

PUBLICATION AND PREEMPTION IN COPY-  
RIGHT LAW: ELEGIAC REFLECTIONS ON  
*GOLDSTEIN v. CALIFORNIA*

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In *Goldstein v. California*<sup>1</sup> the Supreme Court was asked to help eliminate unauthorized tapes, a parasite on the recording industry.<sup>2</sup> This Article is a critical account of how, in search of a remedy, the Court rediscovered state copyright and rode roughshod over the concept of publication in copyright law.

The "tape pirate" takes and sells two separable sets of interests. One is the rights in the musical composition. These are usually embraced by the compulsory licensing scheme that has

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I don't know whether Professor Mueller will join in these strictures on *Goldstein v. California*. For one thing, the decision paid great deference to the interests of the Golden State, where Peggy and Ad put down refreshing roots nearly two decades ago, in the early days of the UCLA Law School, when a valiant little band outfought and outlasted an obscurantist administration. They had already pulled up the New Haven roots, to the lasting regret of their Yale friends. Of course, the real roots are in Wisconsin, in the stubborn, sturdy soil of Milwaukee. When I was housed in a University of Wisconsin high-rise at a meeting there a year ago, I was delighted to discover and show to Professor Nimmer a modest bronze plaque, saying simply "A. Mueller." It was in an elevator. An inquiring note to Ad, "Was this a memorial elevator?," led only to the expected quizzical—shall I say Socratic?—putoff. The incident leads me to propound a schoolboy riddle, which any schoolboy who has been through UCLA Law School can answer: Why is Professor Mueller *not* like an elevator? Because, though an elevator lifts you up, it also lets you down.

<sup>1</sup> 412 U.S. 546 (1973).

<sup>2</sup> The problem is not new. See Note, *Piracy on Records*, 5 STAN. L. REV. 433 (1953). However, its magnitude increased enormously because of the facility with which tapes can be reproduced. See, *Hearings on S. 646 and H.R. 6927 Before Subcomm. No. 3 of the House Comm. on the Judiciary*, 92d Cong., 1st Sess., ser. 7 (1971) [hereinafter cited as *Hearings*]. For an especially well-informed Note which explores odd corners of unauthorized duplication (e.g., of operatic performances), refer to Note, *Record Piracy and Copyright: Present Inadequacies and Future Overkill*, 23 MAINE L. REV. 359 (1971) [hereinafter cited as *Record Piracy*]. The big money of course is in current hits. See Lees, *Psst! Get Your Hot Glen Campbell Tapes Here*, N.Y. Times, Dec. 1, 1974, § 2, at 21, col. 1.

been part of the federal statute since 1909.<sup>3</sup> The composer and publisher may have enforcement problems, but they have clear enough rights against the pirate.<sup>4</sup> The second set of interests is the rights in the performance or rendition. The sharing of these interests between the actual artists and the producers of sound recordings is in dispute; however our present concern is with the existence and extent of such interests.

Congress in 1971 for the first time created federal rights against unauthorized duplication of sound recordings.<sup>5</sup> But the operation of these rights was prospective only. The state law violation alleged in *Goldstein* preceded the enactment of the federal statute, so the issue in that case was the enforceability of a state statute<sup>6</sup> against duplications occurring before the 1971 Sound Recording Amendment (hereinafter 1971 amendments) to the Copyright Act of 1909 became effective. Did the copyright clause of the Constitution, or the 1909 statute, or the 1971 amendments, or some combination of them, preclude state protection of sound recordings against unauthorized duplication?

The California statute, copied from a New York prototype,<sup>7</sup> is simple and sweeping: One is guilty of a misdemeanor who knowingly and with intent to sell "transfers or causes to be transferred any sounds recorded on a phonograph record, disc, wire,

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<sup>3</sup> 17 U.S.C. §§ 1 *et seq.* (1970).

<sup>4</sup> *Id.* §§ 1(e), 101(e). Note also 17 U.S.C. § 101(e) (Supp. II, 1972), which incorporates the remedies provided for copyright owners generally. See B. KAPLAN & R. BROWN, CASES ON COPYRIGHT, UNFAIR COMPETITION, AND OTHER TOPICS BEARING ON THE PROTECTION OF LITERARY, MUSICAL, AND ARTISTIC WORKS 542 (2d ed. 1974) [hereinafter cited as KAPLAN & BROWN]. There are also several recent holdings that unauthorized duplication is not the "similar use" that authorizes a compulsory license under section 1(e). *Fame Publishing Co. v. Alabama Custom Tape, Inc.*, 507 F.2d 667 (5th Cir. 1975); *Jondora Music Publishing Co. v. Melody Recordings, Inc.*, 506 F.2d 392 (3d Cir. 1974); *Edward B. Marks Music Corp. v. Colorado Magnetic, Inc.*, 497 F.2d 285 (10th Cir. 1974), *cert. denied*, 95 S. Ct. 801 (1975); *Duchess Music Corp. v. Stern*, 458 F.2d 1305 (9th Cir.), *cert. denied*, 409 U.S. 847 (1972). There have been dissents in each of these cases. Previously, duplicators who paid the statutory royalty stood apart from those who did not. See, *Hearings, supra* note 2, at 68-69. Now publishers can seek injunctions against any duplicators.

<sup>5</sup> Sound Recording Amendment of 1971, 17 U.S.C. §§ 1(f), 5(n), 19, 20, 26, 101(e) (Supp. II, 1972), amending Copyright Act, 17 U.S.C. §§ 1 *et seq.* (1970). The 1971 amendments limited the newly created right to sound recordings "fixed, published, and copyrighted . . . before January 1, 1975." Sound Recording Amendment of 1971, Pub. L. No. 92-140, § 3, 85 Stat. 392. This time limitation was removed by a subsequent amendment. Act of Dec. 31, 1974, Pub. L. No. 93-573, § 101, U.S. Code Cong. & Ad. News 6854 (Jan. 30, 1975). The subsequent law also increased the criminal penalties for infringing sound recordings. 17 U.S.C.A. § 104 (Supp., Feb. 1975); 18 U.S.C.A. § 2318 (Supp., Feb. 1975). See H.R. REP. NOS. 1389, 1581, 93d Cong., 2d Sess. (1974) (especially the dissenting views of Congressperson Drinan).

<sup>6</sup> CAL. PENAL CODE § 653h(a)(1) (West 1970).

<sup>7</sup> N.Y. GEN. BUS. LAW. § 561 (McKinney 1968).

tape, film," etc., "without the consent of the owner."<sup>8</sup> The "owner" is defined as "the person who owns the master phonograph record" or master tape used for producing records or tapes from which the illicit recorded sounds are in turn derived.<sup>9</sup> The "transfer" of sounds for sale without the consent of the owner of the master source is the total offense and the total scheme.

Contrast the state laws with the 1971 amendments to the Copyright Act. They first specify a new exclusive right: to "reproduce and distribute to the public . . . the actual sounds fixed in the recording."<sup>10</sup> Two provisos are incorporated to insure that this is all that is conferred, and that anyone is free independently to make a recording even though its "sounds imitate or simulate those in the copyrighted sound recording . . . ."<sup>11</sup> Then, after adding "sound recordings" to the classification of copyrightable works, the amendments provide for a new form of notice, the letter P (for "phonogram") in a circle.<sup>12</sup> This is to distinguish the new claim of copyright from the copyright in the recorded composition (if there is one), the notice for which would be the familiar C in a circle. Definitions and cross-references follow; these locate the new right firmly within the fabric of the statute. Who would claim and enforce the new copyright was left ambiguous; there is a reference to "the producer of the sound recording," and that is doubtless the intended solution.<sup>13</sup>

In order to give the Copyright Office time to prepare for the new registrations, the statute's effective date was set at four months after enactment, and accordingly became February 15, 1972. The new right applies only to "sound recordings fixed, published, and copyrighted on and after the effective date." Nothing in the Copyright Act as now amended is to "be applied retroactively or be construed as affecting in any way any rights with respect to sound recordings fixed before the effective date of [the] Act."<sup>14</sup> We shall in due course ask what inferences, if any, are to be drawn from this disclaimer.

The right against duplication (often called dubbing) is thus defined; and it acquires scope, duration, and remedies from the

<sup>8</sup> CAL. PENAL CODE § 653h(a)(1) (West 1970).

<sup>9</sup> *Id.* § 653h(b).

<sup>10</sup> Sound Recording Amendment of 1971, 17 U.S.C. § 1(f) (Supp. II, 1972).

<sup>11</sup> *Id.*

<sup>12</sup> *Id.* § 19.

<sup>13</sup> On the administration of the sound recordings copyright, refer to Keziah, *Registration Problems Encountered by the Copyright Office Under the Recent Sound Recording Amendment*, 20 BULL. COPYR. Soc'y 3 (1972).

<sup>14</sup> Sound Recording Amendment of 1971, Pub. L. No. 92-140, § 3, 85 Stat. 392.

rest of Title 17 of the United States Code. There can be no realistic doubt that this field—of recordings fixed since February 15, 1972—is now occupied.

The Court, however, had reached for a case where both the recorded performance that was duplicated and the act of duplicating antedated February 15, 1972.<sup>15</sup> But the effect of its decision is not confined to this combination of preceding events. In the Court's reading of the closing disclaimer in the 1971 amendments, the whole world of recordings created before the effective date lies open, either ripe for copying or subject to whatever restraints the states are permitted to impose.

The defendant Goldstein and his co-workers had moved to dismiss a charge against them for violation of the California statute, contending that the statute encroached upon a field occupied both by the federal statutes and by the unaided force of the constitutional grant to Congress of:

Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries . . . .<sup>16</sup>

#### THE *Goldstein* OPINION: PREEMPTION

The Chief Justice, in deciding that the copyright clause was not automatically preemptive, eschewed the easy ground that the clause by its terms does not exclude concurrent state power. He took the high road that Marshall first laid out in *Gibbons v. Ogden*<sup>17</sup> and that Curtis succinctly stated in *Cooley v. Board of Wardens*<sup>18</sup> with respect to the commerce power:

Whatever subjects of this power are in their nature national, or admit only of one uniform system, or plan of regulation, may justly be said to be of such a nature as to require exclusive legislation by Congress.<sup>19</sup>

Chief Justice Burger then recalled Madison's observation in No. 43 of the *Federalist*, about copyright and patent: "The States can-

<sup>15</sup> The selection of *Goldstein* was odd, since the record was skimpy, and there had been nothing more than one memorandum opinion in the state courts. See Brief for Petitioners at App., *Goldstein v. California*, 412 U.S. 546 (1973). Some content was however supplied by *Tate Indus. Ass'n of America v. Younger*, 316 F. Supp. 340 (C.D. Cal. 1970), *appeal dismissed for lack of jurisdiction*, 401 U.S. 902 (1971) (upholding the California statute in a declaratory judgment action to which the *Goldstein* defendants were parties); see *Record Piracy*, *supra* note 2, at 394 n.135.

<sup>16</sup> U.S. CONST. art. I § 8, cl. 8.

<sup>17</sup> 22 U.S. (9 Wheat.) 1 (1824).

<sup>18</sup> 53 U.S. (12 How.) 299, 319 (1851).

<sup>19</sup> *Id.*

not separately make effectual provision for either of the cases . . . ."<sup>20</sup> But he turned away from the conclusion one would expect, that in an era of national networks and national markets, "one uniform system" was called for. Instead, he invoked an image of diversity, asserting that some writings may "be of purely local importance." He pronounced state copyright capable of "induc[ing] new artistic creations" within a state and minimized the economic burden of state copyright, likening it to a food concession which one could avoid by buying elsewhere.<sup>21</sup> Later in the Court's opinion he noted California's particular interest in barring piracy as "conduct that may adversely affect the continued production of new recordings, a large industry in California."<sup>22</sup>

All of this amounts to a quite original endorsement of state copyright,<sup>23</sup> which was not even suggested in the numerous briefs (all but one of the amicus briefs supported California). But this rehabilitation of state copyright was tempered by a recognition that Congress can impose as much uniformity as it wishes, and led to the mild conclusion that "under the Constitution, the States have not relinquished all power to grant to authors 'the exclusive Right to their respective Writings.'"<sup>24</sup>

If the copyright clause does not clearly imply a need for uniformity, it is more explicit in specifying that Congress may authorize patents and copyrights only for "limited Times." The intention to limit monopoly grants, especially in products of the mind, is obvious and has strong historical roots. Is it possible that the states may create copyrights of unlimited duration? That would appear to be what the California statute does; the Court said it "forbids individuals to appropriate recordings at any time after release." The Court gave the "limited Times" argument remarkably short shrift, again with a novel explanation:

When Congress grants an exclusive right or monopoly, its effects are pervasive; no citizen or State may escape its reach. As we have noted, however, the exclusive right granted by a State is confined to its borders. Consequently, even when the right is unlimited in duration, any tendency to inhibit further progress in science or the arts is narrowly circumscribed. The challenged statute cannot be voided for lack of a durational limitation.<sup>25</sup>

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<sup>20</sup> 412 U.S. at 555-56, quoting THE FEDERALIST No. 43, at 309 (B. Wright ed. 1961) (J. Madison).

<sup>21</sup> 412 U.S. at 558-59.

<sup>22</sup> *Id.* at 571.

<sup>23</sup> There is, however, a scholarly counterpart to this position. See Whicher, *The Ghost of Donaldson v. Beckett: An Inquiry Into the Constitutional Distribution of Powers Over the Law of Literary Property in the United States* (pt. 1), 9 BULL. COPYR. SOC'Y 102 (1961); *id.* (pt. 2), at 194 (1962), reprinted in THE CREATIVE ARTS AND THE JUDICIAL PROCESS 85 (J. Whicher ed. 1965).

<sup>24</sup> 412 U.S. at 560.

<sup>25</sup> *Id.* at 560-61.

The Court, having magnified state copyright power rather beyond what I believe was the common understanding, then turned to the decisive question: How far had Congress exerted its power to displace state law under the supremacy clause? The opinion was perceptive in observing that:

The history of federal copyright statutes indicates that the congressional determination to consider specific classes of writings is dependent, not only on the character of the writing, but also on the commercial importance of the product to the national economy. As our technology has expanded the means available for creative activity and has provided economical means for reproducing manifestations of such activity, new areas of federal protection have been initiated.<sup>26</sup>

A long footnote recited the accretion of copyrightable classes of writings since the original Act of 1790, which dealt only with maps, charts, and books.<sup>27</sup>

The Chief Justice then confidently attacked the problems posed by the tortuous treatment of player-piano rolls and phonograph records in the major revision of the statute in 1909. In 1908 the Supreme Court, in the celebrated and obfuscating case of *White-Smith Music Publishing Co. v. Apollo Co.*,<sup>28</sup> had held that a player-piano roll could not be an infringing copy of the composition (because a copy, the Court said, had to be visually perceptible). The revisers, pressed on the one hand to allow composers some rights against the burgeoning business of making rolls and records, but on the other intimidated by the implications of *White-Smith v. Apollo* (and concerned also not to create exclusive rights that could be monopolized by a player-piano Trust!), declared in the authoritative House Report that:

It is not the intention of the committee to extend the right of copyright to the mechanical reproductions themselves, but only to give the composer or copyright proprietor the control, in accordance with the provisions of the bill, of the manufacture and use of such devices.<sup>29</sup>

The primary provision referred to was section 1(e) which created a new right in the use of a musical composition on "parts of instruments" (e.g., rolls and records), modified by the compulsory license available to anyone, once the work had been recorded.<sup>30</sup>

We may readily agree that all this remains obfuscating to this day, that it determined nothing about the *possibility* of copyright

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<sup>26</sup> *Id.* at 562.

<sup>27</sup> *Id.* at 562 n.17.

<sup>28</sup> 209 U.S. 1 (1908).

<sup>29</sup> H.R. REP. NO. 2222, 60th Cong., 2d Sess. 9 (1909).

<sup>30</sup> 17 U.S.C. § 1(e) (1970).

in renditions. Moreover, as the Court concluded (albeit in a backhanded fashion) in *Goldstein*: "Nowhere does the report indicate . . . that Congress intended records, as renderings of original artistic performance, to be free from state control."<sup>31</sup>

Suppose one asks instead whether Congress—in 1909 or later—intended renderings to be subject to state control? How one poses the issue reveals one's assumptions. The significance of the Court's rehabilitation of state copyright is the assumption that it exists unless Congress takes it away. My starting-point is to doubt that it exists at all unless Congress says or implies that it wishes or permits the states to exercise a portion of the copyright power.

In determining how much of a field Congress has pre-empted, "[n]o simple formula," as the Chief Justice wisely declared, "can capture the complexities of this determination; the conflicts which may develop between state and federal action are as varied as the fields to which congressional action may apply."<sup>32</sup> When there is a fairly comprehensive scheme of federal regulation, as there is in the Copyright Act, one should look at the total structure of the Act, as well as at specific sections that speak to its scope. Of the latter sort, there are three not altogether concordant statements of its scope. One is section 4, a free-floating declaration: "The works for which copyright may be secured under this title shall include all the writings of an author."<sup>33</sup> If this means that anything which qualifies as a "writing" under the Constitution has been protected by the statute, it is simply not so, even if all 535 members of Congress should rise in their two Houses and recite section 4 with feeling. The question before us—the protection of recorded renditions—makes it clear that the statute does not protect all "writings." Although there have been doubts and uncertainties in the past, there has recently been agreement by the congressional committees reporting the 1971 amendments, by the Court and the dissenters in *Goldstein*, and by all right-thinking copyright scholars and practitioners that: (1) Renditions are "writings" within the copyright clause; and (2) Renditions did not become eligible for statutory copyright until February 15, 1972—and then only for the narrowly stated right against dubbing as distinct, for example, from a right to control the broadcast of a rendition.<sup>34</sup>

Until the 1971 amendments, there simply was no way to fit renditions within the structure and machinery provided by the

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<sup>31</sup> 412 U.S. at 566 (emphasis in original).

<sup>32</sup> *Id.* at 561.

<sup>33</sup> 17 U.S.C. § 4 (1970).

<sup>34</sup> See note 118 *infra*.

statute. The Copyright Office would not accept phonograph records for deposit and registration, even for copyright in the musical composition, and its position was not challenged.<sup>35</sup>

The next provision that purports to declare the scope of the statute is equally puzzling. Section 5, after listing classes (a) through (m) of works to which copyright is extended, says: "The above specifications shall not be held to limit the subject matter of copyright as defined in section 4 of this title . . . ."<sup>36</sup> This props up section 4, but does not add anything to it. The Chief Justice concluded reasonably that these sections should not be given a preemptive reading. But the Court substantially ignored the third statutory declaration about preemption, section 2. Section 2 does have preemptive effect, making "publication" the key to those parts of copyright that Congress intended to leave to the states:

Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.<sup>37</sup>

If the verbiage of section 2 has an archaic aroma—"at common law or in equity"—it arises because section 2, although new in 1909, is redolent of history. It looks back to the great cases—*Donaldson v. Becket*<sup>38</sup> in England, and *Wheaton v. Peters*<sup>39</sup> in this country—which subjugated whatever copyright existed in the common law to the early statutes in both countries, and established publication as the great divide. After *Wheaton v. Peters*, a work that was published could acquire copyright, if at all, only by adherence to the statute. An unpublished work was left to common law rights and equitable remedies, that is, to state law. But it need not have been so. The constitutional grant of power to Congress refers to "Writings;" it is not limited to published writings. Thus, from the first Copyright Act of 1790<sup>40</sup> until 1909 there was a curious and seldom used federal right of action for the unauthorized publication of a manuscript.<sup>41</sup> The 1909 statute deleted this, but it offered in section 12 a statutory copyright for several classes of works (but not book manuscripts!) "of which copies are

<sup>35</sup> See *Goldstein v. California*, 412 U.S. 546, 568 n.25 (1973); Kurlantzick, *The Constitutionality of State Law Protection of Sound Recordings*, 5 CONN. L. REV. 204, 210 (1972) [hereinafter cited as Kurlantzick].

<sup>36</sup> 17 U.S.C. § 5 (1970).

<sup>37</sup> *Id.* § 2.

<sup>38</sup> 98 Eng. Rep. 257 (H.L. 1774).

<sup>39</sup> 33 U.S. (8 Pet.) 591 (1834).

<sup>40</sup> Act of May 31, 1790, ch. 15, 2 Stat. 124.

<sup>41</sup> *Id.* § 6, 2 Stat. 125. See Kaplan, *Performer's Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 424-25 n.59 (1956).



not reproduced for sale . . . ."<sup>42</sup> (If the reader is beginning to find the 1909 statute incoherent in important respects, he should know that he is not alone.) Section 12 is mentioned here only to underscore the point that Congress can exercise jurisdiction over unpublished works. The coexistence of section 2 and section 12 signals a concurrent and not a preemptive exercise as to these unpublished works.

The important question is: Does the statute preempt all published works? Consider the investitive language of section 10, on which, I would assert, everything else pivots: "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 . . . ."<sup>43</sup> Does this leave some published works to the state? If so, which? If publication is the critical event, are renditions published when they are generally disseminated and sold as sound recordings? What law decides this, state or federal? These have been familiar questions in copyright, at least since *RCA Manufacturing Co. v. Whiteman*<sup>44</sup> in 1940. I shall shortly suggest answers to them.

The immediate point is (remember, we are still working through the Court's opinion in *Goldstein*): What did the Court say about these aspects of publication? Nothing. There is a footnote. It is, with all due respect, deplorably ill-informed. Its total text follows:

Petitioners place great stress on their belief that the records or tapes which they copied had been "published." We have no need to determine whether, *under state law*, these recordings had been published or what legal consequences such publication might have. *For purposes of federal law*, "publication" serves only as a term of the art which defines the legal relationships which Congress has adopted under the federal copyright statutes. As to categories of writings which Congress has not brought within the scope of the federal statute, the term has no application.<sup>45</sup>

That footnote is appended to a rather cursory consideration of *Sears, Roebuck & Co. v. Stiffel Co.*<sup>46</sup> and *Compco Corp. v. Daybrite Lighting Co.*,<sup>47</sup> which will be discussed presently. It is as though the opinion were hurrying to a close. And it does close, in a brief coda which quickly recapitulates earlier themes: California's power "retained under the Constitution" has been

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<sup>42</sup> 17 U.S.C. § 12 (1970).

<sup>43</sup> *Id.* § 10 (emphasis added).

<sup>44</sup> 114 F.2d 86 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940).

<sup>45</sup> 412 U.S. at 570 n.28 (emphasis by the Court).

<sup>46</sup> 376 U.S. 225 (1964).

<sup>47</sup> 376 U.S. 234 (1964).

exercised to give "recordings the attributes of property." No statutory preemption bars the way, "since Congress has indicated neither that it wishes to protect, nor to free from protection, recordings of musical performance fixed prior to February 15, 1972."<sup>48</sup> This conclusion must rest in large part on the disclaimer in the 1971 amendments, the meaning of which had been left unexplored. We are reassured that: "No restraint has been placed on the use of an idea or concept;" others "can record the same composition in the same manner." *Sears* and *Compco*, "which [the Court said] we reaffirm today" are simply inapplicable.<sup>49</sup> Congress can take further action if it chooses.

What we have from the Court, then, is first an unnecessarily elaborate reconstruction of state power to create copyright interests, a power that is, however, always vulnerable to preemption. Second, the copyright clause itself is found wanting in preemptive force, a conclusion that might be acceptable if it had not dealt so casually with the "limited Times" constraint.<sup>50</sup> Third, what looks like preemptive language in the statute (sections 4 and 5) is shown not to have that effect; but, fourth, the significance of publication (sections 2 and 10) as denoting a primarily federal sphere for published works is ignored; and, fifth, the teaching of *Sears* and *Compco*, that omission from protection points toward exposure to competition, is diminished.

#### PUBLICATION: LEARNED HAND V. NEW YORK

Let us try to construct the fourth and fifth steps that the Court neglected. The significance of publication is dramatized by a long wrestling match between Judge Learned Hand and the New York courts. Judge Hand achieved the first fall, in *RCA Manufacturing Co. v. Whiteman*.<sup>51</sup> There, RCA as producer and Paul Whiteman as band leader tried to prevent the broadcast of Whiteman records.<sup>52</sup> The records bore the restrictive legend "Only For Non-commercial Use."<sup>53</sup> The legend was held to be ineffective.<sup>54</sup> The plaintiffs asserted the broadcasters' conduct to

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<sup>48</sup> 412 U.S. at 571.

<sup>49</sup> *Id.*

<sup>50</sup> *Cf. Kurlantzick, supra* note 35, at 225.

<sup>51</sup> 114 F.2d 86 (2d Cir.), *cert. denied*, 311 U.S. 712 (1940). For an important companion statement of Judge Hand's views on publication, refer to *Fashion Originators Guild v. FTC*, 114 F.2d 80, 83 (2d Cir. 1940).

<sup>52</sup> Whiteman had previously sued a broadcasting company to enjoin the broadcast of records of his performances. In this case RCA was also suing the same broadcasting company, but joined Whiteman as defendant so as to establish that he had no interest in the records of his performances. 114 F.2d at 87.

<sup>53</sup> *Id.*

<sup>54</sup> *Id.* at 88.

be unfair competition (recall that at the time there were regular live broadcasts by the big bands), invoking the misappropriation concept of *International News Service v. Associated Press*.<sup>55</sup> Judge Hand deprecated the authority and applicability of *International News* in a famous passage.<sup>56</sup> The plaintiffs, he insisted, were claiming a common law copyright, but they no longer had one because the renditions had been published.<sup>57</sup> This conclusion is entwined with arguments rebutting the efficacy of the restrictive notice. That the renditions were published so as to divest common law copyright is not stated in directly quotable form; but there was no doubt of the presence and impact of this view. Indeed in *Capitol Records, Inc. v. Mercury Records Corp.*<sup>58</sup> Judge Dimock later characterized *RCA Manufacturing Co. v. Whiteman* as stating that "common law property . . . ended with the sale of the records and that thereafter anyone might copy them and use them as he pleased."<sup>59</sup> (The latter part of this characterization goes a bit too far; *Whiteman* was not directly concerned with copying).

Judge Hand's direct opponent in *Whiteman* was not the New York courts, but the Supreme Court of Pennsylvania, which three years before in *Waring v. WDAS Broadcasting Station, Inc.*,<sup>60</sup> had reached conclusions on the main issues contrary to Hand's position. The *Whiteman* decision did not invoke federal supremacy. Indeed, in that innocent time when the *Erie* doctrine was still in its infancy, Hand did not say what law he was invoking. His own authority, and that of the Second Circuit Court of Appeals as then constituted, pinned *Waring* to the mat to win the first round.

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<sup>55</sup> 248 U.S. 215 (1918).

<sup>56</sup> That much discussed decision really held no more than that a western newspaper might not take advantage of the fact that it was published some hours later than papers in the east, to copy the news which the plaintiff had collected at its own expense. In spite of some general language it must be confined to that situation; certainly it cannot be used as a cover to prevent competitors from ever appropriating the results of the industry, skill, and expense of others. "Property" is a historical concept; one may bestow much labor and ingenuity which inures only to the public benefit; "ideas", for instance, though upon them all civilization is built, may never be "owned". The law does not protect them at all, but only their expression; and how far that protection shall go is a question of more or less; an author has no "natural right" even so far, and is not free to make his own terms with the public. . . . If the talents of conductors of orchestras are denied that compensation which is necessary to evoke their efforts because they get too little for phonographic records, we have no means of knowing it, or any right to assume it; and it is idle to invoke the *deus ex machina* of a "progress" which is probably spurious, and would not be for us to realize, if it were genuine.

114 F.2d at 90 (citation omitted).

<sup>57</sup> See, *id.* at 87.

<sup>58</sup> 221 F.2d 657 (2d Cir. 1955).

<sup>59</sup> *Id.* at 663.

<sup>60</sup> 327 Pa. 433, 194 A. 631 (1937).

But the New York courts were then and are now true believers in an expansive tort of misappropriation. In the second round ten years later, Justice Greenberg called upon this ground for relief in *Metropolitan Opera Association, Inc. v. Wagner-Nichols Recorder Corp.*<sup>61</sup> There the defendants' misconduct lay in taking Metropolitan broadcasts off the air and selling records of them. The Met had an exclusive contract with Columbia Records, which was also a plaintiff.<sup>62</sup> If this case had been decided on a theory of common law copyright, the court would not have had to conclude that broadcast performances had been published so as to divest common law rights. It is well established that an unrecorded performance does not "publish" a dramatic or a musical work so as to divest common law rights; such works are traditionally published by reproduction in printed copies.<sup>63</sup> Similarly, the unrecorded performance by a Saturday afternoon's soloist, chorus and orchestra need not be considered publication, even if it is broadcast. The "author"—here taken to be the Metropolitan Opera Association—should have the right of *first* publication, of first reproducing the performance in some form of "copies." In the case of a rendition, the only form of copy that is imaginable, certainly the only form that would be salable, is a recording. If publication has any useful meaning, the rendition has been published once it has been generally disseminated in recordings for sale. Whether the performer then has a right to prevent others from reproducing his record is of course the question; and, as the Court held in *Goldstein*, that is a question of copyright.

But Justice Greenberg did not follow this dusty path in his opinion. He galloped off cross-country to protect the "property" of the plaintiffs against the defendants' "unconscionable business practices and their invasion of the moral standards of the market place" by a "venture purposed to gather in the harvest the seeds of which were planted and nurtured by others . . . ."<sup>64</sup> The Appellate Division affirmed in an unemotional *per curiam* opinion, the essence of which was:

Defendants' acts, as alleged in the complaint, constitute a misappropriation of the work, skill, expenditure and good will of plaintiffs, and present a case of unfair competition. Moreover, upon this record, these property interests of plaintiffs are entitled to protection by injunction *pendente lite*

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<sup>61</sup> 199 Misc. 786, 101 N.Y.S.2d 483 (Sup. Ct. 1950), *aff'd* 279 App. Div. 632, 107 N.Y.S.2d 795 (1951).

<sup>62</sup> American Broadcasting Company, which had an exclusive broadcast contract with Metropolitan, was also a plaintiff.

<sup>63</sup> *Ferris v. Frohman*, 223 U.S. 424 (1912); see text accompanying note 88 *infra*.

<sup>64</sup> 199 Misc. at 805, 101 N.Y.S.2d at 500.

against acts of infringement induced by defendants' unfair course of business.<sup>65</sup>

Finally in the third round an actual case of sound recording duplication came before the Second Circuit Court of Appeals in *Capitol Records, Inc. v. Mercury Records Corp.*<sup>66</sup> Plaintiff and defendant were each in possession of master recordings of virtuoso performances of compositions in the public domain. After finding that "plaintiff was in the beginning vested with the right to make and vend the records in the United States," Judge Dimock properly inquired: "Was that right lost as soon as plaintiff sold first records?"<sup>67</sup> *RCA Manufacturing Co. v. Whiteman*, he noted, would tell us: "The common-law property in the performances of musical artists which had been recorded ended with the sale of the records . . ." <sup>68</sup>

But, Judge Dimock continued, that statement from the *Whiteman* case, "is not the law of the State of New York."<sup>69</sup> He considered it an inescapable inference from the *Metropolitan Opera* case that New York courts would protect the producer of sound recordings. Indeed, though not much was made of it, Columbia had earlier made and sold recordings of two of the Metropolitan operas that defendants had taken off-the-air. (But note, the records were not of the same performance that defendants appropriated.)

How did the law of the state of New York come to be controlling? It was much more than a matter of heightened sensitivity to *Erie*. Judge Dimock, in a careful and persuasive analysis, showed that renditions were writings capable of copyright but that they were not protected under the 1909 Act. Without using any of the apparatus for finding or denying preemption, he then concluded baldly: "Since the Copyright Act does not deal with the protection of phonograph records of the performances of public-domain compositions by virtuosos, we have no basis for applying federal law."<sup>70</sup>

This was the weak point of his otherwise admirable opinion, and Judge Hand lunged for it. But he missed, for his is the dissenting opinion. In a passage of considerable density, he maintained that whether federal law applied must be a federal question. Taking as given that in federal law "publication" amounts

<sup>65</sup> 279 App. Div. 632, 633, 107 N.Y.S.2d 795, 797 (1951).

<sup>66</sup> 221 F.2d 657 (2d Cir. 1955).

<sup>67</sup> *Id.* at 663.

<sup>68</sup> *Id.* (Dimock, J.), characterizing the result in *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir. 1940).

<sup>69</sup> 221 F.2d 657, 663 (2d Cir. 1955).

<sup>70</sup> *Id.* at 662 (emphasis added).

to a surrender of common law property, he said it was arguable that:

[t]he courts of New York should be deemed free, sub nomine "unfair competition," to determine what conduct shall constitute a "publication" of a "work" not covered by the Copyright Act. It would then follow that they could grant to an author a perpetual monopoly, although he exploited the "work" with all the freedom he would have enjoyed, had it been copyrighted. I cannot believe that the failure of Congress to include within the Act all that the Clause covers should give the states so wide a power. To do so would pro tanto defeat the overriding purpose of the Clause, which was to grant only for "limited Times" the untrammelled exploitation of an author's "Writings." Either he must be content with such circumscribed exploitation as does not constitute "publication," or he must eventually dedicate his "work" to the public.<sup>71</sup>

He reinforced this "limited Times" argument with a demonstration that the clause also presses for national uniformity.

Judge Hand concluded that it was wrong for Judge Dimock to rely on "the view of the New York courts." If a performer's work is a writing within the copyright clause, Hand said "it must follow that it is a federal question whether he has published the 'work.'"<sup>72</sup> Federal preemption principles and federal copyright principles require attention to the decisive role of publication.

By now Judge Hand had lost, two falls out of three. Ringer, an astute commentator, in summing up the state of the law in 1957, could reasonably conclude (after examining all the cases, not just the high points here reviewed) that "courts in dubbing [duplicating] cases must apply state common law rules. . . . Recent decisions indicate that common law copyright protection for a recorded performance may be unlimited both in duration and in scope."<sup>73</sup> And so also unlimited protection on a theory of unfair competition might be available "where there has simply been a 'misappropriation' or a 'free ride.'"<sup>74</sup>

Thus, Hand's seemed a voice crying in the wilderness. But it was the voice of a true prophet, for in 1964 his position was essentially validated in the *Sears* and *Compco* cases.

In these unanimous decisions the Court held broadly that a state could not prevent copying of lamps and lighting fixtures that did not qualify for patents, and also broadly declared that the same

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<sup>71</sup> *Id.* at 667.

<sup>72</sup> *Id.*

<sup>73</sup> Ringer, *The Unauthorized Duplication of Sound Recordings*, COPYRIGHT LAW REVISION STUDIES, No. 26, in SENATE COMM. ON THE JUDICIARY, 82D CONG., 2D SESS. 20 (Comm. Print 1961; original date 1957).

<sup>74</sup> *Id.*

federal preemption principles would apply to works not copyrightable.<sup>75</sup> Federal supremacy pervaded Justice Black's opinion, carrying with it what seemed to be a clear message that federal law must determine whether an invention or a writing is open to the public; that is, whether it is published, whether it has the protection of patent or copyright, and whether the states can give it any form of protection.

#### THE PUT-DOWN OF *Sears* AND *Compco*

However, this vindication of Hand's position turned to ashes in *Goldstein* (we are now in the fifth step of that opinion). For familiar and generous readings of *Sears* and *Compco*, we have to look to the dissenting opinions of Justices Douglas and Marshall.<sup>76</sup> They noted that, although these cases were about patents, Justice Black had reiterated:

Today we have held in *Sears, Roebuck & Co. v Stiffel Co.* . . . that when an article is unprotected by a patent or a copyright, state law may not forbid others to copy that article. To forbid copying would interfere with the federal policy, found in Art. I § 8, cl. 8, of the Constitution and in the implementing federal statutes, of allowing free access to copy whatever the federal patent and copyright laws leave in the public domain.<sup>77</sup>

Justice Douglas pointed to the Court's emphasis in *Sears* on the need for "uniform federal standards" in the patent system, and recalled with approval Judge Hand's similar observations about copyright. Justice Marshall, mindful that the silence of Congress is ordinarily said to betoken freedom from preemption, saw in *Sears* and *Compco*:

A rule of construction that, unless the failure to provide patent or copyright protection for some class of works could clearly be shown to reflect a judgment that state regulation was permitted, the silence of Congress would be taken to reflect a judgment that free competition should prevail.<sup>78</sup>

But the Court read *Sears* and *Compco* narrowly.

In those cases, the question was whether a State could, under principles of a state unfair competition law, preclude the copying of mechanical configurations which did not possess the qualities required for the granting of a federal design or mechanical patent.<sup>79</sup>

The Chief Justice found in the patent law a careful balance between articles it was willing to protect in order to "encourage in-

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<sup>75</sup> *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964).

<sup>76</sup> 412 U.S. at 572, 576.

<sup>77</sup> *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964).

<sup>78</sup> 412 U.S. at 577-78.

<sup>79</sup> *Id.* at 569.

novation and originality of invention" and those "it wished to remain free" to be copied. But, "[i]n regard to this category of 'writings' [sound recordings] Congress has drawn no balance; rather it has left the area unattended, and no reason exists why the State should not be free to act."<sup>80</sup>

Now, there are seemingly important differences between patent preemption and copyright preemption which I will note very briefly. First, the objects in *Sears* and *Compco* were unpatentable because they did not meet the qualitative standards of invention, not because lamps and lighting fixtures as such were not patentable machines or patentable designs. The copyright equivalent to the lamp in *Sears* would be works that are unoriginal or that are too abstract to be considered expressions.<sup>81</sup> It would confound the copyright system to let the states create monopolies in such works, just as it would confound the patent system to let the states give patents for discoveries that are in fact obvious.

Unlike *Sears* and *Compco*, *Goldstein* dealt with categories of works that are not included in the copyright statute. Similar problems can arise with patent subject-matter. For example, the Supreme Court has held that most computer programs are not statutory subject-matter.<sup>82</sup> Does this mean that the states can issue patents on computer programs? I doubt it; in this respect the patent system is more preemptive than copyright (and always has been).<sup>83</sup>

But even though patent law is preemptive, it does leave a substantial area to state regulation, namely the protection of contractual and confidential relations with respect to industrial trade secrets, as the Supreme Court recently affirmed in an opinion by the Chief Justice which relied heavily on *Goldstein*.<sup>84</sup> Important complications aside, is there not a rough parallel here between trade secrets and the copyright scheme that leaves unpublished

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<sup>80</sup> *Id.* at 570.

<sup>81</sup> See Goldstein, "Inconsistent Premises" and the "Acceptable Middle Grounds": A Comment on *Goldstein v. California*, 21 BULL. COPYR. SOC'Y 25 (1973).

<sup>82</sup> *Gottschalk v. Benson*, 409 U.S. 63 (1972).

<sup>83</sup> So I thought in contributing to the Columbia Law Review's *Symposium* in 1964. *Product Simulation: A Right or a Wrong?*, 64 COLUM. L. REV. 1216 (1964). I still think so; but perhaps I have insufficiently absorbed some astonishingly loose and sweeping statements in *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974). I have to leave these to articles I hope others are preparing; and like Justice Marshall, concur only in the predictable outcome of *Kewanee*. See Stern, *A Reexamination of Preemption of State Trade Secret Law After Kewanee*, 42 GEO. WASH. L. REV. 927 (1974), which came to hand just as this paper was completed and which does not seem seriously inhibited by the author's position in the Antitrust Division.

<sup>84</sup> *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470 (1974). Justices Douglas and Brennan dissented.



writings to state law? A trade secret is "unpublished," and is effectively exploitable only until it is disclosed or rediscovered. Furthermore, an inventor is barred from a patent if his invention has been in public use or on sale more than a year.<sup>85</sup>

There is a fascinating interplay between patents and copyright that keeps the differences just noted from becoming real distinctions; it is an interplay which turns on policies about preemption and publication.

#### DISTORTIONS OF "PUBLICATION"

Although the dissenting Justices in *Goldstein* tried to rehabilitate *Sears-Compco* preemption, they dealt no more adequately than the Court did with the significance of publication, which survives only in mutilated form. Not that it was a polished and symmetrical touchstone before *Goldstein*. It has never been decisively settled, for example, whether phonograph records published the musical composition, as distinct from the rendition of the composition. The English-speaking visitor from outer space would surely think that a hit song which had been broadcast wearisome tens of millions of times and of which a million records had been distributed, was "published;" and a number of judges from inner space thought so too—albeit in *obiter dicta*.<sup>86</sup> But there was an intensely practical reason for the trade and the copyright bar to resist such a conclusion. The Copyright Office would not accept records for registration of copyright. The acquisition of section 10 copyright, to be sure, depends not on registration but on publication with notice; but where and how the notice should be affixed was unknown. Furthermore, when dozens of recording companies could use the compulsory license to produce their version of a major hit, there would be understandable uncertainty about the retention of the notice and about the consequence of its widespread omission.<sup>87</sup> In any case, obtaining statutory copyright for a song is simplicity itself. Even if old-fashioned sheet music is no longer published for sale, the statute, as we have seen, offers section 12 copyright by deposit of a single copy.

This ready availability of statutory copyright for musical compositions set them apart from renditions, for which there was no statutory copyright until the 1971 amendments. Its drafters realized that only the sound recording could embody the rendition, a view consistent with the Hand position that only a recording

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<sup>85</sup> 35 U.S.C. § 102(b) (1970).

<sup>86</sup> See KAPLAN & BROWN, *supra* note 4, at pt. 1, Topic B, § 4, at 79 *et seq.*

<sup>87</sup> See Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469 (1955).

could publish the rendition, if it were to be "published" at all in such a way as to divest common law rights.

The contrary notion is a stubborn one. Performance does not publish a work even when the work is designed for performance and is commercially exploited chiefly by performance. In American law the notion is rooted in *Ferris v. Frohman*,<sup>88</sup> which involved the unauthorized production of a play of British origin (with attendant complications that we may disregard). Justice Hughes, in his magisterial manner that brooked no impediments, held for a unanimous Court: "The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right, save by operation of statute."<sup>89</sup> And "[t]here was no statute here by virtue of which the common-law right was lost through the performance of the unpublished play."<sup>90</sup> The defendant's production in *Ferris* took place in 1905. The 1909 revision introduced section 12 with its invitation to acquire statutory copyright without publication for dramas as well as for music. Was the invitation one that had to be accepted?

The suggestion that section 12 had some preemptive effect has never taken hold,<sup>91</sup> with the result that music, dramas, lectures, motion pictures, works of art, and probably the whole world of broadcasting (a technology barely nascent in 1909) can all be exploited without resort to statutory copyright. Or they can make use of section 12 so long as copies are not reproduced for sale. Finally, if printed or pictorial copies are published, they can have regular section 10 copyright. But if the entrepreneurs and authors in these fields choose to stay with their common law rights, they escape the limits on duration and any other constraints of the statute. The price is that they must refrain from making and selling copies of the work.

All this amounts to a serious distortion of the concept of publication, or rather of *unpublication*. Stemming from the classic instances of the unpublished book manuscript in the desk drawer, or the play existing only in working script, common law rights in "unpublished" works have come to flourish wholly outside the constraints of the copyright statute.<sup>92</sup> Does this distortion excuse the

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<sup>88</sup> 223 U.S. 424 (1912).

<sup>89</sup> *Id.* at 435.

<sup>90</sup> *Id.* at 434.

<sup>91</sup> See Selvin, *Should Performance Dedicate?*, 54 CALIF. L. REV. 40 (1954).

<sup>92</sup> Apparently there has been considerable traffic in songs whose composers do not seek either section 10 or section 12 copyright, exploit the songs on records, and then claim to be immune from the statutory compulsory license. This claim was neatly undercut by Judge Gurfein in *Rosette v. Rainbo Record Mfg. Corp.*, 354 F. Supp. 1183 (S.D.N.Y. 1973). Also, controversy and uncertainty persist

introduction of still another incongruity, the state law copyright in sound recordings?

For one thing, we should note that the new right makes it possible for the producers of performances addressed to the ear to retain all their existing rights, free of durational or other limits, and then to do what most other common law copyright holders could not do—exploit the work in copies for sale, still free of statutory limits.

To be sure, the gravity of the anomaly is lessened by the fact that it applies only to pre-1972 renditions. But these are not a small array, even though they will diminish with time. The radio stations that create the current Top Forty also plug golden oldies that antedate their current audience of teenagers. Middle-of-the-road stations keep older performances alive, so that markets remain evergreen, from Benny Goodman to the Beatles.

I have dwelt so much on the distortion of publication that I have perhaps obscured my thesis that it is (or was) central in the statutory copyright scheme. Let me baldly restate several propositions:

1. *Sears* and *Compco* ascribed sweeping preemptive effect to both the patent and the copyright statutes.

2. But the copyright statute leaves a block of power to the states, namely over unpublished works.

3. Congress can bring unpublished works into the statute, and has done so in section 12, but not preemptively.

4. Published works normally find protection, if any, under the statute.

5. Whether a work is published or unpublished must be a federal question, because publication is the primary signal for preemption.

6. Some classes of works are not included in the statutory scheme. If published, they are presumptively open to competitive copying.

7. Congress may, however, authorize the states to regulate published works, and conceivably did so in the disclaimer to the 1971 amendments with respect to preexisting sound recordings.

These were all respectable assertions until the Court in *Goldstein* reversed the presumption of preemption, gave publication ignominious burial in a footnote, and consequently cast into doubt propositions 1, 4, 5, and 6.

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about what constitutes publication of motion picture sound tracks. See Yuzek, *Publication and Protection: In Qualified Support of the Copyright Office Approach to Motion Picture Soundtracks*, 22 BULL. COPYR. SOC'Y 19 (1974).

## THE 1971 DISCLAIMER AND PREEMPTION

Can we learn anything from further exploration of the 1971 disclaimer? What might Congress have intended when it declared that the new copyright in sound recordings was not to be "applied retroactively or be construed as affecting in any way any rights with respect to sound recordings" fixed before February 15, 1972?<sup>93</sup> The language is pretty colorless. One thing is clear. Congress did not *create* any rights in existing recordings. Why not? There are several possibilities, all speculative. First, those who thought about the matter may have been daunted by the practical problems with respect to recordings that were already in circulation, of bringing them into a scheme that made vesting of copyright depend upon notice and registration. But these problems would not have been insuperable. Those wishing to claim copyright in pre-1972 recordings could have been given a reasonable period of time to register their claims. Prospective copiers of recordings already in circulation could then look to the Register to discover whether the recording had gone into copyright.

Second, an informed legislator might also have thought that pre-1972 recordings were in the public domain and that it was simply not a good idea to try to bring them into copyright. The belief that they were in the public domain would have derived from an understanding that they had been divestitively published by their general dissemination. This, as we have seen, had been a controverted issue with respect to both the music and the renditions.

Third, if the informed legislator thought that pre-1972 recordings were published and in the public domain, he might also have thought that he was powerless to bring them back into copyright. There are strong statements to this effect in a patent context, most recently and notably by the Chief Justice in a trade secrets case: "That which is in the public domain cannot be removed therefrom by action of the States."<sup>94</sup> But could removal be brought about by action of Congress, so long as it stays within the limited-time frame that would apply to other contemporary works?<sup>95</sup>

Fourth, the informed legislator might well have decided to ignore these riddles and to leave the matter to state law, which would in the end leave it to the courts to say how far states could

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<sup>93</sup> Nimmer has an interpretation that the disclaimer positively remits pre-1972 sound recordings to the states. See, 1 M. NIMMER, NIMMER ON COPYRIGHT § 35.225 (1974) [hereinafter cited as NIMMER]; cf. Kurlantzick, *supra* note 35, at 244.

<sup>94</sup> *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 481 (1974).

<sup>95</sup> Cf. 1 NIMMER, *supra* note 93, at § 5.1 (1972), § 9.231 (1974).

protect old sound recordings. What the expectations of a legislator taking this course might have been are also speculative. His attention could have been called to the handful of state anti-piracy statutes then in being.<sup>96</sup> These statutes, and another handful of state equity actions decided without benefit of a statute,<sup>97</sup> pointed toward a misappropriation rationale for protecting sound recordings. Standing against them was the massive presence of *Sears* and *Compco*. If the legislator was concerned about controlling the reach of state power, especially its expression in the broad terms of section 653h of the California Penal Code, he did not say so. Did he expect the state courts to limit or preclude state power? Was he content to permit them to adjudicate without regard to federal standards of divestitive publication? To recognize rights not limited in time?

The alert legislator would have found that the state courts that had responded to the outcries against record and tape piracy had cast their responses in terms of the tort of misappropriation. This was thought to be a way to circumvent the mandate of *Sears* and *Compco* that state law could not forbid the copying of articles unprotected by patent or copyright. The tape-pirate, New York courts were able to discover, was not simply copying another's product. He was misappropriating the "actual performances,"<sup>98</sup> the very essence of the recording artist's talent. The distinction is fallacious. One could say with equal assurance that if Sears made a mold from Stiffel's pole lamp and reproduced it they were taking Stiffel's creation—"The product itself."<sup>99</sup> So they were—but Stiffel still had it too; that is what is distinctive about copying in contrast to other forms of appropriation or misappropriation<sup>100</sup>

<sup>96</sup> Eight as of Sept. 22, 1971. H.R. REP. No. 487, 92d Cong., 1st Sess. 2 (1971). Ten more by Nov. 1, 1973. See 21 BULL. COPYR. Soc'Y 194 (1973).

<sup>97</sup> *Capitol Records, Inc. v. Erickson*, 2 Cal. App. 3d 526, 82 Cal. Rptr. 798 (2d Dist. 1969), cert. denied, 398 U.S. 960 (1970); *Capitol Records, Inc. v. Spies*, 130 Ill. App. 2d 429, 264 N.E.2d 874 (1970); *Capitol Records, Inc. v. Greatest Records, Inc.*, 43 Misc. 2d 878, 252 N.Y.S.2d 553 (Sup. Ct. 1964).

<sup>98</sup> *Capitol Records, Inc. v. Greatest Records, Inc.*, 43 Misc. 2d 878, 881, 252 N.Y.S.2d 553, 556 (Sup. Ct. 1964).

<sup>99</sup> *Capitol Records, Inc. v. Erickson*, 2 Cal. App. 3d 526, 538, 82 Cal. Rptr. 798, 806 (2d Dist. 1969), cert. denied, 398 U.S. 960 (1970).

<sup>100</sup> Note, *The "Copying-Misappropriation" Distinction: A False Step in the Development of the Sears-Compco Pre-Emption Doctrine*, 71 COLUM. L. REV. 1444 (1971); 1 NIMMER, *supra* note 93, at § 35.224 (1974). The pole lamp analogy—does it make any difference whether Sears "imitated" it or physically copied it?—is in *International Tape Mfg. Ass'n. v. Gerstein*, 344 F. Supp. 38 (S.D. Fla. 1972), vacated for unripeness, 494 F.2d 25 (5th Cir. 1974); see Kurlantzick, *supra* note 35, at 215, *confuted in Comment*, Goldstein v. California: *Breaking Up Federal Copyright Preemption*, 74 COLUM. L. REV. 960, 975 (1974), which points out that the pirate's cost advantage would decrease if he had to "imitate" by assembling musicians, etc. Usually no one would want such an imitation anyway.

—e.g., taxation or mugging—which leave the victim empty-handed.

One form of unfair competition, fraudulent labelling, is not privileged copying. So *Sears* and *Compco* affirmed. But, in the absence of patent or copyright, they emphatically affirmed that simple copying was privileged. For the state courts once again to relabel copying as misappropriation was effective (one would have supposed) only until the Supreme Court got wind of it.

The anti-piracy statutes also had to avoid *Sears* and *Compco*, though they did not, like the courts, have to talk about how they were doing it. With New York again providing the model, they were directed in an elaborately offhand way at what was described as a form of larceny, or “traffic in illicit and contraband property,” as the Tennessee brief put it.<sup>101</sup> The Attorney-General of the state of New York declared that the prototype statute, General Business Law section 561,<sup>102</sup> was “an anti-larceny statute, whose enactment was within the state’s police power.”<sup>103</sup> “It has been drawn,” he said, “to prevent the theft of a particular type of property.”<sup>104</sup> Briefs addressed to the Supreme Court in *Goldstein* made a great deal of this view that such statutes were exercises of the police power. Drawing on that vast armory of state authority helped fend off the threat of federal preemption.

Furthermore, what the New York statute penalized was the “transfer” without the consent of the owner of sounds recorded on a phonograph record. Thus the statute and its carbon copies artlessly tried to avoid any suggestion that the copying of another’s work was prohibited<sup>105</sup> (although “unauthorized copying of phonograph records” did creep in as the caption of New York General Business Law section 561).

It would have been a direct repudiation of *Sears* and *Compco* for the Supreme Court to have accepted all this rigmarole. What the Court did instead was, in one respect, commendable. Instead of embracing the view that there was nothing forbidden here but a little larceny, the Court firmly characterized the conduct of tape pirates as a form of copying—and then declared that California had, without knowing it, enacted a valid state copyright law.

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<sup>101</sup> Brief for the Attorney-General of the State of Tennessee as Amicus Curiae at 1, *Goldstein v. California*, 412 U.S. 546 (1973).

<sup>102</sup> N.Y. GEN. BUS. LAW § 561 (McKinney 1968).

<sup>103</sup> Brief for the Attorney-General of the State of New York as Amicus Curiae at 2, *Goldstein v. California*, 412 U.S. 546 (1973).

<sup>104</sup> *Id.* at 6.

<sup>105</sup> When a statute made it a misdemeanor to reproduce or duplicate for sale certain state land maps not copyrighted, the Maryland court held that this was an attempted prohibition of copying, impermissible under *Sears-Compco*. *State’s Attorney v. Sekular*, 249 Md. 499, 240 A.2d 608 (1968).

## THE NEW STATE COPYRIGHT

So instead of a shapeless tort (or crime) of misappropriation, we have the new recognition of a state copyright power that may extend to any kind of work that is not explicitly preempted. The possibilities have naturally excited those who want protection for particular works heretofore unprotected and have astonished others who have canvassed the variety of interests now potentially sheltered. Kaul set down and briefly commented on a shopping list which he described as "by no means exhaustive" and which included performers' rights (against imitation of a recognizable style), clothing designs, nondramatic choreographic works, printed forms, titles, moral rights, business systems, computer programs, discoveries of laws of nature (these spilling over into patent law), and "various aesthetic works."<sup>106</sup> He did not mention a prime example of an interest important in movies and broadcasting—characters, abstracted from the story-episodes in which they appear. The copyright protection of characters has been under a cloud ever since the *Maltese Falcon* case<sup>107</sup> (the character is Sam Spade, not the falcon); and commentators looking for sunshine think it may be found in *Goldstein*.<sup>108</sup>

It would take another article to wade through the status of all these interests and to try to predict whether they would be considered free of preemption. One would want to sort out old chestnuts like printed forms (claims for protection of forms are often disguises for unprotectable machines or business ideas)<sup>109</sup> from recent arrivals such as computer programs, where the desire is to prevent *use* of one's program; copying is probably protected anyhow.<sup>110</sup> The idea that freedom from preemption could extend to

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<sup>106</sup> Kaul, *And Now, State Protection of Intellectual Property?*, 60 A.B.A.J. 198 (1974).

<sup>107</sup> Warner Bros. Pictures, Inc. v. Columbia Broadcasting Sys., Inc., 216 F.2d 945 (9th Cir. 1954); see KAPLAN & BROWN, *supra* note 4, at 308-12.

<sup>108</sup> Brylawski, *Protection of Characters—Sam Spade Revisited*, 22 BULL. COPYR. SOC'Y 77, 91 (1974); Rothenberg, *Some New Problems in Motion Picture Copyright Law*, 21 BULL. COPYR. SOC'Y 214 (1974). One may be permitted to doubt whether a character is an unpreempted category, or rather a subset within books, dramas, and motion pictures, all very much preempted.

*Goldstein* was invoked in the magistrate's findings on remand from Columbia Broadcasting Sys., Inc. v. DeCosta, 377 F.2d 315 (1st Cir. 1967). This was the unique case of the amateur "character" who was the prototype for Paladin on television. The magistrate found that DeCosta had a common law entertainment service mark, and alternatively, that *Goldstein* validated his claims under New York misappropriation law (Quaere?). See KAPLAN & BROWN, *supra* note 4, at 668. In DeCosta v. Columbia Broadcasting Sys., Inc., 383 F. Supp. 326 (D.R.I. 1974), the magistrate's report was adopted and held to be an appealable judgment.

<sup>109</sup> KAPLAN & BROWN, *supra* note 4, at 220, 225.

<sup>110</sup> *Id.* at 228.

new exclusive rights in already protectable categories—as in the computer program example—seems especially wishful, but it is seriously propounded.<sup>111</sup>

It is also possible that another historic dividing-line in copyright is threatened, namely the separation between “ideas,” which cannot be monopolized, and their “expression”—which is essentially the sphere of copyright. The notion that the states might be free to permit monopolies in *ideas* that have been *published*—thus breaking down two great barriers at once—boggles the conventional mind; and indeed the Court in *Goldstein* was careful to shy away from any such heresy.<sup>112</sup>

That some enthusiasts find such possibilities in *Goldstein* is a reflection, if not of some special interest, then of an attitude that deprecates any omission from protection. We see here another round in a perennial conflict. On the one side is what Paul Goldstein aptly calls “the competitive mandate”<sup>113</sup> imbedded in the antitrust laws, in many applications of the commerce power, and in the “limited Times” restriction of the copyright clause. On the other side are the main thrust of the clause itself (in its choice of “exclusive Right” as the means for encouraging “Science and useful Arts”), most manifestations of misappropriation theories, and deference to state economic regulation which inclines toward anti-competitive measures.

*Sears* and *Compco* were bold and perhaps blunt expressions of the competitive mandate. *Goldstein* is not avowedly anti-competitive. It does help put down cheap tapes, but, as Justice Marshall allowed in dissent, they are not a very appealing form of competition anyway.<sup>114</sup> Its failure, from the standpoint of one with a preference for less rather than more monopoly, lies in weakening the preemptive force of the present statute and in debilitating the potency of publication.

Publication was more than an historical boundary between

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<sup>111</sup> See Comment, *Goldstein v. California: Breaking Up Federal Copyright Preemption*, 74 COLUM. L. REV. 960, 978 (1974).

<sup>112</sup> 412 U.S. at 570-71.

<sup>113</sup> *Goldstein, The Competitive Mandate: From Sears to Lear*, 59 CALIF. L. REV. 873 (1971). In *Lear, Inc. v. Adkins*, Justice Harlan dealt subtly with state and federal powers in the course of disposing of the last vestiges of patent licensee estoppel. 395 U.S. 653 (1969).

<sup>114</sup> 412 U.S. at 579. In one view, piracy is competitive. It certainly brings prices down. Conventionally, however, it is assumed that it will make original recordings unprofitable, and that this burden will fall most heavily on small companies (of which there are many) in an industry which is nevertheless fairly concentrated (see 1970 Census data in 58 MINN. L. REV. 316, 323 (1973)). Cf. 4 largest companies controlled 62 percent of the market; 8 largest controlled 73 percent. Disinterested views are rare. See, *Hearings, supra* note 2, at 20-22 (testimony of Barbara A. Ringer, now Register of Copyrights).



common law and statutory copyright. In an imperfect way it reflected two fundamental things about intellectual and artistic properties. First, that in publication (*i.e.*, communication) lies their social meaning and worth. The unperformed score means very little even to the composer—indeed more frustration than fulfillment. Second, as property to be exploited for reward—not simply consumed in use—intellectual and artistic productions need uncommonly elaborate protection. One does not secure rights in writings and discoveries by a padlock; one needs the legal apparatus of copyright and patent law which we rather take for granted.

Holmes did not. Reluctantly concurring in *White-Smith v. Apollo*<sup>115</sup> (he thought some protection for mechanical reproductions of music should be worked out), he observed:

The notion of property starts, I suppose, from confirmed possession of a tangible object and consists in the right to exclude others from interference with the more or less free doing with it as one wills. But in copyright property has reached a more abstract expression. The right to exclude is not directed to an object in possession or owned, but is *in vacuo*, so to speak. It restrains the spontaneity of men where but for it there would be nothing of any kind to hinder their doing as they saw fit. It is a prohibition of conduct remote from the persons or tangibles of the party having the right. It may be infringed a thousand miles from the owner and without his ever becoming aware of the wrong. It is a right which could not be recognized or endured for more than a limited time, and therefore, I may remark in passing, it is one which hardly can be conceived except as a product of statute, as the authorities now agree.<sup>116</sup>

What then is to be done? Probably the time has come to bury publication, not to praise it. If it has been crippled so that it cannot patrol the boundaries of state and federal interests, and if unpredictable canons of preemption are to take its place, probably the best solution is a unitary system—one in which all exploitable works will be gathered into one national system.

#### THE GENERAL REVISION TO THE RESCUE

I am now of course describing the General Revision of the Copyright Law, a majestic and lumbering enterprise that calls for initial capitals because it has been under way since 1955. A bill was introduced in 1965 and passed the House in 1967.<sup>117</sup> In

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<sup>115</sup> 209 U.S. 1 (1908).

<sup>116</sup> *Id.* at 19.

<sup>117</sup> For developments to 1968 see Nimmer, *Foreword: Two Copyright Crises, Project—New Technology and the Law of Copyright: Reprography and Computers*, 15 UCLA L. REV. 931 (1968).

1974, not much changed, it had a spurt of animation and passed the Senate.<sup>118</sup> Perhaps, after twenty years, 1975 will be its year.

Inaction—stalemate—has resulted from the slow struggles of interest groups and fluid coalitions of interest groups: authors against publishers; authors and publishers against photocopying schools and libraries; composers against their publishers; composers and publishers against broadcasters; composers and broadcasters against cable television; composers against record companies; performers against composers and record companies; composers and performers and record companies against pirates; everybody against juke-box operators clinging to a 1909 exemption;<sup>119</sup> movie producers against almost everybody; computer program designers against program users; industrial designers against retailers. The catalog is long and tiresome. The issues are sometimes principled, but usually they boil down to Samuel Gompers' principle: More.

Amidst all this clash of arms one authentic principle has remained constant since 1965: The revision introduces a unitary system in which:

Copyright protection subsists . . . in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.<sup>120</sup>

A definition of "fixed" emphasizes that any embodiment that is of "more than transitory duration" will do, and that a fixation simultaneous with a transmission (e.g., a broadcast) is effective.<sup>121</sup> Under the revision, then, the availability of copyright is automatic once the work is on a manuscript, a tape, a film, or whatever. It is perfected when the work is published by the traditional copyright notice and by deposit in the Library of Congress; but these requirements are accompanied by generous allowance for mistake and delay.<sup>122</sup> For present purposes, the innovation

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<sup>118</sup> Sept. 9, by a vote of 70-1, 120 CONG. REC. 16167 (1974). See generally Derenberg, *U.S. Senate Passes Omnibus Revision Bill (S. 1361) and Interim Legislation (S. 3976)*, 22 BULL. COPYR. SOC'Y 1 (1974). When S. 1361 came to the floor it included in section 114, in addition to the right against duplication of sound recordings that we have been discussing, a new right in the public performance of sound recordings, with a compulsory license scheme. S. 1361, 93d Cong., 2d Sess. § 114(b) & (c) (1974). This is the performance right in a rendition that was claimed in *RCA Mfg. Co. v. Whiteman*, 114 F.2d 86 (2d Cir.), cert. denied, 311 U.S. 712 (1940). However, this new performers' right was knocked out by a vote of 67-8. Derenberg, *supra* at 2.

<sup>119</sup> 17 U.S.C. § 1(e) (1970) (last sentence).

<sup>120</sup> S. 22, 94th Cong., 1st Sess. § 102(a) (1975).

<sup>121</sup> *Id.* § 101. Other definitions are in other sections.

<sup>122</sup> *Id.* §§ 401-07.

is the existence of federal copyright from their creation for all protected works save performances and like activities that can exist without fixation; and these also are easily protectable by fixation on tape or film.

However, that is not all. Section 301 is headed "Pre-emption with respect to other laws." It is so directly responsive to almost every issue raised in this paper that it must be set forth (and read) in full:

(a) On and after January 1, 1975, all rights in the nature of copyright in works that come within the subject matter of copyright as specified by sections 102 and 103, whether created before or after that date and whether published or unpublished, are governed exclusively by this title. Thereafter, no person is entitled to copyright, literary property rights, or any equivalent legal or equitable right in any such work under the common law or statutes of any State.

(b) Nothing in this title annuls or limits any rights or remedies under the common law or statutes of any State with respect to:

(1) unpublished material that does not come within the subject matter of copyright as specified by sections 102 and 103, including works of authorship not fixed in any tangible medium of expression;

(2) any cause of action arising from undertakings commenced before January 1, 1975;

(3) activities violating rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106, including breaches of contract, breaches of trust, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation.<sup>123</sup>

"The subject matter of copyright as specified by sections 102 and 103" is, in section 102, a simpler version of what is section 5 in the present Copyright Act:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings.<sup>124</sup>

Section 103 deals with "compilations and derivative works."

To see what is *not* preempted we look to section 301(b)(1), a pale shadow of present section 2.<sup>125</sup> The first thing to be said

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<sup>123</sup> *Id.* § 301.

<sup>124</sup> *Id.* § 102(a).

<sup>125</sup> Quoted in full at text accompanying note 37 *supra*.

is that (b)(1) makes more sense if "including" is read to mean "and." Difficulties arise in trying to fit the "including" part within the "unpublished material" part; and an authoritative Committee Report makes it fairly clear that this is not the intention.<sup>126</sup> The "including" clause leaves to state law all unfixed works. These can only be sight and sound events that are not already fixed in a text or a score, and could include the content of improvised music or drama, extemporaneous speeches, many "pantomimes and choreographic works," sporting events, and the sounds, *i.e.*, the renditions, that when fixed become "sound recordings." But note that when any of these is fixed (that is, taped or filmed) state rights end. One can foresee intriguing problems of proof when an author wants to be either in or out of state copyright protection. Was the work really fixed? Where is the tape? Can it be unfixed, by destroying a unique tape? For now, I emphasize only the ease of fixation and therefore of getting federal copyright.

The first part of (b)(1) is more interesting. What kinds of material do not come within the section 102 subject matter? The House Committee Report of 1967, still a basic guide to interpretation, observed that there are "areas of existing subject matter that this bill does not propose to protect,"<sup>127</sup> and appended this footnote:

Without implying that they would be wholly without protection under one or another of the seven categories listed in sec. 102, or that they are necessarily the 'writings' of authors in the constitutional sense, we cite the following as examples. These are areas of subject matter now on the fringes of literary property but not intended, solely as such, to come within the scope of the bill: typography; unfixed performances or broadcast emissions; blank forms and calculating devices; titles, slogans, and similar expressions; certain three-dimensional industrial designs; interior decoration; ideas, plans, methods, systems, mathematical principles; formats and synopses of television series and the like; color schemes; news and factual information considered apart from its compilation or expression. Many of these kinds of works can be clothed in or combined with copyrightable subject matter and thus achieve a degree of protection under the bill, but any protection for them as separate copyrightable works is not here intended and will require action by a future Congress.<sup>128</sup>

This declaration lends force to the obvious implication of (b)(1):

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<sup>126</sup> H.R. REP. NO. 83, 90th Cong., 1st Sess. 98 (1967). The important analysis of section 301, *id.* at 96-100, appears to be reproduced substantially verbatim in S. REP. NO. 983, 93d Cong., 2d Sess. 163-67 (1974), accompanying S. 1361, 93d Cong., 2d Sess. (1974).

<sup>127</sup> H.R. REP. NO. 83, *supra* note 126, at 14-15.

<sup>128</sup> *Id.* at 15 n.1.

If unpublished material not within section 102 is left to the states, published material in these categories is preempted. It is, for the present, left unprotected either by state law or by the statute. We are part way back from *Goldstein* to *Sears*.

Let us now look at (b)(3). It recites a familiar list of torts and other state rights of action which have long co-existed (and now and then conflicted) with federal copyright. These are left to the states under the general classification of "activities violating rights" so long as the rights are not "equivalent to" those granted to copyright holders in section 106 (and then qualified and sometimes taken away in sections 107-17). These basic rights are those of reproduction, distribution, public performance, public display, and making derivative works. The state must keep hands off any activity that is seen to violate a copyright kind of right, e.g., the right to reproduce copies. It would no longer be possible to invoke state notions of "deceptive trade practices" or "unfair competition" to restrict what the federal courts would describe as a form of copying. I am of course harking back to the Court's approach to the "activities" in *Goldstein*. As the Court correctly observed, what the defendants were doing was copying. It is significant that (b)(3) uses the phrase "deceptive trade practices," and not the looser "unfair competition." With its tolerance of state authority in (b)(3) essentially limited to passing off and false representation cases, a stern banishment of the misappropriation tort is evident,<sup>129</sup> and we are nearly all the way back to *Sears*. There is one final observation to make about section 301(a), which is generally sweeping, positive, and not in need of exegesis. Note that it covers works "created before or after" its effective date, and thus wipes out the weak disclaimer that caused all the trouble in *Goldstein*.

The House Committee Report called section 301, which represents a major centralization of control, "one of the bedrock provisions of the bill."<sup>130</sup> After the uncertainties created by *Goldstein*, it is more bedrock than ever and a powerful argument for getting on with the revision. That effort is sound in its core provisions, though seriously flawed where it has been pulled out of shape, mostly by protectionist demands.<sup>131</sup> Yet for all its flaws,

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<sup>129</sup> "[W]here the cause of action involves the form of 'unfair competition' commonly referred to as 'misappropriation,' which is nothing more than copyright protection under another name, section 301 is intended to have preemptive effect." H.R. REP. NO. 83, *supra* note 126, at 100; S. REP. NO. 983, *supra* note 126, at 167.

<sup>130</sup> H.R. REP. NO. 83, *supra* note 126, at 96; S. REP. NO. 983, *supra* note 126, at 163.

<sup>131</sup> "Protectionist" can refer to demands of either producers or users of copyrighted material. As examples only of the former, I would cite the com-

it is a national statement of rights and interests that really have little to do with state lines. When we are told that "New York" or "California" has this or that public policy, it is more realistic to guess that interests without enough influence to move Congress have managed at least to have their way with local lawmakers.

ONCE PUBLISHED . . .

A last elegiac word about publication. I spoke earlier of burying it, since it had been caused to fail as a divider between local personal interests on the one hand, and national expressive policy on the other. In the general revision it is not so much buried as retired. It turns up here and there, with a useful set of errands to run: When is notice to be affixed? When may a state regulate unprotected kinds of works? And it has a statutory definition, so that, anchored in the bedrock of section 301, what is publication is now surely and securely a federal question. Learned Hand's ghost can rest in peace.

Publication in these modest roles will faintly recall an era when it was *the* event that signalled the emergence of a writing from the quiescent cocoon of an unpublished manuscript to the free flight of a published book, watched over by a protective copyright code. This was an era when Lord Brougham, reaffirming in the great case of *Jefferys v. Boosey*<sup>132</sup> that protection of a published work could be found only in the statutes, could exclaim "*Volat irrevocabile verbum*, whether borne on the wings of the wind or the press,"<sup>133</sup> in the confident assumption that his noble and learned friends would not need to be reminded that the first words of Horace's line were: "*Semel emissum*"—once published—"Once published a word takes flight and cannot be recalled."<sup>134</sup>

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bination of prolonged duration (life plus 50 years) with a right of reversion to the author after 35 years (S. 22 94th Cong., 1st Sess. §§ 302, 303 (1975)), and the limited privilege of non-profit performance of musical works (*id.* § 110). Of the latter, I would cite the awkward resolution of the juke box exemption (*id.* § 116). As for cable television uses (*id.* § 111), one can only say a plague on both your houses.

<sup>132</sup> 10 Eng. Rep. 681 (1854).

<sup>133</sup> *Id.* at 740; see KAPLAN & BROWN, *supra* note 4, at 53, 805.

<sup>134</sup> HORACE, EPISTLES I:18:71.