

COPYRIGHT LAW REVISION

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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

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STUDIES 17-

18. Authority of the Register of Copyrights To  
Reject Applications for Registration



Printed for the use of the Committee on the Judiciary

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## SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS

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## FOREWORD

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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

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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.

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## STUDIES IN EARLIER COMMITTEE PRINTS

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**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

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

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

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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 *Bailie 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.

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COMMENTS AND VIEWS SUBMITTED TO THE  
COPYRIGHT OFFICE  
ON  
AUTHORITY OF THE REGISTER OF COPYRIGHTS  
TO REJECT APPLICATIONS FOR REGISTRATION

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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.