \* \* \*.

## COPYRIGHT QUESTIONNAIRE

[Six members of the Association responded. The number voting in favor of each proposition is shown.]

A. *Registration of Copyright*

1. Do you favor registration in general? [Yes, 6.]
2. Do you prefer: (a) Mandatory registration (virtual loss of rights if not registered within a certain time) [4] or (b) optional registration (with registration a prerequisite for suit for infringement and for recording transfers) [2.]
3. Do you favor increasing the amount of information made available on registration, especially concerning the source of derivative material? [Yes 5, no. 1.]
4. Do you favor authorizing the Register of Copyrights to give opinions concerning the legal aspects of copyright? [Yes 3, no 2, qualified 1.]

\* \* \* \* \*

Voting companies: Southern Baptist Publication, Rodeheaver-Hall-Mack, Hope Publishing, John T. Benson, Lorenz Publishing, Nazarene Publishing.

ELLEN JANE LORENZ.

---

STUDY NO. 18  
AUTHORITY OF THE REGISTER OF COPYRIGHTS  
TO REJECT APPLICATIONS FOR REGISTRATION  
BY CARUTHERS BERGER  
March 1959

---

## CONTENTS

---

	Page
I. Statutory provisions.....	85
II. Court decisions.....	86
III. Opinions of the Attorney General.....	90
IV. Cases dealing with other administrative officers.....	91
V. Legislative proposals for revision of the copyright law.....	92
VI. Nature of authority exercised by the Register.....	93
VII. Effect of registration and its refusal.....	94
A. Probative effect of registration.....	94
B. Erroneous refusal of registration.....	95
VIII. Summary of issues.....	98

## AUTHORITY OF THE REGISTER OF COPYRIGHTS TO REJECT APPLICATIONS FOR REGISTRATION

---

In the study by Prof. Benjamin Kaplan on "The Registration of Copyright" [Study No. 17 in the present series of Committee Prints], mention is made, on pages 27, 28, of the question of the authority exercised by the Register of Copyrights to refuse registration for copyright claims he believes to be invalid. The present study is an exploration of that question.

### I. STATUTORY PROVISIONS

The Copyright Law, Title 17 of the United States Code, vests in the Register of Copyrights the administrative function of making registration of claims to copyright and issuing certificates of registration. There is no express provision in the statute delineating the Register's authority to refuse registration, but the extent of such authority may be gleaned from the various provisions specifying the works eligible for copyright and the requirements for securing copyright and obtaining registration.

Section 4 provides that "The works for which copyright may be secured under this title shall include all the writings of an author." Section 5 provides that the application for registration shall specify to which of 13 enumerated classes the work belongs.<sup>1</sup>

The statutory requirements for securing copyright and obtaining registration may be summarized as follows.

Section 10 provides that—

Any person entitled thereto by this title may secure copyright for his works by publication thereof with the notice of copyright required by this title \* \* \*.<sup>2</sup>

Section 11 provides that—

Such person may obtain registration of his claim to copyright by complying with the provisions of this title, including the deposit of copies, and upon such compliance the Register of Copyrights shall issue to him the certificates provided for in section 209 of this title.

Reading sections 10 and 11 together, it appears that for a claim to be entitled to registration under section 11, the claimant must be a "person entitled" to secure copyright, and he must have complied with the requirement that the work be published with the prescribed notice. In order for the claimant to be entitled to secure copyright, the work of course must be one in which "copyright may be secured under this title" (§ 4) and the claimant must be a qualified person (see § 9).

<sup>1</sup> Section 5 provides further that this enumeration of classes "shall not be held to limit the subject matter of copyright as defined in section 4." But section 4 is not as all-inclusive as a literal reading of its language might indicate: cf. *Capitol Records, Inc. v. Mercury Records Corporation*, 221 F. 2d 657 (2d Cir. 1955), particularly the dissenting opinion of Judge Learned Hand.

<sup>2</sup> The form and position of the notice of copyright are specified in §§19 and 20. Section 10 requires that "such notice shall be affixed to each copy [of the work] published or offered for sale in the United States by authority of the copyright proprietor \* \* \*."

To state the matter conversely, it seems clear that a claim is not entitled to registration under section 11 if the "work" is not copyrightable, or if the claimant is not a qualified person, or if the work has not been published,<sup>3</sup> or if the work has been published without the required notice.

When copyright has been secured under section 10, it is eligible for registration under section 11. Title 17 elsewhere provides for the procedural requirements for obtaining registration: an application for registration must be made specifying the class of the work (§ 5) and giving the information which is required to be contained in the certificate of registration (§ 209); copies of the work as published—or substitutes—must be deposited (§ 13); for certain books an affidavit of manufacture in the United States must be filed (§§ 16, 17); and the registration fee must be paid (§ 215).

Further, section 207 provides:

Subject to the approval of the Librarian of Congress, the Register of Copyrights shall be authorized to make rules and regulations for the registration of claims to copyright as provided by this title.<sup>4</sup>

It should be noted that under section 12 copyright may be secured for certain classes of unpublished works by the deposit of a copy of the work—or substitute—with a "claim of copyright" for registration. It seems clear that registration under this section is limited to copyrightable works of the specified classes, when unpublished; and that an application, the copy—or substitute—and the registration fee are required in order to obtain registration.

Sections 208 and 11 provide that when there has been compliance with title 17, the Register of Copyrights "shall" make entry and issue a certificate.

Mention should also be made of two other provisions of title 17, sections 13 and 209, which bear on the consequences of registration or its refusal. Section 13 provides that "no action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with." The situation of a claimant who is refused registration but wishes to sue for an alleged infringement of what he contends is a valid copyright will be considered later.

Section 209, after specifying the facts to be contained in the certificate of registration, provides that "said certificate shall be admitted in any court as prima facie evidence of the facts stated therein." This provision also will be considered later in connection with the Register's authority to refuse registration.

## II. COURT DECISIONS

The earliest decision regarding the Register's authority to refuse registration when the subject matter is deemed not copyrightable is the case of *United States, ex rel. Everson v. John Russel Young*,

<sup>3</sup> As mentioned later, unpublished works of certain classes may be registered under §12, copyright being secured thereby.

<sup>4</sup> The present rules and regulations made pursuant to Section 207 appear in the *Code of Federal Regulations*, Title 37, Chap. II. Among other things, they state the procedural requirements for registration of copyrighted works; define in more detail the classes of works enumerated in § 5 of the statute; and mention examples of uncopyrightable material for which registration will not be made, as well as the fact that registration will not be made for works published without the required copyright notice.

*Librarian of Congress.*<sup>5</sup> This case was decided in 1898 when the Librarian of Congress had duties which are now performed by the Register of Copyrights. The relator, Everson, requested a writ of mandamus against the Librarian for refusal to record a copyright claim in a book that contained no written material. The court refused to issue the writ stating:

\* \* \* I think it is very clear that this proposed publication, which, as already stated, is only book containing blank forms and does not contain a single English sentence—is not a composition of any sort—does not come within the purview of the copyright law, and that if a mandamus should issue requiring the Librarian of Congress to record it under the copyright law, that act would be of no advantage whatever to the applicant for this writ. Any court would adjudge that it was not protected by the copyright law at all.

Thus, the Librarian was held to be under no duty to record a copyright claim in a "book" which was found not copyrightable under the statute.

In the case of *Brown Instrument Co. v. Warner, Register of Copyrights*,<sup>6</sup> the Register had refused to register a copyright claim in a device, consisting of a graphic chart used as a part of a machine, which he deemed not copyrightable. The complainant sought a court order to compel registration. The circuit court upheld the lower court in denying the petition, stating that the evidence sustained the finding below that—

Plaintiff has failed to establish that its charts are "writings of an author" or "drawings" within the meaning of the Constitution and the copyright statute. \* \* \*

In the two cases of *King Features Syndicate, Inc. v. Bouvé, Register of Copyrights*,<sup>7</sup> and *Twentieth Century Fox Film Corp. v. Bouvé*,<sup>8</sup> it was held that the Register could not refuse to make registration for a claim that was entitled to registration under the statute. In both cases the plaintiff had sought to register claims to copyright in a collection of copyrightable materials in the form of "page proofs" which he contended had been published as a "book" before the republication of individual items in various newspapers. The Register had insisted that the page proofs were not a published book and that each item published separately in newspapers had to be registered separately. In both cases the court upheld the contention of the plaintiffs and required the Register to make the registrations. There was no question in these cases as to the copyrightability of the material; the issue was whether the collection was entitled to registration as a single publication in the form of page proofs.

In the *King Features Syndicate* case the district court said:

The defendant, as Register of Copyrights, has no power to refuse or deny registration of a claim of copyright *which is entitled to registration under the Copyright Act*. Whether an applicant or claimant has complied with the law so that his claim is entitled to be registered raises questions of fact and law to be decided by the court; the Register of Copyrights has not power to decide such questions, especially where the deposit of copies and the application filed, when read together as they should be, are in apparent compliance with the act. In any event, findings of fact and conclusions of law made by the Register of Copyrights may be reviewed by the court, and they are neither conclusive nor binding upon the court, and such findings and conclusions, if erroneous, may be rectified by this court. [Italics supplied.]

<sup>5</sup> 26 WASH. L. REP. 546 (Sup. Ct. D.C. 1898).

<sup>6</sup> 181 F. 2d 910 (D.C. Cir. 1947), cert. denied 332 U.S. 801 (1947).

<sup>7</sup> 48 USFQ 237 (D.C.D.C. 1940).

<sup>8</sup> 33 F. Supp. 483 (D.C.D.C. 1940), *aff'd* Bouvé v. Twentieth Century Fox Film Corp. 122 F. 2d 51 (D.C. Cir. 1941).

A somewhat clearer statement was made by the same district court in *Twentieth Century Fox Film Corp. v. Bouvé*, as follows:

As to the discretionary power of the Register of Copyrights, I think that he has no power to refuse to register any copyright *that is entitled to registration under the law*; that it is a question of fact whether the applicant has complied with the law; that *if he has complied with the law* he is entitled to have the copyright registered; that any finding of fact or conclusion of law on the part of the Register of Copyrights is not binding upon the court. I think that the powers of the Register of Copyrights are analogous to the powers of the Postmaster General in admitting articles in the mail and the Register of Deeds in recording instruments (*Payne v. United States ex rel. National Railway Publishing Company*, 20 App. D.C. 581; *Darcy v. Clark*, 24 App. D.C.) [Italics supplied.]

On appeal in *Bouvé v. Twentieth Century Fox Film Corp.*, the circuit court, in sustaining the lower court, made these observations regarding the Register's authority:

*It seems obvious, also, that the Act establishes a wide range of selection within which discretion must be exercised by the Register in determining what he has no power to accept.* The formula which he must apply is a more difficult one than that of the Recorder of Deeds, upon which appellee relies by way of analogy. Nor would there seem to be any doubt that the Register may refuse to issue a certificate of registration until the required fee is paid, and until other formal requisites have been satisfied.

Even amicus curiae concedes that the Register may properly refuse to accept for deposit and registration "objects not entitled to protection under the law." [Italics supplied.]

The decisions in the Bouvé cases held that the Register's refusal to make registration was erroneous in those instances and ordered him to make the registrations. But those decisions did not deny the Register's authority to refuse registration for uncopyrightable material or for claims not entitled to registration under the statute for other reasons. The Register's conclusion that a claim is not entitled to registration was held subject to review by the courts in a mandamus proceeding.

Though not dealing directly with the question of the Register's authority to refuse registration, the decision of the circuit court in *Stein v. Mazer*,<sup>9</sup> and of the Supreme Court in *Mazer v. Stein*,<sup>10</sup> throw some light on this question, at least by implication. In that case registration had been made for the plaintiff's statuette as a work of art although it had been used as the base of a lamp. The defendant, who was sued for infringement, contended that work, being a lamp, was not copyrightable and that the registration was therefore erroneous.

The circuit court, sustaining the copyright, gave weight to the fact that the Regulations of the Copyright Office<sup>11</sup> defined copyrightable works of art as including "works of artistic craftsmanship, insofar as their form but not their mechanical or utilitarian aspects are concerned \* \* \*." The court also gave weight to the practice of the Copyright Office in making or denying registrations for articles submitted as works of art, the court saying:

[I]t has been the practice of the Copyright Office since 1909 to refuse copyright registration only to those works of a wholly utilitarian nature, which could not be called works of art although they might possess pleasing design. Rejection has been placed on the ground that protection for such works lay only under the

<sup>9</sup> 204 F. 2d 472 (4th Cir. 1953) *reversing Stein v. Mazer*, 111 F. Supp. 359 (D.C. Md. 1953).

<sup>10</sup> 347 U.S. 201 (1954).

<sup>11</sup> 37 C.F.R. §202.8 (1949).

Design Patent Law. Thus, registration has been refused for designs for refrigerators, clocks, stoves, gasoline pumps, and oil dispensers.

When an agency of the United States is empowered by a federal statute to issue regulations under, and also to administer and apply, that statute, and when the agency over a course of years applies that statute in a certain way, that application should be given great weight when a court is called upon to determine the meaning of the statute.

The Supreme Court, upholding the copyright, likewise attached significance to the fact that—

\* \* \* we have a contemporaneous and long continued construction of the statutes by the agency charged to administer them that would allow the registration of such a statuette as in question here.

And regarding the definition in the Copyright Office Regulations, the Supreme Court said:

As a standard we can hardly do better than the words of the present Regulation, § 202.8, *supra*, naming the things that appertain to the arts.

Apparently both the circuit court and the Supreme Court assumed that registration signified the conclusion of the Register that the work was copyrightable, and that he would refuse registration for works he considered not copyrightable.

A very recent case directly upholding the Register's authority to refuse registration for an article held not copyrightable is *Baillie and Fiddler v. Arthur Fisher, Register of Copyrights*.<sup>12</sup> The plaintiffs had applied for registration for a picture-record device as a "work of art." This device consisted of cardboard in the shape of a five-pointed star with flaps on the lower two points, which, when folded back, provided a stand; in a circle on the face of the star was a picture of a Hollywood personality, and impressed over the picture was a phonograph recording of his voice. This device was intended to be sent to "fans" of various performers. The plaintiff specifically sought registration for the device itself and not for the photograph, as it was contemplated that the device would be used for many different photographs.

Registration for the device having been refused, the plaintiff brought an action against the Register to compel registration. The district and circuit courts held that the device was not copyrightable and sustained the Register's motion for summary judgment.

In another very recent case, *Vacheron & Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*,<sup>13</sup> the plaintiff alleged infringement by the defendant of copyright in his ornamented watch for which registration had been refused on the ground of noncopyrightability. The district court held the watch not copyrightable and said that the Register had acted properly in refusing registration.<sup>14</sup>

It may be noted that in the converse situation, several decisions have held copyright claims invalid though they had been registered.<sup>15</sup> And there are a number of decisions holding particular items not copyrightable, for example: the title alone of a literary or artistic

<sup>12</sup> Civil Action No. 365, unreported (D.C.D.C. 1957), *aff'd* 258 F. 2d 425 (D.C. Cir. 1958).

<sup>13</sup> 155 F. Supp. 932 (S.D.N.Y. 1957), remanded on appeal, 260 F. 2d 637 (2d Cir. 1958).

<sup>14</sup> On appeal, the majority of the Second Circuit Court did not discuss the copyrightability of the wrist watch or the Register's authority to refuse registration; but held that even assuming copyrightability, the claimant could not maintain the infringement suit without having obtained registration. (This latter point will be discussed later in this paper.) Chief Judge Clark, dissenting, considered the wrist watch copyrightable, and suggested that a mandamus action could be brought against the Register to compel registration, but that the infringement suit should be tried without registration.

<sup>15</sup> *Kemp & Beatley v. Hirsch*, 34 F. 2d 291 (1929); *Forstmann Woolen Co. v. J. W. Mays, Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950); *Sawyer v. Crowell*, 46 F. Supp. 471 (S.D.N.Y. 1942).

work;<sup>16</sup> a label which merely identifies a product;<sup>17</sup> a simple slogan;<sup>18</sup> a system, method, or idea for doing something;<sup>19</sup> a mechanical device, tool, or implement;<sup>20</sup> a dress design;<sup>21</sup> a recorded rendition of music.<sup>22</sup> The Copyright Office follows the decisions of the courts and denies registration for items of the kinds that the courts have held not copyrightable.

### III. OPINIONS OF THE ATTORNEY GENERAL

On at least two occasions opinions were given by the Attorney General's office on the authority of the Register of Copyrights to decide whether a work deposited for registration was entitled to be registered under the law. In 1911, Assistant Attorney General, J. A. Fowler, expressed the opinion that the Register had the responsibility of deciding whether an item qualified as a "work of art" under the copyright statute.<sup>23</sup> The opinion stated:

Furthermore, the meaning of this expression, and its application to a particular work, does not present a question of law, but one of fact and is not, therefore, one for discussion by me. The phrase appears to be a new one in the copyright statutes, and experts would doubtless often differ as to its application, and the Register of Copyrights must, therefore, when application for registration is made, determine for himself the question whether the work presented is one of art, but in so doing he cannot, of course, act arbitrarily and without good reason.

Another opinion of the Attorney General's Office in 1915<sup>24</sup> involved the applicability of the exception to the manufacturing provision in section 15 [now 16] regarding a reproduction of a work of art where the subject matter is located abroad. In regard to the Register's authority to decide whether the work under consideration was a reproduction of a work of art the Attorney General said:

There is no attempt in the statute to define this term. Its definition is a mixed question of law and fact which in the first instance is to be left to the sound discretion of the Register of Copyrights.

\* \* \* \* \*

The suggestion that the determination of the validity of the registration should be left to the courts, and the necessary inference involved that the duty of the Register is purely automatic, and consists wholly (with the single exception of books) in determining whether the subject presented is a lithographic print and therefore within the general class of articles which may be copyrighted, cannot be reconciled with the power vested in the Register to issue rules and regulations under which he will permit registration under the law. That section of the law plainly indicates that he has at least some measure of discretion in the administration of the act. Manifestly, in the exercise of that discretion he may make such investigation and require such showing of compliance with the law as may be necessary to enable him to determine whether the prerequisites imposed have been met.

If the contention be correct that the Register is vested with no discretionary powers of investigation, and has no authority to demand a satisfactory showing of compliance with the plain conditions prescribed by law as prerequisites to the

<sup>16</sup> See *Jollie v. Jacques*, 13 Fed. Cas. 910, No. 7,437 (C.C.S.D.N.Y. 1850); *Glaser et al. v. St. Elmo Co.*,<sup>7</sup> Inc., 175 Fed. 276 (S.D.N.Y. 1909); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934).

<sup>17</sup> *Higgins v. Keuffel*, 140 U.S. 428 (1891); *Forstmann Woolen Co. v. J. W. Mays Inc.*, 89 F. Supp. 964 (E.D.N.Y. 1950); *Griesedieck Western Brewery Company v. Peoples Brewing Company*, 56 F. Supp. 600 (D. Minn. 1944), *aff'd*, 149 F. 2d 1019 (8th Cir. 1945).

<sup>18</sup> *Forstmann Woolen Co. v. J. W. Mays, Inc.*, *supra* note 17; and see *Sinanide v. La Malson Cosmeo*, 44 T.L.R. 574 (1928).

<sup>19</sup> *Page v. Wisden*, 20 L.T.N.S. 435 (1869); *Baker v. Seldon*, 101 U.S. 99 (1879); *Kanover v. Marks*, 91 USPQ 370 (S.D.N.Y. 1951). Blank forms necessary to operate a system or method are likewise not copyrightable.

<sup>20</sup> *Taylor Instrument Co. v. Fawley-Brost Co.*, 139 F. 2d 98 (7th Cir. 1943) *cert. denied* 321 U.S. 785 (1944); *Brown Instrument Co. v. Warner*, 161 F. 2d 910 (D.C. Cir. 1947).

<sup>21</sup> *Cheney Bros. v. Doris Silk Corp.*, 35 F. 2d 279 (2d Cir. 1929), *cert. denied* 281 U.S. 728 (1930); *Fashion Originators Guild v. Federal Trade Commission*, 114 F. 2d 80 (2d Cir. 1940).

<sup>22</sup> *Capitol Records, Inc. v. Mercury Records Corp.*, 221 F. 2d 657 (2d Cir. 1955).

<sup>23</sup> 28 OPS. ATTY. GEN. 557 (1911).

<sup>24</sup> 30 OPS. ATTY. GEN. 422 (1915).

issuance of copyrights, that officer is reduced to the role of a mere automaton, who, upon receiving an application for copyright of a lithograph must register and issue a certificate therefor, which shall thereafter be accepted in the courts as prima facie evidence of the facts stated therein, even though the legal prerequisites to the valid registration of the copyright may have been wholly ignored. Clearly, such a construction would serve to defeat the purpose and intent of the act.

A very recent opinion of the Attorney General (41 Ops. Atty. Gen. No. 73, Dec. 18, 1958) confirms the view that the Register is authorized to refuse registration for material that is not the subject of copyright under sections 4 and 5 of the statute. (The opinion goes on to deal with the further question of the Register's authority to refuse registration for material that is otherwise copyrightable under the statute but contains illegal matter. On this question the opinion holds that even in such cases the Register may refuse registration, but that he is not required to examine deposits for illegal content and is therefore free to make registration without regard thereto.)

#### IV. CASES DEALING WITH OTHER ADMINISTRATIVE OFFICERS

In *Bowé v. Twentieth Century Fox Film Corporation*,<sup>25</sup> it was said that the function of the Register of Copyrights in making registrations involves a "more complicated formula" than must be applied by a recorder of deeds.<sup>26</sup> It is interesting to note what the courts have said about the authority of ministerial officers such as recorders of deeds.

Thus, in *Litchfield v. Register and Receiver*,<sup>27</sup> it was held that the Land Office could determine in the first instance, subject to review by the courts, whether certain lands were within the statutory category of public lands "subject to sale and pre-emption" for which claims could be recorded.

In *Dancy v. Clark*,<sup>28</sup> a writ of mandamus was requested to compel the recorder of deeds to accept and record a corporation charter which on its face was violative of the "single purpose" provision of the pertinent statute. The court held that as the invalidity of the corporation charter was apparent on its face, the recorder of deeds had acted properly in refusing to record it. The court said:

Undoubtedly the recorder of deeds is in the category of ministerial officers, and has no jurisdiction to pass upon the validity of instruments of writing presented to him for record. \* \* \* But he is not for this reason wholly without discretion to determine whether any instrument of writing should be admitted to record. He is by the law required to receive and file, or receive and record, as the case may be, such instruments as have been duly executed, and which purport on their face to be of the nature of the instruments entitled to be filed or recorded. Assuredly, supposing some extreme cases, in order to illustrate what we desire to say, if a promissory note, or a deed of conveyance of land, or a chattel mortgage, were offered to him to be filed as a certificate of incorporation, he would certainly be warranted in a refusal to receive it. Nor would he be warranted in receiving and filing or recording an instrument of writing purporting to have been acknowledged before some person not entitled to take acknowledgments, much less would he be warranted in receiving for recording a paper that was not acknowledged at all. He has the right to exercise discretion in the premises, but not judicial discretion. The courts will sustain him when he acts within the

<sup>25</sup> *Supra* note 8.

<sup>26</sup> See quotation on p. 88, *supra*.

<sup>27</sup> 76 U.S. 575 (1870).

<sup>28</sup> 24 App. D.C. 487 (1904).

limits of the discretion reposed in him; they will coerce his action when he has exceeded those limits and denied a right to which parties are by law entitled.<sup>29</sup>

In *Payne v. Houghton*,<sup>30</sup> the court held that the Postmaster General had the authority to decide whether a series of republished books were periodicals, and the Postmaster General's decision that the publications involved were not periodicals entitled to second class mailing privileges was upheld.

#### V. LEGISLATIVE PROPOSALS FOR REVISION OF THE COPYRIGHT LAW

Most of the series of bills introduced between 1924 and 1940 to revise the copyright law did not deal expressly with the authority to be exercised by the Register of Copyrights in determining whether a claim was entitled to be registered. They contained provisions somewhat like those in the present statute, specifying the kinds of works that were subject to copyright and providing for the registration of copyright in works that qualified therefor under the provisions of the bill.<sup>31</sup> As under the present statute, these bills would seem to have implied that the Register could refuse registration for claims that did not meet the specified requirements for copyright and registration.

The series of Vestal bills<sup>32</sup> introduced between 1926 and 1931 contained a novel provision in this regard. After providing that—

The author or other owner of the copyright in any work, or any right, title of interest therein, may, if he so desires, obtain registration of a claim to copyright \* \* \*, upon the deposit \* \* \* of an application \* \* \*.

these bills provided further:

The Copyright Office shall have no discretion to refuse to receive such application or to refuse to register such work upon such application being made.<sup>33</sup>

This provision was the subject of some discussion during the hearings on one of the Vestal bills.<sup>34</sup> Mr. William L. Brown, then Assistant Register of Copyrights, voiced objection to the provision as follows:

I wish to protest against this restriction of discretion on the part of the Copyright Office. It is not consistent with the provision in another part of the measure that the register of copyrights shall make rules, and the Copyright Office is faced almost every day with applications which are not in accordance with the provisions of the statute. The statute itself determines what shall come under the provisions of copyright, works of literature, drama, music, and fine arts. Suppose we get a wheelbarrow or a stuffed doll baby or an iron puppy dog with an application for copyright. Is the Office to exercise no discretion? We once had an application for the copyrighting of the tricks of a trained bear, in order to prevent another trained bear from performing the same tricks [Laughter]. Under this provision we should have no discretion but to enter it.

In reply, Representative Lanham asked whether the reference in the provision to "such work" was not "so restricted as to make the

<sup>29</sup> It may be noted that the Register of Copyrights has rarely found occasion to refuse recordation of an assignment of copyright under 17 U.S.C. §§ 30, 31. But recordation might be refused where the document obviously had no relation to a copyright or had not been executed as required by the statute.

<sup>30</sup> 22 App. D.C. 234 (1903), *aff'd sub. nom.* *Houghton v. Payne*, 194 U.S. 88 (1904).

<sup>31</sup> For example, the Dallinger bill of 1924, H.R. 8177, 68th Cong., 1st Sess., §§ 5, 14; the Perkins bill of 1925, H.R. 11258, 68th Cong., 2d Sess., §§ 1, 48. And *cf.* the Thomas bill of 1940, S. 3043, 76th Cong., 3d Sess., §§ 2, 14(2), 14(6), 35.

<sup>32</sup> *Cf.* H.R. 10434, 69th Cong., 1st Sess. (1926); H.R. 8912, 70th Cong., 1st Sess. (1928); H.R. 6990, 71st Cong., 2d Sess. (1930); H.R. 12549, 71st Cong., 3d Sess. (1931).

<sup>33</sup> Sec. 36, H.R. 10434, 69th Cong., 1st Sess. (1926). Similarly, sec. 53, after providing for the recordation of "assignments of copyright" and other documents "pertaining to any copyright", further provided: "The register of copyrights shall have no discretion to refuse to record any instrument presented to him for record as aforesaid."

<sup>34</sup> *Hearings Before the House Committee on Patents on H.R. 6890*, 71st Cong., 2d Sess., pp. 180-181 (1930), Part I.

meaning clear"; and after some further colloquy in which Mr. Brown urged that the Copyright Office should not be "deprived of any exercise of discretion \* \* \* in things which are not subject to copyright," Representative Lanham said, "I assume that there is no intention to deprive you of that right."

Mention should also be made of an objection voiced in 1906 to a different kind of provision. The first draft of a bill to revise the copyright acts, prepared by the Copyright Office in 1905 as a basis for discussion, contained the provision that—

\* \* \* no registration shall \* \* \* be made of any article not clearly within the classes of articles designated by this Act as subject to copyright.

A substitute provision in a second draft provided that the Register "shall make entry" of the deposit of "any article made the subject of copyright by this Act."<sup>35</sup>

In the series of conferences convened by the Librarian of Congress in 1905 and 1906 to consider these drafts, two representatives of bar associations expressed the fear that these provisions might give the Register a judicial function to make final decisions which would not be reviewable by the courts. They recognized that the Register might refuse registration in the exercise of his administrative functions, which they apparently considered appropriate as long as his refusal was reviewable by the courts.<sup>36</sup>

## VI. NATURE OF AUTHORITY EXERCISED BY THE REGISTER

The successive Registers of Copyright have consistently exercised the authority to refuse registration in those instances where the requirements of the statute for securing copyright and for obtaining registration have not been fulfilled. The Copyright Office receives a substantial number of applications for items which it finds not registrable, principally because they have been published without the required notice or they appear on their face to be uncopyrightable. During fiscal year 1957, for example, about 3 percent of the applications received were rejected, mainly for those reasons.<sup>37</sup>

It is pertinent to note briefly some of the aspects of the examination which the Copyright Office makes of applications for registration and the copies of the works deposited therewith. The copies are examined to determine that the work is of a copyrightable character under the statute, and if the work has been published, to see that the copies bear the required notice; but the Office does not purport to determine whether the work is original.<sup>38</sup> The application is examined to see that it contains the necessary data, including the data required to be set forth in the certificate of registration, and that it is consistent with corresponding data in the copies of the work; and applicants may be requested to supply missing data or to reconcile inconsistencies. But the Office does not purport to determine whether the statements of fact

<sup>35</sup> The draft bills are printed in Copyright Office Bulletin No. 10 (1905).

<sup>36</sup> See Conference on Copyright, Third Session, March 13-16, 1906 (Copyright Office): statements of Arthur Stewart (pp. 62, 63) and Paul Fuller (p. 66).

<sup>37</sup> Annual Report of the Register of Copyrights for the fiscal year ending June 30, 1957, p. 2.

<sup>38</sup> It would manifestly not be feasible to examine and compare the work submitted for registration and all existing works which it might conceivably plagiarize. Moreover, similarity between two works does not prove plagiarism (see, for example, *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F. (2d) 99 (2d Cir. 1951)). In relatively rare cases the Copyright Office examiners may recognize the material submitted as apparently being an old work, e.g., the Lord's Prayer or a mere quotation from the Bible or Shakespeare; and in such cases, inquiry is made of the applicant as to the element of originality.

in the application are true;<sup>39</sup> nor does the Office undertake to resolve conflicting claims.<sup>40</sup>

The functions of the Register in regard to the registration of claims may be characterized as ministerial. While he has been said to have "discretion,"<sup>41</sup> this must be understood in its context as referring to the fact that he must construe the statute and exercise judgment in determining whether a particular claim is eligible for registration under its provisions. It seems clear that he has no quasi-judicial functions: his determinations are not final but are subject to review and decision by the courts. It has been said that his functions in making registration are similar to those of a recorder of deeds, though the Register's administrative determinations are more difficult because of the complexities of the copyright statute.<sup>42</sup>

## VII. EFFECT OF REGISTRATION AND ITS REFUSAL

### A. PROBATIVE EFFECT OF REGISTRATION

Under section 209, the registration of a copyright claim entitles the claimant to a certificate of registration which "shall be admitted in any court as prima facie evidence of the facts stated therein." Section 209 requires the certificate to state the following facts: the name and address of the claimant; the name of the author (when shown in the Copyright Office records) and his citizenship, and the domicile of an alien author who is domiciled in the United States; the title of the work; the date of the deposit of copies; the date of publication of the work (if published); identification of the registration entry by class designation and number; and the receipt of the affidavit of manufacture in the United States (with the date of printing or publication as stated therein) in the case of a book for which the statute requires such an affidavit.

These facts alone do not prove that the copyright claim is valid: a court might still hold the claim invalid because the subject matter is not copyrightable,<sup>43</sup> or because the work is not original,<sup>44</sup> or because the claimant is not the rightful owner of the copyright,<sup>45</sup> or for some other reason.

Nevertheless, since the certificate identifies the author (which may imply an assertion that the work is his origination) and the claimant (which may imply an assertion that he is the owner), as well as the work, and since the courts apparently assume that the Copyright Office considers the questions of copyrightability and compliance with statutory requirements, courts have frequently spoken of the certificate as being prima facie evidence of the validity and ownership of the copyright claim.<sup>46</sup> And in practice, numerous transactions have

<sup>39</sup> The Office does not undertake to investigate the accuracy of statements in the application as to authorship, ownership, date of publication, etc. Occasionally, where a statement of fact appears on its face to be questionable, the Office may ask the applicant for confirmation.

<sup>40</sup> In the Report of the Librarian of Congress, 1901, at page 287, he said: "The Copyright Office \* \* \* has no authority to question any claim as to authorship or proprietorship or give consideration to conflicting claims, and for obvious reasons can give no statement of opinion upon questions of copyright which affect the rights of contending parties."

<sup>41</sup> See pp. 88, 90 and 91, *supra*.

<sup>42</sup> See p. 88, *supra*.

<sup>43</sup> See, for example, *Taylor Instrument Cos. v. Fawley-Brost Co.* 139 F. 2d 98 (7th Cir. 1943). See also note 15 *supra*.

<sup>44</sup> See note 38 *supra*.

<sup>45</sup> See notes 39 and 40 *supra*.

<sup>46</sup> See Kaplan, *The Registration of Copyright* [Study No. 17 in the present series of Committee Prints], p. 29.

been based on the assumption that the certificate is evidence of the existence and ownership of copyright.

Be that as it may, while the Copyright Office cannot determine the originality or ownership of a work, the copies deposited are all that is needed to determine whether the work is of a copyrightable character; and it has been the practice of the Copyright Office for many years to examine the deposits and make this determination, and to refuse registration for material it considers clearly not copyrightable. It is generally understood<sup>47</sup> that the issuance of a certificate implies that the Copyright Office considers the work to be copyrightable, though its determination on this point is subject to review by the courts.

It has been thought that the refusal of the Copyright Office to register uncopyrightable material serves to inform applicants and the public of the scope of the copyright law. It is believed to be of some assistance also to the courts insofar as they give weight to the probative value of registration and the interpretation of the law by the Copyright Office.

Conversely, if the Copyright Office were to register claims and issue certificates without regard to the copyrightability of the material, the result would be to mislead the applicant and the public. What materials are copyrightable is a rather esoteric question on which the general public is not well informed. Many applications are received in the Copyright Office for the registration of uncopyrightable material such as titles, names, ideas, mechanical devices, tools, toys, and almost anything imaginable, usually under a misapprehension by the applicant of the copyright law. In some instances, protection may be available under the trademark or patent laws. Registration of a copyright claim in such material would lull the applicant into a false sense of security in believing he had copyright protection, instead of seeking advice and other means of protecting his interests; and the public would often be given the false impression that the material is copyrighted. Further consequences also seem evident: the registration records would be cluttered with unfounded claims; registration records and certificates would be unreliable and would lose much of their probative value for copyright claimants, for other persons dealing with them, and for the courts; and many unfounded claims would probably become the source of litigation.

#### B. ERRONEOUS REFUSAL OF REGISTRATION

On the other side of the coin are the consequences to an applicant who may have a valid claim for which registration is refused. Copyrightability is sometimes a close question. In general, the Copyright Office has leaned toward making registration in doubtful cases. Even so, some cases arise in which applicants who are refused registration believe they have a valid claim.

No case has been found in which a court has held copyrightable a work which the Copyright Office refused to register on the ground of

<sup>47</sup> See, for example, the discussion *supra*, pp. 88, 89 of *Stein v. Mazer*.

uncopyrightability.<sup>48</sup> There have been several cases, on the other hand, in which the courts have held a work which was registered to be uncopyrightable.<sup>49</sup>

Section 13 provides that—

No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this title with respect to the deposit of copies and registration of such work shall have been complied with.

It has sometimes been argued that the Register has no authority to refuse registration when the proper deposit, application, and fee have been submitted, because under section 13 an erroneous refusal would deprive the claimant of his right to have his copyright protected in court.<sup>50</sup> This raises the question of the recourse open to a claimant who seeks to enforce a claim which he believes to be valid but which the Copyright Office has refused to register.

In a case decided in 1911, *White-Smith Music Publishing Co. v. Goff*,<sup>51</sup> although the plaintiff had applied for and been refused registration of a claim to renewal copyright, the court considered the merits of the plaintiff's claim in an infringement action, holding the claim unfounded. The court said:

[The plaintiff] offered registration under the statute, and, although registration was refused, yet it fully complied with the requirements of law, and is entitled to maintain this suit if it had any statutory right to the extension.<sup>52</sup>

In this view section 13 would permit the claimant to bring an infringement action if he had submitted the required deposit, application, and fee for registration, even though registration had been refused, and the court would determine the question of the validity of the claim in that action.

Several later decisions contain broad statements to the effect that no suit can be brought without registration.<sup>53</sup> In all these cases, however, it appears that the plaintiffs had not followed the required procedure to obtain registration; and in two of these cases the courts expressly stated that the complaints were being dismissed without prejudice.<sup>54</sup> Apparently the plaintiffs could thereafter have obtained registration and instituted new suits.

In the recent case of *Vacheron Constantin-Le Coultre Watches, Inc. v. Benrus Watch Co.*, where registration for a wristwatch had been refused, the district court<sup>55</sup> in an infringement action held the wristwatch not copyrightable. In a footnote the court expressed doubt as to whether the suit could be entertained unless the plaintiff first brought an action to compel the Register to make registration, but

<sup>48</sup> In the *Bouvé* cases, *supra* notes 22, and 23, where the refusal of registration was reversed by the court, there was no question of copyrightability. The question was whether registration should be made on the basis of a collection of materials in the form of page proofs said to be published as a book, rather than on the basis of the separate portions of the same material published in various periodicals.

In *Vacheron v. Benrus Watch Co.*, dealing with a copyright claim in the design of a wrist watch, for which registration had been refused on the ground of non-copyrightability, the District Court (155 F. Supp. 932 (S.D.N.Y. 1957)) held the design not copyrightable. In the Circuit Court of Appeals (260 F. 2d 637 (2d Cir. 1958)) the majority did not consider this question, but held that no action could be brought on the copyright claim without the certificate of registration; Judge Clark, dissenting, considered the design copyrightable.

<sup>49</sup> See note 43 *supra*.

<sup>50</sup> Brief for Appellee, pp. 60, 61, *Bouvé v. Twentieth Century Fox Film Corporation*, 122 F. 2d 51 (D.C. Cir. 1941); Brief for Appellants, *Baillie and Fiddler v. Fisher*, pp. 8, 9, 258 F. 2d 425 (D.C. Cir. 1958).

<sup>51</sup> 187 F. 247 (1st Cir. 1911).

<sup>52</sup> In the decision of the Second Circuit Court in *Vacheron v. Benrus Watch Co.*, 260 F. 2d 637 (2d Cir. 1958), the majority opinion referred to this statement as "dicta," with Judge Clark disagreeing on this point in his dissenting opinion.

<sup>53</sup> *New York Times Co. v. Star Co.*, 195 Fed. 110 (S.D.N.Y. 1912); *Lumiere v. Pathe Exchange*, 275 Fed. 428 (2d Cir. 1921); *Rosedale v. News Syndicate*, 39 F. Supp. 357 (S.D.N.Y. 1961); *Algonquin Music Inc. v. Mills Music Inc.*, 93 F. Supp. 268 (S.D.N.Y. 1950).

<sup>54</sup> In the *Rosedale and Algonquin* cases, *supra* note 53.

<sup>55</sup> 155 F. Supp. 932 (S.D.N.Y. 1957).

added that it was unnecessary to pass upon this question since the copyright claim was being held invalid. On appeal in the Second Circuit Court,<sup>56</sup> Judge Hand declined to consider the question of copyrightability, and held that even if copyrightability were assumed, the suit could not be maintained without registration. Judge Lumbard, in a concurring opinion did not discuss this question. Chief Judge Clark, dissenting, considered that the wristwatch was copyrightable and that the refusal of registration was erroneous. In this situation, he said:

the Register must carry out the provisions of the law and has no judicial or discretionary functions \* \* \*. [I]t is his duty to obey the law and \* \* \* mandamus will issue to require him to do so.

As to the plaintiff's right to sue though registration was refused, Judge Clark said in his dissent:

I doubt if the ministerial grant of a certificate is a condition precedent to a suit for copyright; but however this question is answered, it seems to me clear that a plaintiff situated as is this one is entitled to at least \* \* \* an injunction preventing further wrongdoing until it is able to seek mandamus against the Register in the District of Columbia.

Citing *White-Smith Music Pub. Co. v. Goff, supra*, Judge Clark intimated that he would go further and have the court determine the validity of the copyright claim in the infringement suit.

As noted above, the authority of the Register of Copyrights is ministerial in registering the claims of persons entitled to copyright, though in executing this ministerial function he must apply, and hence construe, the law governing the question of whether the applicant for registration is entitled to copyright. It seems clear that he has no discretionary authority in the sense of establishing the legal right of claimants to secure copyright or to obtain registration; and his ministerial application of the law in granting or refusing registration is therefore subject to review by the courts. Accordingly, it seems to be settled that a claimant who is refused registration may bring an action in the nature of mandamus against the Register to compel him to make registration if the court concludes that the claim is entitled to registration under the provisions of the law. The unsettled question is whether a claimant who has fulfilled the procedural requirements (deposit, application, and fee) for registration but has been refused registration on the ground that the copyright claim is invalid, must first secure registration by a mandamus action against the Register before he can maintain a suit for infringement; or whether he may sue for infringement without registration and have the validity of his claim determined in that suit.

In a revision of the copyright law, assuming that some kind of registration system is provided for, this last question should be clarified.

It might be argued, on the one hand, that the requirement of registration as a precondition to instituting an infringement suit is desirable to forestall suits based on unfounded claims; that an erroneous refusal of registration for a valid claim could be corrected by mandamus proceedings; and that in any suit to establish the validity of a claim which the Register has held to be invalid, the Register should be a party to present his view to the court. In

<sup>56</sup> 260 F. 2d 637 (2d Cir. 1958).

support of this approach it might be pointed out that there have been only a few such mandamus proceedings and that the courts have generally sustained the Register in holding the claim invalid. In only two cases<sup>57</sup> has mandamus been issued to compel registration which the Register had refused, and these did not involve any question of copyrightability.

On the other hand, a mandamus action is costly and time consuming. It can be argued that when registration has been refused, a claimant who believes that his claim is valid and is being infringed should be able in a single suit to have the validity of his claim determined and, if his claim is held valid, to obtain redress against the infringer. As Chief Judge Clark of the Second Circuit pointed out in his dissenting opinion in *Vacheron v. Benrus Watch Co.*,<sup>58</sup> the claimant in this situation may need injunctive relief against an infringer to prevent further injury during the time it would take to litigate a mandamus action.

Perhaps these two views could be reconciled by permitting the validity of the rejected claim to be tried in an infringement action, with the requirement that the Register be notified of the action so that he may present to the court the basis for his refusal of registration.

### VIII. SUMMARY OF ISSUES

Assuming that some kind of registration system will be provided for in a revised copyright statute:

1. Should the statute contain express provisions specifying the scope or limits of the authority of the Register of Copyrights to refuse registration? If so, should such specification be stated in terms of (a) claims which do not meet the requirements of the statute; (b) claims which are invalid for stated reasons; (c) some other basis?

2. Should the statute provide expressly that a refusal of registration is subject to review by the courts?

3. Should registration, or application therefor, be a prerequisite to an action for infringement? Where registration is applied for and refused, should the applicant be required to establish the validity of his claim in a proceeding against the Register, or should he be entitled to bring an action for infringement and have the validity of his claim tried in that action? If the latter, should notice to the Register of the infringement action be required so that he may present to the court the basis for his refusal of registration?

<sup>57</sup> *King Features Syndicate, Inc. v. Bouvé*, 48 U.S.P.Q. 237 (D.C.D.C. 1940); and *Twentieth Century Fox Film Corp. v. Bouvé*, 33 F. Supp. 463 (D.C.D.C. 1940), *aff'd* 122 F.2d 51 D.C. Cir. 1941).

<sup>58</sup> *Supra* note 56.

---

---

COMMENTS AND VIEWS SUBMITTED TO THE  
COPYRIGHT OFFICE  
ON  
AUTHORITY OF THE REGISTER OF COPYRIGHTS  
TO REJECT APPLICATIONS FOR REGISTRATION

---

---

## CONTENTS

---

Comments and views submitted by—	Page
Harry R. Olsson, Jr.-----	103
Richard H. Walker-----	103
Walter J. Derenberg-----	104
George E. Frost-----	104
Alfred H. Wasserstrom-----	105

101

COMMENTS AND VIEWS SUBMITTED TO THE COPYRIGHT  
OFFICE ON AUTHORITY OF THE REGISTER OF COPY-  
RIGHTS TO REJECT APPLICATIONS FOR REGISTRATION

*By Harry R. Olsson, Jr.*

APRIL 22, 1959

\* \* \* \* \*  
AUTHORITY OF THE REGISTER TO REJECT REGISTRATION APPLICATIONS

(1) and (2) The statute should state it shall be the duty of the Register to accept valid applications for registration. It need not provide for a court review.

(3) A valid application for registration should be a prerequisite to an infringement action. The applicant should be entitled to bring an action for infringement and have the validity of his claim for registration tried in that action. Notice to the Register should be required so that he may present to the court his case for refusing registration.

\* \* \* \* \*  
HARRY R. OLSSON, JR.

---

*By Richard H. Walker*

(The Curtis Publishing Co.)

MAY 4, 1959.

\* \* \* \* \*  
AUTHORITY OF THE REGISTER OF COPYRIGHTS TO REJECT APPLICATIONS FOR  
REGISTRATION

The Register of Copyrights should have the authority by statute to refuse registration of copyrights under certain circumstances, but it is important that where a refusal results from an inaccurate exercise of discretion, the applicant should not have been substantially injured.

With respect to compliance with technical requirements or with regulations for registration, the Register should be expected to be infallible. When he refuses registration because of some failure here, it should be with notice to the applicant that his application can be corrected or that registration is impossible (i.e., because of omission of indicia on published copies; because the applicant is known not to be the "person entitled" to copyright; etc.). He should be told also that he has no standing to sue for infringement without first establishing his claim to copyright.

With respect to problems other than technical requirements and regulations relating to registration, if the Register sees fit to refuse registration, it should be with notice to the applicant that he may continue publication with notice of copyright, but that in a suit for infringement he will first be expected to establish his claim to copyright. No substantial injury to the public should result from continued publication with a possibly invalid copyright, because initial publication with copyright notice has already been made.

It should be a matter for the discretion of the Register to decide whether his refusal is based on failure to comply with technical requirements or regulations for registration, or for other reasons.

The statute should provide that refusal of registration is subject to review by the courts, and if a suit for infringement arises concerning a copyright, registration for which was refused, notice to the Register should be a requirement so that he could present the basis for his refusal.

\* \* \* \* \*  
RICHARD H. WALKER.

By *Walter J. Derenberg*

MAY 18, 1959.

\* \* \* [I]n connection with the study on the authority of the Register of Copyrights to reject applications for registration[:] I believe that the Register's authority is clearly circumscribed in the recent opinion by the Attorney General (41 Ops. A.G. No. 73). I strongly feel, however, that with regard to point 3 of the summary of issues, we should adopt the view of the dissenting judge in the *Vacheron* case and provide that registration shall not be a prerequisite to an action for infringement but that the unsuccessful applicant should be able to institute an infringement suit where he has tried in vain to register his claim with the Copyright Office. I believe it would be a good idea to provide that notice of the filing of such suit should be given to the Register of Copyrights, as suggested in the last sentence on page 98 of the study. As you may recall, the giving of a similar notice is presently provided whenever suits for patent or trademark infringement are filed in the Federal courts.

WALTER J. DERENBERG.

By *George E. Frost*

MAY 19, 1959.

\* \* \* \* \*  
 It makes me wince to think that it is even necessary to talk about the differing court decisions on whether suit can be brought on a copyright when registration has been sought and refused. More fundamentally, it seems to me that the Copyright Office can, and should, play a major creative role in the copyright law. One need only to point to the Patent Office and its history since 1836 to see how a specialized agency can exert an influence equal to that of the courts in molding the written law into conformity with practical matters.

In some respects the Office has indeed played this role. One of the prime examples is *Mazer v. Stein*. In other respects a decisive position by the Office has been lacking. The *Ballentine* case is a good example. It seems to me that a persuasive argument can be made that the *Ballentine* case represents the sort of situation where either answer, firmly made, would be better than leaving the issue floating for the many years that it did.

Of course this is not a one-way street. There are real headaches to decision-making. The recent opinion of the Attorney General on obscenity and the notice in the public press that the Office has chosen not to inquire into this matter bring out the point. The practical reasons in this particular case are most persuasive, but one might well question whether one approach should apply in the Copyright Office and another in the Post Office. I am personally inclined to favor what I understand the Copyright Office approach to be. But the real point is not whether examination procedures are easy or are hard, but rather whether through their use a more effective administration of the copyright law can be achieved.

In answer to question 1, page 98, it is my feeling that the statute should definitely include some provisions for the rejection of applications for registration. The language of title 35, United States Code, section 131 might form one approach. I would hesitate to name specific reasons in a statute on why registration should be refused, and hence would think that a generalized statement as to meeting the requirements of the statute is all that can be used. Incidentally, just because a statute calls for "examination" does not mean that the Office must in every instance go beyond the oath of the applicant.

As to question 2, some sort of review by appeal (rather than *mandamus*) appears to be an essential accompaniment to a power of the Register to refuse an application.

On question 3, I would insist that the applicant either pursue his right to register on appeal from the ruling of the Register, or abandon the whole matter.

GEORGE E. FROST.

*By Alfred H. Wasserstrom*

MAY 21, 1959.

\* \* \* \* \*

At the outset, let me say that I consider [Mrs.] Berger's study a valuable one. It raises, with commendable thoroughness, pertinent and significant questions. My own position is that the authority of the Register to refuse applications should be confined to relatively narrow limits. If an application, and I take that to include the accompanying deposit, is in apparent compliance with legal requirements, the application should be accepted and the certificate should issue. To put it another way, if the papers are good on their face that showing should suffice. I think our present basic statutory scheme as determined by the courts comports with this view and I consider it desirable to preserve such scheme, albeit in other respects there may be need for revision.

As [Mrs.] Berger rightly observes, the authority of the Register is essentially ministerial and subject to judicial control and correction by what was formerly mandamus and is now a mandatory injunction. That, I submit, is as it should be. Moreover, if the Register has refused to register even though application therefor has been made, the copyrightee should, nevertheless, be entitled to proceed against an alleged infringer, bearing in mind that he will have to establish in such action not only his right to the copyright which he seeks to vindicate, but also his right to the registration of his copyright claim which the Register should have granted. This is the view that Chief Judge Clark took in his dissent in *Vacheron Watches* and I think it is a sound one. While it does not seem to me necessary for a plaintiff to serve a notice to intervene on the Register in such a case, I suggest that the defendant have the right to call upon the Register to intervene (as, of course, so might the court on its own motion); thus would the court be aided in reaching its decision by knowing the Register's grounds for his refusal to register.

ALFRED H. WASSERSTROM.