

Cyclopædias and Periodicals. — In the case of “any encyclopædia, review, magazine, periodical work, or other work published in a series of books or parts,” it is enough to register the title of the work, the date of the publication of the first volume, number, or part, and the name and place of abode of the owner and the publisher.¹ When the first volume, number, or part has been registered, all following numbers of the same work or series will be protected, without the necessity of any additional registration.² If the first number be registered before it is published, the registration is not valid.³ As registration of the first number of a periodical applies to future issues, it extends to and protects matter not published at the time of registration. This principle, as just shown, has been declared to be unsound in the case of a book. But the copyright cannot vest in any number of the periodical until that number is published.⁴

Newspapers. — It has been held that articles published in a newspaper are entitled to the protection of the copyright statutes, although neither the newspaper nor the articles have been registered.⁵ The unsoundness of this decision has been pointed out elsewhere.⁶

Dramatic Compositions. — According to the judicial construction of the statute, registration is not necessary either to secure the exclusive right of representing a dramatic piece, or to maintain an action for the infringement of that right.⁷

Engravings and Prints. — The copyright in engravings, prints, and lithographs is not governed by 5 & 6 Vict. c. 45, but by statutes which do not require registration.⁸ But an action for piracy cannot be maintained unless the date of publication and the name of the owner appear on the print, engraving, or litho-

¹ 5 & 6 Vict. c. 45, s. 19.

² See *Sweet v. Benning*, 16 C. B. 459.

³ *Correspondent Newspaper Co. v. Saunders*, 11 Jur. n. s. 540; s. c. 12 L. T. n. s. 540; *Maxwell v. Hogg*, Law Rep. 2 Ch. 307; *Henderson v. Maxwell*, 4 Ch. D. 163, on ap. 5 id. 892. See also *Casell v. Stiff*, 2 Kay & J. 279.

⁴ See remarks of Lord Chelmsford in *Platt v. Walker*, 17 L. T. n. s. 159, quoted *ante*, p. 169, note.

⁵ *Cox v. Land & Water Journal Co.*, Law Rep. 9 Eq. 324.

⁶ See *ante*, p. 172.

⁷ *Russell v. Smith*, 12 Q. B. 217; *Clark v. Bishop*, 25 L. T. n. s. 908. See also *Lacy v. Rhys*, 4 Best & S. 873; *Marsh v. Conquest*, 17 C. B. n. s. 418.

⁸ 8 Geo. II. c. 13; 7 Geo. III. c. 38; 17 Geo. III. c. 57; 6 & 7 W. IV. c. 59; 15 & 16 Vict. c. 12, s. 14.

graph for which protection is claimed.¹ But engravings or illustrations published in a copyrighted book will be protected, though the name of the owner and date of publication do not appear on them.²

Maps. — Maps, which were formerly within the provisions of the statutes relating to engravings, are now governed by 5 & 6 Vict. c. 45.³ Hence, the same regulations apply to them as to books.

Paintings, Drawings, and Photographs. — These productions are within 25 & 26 Vict. c. 68, which prescribes the manner of registration, and declares that “no proprietor of any such copyright shall be entitled to the benefit of this act until such registration; and no action shall be sustainable nor any penalty be recoverable in respect of any thing done before registration.”⁴ Under this act, an assignment must be registered to entitle the assignee to sue.⁵

Sculpture. — The 54 Geo. III. c. 56, which grants copyright in sculpture, models, and busts, and gives a special action on the case for damages as a remedy for infringement, requires the name of the owner and the date of publication to be put on the work “before the same shall be put forth or published.”⁶ The 13 & 14 Vict. c. 104, provides⁷ for the registration of such works, and imposes penalties for the invasion of the property therein; but the owner is not entitled to the benefit of such penalties, unless he has complied with the provisions relating to registration, and marked his work “registered,” with the date of registration.⁸

Registration under International Copyright Acts. — The form of registration necessary to secure protection under the International Copyright Acts is prescribed by 7 & 8 Vict. c. 12.

¹ 8 Geo. II. c. 13, s. 1; *Harrison v. Hogg*, 2 Ves. 323; *Thompson v. Symonds*, 5 T. R. 41; *Newton v. Cowie*, 4 Bing. 234; *Brooks v. Cock*, 3 Ad. & El. 138; *Colnaghi v. Ward*, 6 Jur. 969; *Avanzo v. Mudie*, 10 Exch. Rep. 203; *Graves v. Ashford*, Law Rep. 2 C. P. 410; *Rock v. Lazarus*, Law Rep. 15 Eq. 104.

² *Bogue v. Houlston*, 5 De G. & Sm. 267; *Bradbury v. Hotten*, Law

Rep. 8 Exch. 1. See also *Wilkins v. Aikin*, 17 Ves. 422; *Barfield v. Nicholson*, 2 Sim. & St. 1; *Cobbett v. Woodward*, Law Rep. 14 Eq. 407.

³ *Stannard v. Lee*, Law Rep. 6 Ch. 346. See *ante*, p. 174, note 3.

⁴ s. 4. See *Ex parte Beal*, Law Rep. 3 Q. B. 387.

⁵ s. 4. *Graves's Case*, Law Rep. 4 Q. B. 715.

⁶ ss. 1, 3.

⁷ s. 6.

⁸ s. 7.

Special requirements in the case of translations are made by 15 & 16 Vict. c. 12.¹ Section 6 of the former statute provides that in the case of a book, dramatic piece, or musical composition, which has been published abroad in print, "the title to the copy thereof, the name and place of abode of the author or composer thereof, the name and place of abode of the proprietor of the copyright thereof, the time and place of the first publication, representation, or performance thereof, as the case may be, in the foreign country," shall be registered, and that a copy of the work shall be delivered to the officer of the Stationers' Company. In the case of dramatic and musical compositions in manuscript, the time and place of the first representation or performance are to be entered, instead of the time and place of publication. No copy is required to be deposited. In *Wood v. Boosey*, the registration of the piano-forte arrangement of an opera was held to be invalid, because the name of the composer of the opera had been entered in the registry, instead of the name of the person who had made the arrangement.² In the opinion of the court, the latter, and not the former, was the author of what was registered.

In *Boosey v. Fairlie*, the plaintiffs claimed the exclusive right of representing an opera composed by Offenbach, of which a piano-forte arrangement made by Soumis, but not the orchestral parts, had been published in print. There had been entered in the registry the title of the opera, the name and place of abode of Offenbach as composer and owner, the time and place of the first representation of the opera, and the time and place of the first publication of the piano-forte arrangement. A copy of the piano-forte arrangement, but not of the opera itself, had been delivered to the officer of the Stationers' Company. Vice-Chancellor Bacon ruled that the piano-forte arrangement, and not the opera itself, was the thing registered; and that, as the name and place of abode of Soumis, the author of the arrangement, had not been entered, the registration, according to *Wood v. Boosey*, was not valid.³ The Court of Appeal, however, held that all the facts required

¹ See *ante*, p. 217.

² Law Rep. 2 Q. B. 340, on ap. 3 Id.

³ 7 Ch. D. 301, 307.

for the registration of the opera itself had been duly entered, and that the additional entry of the time and place of the first publication of the piano-forte arrangement and the delivery of a copy of it were superfluous acts, which did not affect the registration of the original opera. There was, therefore, a good registration of the unpublished opera, but not of the piano-forte arrangement.¹

PUBLICATION.

Statutory Copyright begins with Publication ; does not exist in Unpublished Works. — The chief object of the legislation for the advancement of learning is to secure the publication of literary works for the benefit of the public, and this consideration is a condition on which protection is extended to authors. Publication is the beginning of statutory copyright, and a condition precedent to its existence.

The statute of Anne gave copyright in a book for a term "to commence from the day of the first publishing the same ;" and the statute of Victoria expressly makes "first publication" the beginning of the term of protection.² "Copyright," said Lord Chancellor Cranworth, "defined to mean the exclusive right of multiplying copies, commences at the instant of publication."³ In the language of Mr. Justice Crompton, "The monopoly is vested in the author or his assigns, for the limited term after first publication. This first publication is the commencement and foundation of the right, the *terminus a quo*, the period of the existence of the right is to run, and a condition precedent to the existence of the right."⁴ Furthermore,

¹ 7 Ch. D. 311. See criticism on the judgment in this case in Chap. XV. As to registration in the case of a foreign newspaper, see *Cassell v. Stiff*, 2 Kay & J. 279 ; in the case of a foreign print, *Avanzo v. Mudie*, 10 Exch. Rep. 203.

² 5 Anne, c. 19, s. 1 ; 5 & 6 Vict. c. 45, s. 3.

³ *Jefferys v. Boosey*, 4 H. L. C. 955. In the same case, Mr. Justice Wightman said that neither the author "nor his assignee would be entitled to copyright until publication. Whatever

right the author may have possessed before publication must have been at common law." Ibid. 886.

⁴ Ibid. 847. "In *Beckford v. Hood*," continued the same judge, "which I have before referred to, and which was decided not very long after the great case in the House of Lords, the declaration averred the infringement as being within the period after the first publication ; and Lord Kenyon, in saying that it was established that the right was confined to the times limited by the statute, in effect, treated the act of first publica-

the statute gives a remedy for piracy only in the case of a "book in which there shall be subsisting copyright;" and makes registration a condition precedent to bringing an action at law or a suit in equity for the infringement of copyright.¹ As publication must precede registration, it is clear that there can be no statutory protection for an unpublished work.²

It has been shown that, notwithstanding some diversity of opinion, the law in the United States has always been well established that copyright could not under the earlier statutes, and cannot under the existing one, be secured without performance of the three prescribed requisites relating to the filing of the title before publication, printing the notice of copyright in the book, and delivering copies within a named time after publication.³ It is obvious that these acts cannot be done without publishing the work. Publication, therefore, is made an essential prerequisite to securing copyright; and hence there can be no statutory copyright in an unpublished work.⁴

Publication must be within Reasonable Time after Filing Title.—No time is indicated by the statute within which a work whose title-page has been recorded shall be published; nor has any more definite rule on this point been laid down by the courts than that publication must be made within a reasonable time after the filing of the title. In *Boucicault v. Hart*, where it appeared that the title had been recorded on October 24, and the work had not been published when the bill was filed in the following February, the court did not hesitate to hold that publication had not been made within a reasonable time.⁵

tion, from which such time was to run, as a condition precedent to the existence of the right." See also *Colburn v. Simms*, 2 Hare, 543.

¹ 5 & 6 Vict. c. 45, ss. 15, 24.

² See *ante*, p. 279.

³ See *ante*, p. 265.

⁴ In not fewer than five cases, the Circuit Court of the United States, by holding that a dramatist who files a copy of the title of his play with the Librarian of Congress is entitled to the protection of the statute, although the play is not published in print, has

construed the law to the effect that copyright as well as playright may exist in an unpublished work. But this doctrine was rightly overruled in *Boucicault v. Hart*, 13 Blatchf. 47, whose authority was followed in *Carillo v. Shook*, 22 Int. Rev. Rec. 152. See Chap. XV.

⁵ 13 Blatchf. 47. "There is no time prescribed," said Longyear, J., "within which actual publication shall commence. That is left entirely to the option of the proprietor." *Farmer v. Calvert Lithographing, Engraving, &*

What is a Publication. — In one sense, a work of literature or art is published when it is communicated to the public, in whatever manner this may be done; whether by the circulation of copies, oral delivery, representation, or exhibition. At common law, the word publication may have this comprehensive signification.¹ But, to determine its meaning under the statute, it is necessary to ascertain in what sense the legislature used the word. In the case of books, maps, charts, drawings, engravings, photographs, lithographs, and chromos, the only kind of publication recognized by the statute is the circulation of copies.² Hence, a literary composition is not published, within the meaning of the statute, when it is orally communicated to the public;³ nor a pictorial production, excepting perhaps a painting, when it is publicly exhibited.⁴

Dramatic Compositions. — Under the statute of the United States, dramatic compositions are governed by the same rule as are general literary works. With reference to copyright, they differ in no wise from books. The right of representation is secured by the statute only in case of a dramatic composition which has been published and copyrighted as a book. Whether copyright or playwright be claimed, the question of publication, as far as the vesting of the right is concerned, is determined in the same manner as in the case of a book. Circulation of copies is essential to a publication. The public performance of a drama is not such a publication as will defeat a copyright afterward obtained for the composition;⁵ and it is not such a publication as the statute requires to be made before the copyright can be secured.⁶

In England, the law is somewhat different. The statute secures the right of representing or performing, not only

Map-Publishing Co., 5 Am. L. T. R. 172. But there is little doubt that the work must be published within a reasonable time after the filing of the title.

¹ See *ante*, p. 115.

² See *Keene v. Wheatley*, 9 Am. Law Reg. 44; *Palmer v. DeWitt*, 2 Sweeny (N. Y.), 548.

³ See *Abernethy v. Hutchinson*, 1 Hall & Tw. 28; *Bartlett v. Crittenden*,

4 McLean, 300, 5 Id. 32; *Keene v. Kimball*, 16 Gray (82 Mass.), 545; *Boucicault v. Fox*, 5 Blatchf. 87.

⁴ See *Martin v. Wright*, 6 Sim. 297.

⁵ *Roberts v. Myers*, 13 Monthly Law Reporter, 396; *Boucicault v. Fox*, *supra*; *Boucicault v. Wood*, 2 Biss. 34.

⁶ *Boucicault v. Hart*, 13 Blatchf. 47; *Carillo v. Shook*, 22 Int. Rev. Rec. 152.

printed, but also manuscript, dramatic and musical compositions;¹ and declares that the representation or performance of such compositions shall be deemed equivalent to the publication of a book.² But representation or performance is a publication only with reference to the vesting of playright, and not of copyright. Thus, in determining the statutory right of an author to represent a drama, its public performance is treated as a publication; but, in determining any question relating to the copyright in the same composition, representation is not a publication.³

Paintings and Sculpture. — What is a publication within the meaning of the statute in the case of paintings and sculpture, is a question not easily determined. Not only copies of such works, but the originals themselves, are made subjects of copyright; and, if the principle that publication is essential to copyright is to be applied in all cases without exception, it follows that a painting or a statue must be published before copyright will vest in it. Of course, such works cannot be published in the same manner as a book. It is true that copies, such as photographs, engravings, chromos, casts, &c., may be given to the public. But, in that case, it is the copy, and not the original, that is published; and there is here, between the thing itself and the copy, an essential difference, which does not exist in the case of a literary composition. Hence, in the Irish case of *Turner v. Robinson*, it was held that printing in a magazine an engraving of a painting was a publication of the engraving, but not of the painting.⁴ The court said that the publication must be of the thing itself.

United States. — Strictly speaking, a painting or statue can be published only by being exhibited. But there is a difficulty in holding exhibition to be a publication within the meaning of the American statute. The mode of publication must correspond to the nature of the right secured. The oral com-

¹ 3 & 4 Will. IV. c. 15.

² 5 & 6 Vict. c. 45, s. 20. *Boucicault v. Delafield*, 1 Hem. & M. 597; *Boucicault v. Chatterton*, 5 Ch. D. 267.

³ *Clark v. Bishop*, 25 L. T. N. S. 908; *D'Almaine v. Boosey*, 1 Y. & C. Exch. 288; *Tinsley v. Lacy*, 1 Hem. & M. 747. See also *Coleman v. Wathen*,

5 T. R. 245; *Murray v. Elliston*, 5 Barn. & Ald. 657.

⁴ 10 Ir. Ch. 121, 510. As to the different meanings given to the word publication in this case and in *Prince Albert v. Strange*, see *ante*, p. 115, note 2.

munication of a literary composition is not a publication, because such use of the work is not within the right granted by the statute. So in England, where the statute secures the right of representing manuscript as well as printed dramatic compositions, the performance of a play, as has been said, is a publication with reference to the right of representation, but not with reference to the right of multiplying copies. In the United States, representation is not a publication in either case, for the reason that the statute grants playwright only in the case of a dramatic composition which has been published and copyrighted as a book. This necessarily requires a play to be published in the same manner as a book. The exhibition of a painting or a work of sculpture is not strictly a publication within the meaning of the statute of the United States, because the right secured is that of copying, and not that of exhibiting. This objection may not exist in England, where, as is shown further on, the right of exhibiting, as well as that of publishing, copies is secured by the statute.

It may be maintained with reason that, to give the public the benefit of the production is as essential to copyright in the case of any work of art as in that of a literary composition; and, hence, that copyright will not vest in a painting or work of sculpture unless it has been published. But what shall be considered a publication within the meaning of the law is a question which remains for judicial determination. It is not improbable that the American courts will hold the publication of a photographic or other copy of the original to be equivalent, within the meaning of the statute, to the publication of the work itself.¹

¹ In *Oertel v. Wood*, 40 How. Pr. 10, and *Oertel v. Jacoby*, 44 Id. 179, decided by the special term of the New York Supreme Court, in 1870 and 1872, an important question concerning the publication of a painting was raised; but the opinions throw no light on the subject. The plaintiff had painted a picture named *The Rock of Ages*, of which chromo-lithographs and photographs were published with the consent of the plaintiff. Neither these copies nor the painting were copy-

righted, but the plaintiff claimed a common-law property in the painting. The defendant had published photographs of the painting; but it does not appear from either report whether he had copied the original or the authorized photographs. It is clear that the copies which had been published with the consent of the plaintiff were common property. But their publication, according to the decision in *Turner v. Robinson*, was not a publication of the painting destructive of the owner's

Great Britain. — What is a publication of a painting or of a work of sculpture is as doubtful in England as it is in this country. The 25 & 26 Vict. c. 68, secures copyright in paintings, and prohibits not only the circulation, but also the exhibition, of any piratical “repetition, copy, or imitation of the said work, or of the design thereof.”¹ What is a publication within the meaning of this act is a question on which neither the statute nor the decisions throw any light. In *Turner v. Robinson*, it was held that neither the public exhibition of a painting, nor the printing of an engraving of it in a magazine, was such a publication as would work an abandonment of the owner’s rights in the original.² But this case was governed by the common law, and was decided before statutory copyright in paintings was granted. It is not, therefore, an authority as to what is a publication of a painting within the meaning of the statute.

By 54 Geo. III. c. 56, copyright is given in sculpture, models, and busts, for a term of years from “first putting forth or publishing the same.” The property secured by this act seems to be comprehensive enough to embrace the right of public exhibition.³ The opinion has been judicially expressed that, within the meaning of the statute, a work may be published by being publicly exhibited.⁴

common-law right. Hence, whether this right was invaded depended on the fact whether the defendant had copied the painting or the authorized photograph. This vital question does not appear to have been referred to in either case. The controlling facts and principles were the same in both cases. The decision was in favor of the plaintiff in *Oertel v. Wood*, and against him in *Oertel v. Jacoby*.

¹ s. 6.

² 10 Ir. Ch. 121, 510.

³ See Chap. X., where it is shown that a remedy is afforded by the common law to the extent of the right secured by the statute.

⁴ In *Turner v. Robinson*, Lord Chancellor Brady said: “In the statutes bestowing protection upon works of sculpture, the *terminus a quo* from which the protection commences is the

publication of the work, that is, from the moment the eye of the public is allowed to rest upon it. Many large works in this branch of art, which decorate public squares and other places, are of course so published, but there are others, not designed for such purposes, which could never be published in any other way than in exhibitions; therefore I apprehend that these works of sculpture must be considered as published by exhibition at such places as the Royal Academy and Manchester, so as to entitle them to the protection of the statutes, from the date of such publication.” 10 Ir. Ch. 516. In *Boucicault v. Chatterton*, as reported 35 L. T. n. s. 745, James, L. J., referring to the fact that s. 19 of 7 & 8 Vict. c. 12, did not repeal any thing in 3 & 4 Will. c. 15, said: “It has a limited purpose only, which lim-

Is Circulation of Manuscript Copies Publication? — When printed copies of any literary or other work are circulated, the question of publication is simple. Whether a composition may be published, within the meaning of the statute, by the circulation of copies in manuscript, is a question on which little light is thrown either by the statutes or the decisions.¹ It may be claimed, on the one hand, that the legislature used the words publish, publication, &c., in their ordinary meaning, which is the circulation of printed copies. On the other hand, it may be urged that the purpose of making publication a prerequisite of copyright is that the public may have the benefit of the production for which protection is granted, and that this object is secured by communicating the work to the general public, though the copies circulated be in manuscript and not in print. As selling manuscript copies of a composition may be practically equivalent to the sale of printed ones, there appears to be

ited purpose is expressed in words which must *prima facie* give us the meaning of the word 'published,' which is to be that sort of thing which you can predicate of a book, or of a dramatic piece, or of a musical composition, and which you may predicate of a print, or article of sculpture, or any other work of art; that is to say, made public by those means which are appropriate to the particular article or the particular thing. A book is published by being printed; a dramatic piece or musical composition is published by being publicly represented; a print or article of sculpture is published, for the purposes of this act, by being made the subject of copy in casts or prints; and I should say with regard to sculpture and other works of art being multiplied by casts or other copies, it would depend in each case upon that which applies to the particular thing, if it be for sale or public use."

¹ In *Keene v. Wheatley*, 9 Am. Law Reg. 44, Mr. Justice Cadwallader said: "The intended meaning of the word publication in this and other statutory provisions concerning copyright is publication in print." Similar language was used by Monell, J., in *Palmer v.*

De Witt, 2 Sweeny (N. Y.), 548. But in each case the court was drawing a distinction between the ordinary mode of publishing a literary composition and the representation of a play. The question of publication by the general circulation of manuscript copies was not discussed, though in the former case the court considered the private circulation of such copies.

In *Bartlett v. Crittenden*, where it appeared that a teacher had permitted his pupils to make copies of a manuscript for their private use, Mr. Justice McLean seems to have been of the opinion that a work might be published by circulating manuscript copies. "It is contended," he said, "that this is an abandonment to the public, and is as much a publication as printing the manuscripts. That printing is only one mode of publication, which may be done as well by multiplying manuscript copies. This is not denied; but the inquiry is, Does such a publication constitute an abandonment?" 4 McLean, 303. But in this case the decision, that there had been no publication, was based on the ground that the circulation of copies was private and not public.

no reason why this latter view of the law may not be adopted. Of course, to secure copyright for manuscript copies, it would be necessary to comply with the same statutory requisites that must be observed in the case of printed compositions.¹

If the public circulation of manuscript copies is a publication within the meaning of the statute, it follows that the copyright in a printed composition may be defeated by a general sale of manuscript copies before the copyright was secured.²

Private Circulation of Copies not Publication. — The law recognizes a vital distinction between the public and the private circulation of copies. The owner may circulate copies of a work among a limited number of persons, with the understanding and on the condition that it is not to be made public. In such case no publication takes place, notwithstanding that the copies so distributed are printed.³ It may sometimes be difficult to determine whether a work is given without reservation to the general public, or conditionally to a select few. But when the fact is found that the circulation of copies is public, or that it is private, the law will be determined accordingly.

The deposit of a chart with the Secretary of the Navy, for the use of the government and for preservation, but with the ex-

¹ In *Rees v. Peltzer*, 75 Ill. 475, the Supreme Court of Illinois held that giving a copy of a manuscript map, which had not been copyrighted, to the city of Chicago for public use, and selling without any restriction several copies to real-estate dealers, amounted to a publication which destroyed the common-law property in the map. The court did not expressly declare that this was a publication within the meaning of the copyright statute; but such must be the effect of the decision. It is reasonably clear that statutory copyright could not have been secured for the map after it had been made public by the circulation of manuscript copies. But such circulation would be no bar to the vesting of copyright, unless it amounted to a publication within the meaning of the statute. Moreover, the common-law property in a work is not lost until it is published within the meaning of the statute. If

this manuscript map had been duly copyrighted, treating the sale of manuscript copies as a publication, it is reasonable to suppose that the copyright would have been valid.

² In *White v. Geroch*, 2 Barn. & Ald. 298, it was held that the copyright in a printed musical composition was not defeated by the fact that several thousand manuscript copies had been sold before it was published in print. But it cannot be satisfactorily determined whether this decision was based on the ground that the circulation of manuscript copies was a publication within the meaning of the statute, and hence the beginning of copyright; or that it was not a publication, and hence did not affect the copyright.

³ *Prince Albert v. Strange*, 2 De G. & Sm. 652, on ap. 1 Mac. & G. 25; *Bartlett v. Crittenden*, 4 McLean, 300, 5 Id. 32; *Keene v. Wheatley*, 9 Am. Law Reg. 83.

press understanding that it was not to be published, was held not to be a publication.¹

When a Book is Published. — A book is published when printed copies are sold unconditionally to the public. "A sale naturally imports publication."² But sale is not essential. A work may be published by the gratuitous circulation of copies.³ The question of publication cannot depend on the number of copies sold; because a sale of ten copies, or even of one, is as clearly a publication as is the sale of ten thousand. Nor can it be essential that a single copy shall be disposed of before the work can be said to be published. The requirements of the law are met when the book is publicly offered for sale. Then the opportunity is given to the public to avail themselves of its advantages; and if they fail to do so, even to the extent of obtaining one copy, it is through no fault of the author or publisher. But, to constitute a publication, it is essential that the work shall be exposed for sale, or gratuitously offered to the general public; so that the public, without discrimination as to persons, may have an opportunity to enjoy that for which protection is granted. Printing itself cannot amount to a publication, for the obvious reason that a book may be withheld from the public long after it has been printed. Hence, where the publisher makes consignments of copies to other booksellers, with instructions not to sell until a specified time, publication will not take place until the copies are exposed to public sale. But, if such consignments can be properly regarded as general and unconditional sales, they will amount to a publication.⁴

¹ *Blunt v. Patten*, 2 Paine, 393, 397.

² *Betts, J., Baker v. Taylor*, *infra*.

³ See *Novello v. Sudlow*, 12 C. B. 177; *Alexander v. Mackenzie*, 9 Sc. Sess. Cas. 2d ser. 748.

In *Heine v. Appleton*, *Ingersoll, J.*, said: "The sketches and drawings were made for the government, to be at their disposal; and Congress, by ordering the report which contained those sketches and drawings to be published for the benefit of the public at large, has thereby given them to the public." 4 Blatchf. 128. The actual circulation of copies among the

public would be a publication; but the order to publish would not have that effect.

⁴ *Baker v. Taylor*, 2 Blatchf. 82, 85. "It is argued for the plaintiff," said, *Betts, J.*, "that these alleged sales were only consignments of the work in advance of the publication, or that publication, by putting the book in circulation, was not made until after the date of the deposit of the title. There is no proof to support this version of the facts. A sale naturally imports publication. The purchaser having the right to know the contents of the book, and make them known to others, no

Where the owner left printed copies of a musical composition with a dealer, with instructions not to sell until a named day, the sale after that time was held to be a publication.¹

The publication of a part of a book is not a publication of the whole.² Neither the publication of a piano-forte arrangement of an opera, nor that of a few of the orchestral parts, is a publication of the opera itself.³ In such cases, there is a publication only of the part of the book or the arrangement of the opera which is published.

Place of first Publication. — **Great Britain.** — The 8 Anne, c. 19, was, and the 5 & 6 Vict. c. 45, is, silent as to where a work must be published in order to be entitled to copyright; but the law has been settled by the courts that the first publication must be in the United Kingdom.⁴ This doctrine is based on the ground that the chief object of the copyright statutes is the advancement of learning in Great Britain, which is attained by securing there the first publication of books. “The intention of the act,” said Lord Chancellor Cairns, “is to obtain a benefit for the people of this country by the publication to them of works of learning, of utility, of amusement. . . . The aim of the legislature is to increase the common stock of the literature of the country.”⁵

presumption can be raised that the right was not exercised, or that an actual publication did not follow the sale. On the contrary, the presumption is the other way. And the inference is strong, that actual publication was made, as sworn to by the defendant, anterior to the 10th of November, from the fact that a printed copy of the work, then complete, was on that day deposited in the clerk's office; the deposit of the book complete for circulation, and the deposit of the title, being simultaneous acts. The 4th section of the act in express words denies all benefit to a person under the act, unless he shall, *before* the publication of his work, deposit the title-page, &c.”

¹ Wall v. Gordon, 12 Abb. Pr. n. s. (N. Y.) 349.

² Low v. Ward, Law Rep. 6 Eq. 415.

³ Boosey v. Fairlie, 7 Ch. D. 301.

See also Wood v. Boosey, Law Rep. 2 Q. B. 340, on ap. 3 Id. 223.

⁴ Clementi v. Walker, 2 Barn. & Cr. 861; Guichard v. Mori, 9 L. J. (Ch.) 227; Chappell v. Purday, 4 Y. & C. Exch. 485; Chappell v. Purday, 14 Mees. & W. 303; Cocks v. Purday, 5 C. B. 860; Boosey v. Purday, 4 Exch. Rep. 145; Boosey v. Davidson, 13 Q. B. 257; Jefferys v. Boosey, 4 H. L. C. 815; Boucicault v. Delafield, 1 Hem. & M. 597; Low v. Ward, Law Rep. 6 Eq. 415; Routledge v. Low, Law Rep. 3 H. L. 100; Boucicault v. Chatterton, 5 Ch. D. 267.

⁵ Routledge v. Low, Law Rep. 3 H. L. 111. “If it should be said, Why is the publication to be construed to mean a British publication, and the author not to be construed a British author, and the composition a British composition? the answer seems to me to be, that the publication being made

When, therefore, a book is published in a foreign country before it is published in Great Britain, it becomes in the latter country *publici juris*, and may be republished by any one, unless protection be secured under the International Copyright Acts. But contemporaneous publication abroad, by which is meant a publication on the same day that the work is published in England, is not a bar to English copyright.¹ And, provided the two publications be on the same day, it is immaterial whether the foreign one precedes that in England.² Nor does it matter in how many foreign countries the work may be published, provided it appears in Great Britain at the same time. If the first publication of part of a work takes place in England, and of another part in a foreign country, English copyright will vest in the former, but not in the latter.³

The question whether the place of publication may be in any

the commencement of the term from which the monopoly is to run, and that publication giving rights confined to Britain, and the enactments as to the entry at Stationers' Hall before the rights as to the penalties were to attach, and the obligation imposed of delivering copies to British institutions, together with the authority of *Clementi v. Walker*, satisfactorily show that the publication must be intended to be in England; whilst there seems nothing in the act to show that the legislature in using the words authors and assigns had any intention of making any restriction as to the place of composition, or as to any personal capacity of the author or assignee." *Crompton, J., Jefferys v. Boosey*, 4 H. L. C. 850. See also language of Lord Chancellor Cairns, *post*, p. 294, note 2.

¹ *Cocks v. Purday*, 5 C. B. 860; *Boosey v. Purday*, 4 Exch. Rep. 145; *Jefferys v. Boosey*, 4 H. L. C. 815; *Buxton v. James*, 5 De G. & Sm. 80. "The second question argued at the bar is scarcely separated from the first; viz., whether the copyright which the author, or his assignee, would otherwise have had in this country, was defeated by the contemporaneous publication abroad. If it be correct to say that a foreigner, the author of a

work composed abroad, and published by him in this country, is, by the municipal law of this country, entitled to copyright in the work, how can his right be defeated by a contemporaneous publication abroad? In the popular sense of the word, each would be the first publication. But, if neither could be so called, we think the result would be the same; for, that, in order to defeat the claim of copyright, a prior publication in some other place, or by some other party, should be proved." *Wilde, C. J., Cocks v. Purday*, 5 C. B. 884.

² "With respect to the circumstance that the publication abroad and in England was not in this case exactly contemporaneous, as a publication took place at Milan a few hours before it was made in England, we conceive that this would not defeat the plaintiff's copyright here, if he had any, as the author certainly did not mean to give the work to the foreign before he gave it to the British public; and in no case is it intimated, that, to be entitled to a British copyright, the foreign author must give his work to the United Kingdom exclusively." *Pollock, C. B., Boosey v. Purday*, 4 Exch. Rep. 157.

³ *Low v. Ward*, Law Rep. 6 Eq. 415.

part of the British dominions, or is restricted to a less area, was considered by the House of Lords in 1868, when the law was expounded to the effect that, while the statute of Victoria extends protection throughout the British dominions, publication must be in the United Kingdom.¹ The reasons for this distinction were not found in the express intention of Parliament, but were based on "various provisions and conditions contained in the act, which could not possibly be complied with, if the first publication were to take place in distant parts of the British empire."²

The International Copyright Act declares that the author of a book, dramatic composition, or other work mentioned in that statute, which shall be first published out of the British dominions, shall have no copyright therein, nor the exclusive right of representation, "otherwise than such (if any) as he may become entitled to under this act."³ This provision has been judicially construed to bar every author, native or foreign, from acquiring copyright, except under the International Copyright

¹ *Routledge v. Low*, Law Rep. 3 H. L. 100.

² Lord Westbury, *Ibid.* 117. For the extent of the United Kingdom and of the British dominions, see *post*, p. 298. "By the 8th section" of 5 & 6 Vict. c. 45, said Lord Chancellor Cairns, "copies of every book are to be delivered to various public libraries in the United Kingdom, within one month after demand in writing,—an enactment which in the case of a publication at the antipodes could not be complied with. By the 10th section, penalties for not delivering these copies are to be recovered before two justices of the county or place where the publisher making default shall reside, or by action of debt in any court of record in the United Kingdom. By the 11th section, the book of registry of copyrights and of assignments is to be kept at Stationers' Hall, in London, and no registry is provided for the colonies. By the 14th section, a motion to expunge or vary any entry in this registry is to be made in the Court of Queen's Bench, Common Pleas, or Exchequer. These clauses are intelli-

gible if the publication is in the United Kingdom, but hardly so if it may be in India or Australia. Finally, by the 17th section, there is a provision against any person importing into any part of the United Kingdom, or any other part of the British dominions, for sale or hire, any copyright book first composed or written, or printed and published, in any part of the United Kingdom, and reprinted in any country or place out of the British dominions; a provision showing clearly, as it appears to me, that publication in the United Kingdom is indispensable to copyright." *Routledge v. Low*, Law Rep. 3 H. L. 109. The determination of this question was not essential to the decision of the case before the House of Lords, as the first publication of the book in controversy had been in London. The discussion grew out of the extra-judicial opinion expressed by Vice-Chancellor Kindersley at the hearing of the case, to the effect that publication might be anywhere within the British dominions. See *Low v. Routledge*, 33 L. J. N. S. (Ch.) 724.

³ 7 & 8 Vict. c. 12, s. 19.

Acts, for a work first published in any foreign country, whether an arrangement for international copyright has or has not been made with that country. In *Boucicault v. Delafield*,¹ and in *Boucicault v. Chatterton*,² the plaintiff, while resident in England, claimed, under 3 & 4 Will. IV. c. 15, and 5 & 6 Vict. c. 45, the exclusive right of representing a manuscript play, which he had caused to be publicly performed in New York before its representation in Great Britain. He was not entitled to any privileges under the International Copyright Acts, for the reason that their provisions did not apply to the United States; and the court held that, because the drama had been first publicly represented abroad, he was barred by section 19 of 7 & 8 Vict. c. 12, from obtaining the protection to which he would have been entitled under 3 & 4 Will. IV. c. 15, and 5 & 6 Vict. c. 45, if the first performance of his play had been in Great Britain.³

United States. — The statute of the United States does not expressly prescribe that the first publication of a work entitled to copyright shall be in this country. Nor has this point been directly adjudicated, although it is settled that no copyright can be obtained for a book unless a printed copy of the title-page shall be deposited before publication, and two copies of the book delivered within ten days after publication. But there can be no doubt that the proper construction of the act

¹ 1 Hem. & M. 597.

² 5 Ch. D. 267.

³ A similar provision was made by section 14 of 1 & 2 Vict. c. 59, which was the first statute providing for international copyright, and which is now repealed. As each of these acts was passed for the purpose of extending protection to foreign authors whose works were first published in their own country, and whose country gave reciprocal privileges to English authors, the natural purpose of the provision above cited would seem to be simply to declare negatively that such foreign authors should not be entitled to copyright *under that statute*, unless they should comply with its prescribed requirements. This view is strengthened by the fact that no such provision

is contained in the general law of 5 & 6 Vict. c. 45; and it appears to have been the view taken by the courts in all of the cases, excepting *Boucicault v. Delafield* and *Boucicault v. Chatterton*, decided since the passing of the first International Copyright Act, in which it has been held that English copyright is defeated by a prior publication abroad. For those cases were, and the two cases just cited might have been, properly decided without reference to the International Copyright Acts. But it is immaterial whether section 19 of 7 & 8 Vict. c. 12, does or does not apply to cases governed by the general statutes; for it makes no change whatever in the law in those cases.

is the same as that given to the English statutes, and that an author forfeits his claim to copyright in this country by a first, but not by a contemporaneous, publication of his work abroad.¹

A publication, to defeat the author's claim to copyright, must be one which has been made by his authority or with his consent.²

Place of Printing.—The question may arise whether it is essential to the securing of copyright that the book shall be printed in the United States. On this point the statutes are silent, and there is no judicial light. Every requirement which the statute prescribes concerning the vesting of copyright may be complied with, though the work has been printed in a foreign country. Nor does the purpose or spirit of the law demand that the printing shall be done in the United States. The copyright laws were passed, not for the protection of mechanical industries, but for the encouragement of native authors, and the advancement of learning in the country. These objects are secured by the first publication here of works of literature and art; and hence such publication is made a condition precedent of obtaining the privileges granted. But printing is a thing distinct from publication, and whether it has been done in one place or in another is a question which does not affect the true purposes of the statute. If the protection of native industry were a legitimate object of the copyright law, it might with reason be claimed that all the material processes in the production of a book should be done in the country. Copyright would then be defeated, not only by printing the work abroad, but also by setting the types and casting the stereotype-plates in a foreign country, though the copies be struck off here. So, also, it would be essential that the binding should be done in this country; and the same principle, logically carried out, would require that the paper should be of home manufacture. It is not reasonable to suppose that such requirements are within the scope of the statute passed for the advancement of learning. It is clearly imma-

¹ See *Wall v. Gordon*, 12 Abb. Pr. n. s. (N. Y.), 349. *De Witt*, 2 Sweeny (N. Y.), 580, 551, on ap. 47 N. Y. 582; *Shook v. Neuen-*

² *Boucicault v. Wood*, 2 Biss. 34, 39; *Crowe v. Aiken*, *Ibid.* 208; *Palmer v.*

terial where the work has been written, and the same principle should govern the question of printing.¹

In England, the question is in the same condition as in this country. The statutes are silent, and the point has not been judicially determined; but there are *dicta* to the effect that the printing must be done in Great Britain.²

SUMMARY OF THE LAW.

United States. — The conditions on which copyright will vest in a work may now be summarized. In the United States, the title of a book must be recorded before publication, the copyright notice printed on the title-page, or the page next following, and two copies of the book delivered or mailed to the Librarian of Congress within ten days after publication.³ The first publication of the work must be in this country. If any work is published without compliance with these conditions, it becomes public property.

Great Britain. — In England, there are some special regulations in the case of prints, engravings, works of sculpture, paintings, and photographs; and special provision is made for protecting, on certain conditions, the works of foreign authors first published abroad. Copyright will vest in any literary work of which a British subject is the author, on the sole condition that it is first published in the United Kingdom, or is published there on the day of its first publication elsewhere. Copyright will vest in the work of a foreign author on the same condition, provided he be anywhere within the British dominions on the day his work is published in the United Kingdom. It is immaterial where an English author may be

¹ "It is difficult," says Mr. Curtis, "to extract from the act any thing like a tariff protection to the mere arts of paper-making and printing. Literary labor and the advancement of the literature of the country were the great objects of encouragement." *Law of Copyright* (Boston, 1847), p. 144.

² In *Clementi v. Walker*, decided in 1824, 2 Barn. & Cr. 861, the court expressed the opinion that the printing must be done in Great Britain. Lord St. Leonards gave expression to like

views in *Jefferys v. Boosey*, 4 H. L. C. 983, 986. In *Page v. Townsend*, 5 Sim. 395, it was held that the object of the legislature was not to protect prints "which were designed, engraved, etched, or worked abroad, and only published in Great Britain." But this decision was based on the special provisions of the statute relating to copyright in prints.

³ For the variation in these requirements in the case of works of art, see *ante*, p. 265.

at the time of publication. When copyright has once vested, protection extends throughout the British dominions.¹ While valid copyright may be secured on these conditions, an action at law or a suit in equity cannot be maintained for piracy until the work has been registered in the manner prescribed by statute. But such registration may be made at any time before the action or suit is brought.

United Kingdom and British Dominions Defined. — It is important here to note carefully the meaning of the terms used. The United Kingdom embraces England, Wales, Scotland, and Ireland; while the British dominions include “all parts of the United Kingdom of Great Britain and Ireland, the islands of Jersey and Guernsey, all parts of the East and West Indies, and all the colonies, settlements, and possessions of the crown which now are or hereafter may be acquired.”² It will be noticed that the area within which the presence of a foreign author at the time of publication is required, and that throughout which copyright extends, are the same, namely, the British dominions; while the place of publication is restricted to a smaller territory, — the United Kingdom.³

¹ See *Routledge v. Low*, Law Rep: 3 H. L. 100.

² 5 & 6 Vict. c. 45, s. 2.

³ *Colonial Copyright.* — The provisions of the general copyright law, 5 & 6 Vict. c. 45, apply to all parts of the British dominions. Section 17 of this act prohibits, under heavy penalties, any person without the consent of the owner of the copyright from importing into any English colony a book copyrighted in Great Britain, and reprinted in any country out of the British dominions. A like prohibition was made in the Customs Act, 16 & 17 Vict. c. 107, s. 160, and is continued in the Consolidated Customs Act, 39 & 40 Vict. c. 36, s. 42, passed in 1876. By 10 & 11 Vict. c. 95, passed in 1847, and known as the Foreign Reprints Act, the Queen was empowered, by order in council, to suspend in certain cases the prohibition against importing English copyrighted books into the colonies. This act provides, “that in case the legislature or proper legislative author-

ities in any British possession shall be disposed to make due provision for securing or protecting the rights of British authors in such possession, and shall pass an act or make an ordinance for that purpose, and shall transmit the same in the proper manner to the Secretary of State, in order that it may be submitted to her Majesty, and in case her Majesty shall be of opinion that such act or ordinance is sufficient for the purpose of securing to British authors reasonable protection within such possession, it shall be lawful for her Majesty, if she think fit so to do, to express her royal approval of such act or ordinance, and thereupon to issue an order in council declaring that so long as the provisions of such act or ordinance continue in force within such colony the prohibitions contained in the aforesaid acts, and hereinbefore recited, and any prohibitions contained in the said acts, or in any other acts, against the importing, selling, letting out to hire, exposing for sale or hire,

DURATION OF COPYRIGHT.

In the United States, the statute grants protection in the case of all works for twenty-eight years from the time of

or possessing foreign reprints of books first composed, written, printed, or published in the United Kingdom, and entitled to copyright therein, shall be suspended so far as regards such colony; and thereupon such act or ordinance shall come into operation, except so far as may be otherwise provided therein, or as may be otherwise directed by such order in council, any thing in the said last-recited act or in any other act to the contrary notwithstanding."

The Canadian legislature having provided for the collection of a customs duty of 12½ per cent on foreign reprints of English copyright works, the amount thus collected to go to the owner of the copyright, an order in council was made July 7, 1868, by which were suspended all prohibitions in the imperial acts against importing such works into Canada. Like provision for protecting the rights of British authors have been made by other colonies. Referring to the operation of the Foreign Reprints Act, the Royal Copyright Commissioners, in their report submitted to Parliament in June, 1878, p. xxxi, § 193, say: "So far as British authors and owners of copyright are concerned, the act has proved a complete failure. Foreign reprints of copyright works have been largely introduced into the colonies, and notably American reprints into the Dominion of Canada; but no returns, or returns of an absurdly small amount, have been made to the authors and owners. It appears from official reports that, during the ten years ending in 1876, the amount received from the whole of the nineteen colonies which have taken advantage of the act was only £1,155 13s. 2½d., of which £1,084 13s. 3½d., was received from Canada; and that, of these colonies, seven paid nothing whatever to the authors, while six now and then paid small sums amounting to a few shillings."

In 1875, the Dominion Parliament passed an act giving copyright for twenty-eight years to any person domiciled in Canada, or in any part of the British dominions, or being the citizen of any country having an international copyright treaty with Great Britain. To secure copyright, the book must be published or republished in Canada. Section 15 of this act provides that "works of which the copyright has been granted and is subsisting in the United Kingdom, and copyright of which is not secured or subsisting in Canada under any Canadian or Provincial act, shall, upon being printed and published or reprinted and republished in Canada, be entitled to copyright under this act; but nothing in this act shall be held to prohibit the importation from the United Kingdom of copies of such works legally printed there."

The Canadian act was sent in the form of a bill reserved for the Queen's approval; but as there were doubts whether it was not repugnant to imperial legislation, and to the order in council made in 1868, the 38 & 39 Vict. c. 53, was passed, authorizing the Queen to assent to the Canadian bill. It was further provided by section 4 of 38 & 39 Vict. c. 53, that "where any book in which, at the time when the said reserved bill comes into operation, there is copyright in the United Kingdom, or any book in which thereafter there shall be such copyright, becomes entitled to copyright in Canada in pursuance of the provisions of the said reserved bill, it shall be unlawful for any person, not being the owner, in the United Kingdom, of the copyright in such book, or some person authorized by him, to import into the United Kingdom any copies of such book reprinted or republished in Canada." By section 5 the order in council of 1868 is continued in force "so far as

recording the title.¹ An additional term of fourteen years may be secured by the author, if he be living at the end of the first term, or by his widow or children, if he be dead.²

In England, the copyright in a book is granted for forty-two years from the time of first publication. If the author is living at the end of that period, the copyright will continue until seven years after his death.³ The copyright in prints, engravings, and lithographs lasts for twenty-eight years from the time of publication;⁴ in paintings, drawings, and photographs, during the life of the author, and seven years after his death;⁵ and in sculpture, models, and busts, for fourteen years from first publication,⁶ and the artist, if living at the end of that period, may secure protection for an additional term of fourteen years.⁷

relates to books which are not entitled to copyright for the time being, in pursuance of the said reserved bill."

The Canadian copyright act is given as a schedule to 38 & 39 Vict. c. 53. See also Reserved Act, 1875, Stat. Dom. Canada, 1876, p. xvii.

¹ U. S. Rev. St. s. 4953.

² Id. s. 4954.

³ 5 & 6 Vict. c. 45, s. 8. See *Marzials v. Gibbons*, Law Rep. 9 Ch. 518,

as to the construction of section 4, which provides for the extension of the copyright in works published when the statute was passed.

⁴ 7 Geo. III. c. 38, s. 7. The provisions of the acts relating to prints and engravings were extended to lithographs by 15 & 16 Vict. c. 12, s. 14.

⁵ 25 & 26 Vict. c. 68, s. 1.

⁶ 54 Geo. III. c. 56, s. 1.

⁷ Id. s. 6.

CHAPTER VI.

TRANSFER OF COPYRIGHT.

GREAT BRITAIN. — BOOKS.

By Registration. — In England, the statute provides for the transfer of copyright in books by registration, but does not require it to be done in this way. Section 13 of 5 & 6 Vict. c. 45, after providing for the registration of books in the registry of the Stationers' Company by the owners of the copyright, enacts "that it shall be lawful for every such registered proprietor to assign his interest, or any portion of his interest therein, by making entry in the said book of registry of such assignment, and of the name and place of abode of the assignee thereof, in the form given in that behalf in the said schedule, on payment of the like sum [five shillings]; and such assignment so entered shall be effectual in law to all intents and purposes whatsoever, without being subject to any stamp or duty, and shall be of the same force and effect as if such assignment had been made by deed." The entry is made on the application of the assignor, and sets forth the date of entry, title of the book, name of the assignor, and name and place of abode of the assignee. The statute makes a certified copy of the entry *prima facie* proof of assignment, "but subject to be rebutted by other evidence."¹

This mode of transfer appears to be available only to a "registered proprietor" of the copyright. It does not, therefore, apply to transfers made before the original entry of copyright. In case the assignment has been made before publication, the assignee as owner would properly make the original entry.

¹ S. 11. See *Low v. Routledge*, 88 L. J. N. S. (Ch.) 717, 723; *Low v. Ward*, Law Rep. 6 Eq. 415; *Wood v. Boosey*, Law Rep. 2 Q. B. 340, on ap. 8 Id. 223; *Graves's Case*, Law Rep. 4 Q. B. 715; *Boosey v. Fairlie*, 7 Ch. D. 801.

By Bequest and in Case of Intestacy. — The act further provides for the transmission of copyright in case of the death of the owner. Section 25 declares “that all copyright shall be deemed personal property, and shall be transmissible by bequest, or, in case of intestacy, shall be subject to the same law of distribution as other personal property, and in Scotland shall be deemed to be personal and moveable estate.”

MUST ASSIGNMENT OF COPYRIGHT BE IN WRITING ?

As registration is a mode of transfer optional with the parties thereto, it becomes necessary to inquire in what other manner the ownership of copyright may be passed from one person to another. The law on this point cannot be properly determined without a critical examination of the leading decisions on the subject, nor without carefully considering each with strict reference to the governing statute. It is necessary to divide the authorities into two classes, and treat each class separately: 1, those in which the decision was governed by a statute in force prior to that of Victoria; 2, those wherein the question was controlled by the 5 & 6 Vict. c. 45.

Judicial Construction of Former Statutes. — **Writing but not Attestation held to be Necessary.** — Every statute before that passed in the reign of Victoria was silent as to the mode of transferring the copyright in a book. Hence, it was left to the courts to determine the requisites of an assignment. It appears that before 1814 the chancery courts assumed that copyright might be transferred by parol.¹ The question was first raised in *Power v. Walker*, decided in that year, under 8 Anne, c. 19, which imposed penalties on any person who should print or import a copyrighted book “without the consent of the proprietor or proprietors thereof first had and obtained in writing, signed in the presence of two or more credible witnesses.”² The plaintiff, whose title had been derived by parol, brought an action for piracy against the defendant, who pleaded the absence of a written assignment

¹ “It is settled now,” said Lord Eldon, “that an assignment of copyright must be in writing, although it frequently happened that courts of equity had granted injunctions at the suit of persons claiming under assignments not in writing, until we were set right by a decision of the Court of King’s Bench.” *Rundell v. Murray*, Jac. 314.

² s. 1.

from the author to the plaintiff. Lord Ellenborough ruled that "the statute having required that the consent of the proprietor, in order to authorize the printing or reprinting of any book by any other person, shall be in writing, the conclusion from it seemed almost irresistible that the assignment must also be in writing; for if the license, which is the lesser thing, must be in writing, *a fortiori* the assignment, which is the greater thing, must also be."¹

This reasoning was carried to its logical conclusion in *Davidson v. Bohn*, decided in 1848, when the court declared that, as a consent in writing signed by two witnesses was necessary to a license, an assignment to be valid must likewise be in writing and attested by two witnesses.² A written assignment with one witness was therefore held to be invalid. The question came before the House of Lords in *Jefferys v. Boosey* in 1854, when a majority of the judges were of opinion that a written assignment without witnesses was good.³ It was considered that the necessity for attestation, if any existed under the statute of Anne, had been removed by the 54 Geo. III. c. 156, passed in 1814, which made the owner's consent in writing necessary to a license to publish, but contained no mention of witnesses. In the Scotch case of *Jeffreys v. Kyle*, which will be more fully considered further on, it was also held that after the 54 Geo. III. c. 156, attestation was not necessary to a valid assignment.⁴

In *Shepherd v. Conquest*, the Court of Common Pleas, applying the reasoning of Lord Ellenborough to the 3 & 4 Will. IV. c. 15, held that an assignment conveying the exclusive right of performing a play must be in writing; and the plaintiff failed because he claimed by a parol title.⁵

¹ 3 Maule & S. 9.

² 6 C. B. 456.

³ 4 H. L. C. 815.

⁴ 18 Sc. Sess. Cas. 2d ser. 906. Affirmed by House of Lords, *Kyle v. Jeffreys*, 3 Macq. 611.

Davidson v. Bohn appears to have been decided under 8 Anne, c. 19. Although the case was tried many years after the passing of 54 Geo. III. c. 156, no reference was made to this statute.

In *Jefferys v. Boosey*, Lord St.

Leonards and Baron Alderson were of opinion that the license clause in the statute of Anne had not been repealed by the 54 Geo. III. c. 156, s. 4, since the provisions of both acts as to license might stand together; and they regarded the law as settled by *Power v. Walker* and *Davidson v. Bohn*, that a valid assignment must be in writing, and attested by two witnesses. 4 H. L. C. 994-996, 915.

⁵ 17 C. B. 427. See also *Barnett v. Glossop*, 3 Dow. Pr. Cas. 625.

In the following case of *Cumberland v. Copeland*, the plaintiff, to whom the author had assigned a play by a writing attested by one witness, brought an action under 3 & 4 Will. IV. c. 15, against the defendant, for representing the piece without authority. The Court of Exchequer, declaring *Power v. Walker* and *Davidson v. Bonny* were bound by *Power v. Walker* and *Davidson v. Bonny*, held the plaintiff's title to be bad for want of an assignment attested by two witnesses.¹ But this judgment was reversed by the Exchequer Chamber, which unanimously held that an assignment in writing, without witnesses, was good.²

In *Cumberland v. Copeland* as well as in *Jefferys v. Boosey*, the assignment was shown to have been in writing, but without witnesses. The point decided was that a written assignment, though not attested, is valid. The question whether a writing is necessary was not before the court.

The doctrine affirmed in *Power v. Walker* has been recognized in several other cases than those here reviewed. But in most, if not all, of them the question was so involved with other issues that the decisions did not turn directly on this point.³

The leading authorities relating to the construction of the statutes in force before the 5 & 6 Vict. c. 45, have now been reviewed. Their result is, that, before the present statute was passed, copyright could not be assigned by parol, but only by an instrument in writing, to which no attestation was required after 54 Geo. III. c. 156, became a law.

THE DOCTRINE MAINTAINED THAT ASSIGNMENTS NEED NOT BE IN WRITING UNDER ENGLISH STATUTES.

Former Statutes Considered. — I shall now try to show that, independently of the statute of Victoria, the doctrine affirmed by the English courts is not sound, and that the

¹ 7 Hurl. & N. 118.

² 1 Hurl. & C. 194. See also *Marsh v. Conquest*, 17 C. B. n. s. 418, where it was held that the assignment need not be by deed.

³ See *Latour v. Bland*, 2 Stark. 382; *Morris v. Kelly*, 1 Jac. & W. 461; *Run-*

dell v. Murray, Jac. 811; *Clementi v. Walker*, 2 Barn & Cr. 861; *Barnett v. Glossop*, 8 Dow. Pr. Cas. 625; *De Pinna v. Polhill*, 8 Car. & P. 78; *Colburn v. Duncombe*, 9 Sim. 151; *Hodges v. Welsh*, 2 Ir. Eq. 266; *Chappell v. Purday*, 4 Y. & C. Exch. 485.

statutes on whose construction it was based were wrongly interpreted.

The 8 Anne, c. 19, and the 54 Geo. III. c. 156, secured to the author and his assignee the sole right of publishing a book for a named period, and declared that any other person who should during that period republish such book without the consent in writing of the owner of the copyright should be liable to certain penalties. In like manner, the 3 & 4 Will. IV. c. 15, gave to the author and his assignee the sole liberty of representing a dramatic composition for the term therein mentioned, and imposed penalties on any other person who should cause such composition to be performed without the written consent of the owner. The provisions of these three acts relating to the vesting of the right and its protection by penalties were the same as far as concerns the question of the necessity of a written assignment.¹ All were silent as to the mode of transferring the rights which they secured.

The distinction between an assignment and a license is that by the former the ownership of the copyright is vested in the assignee, while by the latter the licensee acquires the privilege of publishing, but no proprietary rights in the copyright. It is conceded that the provision relating to a consent in writing does not expressly govern the mode of assignment. The theory advanced by Lord Ellenborough is that this clause must by implication be construed to apply to a transfer of the copyright, as well as to a license to publish. This reasoning would be entitled to more consideration if the act prohibited every person except the author from publishing without authority in writing. But such is not the language or the intent of the statute. It expressly declares that the author and his assignee shall have the benefit of copyright, and that any person who is not the author or assignee must show a consent in writing to publish. Now, it is clear that when piracy is charged, two defences are open to the alleged wrong-doer. He may show either that he is the author or the assignee, that is

¹ As already said, the 8 Anne, c. 19, of George III. But the question required the written consent to be attested by two witnesses, while no mention of witnesses was made in the act whether an assignment must be in writing is not affected by this difference between the two statutes.

the owner of the copyright; or that he has a license in writing from the owner to publish. If he can establish the first fact, he need not prove the second. Only those who cannot prove ownership are required by the statute to produce a written license. The clause in question does not, therefore, apply to the owner of the copyright.¹ Hence, we must look elsewhere to ascertain what is necessary to constitute a good title of ownership.

The statute recognizes as owners the author and his assignee. No difficulty is presented when the author claims as owner, since authorship creates an undisputed title to ownership. But when the owner is not the author, but derives his title from him, the inquiry is raised as to what formality is required to make the transfer valid in law. The statute secures to the author and his assignee the exclusive right of publishing a book during a specified period. If the author, before parting with his property in a manuscript work, publish it as his own, the right conferred by the statute will vest in him. The copyright thus acquired may at any time afterward be transferred to another, who thereby becomes clothed with all the rights which were conferred upon the author, and the latter becomes divested of those rights. But the statute not only protects the title of the assignee thus derived after publication, but it also grants copyright in the first instance to the assignee as well as to the author. In other words, statutory copyright will vest *ab initio* either in the author or in his assignee. When, therefore, the author has parted with his property in a work not yet published, the owner of the manuscript may become the first publisher, and thereby secure to himself the copyright conferred by the statute. As the lawful owner of the manuscript, his standing under the statute is the same as if he were the author.

Here, then, are two different classes of persons embraced within the meaning of assignee as used by Parliament: 1st, those to whom an assignment of statutory copyright in a pub-

¹ "The statute does require the defence of license to be so [in writing] proved; and that in case of a plaintiff claiming under a license, and suing for a statutable penalty, the license should be so proved; but it appears to leave the assignee, suing according to the common law, to prove his case under that law." Erle, J., *Jefferys v. Boosey*, 4 H. L. C. 882.

lished work has been made after the securing of such right by the author; 2d, those to whom the author's rights were transferred before publication, and, consequently, before the creation of statutory copyright, and who are entitled to secure for themselves the statutory copyright by virtue of being the owners of the manuscript.¹

Now, in cases wherein the title has passed before the creation of the statutory right, the statute cannot rightly be construed to regulate the form of transfer.² As there can be no statutory copyright in an unpublished work, the right thus transmitted before publication exists only by common law. Hence, the mode of transfer must be governed by the common law, which is the only law applicable; and, if the title held by the assignee is good by the common law under which it was derived, it must, in the absence of express legislation to the contrary, be equally valid under the statute. Therefore, as a parol assignment is valid when made by the common law,³ it follows that such assignment will continue to be sufficient under the statute in cases wherein the transfer has taken place before the vesting of the statutory copyright; that is, before publication.

What, then, is the mode of assignment after publication, and after the statutory copyright has once vested in the author? If any formalities or requirements were prescribed by Parliament, they would doubtless have to be observed. But, as already said, the statute is silent on this point. Hence, according to a well-established rule of construction, the mode of transfer can be governed only by the common law; and by the common law, as has been said, a good assignment may be made by word of mouth.

Lord Ellenborough's theory, that the mode of assignment is impliedly governed by the clause of the statute requiring a license to be in writing, has been applied indiscriminately to all cases of transfer, whether made before or after publication.

¹ See *ante*, pp. 238-242.

² Mr. Justice Erle rightly said: "Even if the statute should be held to annul the property after publication, still it leaves the property before publication as it was; and then the right of

the plaintiff below stands; for he took by assignment, before publication, when the statute had no operation." *Jefferys v. Boosey*, 4 H. L. C. 878.

³ See *ante*, p. 104.

The important distinction between an assignment made prior and one subsequent to the vesting of the statutory copyright appears either not to have been observed, or to have been disregarded. I have tried to show that this construction of the statute is erroneous in either case. But, whatever grounds there may be for enlarging the meaning of the license clause so as to embrace an assignment of the copyright in a published work, they wholly disappear in the case of a transfer made before publication. The clause of the statute which imposes penalties on any person publishing a book without the written consent of the owner of the copyright applies only to one who reprints what has already been published. Statutory copyright begins with publication, before which it has no existence, and hence can neither be violated, nor protected by statutory penalties. It exists only for a given term, and it is only during this period that its invasion is guarded against by penalties. The right must exist before it can be violated, and it cannot exist before publication. The statute does not prohibit or impose penalties for the unauthorized publication of a manuscript, but only for the unlicensed republication of a work in which copyright has vested. Such is the plain reading of the 8 Anne, c. 19, and of the 54 Geo. III. c. 156; but this meaning is put beyond doubt by the language of 5 & 6 Vict. c. 45, s. 15, which prohibits any person, without the written consent of the owner, from printing "any book in which there shall be subsisting copyright."

The clause imposing penalties in the absence of a written license applies, therefore, solely to published productions. The penalties cannot attach nor the written license be required for an act done before publication, and before the statutory right vests. The provision does not apply to what is done outside of the statute. Now, we have seen that the section which secures copyright to the assignee recognizes assignments made before as well as those made after the vesting of the statutory right. It is, therefore, more extensive in its operation than the clause requiring a written license. Hence, if the reasoning were sound that an assignment made after publication must be in writing, because a license in writing is required to reprint a published work, the analogy fails when the transfer has been

perfected before publication; since, before publication, the license clause of the statute has no force.

The cases which have been reviewed present a marked instance of the force of the custom, too common in English and American courts, of following precedent without examining the sufficiency of the grounds on which such precedent is based, and without seeking to ascertain the true principles by which alone the law can be rightly determined. When the question as to the validity of a parol assignment of copyright came before Lord Ellenborough in *Power v. Walker*, there was neither judicial authority nor express statutory directions on the subject.¹ The point appears not to have been thoroughly considered in that case, and the supposed meaning of the statute was reached by applying to one of its clauses reasoning as fallacious as it was novel. The judgment in *Davidson v. Bohn*, the next case in which the issue was directly tested in a court of law, was based solely on the precedent of *Power v. Walker*; and in every subsequent case, in which the construction under consideration has been affirmed or recognized, it has been affirmed or recognized simply on the authority of those two cases. Of course, to adopt Lord Ellenborough's conclusion is to accept his reasoning. But his reasoning as well as his conclusion, when accepted, has been accepted on his authority, and without inquiry as to its soundness.²

Judicial Opinions Against the Soundness of the Prevailing Doctrine. — While the doctrine founded on the authority of Lord Ellenborough, that copyright could not be transferred by parol under the statutes preceding that of Victoria, has not been overruled in any case yet reported, its soundness has been disputed or questioned by many British judges. In expressing his opinion in the House of Lords, in *Jefferys v. Boosey*, Mr. Justice Coleridge said of *Power v. Walker* and *Davidson v. Bohn*: "It is remarkable that both these are cases merely of refusing a rule for a new trial, the latter mainly proceeding on the authority of the

¹ The question had not been determined by a court of law. See *ante*, p. 302, note 1, as to the course of the chancery courts.

² In view of the potent influence of precedents in the English courts, I am

convinced that, if Lord Ellenborough had held a parol assignment to be sufficient, this construction would have been followed and confirmed in subsequent cases.

former, and neither of them fully argued; both, I must take leave to say with most sincere respect, founded on reasoning which is any thing but satisfactory.”¹ In *Cumberland v. Copeland*, in the Court of Exchequer, one of the judges questioned the soundness of the judgments in *Power v. Walker* and *Davidson v. Bohn*, and another expressly declared that those cases had been wrongly decided; but both thought they were binding precedents. Baron Bramwell used the following strong language: “If I had for the first time to construe the statute of Anne, I should not put upon it the construction which the court did in *Power v. Walker*. It seems to me that the whole difficulty is attributable to the mistake which I cannot help thinking the court made in that case. They construed the statute as requiring an assignment of copyright to be in writing, not as a consequence of the necessity of a license in writing signed by two witnesses, in order to justify what would otherwise be a piracy; but, as an inference or conclusion from such a license being required, they considered that an assignment of copyright must also be in writing. That decision was corroborated in *Davidson v. Bohn*, and recognized in the House of Lords, and it is now too late to question it.”² In *Jeffreys*

¹ 4 H. L. C. 906. “The statute of Anne,” said the same judge, “speaks, in respect of works already printed, ‘of the author who hath not transferred to any other, the bookseller, the printer, or other person or persons, who hath purchased or acquired the copy of a book in order to print the same;’ and in respect of books not then printed and published, it speaks of ‘the author and his assignee or assigns:’ in both cases being entirely silent as to any special form of transfer or attestation, and using words which embrace assignees in law, and by devolution, as well as assignees by act of the parties. This is the part of the section which either confers or regulates the limited copyright; and because, in the penal part of the clause which follows, an exception is made in favor of those who are licensed by a consent in writing, attested by two witnesses, it has been twice held that the assignees in the first part must be

such as claim under an assignment in writing so attested.” *Ibid.* 905.

Mr. Justice Crompton thought that *Power v. Walker* was a binding authority; but said that he would “not stop to inquire how far such a doctrine, if now propounded for the first time, might or might not be satisfactory.” *Ibid.* 854.

See also the views of Erle, J., *ante*, p. 306, note 1, p. 307, note 2.

² 7 Hurl. & N. 133. “I am not prepared to say,” remarked Channel, B., “that if I had to construe those statutes [8 Anne, c. 19, and 54 Geo. III. c. 156] for the first time, I should concur with the decisions in *Power v. Walker* and *Davidson v. Bohn*; but we cannot overrule them. If I am right in my view that the statute of Anne is in force for some purpose, I must construe it according to the decisions, although not satisfactory to my mind.” *Ibid.* 135.

v. Kyle, three of the four judges of the Scotch Court of Session expressed their dissatisfaction with the doctrine propounded by Lord Ellenborough. "If the question," said Lord Deas, "were now to be decided as to the construction of the act of Queen Anne, I should agree with those who think that the statute did not regulate the form of assignments, but only the form of license to publish, and that the form of assignments was left to be regulated by the common law. Assuming copyright to be the creature of statute, and to cover only publications by British subjects within Britain, it appears to me that, when property has been so created, and the form of assignments not regulated, these are to be what the common law requires."¹

It is hardly necessary to add, that the views above quoted are in the nature of *obiter dicta*, and therefore have no binding force as precedents; but, as the opinions of able jurists speaking from the bench, they should at least show the necessity of a thorough judicial examination of the doctrine under consideration, in order to determine what is the sound law on this subject.

Does Present Statute Require Assignment to be in Writing?
We have thus far considered the question of assignment solely in connection with the statutes passed before the reign of Victoria, with the view of showing that, not even under those acts on which it is based, can the construction announced by Lord Ellenborough be sustained. But suppose Lord Ellenborough's reasoning to be sound, and that the acts to which it was applied were rightly construed, will the statute now in force admit of

¹ 18 Sc. Sess. Cas. 2d ser. 914. Lord Ivory, referring to *Power v. Walker* and *Davidson v. Bohn*, said: "I confess, with reference to these authorities, although not satisfied with the grounds on which they are rested, that I should be slow to disturb authorities which had been pronounced and acted on so long." Ibid. 910. Lord President M'Neill, citing *Power v. Walker*, said: "That decision, standing for a long time undisturbed, would certainly be one which I should be unwilling to go against in the construction of the statute, although my

own judgment would not readily lend its consent to the reasons upon which it proceeds." Ibid. 915. See also the views of the same judges given *post*, pp. 314, 315, as to the construction of 5 & 6 Vict. c. 45.

Mr. Justice Byles, in *Lacy v. Toole*, 15 L. T. N. S. 512, after asking counsel whether there was any provision in 3 & 4 Will. IV. c. 15, as to the attestation of an assignment of the right to represent a drama, said: "Nor does it seem that there is any provision even that an assignment must be in writing."

the same construction? The affirmative of this question is supported by a single chancery decision. In the recent case of *Leyland v. Stewart*, the Master of the Rolls ruled that the construction given to the earlier statutes is applicable to the 5 & 6 Vict. c. 45, and that, under this act, an assignment, unless made by entry in the registry at Stationers' Hall, must be in writing.¹

In my judgment, this decision is wrong; and is the result of following the earlier authorities, in disregard of the plain provisions of the existing statute. This statute contains language which should remove all doubt concerning the mode of transfer since it was passed. Like the earlier statutes, it makes the printing of a book in which copyright has vested unlawful without the written consent of the owner; and excepting the definition of assigns, and the provision relating to transfer by registration, bequest, and in case of intestacy, it contains no express enactment concerning the mode of assignment. It employs the word assignee in the same sense in which it was used in the antecedent acts; but, unlike those acts, it expressly defines the meaning which the word shall have. Section 2 declares that "the word 'assigns' shall be construed to mean and include every person in whom the interest of an author in copyright shall be vested, whether derived from such author before or after the publication of any book, and whether acquired by sale, gift, bequest, or by operation of law, or otherwise." This language seems to be conclusive of the question under consideration. It is at once a definition of an assignee and of an assignment. It declares in effect that any transfer which vests the rights of the author in the assignee shall be valid, whether made before or after publication, whether under the statute or the common law, and whether by sale, gift, bequest, or by operation of law, or otherwise. The formality of a writing is not required. If the transfer be made under the common law before the vesting of copyright, and be valid by that law, its validity is recognized by the statute. If, either before or after statutory copyright has vested, the author by parol sells or gives his interest to another; or if the right passes in case of bankruptcy, marriage, or intestacy, or otherwise by the operation of law, although there be no writing, —

¹ 4 Ch. D. 119.

the transmission will come within the above definition, and meet the requirements of the statute. In other words, a sound construction of the statute must lead to the conclusion, that a parol transfer of copyright, whether made before or after publication, is good in law.

Authorities in Favor of Doctrine that under Present Statute Copyright may be Transferred by Parol. — In harmony with this view are the judgment of the Common Bench in *Cocks v. Purday*,¹ and the *dicta* of the Scotch judges in *Jeffreys v. Kyle*.² In the former case, it appeared that the plaintiff had bought from Hoffmann, of Bohemia, the exclusive right of publishing in Great Britain a musical composition which at the time of purchase had not been published anywhere. Hoffmann had bought the composition from the author, Labitzky. No writing appears to have passed between these two persons; but by the Austrian law, which prevailed in Bohemia, a parol transfer of copyright was valid. The sale by Hoffmann to Cocks was made by letter, and no formal assignment was executed until nearly a year after the latter had published and copyrighted the work in England. The defendant argued that the plaintiff's title was not good, because it had not been derived by a written assignment. The court, after quoting the definition of assigns in section 2 of 5 & 6 Vict. c. 45, said: "There being then a sale in this case valid by the law of Austria, where it was made, the interest of the author became vested in the plaintiff before publication, so as to make him an assignee within the meaning of the third section; and he, therefore, had a good derivative title."³

If the statute of Victoria can be rightly construed as requiring every assignment, whether made before or after publication, to be in writing, this decision is clearly wrong. In such case, it would be immaterial whether the transfer were good or bad under a foreign law. The question would be wholly governed by the English statute.⁴ But the judgment in *Cocks v.*

¹ 5 C. B. 860.

² See *post*, p. 814.

³ Wilde, C. J., 5 C. B. 885.

⁴ The judges who advised the House of Lords in *Jefferys v. Boosey*, 4 H. L. C. 815, were divided in opinion

as to the validity in England of an assignment valid in Milan. See also *Chappell v. Purday*, 14 Mees. & W. 308. The principle which governs the question is clear. An assignment of English copyright made after publica-

Purday is sound ; and is an express authority to the effect that, when a valid transfer, whether by writing or parol, is made before publication, it must be held to give the assignee a good title under the statute. It is true that what the court directly decided was that the transfer of the property in an unpublished work made in a foreign country, and valid by the law of that country, must be held as giving to the English buyer a good title in England. But the principle is the same when a sale of an unpublished work is made in England under the common law. The court in this case did not consider the question of an assignment made after publication.

At the trial of *Jeffreys v. Kyle* before the Lord President, the title acquired by the plaintiff, who had bought a song from the author, and registered himself as owner of the copyright under 5 & 6 Vict. c. 45, but who had no other writing than the author's receipt for the purchase-money, was held to be valid. This decision was affirmed by the Court of Session,¹ and by the House of Lords,² which held that an assignment made after the 54 Geo. III. c. 156, need not be attested. But the question as carelessly brought on appeal before these two tribunals was as to the necessity of attestation ; and the court was precluded by the pleadings from directly passing on the validity of a parol assignment. Nevertheless, three of the four judges of the Court of Session questioned, as has already been shown,³ the soundness of the construction which had been given by the English courts to 8 Anne, c. 19, and 54 Geo. III. c. 156 ; and maintained that, whatever might be the true meaning of those statutes, a writing could not be considered necessary under the 5 & 6 Vict. c. 45. "Even before that statute," said Lord Ivory, "there were other titles than the mere title of a deed of assignment, which effectually carried the property

tion, is an assignment of a right granted and regulated by an English statute. If any form is prescribed or required by the statute, the assignment, wherever made, must be in that form. But a transfer of the property in an unpublished work is not a transfer of a statutory right, and hence is not governed by the statute. If the transfer is made in England and is good by

the common law, or if made in a foreign country and is valid by the law of that country, the buyer becomes the owner of the property, and is an assignee entitled to secure the statutory copyright, provided the work be a proper subject of copyright.

¹ 18 Sc. Sess. Cas. 2d ser. 906.

² *Kyle v. Jeffreys*, 3 Macq. 611.

³ *Ante*, pp. 310, 311.

of copyright; *e. g.*, in a case of bankruptcy. There it has been held that the transference is good. So also in intestacy, where a party takes up the rights of his ancestor, what carries the property of the deceased also effectually carries the copyright belonging to him. The legal effects of marriage have the same effect. In the event of her marriage, all right would be carried from Miss Cook to her husband. Therefore it would be difficult to hold that all right of transfer was to be denied under the statute. In short, there are a great many cases in which, it being essential that the party to whom the right is to be transferred should be vested in such right, and properly secured, still that such right is carried by common law without any formalities. The statute of Victoria does away with all that; because it says, in its interpretation clause, that the word assigns shall be construed to mean and include every person in whom the interest of an author in copyright shall be vested, whether derived from such author before or after the publication of any book; and whether acquired by sale, gift, bequest, or by operation of law, or otherwise. And in its operative clause, section 13, it goes on to deal with the question of succession of a legal assignment." He then expressed the opinion, that "a party holding a good assignment at common law would have been supported in any question raised under the recent statute" of Victoria.¹

The Lord President, M'Neill, thought that, under the definition of assigns in the statute of Victoria, "any thing that would instruct a sale or gift, or any right in that way whatever, would make the party in whose favor such gift was made proprietor."²

In *Hazlitt v. Templeman*, where it appeared that the copyright in a work, of which the plaintiff was author, had been registered under the statute of Victoria, with the verbal consent of the plaintiff, in the name of the defendant as owner, it was held that such registration was *prima facie* evidence of the defendant's title, which was not rebutted by the absence of proof of a written assignment.³ But the facts in this case and

¹ 18 Sc. Sess. Cas. 2d ser. 911.

² *Ibid.* 917.

³ 13 L. T. N. S. 593.

the questions involved were such that the decision throws little light on the question of assignment.

Leyland *v.* Stewart,¹ then, is the only case yet reported in which it has been held that an assignment under 5 & 6 Vict. c. 45, must be in writing; and this was a suit in chancery in which the Master of the Rolls, overlooking or disregarding the significant definition of assignee contained in it, applied to that statute the same construction which had been given to the earlier ones. Opposed to this decision is the authority of the Common Pleas in Cocks *v.* Purday,² the judgment of the Lord Ordinary in Jeffreys *v.* Kyle, and the *dicta* of a majority of the Court of Session in the same case.³

From this review of the question, it will be seen that the law governing the form of assignment under the statute now in force cannot be regarded as judicially settled. But the weight of authority, taking those cases in which alone this statute has been considered, and which alone can be regarded as binding authorities on the question of its meaning, is in favor of the doctrine that the copyright in a book may now be assigned by parol.

I have tried to show that the accepted construction of the earlier statutes is wrong; that its soundness has been questioned by many able jurists; and that, whether sound or unsound, the authorities by which it is supported cannot be regarded as settling the judicial construction of the statute now in force. I have thus treated the subject, in the belief that, when the question shall again be brought before a high judicial tribunal, the law will be carefully and thoroughly examined with special reference to the statute of Victoria, and determined, not by precedent, but by sound principles.

ENGRAVINGS, PAINTINGS, PHOTOGRAPHS, &C.

Engravings and Prints. — The statutes relating to prints and engravings do not prescribe the mode of assigning the copyright; and the law in such case has not been judicially determined. Parliament has prohibited the publication of such productions without the written consent of the owner, signed in the presence of two witnesses. If the mode of transfer is

¹ 4 Ch. D. 419.

² 5 C. B. 860.

³ 18 Sc. Sess. Cas. 2d ser. 905.

governed by this provision, as in the case of books, it will follow that an assignment must be in writing, and signed by two witnesses.¹ But section 2 of 8 Geo. II. c. 13, has an important bearing on this question. It provides "that it shall and may be lawful for any person or persons who shall hereafter purchase any plate or plates for printing from the original proprietors thereof, to print and reprint from the said plates without incurring any of the penalties in this act mentioned." This seems to be a bar to applying to the license clause in the case of engravings the same reasoning that has been applied to the license clause in the case of books. The true construction of the provision above quoted would appear to be, that any person may acquire the copyright in an engraving by buying the plate; and there is nothing in the statute and no principle which requires that such sale of the plate or transfer of the copyright shall be accompanied by a writing.

Maps. — As maps are within the provisions of the statute relating to books,² the mode of transferring the copyright must be the same as in the case of books.

Paintings, Drawings, and Photographs. — In the case of these productions, the assignment of the copyright must be in writing, but need not be attested. Section 3 of 25 & 26 Vict. c. 68 declares that "all copyright under this act shall be deemed personal or moveable estate, and shall be assignable at law; and every assignment thereof, and every license to use or copy by any means or process the design or work which shall be the subject of such copyright, shall be made by some note or memorandum in writing, to be signed by the proprietor of the copyright, or by his agent appointed for that purpose in writing."³

Registration of the assignment is made necessary to give the assignee the benefits of the act;⁴ but the statute does not provide for transferring the copyright by means of registration.

The statute further provides that, when any person makes for another, or sells to another any painting, drawing, or the

¹ 8 Geo. II. c. 13, s. 1; 17 Geo. III. c. 57.

² See *ante*, p. 174.

³ See *Strahan v. Graham*, 16 L. T. N s. 87, on ap. 17 Id. 457.

⁴ s. 4. *Graves's Case*, Law Rep. 4 Q. B. 715.

negative of any photograph, the former shall not retain the copyright, except by an agreement in writing signed by the latter; and the latter shall not acquire the copyright, except by a like agreement signed by the former.¹

MODE OF TRANSFER IN THE UNITED STATES.

It is to be regretted that, in copying from the statute of Anne the license clause, which in England has given rise to an unsatisfactory and questioned construction of the law governing the transmission of copyright, Congress has failed to prescribe in unmistakable language the requisites of a good assignment.

Former Statutes. — The act of 1790² and that of 1831³ prohibited any person from publishing a copyrighted book without the owner's consent in writing, signed by two witnesses. Both were silent respecting the mode of transfer. The first and only legislation on this point before 1870 was the supplemental act of 1834, which declared "that all deeds or instruments in writing for the transfer or assignment of copyrights, . . . shall and may be recorded in the office where the original copyright is deposited and recorded."⁴

What form of assignment was requisite or sufficient under these several acts is a question which has not received thorough judicial consideration. The Supreme Court of New York, in 1832, following the English decision in *Power v. Walker*, ruled that an assignment under the act of 1790 must be in writing, but that a verbal agreement to assign was valid.⁵ Besides this decision of a State court, there are *dicta* respecting the form of assignment by two justices of the Supreme Court of the United States. In *Stevens v. Cady*, Mr. Justice Nelson, applying the English theory to the license clause⁶ of the statute of 1831, remarked that an assignment "must be in writing, and signed in the presence of two witnesses;" but added that it was "unnecessary, however, to express an opinion upon this point."⁷ In *Little v. Hall*, Mr. Justice McLean said *obiter* that "a formal transfer of a copyright by the supplementary act of

¹ s. 1.

² s. 2; 1 U. S. St. at L. 124.

³ s. 7; 4 Id. 438.

⁴ Id. 728.

⁵ *Gould v. Banks*, 8 Wend. (N. Y.) 562.

⁶ s. 7.

⁷ 14 How. 532.

the 30th of June, 1834, is required to be proved and recorded as deeds for the conveyance of land ; and such record operates as notice.”¹ But this question was not before the court. Mr. Curtis, more soundly interpreting the meaning of the act of 1834, says : “ This statute seems to recognize the doctrine that transfers of copyright must be in writing ; but it does not expressly declare that they shall be so.”²

Meaning of Statute in Force. — There is, then, no reported decision which can be regarded as an express authority, binding on the federal courts, to the effect that, under the statute cited, an assignment of copyright was required to be in writing. It remains to consider the statute passed in 1870, and now in force. Its meaning respecting the question under consideration has not been judicially considered. Like the antecedent acts, it declares unlawful the publication of a copyrighted book “ without the consent of the proprietor of the copyright first obtained in writing, signed in presence of two or more witnesses.”³ Unlike those statutes, it provides that “ copyrights shall be assignable in law, by any instrument of writing, and such assignment shall be recorded in the office of the Librarian of Congress within sixty days after its execution ; in default of which it shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice.”⁴

Mode of Transfer before Publication. — Whatever effect these provisions may have respecting the requisites of an assignment of the copyright in a published book, the statute cannot, in my judgment, be rightly construed as governing a transfer made before publication, and hence before the statutory right attaches. In other words, if the statute can be considered as regulating the mode of transfer, it is only in the case of works in which the statutory copyright has vested that it can have this effect ; and such copyright will not vest in an unpublished work.⁵ The important distinction between a transfer made before and one

¹ 18 How. 171.

² Law of Copyright (Boston, 1847), p. 233.

³ U. S. Rev. St. s. 4964.

⁴ s. 4955.

⁵ It is not necessary here to consider the exceptional case in which

an inchoate or equitable statutory right may exist in a work between the time of filing the title and the time of publication. The question must be treated with reference to the general rule, that only published works are protected by statutory copyright.

made after statutory copyright has vested, which is to be observed in determining whether the mode of assignment is governed by the statute, has been fully considered in the examination of the English statutes, which, in this respect, are like our own.¹ It is enough here to add, that the act of Congress now in force expressly provides for granting copyright in the first instance to the owner of a manuscript;² and hence copyright will vest *ab initio* in the owner, whether he is or is not the author. When, therefore, a person has become possessed of the author's property in an unpublished work, he is the proper one, as owner, to secure the statutory copyright. As his title was acquired before publication, its validity is determined by the common law under which it was derived, and not by the statute.³

Must Assignment of Copyright in Published Book be in Writing? — We come now to the inquiry, whether the statute prescribes the mode of assigning the copyright in a published work. The solution of this question depends on the meaning to be given to sections 4955 and 4964 above referred to. The latter makes no reference, direct or indirect, to the subject of assignment; but the theory has gained currency in England, from whose statutes this clause has been copied, and, as we have seen, has been twice recognized in this country, that the provision under consideration, though intended to apply simply to licenses to publish, must be construed to prescribe the mode of assigning the copyright. I have already endeavored to show that this construction is unwarranted and indefensible.⁴ As it is not supported by any authority binding on a court of the United States, it is to be hoped that, when the question is presented for judicial determination, the subject will be thoroughly examined, and the decision grounded on sound principles.

The only express provision in the Revised Statutes relating to assignments is section 4955, which declares that "copyrights

¹ *Ante*, pp. 306-308.

² U. S. Rev. St. s. 4952.

³ In *Little v. Gould*, 2 Blatchf. 165, 362, the author's rights in manuscript reports were held to have passed to the Secretary of State, although there

was no writing. It was "regarded as an assignment by operation of law." Conkling, J., *Ibid.* 183. To the same effect is *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402.

⁴ *Ante*, p. 304 *et seq.*

shall be assignable in law by any instrument of writing," and provides for the recording of such assignments. This language plainly shows that an assignment need not be attested. Any writing, clearly expressing the intention of the parties to that effect, will be sufficient to pass the ownership of copyright. It has also been decided that an assignment, though not recorded, will be valid as between the parties, and as to all other persons not claiming under the assignor.¹

Does section 4955 require that an assignment of copyright to be valid under the statute must be in writing? If Congress intended to make such a law, it failed to use the proper language for that purpose. The words, "copyrights shall be assignable in law by any instrument of writing," are declaratory, and not mandatory. Their true meaning, as determined by established principles of construction, is, that copyright is transferable, and that a simple writing, without attestation, seal, or other formality, shall be sufficient as a valid assignment. The act does not expressly declare, and its language strictly interpreted does not imply, that a writing shall be necessary, and that an assignment not in writing shall be void. But it is reasonable to suppose that, in enacting this provision, Congress intended to regulate the mode of transferring copyright, and to make a writing essential to a valid assignment. And the courts may construe the statute in accordance with this intent, rather than follow the strict meaning of the language used.

The question, therefore, as to the form of assignment remains for judicial determination. But whatever the law may be declared to be in the case of assignments made after publication, the statute cannot rightly be held to apply to transfers of literary property made before publication. In such case, the form of assignment is governed by the common law, which, as has been shown, recognizes the validity of parol transfers.²

Transmission by Bequest and in Case of Intestacy. — By section 4952, copyright is secured to the executors or administrators of the owner. It may, therefore, be transmitted by

¹ *Webb v. Powers*, 2 Woodb. & M. 497, 510. This case was decided under the act of 1834, whose governing clause was the same in effect as that contained in the statute now in force.

² See *ante*, p. 104.

bequest; and there seems to be no good reason why, in case of intestacy, it will not pass to heirs without the necessity of a writing.¹

In Case of Bankruptcy. — The question whether copyright will pass from a bankrupt to his assignee without a writing does not appear to have been directly adjudicated. In *Mawman v. Tegg*, where it appeared that the author, who was one of the original owners and publishers of a work, had gone into bankruptcy, and his copyright had passed to assignees, from whom it was bought by the plaintiffs, Lord Eldon said: "Whatever question there may be in some cases, whether an interest in copyright does or does not pass without writing, it would, I apprehend, be difficult to maintain that there must be an instrument in writing between the bankrupt and his assignees."²

It has been held that statutory copyright must be in existence before it can be assigned in law.³ But an agreement may be made to assign at a future time;⁴ in which case an equitable title may vest in the assignee.⁵ So the owner's common-law rights may be assigned before publication; in which case the statutory copyright may be secured by the assignee.⁶

¹ In *Latour v. Bland*, Abbott, J., said, that under the statute of Anne, which was silent concerning the transmission of copyright by bequest and in case of intestacy, "if the author died without assigning his copyright, the interest would go to his heirs." 2 Stark. 385. *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402, was a case in which copyright had been transmitted to heirs; but whether by bequest or otherwise does not appear from the report.

² 2 Russ. 392. *In re Curry*, the Irish Commissioner in Bankruptcy expressed the opinion that copyright would pass to the bankrupt's assignee without a writing. 12 Ir. Eq. 391, 392. See also the views of Lord Ivory, *ante*, pp. 314, 315, and *Stevens v. Benning*, 1 Kay & J. 168, on ap. 6 De G., M. & G. 223.

³ *Colburn v. Duncombe*, 9 Sim. 151; *Sweet v. Shaw*, 3 Jur. 217; *Pulte v. Derby*, 5 McLean, 328; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402, 414.

"It is true," said Vice Chancellor Shadwell, in *Sweet v. Shaw*, "not only with respect to an assignment, but also with respect to a lease, as Littleton points out, that there cannot be a release of a future right, and in consequence, there cannot be an assignment of any thing that does not now exist." 3 Jur. 219.

In *Little v. Gould*, 2 Blatchf., the contract between the Secretary of State of New York and the plaintiffs had reference to matter not in existence, and it was declared to be an assignment of copyright. The equitable title clearly passed to the plaintiffs. The court seems not to have expressly considered the question of the legal title.

⁴ *Gould v. Banks*, 8 Wend. (N. Y.) 562; *Leader v. Purday*, 7 C. B. 4.

⁵ *Sims v. Marryat*, 17 Q. B. 281; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402.

⁶ See *ante*, pp. 238-242.

Form of Written Assignment. — No particular form of writing has been prescribed as essential to make a good assignment. There appears to be no reason why any writing may not be sufficient which clearly expresses that an assignment of the copyright is made for a good consideration. It has been held in two English cases that a receipt for the purchase-money is not a valid assignment of the copyright. But in one it appeared that the receipt had been destroyed, and the plaintiff denied that he had made an assignment to the defendant.¹ And in the other the receipt had reference to the sale of the American copyright alone;² moreover, the decision was rendered before the doctrine of *Davidson v. Bohn*, that two witnesses are necessary to a valid assignment, had been overruled. In the Scotch case of *Jeffreys v. Kyle*, Lords Ivory³ and Wensleydale⁴ expressed the opinion that a receipt is sufficient as an assignment.

There seems to be no reason why the same writing may not serve as a receipt for the purchase-money and an assignment of the copyright.⁵ But, to operate as an assignment, it would doubtless be necessary that the writing should contain the agreement itself by which the copyright has been passed. When the agreement is expressed in one paper, and the payment of the money acknowledged in another, the former, and not the latter, is obviously the assignment. And not unfrequently the money for the copyright is paid, and a receipt given, on an agreement that the assignment shall be made at some future time. In this case, no transfer is effected when the receipt is passed; and a writing which shows that such was the agreement cannot operate as a legal assignment.⁶

In *Cocks v. Purday*, a sale made by letter was held, under the circumstances, to be a valid transfer.⁷

¹ *Latour v. Bland*, 2 Stark. 382.

² *Lover v. Davidson*, 1 C. B. n. s. 182.

³ "If there is not here," said Lord Ivory, "an express assignation, there is certainly an implied assignation, corroborated by the writing in this lady's book, in which she notes the disposal of her copyrights." 18 Sc. Sess. Cas. 2d ser. 911.

⁴ 3 Macq. 617.

⁵ For the effect which a receipt may have on the agreement of the parties, see *Howitt v. Hall*, 6 L. T. n. s. 348; *Strahan v. Graham*, 10 L. T. n. s. 87, on ap. 17 Id. 457.

⁶ *Colburn v. Duncombe*, 9 Sim. 151; *Sims v. Marryat*, 17 Q. B. 281; *Levi v. Rutley*, Law Rep. 6 C. P. 523.

⁷ 5 C. B. 860. See this case considered *ante*, p. 313.

In *Lacy v. Toole*, which was an action against the defendant for representing a play written by the plaintiff, the defence was that the latter was not the owner of the playright in the piece. A letter was produced in which the plaintiff, in reply to a letter from a third person, had written to the latter, "I accept the offer you therein make me, and agree to the conditions you propose for cancelling my debt to you; viz., to let you have my drama of *Doing for the Best*, in discharge of £10 of the sum due." The court expressed the opinion that this letter was a valid assignment, but left it to the jury to find whether the agreement was to transfer the property in the play, or simply to license its use. The verdict was in favor of the defendant, and the letter was accordingly held to amount to an assignment.¹

Sale of Stereotype Plates. — As the copyright in a work is entirely distinct from the property in the stereotype plates from which it is printed, a sale on execution of such plates gives to the buyer no right to print and publish copies of the work.² But when the owner of the copyright voluntarily sells

¹ 15 L. T. n. s. 512.

² *Stevens v. Cady*, 14 How. 528; *Stevens v. Gladding*, 17 Id. 447; *Carter v. Bailey*, 64 Me. 458. "The sole question is," said Mr. Justice Curtis, "whether the mere fact that the plaintiff owned the plate, attached to it the right to print and publish the map, so that this right passed with the plate by a sale on execution. And upon this question of the annexation of the copyright to the plate it is to be observed, first, that there is no necessary connection between them. They are distinct subjects of property, each capable of existing, and being owned and transferred, independent of the other. It was lawful for any one to make, own, and sell this copperplate. The manufacture of stereotype plates is an established business, and the ownership of the plates of a book under copyright may be, and doubtless in practice is, separated from the ownership of the copyright. If an execution against a stereotype founder were levied on such plates, which he had made for an author and not delivered, the title to those plates would be

passed by the execution sale, and the purchaser might sell them, but clearly he could not print and publish the book for which they were made. The right to print and publish is therefore not necessarily annexed to the plate, nor parcel of it.

"Neither is the plate the principal thing, and the right to print and publish an incident or accessory thereof. It might be more plausibly said that the plate is an incident or accessory of the right; because the sole object of the existence of the plate is as a means to exercise and enjoy the right to print and publish. Nor does the rule that he who grants a thing, grants impliedly what is essential to the beneficial use of that thing, apply to this case. A press, and paper, and ink are essential to the beneficial use of a copperplate; but it would hardly be contended that the sale of a copperplate passed a press, and paper, and ink, as incidents of the plate, because necessary to its enjoyment.

"The sale of a copperplate passes the right to such lawful use thereof as the purchaser can make, by reason of the

the plates, the rights acquired by the buyer are to be determined by the intention of the parties. "What rights would pass by such a sale," said Mr. Justice Curtis, "would depend on the intentions of the parties, to be gathered from their contract and its attendant circumstances. In this case, the owner of the copyright made no contract of sale, and necessarily had no intention respecting its subject-matter."¹

The opinion has been expressed *obiter* by the Supreme Court of the United States that copyright is not subject to seizure and sale on execution,² but that it may be reached by a creditor's bill.³

ownership of the thing he has bought ; but not the right to a use thereof, by reason of the ownership of something else which he has not bought, and which belongs to a third person. If he has not acquired a press, or paper, or ink, he cannot use his plate for printing, because each of these kinds of property is necessary to enable him to use it for that purpose. So, if he has not acquired the right to print the map, he cannot use his plate for that purpose, because he has not made himself the owner of something as necessary to printing as paper and ink, or as clearly a distinct species of property as either of those articles. He may make any other use of the plate of which it is susceptible. He may keep it till the limited time during which the exclusive right exists shall have expired, and then use it to print maps. He may sell it to another, who has the right to print and publish ; but he can no more use that right of property than he can use a press, or paper, which belongs to a third person. . . .

"For these reasons, as well as those stated in 14 How. 528, our conclusion is, that the mere ownership of a copper-plate of a map, by the owner of the copyright, does not attach to the plate the exclusive right of printing and publishing the map, held under the act of Congress, or any part thereof ; but the incorporeal right subsists wholly separate from and independent of the plate, and does not pass with it by a sale thereof on execution." *Stevens v. Gladding*, 17 How. 452.

¹ *Stevens v. Gladding*, 17 How. 452. See also *Fullarton v. M'Phun*, 10 Sc. Sess. Cas. 2d ser. 219.

² "There would certainly be great difficulty," said Mr. Justice Curtis, "in assenting to the proposition that patent and copy rights held under the laws of the United States are subject to seizure and sale on execution." Not to repeat what is said on this subject in 14 How. 531, it may be observed that these incorporeal rights do not exist in any particular State or district ; they are coextensive with the United States. There is no act of Congress, or in the nature of the rights themselves, to give execution anywhere, so as to subject them to the process of courts having jurisdiction limited by the limits of States or districts. That an execution out of the Court of Common Pleas for the county of Bristol, in the State of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island or New York, will hardly be pretended. That by the levy of such an execution the entire right could be divided, and so much of it as might be exercised within the county of Bristol sold, would be a position subject to much difficulty. These are important questions, on which we do not find it necessary to express an opinion, because in this case neither the copyright, as such, nor any part of it, was attempted to be sold." *Stevens v. Gladding*, 17 How. 451. See also *Stevens v. Cady*, 14 Id. 531.

³ "No doubt," said Mr. Justice

RENEWAL OF COPYRIGHT CONSIDERED WITH REFERENCE TO
ASSIGNMENT.

The American statute now in force grants copyright absolutely for twenty-eight years, and provides that the author if living, or his widow or children if he be dead, shall have the same exclusive right for the further term of fourteen years.¹ The act of 1831 was to the same effect.² The question arises, whether an assignment of copyright made under either of these statutes divests the author, or his widow and children, of the right to the second term of protection thus provided for, and whether the assignee becomes vested with that right. This question cannot arise in England, because the statute of that country does not provide for such extension.³

Author may Divest Himself and Family of Right to Renewal.—It may be claimed that the provision of the American statute above referred to was intended for the personal benefit of the author or of his family. It is reasonably clear that the copyright for the additional term will vest only in the author, if he be living. But there appears to be no reason why he may not divest himself of the right thus reserved for him, either by parting absolutely with his entire interest in a work, or by an agreement to convey the copyright for the additional term when it shall be secured. In the former case, he has no interest in the work, and cannot rightly claim the additional privilege guaranteed to him by the statute. In the latter case, he is bound by his agreement to transfer to another the right when it shall be secured to him. The principle is the same in case the author be not living at the end of the first term. Then the

Nelson, "the property may be reached by a creditor's bill, and be applied to the payment of the debts of the author, the same as stock of the debtor is reached and applied, the court compelling a transfer and sale of the stock for the benefit of the creditors. But, in case of such remedy, we suppose it would be necessary for the court to compel a transfer to the purchaser, in conformity with the requirements of the copyright act, in order to vest him with a complete title to the property."

Stevens v. Cady, 14 How. 531. See also Cooper v. Gunn, 4 B. Mon. (Ky.) 594.

¹ U. S. Rev. St. ss. 4953, 4954.

² ss. 1, 2; 4 U. S. St. at L. 436.

³ See Marzials v. Gibbons, Law Rep. 9 Ch. 518, as to the construction of section 4 of 5 & 6 Vict. c. 45, which provides for an extension of the copyright in books published before the statute was passed. See also Brooke v. Clarke, 1 Barn. & Ald. 396.

copyright for the additional term will vest only in his widow or children. But their rights are dependent on his. Their title is derived from him, and stands or falls with his. There must be a good foundation on which to rest their claim. If the author has parted with his absolute property in the work, and could not, if living, himself secure the copyright, it seems to be clear that his representatives are equally incapable of securing it, for the reason that the work does not belong to them. So, when he has bound himself to assign his future term, there is no reason why such agreement should not be equally binding on them after his death, unless there is in it some condition or other circumstance to warrant a different construction. The provision under consideration was, doubtless, intended to secure to the author and his family a privilege which is not given directly to an assignee; but it is not reasonable to suppose that the object of the statute was to reserve to the author or his family any rights with which he has voluntarily parted, and for which he has received and enjoyed the consideration.¹

Effect of Transfer before Publication on Renewal.—When the transfer is made before publication, the assignment is not of the statutory copyright, because that is not then secured, and does not exist.² When an author has conveyed all his right, title, and interest in a manuscript, the assignee becomes the absolute owner, and may secure to himself the copyright for the term of twenty-eight years. The author, having parted with his entire property, can rightly claim no further interest in it, and has nothing on which to base a claim for copyright during the additional term of fourteen years provided for an author, his widow or children. But in transferring the exclu-

¹ The 8 Anne, c. 19, after granting copyright for an absolute term of fourteen years, provided, section 11, "that after the expiration of the said term of fourteen years the sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of fourteen years." In *Carnan v. Bowles*, 2 Bro. C. C. 80, where it appeared that a general assignment of the author's interest in a work had been made, it was contended by counsel that the

copyright for the absolute term alone had passed, and that the contingent term was intended by Parliament as a "personal bounty to the authors only." The court held that the author had conveyed all his interest in the copyright, the contingent as well as the absolute term. To the same effect is *Rennet v. Thompson*, cited in *Carnan v. Bowles*, *Ibid.* 81.

² *Pulte v. Derby*, 5 McLean, 328; *Paige v. Banks*, 7 Blatchf. 152, on ap. 18 Wall. 608.

sive right to publish his manuscript, the author may limit the duration of that right in the assignee to twenty-eight years, and reserve to himself all further rights. In this case, also, the assignee may secure, and will be the owner of, the statutory copyright for twenty-eight years; but at the end of that period the author, or his widow or children, becomes entitled to secure the copyright for the further term of fourteen years.

Rights of Parties Determined by Agreement.— Whether the entire or a limited property in the work thus passes from the author to the assignee depends on the agreement made by them. If that is precise and clear, the respective rights of the parties to it are easily determined. But not unfrequently the agreement is expressed in such words that it is doubtful whether the entire or a limited interest was intended to be conveyed. Its meaning then becomes a question for judicial construction. An absolute sale of a manuscript, an assignment of all right, title, and interest in it, an agreement that the assignee shall have for ever the exclusive right of publication, would naturally, in the absence of any thing to the contrary, be construed as a transfer of the entire property. But when “the copyright” is assigned, it may admit of doubt whether the parties had in view the statutory term of twenty-eight years, which is the only term which the statute gives to an assignee, or whether by the word copyright was meant the author’s entire interest in the work.¹

Absolute Assignment before Publication gives Unlimited Right to Publish.— In *Paige v. Banks*, it had been agreed that Alonzo C. Paige, the reporter of the New York Court of Chancery, in consideration of \$1,000 to be paid for each volume of manuscripts, “shall and will furnish the said Gould & Banks,

¹ In *Rundell v. Murray*, it appeared that the plaintiff had given to the defendant the right to publish a manuscript, without any limitation as to time, and at the end of fourteen years claimed the copyright for the contingent term provided for by the statute of Anne. Lord Eldon said, “I conceive that an author will not be taken to have assigned his contingent right in case of his surviving fourteen years, unless the assignment is so expressed

as to purport to pass it; but I have been at a loss throughout the argument to understand what difference the expiration of that term can make in this case.” Jac. 315. Without deciding in whom the copyright was, but considering that the plaintiff had given an unconditional right to publish, and had acquiesced in the publication for fourteen years, the Chancellor dissolved the injunction which had been granted.

in manuscript, the reports of the said court for publication, and that the said Gould & Banks shall have the copyright of said reports to them, and their heirs and assigns for ever." The copyright was entered in the name of the publishers. At the end of twenty-eight years the author took the necessary steps to secure to himself the copyright for the further term of fourteen years; and after his death his executors sought to enforce that right against the defendants, who also had entered in their own names the copyright for the same term. The agreement was made when the act of 1790 was in force, under which copyright could not last longer than twenty-eight years. The additional term of fourteen years was provided for by the statute of 1831, which was passed after the agreement had been made. For the plaintiffs, it was contended that the words in the contract, that the publishers "shall have the copyright of said reports," were to be construed as limiting the transfer to the copyright known to the law at the date of the contract; viz., for twenty-eight years. The Supreme Court of the United States, affirming the judgment of the Circuit Court,¹ held that the agreement was for an unlimited publication, and that the publishers had acquired, as against the author, the perpetual right to publish and sell the work. Hence, the latter had for ever barred himself from interfering with the right of the former to publish.²

¹ 7 Blatchf. 152.

² 13 Wall. 608. The contract was thus construed by Mr. Justice Blatchford in the Circuit Court: "It is to be noted, in respect to this agreement, that Gould & Banks are not limited by it to the publication of any specified number of copies of each volume. Mr. Paige is to furnish the reports in manuscript, for publication. The publication is to be made by Gould & Banks. The number of copies to be published of each volume is unrestricted. Mr. Paige is to be paid one thousand dollars for each volume published. The publication spoken of everywhere in the agreement is the publication of a volume. When such volume is once published, Mr. Paige is to have, within six months after the publication thereof, that is, within six months after the first printed copy is made public, the

one thousand dollars. No matter how many copies of the volume shall be, after that, printed or sold by Gould & Banks, Mr. Paige is never to have any more from them, as compensation, in respect of such volume, than the one thousand dollars. These provisions clearly give to Gould & Banks, as against Mr. Paige, the perpetual right to print, publish, and sell copies of such first volume, without giving to Paige any further compensation, in respect thereof, beyond the one thousand dollars, unless some other clause in the agreement restricts such right on the part of Gould & Banks.

"It is claimed that such right is restricted by the provision that Gould & Banks shall have the copyright of the reports to them, and their heirs and assigns for ever. It is contended that, under that provision, the whole agree-

The court did not express an opinion as to whether the copyright entered by the author for the term of fourteen years was

ment is to the effect that Gould & Banks are to have, as against Mr. Paige, the exclusive right to publish and sell the volumes of reports no longer, at most, than during the term known to the law, under the act of 1790, at the date of agreement, as the term for which a copyright could be obtained; that is, twenty-eight years, or not beyond the 5th of January, 1858. But the provision in respect to copyright was inserted in the agreement for the sole purpose, manifestly, of making it clear that Gould & Banks were to be understood to be such assignees of Mr. Paige, as the author of the books, as could, under the act of 1790, secure to themselves a copyright. There is no provision in the agreement for the taking out of a copyright by Mr. Paige, and for the transfer thereof to Gould & Banks. The provision in the agreement in respect to copyright cannot be held to cause the agreement to confer any less rights on Gould & Banks, if such provision be availed of by them, than if they do not avail themselves of it. If they had not chosen to take out any copyright, as proprietors, of any volume of the reports, they would have had, as against Mr. Paige, the perpetual right to print, publish, and sell the reports. If they had not chosen to avail themselves of the provision of the agreement in regard to copyright, in respect to the first volume, the construction of the agreement would have been in no manner dependent upon the existence or contents of such provision. Nor can it be dependent thereon when, as against others than Mr. Paige, Gould & Banks have availed themselves of the privilege of copyrighting such volume." 7 Blatchf. 155.

In delivering the opinion of the Supreme Court, Mr. Justice Davis said: "Independent of any statutory provision, the right of an author in and to his unpublished manuscripts is full and complete. It is his property,

and, like any other property, is subject to his disposal. He may assign a qualified interest in it, or make an absolute conveyance of the whole interest. The question to be solved is, Do the terms of this agreement show the intent to part with the whole interest in the publication of this book, or with a partial and limited interest? . . . It is insisted by the appellants that a just interpretation confines the agreement to a mere assignment of the interest in such copyright, as is provided for in the act of 31st May, 1790; that this was the law in force when the contract was entered into; that the fourteen years therein provided for, with the right to a prolongation of fourteen years more, is all that the publishers at most are entitled to; and that they are excluded necessarily from the benefit of the provisions conferred by the act of the 3d February, 1831, granting to authors an additional extension of fourteen years. In our view this is too narrow a construction. The fair and just interpretation of the terms of the agreement indicate unmistakably that the author of the manuscript, in agreeing to deliver it for publication at a stipulated compensation, intended to vest in the publishers a full right of property thereto. The manuscript is delivered under the terms of the agreement 'for publication.' No length of time is assigned to the exercise of this right, nor is the right to publish limited to any number of copies. The consideration is a fixed sum of one thousand dollars. Whether one or one hundred thousand copies were published, the author was entitled to receive, and the publishers bound to pay, this precise amount.

"As between the parties to the agreement the absolute interest was conveyed by the stipulation of Paige, that he would furnish the manuscript for publication. Paige could no longer do any act after such delivery for publication inconsistent with the absolute ownership of the publishers. But it

valid as against others than the defendants. But there can be little doubt that it was void, and such is the effect of the decision. Nor was it necessary to inquire into the validity of the copyright, which had been taken out in the name of the defendants for the same term. But it has been shown elsewhere that an assignee is not entitled to secure copyright for this additional term.¹

Absolute Assignment of Copyright held to Carry Future Play-right. — In an English case, it appeared that a dramatist had assigned his copyright in a farce to be the “absolute property” of the assignee, who published it and became the owner of the statutory copyright. There was then no statutory right of representation; but afterward the 3 & 4 Will. IV. c. 15, was passed, giving to the author or his assignee the sole liberty of performing a dramatic composition. It was held that the author’s entire interest had passed to the assignee by the assignment, and that the latter, therefore, was entitled to the exclusive right of representation conferred by the statute above mentioned.²

Effect of Assignment after Publication on Renewal. — After

was proper, for the protection of the publishers, that they should be in position to assert the remedies given by the law against intruders; and it is to this end it is added in the agreement, ‘and the said Gould & Banks shall have the copyright of said reports to them, their heirs and assigns for ever.’ It is not covenanted that the publishers should take out the copyright, nor is there any express agreement for an assignment to them by Paige, if he should take it out. Undoubtedly, the provision that the publishers ‘should have the copyright’ would authorize them to apply for it; and, if Paige had taken it out in his own name, it would have inured to their benefit. But, as between Paige and the publishers, the rights of the latter could not be estimated differently, whether they had or had not availed themselves of the provisions of the act.” 13 Wall. 614.

See also *Cowen v. Banks*, 24 How. Pr. 72, where the court expressed the opinion that the written agreement,

“if there were nothing else in the case,” would be rightly construed as limiting the interest assigned to the copyright for the first term of fourteen years given by the act of 1790. But the author having testified in a previous action that in making the agreement his intention was to convey his “whole interest in the copyright of the work,” this testimony was admitted as evidence in the present case; and the court held that the assignees had acquired the author’s contingent interest in the second term of fourteen years given by the act of 1790, and that they were entitled to become the absolute owners of this term, under section 16 of the act of 1831. It was ordered that the contract be reformed so as to conform to the intention of the parties.

¹ See *ante*, p. 261.

² *Cumberland v. Planché*, 1 Ad. & El. 580. For the statutory provisions now in force in England concerning the transfer of playwright, see Chap. XV.

a book has been published, and within twenty-eight years from the time of publication, the only copyright in existence, and hence the only one which can be assigned, is that secured for twenty-eight years. The copyright for the second term of fourteen years cannot be assigned before it has been secured, and it cannot be secured until the first term has ended. I have already endeavored to show that the author may bind himself by an agreement to assign it when it shall have been secured, and that such agreement may be made binding on his personal representatives; also, that he may make such assignment of his rights in a published work as will bar him and his family from claiming for themselves the copyright for the future term of fourteen years.¹ What effect an assignment which has been made after publication will have on the future rights reserved for the author by the statute will depend, as in the case of a transfer made before publication, on the nature of the agreement. For the author may part with every right and interest which he has in the work, or he may transfer the existing statutory copyright alone. And the question in each case is, whether the language of the agreement is comprehensive enough to embrace all rights in the work, or whether it properly applies only to the existing statutory copyright. An assignment of the "copyright" would naturally have the latter restricted meaning, unless there is something else to show that a greater interest was intended by the parties to be passed. Thus, where the author had assigned "the copyright" of one book, and, with reference to another, had agreed that "the copyright shall be considered the joint and equal property" of himself and the assignee, the Circuit Court of the United States held that the assignment did not extend beyond the first term of fourteen years which, at the time the agreement was made, had been secured under the act of 1790 then in force; and that no interest was passed in the second term of fourteen years given by that statute, nor in the term of fourteen years created for the benefit of the author by the act of 1831, which was in force when the cause of action arose.²

¹ See *ante*, p. 326; also, *Paige v. Banks*, 7 Blatchf. 152, on ap. 13 Wall. 608.

² *Pierpont v. Fowle*, 2 Woodb. & M. 41-45. "In respect to both copyrights, also," said Mr. Justice Wood-

Assignee cannot make Renewal. — Section 4954 of the Revised Statutes, which provides for a renewed term of copyright, makes no mention of an assignee. The view has been elsewhere expressed that the copyright for this term will not vest *ab initio* in an assignee, but only in the author, his widow or children.¹ Hence, when an author has assigned his entire interest in a work, and has thereby or otherwise barred himself and his family from securing the copyright for the second term, the assignee is powerless to make the renewal for his own benefit.

Author may Assign Renewed Term. — But when the copyright has been acquired by the person entitled to secure it, can it be transferred to an assignee? This question has not been judicially determined.² The object of the legislature manifestly was to create an additional right for the express benefit of the author and his family. This object would not be promoted, but rather defeated, by denying to him and them the power to transfer the right after it has been secured. The value of property is increased by the capacity of the owner to alienate it. Moreover, the provision of the statute, that “copyrights shall be assignable,”³ doubtless applies to those granted for fourteen years not less than to those for twenty-eight years. The sound construction, then, would seem to be that the copy-

bury, “the complainant conveyed *eo nomine*, not a term of twenty-eight years, nor one as long as he should be entitled, nor all his interest of every kind in the book or its manuscript; but simply, as to the first, ‘the copyright of said book,’ and, as to the last, ‘the copyright’ of it ‘shall be considered the joint and equal property of said P. and F.’ The only copyright then existing or taken out for either was for fourteen years only. One contract was dated July 21, 1823, and one July 12, 1827. That copyright which had been then taken out was the subject-matter of the contracts. No words are used looking beyond that; no consideration was paid or talked of beyond that. There was no mutuality beyond that; for the payment of the last was made in another copyright, in another book, where the

author might not secure the first term, or, if he did, might not be willing to renew the copyright. The renewal of the copyright in either of these was then uncertain, and not, to appearance, contemplated by either side. When the assignment was made, it doubtless referred to what was in existence, and not to any future contingency, nor to what was personal for the author, if spared to old age, nor for what any compensation was specially either asked or made.” *Ibid.* 42. See *Cowen v. Banks*, 24 How. Pr. 72.

¹ See *ante*, p. 261.

² In *Paige v. Banks*, as has been shown, *ante*, p. 328, it appeared that the copyright for the additional term of fourteen years had been renewed by the assignees. But the court was not called upon to inquire into its validity.

³ U. S. Rev. St. s. 4955.

right for the renewed term of fourteen years is capable of being assigned after it has been secured.

LIMITED ASSIGNMENT.

The question has been raised whether copyright can be divided, and any part of it assigned. The English statute provides for the registration by the owner of a copyright "or of any portion of such copyright," and enacts that such registered owner, by entry in the registry, may assign "his interest, or any portion of his interest" in the copyright.¹ The American statute is silent on this point.

One or More of Several Rights in a Work may be Assigned. — It is clear that, without destroying the unity of the copyright, a qualified interest, or certain rights embraced in it, may be assigned. Thus, the owner may make to one or more persons an absolute conveyance of any part of his interest in the whole. In this case, the copyright becomes the undivided property of joint owners. The exclusive right of publication and sale vests, not in one independently of the others, but in all. So, also, statutory copyright embraces several rights which, though created and conferred by the same statute, may be regarded as independent and distinct rights, capable of being separately owned and used by different persons. Thus, the statute gives to the owner of a dramatic composition the exclusive right to print it, and the sole liberty of performing it. Either of these rights may be absolutely assigned independently of the other;² and in England this fact is recognized by the statute. Whether one or both of these rights pass by the assignment will depend on the intention of the parties, as expressed in their agreement.³ Again, in the United States, an author, in securing copyright in a literary composition, may reserve to himself the exclusive right to translate or dramatize it; and, as has been elsewhere maintained,⁴ he has the exclusive right, without special reservation, to abridge it. The owner may,

¹ 5 & 6 Vict. c. 45, s. 13. Referring to this provision, Mr. Justice Maule said, that the author or owner "may assign the copyright to less than the full term." *Davidson v. Bohn*, 6 C. B. 458.

² *Roberts v. Myers*, 13 Monthly Law Reporter, 396.

³ See Chap. XV., Transfer of Playright.

⁴ See Chap. IX.

doubtless, assign any of these rights without parting with the others, or the original copyright. In this case, also, the copyright in the original, that is, the right to publish and sell it, continues whole. The author parts with the right, which is embraced in the original copyright, to translate, dramatize, or abridge. Another may be thus clothed with authority to publish a translation, dramatization, or abridgment; but such production, when published, is protected by a new copyright, independent of that which has vested in the original work. An absolute assignment of the copyright would doubtless carry the right to translate, dramatize, or abridge the work, unless such right is specially excepted in the assignment. If a translation, dramatization, or abridgment has been published and copyrighted, no interest in the copyright of such publication could pass by a transfer of the copyright in the original work.

Copyright Indivisible as to Locality.—There can be little doubt that copyright is indivisible as to locality. The property is of such a nature that it cannot be practically divided among independent owners, so that each may have the exclusive right of publication and sale for a distinct part of the same country. In the United States, for instance, it would be obviously impracticable for one person to exercise the exclusive right of publishing and selling a book in New England, another in the Southern, and another in the Western, States. On this principle, the persons claiming to be exclusive publishers of the same book might be as numerous as the States. Any number of persons in the same or in different States may be authorized to publish contemporaneously. But in that case there is no assignment. The author remains the absolute owner of the copyright, and each publisher is a mere licensee, without power to prevent publication or sale by any other person.¹

Copyright may be Assigned for One or More of Several Countries.—This difficulty does not arise, nor is the principle the same, when the right of publication for an entire country is transferred. In *Jefferys v. Boosey*, where it appeared that Ricordi, of Milan, who was the owner of all rights in Bellini's Opera, *La Sonnambula*, had assigned to Boosey the right of publication

¹ See *Keene v. Wheatley*, 9 Am. Law Reg. 46.

in Great Britain, Lord St. Leonards, Lord Chief Baron Pollock, and Mr. Baron Parke expressed opinions that copyright is indivisible as to locality, and that there cannot be an assignment of a part of the right for a particular country or a part of a country.¹ But a majority of the judges who advised the House of Lords were of opinion, and the effect of the judgment is, that the owner might assign the exclusive right of publication in Great Britain, and reserve to himself the Austrian copyright.² So an American author, who on certain conditions can secure a copyright for his work both in the United States and in England, may make a valid assignment of the English copyright to one person, and either himself retain or assign to another the American copyright.³ But in such case there is no division of copyright. The copyright granted by one government is wholly distinct from that conferred by another. When protection is secured for the same work in different countries, there is a separate and independent copyright for each country. Each copyright is a unit, and may be absolutely assigned independently of another; and no inconvenience will necessarily result therefrom.⁴

¹ "Now, it there is one thing," said Lord St. Leonards, "which I should be inclined to represent to your Lordships as being more clear than any other in this case, it is, that copyright is one and indivisible. I am not speaking of the right to license; but copyright is one and indivisible, or is a right which may be transferred, but which cannot be divided. Nothing could be more absurd or inconvenient than that this abstract right should be divided, as if it were real property, into lots, and that one lot should be sold to one man, and another lot to a different man. It is impossible to tell what the inconvenience would be. You might have a separate transfer of the right of publication in every county in the kingdom." 4 H. L. C. 992. See Views of Pollock, C. B., *Ibid.* 940; of Parke, B., *Ibid.* 933.

² The House of Lords decided that the English copyright was not valid, but on the ground that the author was a foreigner, and not in England at the

time of publication. Numerous cases might be cited, such as *D'Almaine v. Boosey*, 1 Y. & C. Exch. 288, and *Cocks v. Purday*, 5 C. B. 860, where a foreigner, retaining the copyright for his own country, had assigned the right of publication in Great Britain, and the validity of the English copyright was not questioned on the ground that the author's entire rights in the work had not been assigned.

³ See *Low v. Ward*, Law Rep. 6 Eq. 415; *Routledge v. Low*, Law Rep. 3 H. L. 100.

⁴ In *Jefferys v. Boosey*, where it appeared that the assignor, reserving to himself the Austrian copyright, had assigned the British copyright, Mr. Justice Crompton said: "It was suggested in argument that if the right was an entire right, it could not be divided, so, for instance, as to make an assignment of English copyright to one person for Yorkshire, and to another for Middlesex; and I think that in such case there would be great diffi-

Is Copyright Divisible as to Time? — Whether copyright is divisible as to time, so that it may be assigned for any period less than the full term, is a question not easily determined. It is clear that the owner of the copyright may transfer the exclusive right of publication for any limited time. But is the person who has acquired this right a licensee or an assignee? ¹ If the former, he has but an equitable title in the copyright, while the legal title remains in the owner. But an assignment must vest the assignee with a legal title to the copyright, and with the rights of ownership, at least during the time for which the assignment has been made. Is, then, the copyright for the entire term capable of division into two or more terms, so that the legal title to one part will vest in the assignee, and the legal title to the remainder continue in the assignor? Or must the legal title to the undivided whole pass from the assignor and vest in the assignee during the time for which the assignment is made; and, if so, does it return *per se* to the assignor at the end of that time? In other words, when an author has assigned his copyright for a limited time, is it necessary that it shall be assigned back in order to revest him with the legal title? These questions, which have not been judicially considered, are involved in so much doubt that no attempt will be here made to answer them.²

If, however, it should be held that the title as a whole passes to the assignee, he would be regarded as an owner for a limited

culty. In such a case as the present, however, I regard the right of the author to the English copyright as an entire thing under our municipal statutes; and as not being parcel of or derived out of any thing else." 4 H. L. C. 857.

¹ Such a transfer had been made in *Howitt v. Hall*, 6 L. T. N. s. 348; but the court did not determine whether it amounted to a limited assignment, or a mere license.

² It is my opinion that copyright is indivisible as to time, and that the entire legal title must either remain in the author or pass from him to the assignee. In the former case, the agreement would create not an assignment, but a license. In the latter case, the

assignor having become divested of the legal title, an assignment would, in my judgment, be necessary to revest him with it. In *Lawrence v. Dana*, 2 Am. L. T. R. N. s. 402, where it appeared that the copyright had been taken out for a limited purpose, by a person who was not the absolute owner, it was held that the legal title had vested in such person, and that an assignment was necessary to vest the absolute owner with it. But this is not strictly analogous to the case of a limited assignment such as is considered in the text; for the reason that, in *Lawrence v. Dana*, the absolute owner of the copyright had never been vested with the legal title.

time or purpose, and doubtless as holding the copyright in trust for the owner of the remainder of the term; and, if the title would not return *per se* to the latter when he became entitled to it, a court of equity, if called upon, would decree a retransfer to be made.¹

May Limited Assignee Transfer Copyright? — The question may also arise, whether an assignee for a limited term may transfer the copyright to a third person. It would seem to be clear that he cannot make a valid assignment for a longer time than that during which the right is to continue in him. If the copyright is divisible, so that the legal title is in the assignee for a part of the term and in the author for the remainder, there seems to be no reason why the former may not transfer his title. But, if the title for the entire term vests in the assignee, he would doubtless be considered as holding it in trust for the absolute owner; and in that case it may be questioned whether he has the power to transfer it to a third person.²

RIGHTS OF ASSIGNOR AND ASSIGNEE AS TO SELLING COPIES.

The Law as Construed in England. — In England, it has been held, 1, that, after the copyright has been assigned, the assignor has the right to sell copies printed before the assignment was made; 2, that an assignee for a limited term is entitled, after the expiration of that term, to continue the sale of copies printed during the term.

In *Taylor v. Pillow*, where it appeared that the defendant had continued to sell copies of a song after he had sold the copyright to one of the plaintiffs, Vice-Chancellor James said: "I was at first in favor of the plaintiff's view; but, on looking at the copyright act, 5 & 6 Vict. c. 45, I find that the definition given of copyright is, 'the sole and exclusive liberty of print-

¹ *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402, 417. See also *Hazlitt v. Templeman*, 13 L. T. n. s. 593; *Stevens v. Cady*, 14 How. 531. See *ante*, p. 261, note 1.

² In *Pulte v. Derby*, where the defendant was in possession of the legal title, the court expressed the opinion *obiter* that he could not without the con-

sent of the owner transfer it to a third person. 5 McLean, 335. But in this case the defendant was not an assignee, but had taken out the copyright in his own name, merely for the purposes of a contract which he had made with the author for the publication of two editions of a book.

ing or otherwise multiplying copies ;' and, unless there is some stipulation to the contrary in the conditions of sale, the vendor of a copyright may print any number of copies up to the time of the sale, and retain and sell such copies after disposing of the copyright." ¹

In *Howitt v. Hall*, it appeared that the defendants, having bought "the copyright" for four years in a book of which the plaintiff was the author, were still continuing, several years after the end of that term, to sell copies which they had printed during the four years. The court, in refusing to enjoin such sales, held that the purchase of the copyright carried the right of printing; and that, while this right reverted to the author at the end of four years, the publishers were entitled to sell, after the expiration of that term, all copies which had been printed in good faith during the term. "The copyright acts," said Vice-Chancellor Wood, "were directed against unlawful printing (8 Anne, c. 19, and 5 & 6 Vict. c. 45, s. 15); and when, as in this case, the defendant had acquired the right of lawfully printing the work, he was at liberty to sell at any time what he had so printed." ²

In United States, may Assignor Sell Copies after Assignment? — The doctrine affirmed in the two cases just cited cannot, in my judgment, be rightly adopted in this country. Copyright is not defined by the statute; but its meaning is expressed in the section which confers the right. This declares that the author or owner of a book shall "have the sole liberty of printing, reprinting, publishing, . . . and vending the same." ³ Copyright, as here secured, is the right, not only of exclusive printing, but also of exclusive sale. The legislature further declares the right of exclusive sale to be an essential part of copyright, by expressly prohibiting unlawful selling as well as unlawful printing. ⁴ So essential to the true meaning of the

¹ Law Rep. 7 Eq. 420.

² 6 L. T. N. S. 348. See also *Murray v. Heath*, 1 Barn. & Ad. 804.

³ U. S. Rev. St. s. 4952.

⁴ *Id.* s. 4964. If the statute secured only the right of printing, and prohibited only unlawful printing, it is obvious that copyright would not be violated by the unauthorized importing

and selling of copies reprinted abroad. The statute cannot prevent unlicensed printing in a foreign country. But it protects the owner against piracy from this source, by giving him the exclusive right of sale, and by expressly prohibiting the importing of copies without his consent, and the sale of such copies.

word is the act of selling, that statutory copyright does not begin until the book is first offered for sale to the public.¹ To limit the sense of the word to printing is to change its true meaning and abridge the right. When, therefore, the owner sells or assigns the copyright in a work, he conveys the exclusive right to print and the exclusive right to sell that work. Obviously, the right of sale is not exclusive in the assignee, and he has not become vested with the copyright, for which he has contracted, as long as the assignor is at liberty to sell copies. When the assignee acquires the copyright, he becomes vested with the exclusive right of printing and selling the work. The assignor is then wholly divested of any right to print or to sell; and he cannot sell a single copy of the work without invading the copyright which he has transferred.

It may be argued that the exclusive right of sale acquired by the assignee applies only to the copies printed by him after the assignment, and not to those printed before he came into possession of the copyright. But this view is contrary to the nature of copyright, which embraces the right to sell exclusively, not merely certain copies, but all copies of the work. When the copyright is assigned, the assignor grants the exclusive right to sell the work itself; and from that time the assignor and all other persons, without the consent of the assignee, are excluded from selling copies, no matter when or by whom printed. There is, however, this limitation to the assignee's exclusive right to sell: At the time of the assignment, various booksellers may have on hand copies of the work, which were bought before the copyright was transferred. Such copies are beyond the control of the assignor. The liberty to sell them is a right which vested before the assignment was made, and cannot be disturbed by any subsequent change in the ownership of the copyright. Hence, the assignee has no right to interfere with such sales, though made after the assignment. But a wholly different principle applies to the copies which the assignor has printed, but not sold. In parting with the copyright, he voluntarily parts with the right to sell such copies, and in effect covenants not to sell them.

¹ Copyright begins with publication, which takes place when the book is publicly offered for sale, or is given to the public.

May Assignee sell Copies after End of Limited Assignment? —
The same principle governs the rights of the parties to an assignment for a limited time. When the copyright is sold or assigned for a specified term, the assignee becomes vested with the exclusive right to print and to sell during that term, and the assignor parts with all rights both of printing and of selling. At the end of the term, the assignor becomes re-vested with the exclusive right of printing and of selling, and no right to print or to sell remains in the assignee. What the assignee receives from the assignor for a limited time, he is bound to return to him at the end of that time. What he receives is the exclusive right to print and to sell the work; what he must surrender is the exclusive right to print and to sell the work. And, as has been above shown in an analogous case, the right to sell, which reverts to the assignor, is exclusive, not merely with reference to the copies that may be printed by him after such reversion, but with reference to all copies of the work, excepting those held by persons who bought from the assignee while he was in possession of the copyright. The assignee, but not such buyers, are excluded from selling after the term of the assignment has ended.

It may be urged that the assignee may have a large stock of copies on hand at the end of the term; and that, unless he is free to sell them, he may be subject to heavy losses. The answer to this is, that he has not agreed for, paid for, or acquired the right to sell, except for a limited time. He must exercise his own judgment as to the number of copies which he can sell during that time. He prints at his own risk. If he prints more copies than he can sell, the fault is with him, and not with the assignor; and so he, and not the assignor, must bear the loss. Of course, as in the first case above considered, there may be an express or an implied agreement that the assignee shall have the right to sell whatever copies he may have on hand at the expiration of the term of the assignment.

I have thus endeavored to show what is the true interpretation of the law, when the copyright is assigned without any express or implied agreement as to the sale of copies. When such agreement has been made, the rights of the parties will be controlled by it.

English Decisions Questioned. — The judgments in *Taylor v. Pillow* and *Howitt v. Hall* were based on the ground that copyright, as defined by the statute, is the exclusive right of printing copies; that the statute is directed only against unlawful printing; and hence that the sale of copies, which have been lawfully printed, is not a violation of copyright. It is a question whether, on the point under consideration, the English statute in spirit, if not in letter, is not the same as the American; and whether, under the former as well as the latter, the true meaning of copyright is not the exclusive right of printing and selling. It is true that, by the statutory definition, English copyright is limited to printing; but it is not true that the statute is directed against unlawful printing alone. It prohibits unlawful importing and selling,¹ and thereby in effect secures the exclusive right of sale.

Author may not Reproduce Work after Assignment. — When an author has parted with his copyright in a work, he is not at liberty to reproduce substantially the same matter in another publication.²

Warranty of Title. — Where a person had sold in good faith the exclusive right of publishing a book for a term of years, and it afterward appeared that he had no title to the copyright, it was held that the representations which he had innocently made, that the copyright was in him, amounted to an express warranty of the title, and that he was liable to damages for a breach of that warranty.³

¹ 5 & 6 Vict. c. 45, ss. 15, 17, 23.

² *Rooney v. Kelly*, 14 Ir. Law Rep. n. s. 158; *Colburn v. Simms*, 2 Hare, 543.

³ *Sims v. Marryat*, 17 Q. B. 281. It appears that after Dr. Shebbeare had been enjoined (*Duke of Queensbury v.*

Shebbeare, 2 Eden, 329) from publishing Clarendon's History, which he had bought from Mr. Gwynne, he recovered damages against the latter for falsely representing that he had a right to print that work. See *Millar v. Taylor*, 4 Burr. 2330, 2397.

CHAPTER VII.

AGREEMENTS BETWEEN AUTHORS AND PUBLISHERS.

As the owner of the literary property in a work which he has created, the author may make of it any disposition he pleases. He may make an absolute assignment of the copyright, or an assignment for any limited term. He may convey a limited interest in the undivided copyright, and thereby make one or more persons joint owners with himself. Without parting with the ownership, or any part of it, he may confer upon another the right to use the work for a limited time, or for specified purposes; may license another to publish exclusively, or more than one to publish contemporaneously; may grant an irrevocable license to publish for a term, or a license revocable at will.

In ascertaining what rights the author has conveyed, the first point to be established is, whether the agreement made by him is an assignment of the copyright, or whether it is merely for a restricted use of the work. Assignments have already been treated. Here will be considered those agreements by which an author, without parting with the copyright, gives to a publisher certain privileges of publication and sale. In order to ascertain the respective rights of the parties under an agreement of this kind, it will be necessary to determine the duration or extent of the right given to publish, whether or not it is exclusive, and how the contract may be ended and the rights created by it annulled. The law on this subject may be best understood by reviewing the leading cases which have been decided.

Agreement for Publication of One Edition. — Number of Copies Specified. — In *Sweet v. Cater*, the plaintiff sought to restrain the defendants from publishing a work containing matter copied without authority from the tenth edition of Sir Edward Sug-

den's Treatise on the Law of Vendors and Purchasers, of which the plaintiff was the publisher. The rights of the plaintiff had been acquired under a written contract with the author, by which it was agreed that the former should print, at his own cost and in a certain style, twenty-five hundred copies of the tenth edition of this work, sell each copy at a named price, and pay to the author a specified sum for the privilege of publication. The defendants contended that, under this agreement, the title, equitable as well as legal, to the copyright was in Sir Edward Sugden, and that the plaintiff was a licensee, not exclusive, but merely to sell twenty-five hundred copies; and, therefore, that he had no right to prevent any other person from publishing the work. The court held that, while the legal title was in the author, the plaintiff had acquired an equitable title sufficient to give him a standing in a court of chancery. The injunction was granted on condition that the plaintiff would undertake to try his right at law; and Sir Edward Sugden, having refused to permit the action to be brought in his name, the defendants were ordered to admit at the trial that the plaintiff was the legal owner of the copyright in the tenth edition of the work.¹

The direct decision in this case was that the contract with the author gave to the plaintiff the right, while any of the twenty-five hundred copies published by him remained unsold, to restrain any person not claiming under the author from publishing the same work. But Vice-Chancellor Shadwell went further, and expressed the opinion that the plaintiff had acquired the exclusive right to sell twenty-five hundred copies; and that, until they should be sold, not even the author was at liberty to publish any copies of the work.²

¹ 11 Sim. 572.

² "Now by this contract," said the Vice-Chancellor, "there is an obligation which is binding on both parties. Sweet is to sell at a given price; and therefore Sir E. Sugden has bound himself to abstain from doing any thing which might at all interfere with the act which Sweet was to do. Suppose that, before the two thousand five hundred copies, which form the tenth edition, are sold, Sir E. Sugden (to put

a hypothetical case) should fancy that he had a right to sell another edition to another bookseller, with the immediate right of publication; I apprehend that this court would certainly restrain him from doing so, on this contract. It is not merely optional with Sweet whether he will sell or not; but he is bound to sell, and to sell in a given manner. It is most probable that, when Sir E. Sugden drew this agreement, he was looking forward to the

Agreement Indefinite as to Duration and Number of Copies. — Subsequent Editions, if called for. — Transfer of Rights of Publisher in Bankruptcy to Third Persons. — In *Stevens v. Benning*,¹ the contract between William Forsyth, the author, and Robert Saunders and William Benning, the original publishers, of a *Treatise on the Law relating to Composition with Creditors*, came up for judicial construction. The agreement was that the book should be published at the expense and risk of the publishers, and that the net profits should be divided equally between them and the author. Nothing was said about the copyright, the number of copies to be printed, or the absolute duration of the agreement. It was, however, agreed that, in case the first edition should be sold, “and a second or any subsequent edition of the said book be required by the public,” Forsyth should make the necessary revision, and Saunders & Benning should publish “the said second and every subsequent edition” on the same conditions agreed on for the original publication. It was further provided, that, in case any edition should not be entirely sold within five years after publication, the publishers might dispose of the unsold copies in such manner as they deemed most advisable, in order that

time when he might think it right to publish some subsequent edition; and he was taking care to impose an obligation on Sweet to sell; and, while he imposes that obligation, he is himself bound at the same time to perform his part of the contract, which is not to interfere with the sale of the book. I think that, upon the plain construction of this contract, Sweet has obtained a right in the copyright of the work, to the extent that he is to be at liberty to be the sole publisher of it until the whole edition, consisting of two thousand five hundred copies, shall be sold. He therefore is an assign of the copyright, in a limited sense.”
11 Sim. 578.

It appeared that some of the passages in the defendant's publication had been published in earlier editions of Sir Edward Sugden's work, as well as in the tenth; and, as to these, it was contended that the plaintiff had

no right to complain. On this point the Vice-Chancellor said: “But I do not think that that fact at all alters the case; for the entire copyright in all those prior editions was vested in Sir E. Sugden when he made the agreement with the plaintiff; and my opinion is that the effect of that agreement was to give to the plaintiff, as against Sir E. Sugden and all persons claiming under him, a right to insist that the matter contained in the tenth edition should not be published whilst he was performing his part of the contract, by selling that edition to the public. And, that being my view of the case, I think that, although the passages may be contained in some prior edition, yet, if they are contained in the tenth edition as well, the court ought to prevent their being copied.”
Ibid. 580.

¹ 1 Kay & J. 168, on ap. 6 De G., M. & G. 223.

the account might be "finally settled and closed." The first edition was published by Saunders & Benning in 1841. Afterward, John Kirton Gilliat succeeded Saunders in the firm, which now assumed the title of William Benning & Co., and in 1844 published a second edition of the work revised by the author. In 1851, William Benning was adjudged a bankrupt, and afterward his assignees and Gilliat assigned to Stevens & Norton the contract which had been made by Saunders & Benning with Forsyth. At the same time, about four hundred copies of the second edition of Forsyth's book were transferred to Stevens & Norton. In the mean time, William Granger Benning had published a third edition of the work revised by Forsyth, who was ignorant of the transactions by which Stevens & Norton claimed to have acquired their rights. The latter firm now sought to restrain the further publication of the book by W. G. Benning, and also applied for an account of profits.

Both Vice-Chancellor Wood, before whom the suit was first brought, and the judges on appeal, found great difficulty in determining the precise nature of the contract between Forsyth and Saunders & Benning, and the rights of the original parties under it.¹ They agreed, however, that it was not an assignment of the copyright. The Vice-Chancellor expressed the opinion that the first publishers were entitled, and were bound, to publish on the terms of the agreement as many

¹ Vice-Chancellor Wood regarded the contract as "a special kind of agency, under which the agents were bound to sell, and to take the risk of there being no profits upon themselves." 1 Kay & J. 175. But, in the following case of *Reade v. Bentley*, the same judge, in considering a like contract, remarked that the defendant was more than a mere agent of the plaintiff. "A mere agent," he said, "may be paid, as the defendant was to be paid, by a share of the profits: but a mere agent never embarks in the risk of the undertaking; and here the defendant took upon himself the whole expense and risk of bringing out the work. Clearly, therefore, the case is

something more than one of simple agency." 4 Kay & J. 662. Lord Justice Knight Bruce thought that whatever rights vested in Saunders & Benning, by virtue of the contract with Forsyth, they acquired "by way of joint adventure with him or of partnership with him." 6 De G., M. & G. 229. Lord Justice Turner expressed the opinion, that, if there was a partnership, it was "not in the copyright, but in the copies printed under the license contained in the agreement. In that case, the court has nothing to do with the question of partnership, except as regards the unsold copies." *Ibid.* 281.

editions as might be required by the public, and that during the existence of the contract they had the exclusive right of publication and of sale;¹ that the agreement was terminable by failure to comply with its material conditions; and that after its termination the author would not be at liberty to publish until the first publisher had sold the editions printed under the agreement.² It was, however, not necessary to

¹ "In the contract, however, no mention is made of copyright, which is a right so well known and defined that I should expect, if it was intended to part with it, the intention would have been clearly expressed. However, such an intention may be inferred; and it is argued that it must necessarily be inferred here, because Mr. Forsyth agreed that Messrs. Saunders & Benning should 'print, reprint, and publish' his work upon certain conditions; of which one was, that, if any further edition should be required, as soon as the first and subsequent editions were sold Mr. Forsyth would make all the necessary alterations and additions thereto, and the publishers would print and publish every subsequent edition, upon certain specified conditions; and they were to have the power of selling, by auction or otherwise, all copies unsold five years after the date of publication. The conditions in favor of the publishers are, that they were to have the sole control of the mode of printing and publishing, taking all the risk; and, after deducting the charges and expenses incurred, they were to give Mr. Forsyth one-half of the profits, and to account with him in a certain manner. The most that I could infer upon this contract, as to its equitable effect in favor of Messrs. Saunders & Benning, if they were now before me, would be, that, during its subsistence, they performing all the conditions on their part, Mr. Forsyth would not be at liberty to transfer to any other person the right of printing and publishing this work, nor himself to conduct the publication of it through other hands.

"Then, it is argued that the sole

power of printing, reprinting, and publishing is, in fact, the copyright. And, no doubt, if an author, in consideration of a sum of money paid to him, agrees that certain persons shall have the sole power of printing, reprinting, and publishing a certain work, for all time, that would be parting with the copyright; but if the agreement is that the publishers, performing certain conditions on their part, should, so long as they do perform such conditions, have the right of printing and publishing the book, that is a very different agreement. The legitimate inference from this contract is, that, so long as the publishers duly and properly perform their duty with reference to all that they have engaged to do, Mr. Forsyth should not be at liberty to defeat the benefit of his own agreement, by publishing a new edition before the former editions are sold off. As the Vice-Chancellor observed in *Sweet v. Cater*, 11 Sim. 572, by such an agreement, although not an assignment of the copyright, the author would incur obligations, and therefore could not interfere with the interest acquired by the publishers under it." 1 Kay & J. 173.

² "The question which struck me, and on which I desired to hear the defendant's counsel, was whether, combining the clause of the agreement which obliges the publishers to incur all the expenses of printing and publishing, with the last clause, which provides that, in case all the copies of any edition should not be sold off within five years after the time of publication, they might sell them by auction or otherwise, the result was not that when once an edition of the book had

decide these questions, as the original parties to the agreement were not before the court. Nor was it necessary to determine what rights had passed to the assignees in bankruptcy. But the Vice-Chancellor, after pointing out the circumstances under which the original publishers might have been entitled to an injunction, incidentally remarked, that "it would be very possible for the assignees, disposing of the remaining copies of this work as part of the bankrupt's effects, as they might properly do if they could prove clearly that no disadvantage would thereby be occasioned to Mr. Forsyth, and if they made such sale within a reasonable time, to sustain a suit for an injunction under similar circumstances."¹

The judgment was that the contract in controversy was in the nature of a personal engagement; and hence that the rights and obligations created by it, whatever they were in the case of the original parties, were not transferable, and therefore had not passed to the plaintiffs. Nor was the standing of the plaintiffs the same as that of the assignees in bankruptcy through whom they claimed to have derived their interests. The injunction was accordingly refused.²

been printed, and all the expenses incurred, the publishers might have a right in that edition somewhat similar to that recognized in *Sweet v. Cater*, 11 Sim. 572; so that they might contend, that, having incurred all the liabilities, and having performed their duty by doing every thing necessary on their part to bring the book into the market, they had a right, until they had realized their profit, to prevent the author from interfering with them by bringing into the market any thing which might deteriorate the value of what they had on hand; and that, therefore, no new edition of the book should be published which would destroy the value of the former one. I still think that Messrs. Saunders & Benning, suing under this agreement, and showing that they had performed their part and were ready to continue to do so, would be entitled to prevent Mr. Forsyth from disposing of a third edition of his work until they had sold the preceding edition." 1 Kay & J. 176.

¹ 1 Kay & J. 177.

² "The principal question then is," said Vice-Chancellor Wood, "whether this agreement is a personal engagement or not. It would be difficult for me to say, that, in a contract of this kind, the author is utterly indifferent into whose hands his interests under such an engagement are to be intrusted. It is not merely a question of his literary interests; but certain publishers undertaking to incur the expenses of bringing out the work, and fixing the price, the author is to have a share of the profits; and they are to decide in what shape the book is to come out, and at what price it is to be sold, and are to account with him. I must say, that, in my opinion, these are peculiarly personal considerations; and that this contract bears the impress of being a personal contract in all these respects. It could not be a matter of indifference to Mr. Forsyth, that the assignees in bankruptcy of Mr. Benning should be at liberty to transfer the future right of fixing the price of

This decision was affirmed on appeal; but it does not appear how far the judges agreed with the views expressed by the Vice-Chancellor as to the respective rights of the original parties to the agreement.¹

this and subsequent editions, and the right to call upon him to fulfil his duty of preparing a new edition, and the risk which might be incurred in conducting it, and the other benefits and obligations of the agreement, to any one they might think proper; possibly to some one not even carrying on the trade of a bookseller, as might happen in case of an absolute sale to the best bidder. Regarding the agreement as a contract for the purchase of a limited right, according to the view of the Vice-Chancellor of England in *Sweet v. Cater*, 11 Sim. 572, it is still impossible that it should be indifferent to Mr. Forsyth that it should pass from a respectable firm in London to booksellers residing in a remote part of the country, or to other persons unable to fulfil the engagements entered into with him. The contract, therefore, is one which involves personal considerations; and, framed as it is, I must regard it as a special kind of agency, under which the agents were bound to sell, and to take the risk of there being no profits upon themselves." 1 Kay & J. 174.

"I still think," continued the Vice-Chancellor, "that Messrs. Saunders and Benning, suing under this agreement, and showing that they had performed their part and were ready to continue to do so, would be entitled to prevent Mr. Forsyth from disposing of a third edition of his work until they had sold the preceding edition. But the case here is a very different one. It is not necessary for me even to say what would be the position of the assignees in bankruptcy in this case. I think it would be very possible for the assignees, disposing of the remaining copies of this work as part of the bankrupt's effects, as they might properly do if they could prove clearly that no disadvantage would thereby be occa-

sioned to Mr. Forsyth, and if they made such sale within a reasonable time, to sustain a suit for an injunction under similar circumstances. The case here, however, is different. Mr. Benning's assignees and Mr. Gilliat have disposed of this property to the present plaintiffs; and they now say that the rights under the agreement have been transferred to them, and that they are, therefore, entitled to prevent Mr. Forsyth from selling or disposing of a third edition of this book. If that be the correct view, I must hold that every right which Messrs. Saunders & Benning had under the agreement has passed to the present plaintiffs, and that they have a right to call upon Mr. Forsyth to publish a new edition, and have been put in all respects in the place of Messrs. Saunders & Benning; and that this personal agreement, as I must consider it, has been transferred to these plaintiffs, with whom Mr. Forsyth has entered into no contract. In the particular case before me, if that were so, of course Mr. Forsyth would be in as good hands as he was before; but that can make no difference in the law of the case. The assignees were not bound to take care to whom they sold the property, their only duty being to get the best price they could for it; and if any other gentleman in a remote part of the country, or even residing abroad, had been the purchaser, they would have been at liberty to part with it to him; in which last case the purchaser could not have interfered with Mr. Forsyth in bringing out a new edition." Ibid. 176.

¹ 6 De G., M. & G. 223. Lord Justice Knight Bruce, one of the judges on appeal, while sustaining the refusal of the Vice-Chancellor to grant an injunction, and believing that the duties imposed by the contract were personal

Division of Profits on Copies Sold above Specified Number. — Publisher Bankrupt. — Author claims as Partner in Unsold Stock. —In a case in the Irish Bankruptcy Court in 1848, it appeared that Curry & Co. had published three novels by Charles Lever, under an agreement that they should bear the expense of publication, and pay to the author a specified sum for a certain number of copies, and should divide with him the net profits on the copies sold beyond that number. While a large

to the contracting parties, and not capable of vicarious performance, seems to have been of the opinion, that certain rights under the contract might have passed to the plaintiffs. He also had the impression that not even the original publishers, had they retained their rights and position under the contract, would have been entitled to the injunction prayed for in this case. He said:—

“In acceding, as I do, to the propriety of the course taken by the Vice-Chancellor, I consider it as perfectly consistent with the notion, that the plaintiffs may have some ground of claim under the agreement of December, 1840, on which their bill is founded; may be entitled to have an account or to maintain an action or actions against one or both of the defendants. The only question, I repeat, with which we are dealing, is one of granting or not granting an interlocutory injunction; and for that purpose it must be observed that such interest, if any, in the copyright of Mr. Forsyth's work on *Composition with Creditors*, as the other parties to the agreement acquired under it, they acquired, I apprehend, not exclusively of Mr. Forsyth, but by way of joint adventure with him, or of partnership with him, in respect and for the objects of which he undertook the fulfilment by himself personally of certain duties to them, and they undertook the fulfilment by themselves personally of certain duties to him; nor on either side, without the consent of the other, could there be a vicarious performance, a performance by deputy or by assignee, of the duties thus undertaken. At

least, so I understand the instrument and the matter; nor do I see that the duties were on either side of such a nature as that their performance specifically could have been enforced by a court of equity. My impression, therefore, is that had Messrs. Saunders & Benning, parties to the agreement of 1840, retained their original position and rights under it, they could not successfully have asked an injunction against Mr. Forsyth, such as that prayed by the bill before us.

“If this opinion is correct, the plaintiffs clearly cannot do so; but, if incorrect, it does not of necessity follow that such an injunction ought to be granted to them. For in them, however trustworthy, Mr. Forsyth has not agreed or intended to place confidence; with them, however respectable, he has not consented to associate himself. In the way of specific performance, there must be at least as much difficulty between him and them as between him and the other parties to the agreement of 1840. I do not assert that the plaintiffs have not, or that they have, been wronged. If wronged, they may proceed for damages or compensation, or an account; but any such injunction as that now sought seems to me plainly impossible. The appeal, not supported in my judgment by *Morris v. Colman*, 13 Ves. 437, or *Lumley v. Wagner*, 1 De G., M. & G. 604 (cases which I do not question), appears to me opposed by a great body of binding authority, as well as by principle, and one of course to be dismissed with costs.” 6 De G., M. & G. 228.

number of printed copies remained unsold, Curry became bankrupt, when Lever claimed to be entitled as partner to one-half of the unsold stock, and to have a special lien on the other half, entitling him as a preferred creditor to be paid in full for whatever balance might be due him. The commissioner held that, if Lever was a partner in the unsold stock, he was a mere dormant and secret partner; and, as the whole of the stock had been in the possession and disposition of the bankrupt, it passed to the creditors under the Bankrupt Act;¹ and that, for the same reason, Lever had no special lien on it. The commissioner said that the question as to whom the copyright belonged was not within the jurisdiction of the court; but he expressed the opinion that, as Curry had been permitted to advertise himself as the owner, the copyright should be dealt with as his property in bankruptcy.²

Agreement Indefinite as to Duration and Number of Copies. — Division of Profits. — Publisher may fix Selling Price. — Author may End Agreement by Proper Notice. — The contracts made by Charles Reade and his publisher, Richard Bentley, which came up for judicial construction in the two suits brought by the former against the latter, were similar to that discussed in *Stevens v. Benning*; except that in the agreements of Reade and Bentley there was no provision binding on either party for the publication of a second or any following edition of the books. In the first contract, made in 1852, it was agreed that Bentley should publish at his own expense and risk Reade's novel *Peg Woffington*; and that, after certain expenses and allowances were deducted, the profits of every edition printed should be divided equally between author and publisher. In 1853, a similar agreement was made by the same parties for the publication of *Christie Johnstone*. The price at which the books were to be sold was not specified. An edition of five hundred copies of *Peg Woffington* having been published and sold at 10s. 6d. a copy, Bentley, against the protest of Reade, prepared to issue an edition of the same novel at 3s. 6d. a copy. The latter notified the former not to publish, served a written

¹ 6 & 7 Will. IV. c. 14, s. 86. Repealed by 20 & 21 Vict. c. 60, s. 2; but see 35 & 36 Vict. c. 58, s. 5.

² *In re Curry*, 12 Ir. Eq. 382, 390.

notice for a dissolution of the partnership, if any existed, between them, and applied for an injunction to restrain the publication of the second edition. Vice-Chancellor Wood held that under the agreement the publisher was the proper person to fix the price; that he was at liberty to continue publishing successive editions until he received notice to end the agreement; and that such notice, to be operative, must be given before any expense on a future edition had been incurred. The court, therefore, refused to interfere with the sale of the second edition, for which the publisher had made disbursements before receiving from the author notice to end the agreement.¹

¹ *Reade v. Bentley*, 3 Kay & J. 271. In the contract were these words: "The books sold to be accounted for at the trade sale price, reckoning twenty-five copies as twenty-four, unless it be thought advisable to dispose of any copies, or of the remainder, at a lower price, which is left to the judgment and discretion of the said Richard Bentley." The meaning of this provision was thus explained by the Vice-Chancellor: "There being this special clause, showing that in a particular case the diminution of price is to be left to the discretion of the publisher, it was argued that the inference is, that the publisher has no such discretion, except in the particular case there mentioned. It is quite obvious that this clause was introduced with no such view, but because Mr. Bentley is to bring out the work, and, in bringing it out, he is to fix a certain price to the trade. He is aware that there are persons who are in the habit of purchasing all these works for resale. There is a certain quantity in the first instance offered to the trade, as it is called, who send in their orders, each buyer for a certain quantity of copies, and it is brought out to the trade at a price which is fixed upon each edition. Then it might happen that some copies would remain unsold. Mr. Bentley first agrees to account with the author for all copies at the trade price; but then, as that might be rather

too hard upon the publisher, who has had all the expense of bringing out the work, it is agreed, that, if any copies remain unsold, he is to have liberty, as regards that edition, to dispose of the unsold copies at a lower price. That is the obvious meaning of this clause; and it has no reference to the general question of fixing or not fixing the price." *Ibid.* 277.

"The question then arises," said the Vice-Chancellor, "if Mr. Bentley was to publish at his own risk, who was to fix the price of the work? The agreement is entirely silent upon this point, and it is left to be inferred from the nature of the contract between the parties. I am decidedly of opinion, that the plaintiff's view, that he was to have a voice in fixing the price, is not consistent with the terms of the agreement. I think, if he intended to retain such a power, it is scarcely possible to conceive that he should have allowed a term so important to be omitted from the agreement; and, when I look to the words of the agreement, I see that Mr. Bentley is to be the publisher, that he is to bear the expense, and to make all payments; and considering also that it is the business of the publisher to make his expenses and profits balance, that he is the person to whom the author has intrusted that department, the publisher taking the whole charge and risk, and the whole duty of bringing out the work as he thinks

Soon after, when Bentley had published two editions of *Peg Woffington* and four of *Christie Johnstone*, and was intending to issue a new edition of each novel, but had made no outlay for that purpose, Reade again served on him notice to end the agreements between them, and applied for an injunction against such intended publication. The direct issue now raised was, whether Reade had the power to end the agreements, and prevent the publisher from printing an edition on which no expense had been incurred. Vice-Chancellor Wood was of opinion, that, if the author were powerless to end the agreement, the publisher would be at liberty to issue any number of successive editions, and at the same time prevent the author from publishing a single copy. Moreover, as it had been held in the first suit of *Reade v. Bentley* that the publisher was the proper person to fix the selling price of the book, he would have, by parity of reasoning, the power to determine the time of issuing a new edition. He might thus be enabled to postpone indefinitely the publication of an edition for which there might in reality be a demand. In this case, also, the author would be powerless to publish. On the other hand, the author could not, under the agreement, compel the publisher to issue more than the first edition. Such "a construction," said the Vice-Chancellor, "which would leave the author fast bound, and the publisher entirely free, after the publication of one edition, is not a reasonable construction to adopt in considering the effect of an agreement of this character." The court decided that no interest in the copyright had been transferred, and that the agreement created no "more than a joint adventure," terminable by the author, with a revocable license to publish. As the contract provided for an adjustment of accounts when the profits of each edition should be ascertained, the time of making such adjustment was held to be the proper time for ending the agreement. The injunction was, therefore, granted

best for the interest of both parties, it seems to be necessarily incident to the duty which he has to perform, that he should have the right also of determining the price at which the work should be brought out. I think the construction of the agreement is plain enough up to this point, that the de-

fendant, the publisher, is to fix the price of the work; that he is to choose the embellishments and every thing else connected with its publication; and that he is to do this for all editions which should be brought out during the subsistence of the agreement." 3 Kay & J. 275.

to restrain the publication of the editions on which no expense had been incurred by the publisher.¹

¹ Reade v. Bentley, 4 Kay & J. 656. "Lord Justice Turner," said Vice-Chancellor Wood, "looked upon the agreement in Stevens v. Benning, in the double light of a license and a partnership; speaking, however, less decidedly as to its being a partnership. He says, 'Next, if there was a partnership, then, if the agreement does not affect the copyright, the partnership was not in the copyright, but in the copies printed under the license contained in the agreement' (6 De G., M. & G. 231); viewing it, therefore, as a license for the publication of the work, and then a joint adventure between the author and publisher in the copies so to be published. If that were the effect of the agreement in the present case, the question would still remain, whether the license be irrevocable.

"In the former suit between these parties, 3 Kay & J. 271, the plaintiff claimed a right to prevent the publication of an edition with respect to which the defendant had been allowed to incur various expenses before the plaintiff had taken any steps to determine the joint adventure between them. In the present suit, his claim is wholly different. He does not attempt to interfere with the publication of an edition which the defendant had commenced, and incurred expense in preparing for publication, before he exercised the option of determining the agreement. His claim is limited to editions about which no such expense had been incurred by the defendant; and his argument is, that, unless he has a right to determine the agreement as to all such editions, the consequence will be, that, during the whole of the defendant's life, he may be under an obligation to the defendant, while the defendant will be under no reciprocal obligation to him. It is true, that, according to Stevens v. Benning, a license like the present would, I apprehend, be restricted to the defendant personally, and would

not extend to his executors, or to any future partner or assignee; but, if the defendant's construction be correct, it follows that so long as he lives and is willing to continue publishing fresh editions of the work, so long, according to the doctrine in Sweet v. Cater, the plaintiff will be precluded from asserting a right to publish any competing edition. The defendant could compel the plaintiff to abstain from publishing a single copy of the work, so long as he expressed his readiness to continue publishing. But the plaintiff has no reciprocal power. He could never compel the defendant to publish more than a single edition of the work. His powers are limited to what the contract gives him; and, according to the contract, when the defendant has published a single edition the contract on his part is fulfilled. That is a position of considerable hardship for an author, and one which ought to be clearly shown, upon the face of a contract, to have been contemplated by the parties who entered into it. Besides, the plaintiff might be placed in a position of still greater hardship, if the defendant's construction be correct. In the former suit between the parties, in reference to this agreement, I held, that, although the agreement is silent on the subject, yet inasmuch as the defendant was to bear the risk of the publication, he was the proper person to fix the price; and, by parity of reasoning, he would be the proper person to fix the time and mode of publication; and, in the exercise of his discretion on that subject, it might well happen that the defendant, acting perfectly *bona fide* and upon an honest conviction that circumstances were unfavorable for the publication of a further edition, would decline indefinitely to publish, but without resigning his contract. The author, at the same time, might be of a contrary opinion, and yet for months or even years he might be kept in suspense, and pre-

Agreement for First Edition of Specified Number, and Unlimited Second Edition if called for. — Pulte v. Derby was a contro-

vented from publishing on his own account until his publisher should be of opinion that the time had come for the revival of the public interest in the work. That is a position of difficulty and hardship to which an author ought not to be reduced, unless the contract is express and clear upon the subject.

“On the other hand, it was very ably urged by the defendant’s counsel, that, if the plaintiff has the right of determining the agreement, he is bound to show from the contract at what precise time that right commences. If he can arrest the publication of a third, fourth, or fifth edition, the same argument, it was said, must apply to the second; and if the plaintiff cannot fix upon some particular time at which, according to the contract, his right is to commence, the inference must be, that the agreement is only determinable by a joint resolution of both parties. As regards a second edition, this argument is particularly forcible, although possibly it might apply to others. The publisher may urge that he has given the benefit of his talents and position as a publisher; that he has invested his capital, sparing no expense, in bringing out the first edition, in the expectation of being recouped the cost of the first by the sale of the second and subsequent editions; that as to one of the works in question he has even gone so far as to have it stereotyped with that view; and that, to hold the author entitled at his own instance to determine an agreement like the present, when the first edition has been published, would be to enable him, by an arbitrary and unreasonable exercise of that power, to deprive the publisher of all his profits.” 4 Kay & J. 663.

The meaning of the word edition was thus construed by the Vice-Chancellor: “This consideration makes it necessary to inquire, whether, upon the face of the agreements, any definite

time can be reasonably said to be pointed out for the determination of the joint adventures in question; or whether the terms of the agreements are such as necessarily to hold the plaintiff bound for an indefinite series of editions, and thus to subject him to the disadvantages to which I have referred. Now, on carefully reading through each agreement, it appears to me, that, at all events, certain definite times are distinctly pointed out for the adjustment of the accounts, and that those times are the successive periods when the various receipts and payments on account of the successive editions have been ascertained.

“It was said that the court must first ascertain the meaning of the term edition; that when a work has once been stereotyped, the term edition is no longer applicable; that when a work is published in what are called ‘thousands,’ twenty thousand or thirty thousand being circulated, each thousand could not properly be called an edition. Now, I apprehend, that, not merely in point of etymology, but having regard to what actually takes place in the publication of any work, an edition of a work is the putting of it forth before the public, and, if this be done in batches at successive periods, each successive batch is a new edition; and the question whether the individual copies have been printed by means of movable type or by stereotype, does not seem to me to be material. If movable type is used, the type having been broken up, the new edition is prepared by setting up the type afresh, printing afresh, advertising afresh, and repeating all the other necessary steps to obtain a new circulation of the work. In that case, the contemplated break between the two editions is more complete, because, until the type is again set up, nothing further can be done. But I apprehend it makes no substantial difference, as regards the meaning of the term edi-

versy in the Circuit Court of the United States, growing out of a contract for the publication, by the defendants, of a book of which the plaintiff was the author. The agreement was that the defendants should have "the exclusive right to print and publish an edition of one thousand copies," at their own expense, and that they should pay to the plaintiff fifteen cents for each copy sold. It was further agreed "that, if the said Derby & Co. find a second edition called for, the said Pulte is to revise and correct a copy of the first edition ready for the press, which the said Derby & Co. agree to have stereotyped at their own cost, having the exclusive use and control of the plates, printing as many copies as they can sell, paying to said Pulte the sum of twenty cents for each and every copy sold." The copyright was entered in the name of the publishers, and after the first edition of one thousand copies had been sold stereotype plates were prepared, and a second edition of fifteen hundred copies, revised by the author, was printed. Afterward the defendants published two thousand copies, which were represented on the title-page as the third edition. The plates were then transferred to A. S. Barnes & Co., under a contract to publish, and account to the defendants, on the same terms mentioned in the agreement between the plaintiff and the defendants. The complainant, alleging that the publication of

tion, whether the new thousand have been printed by a resetting of movable type, or by stereotype, or whether they have been printed at the same time with the former thousand, or subsequently. A new edition is published whenever, having in his storehouse a certain number of copies, the publisher issues a fresh batch of them to the public. This, according to the practice of the trade, is done, as is well known, periodically. And if, after printing twenty thousand copies, a publisher should think it expedient, for the purpose of keeping up the price of the work, to issue them in batches of a thousand at a time, keeping the rest under lock and key, each successive issue would be a new edition in every sense of the word. The persons who framed this agreement appear to have understood the word in this sense.

The agreement provides that, 'after deducting from the produce of the sale the charges for printing, paper, advertising, embellishments (if any), and other incidental expenses, the profits remaining of every *edition* that shall be printed of the work' shall be divided as specified. It uses the word *edition* to designate that periodical issue which is capable of being made the subject of a separate account of profit and loss.

"Such, then, being the meaning of the word *edition*, the agreement provides, that, so soon as all the charges and expenses, and all the receipts in respect of each *edition*, shall have been ascertained, the accounts shall be taken, and the profits divided. That is the period distinctly pointed out by the agreement for the adjustment of the accounts." 4 Kay & J. 666.

the third edition was in violation of his rights, applied for an injunction against the sale of that edition. The defendants filed a cross-bill, alleging that the copyright was in them, and praying that the complainant be enjoined from publishing the book, as he was about to do.

There was no controversy respecting that part of the agreement which gave to the defendants the exclusive right to publish and sell the first edition of one thousand copies. The questions brought before the court related to the second clause of the contract, which provided for the publication of a second edition of the work. The difficulty in determining the true effect and meaning of this provision grew out of the fact that the number of copies of which the edition should consist was not specified; the publishers being authorized to prepare stereotype plates, and to print "as many copies as they can sell." The court held that it had no jurisdiction, and on this ground refused to grant an injunction. But Mr. Justice McLean construed the contract to the effect, that the defendants had acquired the right to publish as many copies of the second edition as they could sell; that the second edition could not be limited "to the number of copies that may be struck off at one impression;" that "the defendants were not to be limited to the publication of the second edition, if they could sell more than happened to be published on that occasion;" and that "the mere fact of inserting in the title-page in the third impression, the 'third edition,' cannot cut off the defendants from the right expressly given in the agreement."¹

¹ 5 McLean, 328. After referring to the circumstance that the copyright, with the presumable sanction of the author, had been entered in the names of the defendants, Mr. Justice McLean said: "Now, this fact goes strongly to show that the contract was intended to operate as long as the defendants, in the language of the agreement, could 'sell the copies of the book.' If such were not the understanding of the parties, it is reasonable to suppose that there would have been a restriction to the exercise of this right, in the contract. The counsel for the complainant contend that a restriction does appear upon the face of the agreement. And this is found, it is said, in the provisions made for the publication of the first and second editions. The first edition was limited to one thousand copies. And, should a second edition be called for, plates were to be provided by the defendants, and they were authorized to 'print as many copies as they can sell.' Does this limit the second edition to the number of copies that may be struck off at one impression? Such a supposition is contrary to the words of the agreement. The advantage of stereotype plates to the publishers is

If by this language it was meant that the publishers were entitled to print as many copies of the second edition as could be sold, and that the size of that edition was not necessarily determined by the number of copies that were struck off at the first printing, the ruling is doubtless correct. But if the meaning intended to be expressed by the court was that the defendants were empowered to publish what might properly be considered a third edition, the soundness of the construction may well be questioned. The contract cannot rightly be construed as an assignment of the copyright. It gave the publishers the right to publish a second edition of unlimited size; but they had no authority to issue a third edition. The dividing line between two editions is often uncertain and of difficult

to enable them to strike off additional copies without delay, and with little increase of expense, as they shall be called for. This is known to all publishers and authors, and this was provided for in the agreement. The defendants were authorized to 'print as many copies as they can sell.' Now, how are they to ascertain the number of copies they can sell, until the stock on hand shall be exhausted, or nearly exhausted, and a demand is made for more? They are no more able to ascertain this important fact on the publication of the second edition than on the publication of the first one. The fact can only be known in the progress of the sale, and this shows that the defendants were not to be limited to the publication of the second edition, if they could sell more than happened to be published on that occasion. And it also shows the propriety of preparing the stereotype plates.

"The contract seems to be susceptible of no other interpretation. The words authorizing the defendants to print as many copies as they can sell must be stricken out of the contract, to give to it a different construction. Effect must be given to every part of the contract, if one part be not repugnant to another. There is no repugnancy in any part of the contract to the above provision. On the contrary,

it harmonizes with every part of the agreement, and especially with the acts of the parties in having the copyright vested in the defendants, and with the preparation of the plates. Plates, it is believed, are rarely if ever used when only one edition or impression of a work is contemplated; they are now uniformly used when a continued and an increasing demand is anticipated.

"To this view it is objected that there is no provision in the agreement for the third edition. There is only a provision that the defendants may print as many copies as they can sell; and the mere fact of inserting in the title-page in the third impression, the 'third edition,' cannot cut off the defendants from the right expressly given in the agreement. In a Court of Chancery, the substance of a thing is more regarded than the form. Whether the defendant stated in the title-page the third impression, or the third edition, is immaterial. The only objection perceived to the title-page is, that the third edition purports to have been revised and corrected by the author. This applies to the second edition, and not to the third. But it is supposed to have been an inadvertence in copying the title-page of the second edition. It is clear this could not have been inserted with a view to injure the complainant." 5 McLean, 332.

determination. The word edition is indefinite and variable in its meaning. It may be used in different senses, by different persons, at different times and in different places. The meaning to be ascertained is that in which it was understood by the parties who used it. Whether the two thousand copies complained of in *Pulte v. Derby* were in reality a part of the second, or constituted a third, edition was a question of fact, to be determined by the attendant circumstances. Whether they were one or the other in the meaning of the parties to the agreement was a question depending on the sense in which the word edition had been understood and used by them. If, in the meaning of the parties when the agreement was made, such additional copies were properly a part of the second edition, the publishers were within the authority of the contract; but, if they could fairly be considered to be a new edition, their publication was in violation of the author's rights.¹

¹ The chief difficulty in determining the rights of the parties under the second part of the contract lay in defining the limits of the second edition. It was clear that the author had given no authority to publish what could properly be understood to be a third edition. Having expressly limited the first edition to one thousand copies, he agreed that, if a second edition should be called for, the publishers should publish that also; and, as it was not foreseen how many copies of that edition it would be well to publish, the number was not specified, but was left to be determined by the public demand. The words that the publishers should print "as many copies as they can sell," on which so much stress was laid by the court, applied exclusively to the second edition, and had no other force than to negative the inference that might have been drawn if express words had not been used, that the second edition was to be of the same size as the first; viz., one thousand copies. As the number of copies of which the second edition should consist was not expressly limited, the publishers, except for the implied limitation just referred to,

would have been fully entitled, even if the words above quoted had been omitted, to publish as many copies of the second edition as they could sell; and the insertion of these words did not enlarge that right, or extend it beyond the second edition. For the second edition, the publishers first printed fifteen hundred copies. They afterward issued two thousand copies, with the imprint "third edition" on the title-page. The fact that the two thousand copies, thus printed separately and distinctly from the fifteen hundred, were represented by the publishers to be the third edition, was a most significant circumstance in determining whether, in the meaning of the agreement, they were a third edition or a part of the second.

Mr. Justice McLean attached much importance to the fact that stereotype plates had been prepared for the second edition. In *Reade v. Bentley*, Vice-Chancellor Wood expressed the opinion that it was immaterial, in determining the limits of an edition, whether the copies had been printed from stereotype plates or ordinary types. See *ante*, p. 355, note.

The cross-bill raised the important question, whether the defendants had acquired the right, not only of publishing the work themselves, but also of preventing the author, or any person claiming under him, from issuing an edition while they were the authorized publishers. On this point the court expressed the opinion, that, as the copyright had been entered in the name of the defendants, the legal title was in them, but only for the purposes of the agreement; that they had the exclusive right to publish on the conditions of the contract, but were not empowered to transfer the copyright, nor to publish except on the terms agreed on; and that the author was not entitled to publish the work in disregard of the contract.¹ As the agreement was for the publication of two editions, the defendant's rights were restricted to those two editions, and hence they would cease when the second edition should be sold.

Agreement for Use of Matter in Specified Editions. — In *Lawrence v. Dana*,² it appeared that the complainant, William Beach Lawrence, at the request of Mrs. Wheaton, widow of Henry Wheaton, had prepared two annotated editions of Wheaton's *Elements of International Law*; of which one was issued in 1855, and the other in 1863. Both were published by Little, Brown, & Co., of Boston; and the copyright in each was entered in the name of Mrs. Wheaton. The complainant prepared the notes, without asking or receiving pay for his services. He alleged that it had been understood and agreed between Mrs. Wheaton and himself that she should be entitled to the use, in those two editions, of the matter prepared by him; but that, subject to this use, the property in such matter should be his, and that she should hold in trust for him the copyrights taken out in her name. The agreement for the publication of the first of the two editions was oral. Concerning the second edition, Mrs. Wheaton agreed in writing "to make no use of Mr. Lawrence's notes in a new edition, without his written consent," and to give to him "the right to make any use he wishes to of his own notes." On this agreement the complainant based his suit.³ After these two editions had been sold, Mrs.

¹ 5 McLean, 335.

² 2 Am. L. T. R. N. S. 402.

³ See *Ibid.* 405.

Wheaton employed the defendant to prepare another annotated edition, which was also published by Little, Brown, & Co. The complainant alleged that this edition contained matter copied from his notes in the two preceding editions, and hence infringed his copyright therein. The court held that Mrs. Wheaton had acquired the right to use Lawrence's notes in the two editions as agreed, but not otherwise; that the legal title to the copyright was in her; that the copyright was the property of Lawrence, in whom vested the equitable title which entitled him to maintain his suit in equity; that neither Mrs. Wheaton nor any one claiming under her had a right to use Lawrence's notes, without his consent, in any publication other than the two editions agreed on.¹

¹ "The legal title to the copyrights," said Mr. Justice Clifford, "is in Mrs. Wheaton or her legal representative; and the complainant claims, in the first place, that the same is held in trust for him as the equitable owner of the notes by virtue of the original arrangement under which the same were prepared. Secondly, the complainant claims that the negative as well as the affirmative promise contained in the agreement in regard to the use of the notes was binding upon Mrs. Wheaton; and that both are obligatory upon her legal representative, and all others having notice of the existence of those covenants.

"Two principal objections are taken by the respondents to the claim of the complainant that he is the equitable owner of the notes under the original arrangement. First, they deny that the proofs in the case warrant any such finding, especially as the theory is denied in the answer. Second, they contend that Mrs. Wheaton, if such was the agreement, could not legally copyright the notes; as it would show that she was but a mere licensee, and that the copyrights in that state of the case would be void on that account.

"First, conclusive proof to show what was the original understanding between the parties is found in the correspondence upon the subject. Unaided by any one, the complainant prepared the

notes, but with the express understanding that he would do so without any charge, and that the property of the same, so far as respected the new edition, should vest in the proprietor of the book, and that she should take out the copyright and remain, as she was, the sole and exclusive owner of the entire book. Liberal, however, as the agreement was toward the proprietor of the book, yet it did not include any thing except that edition; and when the second annotated edition was prepared under a similar arrangement, as conceded by both parties, the agreement was not extended beyond that publication. Confirmation of those propositions is unnecessary, as they are not controverted by the respondents. They deny that it was agreed between the parties that the notes should ever afterward become the property of the complainant; but they do not allege nor offer any proof tending to show that his agreement with Mrs. Wheaton extended beyond the annotated editions. Tested by these indubitable facts, the rights of the parties are plain, and easy to be understood. As the proprietor of the book, Mrs. Wheaton, by virtue of that arrangement, became the absolute owner of the notes as they were prepared, so far as respects the editions in question; and she also acquired therewith the right to copyright the same for the

Agreement with State Reporter for Publication of Law Reports. — In *Little v. Hall*, it appeared that the complainants by a contract with Christopher Morgan, the Secretary of State of New York, and George F. Comstock, the State Reporter, were to publish and have the copyright of reports of decisions to be prepared by Comstock. The last named received a salary from the State for acting as reporter, and the copyright in the reports was to be the property of the State. When three volumes of reports had been published under the agreement above referred to, Comstock ceased to be State Reporter; but afterward, with the consent of the court, he prepared, from manuscripts, some of which had come into his hands while reporter, and others had been given to him by the judges after the expiration of his term of office, a fourth volume of reports, which was bought and published by the defendants. The plaintiffs republished this volume, and sought to enjoin the sale of the edition published by the defendants. The Supreme Court of the United States held that the complainant's contract had been made with Comstock as State Reporter; and that, whatever claim they might have against him for failure to supply the manuscripts to them, they could not be considered as the owners of the copyright in the volume of reports prepared by him after he had ceased to be State Reporter.¹

protection of the property; but she did not acquire thereby any right or title, legal or equitable, to use the notes in a third edition of the annotated work without the consent of the complainant. Proof to support any such right or title is entirely wanting in the record, and no such right or title is set up in the answer. Such omission confirms the view that no such right or title was intended to be conveyed; and the subsequent conduct of the parties in executing the memorandum tends strongly to the same conclusion.

"Second, suppose the facts to be so, then the respondents contend that the copyrights are void, because, as they insist, the applicant for the same was a mere licensee of the author of the notes; but the court is of a different opinion, for the reasons already given, as well as for others yet to be mentioned." 2 Am. L. T. R. N. S. 418.

¹ 18 How. 165. "After the expiration of his official term, Comstock did not and could not act as reporter. His successor, having been appointed and qualified, discharged the duties of the office and received the salary. . . . As his term of office had expired, he was unwilling to publish the fourth volume without compensation for his labor. This changed his relations with the plaintiffs, as that contract was made as reporter, and on the supposition that he would be continued in that office. . . . Comstock could not have published the work as reporter without the consent of the court of appeals, and also the Secretary of State, who was required to secure the copyright to the State; and for his labor in preparing the notes, references, &c., and superintending the printing, he could have received no compensation.

"Without saying what effect might

Principles Drawn from Foregoing Cases.— Certain general principles may now be drawn from the cases which have been examined. These cases present contracts which, with respect to the duration or extent of the right to publish, may be arranged in three general classes: 1, those in which the number of copies to be published, or the time during which publication is to continue, is expressly limited; 2, those in which the right of publication and its duration are made conditional on a certain event; 3, those in which the agreement is indefinite as to the number of copies to be published, or the period through which publication is to extend.

A person who has acquired the right to publish only one edition of a work cannot publish another edition, without authority.¹

Where the agreement is for the exclusive publication of a specified number of copies, the publisher acquires the right to print and sell on the terms of the contract that number of copies; and, while those terms are observed by the publisher, the author is powerless to revoke the authority given, or himself to publish, until the number of copies agreed on has been sold.²

An agreement which is made conditional on a certain event becomes binding on the occurrence of that event. Thus, where the contract provided that, if a second edition should be called for, the publishers should publish it, the latter acquired the

have been given to the contract had the relation of the parties remained unchanged, we are unable to say, as the case now stands before us, that the plaintiffs were the legal owners of the manuscript within the copyright law. The contract was made by Comstock as reporter, whose duties were regulated by law; and the obligations of the complainants as publishers were embodied in the contract, and were incompatible with any publication on private account. The entire labor of the work was performed by Comstock, not as reporter, but on his own account. It is, we think, not a case for a specific execution of the contract; and in effect that is the object of the bill. . . . Under the changed relation of the

parties, the plaintiffs cannot be considered as the legal owners of the manuscript for the purposes of the contract under the copyright law. Whatever obligation may arise from the contract under the circumstances as against Comstock must be founded on his failure to furnish the manuscripts to the plaintiffs, and of such a case we can take no jurisdiction as between the parties on the record." McLean, J., *Ibid.* 171, 172.

¹ *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402. See also *Delf v. Delamotte*, 3 Jur. n. s. 933.

² *Sweet v. Cater*, 11 Sim. 572; *Pulte v. Derby*, 5 McLean, 328. See also *Blackie v. Aikman*, 5 Sc. Sess. Cas. 719.

right, and became bound, when a second edition was called for, to publish that edition on the terms of the contract.¹ Under such agreement, the question whether a new edition is demanded by the public is not left solely to the discretion of the publisher; but is one of fact, which may be determined by proof.² But, where the agreement was for the publication of a single edition, and, without any special provision for that purpose, had in view the issue of following editions, the court was of opinion that it was left to the publisher to determine the proper time for bringing out a new edition.³

An agreement that the publishers shall publish a second edition, if demanded by the public, and print as many copies as they can sell, — an exclusive publication being understood, — gives them the right, when such demand arises, to publish and sell as many copies as can properly be considered to belong to that edition, and to prevent the author, or any one claiming under him, from publishing until such copies shall be sold.⁴ And so, where the publishers are authorized and agree to publish as many editions as may be demanded, there can be little doubt that they have the right, and are bound, to continue the publication on the terms of the agreement as long as they can sell the book. In this case, the rights and obligations of the parties are ended only when the demand for the book ceases, or the conditions of the contract are violated.⁵

When neither the time during which the publication is to last, nor the number of editions or copies to be published, is specified, the publisher is not bound to publish more than the first edition; and the author, by giving proper notice, may end

¹ *Pulte v. Derby*, 5 McLean, 328.

² "If Derby & Co. find a second edition called for, they are bound to prepare the plates, and publish a second edition. Now, if a second edition was called for, which is a fact susceptible of proof, could the defendants, in the exercise of their discretion, refuse to publish? Such a ground would be in opposition to the spirit of the contract; and it is supposed that a Court of Chancery, looking at the whole contract, would have compelled them to publish. The discretion vested in the

defendants was not an arbitrary one, but a discretion to be governed by facts, and on the establishment of the facts the right of the complainant could be enforced." McLean, J., *Ibid.* 334.

³ *Reade v. Bentley*, 4 Kay & J. 665.

⁴ *Pulte v. Derby*, *supra*.

⁵ Such was the agreement in controversy in *Stevens v. Benning*. The case was decided on other grounds. But Vice-Chancellor Wood expressed *obiter* the same view of the law that is given in the text. See *ante*, p. 347, note 1.

the contract, and prevent the publication of any following edition.¹ But the publisher is at liberty to continue publishing successive editions on the terms of the contract until the receipt of such notice; and the author is not entitled to restrain the publication or sale of any edition on which the publisher has incurred expense before receiving notice to end the agreement.²

The publisher is bound to observe the terms of the contract as to manner and style of publication, selling price of copies, &c.³ If the price at which the book is to be sold is not named in the agreement, it is left to the judgment of the publisher;⁴ and, on the same principle, he would be the proper person to determine the style in which the book is to appear.⁵ But while the publisher, in the absence of a special agreement, may determine the style of publication and the selling price, it would seem that this liberty would not entitle him to publish in a style, and to sell at a price, which would be clearly and positively injurious to the literary reputation or pecuniary interests of the author, unless there are circumstances to show that the consent of the latter is to be presumed.

A contract which is not, as well as one which is, terminable at will, may be ended by the neglect or refusal of the publisher to comply with its material conditions.⁶ When the manner and style of publication, the selling price of copies, or other material particulars, are specified in the contract, it is reasonable to conclude that the publisher's rights are dependent on

¹ *Reade v. Bentley*, 3 Kay & J. 271, 4 Id. 656; *Warne v. Routledge*, Law Rep. 18 Eq. 497.

² *Reade v. Bentley*, *supra*. As to the time when the agreement may be ended, and the meaning of "edition," see opinion of Vice-Chancellor Wood, *ante*, p. 355, note.

³ *Sweet v. Cater*, 11 Sim. 572; *Stevens v. Benning*, 1 Kay & J. 168, on ap. 6 De G., M. & G. 223. And so, in *Pulte v. Derby*, the court remarked that the publishers had no power "to publish the work except upon the terms of the contract." 5 McLean, 335.

⁴ *Reade v. Bentley*, 3 Kay & J. 271.

See also *Stevens v. Benning*, *supra*. Where it had been agreed that the book should be sold "to the public" at one shilling, the Irish Commissioner in Bankruptcy, holding that a sale to another publisher at a reduced price was no violation of the agreement, said: "There is nothing in the words or spirit of the agreement restricting the price to the trade; and every person, however little acquainted with the business of a bookseller and publisher, knows how enormously those prices differ." *In re Curry*, 12 Ir. Eq. 387.

⁵ See *In re Curry*, *Ibid.* 388.

⁶ *Stevens v. Benning*, *supra*.

his observance of these provisions. He has no authority to publish except on such conditions; and the author would seem to have the power, if not to compel him to publish on the terms agreed on, at least to prevent him from publishing in disregard of them. The author would thus be free to license another to publish, but not in violation of whatever rights the first publisher may have acquired with respect to any copies that he may have already printed in compliance with the terms of the contract.¹

The contract in controversy in *Stevens v. Benning* was held to be in the nature of a personal engagement, and the duties imposed by it not capable of vicarious performance. Hence, the rights acquired by the publisher were not transferable.² The same opinion was incidentally expressed by the court in *Reade v. Bentley*, of the agreement which had been made by the parties to that suit.³ The consideration in these contracts was that the author should receive a share of the profits. And the opinion of the court on the point under consideration was evidently based on the ground, that the benefits to be received by the author were dependent to a material degree on the judgment, enterprise, reputation, and business facilities of the publisher, and that these were important considerations on which the author had relied in making the agreement. These reasons would also prevail where the author is to receive a royalty on the copies sold; but they would lose their force

¹ In considering the equitable force of an agreement between the author and his publishers, Lord Justice Turner said: "It was, however, said that there was a personal equity against Mr. Forsyth operating in this mode; that Mr. Forsyth could not, as between him and Messrs. Saunders & Benning, have permitted a third edition of the work to be issued whilst copies of the second remained unsold under the agreement. How the case would have stood if Messrs. Saunders & Benning had remained in a position to perform their part of the agreement, I need not give any opinion; but, if there was a personal equity on one side, there must also be on the other. If Messrs. Saunders & Benning are not in a

situation to perform their personal part of the contract, neither in my view of the case could they in equity enforce, as against Mr. Forsyth, any contract which he had entered into with them." *Stevens v. Benning*, 6 De G., M. & G. 231.

² 1 Kay & J. 168, on ap. 6 De G., M. & G. 223. As to what rights might pass to an assignee in bankruptcy, see *ante*, p. 348.

³ "It is true," said Wood, V. C., "that, according to *Stevens v. Benning*, a license like the present would, I apprehend, be restricted to the defendant personally, and would not extend to his executors, or to any future partner or assignee." 4 Kay & J. 664.

where a definite sum has been agreed on for the privilege of publication. In the latter case, the author would not sustain direct pecuniary loss in consequence of a change of publishers. His literary interests might be thereby affected; but it may be doubted whether this circumstance would operate to annul the contract.¹

In ascertaining the respective rights of the parties under an agreement, it is necessary to determine whether an exclusive publication is agreed on, or whether there is reserved to the author the power to license others to publish contemporaneously. Of course this question does not arise when the contract is express on this point. But, not unfrequently, nothing is said concerning the intentions of the parties in this respect. There is no doubt, however, that the publisher may acquire the right of exclusive publication and sale for a definite period, or during the existence of the contract, without express words in the agreement to that effect.² Indeed, in the absence of express words or controlling circumstances to the contrary, the natural presumption in some cases would seem to be that an exclusive publication was understood; since a copyrighted book is usually brought out by but one publisher at the time,

¹ In *Pulte v. Derby*, it appeared that the defendants, who had acquired the right of publication in consideration of paying the author a royalty on each copy sold, had, without the author's consent, transferred to another firm the stereotype plates, under an agreement to publish, and account to the defendants, on the terms of the agreement between the latter and the author. The question whether the defendants had the power to make such transfer of their rights under the contract was not decided. Nor did the court express any opinion on this point, unless the following language had reference to it. After remarking that the legal title to the copyright was in the defendants, but only for the purposes of the contract, Mr. Justice McLean said: "The right covers their interest, and protects it, so long as they shall be engaged in the publication and sale of the work. Beyond this, they are not considered as having the

right. They cannot transfer it. They have no power to assign the copyright, nor to publish the work, except upon the terms of the contract." 5 McLean, 335. The views of the court are here clearly expressed to the effect, that the defendants could not assign the copyright, or transfer their title to it; and the language might reasonably be understood to mean that they were not entitled to transfer the stereotype plates, and authorize another to publish, as they had done. But whether the court was or was not of this opinion cannot be affirmed with certainty.

² *Sweet v. Cater*, 11 Sim. 572; *Stevens v. Benning*, 1 Kay & J. 168; *Warne v. Routledge*, Law Rep. 18 Eq. 497. In *Reade v. Bentley*, 3 Kay & J. 271, 4 Id. 656, though the question was not discussed, it was not denied that the publisher's rights under an indefinite agreement were exclusive during the existence of the agreement.

who undertakes the publication, and expects to realize his profits, on the implied understanding that he is to be the sole publisher for the time agreed on, or as long as the agreement lasts.¹

Unless an assignment of the copyright has been made, the legal title, the possession of which is necessary to sustain an action at law for piracy, remains in the author. But the publisher may acquire an equitable title sufficient for the assertion of his rights in a Court of Chancery.² In the United States, when the copyright is entered in the name of the publisher, the legal title will vest in him for the purposes of the agreement. It is then held in trust for the owner.³

Rights of Parties after Agreement is Ended. — When a contract for an exclusive publication is terminable at will, or by non-compliance with its provisions, the question is raised as to what are the rights of the parties after the agreement has been ended. It is conceded that the publisher may sell all the copies printed under the agreement.⁴ But is this right exclusive, so that he may prevent the author, or any one claiming under him, from publishing until such copies shall have been sold? In *Stevens v. Benning*, Vice-Chancellor Wood, in considering a contract terminable by circumstances, expressed the opinion that the publisher would continue to have the exclusive right of selling the copies which had been printed before the termination of the agreement.⁵

Publisher's Right to Sell after Agreement is Ended held not to be Exclusive. — This issue was directly raised in the recent case of *Warne v. Routledge*. The plaintiffs had orally agreed with Mrs. Cook to publish, at their own expense, a book written by her, and entitled *How to Dress on £15 a Year as a Lady*,

¹ In a recent case, the English Court of Chancery held that a contract between a manager of a theatre and an actor must be understood to be for the exclusive services of the latter during the period for which he had been engaged, though there was no express agreement that he should not act elsewhere. *Montague v. Flockton*, Law Rep. 16 Eq. 189.

² *Sweet v. Cater*, 11 Sim. 572; *Reade v. Bentley*, *infra*.

³ *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402; *Pulte v. Derby*, 5 McLean, 328, 385.

⁴ *Reade v. Bentley*, 3 Kay & J. 271, 4 Id. 656; *Warne v. Routledge*, Law Rep. 18 Eq. 497; *Howitt v. Hall*, 6 L. T. n. s. 348.

⁵ See *ante*, p. 347, note 2.

by a Lady, to sell at a shilling a copy, and to pay her a penny for each copy sold. Nothing was said as to how many copies or how long the plaintiffs should publish, or whether they should be the sole publishers. When forty-four thousand copies had been printed, and forty-two thousand sold, the author notified the plaintiffs of the termination of the agreement, and immediately authorized the defendants to issue a new edition. The plaintiffs now sought to restrain such publication until the copies printed by them under the agreement should be sold. The Master of the Rolls, Sir George Jessel, held that the plaintiffs were entitled to be the exclusive publishers while the agreement lasted; but that after its termination, though they were at liberty to sell the copies previously printed, they had no power to prevent the author or any person claiming under her from publishing.¹

¹ Law Rep. 18 Eq. 497.

“Looking at the nature of the book, and to the circumstance that it was a term of the agreement that the publishers should publish at their own risk and pay the royalty, I think the contract, so long as it existed, must be taken to be an exclusive contract; that is to say, that so long as Messrs. Warne & Co. were allowed to publish, so long no one else could publish,—neither the lady herself, nor an assign from her. That being established, what is the next right it gives to either party? On the determination of the partnership adventure, or whatever you choose to call it, what right had Messrs. Warne & Co. in the book? There is authority upon the subject; but I do not think it wants authority. I think it is plain that no termination of the agreement could deprive them of the right of selling the copies which they have themselves printed under this arrangement. Whether the arrangement was at will or for a term, the publishers must retain the right of selling for their own benefit (subject to the royalty) the copies which they have printed at their own expense, in reliance upon that agreement. So far I go with the plaintiffs; but the plaintiffs then want me to import something

else,—not only that the publishers should have the right to sell any copies they might have printed before the disagreement, but that the owner of the copyright should not have the right to publish at all so long as any copies remain unsold. I cannot find that in the agreement, and it does not seem to be reasonable to import it; because it would come to this, that, if the publishers printed a very large number of copies, it would deprive the authoress of the copyright altogether. I cannot import such an unreasonable term into the agreement.

“Then it is said, that, if you give the publisher no protection, the result may be that the author may publish another edition a day or two after the publishing of the first edition, and so destroy the value of the remaining copies of the first edition remaining unsold. That may be. And it is said that that is so unreasonable that you must infer some stipulation to prevent it. Why? No doubt, partnerships at will have their inconveniences as well as their conveniences. There is no reason why I should make persons take up a totally different position from that which they have agreed to take up, because it might be convenient to one of the parties after the termination of

Above Decision Questioned. — The correctness of the rule laid down in this decision, that the author may publish at any time after notice of the termination of the agreement, and before the publisher has had an opportunity to sell the copies lawfully printed, is open to reasonable doubt. It had not been expressly agreed in this case that the publishers should have the right of exclusive publication. But the court held that such must be taken to be the understood or implied meaning of the contract; because otherwise the publishers, after incurring the cost and assuming the risk of publication, might be unjustly deprived of the profits to which they were entitled. The same reason applies with equal force in determining whether the publisher is to have the sole liberty of selling the copies which he was authorized to print. If the author is free, at any time after giving notice to end the agreement with the first publisher, to license another to publish and sell, the latter may issue a competing edition, and even sell at a lower price, immediately after the first publisher has brought out a large edition at great expense, and before he has had an opportunity to sell any considerable number of copies, or even before he has sold any copies. In this way, the first publisher may not only be prevented from realizing the profits to which he is entitled, but may also be subjected to heavy losses in consequence of the expenses of publication.¹ The Master of the Rolls replied to this argument by saying, that, if the publishers “want that protection,” they “must contract for it.” He might have said, with equal reason, that they could not successfully claim the exclusive right of publication during the existence of the agreement, unless they had contracted for it. But he held that they had acquired that right; and yet they had not agreed for it more clearly than they had for the right of exclusively selling the copies which they had been authorized to print.

the arrangement. If you do want that protection for a term of years, or for a definite term, you must contract for it. That is all. But I cannot import such a term into the contract. If I did, I should make partnerships at will involve consequences that the partners never dreamt of.” Jessel, M. R., *Ibid.* 501.

¹ If Mrs. Cook could lawfully authorize the defendants to bring into the market a new edition, while two thousand copies printed by the plaintiffs remained unsold, she could grant a similar license when forty-two thousand copies, or even the entire number printed, were still in the plaintiffs' stock.

It was conceded in this case that the right both of printing and of selling was exclusive in the defendants during the existence of the contract. It has been seen that the author cannot end the agreement, as far as the printing is concerned, without giving due notice to the publisher; and that such notice, to be operative, must be given before any expense has been incurred on a future edition.¹ Does not the same principle govern in ending the agreement as far as the right of selling is concerned? It is not consistent to hold that the author is powerless to interfere with the printing of an edition when the publisher will thereby incur loss, but that he is free to subject the publisher to a much greater loss by defeating the sale of the edition as soon as it is published. The publisher prints with the understanding that his right to sell is to be exclusive; and, as has been seen, this right is conceded to be exclusive, while the agreement lasts. Is not the author bound, as in the case of printing, to give due notice before he can annul that right; and must not such notice, to be operative, be given before the copies are printed? In other words, is not the author powerless to end the agreement, as far as the selling is concerned, until the copies printed shall have been sold?

It may be objected that, if the author cannot publish while any copies printed under the agreement remain unsold, he may practically be deprived of his copyright, since there may be little or no demand for such copies; or it may be said, the publisher may neglect or refuse to sell them. It is clear that the latter has no right to neglect or refuse to sell. If there is no demand for the copies printed, or if the demand be insignificant, the first publisher would not sustain any material loss by the author's permitting another publisher to publish a new edition; and a court of equity might refuse to interfere with such publication. While there is a fair demand for the copies printed by the first publisher, the author is not deprived of his copyright nor the benefits for which he bargained; since he is entitled to the royalty on the copies sold, or other consideration, for which the agreement was made.

The question under consideration is not free from doubt and

¹ *Reade v. Bentley*, 3 Kay & J. 271, 4 Id. 656.

difficulty. The true doctrine would seem to be, that an agreement which is indefinite as to the time of its continuance, and as to the number of copies to be published, and which, while it continues, gives to the publisher the exclusive right of printing and of selling, cannot be ended until a reasonable time for selling the copies printed under it has passed. The publisher may at any time be prevented from printing a future edition on which he has incurred no expense; but it would seem that he is entitled to have a fair opportunity to sell exclusively the copies which he has printed on his faith in the agreement.¹

Held in England that Buyer of Copyright for Limited Time may Sell all Copies Printed during that Time. — Where it had been agreed that the publisher should have “the copyright and sole right of sale for four years,” Vice-Chancellor Wood held that the right of printing and selling reverted to the author at the end of the four years, but that the publisher was entitled to

¹ *Willis v. Tibbals*, 1 Jones & Sp. (N. Y.) 220, was an action in the New York Superior Court, growing out of the alleged breach of a contract for the publication of a book written by the plaintiff. The agreement, which appears to have been oral, was that the defendant should publish the book, and pay to the plaintiff a royalty on each copy sold. It was not specified how long the publication should continue, or how many copies should be published, nor whether the defendant was to be the exclusive publisher. When eight thousand copies had been printed, and before all of them had been sold, the author, without notifying the publisher of his intention to end the agreement, and without the knowledge of the latter, authorized another firm to publish the book. The action was brought by the author for the recovery of money alleged to be due under the contract; but the counter-claim, set up by the defendant for damages sustained in consequence of the publication and sale of the book by another publisher, raised the question whether the defendant had acquired the right to be the exclusive publisher during

the existence of the contract, or whether during that time the author was at liberty to license another to publish. The fact that the plaintiff had granted such a license, without taking any steps to end his agreement with the defendant, raised, or should have raised, the vital question, which had been so elaborately discussed and decided in the two suits of *Reade v. Bentley*, whether an author is at liberty at any time, and without giving any notice, arbitrarily to end an indefinite contract which he has made with a publisher. This question, whose determination was essential to a right decision of the case, is not referred to in the reported opinion. The court held that, in the absence of an express agreement to that effect, the defendant had not acquired the right of exclusive publication; and, in effect, that the plaintiff, without taking any steps to end his contract with the defendant, was entitled at any time to authorize another to publish. This decision was rendered without any reference, as far as appears from the report of the case, to the leading authorities on the subject, and is entitled to little consideration.

sell after the expiration of that term the copies which he had printed in good faith during the term.¹

And that, after Sale of Copyright, Seller may Sell Copies Printed before Sale. — It has also been held that, after he has assigned his copyright, the assignor is free to sell any copies of the book which he had printed before the assignment was made.² In this, as well as the case last referred to, there was no express agreement or mutual understanding as to the sale of the copies in dispute. Of course, if an express or an implied agreement had been proved, the rights of the parties would have been determined by it.

Law Claimed to be Different in United States. — The two cases under consideration were decided under the English statute. The soundness of the decisions has been questioned elsewhere in this work, and it is maintained that a different construction should be given to like agreements in this country: that the buyer of a copyright for a limited term is not entitled, without the consent of the owner, to sell copies after that term has ended; and that an assignment of the copyright divests the assignor of the right of sale.³

Negative Covenant by Author. — It has been seen that an author, in agreeing with a publisher for the exclusive publica-

¹ *Howitt v. Hall*, 6 L. T. N. S. 348. "The copyright acts," said the Vice-Chancellor, "were directed against printing (8 Anne, c. 19, and 5 & 6 Vict. c. 45, s. 15); and when, as in this case, the defendant had acquired the right of lawfully printing the work, he was at liberty to sell at any time what he had so printed. The words, 'sole right of sale,' might or might not have been superfluous; but after four years the right to print the work reverted to the author, who had taken care to secure himself in that respect. It had been suggested that the effect might be to destroy the copyright in the author altogether, as the publisher, who had purchased the copyright for a limited period only, might during that period print off copies enough to last for all time. Probably a nice question might have arisen as to the number of copies of which an edition might consist; but

a publisher was not likely to incur the useless expense of printing copies enough to exhaust the demand for all time, and have them lying on his hands unprofitably. But the answer was palpable, that, if the author wished to guard against such a contingency, he might easily secure himself by stipulating what number of copies was to be printed. Should, however, a case of fraud be established against a publisher under such a state of circumstances, the court could deal with it. But no case of fraud was alleged in the present case. What the defendants had done appeared to him (the V. C.) to have been done perfectly *bona fide*; and they were entitled under the contract to do what they had done." *Ibid.* 350.

² *Taylor v. Pillow*, Law Rep. 7 Eq. 418.

³ See *ante*, pp. 338-342.

tion of a literary composition, binds himself not to publish, or permit a third person to publish, the same work while the first publisher's rights are exclusive. So also an author, in giving one person the right to publish a book, may covenant not to write another work on the same subject, or to take part in a rival publication, or to do any thing to defeat or prejudice the sale of the first composition. Lord Eldon held that a covenant made with his copartners by the dramatist Colman, not to write plays for any other theatre than the Haymarket, was not analogous to a contract in restraint of trade and against public policy.¹

It may be regarded as settled that a Court of Chancery will restrain an author, or any person having notice, from violating an express negative covenant made by the author;² and it has been held that a third person, without notice of the covenant, may be enjoined from publishing or selling a book in violation of it.³ The same principle would doubtless apply in the case of a negative covenant, not express, but clearly implied and understood by all the parties. It has been held that an actor may bind himself by an implied stipulation not to act in any other theatre than that for which he is regularly engaged; and a court of equity will enjoin him from violating such covenant.⁴ There is no reason why literary contracts should not come within the same rule.⁵

Author may not Reproduce Work after Sale of Copyright. — After an author has sold the copyright in a book, he is not free to reproduce substantially the same matter in another work. Even in the absence of any special agreement, the

¹ *Morris v. Colman*, 18 *Yes.* 437. "I cannot therefore," said the Lord Chancellor, "see any thing unreasonable in this. On the contrary, it is a contract which all parties may consider as affording the most eligible, if not the only, means of making this theatre profitable to them all as proprietors, authors, or in any other character which they are by the contract to hold."

² *Barfield v. Nicholson*, 2 *Sim. & St.* 1; *Brooke v. Chitty*, 2 *Coop.* (*temp.* Cottenham) 216; *Colburn v.*

Simms, 2 *Hare*, 543, 558; *Warne v. Routledge*, *Law Rep.* 18 *Eq.* 497; *Ward v. Beeton*, *Law Rep.* 19 *Eq.* 207.

³ *Colburn v. Simms*, *supra*; and see *Barfield v. Nicholson*, *supra*.

⁴ *Montague v. Flockton*, *Law Rep.* 16 *Eq.* 189. See also *Webster v. Dillon*, 3 *Jur. n. s.* 432; *Fechter v. Montgomery*, 33 *Beav.* 22; *Daly v. Smith*, 6 *Jones & Sp.* (38 *N. Y. Superior Ct.*) 158.

⁵ For a further consideration of this subject and the authorities bearing on it, see latter part of Chap. XI.

second publication would be an infringement of the copyright in the first.¹

May Publisher make Changes in Author's Manuscript ? —
The question has been raised, whether a person who has acquired the right to publish a manuscript is at liberty to make alterations in it without the consent of the author. In *Cox v. Cox*,² it appeared that the defendant, in preparing a book for the use of tenants and owners of property, had engaged the plaintiff, for a specified sum, to write the legal part, and also to revise or rewrite the part prepared by the defendant. In the agreement, nothing was said about the copyright, or in whose name the work should be published, or whether the plaintiff's name should appear as the author of that which he was to write. On receiving the manuscript, the defendant objected to the length and technical treatment of the part contributed by the plaintiff, which led to a controversy as to whether alterations and omissions should be made in this part, or whether it should be printed without change. But no definite agreement on this point seems to have been reached. The defendant proceeded with the printing; and, on reading the proof-sheets, the plaintiff learned that extensive omissions and changes in the legal part had been made without his knowledge or consent. The plaintiff now sought to enjoin the publication of the work, on the ground that such use of his manuscript would be injurious to his reputation, and also on the ground that he had not been paid for his services. The court finding that "the plaintiff was evidently in the subordinate position of assisting in the production of a work which was to come out in the name, and as the work of, the defendant," and that there had been proved no stipulation that the defendant should not make any alteration in the manuscript, refused to grant the injunction. It was further held, that the plaintiff's remedy for money due was at law.³

¹ *Rooney v. Kelly*, 14 Ir. Law Rep. n. s. 158; *Colburn v. Simms*, 2 Hare, 548. The 25 & 26 Vict. c. 68, s. 6, expressly prohibits the artist from reproducing a painting or photograph after he has sold the original.

² 11 Hare, 118.

³ After the agreement had been made, the plaintiff obtained permission from the defendant to publish the legal part in separate form; but the Vice-Chancellor held that this was a voluntary arrangement that did not affect the original contract.

The special facts on which this decision was based should be distinctly borne in mind. The court intimated that a different rule would apply to different facts.¹ The case decides nothing as to the right of a person to make alterations in a manuscript which is to be published as the work and in the name of its author. Whatever liberties may be taken with a production with which the author's name is not connected, or whatever may be the rights of a publisher in making unimportant or harmless changes in a work for whose composition the author is to be held responsible, it cannot be successfully maintained that a publisher, whether he has bought the copyright or is merely licensed to publish, is at liberty, without the consent of the author, to make whatever changes he may please in a composition to be published in the name of the author. In the absence of an express understanding or special circumstances to that effect, such a privilege is not even impliedly given by a sale of the copyright, or a license to publish. The unauthorized exercise of such freedom with a manuscript might seriously hurt the reputation of the author; and there is no principle to defeat his right in equity to prevent such publication by injunction, or in law to recover damages for the injury sustained in consequence of the publication. A Court of Chancery has enjoined the publication of a book falsely represented to be the work of a well-known author;² and a court of law

¹ "A serious question," said Wood, V. C., "was then adverted to,—but it is one which does not arise in this case,—how far a party who had purchased a manuscript has a right to alter it, and produce it in a mutilated form?—how far, in a case in which the property has completely passed, it is to be assimilated to a case of goods sold and delivered, and thenceforward in the complete dominion of the purchaser? A qualified contract may be made: an essay may be supplied to a magazine or an encyclopædia on the understanding that it is to be published entire; and it may be accepted by the editor, and paid for as what it purports to be. In the instance of an essay which has been accepted in that shape, the question might arise, whether any

curtailment could be allowed under that special contract. But here there is no such special contract. The contract is that the plaintiff shall supply the defendant with the matter which is required, in such a form as to enable the defendant to publish it as his own. I can find no circumstances from which any such special contract as I have mentioned can be inferred. The plaintiff has indeed sought to make it a stipulation that his contribution of the legal materials shall not be published otherwise than entire; but this stipulation has no foundation in the original contract upon which his case rests." 11 Hare, 124.

² *Byron v. Johnston*, 2 Meriv. 29; *Harte v. De Witt*, 1 Cent. Law Jour. 360.

has awarded damages for the injury done to the reputation of an author by the publication of an erroneous edition of a book, edited by another, but with a title-page tending to mislead the public to believe that the edition had been revised by the author.¹ In the latter case, the publisher charged with wrong was the owner of the copyright by purchase from the author; and in both cases the controlling principle was, that a person shall not be held up to the public as the author of that which he has not written. The general principle is the same when what is published is materially different from that written by the author.

Publisher Liable for Injury to Author by False Representations as to Authorship of Revised Edition. — When a publisher is the absolute owner of the copyright, he is entitled, without the consent of the author, to publish successive editions of the work, with additions and corrections; and, in bringing out new editions, may perhaps make such omissions and other changes in the original as will not injure the reputation of the author. But such revision, when done by another, cannot lawfully be represented as having been made by the author of the original. In *Archbold v. Sweet*,² the facts showed that the plaintiff, having prepared a second edition of his work on criminal law, had sold the copyright to the defendant, who published the book. Afterward, the defendant published a third edition, prepared by an editor whose name did not appear in the book. The title-page represented the work to be “A Summary of the Law relative to Pleading and Evidence in Criminal Cases, . . . by J. F. Archbold, Esq., Barrister at Law. Third edition, with very considerable additions.” The plaintiff proved that there were numerous gross blunders in the third edition, and alleged that his reputation would thereby be injured, as the public would be led to believe that that edition had been prepared by him. Lord Tenterden instructed the jury, that if they found that buyers, using reasonable care, would be led to believe that the third edition had been revised by the plaintiff, the latter was entitled to damages. The verdict was against the defendant.

¹ *Archbold v. Sweet*, *infra*.

² 5 Car. & P. 219. See *Seeley v. Fisher*, 11 Sim. 581, treated in latter part of Chap. XI.; also, *Wright v.*

Tallis, 1 C. B. 893, where it was held that there can be no copyright in a book falsely represented to be the work of a well-known author. See *ante*, p. 196.

Publisher Entitled to Damages when Author Refuses to Supply Rest of Manuscript after Part is Printed. — Where it had been agreed that the publishers should publish a manuscript at their own expense, and divide the profits with the author, and, after part of the book had been printed, the author refused to supply the rest of the manuscript, it was held, in an action for breach of contract, that the publishers were entitled to recover the amount which they had expended in printing, and of the profits which they would probably have realized by publication. In answer to the objection that the action was brought by one partner against another for the recovery of partnership profits, and therefore could not be maintained, Lord Ellenborough said: “The action is not brought against the defendant to recover partnership profits, but for not contributing his labor towards the attainment of profits to be subsequently divided between the parties.”¹

Copies Printed to Replace those Destroyed by Fire not a New Edition. — It has been held by the Scotch Court of Session that an editor, under an agreement that he should prepare every new edition of a work, and should receive a certain sum for his services, is not entitled to superintend or to claim pay for, the reprinting of a part of the work to replace copies destroyed by fire. The copies reprinted under such circumstances do not form a new edition, but go to replace the part of the edition destroyed.²

Unlawful Publications. — A contract for the publication of a book which it is unlawful to publish is not valid.³ But where

¹ *Gale v. Leckie*, 2 Stark. 108. In *Brook v. Wentworth*, decided in 1798, 3 Anstr. 881, it appeared that the plaintiff had agreed to publish a work written by the defendant, and that the former should have a part of the profits, and be reimbursed by the author for money advanced for publication. Having advanced a considerable sum, the publisher refused to go on with the printing until what was due him should be paid. The defendant then agreed with another bookseller for the publication of the book, when the plaintiff applied for an injunction to restrain such publication until he should be paid the amount of his claim. The court expressed the opinion that “the plaintiff was entitled to have an in-

junction on such an agreement, as well as if he had absolutely purchased the copyright.” But a settlement was made by the parties.

As this was simply a claim for money by the plaintiff, who did not seek to enforce a right to publish the book, and did not allege any injury arising from publication by another, it may be doubted whether this was a case for an injunction. The plaintiff’s remedy was an action at law for breach of contract as in *Gale v. Leckie*, *infra*, and *Cox v. Cox*, 11 Hare, 118.

² *Blackwood v. Brewster*, 23 Sc. Sess. Cas. 2d ser. 142.

³ *Gale v. Leckie*, 2 Stark. 107; *Poplett v. Stockdale*, 1 Ryan & M. 337; *Clay v. Yates*, 1 Hurl. & N. 73.

this defence was set up, and the work itself was not produced, and no evidence of its character was offered, the court instructed the jury that they were not to presume that the book was obnoxious.¹

It has been held that a printer cannot maintain an action against a publisher for money due for printing an obscene book.² But where a printer, after printing part of a book, received the manuscript of the other part, and found it to be libellous, it was held that he was not bound to print the libellous part, and was entitled to recover for what he had printed.³

Cyclopædias and Periodicals. — In England, there are statutory provisions concerning the respective rights of author and publisher in articles published in cyclopædias, magazines, reviews, and other periodicals.⁴ In the absence of an express or implied agreement to the contrary, a license to use a composition in a named publication gives the publisher no right to publish it in a separate or other form not within the meaning of the contract.⁵ And the same is true independently of the statutory regulations.⁶

¹ Gale v. Leckie, 2 Stark. 107.

² Poplett v. Stockdale, 1 Ryan & M. 337. Best, C. J., said that "no person who has contributed his assistance to the publication of such a work can recover in a court of justice any compensation for labor so bestowed. The person who lends himself to the violation of the public morals and laws of the country shall not have the assistance of those laws to carry into execution such a purpose."

³ Clay v. Yates, 1 Hurl. & N. 73. "I told the jury," said Pollock, C. B., "that if the plaintiff agreed to print the dedication and the treatise, and so undertook to print that which he knew to be libellous, and afterwards said that he would not print both, in such case he could not recover. I think his right to recover rests entirely on this ground, that he had been furnished with the treatise without the dedication. The dedication was afterwards sent; but he had no opportunity of reading it until after it was printed.

He then discovered that it was libellous, and refused to permit the defendant to have it. I think that if a contract is *bona fide* entered into by a printer to print a work consisting of two parts, and at the time he enters into the contract he has no means of knowing that one part is unlawful, and he executes both, but afterwards suppresses that which is unlawful, there is an implied undertaking on the part of the person employing him to pay for so much of the work as is lawful." Ibid. 78.

⁴ 5 & 6 Vict. c. 45, s. 18.

⁵ Bishop of Hereford v. Griffin, 16 Sim. 190; Mayhew v. Maxwell, 1 Johns. & H. 312; Smith v. Johnson, 4 Giff. 632; Strahan v. Graham, 16 L. T. n. s. 87, on ap. 17 Id. 457. For a fuller consideration of the rights of the parties to an agreement governed by section 18 of 5 & 6 Vict. c. 45, see *ante*, p. 243.

⁶ Stewart v. Black, 9 Sc. Sess. Cas. 2d ser. 1026. The rights of the respective parties in the United States

Where an author had been engaged to write an article for a periodical, and before the article was done, and before the publication or delivery of any part of it, the periodical was discontinued, it was held that the publishers were not entitled to claim the completion of the article for publication in a separate form, but were bound to pay a fair sum for the part that had been written.¹

Title of Magazine Partnership Property. — Where an editor and publishers have formed a partnership for the publication of a magazine of which they are joint owners, the editor, having taken steps to dissolve the partnership with the view of establishing another periodical, is not at liberty to advertise the discontinuance of the first magazine. The title of the latter and the right to publish it are partnership property, and may be sold for the benefit of the partners. But the editor may advertise its discontinuance by him, or as far as he is concerned.²

Name of Editor not Part of Title. — In *Crookes v. Petter*,³ it appeared that an agreement had been made that the plaintiff, for a sum to be determined by the number of copies sold, should be the editor of a periodical owned by the defendants, and to be published by them under a title to be agreed on. After it had been published for about a year with the title or heading, “The Photographic News, a Weekly Record of the Progress of Photography, Edited by W. Crookes, F. C. S.,” and with a printed notice that all editorial communications should be addressed to the editor, the plaintiff sought to have the defendants enjoined from interfering with his editorial management, and from publishing the periodical without his name as editor appearing in the title, or in some other place, or without a printed notice that editorial communications should be addressed to him. The court refused to grant an injunction on the grounds that the title of the periodical had not been changed by the omission of the editor’s name, which was not a

in the case of articles published in magazines and other periodicals are considered, *ante*, p. 259.

¹ *Planché v. Colburn*, 5 Car. & P. 58, on ap. 8 Bing. 14.

² *Bradbury v. Dickens*, 27 Beav. 53. See also *Constable v. Brewster*, 3 Sc. Sess. Cas. 214; *Hogg v. Kirby*, 8 Ves. 215.

³ 3 L. T. N. s. 225.

part of the title, and that there was no stipulation, express or implied, in the agreement that the defendants should not do what the plaintiff sought to enjoin them from doing.

Joint Owners of Copyright. — Joint owners of the copyright may make any agreement between themselves with reference to the printing, publication, and sale of a book; and such contract will be binding on them, although it may not be valid as far as other persons are concerned.¹

In *Carter v. Bailey*, it was held by the Supreme Court of Maine that one owner in common of a copyright, who at his own expense has published and sold the book copyrighted, is not liable, in the absence of an agreement *inter sese*, to account to his co-owner.²

Literary Contracts Governed by Statute of Frauds. — There appears to be no reason why the general principles of the Statute of Frauds should not apply to literary as well as to other contracts.³ In *Sweet v. Lee*,⁴ it appeared that the agreement for the publication of a dictionary of legal practice was contained in a memorandum which was signed with the initials

¹ *Gould v. Banks*, 8 Wend. (N. Y.) 502. "There is no principle or authority," said Nelson, J., "which will inhibit such a contract between parties, because they may be partners in the subject-matter of it. They may bind themselves by a private agreement concerning the partnership business; but, so far as third persons may be interested, it would be inoperative as to them." *Ibid.* 568.

² 64 Me. 458. "In the absence of any contract modifying their relations," said Virgin, J., "they are simply owners in common, as the plaintiff has alleged, each owning a distinct but undivided part, which, or any part of which, alone he can sell, as in the case of personal chattels. The statute confers upon all the owners full power, without exacting any obligation in return, to print, publish, and sell. It gives no superior right to either, — the only restriction being as to time. All others within that period, having no license from them or some one of them, are excluded. Each can exercise

his own right alone, without using or receiving any aid or benefit whatever from the title or property of the others. But if none be allowed to enjoy his legal interest without the consent of all, then one, by withholding his consent, might practically destroy the value of the whole use. And a use only upon condition of accounting for profits would compel a disuse, or a risk of skill, capital, and time, with no right to call for a sharing of possible losses. When one owner, by exercising a right expressly conferred upon him, in no wise molests the right, title, possession, or estate of his co-owners, or hinders them from a full enjoyment, or sale and transfer, of their whole property, we fail to perceive any principle of equity which would require him to account therefor. If owners of such property would have the result otherwise, they must bring it about by contract." *Ibid.* 463.

³ See *Strahan v. Graham*, 16 L. T. n. s. 87, on ap. 17 *Id.* 457.

⁴ 3 Man. & Gr. 452.

of the publisher and of the author ; and was to the effect that the latter should receive £80 a year for five years, and £60 a year for the rest of his life, if he should live longer than five years. This was held to be void under the Statute of Frauds ;¹ because, being a memorandum of an agreement not to be performed within a year, no consideration was expressed on the face of it, and it was without any signature other than the initials of the parties. The plaintiff, therefore, was not entitled to damages claimed to have been sustained by the failure of the defendant to perform his agreement to prepare a new edition. Nor, although the contract was void, could the plaintiff, having paid for several years the sums mentioned in the memorandum, recover the money so paid on the ground of failure of consideration.

An agreement by a printer to find the paper and print a book has been held not to be a contract for the sale of goods within the Statute of Frauds.² The printer is entitled under a verbal agreement of this kind to recover for work done and materials supplied.³

¹ 29 Car. II. c. 3, s. 4.

² 29 Car. II. c. 3, s. 17, as extended by 9 Geo. IV. c. 14, s. 7.

³ *Clay v. Yates*, 1 Hurl. & N. 73.

CHAPTER VIII.

PIRACY.

Piracy Defined, and Distinguished from Plagiarism.— In the law of copyright, piracy is the use of literary property in violation of the legal rights of the owner. The meaning of infringement is the same. Neither word is properly used where no legal rights are invaded. Hence, strictly speaking, it is not piracy to take without authority either a part or the whole of what another has written, if neither a statute nor the common law is thereby violated. Such act may be plagiarism, which is a moral but not necessarily a legal wrong; but, to constitute piracy, there must be an act against the law. Plagiarism further differs from piracy in that the plagiarist falsely offers as his own what he has taken from the writings of another. The pirate may or may not do this. Hence, there may be an unauthorized appropriation of literary property which is neither piracy nor plagiarism, as the republication in the United States of the work of a foreign author. This is not piracy, because no law is violated; and, without misrepresentation as to authorship, it is not plagiarism. So, also, the same act may be at once plagiarism and piracy.

The word piracy is applied to the unlawful taking of any kind of intellectual property, whether literary, dramatic, or art. Nor is its use restricted to productions published and protected by statute. The violation of common-law rights by publicly reading a literary composition, representing a manuscript drama, making or exhibiting copies of a work of art, may properly be called piracy.

Fundamental Principles by which Piracy is Determined.— The legislature has not defined piracy, or indicated how far a person may lawfully go in appropriating the results of another's labors. The English statute prohibits any one without au-

thority from printing, publishing, importing, or selling "any book in which there shall be subsisting copyright."¹ The law of the United States prohibits the printing, publication, sale, or importing of "any copy" of a book entitled to protection.² The language of the earlier statutes in both countries was substantially the same. "Book" in the English, and "copy" in the American, law are here used for the same purpose, and with the same meaning; but both acts are silent as to what that purpose and meaning are. A literal reprint of an entire work is obviously a copy. But is the republication of a part of a book within the statutory prohibition? Is the meaning of the word copy, as here used, limited to *verbatim* transcripts, or does it extend to paraphrases and servile imitations? Is the unlicensed translation, dramatization, or abridgment of a copyrighted work piratical? Did the legislature intend to protect the substance of a literary composition, or merely its verbal form? These and kindred questions have been left to the courts. They are to be determined by adjudicated principles.

The declared object of the copyright laws is to encourage learning, and to secure authors in the enjoyment of the fruits of their labors. As a means to this end, the legislature has guaranteed protection to literary property, and has declared the unlicensed use of that property to be piracy. We must first understand what that is for which protection is given, before we can determine what is an unlawful use of it. It has been shown elsewhere that literary property is not limited to the precise form of words, the identical language, in which a composition is expressed, but that it is in the intellectual creation of which language is but a means of expression and communication.³ The same production may be expressed and communicated in various languages, without affecting its identity. The means of communication are changed; but the thing communicated remains the same. So, in the same language, the words may be varied; but the substantial identity of the composition is preserved. It is this intellectual produc-

¹ 5 & 6 Vict. c. 45, s. 15.

² U. S. Rev. St. s. 4964.

³ See *ante*, p. 97.

tion, and not merely one form of language in which it may be expressed, which is the fruit of the author's genius or mental labor. It is this which is his property, and to which the law guarantees protection. It is this whose unlawful appropriation is piracy. Property cannot exist in simple ideas and thoughts; but only in their arrangement and combination. It is this association that forms a literary composition; and, unless this or a substantial part of it be taken, there is no appropriation of property. Hence ideas, thoughts, sentiments, &c., wherever found, may be appropriated by any one. But, to take them in their association is to take the production itself. To reproduce the whole or a large part of the composition, even though the language of the original be paraphrased or translated, is to appropriate what another has produced, and what rightly belongs to him.

True Test of Piracy. — As the owner of material possessions may assert his rights wherever or in whatever disguise his property is found, so the author of a literary composition may claim it as his own, in whatever language or form of words it can be identified as his production. The true test of piracy, then, is not whether a composition is copied in the same language or the exact words of the original, but whether in substance it is reproduced; not whether the whole, but whether a material part, is taken. In this view of the subject, it is no defence of piracy that the work entitled to protection has not been copied literally; that it has been translated into another language; that it has been dramatized; that the whole has not been taken; that it has been abridged; that it is reproduced in a new and more useful form. The controlling question always is, whether the substance of the work is taken without authority.

If the provision of the English statute which declares that no one without license shall publish "any book" protected by copyright, or that of the American act which prohibits the unauthorized republication of "any copy" of a copyrighted work, were construed to mean, that the law is violated only when a literal copy of the work is reprinted, it is obvious that there would be practically little protection for literary property; and the purpose of the legislature would be almost wholly defeated.

To escape the penalty of piracy, it would only be necessary to paraphrase or translate the language of the original, or reproduce the work in another form. In this way, all that is valuable in a literary production might be appropriated by any one with impunity. I have endeavored to explain the true fundamental principles which govern piracy, and to point out those by whose application alone effect can be given to the intent of the legislature, and the protection guaranteed to literary property by the copyright statutes be secured. On these principles rest the great body of the judgments relating to piracy. In some cases, they have been overlooked or disregarded, and judicial opinions and *dicta* marked with inconsistency and injustice have been expressed. But, in general, the courts have liberally and soundly expounded the law, and established principles broad enough to protect the substantial fruits of literary labor. Mr. Justice Story affirmed a fundamental principle of the law of copyright when he held that a work, to be free from piracy, must be the result of the author's "own labor, skill, and use of common materials and common sources of knowledge open to all men."¹ And Vice-Chancellor Wood, afterward Lord Chancellor Hatherley, following a long line of English decisions, gave expression to the same principle, when he said, "No man is entitled to avail himself of the previous labors of another, for the purpose of conveying to the public the same information, although he may append additional information to that already published."²

LAWFUL USES OF COPYRIGHTED WORKS. — I. FAIR USE BY QUOTATION.

It is a recognized principle that every author, compiler, or publisher may make certain uses of a copyrighted work, in the preparation of a rival or other publication. The recognition of this doctrine is essential to the growth of knowledge; as it would obviously be a hindrance to learning if every work were a sealed book to all subsequent authors. The law, therefore, wisely allows a "fair use" to be made of every copy-

¹ *Emerson v. Davies*, 3 Story, 798.

² *Scott v. Stanford*, Law Rep. 3 Eq. 724.

righted production ; and this liberty is consistent with the true purpose of the law to give to the earlier author adequate protection for the results of his labor. But to determine the extent of this license, and to draw the line between a fair and an unlawful use, is often one of the most difficult problems in the law of copyright. The question must generally be determined by the special facts in each case. What will be considered a fair use in one case may amount to piracy in another. The question of fair use will be considered under two heads: First, when *verbatim* extracts have been taken from the copyrighted work, either with or without acknowledgment ; second, when the copyrighted work has been otherwise used in the preparation of another publication.

Extracts for Criticism. — Of the former class, the most common instances arise when extracts are taken for purposes of criticism or review. The critic or reviewer may make liberal quotations from the original work, with or without acknowledgment of the source, and either for favorable or unfavorable comment. The criticism and extracts may be published in a newspaper, magazine, book, or other form. But, in the exercise of this privilege, no person will be allowed to republish in the form of quotations a valuable part of a copyrighted work, and thus to an injurious extent to supersede the original.¹

¹ *Br. Roworth v. Wilkes*, 1 Camp. 94; *Wilkins v. Aikin*, 17 Ves. 422; *Whittingham v. Wooler*, 2 Swans. 428; *Mawman v. Tegg*, 2 Russ. 385; *Bell v. Whitehead*, 3 Jur. 68; *Campbell v. Scott*, 11 Sim. 31; *Bohn v. Bogue*, 10 Jur. 420; *Black v. Murray*, 9 Sc. Sess. Cas. 3d ser. 341; *Bradbury v. Hotten*, Law Rep. 8 Exch. 1; *Smith v. Chatto*, 31 L. T. n. s. 775. **Am.** *Folsom v. Marsh*, 2 Story, 100; *Story's Executors v. Holcombe*, 4 McLean, 306; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402.

“A Review will not in general serve as a substitute for the book reviewed ; and even there, if so much is extracted that it communicates the same knowledge with the original, it is an actionable violation of literary property.” Lord Ellenborough, *Roworth v. Wilkes*, 1 Camp. 98.

“Reviewers may make extracts

sufficient to show the merits or demerits of the work ; but they cannot so exercise the privilege as to supersede the original book. Sufficient may be taken to give a correct view of the whole ; but the privilege of making extracts is limited to those objects, and cannot be exercised to such an extent that the review shall become a substitute for the book reviewed.” Clifford, J., *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 428.

“Acknowledged quotations, even from copyright works, if they are quotations fairly made, either for the purposes of criticism or of illustration, are not infringements of copyright. To hold any thing else would be to sentence to death all our reviews, and the greater part of our works in philosophy. If indeed the quotation is colorable, and made for the mere pur-

Test of Fair Use in Case of Criticism. — Whether the limits of lawful quotation have been exceeded is a question governed by the circumstances of each case. It is to be determined not by the intention of the critic or reviewer, but by the character of his publication and the purpose which it serves. The controlling inquiries will be, whether the extracts are of such extent, importance, or value that the publication complained of will supersede to an injurious extent the original work. Is a material and valuable part of the contents of the original communicated by the compilation? Will the latter tend to diminish the sale of the former, by reason of being wholly or partly a substitute? If so, the results of the original author's labors are appropriated to his injury, and his rights are invaded.¹

Unfavorable Criticism. — An important consideration in these cases is the injury done to the author entitled to protection. But this injury must arise from the tendency of the publication containing the extracts to supersede the work from which they are taken. Damage done to a work by unfavorable criticism of its contents does not enter into the question of infringement.

Extracts for Other Purposes than Criticism. — The principle of inserting a large portion of the copyright work, the result would be different. In the present case, I see nothing in the quotations colorable or improper. Though they are of some length, they are a very small portion of the entire work. They are fairly and legitimately applied to the illustration of the ballads to which they are appended. They may have fittingly applied to them the test which is often referred to in questions of copyright; namely, whether they are likely to injure the sale of the alleged copyright work. I am of opinion that they are likely to do the very reverse of this. I think no one can read these quotations, and rest content till he has acquired and read the whole of that exquisite novel, at whatever cost within his means." Lord Kinloch, *Black v. Murray*, 9 Sc. Sess. Cas. 3d ser. 356.

¹ "We must often," said Mr. Justice Story, "in deciding questions of this sort, look to the nature and object of

the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work." *Folsom v. Marsh*, 2 Story, 116. Referring to this language as cited by Vice-Chancellor Wood in *Scott v. Stanford*, Law Rep. 3 Eq. 722, Vice-Chancellor Hall said: "But I do not understand the Vice-Chancellor to say that we must find all these things concurring, in order to entitle a plaintiff to relief in this court." *Smith v. Chatto*, 31 L. T. n. s. 776.

"The inquiry is," said Mr. Justice McLean, "what effect must the extracts have upon the original work? If they render it less valuable, by superseding its use in any degree, the right of the author is infringed; and it can be of no importance to know with what intent this was done." *Story's Executors v. Holcombe*, 4 McLean, 310.

on which these privileges are accorded to reviewers will justly claim recognition in the case of other works whose purpose is not strictly that of criticism, but in which fair quotation may be used for the advancement of knowledge and without harm to the original author. Thus, in the case of two or more treatises on the same subject, it is not uncommon for the later author to quote the language of his predecessor, either to corroborate his own statements or to show the diversity of views held by other writers. Especially among writers of law books does this custom prevail; and its lawfulness, when kept within reasonable bounds, should be judicially recognized. When quotations are thus made to serve a legitimate purpose, good rather than harm may be done to the earlier author. But when it appears that the purpose of the later author is to save himself labor by taking the fruits of another's industry and learning, and the extracts are of such extent and character as to give a material value to the subsequent treatise, to the substantial injury of the earlier one, a case of infringement may be made out. For obvious reasons, the test of piracy will be applied with more stringency in the case of rival works than when the extracts are used simply for purposes of criticism or illustration.

So the law may be somewhat liberally construed in the case of an author who has taken copyrighted selections to a moderate extent, and fairly used them for illustration or other legitimate purpose in a history of philosophy, literature, poetry, &c.; in a treatise whose purpose is to give a biography of the author from whose publications the quotations are made, an explanation of his theories, an analysis of his character, works, &c.; or in other productions whose object is different from that of the protected publication, and whose tendency is not to supersede the original. Here, also, the freedom of making quotations will generally be more restricted than in the case of works of criticism, for the reason that publications of the former kind have a greater tendency to supersede the original than have those of the latter. But when this tendency is not manifest, and the extracts are fairly used simply for purposes of illustration or corroboration, there seems to be no ground for a case of piracy.

Selections to Illustrate Work on Poetry.—In *Campbell v. Scott*, it appeared that the defendant had published a Book of the Poets, the alleged purpose of which was to illustrate the characteristics of various poets, and the progress of English poetry during the nineteenth century. It was claimed that the selections were made with this view alone, and that the tendency of the book was not to supersede the original works, or to injure their authors. But in the Book of the Poets four hundred and twenty-five selections and extracts, from forty-three poets, were used to illustrate an original essay, twenty-four pages long, on English poetry of the period covered, twenty-three biographical sketches of one page each, and twenty shorter notices of authors. Besides extracts, six poems entire were taken from Campbell's works. The chief value of the compilation was obviously in the selections, and not in the original matter; and the court rightly held that the limits of lawful quotation had been exceeded.¹

For Biography.—A recent English case brought into controversy a book entitled "Thackerayana: Notes and Anecdotes, Illustrated by nearly Six Hundred Sketches, by William Makepeace Thackeray." It purported to be a kind of biography of that novelist, proceeding on the assumption that his own experiences were narrated in certain of his novels. Besides some previously unpublished sketches and caricatures by Thackeray, the publication contained extensive selections from his published works, the copyright of which belonged to the plaintiff.

¹ 11 Sim. 81. Vice-Chancellor Shadwell said: "Then is the work complained of any thing like an abridgment of the plaintiff's work, or a critique upon it? Some of the poems are given entire; and large extracts are given from other poems; and I cannot think that it can be considered as a book of criticism, when you observe the way in which it is composed. It contains seven hundred and ninety pages, thirty-four of which are taken up by a general disquisition upon the nature of the poetry of the nineteenth century; then, without any particular observation being appended to the particular poems and extracts from poems which follow there are seven hundred and

fifty-eight pages of selections from the works of other authors; and therefore I cannot think that the work complained of can, in any way, be said to be a book of criticism. If there were critical notes appended to each separate passage, or to several of the passages in succession, which might illustrate them, and show from whence Mr. Campbell had borrowed an idea, or what idea he had communicated to others, I could understand that to be a fair criticism. But there is, first of all, a general essay; then there follows a mass of pirated matter, which in fact constitutes the value of the volume." Ibid. 88.

The extracts were prefaced by, and interspersed with, original comments by the compiler. It was maintained in defence that the object of the book was to show that Thackeray had given his own biography in his principal novels, and that the extracts were made to establish that proposition. But the court found that the effect of the book was to supersede, to a damaging extent, the works from which the selections had been made, and held it to be a case of piracy.¹

To Illustrate Career of Person. — In a recent English case, the publication complained of was *The Man of his Time*, the object of which was to illustrate the career of Napoleon III. by caricatures taken from leading English and foreign illustrated papers. Nine caricatures, with their original headings and references, but much reduced in size, were copied from nine numbers of *Punch*, comprised within the period extending from 1849 to 1867. It was declared that the selections had been taken for the sole purpose of illustrating the career of Napoleon. While admitting that limited extracts might be taken from copyrighted works for a fair purpose of this kind, the court found that the defendant had republished the caricatures in *Punch* "for the same purpose as they were originally published, namely, to excite the amusement of his readers." It was

¹ *Smith v. Chatto*, 31 L. T. N. S. 775. See also *Folsom v. Marsh*, 2 Story, 100. Lord Eldon suggested a possible case of fair use as follows: "There is no doubt that a man cannot, under the pretence of quotation, publish either the whole or part of another's work; though he may use, what it is in all cases very difficult to define, a fair quotation. Difficulties have arisen in cases that have occurred, upon which I should have taken the same course by sending them to the consideration of a court of law. In the case of maps, for instance: one man publishes the map of a county; another man with the same design, if he has equal skill and opportunity, will by his own labor produce almost a *fac simile*, and has a right to do so; but, from his right through that medium, was it ever contended that he might copy the other map? Suppose a pub-

lication, professing to be an account of the improvement of maps of the county of Middlesex, compiling the history of all the maps of it ever published; pointing out the peculiarities belonging to them, and giving copies of them all; as well those the copyright of which has expired as those of which it was subsisting, — it is not easy to say with certainty what would be the decision upon such a case. If it was a fair history of the maps of the county which had been published, and the publication of the individual map was merely an illustration of that history, that is one way of stating it; but if the jury could perceive the object to make a profit by publishing the map of another man, that would require a different consideration. The slightest circumstances, therefore, in these cases, makes the most important distinction." *Wilkins v. Aikin*, 17 Ves. 424.

held that the defendant had gone beyond the privilege of fair quotation, and therefore a case of piracy was made out.¹

¹ *Hotten v. Arthur*, Law Rep. 8 Exch. 1. Kelly, C. B., said: "I am of opinion that the plaintiffs are entitled to retain their verdict. The questions raised are of interest and importance; but it is difficult to lay down any fixed principle with regard to them. No doubt the matter is, to a great extent, one of degree. It may well be that an author might copy into his book a portion of some books previously published, and yet that a jury might be justified in finding there had been no infringement of copyright; whilst, on the other hand, the copying might take place under such circumstances as clearly to amount to an infringement. . . . Nine of these pictures the defendant has copied, — in some instances alone, in others with the addition of printed words underneath them. If they have been so copied as to amount to a copy of a material part of the plaintiffs' publication, and the defendant has thus obtained a profit which would or might otherwise have been the plaintiffs', then there has been a piracy, for which the defendant is responsible.

"It is said that to copy a single picture, at all events could not be an infringement of the plaintiffs' copyright; but it is impossible to lay that down as a general rule. I can easily conceive a case where such an act would not be piracy. For example, where a picture is reproduced amongst a large collection, published for an entirely different object from that which the first publisher had in view. We must consider in such a case the intent of the copyist, and the nature of his work. To turn for a moment from pictures to printed matter, the illustration put during the argument by my Brother Bramwell will explain my meaning. A traveller publishes a book of travels about some distant country, like China. Amongst other things, he describes some mode of preparing food in use there. Then the compiler of a cookery-book republishes the description. No one would

say that was piracy. So, again, an author publishes a history illustrated with woodcuts of the heads of kings, and another person, writing another history of some other country, finds occasion to copy one of these woodcuts. That, again, would not be a piracy. Yet, on the other hand, the copying of a single picture may, under some circumstances, be an infringement. For example, take the case of a work illustrated by one engraving of the likeness of some distinguished man, where no other likeness is extant, no one would have a right to copy that into a book upon any subject whatever, and a jury would in such a case rightly find that there had been an infringement of the copyright.

"To return to the facts of the present case, the defendant has introduced nine pictures of the plaintiffs' into what I may call his comic life of Napoleon III.: is he by so doing applying to his own use and for his own profit what otherwise the plaintiffs might have turned, and possibly still may turn, to a profitable account? The pictures are of great merit, and no doubt were largely paid for, and by inserting these copies the defendant has unquestionably added to the value of his publication. Why should this not be an infringement? It was said by my Brother Parry, in his able argument, that the plaintiffs will never make such a use of these pictures as the defendant has made. But suppose, as my Brother Pigott suggested, that after the catastrophe which ended in the fall of Napoleon III., the proprietors of *Punch* had chosen to republish all their caricatures of him, or that even now they should choose to do so, one cannot help seeing that the defendant's publication might cause many, who would otherwise have bought, to refrain from buying such a work. I need not refer at length to the authorities cited. The principle of them is, that where one man, for his own profit, puts into his work an essential part of another man's

Objection not to Plan, but Manner of Execution. — In the three cases which have been reviewed, the legal objection was not to the professed plan of the work complained of, but to the manner in which the plan had been executed. In a work prepared for the purposes above indicated, there is little doubt that a court would sanction the use of quotations to a much greater extent than in one having a common object with the original. But, in the cases cited, the selections had been made too extensively; and, instead of being what it purported to be, the result was little more than a compilation of selections, serving in part at least as a substitute for the original.

When Plan is Unlawful. — But suppose that the publication complained of serves two distinct purposes; that, while the extracts are honestly used for criticism or illustration, and fairly serve that purpose, yet at the same time they are of such extent and character as to be capable of materially superseding the original work. On the principles above set forth, such a publication must be regarded as piratical. When the extracts as republished produce this effect, the later author must change the plan of his work, or get permission to use the selections.

work, from which that other may still derive profit, or from which, but for the act of the first, he might have derived profit, there is evidence of a piracy upon which a jury should act."

"I am of the same opinion," said Bramwell, B., "though not without some doubt, — doubt which it is natural to feel in a case like this, which is on the border-land between piracy and no piracy. But I think the plaintiffs are entitled to succeed. They are the proprietors of a sheet of letterpress within the meaning of the act of Parliament. Now, it is quite true that, when a man publishes any thing, he professes to add to the common stock of knowledge, and everybody may avail himself of what is published. This may be illustrated by the case put, of the compiler of a cookery-book taking from some traveller's account of his travels a receipt for a new dish. But, applying that principle here, it does not exonerate the defendant. If he had said, 'I propose to illustrate my

history by extracts from the satirists of the day,' and had then gone on to quote to a reasonable extent the opinions, or even the very words, of satirical writers, no one would call that piracy. Suppose, for instance, he had said, 'At this period of his career, Napoleon was unpopular, and the subject of ridicule in England. This may be seen by examining the sort of pictures of him which appeared in Punch. Later on, he became more popular, and the pictures published represented him more favorably.' That could not have been complained of. Then the defendant would simply have been using the knowledge acquired from Punch for his benefit, as he would have a right to do. But here he has done more. He has not availed himself of the knowledge acquired from Punch; but he has actually reproduced the very pictures published in Punch, and for the same purpose as they were originally published, namely, to excite the amusement of his readers." *Ibid.* 6.

II. FAIR USE OTHERWISE THAN BY QUOTATION.

General Principles.—The fair uses, other than those of legitimate quotation, which an author is privileged to make of a copyrighted work in the preparation of a rival or other publication, are restricted by recent English decisions to very narrow limits. The later compiler of a rival publication may learn from a copyrighted work where to find and how to use materials of which he might otherwise be ignorant. He may derive from it information, hints, suggestions, &c., which otherwise would have escaped his notice. He may use it as a guide in the preparation of his own work, to verify the accuracy and completeness of his own, or to detect errors, omissions, and other faults in his own. But, while he may thus use the copyrighted work as a guide or instructor, he must go to the common sources for materials, and his composition must be the product of his own labor. If, to a material extent, he copies from the protected work, or appropriates the results there found, it is piracy.¹ Speaking of a bookseller's catalogue, Vice-Chancellor Wood said: "The only fair use you can make of the work of another of this kind is where you take a number of such works, — catalogues, dictionaries, digests, &c., — and look over them all, and then compile an original work of your own, founded on the information you have extracted from each and all of them; but it is of vital importance that such new work should have no mere copying, no merely colorable alterations, no blind repetitions of obvious errors. I find all these things

¹ *Br. Lewis v. Fullarton*, 2 Beav. 6; *Murray v. Bogue*, 1 Drew. 353; *Jarrold v. Houlston*, 3 Kay & J. 708; *Spiers v. Brown*, 6 W. R. 352; *Kelly v. Morris*, Law Rep. 1 Eq. 697; *Scott v. Stanford*, 3 Id. 718; *Morris v. Ashbee*, 7 Id. 34; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Morris v. Wright*, Ibid. 279; *Jarrold v. Heywood*, 18 W. R. 279; *Hogg v. Scott*, Law Rep. 18 Eq. 444; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402; *Banks v. McDivitt*, 13 Blatchf. 163.

"I do not understand that the rule prohibits an examination of previous

works by the compiler before he has finished his own book, or the mere obtaining of ideas from such previous works; but it does prohibit a use of any part of the previous book *animo furandi*, with an intention to take for the purpose of saving himself labor." Shipman, J., *Banks v. McDivitt*, *supra*, 166.

The two works in controversy in *Jarrold v. Houlston* were written on the same plan, and presented in the form of question and answer popular information on a variety of scientific subjects. The earlier book, Dr.

here.”¹ “Examined as a question of strict law, apart from exceptional cases,” said Mr. Justice Clifford, “the privilege of

Brewer’s Guide to Science, had evidently been used to a considerable extent in the preparation of the later one, although copying was denied. Vice-Chancellor Wood said:—

“In publishing a work, in the form of question and answer, on a variety of scientific subjects, he [the later author] had a right to look to all those books which were unprotected by copyright, and to make such use of them as he thought fit, by turning them into questions and answers. He had also a further right, if he found a work like Dr. Brewer’s, and, perusing it, was struck by seeing—as I think has been the case in the present instance—that the author had been led up to particular questions and answers by the perusal of some other work, to have recourse himself to the same work, although possibly he would not have thought of doing so but for the perusal of the plaintiff’s book. But these, I apprehend, would be perfectly fair and legitimate modes of using the plaintiff’s book; and neither would be inconsistent with Mr. Philp’s affidavit, that he has not copied or taken any idea or language from Dr. Brewer’s book.

“There is another sort of legitimate use which might fairly be made by Mr. Philp, although it is scarcely so consistent with what he has deposed to in his affidavit. It would be a legitimate use of a work of this description, if the author of a subsequent work, after getting his own work with great pains and labor into a shape approximating to what he considered a perfect shape, should look through the earlier work to see whether it contained any heads which he had forgotten. For instance, it was said—whether accurately or not I have not thought it material to inquire—that, in reference to the several modes by which heat diffuses itself, the books to which the defendant refers as common sources

mention only ‘radiation, conduction, and absorption,’ and make no mention of ‘convection,’—a term found only in the plaintiff’s book until taken thence by Mr. Philp. He might say he had forgotten ‘convection,’ and therefore add it to his book. But surely no one would say, with regard to a subject of so general a description, that this would be an unfair use of the plaintiff’s book; provided, upon adding the word to his own book, he used his own mind to explain what ‘convection’ is, and explained it in his own language. So far there could be no difficulty, if the case rested there.

“The question I really have to try is, whether the use that in this case has been made of the plaintiffs’ book, has gone beyond a fair use. Now, for trying that question, several tests have been laid down. One which was originally expressed, I think, by a common law judge, and was adopted by Lord Langdale in *Lewis v. Fullarton*, 2 Beav. 6, is whether you find on the part of the defendant an *animus furandi*,—an intention to take for the purpose of saving himself labor. I take the illegitimate use, as opposed to the legitimate use, of another man’s work on subject-matters of this description to be this: If, knowing that a person whose work is protected by copyright has, with considerable labor, compiled from various sources a work in itself not original, but which he has digested and arranged, you, being minded to compile a work of a like description, instead of taking the pains of searching into all the common sources, and obtaining your subject-matter from them, avail yourself of the labor of your predecessor, adopt his arrangements, adopt moreover the very questions he has asked, or adopt them with but a slight degree of colorable variation, and thus save yourself pains and labor by availing yourself of the pains

¹ *Hotten v. Arthur*, 1 Hem. & M. 609.

fair use accorded to a subsequent writer must be such, and such only, as will not cause substantial injury to the proprietor of the first publication.”¹

Directories. — In the recent English directory cases, the law was forcibly and clearly expounded to the effect that the compiler of a directory may use a copyrighted rival work as a means of learning the names and places of residence of the persons to be canvassed, of avoiding omissions and errors in his own publication, and generally as a guide in the preparation of his own. But in no case may he save himself the labor and expense of canvassing, by copying or otherwise appropriating the results of his predecessor’s labor. He cannot cut slips from a protected directory, and use them in printing his own, although he verifies the accuracy of the information, or corrects it if erroneous, by personal application to the persons whose names are given. In all cases, he must obtain the information at his own expense and by his own labor, independently of the copyrighted work, which may be used only as a guide.²

Descriptive Catalogue. — And so, in the case of a descriptive catalogue of fruit and trees, the court was of opinion that the later compiler might use the work of his predecessor as a guide or instructor; but might not copy the descriptions from it, although he should verify and correct them from specimens of fruit before him. Though he cannot be prevented from getting much aid in the way of information, suggestions, &c., from the copyrighted work open before him, he must write his own descriptions from actual specimens or common sources of information.³

Work on Ethnology. — The same rule was followed in *Pike v. Nicholas*, where two rival works on the same subject were in controversy. The same arguments, illustrations, quotations, citations, &c., were found in both; and it was evident that, for much contained in his own publication, the defendant was

and labor which he has employed, that I take to be an illegitimate use. That Mr. Philp has made this use of the plaintiffs’ book to a certain extent, I find to be clear.”³ *Kay & J.* 715. See also *Jarrold v. Heywood*, 18 W. R. 279.

¹ *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 428.

² *Kelly v. Morris*, Law Rep. 1 Eq. 697; *Morris v. Ashbee*, 7 Id. 34; *Morris v. Wright*, Law Rep. 5 Ch. 279.

³ *Hogg v. Scott*, Law Rep. 18 Eq. 444.

indebted to that of the plaintiff. The Court of Appeal found that, while the defendant had been led by perusing the earlier work to cite authorities, make quotations, &c., which otherwise would have escaped his notice, he had not, with two unimportant exceptions, copied directly from the plaintiff's production; but, using it as a guide, had obtained the materials from the original sources, and worked them up by his own labor. This was held to be a fair use.¹

Dictionary. — In *Spiers v. Brown*, Vice-Chancellor Wood had great difficulty in determining whether, in the preparation of a dictionary, M. Contanseau had made an unlawful use of the French-English Dictionary of Dr. Spiers. The extent of the use in this case cannot be satisfactorily determined from the report. It was admitted that Dr. Spiers's work had been

¹ Law Rep. 5 Ch. 251. Lord Chancellor Hatherley said: "The result, therefore, of the whole case was this: The defendant was led to look into the particular portions of Prichard by some of the quotations of the plaintiff. Being directed to that part of Prichard, he did go to Prichard's book; for there is in his book a passage omitted by the plaintiff. He was directed by a passage in the plaintiff's book, which referred to Gildas, to inquire into Gildas, which possibly he never might have done if the plaintiff had not led the way by pointing to that author and to the work of Sir T. D. Hardy. Upon perusing Sir T. D. Hardy's work, the defendant found an account of Gildas, and a reference to Nennius, and certain remarks of Gibbon; and then he followed out those remarks by such remarks as he himself made upon the whole subject. . . . If the defendant had been disposed to do what common fairness and justice required him to do, to say nothing of the oath which he took when he put in his answer, and had fairly said, 'I acknowledge my obligation to this gentleman in putting me on a course of thorough critical investigation of Gildas, to begin with; I beg to express my obligations to him in giving me the idea, through the medium of the tables

to which I have had resort, of investigating the population of London, and the number of persons brought up from the country, and I beg also to express my obligations to him for pointing out that passage in Retzius which escaped my attention,' nobody could have blamed him as being a pirate, or have said that what he had done amounted to piracy. That course, unfortunately, was not taken." *Ibid.* 265.

In *Morris v. Wright*, Giffard, L. J., said: "In the late case of *Pike v. Nicholas*, we had this: 'Two rival works were published with reference to the same subject-matter, and we thought certainly that the defendant had been guided by the plaintiff's book, more or less, to the authorities which the plaintiff had cited; but it was a perfectly legitimate course for the defendant to refer to the plaintiff's book, and if, taking that book as his guide, he went to the original authorities and compiled his book from them, he made no unfair or improper use of the plaintiff's book; and so here, if the fact be that Mr. Wright used the plaintiff's book in order to guide himself to the persons on whom it would be worth his while to call, and for no other purpose, he made a perfectly legitimate use of the plaintiff's book.'" Law Rep. 5 Ch. 287.

used in common with other dictionaries, but to a greater extent; but there was no evidence of servile copying, "no colorable alteration proved, nor any thing tending to show a fraudulent design to make an unfair use of the work of another." "Though a good deal has been here taken from the plaintiff," said the court, "yet a good deal of labor has been bestowed upon what has been taken;" and "the result is, in fact, a different work from that of the plaintiff." Applying the test laid down by Lord Eldon, whether there had been made "a legitimate use of the plaintiff's publication in the fair exercise of a mental operation deserving the character of an original work,"¹ the court was of opinion that M. Contanseau had not gone beyond the use allowed by law; but considering the extent to which he had availed himself of the results of Dr. Spiers's labors, the bill was dismissed without costs.²

Statistics. — Where the question related to statistical tables, which the defendant had taken from the plaintiff's publication, Vice-Chancellor Wood remarked that "the defendant, after collecting the information for himself, might have checked his results by the plaintiff's tables."³ This, doubtless, means that the defendant was free to compare his own tables with those of the plaintiff to ascertain whether there were errors in his own, and to correct them, if any were found, by independent means. The authorities are clear to the effect that he would have no right to make corrections in his own by servilely copying the plaintiff's figures.

General Test of Fair Use. — The general test for determining whether a fair or a piratical use has been made of one work in the preparation of another will be, whether the later one or the part in question is the result of independent labor, or is substantially copied from the earlier one. The aim of the law is to encourage learning by allowing a fair use to be made of a copyrighted work, but at the same time to prevent the subsequent author from saving himself labor by appropriating without consideration the fruits of another's skill and industry. It is true that a subsequent author, keeping within the letter of the law defining a fair use, will often avail himself to no small

¹ *Wilkins v. Aikin*, 17 Ves. 426.

³ *Scott v. Stanford*, Law Rep. 3 Eq.

² 31 L. T. R. 16; s. c. 6 W. R. 852. 724.

extent of the learning and industry of another, and give to his own book a value which properly belongs elsewhere. In other words, a fair use in law may in ethics amount to plagiarism. But this cannot well be avoided.

GENERAL PRINCIPLES RELATING TO PIRACY.

Copying from Protected Work Essential to Piracy.— Without regard to its size, its character, or the form in which it is published, every production which is a subject of copyright is an object of piracy. Copying or borrowing from a protected work is an essential element of piracy. It is a fundamental principle of the law of copyright that two or more works may be similar or identical, and each will be entitled to protection; provided it is the result of independent labor, and not of unlawful copying. Hence, even when the publication complained of is identical with that for which protection is claimed, the charge of piracy may be met by showing that one has not been copied or borrowed from the other.¹

But it is no defence of piracy that a piratical copy of a protected work has been copied. Thus, in an English case, where it appeared that the defendant had taken from a foreign publication matter which had been copied without authority from the plaintiff's book, the court rightly held that such copying,

¹ See the consideration of this point and the authorities cited under the head of Originality, *ante*, pp. 205-208.

"It is obvious," said the Vice-Chancellor, in *Nichols v. Loder*, "if two persons of equal skill set to work to prepare such a map as this, the scale being the same, that the maps will be almost *fac similes*. The affidavits must satisfactorily show that the defendant's map is not produced by his own labor employed upon materials, and aided by information, common to him as well as to the plaintiff; but that it has been actually copied from the plaintiff's map, with perhaps some colorable or evasive alterations. Now, in order to make this out, something more is requisite than the fact of there being in appearance no difference between the two maps. The maps may in all re-

spects resemble each other, and yet there may have been no piracy." 2 Coop. (*temp.* Cottenham) 217.

"But he is not liable, unless the musical composition caused to be engraved or printed for sale by him is the same with that of Russell in the main design and in its material and important parts, altered as above mentioned to evade the law; nor is he liable to this action, although it is the same in these respects, provided it was not taken from Russell's, but was the effort of his own mind, or taken from an air composed by another person, who was not a plagiarist from that of Russell." Taney, C. J., *Reed v. Carusi*, Tan. Dec. 74. See also remarks of Vice-Chancellor Leach, in *Barfield v. Nicholson*, 2 L. J. (Ch.) 98.

to a material extent by the defendant, would amount to piracy.¹ In this case, the unauthorized sale in England of the foreign work itself would have been piratical, if it contained a material part of an English copyrighted book.

The principle that copying from a protected publication is an essential element of piracy must hold good when an author has published substantially the same work in two forms, of which but one is copyrighted. The one unprotected is common property; hence its use cannot be a violation of the copyright in the other. It is true that to copy one may be but an indirect copying of the other. But the answer to this objection is that copyright does not prevent any person from using a work which he has obtained from a source open to all.² Thus, if an author publish and copyright a novel, and then publish substantially the same production in the form of a play, without copyrighting it, the latter becomes common property; and its unlicensed publication cannot be an invasion of the copyright in the novel. This principle may be illustrated by supposing a case which may arise under the statute of the United States. Section 4962 makes the printing of the notice of entry in each copy of every edition of a book published essential to copyright. Suppose the first edition is printed with and the second without a notice, the latter edition is not entitled to protection; and, even if the copyright in the first edition continue valid, it cannot prevent any person from reprinting any copy of the second edition.

Similarity Creates Presumption of Copying. — Substantial identity, or a striking resemblance, between the work complained of and that for which protection is claimed, creates a presumption of unlawful copying, which must be overcome by the defendant.³

¹ *Murray v. Bogue*, 1 Drew. 353.

² This principle has been overlooked or disregarded in two or three important English decisions. See the criticism of the judgments in *Reade v. Conquest*, *post*, p. 458; *Boosey v. Fairlie*, Chap. XV.; *Ex parte Beal*, Chap. X.

³ *Mawman v. Tegg*, 2 Russ. 385; *Jarrold v. Houlston*, 3 Kay & J. 708; *Spiers v. Brown*, 6 W. R. 352; *Hotten*

v. Arthur, 1 Hem. & M. 603; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Blunt v. Patten*, 2 Paine, 393.

“If the similitude can be supposed to have arisen from accident; or necessarily from the nature of the subject; or from the artist having sketched designs merely from reading the letterpress of the plaintiff’s work, — the defendant is not answerable. It is

Intention to Pirate not Essential. — To constitute piracy, it is not necessary that there shall have been on the part of the wrong-doer an intention to pirate. His motives in taking the whole or a part of the copyrighted work may have been unobjectionable, or even commendable; the purpose for which such matter is used may, in his view, be harmless. In applying the law, the thing done and its effect, and not the intention with which it is done, are the controlling considerations.¹

In some cases, as where extracts are taken from a copyrighted work for criticism or other lawful purpose, it will be necessary to inquire for what purpose such quotations are used. But the point to be determined here is, not what object the subsequent writer had in view in using the matter, nor what his belief may be as to whether that object is a harmless one or not, but what purpose the publication complained of actually serves.² Thus, a person may publish copious extracts from a copyrighted work for the *bona fide* purpose of legitimate criti-

remarkable, however, that he has given no evidence to explain the similitude, or to repel the presumption which that necessarily causes." Lord Ellenborough, *Roworth v. Wilkes*, 1 Camp. 99.

"Copying is essential to constitute an infringement of copyright, but identity of contents, arrangement, and combination is strong evidence that the second book was borrowed from the first, as it is highly improbable that two authors would express their thoughts and sentiments in the same language throughout a book or treatise of any considerable size, or adopt the same arrangement or combination in their publication." Clifford, J., *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 427.

¹ *Br. Roworth v. Wilkes*, 1 Camp. 94; *Campbell v. Scott*, 11 Sim. 31; *Clement v. Maddick*, 1 Giff. 98; *Reade v. Lacy*, 1 Johns. & H. 524; *Scott v. Stanford*, Law Rep. 3 Eq. 718. **Am.** *Millett v. Snowden*, 1 West. Law Jour. 240; *Story's Executors v. Holcombe*, 4 McLean, 306; *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 427, 428.

"It is urged that this is a case in which no *animus furandi* can be found

on the part of Mr. Hunt, who has taken these statistics in perfect good faith, and with the fullest acknowledgment in his book of the source from which they are derived. But if, in effect, the great bulk of the plaintiff's production — a large and vital portion of his work and labor — has been appropriated and published in a form which will materially injure his copyright, mere honest intention on the part of the appropriator will not suffice; as the court can only look at the result, and not at the intention in the man's mind at the time of doing the act complained of, and he must be presumed to intend all that the publication of his work effects." Wood, V. C., *Scott v. Stanford*, *supra*, 723.

In *Campbell v. Scott*, Shadwell, V. C.; said: "Then, it is said that there is no *animus furandi*; but, if A takes the property of B, the *animus furandi* is inferred from the act." 11 Sim. 38. But it is now settled that the inference or presumption of a dishonest intention is not essential.

² *Campbell v. Scott*, 11 Sim. 31; *Bradbury v. Hotten*, Law Rep. 8 Exch. 1; *Smith v. Chatto*, 31 L. T. N. S. 775.

cism; yet such quotations may in reality serve a purpose not intended by the critic, and amount to piracy.¹

Intention may Aid in Determining whether there has been Copying.—There are cases, however, in which the *animus furandi* will be taken into consideration in determining whether one publication infringes another. Where it can be readily shown that there has been material copying, it matters not with what intent the copying was done; but where it is difficult to ascertain the extent of the copying, in order to determine whether the use made of a protected work by a subsequent author is “fair” or unlawful, the *animus furandi* may aid in the solution of the question. Thus, in *Spiers v. Brown*, where

¹ In *Cary v. Kearsley*, Lord Ellenborough seems to have laid some stress on the existence of the *animus furandi*. “A man,” he said, “may fairly adopt part of the work of another; he may so make use of another’s labors, for the promotion of science and the benefit of the public; but, having done so, the question will be, Was the matter so taken used fairly with that view, and without what I may term the *animus furandi*?” 4 Esp. 170. Doubtless what Lord Ellenborough meant was, not that a dishonest intention is essential to piracy, but that, when such intention is shown to have existed, the question whether there has been an unfair use may be more readily determined. The same judge held, in the subsequent case of *Roworth v. Wilkes*, that “the intention to pirate is not necessary in an action of this sort: it is enough that the publication complained of is in substance a copy whereby a work vested in another is prejudiced.” 1 Camp. 98.

In *Folsom v. Marsh*, Mr. Justice Story said: “No one can doubt that a reviewer may fairly cite largely from the original work, if his design be really and truly to use the passage for the purposes of fair and reasonable criticism. On the other hand, it is as clear, that if he thus cites the most important parts of the work, with a view not to criticise, but to supersede, the use of the original work, and sub-

stitute the review for it, such a use will be deemed in law a piracy.” 2 Story, 106.

The true doctrine is not accurately expressed here, because the question of piracy is made to depend on the intention of the reviewer, whereas the proper test is the purpose which the publication complained of serves; in other words, how far it may take the place of the original work. The law on this point has been correctly expounded by Mr. Justice McLean, who, after quoting the above language of Judge Story, said: “This doctrine seems to consider the intention with which the citations are made as necessary to an infringement. In *Cary v. Kearsley*, 4 Esp. 170, Lord Ellenborough takes the same view. But I cannot perceive how the intention with which extracts were made can bear upon the question. The inquiry is, What effect must the extracts have upon the original work? If they render it less valuable, by superseding its use in any degree, the right of the author is infringed; and it can be of no importance to know with what intent this was done. Extracts made for the purpose of a review or compilation are governed by the same rule. In neither case can they be extended so as to convey the same knowledge as the original work.” *Story’s Executors v. Holcombe*, 4 McLean, 310.

the defendant admitted that he had used the plaintiff's dictionary in preparing his own, Vice-Chancellor Wood was perplexed in finding whether there had been piratical copying, and said: "If the defendant had absolutely denied having received any assistance from the plaintiff's work, the court would have had a plain course, the *animus furandi* being made out."¹ But not even in these cases is the intention to pirate essential to constitute infringement. The existence of such intention is material only as far as it may aid in determining to what extent the earlier work has been adopted in the later one; for, when the *animus furandi* is apparent, the presumption is, in the absence of strong evidence to the contrary, that the likeness between the two works is due to copying; whereas, without the *animus furandi*, many of the resemblances may be regarded as natural and the result of honest labor.²

Ignorance no Defence of Piracy. — Ignorance will not avail as a defence of piracy. Whether he who appropriates the whole or a part of another's work was aware that it was protected by copyright, or whether he knew what would be the legal consequences of his act, is wholly immaterial. The theory of the law in this respect is, that whoever avails himself of the labors of another must do so at his own risk, and must be held responsible for his acts without regard to the extent of his knowledge or ignorance.³ "The plaintiff's rights," said Chief Justice Wilde, "do not depend upon the innocence or guilt of the defendant. . . . The statute would altogether fail to effect its

¹ 31 L. T. R. 18; s. c. 6 W. R. 352. See also Jarrold v. Houlston, 8 Kay & J. 712; Reade v. Lacy, 1 Johns. & H. 524.

² "Evidence of innocent intention may have a bearing upon the question of 'fair use;' and, where it appeared that the amount taken was small, it would doubtless have some probative force in a court of equity in determining whether an application for an injunction should be granted or refused: but it cannot be admitted that it is a legal defence where it appears that the party setting it up has invaded a copyright." Clifford, J., Lawrence v. Dana, 2 Am. L. T. R. n. s. 427.

³ Br. West v. Francis, 5 Barn. & Ald. 737; Lewis v. Chapman, 3 Beav. 133; Colburn v. Simms, 2 Hare, 543, 557; Lee v. Simpson, 8 C. B. 871, 883; Prince Albert v. Strange, 2 De G. & Sm. 652, on ap. 1 Mac. & G. 25; Leader v. Strange, 2 Car. & Kir. 101; Murray v. Bogue, 1 Drew. 353, 367; Novello v. Sudlow, 12 C. B. 177; Gambart v. Sumner, 5 Hurl. & N. 5; Reade v. Lacy, 1 Johns. & H. 524; Reade v. Conquest, 11 C. B. n. s. 479; Rock v. Lazarus, Law Rep. 15 Eq. 104. Am. Millett v. Snowden, 1 West. Law Jour. 240.

object if it were necessary to show that the defendant had a knowledge of the plaintiff's right of property."¹

The question of guilty knowledge on the part of the seller or importer of a piratical work is often affected by statutory provisions.²

The principle which eliminates from consideration, in cases of piracy, the intention on the part of the wrong-doer and the question of his ignorance, is reasonable and proper. If innocent motives or ignorance could be successfully pleaded as a defence to a charge of infringement, the protection intended for literary property would be wholly inadequate. The injury done to an author by an unlicensed use of his work is none the less when the appropriation has been made without a bad intention, or through ignorance. Hence, the remedy should be not less complete. Moreover, if such defences were allowed to prevail, the facilities for fraudulent escape from the penalty of piracy would be largely multiplied.

GENERAL FORMS AND TESTS OF PIRACY.

Piracy may be committed by publishing a literal copy of the whole or of a part of a copyrighted work, or by publishing a whole or a part in a form which is not a *verbatim* copy of the original, but is in substance identical with it.

Reprint of Entire Work. — The simplest and the least common form of infringement is the unauthorized republication of an entire work. In such case, it is immaterial in what form, with what intention, or for what purpose the original is reproduced. Whether a book be republished in the same or in another form, whether a copyrighted article in a magazine be reprinted in another magazine or in a newspaper,³ or in a book, does not affect the question of infringement. The unlicensed republication of a literary composition as part of a larger work is piracy. Thus, in making a selection of pieces or preparing a compilation, the compiler is not at liberty to use a copyrighted production without authority, though such production be but a small part of the compilation.⁴ Nor is it lawful to reprint

¹ Lee v. Simpson, 3 C. B. 883.

² See Chap. X.

³ Maxwell v. Somerton, 30 L. T.

n. s. 11; Cox v. Land & Water Journal Co., Law Rep. 9 Eq. 324.

⁴ Folsom v. Marsh, 2 Story, 100;

without license a copyrighted article in a cyclopædia, though such article be but one of a thousand in the cyclopædia.¹

Purpose for which Work is Taken Immaterial.—In several early cases, *dicta* are to be found recognizing the right of any person without authority to republish a copyrighted work, provided he revise or improve it, or use it as a basis for annotation.² But this theory is contrary to a fundamental principle

Campbell *v.* Scott, 11 Sim. 31; Bradbury *v.* Hotten, Law Rep. 8 Exch. 1; Smith *v.* Chatto, 31 L. T. N. S. 775.

¹ Roworth *v.* Wilkes, 1 Camp. 94; Mawman *v.* Tegg, 2 Russ. 385.

“Neither is it of any consequence in what form the works of another are used; whether it be by a simple reprint, or by incorporating the whole or a large portion thereof in some larger work. Thus, for example, if in one of the large encyclopædias of the present day, the whole or a large portion of a scientific treatise of another author—as, for example, one of Dr. Lardner’s, or Sir John Herschell’s, or Mrs. Somerville’s treatises—should be incorporated, it would be just as much a piracy upon the copyright as if it were published in a single volume.” Story, J., Gray *v.* Russell, 1 Story, 19.

² In Sayre *v.* Moore, where it appeared that the defendant had republished the plaintiff’s chart, but with corrections and improvements of his own, Lord Mansfield said: “If an erroneous chart be made, God forbid it should not be corrected even in a small degree, if it thereby become more serviceable and useful for the purposes to which it is applied. But here you are told that there are various and very material alterations. This chart of the plaintiff’s is upon a wrong principle, inapplicable to navigation. The defendant therefore has been correcting errors, and not servilely copying. If you think so, you will find for the defendant; if you think it is a mere servile imitation, and pirated from the other, you will find for the plaintiffs.” 1 East, 361, note. In Cary *v.* Kearsley, Mr. Erskine said: “Suppose a man took Paley’s *Philosophy*,

and copied a whole essay, with observations and notes or additions at the end of it, would that be piracy?” “That would depend,” replied Lord Ellenborough, “on the facts of, whether the publication of that essay was to convey to the public the notes and observations fairly, or only to color the publication of the original essay, and make that a pretext for pirating it; if the latter, it could not be sustained.” 4 Esp. 170. So in Matthewson *v.* Stockdale, Lord Chancellor Erskine said: “I admit no man can monopolize such subjects as the English Channel, the island of St. Domingo, or the events of the world; and every man may take what is useful from the original work, improve, add, and give to the public the whole, comprising the original work, with the additions and improvements; and in such a case there is no invasion of any right.” 12 Ves. 275. But the most extravagant language on this subject is that of Vice-Chancellor Shadwell, in Martin *v.* Wright, where the point under consideration was not even remotely in issue. He said: “Any person may copy and publish the whole of a literary composition, provided he writes notes upon it, so as to present it to the public connected with matter of his own.” 6 Sim. 298.

The question under consideration was raised, but not decided, in Saunders *v.* Smith, 3 My. & Cr. 711. It appeared that in Smith’s *Leading Cases* the defendant had copied many cases from the plaintiff’s copyrighted reports, but had added numerous notes prepared by himself. Lord Cottenham thought that, under the circumstances, it was not necessary to determine whether

of the law of copyright. It is obvious that there would be little protection for literary property if this plea were a valid defence of piracy. However much a work may be improved by revision, or its usefulness and value be increased by annotation, however extensive or important may be the new matter added, no one without the consent of the owner of the copyright has a right to take it for such purpose. "No man," said Mr. Justice Clifford, repeating the language of Vice-Chancellor Wood,¹ "is entitled to avail himself of the previous labors of another, for the purpose of conveying to the public the same information, even though he may append additional information to that already published."² And so Mr. Justice Leavitt rightly said, "The decision of this question is in no way affected by the fact—if conceded to be the fact—that the guide is in some respects an improvement of and of superior utility to the chart of the complainants. This would confer no right to appropriate and use the prior invention or discovery of Mrs. Drury."³

So the unlicensed republication of an entire literary composition cannot in general be justified on the ground that the

this was an infringement of the plaintiff's copyright. He assumed the existence of that right, but refused to grant the injunction, on the ground that the plaintiff had apparently acquiesced in the publication made by the defendant.

¹ *Scott v. Stanford*, Law Rep. 3 Eq. 724.

² *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 431.

³ *Drury v. Ewing*, 1 Bond, 549.

In *Alexander v. Mackenzie*, where it appeared that statutory forms or "styles" had been copied from the complainant's book, one of the defences was that useful improvements in the forms had been made by the defendant. In considering this point, Lord Jeffrey said:—

"But, then, what is the argument pressed on us here? Why, it is this. The respondents say, 'These styles, though good on the whole, require some correction, and we have therefore corrected and reprinted them; and we were entitled to do so, because it would be inconvenient to have two

books,—one containing the styles, the other the corrections on them.' Now, I do not see any weight in this argument. The law of patents affords a good example of the converse of the respondents' plea. Thus, if a man obtains a patent for a particular machine, and another man invents an additional improvement on the original machine, for which he obtains a separate patent, the second inventor can only make use of his patent by procuring a license for the use of the original machine; and if a third party, in constructing a more complex machine, copies both inventions, then he must pay both the inventors for the use of both their patents. In short, in the construction of a single machine we often find a great variety of patent inventions employed; and these of course are all paid for to the respective patentees. To say that additions have been made to Mr. Alexander's work will of itself never serve as an answer." 9 Sc. Sess. Cas. 2d ser. 759.

object of reproducing it was criticism. If it could be satisfactorily shown that the whole had been fairly quoted for legitimate purposes of criticism, the critic might claim immunity under the recognized privilege of fair quotation. But cases of this kind, where it is necessary to quote the entire original for purposes of comment or illustration, are exceptionally rare. On the same principle, the unlicensed appropriation of music cannot be justified on the ground that the person charged with wrong has made a new arrangement of it, or used it for a different purpose from that of the original.¹

Substantial Copy of Protected Work. — It is uniformly conceded that a republication need not be a literal copy of the original, in order to amount to piracy. As early as 1789, Lord Kenyon, Chief Justice of the King's Bench, declared, "The main question here was whether in substance the one work is a copy and imitation of the other."² In the long line of subsequent English and American decisions, this general doctrine has been followed, with steady progress, especially marked in recent cases, toward liberality in favor of the author entitled to protection.

When the production complained of is a servile imitation, in which the language of the original appears with merely colorable variations, the legal question of piracy becomes a comparatively simple one. The act of infringement is then as complete, and the law is as easily determined, as when the publication in fault is a *verbatim* reprint. But the question becomes more difficult when there is a resemblance, more or less striking, between the substance and the general form of the two works in controversy, while the language of the one is considerably different from that of the other. Then is presented the inquiry as to what degree of resemblance between two works is necessary to constitute an infringement of copyright. Every book which is like another cannot rightly be declared piratical, although in some respects the likeness may be close, and may be due to the fact that the author of the later has followed the earlier work. The law of

¹ See *post*, pp. 410, 411.

² *Trusler v. Murray*, 1 East, 362, note. Four years before, Lord Mansfield said: "The question of fact to come before a jury is, whether the alteration be

colorable or not. . . . The jury will decide whether it be a servile imitation or not." *Sayre v. Moore*, *Ibid.* 361, note.

copyright cannot justly prohibit one author from imitating the production of another, provided the subsequent work is the result of independent labor. To constitute infringement, there must be a bodily appropriation of the contents of a work,—a borrowing of the substantial results contained in it.

Substantial Identity Test of Piracy.—Where complaint is made of the resemblance between two publications, one of which is not a literal transcript of the other, the general test applied to determine piracy is that of substantial identity. Is the similarity between the substance or the contents of the two works such as to justify the conclusion that the later one is in substance identical with the other, and mainly taken from it? Has the subsequent author produced a substantially original work by his own independent labor, or has he appropriated the substantial fruits of another's industry? What amounts to a substantial identity is a question of fact, to be determined in each case by a comparison of the two works. This is a task of great difficulty, and one whose performance will be attended with results varied by circumstances. Different judges—for the determination of this question of fact frequently becomes a duty of the courts—or different juries may reach different conclusions in the same case;¹ and the tests adopted in one case may not be satisfactory in another. But when it is found that a substantial identity exists, and that the earlier work is substantially embodied in the later, the legal requisites of piracy are made out.²

¹ A noteworthy instance of this is afforded by the case of *Pike v. Nicholas*, where the judgment of the lower court was reversed on appeal, simply because the judges of the latter tribunal were led to a different conclusion as to the facts from that reached by the Vice-Chancellor. *Law Rep.* 5 Ch. 251.

² *Br. Matthewson v. Stockdale*, 12 Ves. 270; *Roworth v. Wilkes*, 1 Camp. 94; *Barfield v. Nicholson*, 2 Sim. & St. 1; *Lewis v. Fullarton*, 2 Beav. 6; *Alexander v. Mackenzie*, 9 Sc. Sess. Cas. 2d ser. 748; *Murray v. Bogue*, 1 Drew. 353; *Jarrold v. Houlston*, 3 Kay & J. 708; *Spiers v. Brown*, 6 W. R. 352; *Scott v. Stanford*, *Law Rep.* 3 Eq. 718; *Pike v. Nicholas*, *Law Rep.* 5 Ch.

251. *Am. Emerson v. Davies*, 3 Story, 768; *Webb v. Powers*, 2 Woodb. & M. 497; *Greene v. Bishop*, 1 Cliff. 186; *Drury v. Ewing*, 1 Bond, 540; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402. To the same effect are the authorities cited *post*, p. 412, note 2. For an illustration of what is substantial identity in the case of a dramatic composition, see *Daly v. Palmer*, 6 Blatchf. 256, considered in Chap. XVI.

“It is enough that the publication complained of is in substance a copy whereby a work vested in another is prejudiced.” Lord Ellenborough, *Roworth v. Wilkes*, 1 Camp. 98.

“Absolute *verbatim* identity is not

Same Rule Applies to Maps, Engravings, Paintings, Music, &c.— This rule is equally applicable to maps, charts, pictorial productions, musical compositions, and in short all things which are the subjects of copyright. The test is not whether one production is a *fac simile* of the other, but whether it is substantially a copy. Where it appeared that the defendant had copied, besides a part of the text of an article on Fencing, three engravings representing persons in the same attitudes as those in the plaintiff's work, but disguised by different costumes, Lord Ellenborough, in holding this to be a case of

required to constitute piracy; nor would occasional quotation, fairly made out, amount to that offence. The question is, whether the new work be substantially the same with the old, having merely colorable changes, or pretexts of change, or be a new and different work or compilation." The Lord Ordinary, *Alexander v. Mackenzie*, 9 Sc. Sess. Cas. 2d ser. 754, note.

"The case, therefore, comes back at last to the naked consideration, whether the book of Davies, in the parts complained of, has been copied substantially from that of Emerson, or not. It is not sufficient to show that it may have been suggested by Emerson's, or that some parts and pages of it have resemblances in method and details and illustrations to Emerson's. It must be further shown that the resemblances in those parts and pages are so close, so full, so uniform, so striking, as fairly to lead to the conclusion that the one is a substantial copy of the other, or mainly borrowed from it. In short, that there is substantial identity between them. A copy is one thing, an imitation or resemblance another. There are many imitations of Homer in the *Æneid*; but no one would say that the one was a copy from the other. There may be a strong likeness without an identity; and, as was aptly said by the learned counsel for the plaintiff in the close of his argument, *Facies non omnibus una, nec diversa tamen; qualem decet esse sororum*. The question is therefore in many cases a very nice one, what degree of imitation consti-

tutes an infringement of the copyright in a particular work." Story, J., *Emerson v. Davies*, 3 Story, 787.

"The leading inquiry then arises, which is decisive of the general equities between these parties, whether the book of the defendants, taken as a whole, is substantially a copy of the plaintiffs'; whether it has virtually the same plan and character throughout, and is intended to supersede the other in the market with the same class of readers and purchasers, by introducing no considerable new matter, or little or nothing new, except colorable deviations." Woodbury, J., *Webb v. Powers*, 2 Woodb. & M. 514.

"Copying is not confined to literal repetition, but includes also the various modes in which the matter of any publication may be adopted, imitated, or transferred, with more or less colorable alterations to disguise the source from which the material was derived; nor is it necessary that the whole, or even the larger portion, of a work should be taken in order to constitute an invasion of copyright." Clifford, J., *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 426.

"And here the true inquiry undoubtedly is, not whether the one is a *fac simile* of the other, but whether there is such a substantial identity as fairly to justify the inference, that, in getting up the guide, Mrs. Ewing has availed herself of Mrs. Drury's chart, and has borrowed from it its essential characteristics." Leavitt, J., *Drury v. Ewing*, 1 Bond, 548, 549.

piracy, said: "It is still to be considered whether there be such a similitude and conformity between the prints that the person who executed the one set must have used the others as a model. In that case, he is a copyist of the main design."¹ It matters not that the copy of a painting or engraving is larger or smaller than the original;² nor by what mechanical process the copy may be made.³

In the case of music, Lord Abinger held that the question of infringement "must depend on whether the air taken is substantially the same with the original," and that, "substantially, the piracy is where the appropriated music, though adapted to a different purpose from that of the original, may still be recognized by the ear. The adding variations makes no difference in the principle."⁴ And so Chief Justice Taney said that the

¹ Roworth v. Wilkes, 1 Camp. 99. In West v. Francis, Bailey, J., speaking of prints, said: "A copy is that which comes so near to the original as to give to every person seeing it the idea created by the original." 5 Barn. & Ald. 743. See also: Br. Barfield v. Nicholson, 2 Sim. & St. 1; Moore v. Clarke, 9 Mees. & W. 692; Turner v. Robinson, 10 Ir. Ch. 121, 510; Gambart v. Ball, 14 C. B. n. s. 306; Graves v. Ashford, Law Rep. 2 C. P. 410. Am. Blunt v. Patten, 2 Paine, 393, 397; Drury v. Ewing, 1 Bond, 540; Farmer v. Calvert Lithographic, Engraving, & Map-Publishing Co., 5 Am. L. T. R. 168; Richardson v. Miller, 3 L. & Eq. Reporter, 614.

² Gambart v. Ball, Graves v. Ashford, *supra*; Bradbury v. Hotten, Law Rep. 8 Exch. 1.

³ Gambart v. Ball, Graves v. Ashford, Turner v. Robinson, *supra*; Rositer v. Hall, 5 Blatchf. 362.

⁴ D'Almaine v. Boosey, 1 Y. & C. Exch. 302. "It is admitted," said Lord Abinger, "that the defendant has published portions of the opera, containing the melodious parts of it; that he has also published entire airs; and that in one of his waltzes he has introduced seventeen bars in succession, containing the whole of the original air, although he adds fifteen other

bars which are not to be found in it. Now, it is said that this is not a piracy: first, because the whole of each air has not been taken; and, secondly, because what the plaintiffs purchased was the entire opera; and the opera consists, not merely of certain airs and melodies, but of the whole score. But, in the first place, piracy may be of part of an air as well as of the whole; and, in the second place, admitting that the opera consists of the whole score, yet if the plaintiffs were entitled to the whole, *a fortiori* they were entitled to publish the melodies which form a part. . . . It is the air or melody which is the invention of the author, and which may in such case be the subject of piracy; and you commit a piracy if, by taking not a single bar, but several, you incorporate in the new work that in which the whole meritorious part of the invention consists. I remember in a case of copyright, at *nisi prius*, a question arising as to how many bars were necessary for the constitution of a subject or phrase. Sir George Smart, who was a witness in the case, said, that a mere bar did not constitute a phrase, though three or four bars might do so. Now, it appears to me that if you take from the composition of an author all those bars consecutively which form

musical composition complained of is piratical when it is the same as that for which protection is claimed "in the main design and in its material and important parts, altered as above mentioned to evade the law."¹ To select music from an opera, and arrange it for dancing purposes, or to make a piano-forte arrangement of an opera, may amount to piracy.²

When Material Part is Taken.—It is not necessary that the whole or the greater part of a work, either in form or substance, shall be taken, in order to constitute an invasion of copyright. The copyright protects the whole and all the parts and contents of

the entire air or melody, without any material alteration, it is a piracy; though, on the other hand, you might take them in a different order or broken by the intersection of others, like words, in such a manner as should not be a piracy. It must depend on whether the air taken is substantially the same with the original. Now, the most unlettered in music can distinguish one song from another; and the mere adaptation of the air, either by changing it to a dance, or by transferring it from one instrument to another, does not, even to common apprehensions, alter the original subject. The ear tells you that it is the same. The original air requires the aid of genius for its construction; but a mere mechanic in music can make the adaptation or accompaniment. Substantially, the piracy is where the appropriated music, though adapted to a different purpose from that of the original, may still be recognized by the ear. The adding variations makes no difference in the principle." *Ibid.* 301, 302.

¹ *Reed v. Carusi*, Tan. Dec. 74. See also *Boosey v. Fairlie*, 7 Ch. D. 301, 307; *Daly v. Palmer*, 6 Blatchf. 269.

² *D'Almaine v. Boosey*, 1 Y. & C. Exch. 288. "The composition of a new air or melody is entitled to protection; and the appropriation of the whole, or of any substantial part, of it, without the license of the author, is a piracy. How far the appropriation

might be carried in the arrangement and composition of a new piece of music, without an infringement, is a question that must be left to the facts in each particular case. If the new air be substantially the same as the old, it is no doubt a piracy; and the adaptation of it, either by changing it to a dance, or by transferring it from one instrument to another, if the ear detects the same air in the new arrangement, will not relieve it from the penalty; and the addition of variations makes no difference. The original air requires genius for its construction; but a mere mechanic in music, it is said, can make the adaptation or accompaniment." *Nelson, J., Jollie v. Jaques*, 1 Blatchf. 625.

"Now, in reference to the case that was decided in the Court of Exchequer, *D'Almaine v. Boosey*, 1 Y. & C. Exch. 288, I have no hesitation in saying, that if *Brissler* had published this arrangement for the piano-forte during *Nicolai's* lifetime without his authority, or since his death without the authority of *Bote and Bock*, his representatives, he would have pirated the work; or, if there had been a copyright act in force in Berlin, such as there is in this country, no doubt *Nicolai* or his representatives might have maintained an action for the infringement of the copyright against *Brisler*." *Kelly, C. B., Wood v. Boosey*, Law Rep. 3 Q. B. 228.

work;¹ and whoever appropriates a material part, to the injury of the owner, commits an act of piracy. The offence is the same whether a part is taken by copying literally the language of the original, or by paraphrasing it. In the latter case, it is enough to show substantial identity between the original and the part complained of, and that one has been taken from the other.²

To take one of several articles, or any illustration or cut, in a copyrighted publication, may amount to piracy; since the copyright protects each distinct composition in a book, and all the engravings, illustrations, figures, &c. But, when any part of a book is not entitled to copyright, it is not unlawful to copy that part.

Publication Complained of Need not Serve as Substitute. — In *Roworth v. Wilkes*, Lord Ellenborough said: "The question is whether the defendants' publication would serve as a substitute for" the plaintiff's work.³ The theory suggested by this

¹ See *ante*, p. 144; also *Rooney v. Kelly*, 14 Ir. Law Rep. n. s. 158.

² *Br. Wilkins v. Aikin*, 17 Ves. 422; *Mawman v. Tegg*, 2 Russ. 385; *Bramwell v. Halcomb*, 3 My. & Cr. 737; *Lewis v. Fullarton*, 2 Beav. 6; *Kelly v. Hooper*, 4 Jur. 21; *Sweet v. Maugham*, 11 Sim. 51; *Sweet v. Cater*, *Ibid.* 572; *Campbell v. Scott*, *Ibid.* 31; *Bohn v. Bogue*, 10 Jur. 420; *Stevens v. Wildy*, 19 L. J. n. s. (Ch.) 190; *Murray v. Bogue*, 1 Drew. 353; *Sweet v. Benning*, 16 C. B. 459; *Jarrold v. Houlston*, 3 Kay & J. 708; *Rooney v. Kelly*, *supra*; *Tinsley v. Lacy*, 1 Hem. & M. 747; *Kelly v. Morris*, Law Rep. 1 Eq. 697; *Scott v. Stanford*, 3 Id. 718; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Jarrold v. Heywood*, 18 W. R. 279; *Cobbett v. Woodward*, Law Rep. 14 Eq. 407; *Bradbury v. Hotten*, Law Rep. 8 Exch. 1; *Smith v. Chatto*, 31 L. T. n. s. 775; *Hogg v. Scott*, Law Rep. 18 Eq. 444; *Chatterton v. Cave*, Law Rep. 10 C. P. 572, 1st ap. 2 C. P. D. 42, 2d ap. 3 App. Cas. 483. *Am.* *Gray v. Russell*, 1 Story, 11; *Folsom v. Marsh*, 2 Id. 100; *Story's Executors v. Holcombe*, 4 McLean, 306; *Jollie v. Jaques*, 1 Blatchf. 618; *Greene v. Bishop*, 1 Cliff. 186; *Daly v. Palmer*, 6 Blatchf. 256;

Lawrence v. Dana, 2 Am. L. T. R. n. s. 402; *Banks v. McDivitt*, 13 Blatchf. 163. Other cases to the same effect are cited in considering Lawful Uses of Copyrighted Works, *ante*, p. 386 *et seq.*, and Piracy in the case of Compilations, *post*, p. 416 *et seq.*

"It is certainly not necessary to constitute an invasion of copyright that the whole of a work should be copied, or even a large portion of it, in form or substance. If so much is taken that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient, in point of law, to constitute a piracy *pro tanto*. The entirety of the copyright is the property of the author; and it is no defence, that another person has appropriated a part, and not the whole, of any property. Neither does it necessarily depend upon the quantity taken, whether it is an infringement of the copyright or not. It is often affected by other considerations, — the value of the materials taken, and the importance of it to the sale of the original work." Story, J., *Folsom v. Marsh*, 2 Story, 115.

³ 1 Camp. 98.

dictum, that a work to be piratical must be a substitute for the one copied, has no foundation in reason or principle, and is opposed to the current of authorities, which establish the doctrine that a case of piracy is made out when it is shown that a material part of a work has been taken without authority.¹ When the defence of fair use is set up, it may be material to inquire whether the publication complained of will supersede that for which protection is claimed. But, when this privilege is not pleaded, the fact that one work will not serve as a substitute for the other is no defence of piracy.

What Amount is Material. — When part of a copyrighted production has been reproduced in another publication, and especially when literal extracts have been made, one of the first questions to be determined is, whether the person charged with piracy has acted within the privilege of fair use. Then arise the inquiries, whether the part taken is material, and whether the author entitled to protection is thereby injured.

No fixed rule can be given for determining what amount of copied or borrowed matter is essential to constitute infringement; or, in other words, how small may be the quantity taken, and still amount to piracy. The authorities agree that when the quantity taken is material, and enough to cause substantial injury to the author entitled to protection, a case of infringement may be made out. The determination of this question of fact is often one of extreme difficulty, and the finding will vary with the circumstances in each case, and with the judgment of the person or persons whose duty it may be to ascertain the fact. The ratio which the part bears to the whole from which it is taken will often be a material consideration; but it is obvious that no relative or fractional part of either production in controversy can be fixed as a standard measure of materiality. An amount material in one case will be unimportant in another. “If so much is taken,” said Mr. Justice Story, “that the value of the original is sensibly diminished, or the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient in point of law to constitute a piracy *pro tanto*.”²

¹ See *Bohn v. Bogue*, 10 Jur. 420; *Sweet v. Shaw*, 3 Jur. 217.

² *Folsom v. Marsh*, 2 Story, 115.

In determining whether the part taken is material in extent and importance, a variety of circumstances must be considered: the absolute amount and value of the part; its ratio to the whole from which it is taken, and to the whole in which it is afterward incorporated; its relative value to each of the works in controversy; the purpose which it serves in each; how far the later work may tend to supersede the original, or interfere with its sale; to what extent the original author may be injured, actually or potentially, by the unlicensed use made of his production; and many other special considerations, which need not here be mentioned.¹

It should be remembered, however, that when the fact of copying or borrowing has been established, and cannot be defended on the principle of fair use, the original author is usually in the right, and the other in the wrong. The former is entitled to the full enjoyment of the fruits of his labor; the latter in seeking gain is bound to depend on his own honest resources. Hence, in determining what amount or what value is sufficient to constitute infringement in cases of this kind, the utmost rigor consistent with right and justice should find place against him charged with wrong.

Value to be Considered. — The value of the part taken is also to be considered, in connection with the quantity; and often the question of piracy will be determined by the value of the extract, irrespective of its extent. Lord Chancellor Cottenham well said: "When it comes to a question of quantity, it must be very vague. One writer might take all the vital part of another's book, though it might be but a small proportion

¹ In *Cobbett v. Woodward*, Law Rep. 14 Eq. 407, the court was willing to grant an injunction against about eight lines copied from the plaintiff's publication. In *Sweet v. Benning*, 16 C. B. 459, copied matter forming about one-twentieth part of the defendant's work, was held to amount to piracy. A case of infringement was made out where it appeared that, in a work on caricatures, nine caricatures had been taken from nine numbers of *Punch*, extending from 1849 to 1867. *Bradbury v. Hotten*, Law Rep. 8 Exch. 1;

see *ante*, p. 391. In *Webb v. Powers*, 2 Wood. & M. 497, 520, an injunction was refused where it appeared that only about twenty or thirty lines had been copied from nearly seven thousand in the plaintiff's work. In a recent English case, two scenes or situations taken from a drama were held not to be material enough to amount to piracy. *Chatterton v. Cave*, Law Rep. 10 C. P. 572, 1st ap. 2 C. P. D. 42, 2d ap. 3 App. Cas. 483. For other illustrations as to quantity, see cases given in Chap. XI.

of the book in quantity. It is not only quantity, but value, that is looked to. It is useless to refer to any particular cases as to quantity.”¹

And so, in the language of Mr. Justice Story: “In many cases, the question may naturally turn upon the point, not so much of the quantity as of the value of the selected materials. As was significantly said on another occasion, *Non numerantur, ponderantur*. The quintessence of a work may be piratically extracted, so as to leave a mere *caput mortuum*, by a selection of all the important passages in a comparatively moderate space.”²

¹ *Bramwell v. Halcomb*, 3 My. & Cr. 738.

² *Gray v. Russell*, 1 Story, 20. See also *Bell v. Whitehead*, 3 Jur. 68; *Kelly v. Hooper*, 4 Id. 21; *Campbell v. Scott*, 11 Sim. 31; *Bradbury v. Hotten*, Law Rep. 8 Exch. 1; *Farmer v. Calvert Lithographing, Engraving, & Map-Publishing Co.*, 5 Am. L. T. R. 168, 174.

“The infringement of a copyright does not depend so much upon the length of the extracts as upon their value. If they embody the spirit and the force of the work in a few pages, they take from it that in which its chief value consists. This may be done to a reasonable extent by a reviewer, whose object is to show the merit or demerit of the work. But this privilege cannot be so exercised as to supersede the original book.” *McLean, J., Story’s Executors v. Holcombe*, 4 McLean, 309.

“The question of the extent of appropriation which is necessary to establish an infringement of copyright is often one of extreme difficulty; but in cases of this description the quality of the piracy is more important than the proportion which the borrowed passages may bear to the whole work. Here it is enough to say that the defendant admits that one-fourth of the dramas is composed of matter taken from the novels.” *Wood, V. C., Tinsley v. Lacy*, 1 Hem. & M. 752.

“I shall not trouble your lordships by discussing, in detail, the many authorities which have been cited as to the interpretation to be put upon the acts which regulate copyright in books. They seem one and all to assume, or to affirm expressly, that to render a writer liable for literary piracy, he must be shown to have taken a material portion of the publication of another: the question as to its materiality being left to be decided by the consideration of its quantity and value, which must vary indefinitely in various circumstances. As Lord Chancellor Cottenham said in *Bramwell v. Halcomb*, 3 My. & C. 738: ‘It is useless to refer to any particular cases as to quantity.’ The quantity taken may be great or small; but, if it comprise a material portion of the book, it is taken illegally. The question is as to the substance of the thing; and, if there be no abstraction of that which may be substantially appreciated, no penalty is incurred. In all the cases, the matter is dealt with as one of degree. In all, quantity and value are both the subjects of consideration; and in none of them has an infringement been established without satisfactory evidence of an appropriation, possibly involving a substantial loss to one person and a substantial gain to another.” Lord O’Hagan, *Chatterton v. Cave*, 3 App. Cas. 497.

PIRACY IN THE CASE OF COMPILATIONS. — I. COMPILATIONS OF COMMON FACTS.

It is necessary to consider more particularly the question of piracy in the case of that class of productions which do not consist of original matter in the ordinary meaning of that word, but are simply compilations of materials, plain facts, information, &c., gathered from common sources. Works of this kind may be divided into two general classes: 1, Statements or collections of common facts, which admit of little variation in their description; 2, compilations of materials gathered from other publications.

Of the former class are directories, road-books, maps, charts, mathematical tables, and analogous works. Between two rival publications of this kind, there will necessarily be a striking resemblance, amounting in many instances to substantial identity. In different directories of the same city, the names and addresses of persons, order of arrangement, &c., will be substantially alike. In rival road-books, the location and direction of highways will be similarly described. In maps and charts of the same region, the boundaries of geographical divisions, location of natural objects, distances, latitude, longitude, &c., when accurately described, will be represented by different persons without substantial variation. In mathematical tables, the same figures will result from the same calculations. In all such cases, the materials are equally open to all; and the results prepared by two laborers in the same field will present little variation. May a subsequent compiler take advantage of this circumstance, and say: "These facts are common property; they can be truthfully given in but one form; the results worked out by my own independent labor must be in substance the same as those published by my predecessor. Therefore I do not injure him or invade his rights by copying from his publication"?

Test of Piracy. — Here the general test of piracy is the same as in the case of compositions wholly original. The principle is well established, that the later compiler can escape the penalty of piracy only by going to the common sources for mate-

rials and information, and producing a work by his own labor. He cannot lawfully save himself labor and expense by taking the results of another's industry and skill, except as far as he may be able to do so under the privilege of fair use. He must himself examine the highways and places to be described in an original road-book; must himself make the surveys and other calculations necessary for constructing a map or chart; must himself perform the operations essential to produce mathematical tables; must himself canvass for the names to make a directory. Of course, he is entitled to use any information or materials which may be obtained from common sources, either published or unpublished. But copying to a material extent from a protected work, or appropriating the materials or results there found, is piracy.¹

¹ *Br. Cary v. Longman*, 1 East, 358; *Matthewson v. Stockdale*, 12 Ves. 270; *Longman v. Winchester*, 16 Id. 269; *Baily v. Taylor*, 3 L. J. (Ch.) 66, 1 Russ. & My. 73; *Kelly v. Hooper*, 4 Jur. 21; *M'Neill v. Williams*, 11 Id. 344; *Murray v. Bogue*, 1 Drew. 353; *Jarrold v. Houlston*, 3 Kay & J. 708; *Kelly v. Morris*, Law Rep. 1 Eq. 697; *Scott v. Stanford*, 3 Id. 718; *Morris v. Ashbee*, 7 Id. 34; *Cox v. Land & Water Journal Co.*, 9 Id. 324; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Morris v. Wright*, *Ibid.* 279; *Jarrold v. Heywood*, 18 W. R. 279; *Hogg v. Scott*, Law Rep. 18 Eq. 444; *Grace v. Newman*, 19 Id. 623. *Am. Blunt v. Patten*, 2 Paine, 393, 397; *Farmer v. Calvert Lithographing, Engraving, & Map-Publishing Co.*, 5 Am. L. T. R. 168.

"Take the instance of a map describing a particular county, and a map of the same county afterwards published by another person; if the description is accurate in both, they must be pretty much the same. But it is clear the latter publisher cannot on that account be justified in sparing himself the labor and expense of actual survey, and copying the map previously published by another. So, as to Patterson's Road Book, it is certainly competent to any other man to publish a book of roads; and if the

same skill, intelligence, and diligence are applied in the second instance, the public would receive nearly the same information from both works; but there is no doubt that this court would interpose to prevent a mere republication of a work which the labor and skill of another person had supplied to the world. So, in the instance mentioned by Sir Samuel Romilly, a work consisting of a selection from various authors, two men, perhaps, might make the same selection; but that must be by resorting to the original authors, not by taking advantage of the selection already made by another. In the case of *Hogg v. Kirby*, 8 Ves. 215, there was no doubt that any person might publish a work of the description which was the subject of that injunction. Each party might publish his own collection, and the articles might happen to be the same; but one could not excite the public curiosity by copying into his work from that of the other." *Lord Eldon, Longman v. Winchester*, 16 Ves. 271.

"There is no foundation in law for the argument, that, because the same sources of information are open to all persons, and by the exercise of their own industry and talents and skill, they could, from all these sources, have produced a similar work, one

Law Construed in Case of Directories. — This doctrine was forcibly expressed in the first of the recent English directory cases, by Vice-Chancellor Wood, afterward Lord Chancellor Hatherley: "The defendant has been most completely mistaken in what he assumes to be his right to deal with the labor and property of others. In the case of a dictionary, map, guide-book, or directory, when there are certain common objects of information which must, if described correctly, be described in the same words, a subsequent compiler is bound to set about doing for himself that which the first compiler has done. In case of a road-book, he must count the milestones for himself. In the case of a map of a newly-discovered island,—the illustration put by Mr. Daniel,—he must go through the whole process of triangulation, just as if he had never seen any former maps; and, generally, he is not entitled to take one word of the information previously published, without independently working out the matter for himself, so as to arrive at the same result from the same common sources of information; and the only use he can legitimately make of a previous publication is to verify his own calculations and results when obtained. So, in the present case, the defendant could not take a single line of the plaintiff's directory, for the purpose of saving himself labor and trouble in getting his information. . . . The work of the defendant has clearly not been compiled by the legitimate application of independent personal labor."¹

party may at second hand, without any exercise of industry, talents, or skill, borrow from another all the materials which have been accumulated and combined together by him. Take the case of a map of a county, or of a State, or an empire; it is plain, that in proportion to the accuracy of every such map must be its similarity to, or even its identity with, every other. Now, suppose a person has bestowed his time and skill and attention, and made a large series of topographical surveys, in order to perfect such a map, and has thereby produced one far excelling every existing map of the same sort. It is clear that, notwithstanding this production, he cannot

supersede the right of any other person to use the same means by similar surveys and labors to accomplish the same end. But it is just as clear that he has no right, without any such surveys and labors, to sit down and copy the whole of the map already produced by the skill and labors of the first party, and thus to rob him of all the fruit of his industry, skill, and expenditures. It would be a downright piracy." Story, J., *Gray v. Russell*, 1 Story, 18.

¹ *Kelly v. Morris*, Law Rep. 1 Eq. 701, 703. "This language," said Lord Justice Giffard, "does not mean that he may not look into the book for the purpose of ascertaining where a par-

The soundness of these views was expressly recognized in the following directory cases of *Morris v. Ashbee*¹ and *Morris v. Wright*,² as well as in other decisions.³ In the two cases named, the law was construed with marked unanimity against the right of a subsequent compiler to make of a copyrighted directory any other use than that of a guide in the preparation of a rival publication. Copying in any manner from the earlier directory, or in any wise appropriating the results there found, is strictly prohibited. The later directory must be the result of independent labor. All names, addresses, &c., in it must be got by actual application to the persons. If such persons cannot be found, their names may not be copied from a protected work. The location and description of streets, buildings, parks, squares, and other objects of interest, must be obtained from personal observation, or common sources of information. It was expressly held to be piracy for the subse-

ticular person lived, and for the purpose of ascertaining whether it was worth his while to call upon that person or not; but it means that he may not take that particular slip and show that to the person, and get his authority as to putting that particular slip in." *Morris v. Wright*, Law Rep. 5 Ch. 285.

"No doubt," continued Vice-Chancellor Wood, in *Kelly v. Morris*, "the expense of procuring information in a legitimate way is very great. The defendant himself has told us so, and also that it was " for some years that he was able to do so. But the defendant goes on in his affidavit to propound a most extraordinary doctrine as to the right or propriety in the names of private residences, which, as he expressed it, 'given names for public use.' What he has done has been just to copy the plaintiff's book and then to send out canvassers, and if the information so copied was correct. If the canvassers did not find the occupier of the house at home, or could get no answer from him, then the information copied from the plaintiff's book was reprinted bodily, as if it was a question for the occupier of the house merely, and not for the compiler of the

previous directory. Further than this, the defendant tells us that he had a number of new agents, and that one of them had performed his part of the work carelessly; thus at once showing how easy it would be, on the system adopted by the defendant, for any negligent agent to send back his list all ticked as if correct, without having taken the trouble to make a single inquiry." Law Rep. 1 Eq. 70.

¹ Law Rep. 7 Eq. 34. Vice-Chancellor Giffard, citing *Kelly v. Morris*, said: "In a case such as this, no one has a right to take the result of the labor and expense incurred by another for the purposes of a rival publication, and thereby save himself the expense and labor of working out and arriving at these results by some independent road. If this were not so, these would be practically no copyright in such a work as a directory." *Ilbert v. Kelly*, Law Rep. 5 Ch. 279.

² *Scott v. Stanford*, Law Rep. 3 Ch. 31; *Mox v. Land & Water*, Law Rep. 9 Ch. 324; *Pike v. Nicholas*, Law Rep. 5 Ch. 291; *Hogg v. Scott*, Law Rep. 2 Ch. 44.

quent compiler to print from slips cut from a protected directory; although in every instance he had verified the accuracy of the information, or corrected it, if erroneous, by personal application to the persons whose names were given.¹

In *Morris v. Ashbee*, it appeared that many of the names in the plaintiff's directory had been printed in capital letters, while after others "extra lines" were inserted, the object of which was to advertise the business of those persons who were willing to pay for this advantage. The defendant alleged that he had used slips only of these parts of the plaintiff's directory; and contended that, as the names printed in capitals and the extra lines were advertisements, which had been paid for by the persons for whose special benefit they were inserted, the plaintiff was not entitled to copyright in them. It was further claimed by the defendant that the authority given by the persons themselves vested in him a right so to use their names in his directory. The court, however, held that such persons could not authorize the defendant to copy their names from a copyrighted work, and refused to recognize any legal distinction between the matter so paid for and other parts of the directory.²

¹ In *Kelly v. Morris* and *Morris v. Ashbee*, it appeared that the defendant had cut slips from the plaintiff's directory, and, having verified them by application to the persons whose names were given, printed them in his own book. In the former suit, it was admitted that in the case of persons not found by the canvassers the slips containing their names had been copied without verification. "It is plain," said Giffard, V. C., in *Morris v. Ashbee*, "that it could not be lawful for the defendants simply to cut the slips which they have cut from the plaintiff's directory and insert them in theirs. Can it, then, be lawful to do so because, in addition to doing this, they sent persons with the slips to ascertain their correctness? I say, clearly not. Then, again, would their acts be rendered more lawful because they got payment and authority for the insertion of the names from each individual whose name appeared in the slips? And to this I again an-

swer, clearly not. The simple upshot of the whole case is, that the plaintiff's directory was the source from which they compiled very material parts of theirs, and they had no right so to resort to that source. They had no right to make the results arrived at by the plaintiff the foundation of their work, or any material part of it; and this they have done." Law Rep. 7 Eq. 41.

² *Ibid.* 34. "I am of opinion," said Giffard, V. C., "that the application by the plaintiff for payment, and the payment by the several persons whose names were inserted with capital letters or with added lines, had not the effect of making these names, when so inserted, common property. The plaintiff incurred the labor and expense, first of getting the necessary information for the arrangement and compilation of the names as they stood in his directory, and then of making the actual compilation and arrangement; and though each individual who paid might no doubt have

Descriptive Catalogues. — The same principle was applied in determining the question of piracy in the case of a descriptive catalogue of fruit and fruit-trees. The defendant said that, in preparing his work, he had taken the plaintiff's descriptions, and, after verifying them by comparison with specimens of fruit, had published them in his own book. It was held that this use of an existing work was unlawful, and that the subsequent author was bound to write his own descriptions. "The true principle in all these cases," said Vice-Chancellor Hall, after citing the directory decisions, "is that the defendant is not at liberty to use or avail himself of the labor which the plaintiff has been at for the purpose of producing his work; that is, in fact, merely to take away the result of another man's labor, or, in other words, his property."¹

And so, where the defendant was charged with piracy, for having published facts and information concerning the hunting season, taken from the plaintiff's publication, Vice-Chancellor Malins said: "I also assume the law to be perfectly clear and settled, as laid down by the present Lord Chancellor² in *Kelly v. Morris*; as also by that other case of *Morris v. Ashbee*. It is clear that in this case the getting the names of masters of hunts, the numbers of hounds, the huntsmen and whips, and so forth, is information open to all those who seek to obtain it; but it is information they must get at their own expense, as the result of their own labor, and they are not to be entitled to the results of the labors undergone by others."³

Maps. — And so, where the defendant contended that it was not piracy to copy boundaries of townships from the plaintiff's map, because such boundaries had been fixed by statute, and hence no one could acquire exclusive property in them, the court said: "What is claimed in this regard is true in regard to all original materials from which maps are made, and that is, that none of them are subjects of copyright: they are open

his own name printed in capital letters, or with the same superadded lines wherever he chose, neither one nor all of them could authorize the cutting of a series of slips, or the taking of the names as arranged, from the plaintiff's directory, and the use of them in

the printing of a rival work." *Ibid.* 40.

¹ *Hogg v. Scott*, Law Rep. 18 Eq. 458.

² *Hatherley*.

³ *Cox v. Land & Water Journal Co.*, Law Rep. 9 Eq. 332.

to all. But no one has the right to avail himself of the enterprise, labor, and expense in the ascertainment of those materials, and the combining and arrangement of them, and the representing them on paper. The defendant, no doubt, had the right to go to the common source of information; and, having ascertained those boundaries, to have drawn them upon its map, notwithstanding that, in this respect, it would have been precisely like complainant's map (which, of course, it would have been, if they were both correct). But he had no right to avail himself of this very labor on the part of complainant, in order to avoid it himself."¹

II. COMPILATIONS OF PUBLISHED MATERIALS.

The law governing piracy in the case of compilations consisting of common materials selected from other publications will be considered under three heads: 1. When the entire compilation, the matter and its arrangement, is taken. 2. When the materials, but not the mode of their combination, are copied. 3. When the arrangement, but not the materials, is adopted.

When Materials and Arrangement are Taken.—It has been shown elsewhere that the copyright in a compilation vests not in the component parts independently of their combination, nor in the arrangement apart from the matter; but in the materials as arranged and combined.² The law governing cases wherein both the materials and their arrangement are taken is well settled. Whether the compilation in which copyright is claimed consists of original and selected matter combined, or is made up wholly of selections from common sources, whether or not the materials have been elaborated by the compiler, it is a work entitled to protection; and, when both the substance and the form are copied without authority, it is a clear invasion of copyright. It is true that the component parts of the compilation may be found in sources open and accessible to all persons; and that any one may use the same materials for

¹ *Farmer v. Calvert Lithographing, Engraving, & Map-Publishing Co.*, 5 Am. L. T. R. 174. See also *Blunt v. Patten*, 2 Paine, 393, 397.

² *Ante*, p. 156.

the same purpose. But every compiler is bound to go to the common sources for his materials, and arrange them on a plan original with himself. He must himself do the work, and depend on his own skill; and not save himself labor and expense by appropriating the fruits of another's industry and learning.¹ To constitute piracy in cases of this kind, it is not necessary that the whole of the compilation shall be taken, or that *verbatim* copying shall be shown. The same general tests apply here as in the case of an original work. A case of infringement may be made out when the substance of the whole or of a material part of the compilation has been appropriated.²

¹ *Br. Matthewson v. Stockdale*, 12 Ves. 270; *Longman v. Winchester*, 16 Id. 269; *Lewis v. Fullarton*, 2 Beav. 6; *Kelly v. Hooper*, 4 Jur. 21; *Murray v. Bogue*, 1 Drew. 353; *Macleane v. Moody*, 20 Sc. Sess. Cas. 2d ser. 1154; *Spiers v. Brown*, 6 W. R. 352; *Jarrold v. Houlston*, 3 Kay & J. 708; *Scott v. Stanford*, Law Rep. 3 Eq. 718; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Black v. Murray*, 9 Sc. Sess. Cas. 3d ser. 341. *Am. Gray v. Russell*, 1 Story, 11; *Emerson v. Davies*, 3 Id. 768; *Webb v. Powers*, 2 Woodb. & M. 497; *Story's Executors v. Holcombe*, 4 McLean, 306; *Greene v. Bishop*, 1 Cliff. 186; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402; *Farmer v. Calvert Lithographing, Engraving, and Map-Publishing Co.*, 5 Am. L. T. R. 168; *Banks v. McDivitt*, 13 Blatchf. 163.

"Any man is entitled to write and publish a topographical dictionary, and to avail himself of the labors of all former writers whose works are not subject to copyright, and of all public sources of information; but, whilst all are entitled to resort to common sources of information, none are entitled to save themselves trouble and expense by availing themselves, for their own profit, of other men's works still subject to copyright and entitled to protection." Lord Langdale, M. R., *Lewis v. Fullarton*, 2 Beav. 8.

² *Emerson v. Davies*, *Webb v. Powers*, *Story's Executors v. Holcombe*,

Lawrence v. Dana, *Pike v. Nicholas*, *supra*.

"I think it may be laid down as the clear result of the authorities in cases of this nature, that the true test of piracy or not is to ascertain whether the defendant has, in fact, used the plan, arrangements, and illustrations of the plaintiff as the model of his own book, with colorable alterations and variations only to disguise the use thereof; or whether his work is the result of his own labor, skill, and use of common materials and common sources of knowledge, open to all men, and the resemblances are either accidental, or arising from the nature of the subject. In other words, whether the defendant's book is, *quoad hoc*, a servile or evasive imitation of the plaintiff's work, or a *bona fide* original compilation from other common or independent sources." Story, J., *Emerson v. Davies*, 3 Story, 793.

In *Pike v. Nicholas*, it was held in the lower court that "the plaintiff has a right to say that no one is to be permitted, whether with or without acknowledgment, to take a material and substantial portion of his work, of his argument, his illustrations, his authorities, for the purpose of making or improving a rival publication," Law Rep. 5 Ch. 260. This principle was expressly approved on appeal; but the judgment was reversed on the ground that copying had not been satisfactorily

When Materials, without Arrangement, are Taken. — Will it amount to piracy in any case to appropriate the matter of a compilation without adopting the arrangement; or to copy the plan without taking the materials?

There is no recognized principle which will prevent a subsequent compiler from copying common materials from an existing compilation, and arranging and combining them in a new form, or using them for a different purpose. It is true that, in this case, he avails himself to some extent of the labor and research of his predecessor, instead of obtaining the materials from the original sources. But the first compiler has no exclusive property in that of which he is not the author, and which may be used by any one. His copyright protects only his own arrangement of the materials which he has selected.¹

The principle is different, however, when the first compiler has translated, abridged, or elaborated the common materials. In such case, his claim is founded not alone on arrangement, but he has acquired a title by authorship; and to appropriate the results of that authorship, with or without the arrangement

proved. Lord Chancellor Hatherley, referring to common quotations found in both books, said that the defendant "must not simply copy the passage from the plaintiff's book," but must "really and *bona fide* look at that common source," Law Rep. 5 Ch. 263. The court of appeal held that the taking of a single quotation from the plaintiff's compilation was not, under the special circumstances of the case, a sufficient ground for an injunction.

¹ In *Barfield v. Nicholson*, where it appeared that common figures or drawings in architecture were used in the plaintiff's book, *The Architectural Dictionary*, and in the defendant's work, *The Practical Builder*, though their arrangement in the former was not new, and the arrangement adopted by the defendant was different from that in plaintiff's book, Sir John Leach, Vice-Chancellor, said: "If therefore the figures furnished by Nicholson for *The Practical Builder*

had in fact been copied from *The Architectural Dictionary*, this would have been no piracy, because the author of *The Architectural Dictionary* had no property in these figures. But the Nicholsons, both father and son, positively swear that these figures were not copied from *The Architectural Dictionary*, nor from any materials collected for *The Architectural Dictionary*." 2 Sim. & St. 8.

In *Folsom v. Marsh*, 2 Story, 100, where it appeared that three hundred and fifty-three pages of Washington's letters and writings in the defendant's work had been copied from that of the plaintiff, the injunction granted by Judge Story extended only to the three hundred and nineteen pages which were first published in the plaintiff's work, and not to the thirty-four pages which had been previously published, and which were common property.

of the materials, is the same in principle as copying original matter.¹

When Arrangement, but not Materials, is Copied. — The question, whether a person is barred from copying the plan and arrangement of a compilation, though he takes no materials from it, involves two inquiries: 1. Whether, in adopting the mode of combination, he uses different materials from those in the earlier work; 2. Whether he uses the same selections, but obtains them from the original authorities. In the former case, it is difficult to see how any piracy can be committed. In the mere plan or arrangement of a compilation, independently of the materials themselves, there can be no copyright to the extent that the compiler may rightfully prevent another from using the same arrangement for materials not found in the earlier publication, or for a different purpose. In such case, the later compilation will be substantially new, and different from the earlier one.²

But the case is different when the same materials are found in the same order in both books. There is then a substantial identity between the two; and, if the subsequent compiler has

¹ "But the respondent contends that, even if it be true that matters of fact, citations, and authorities have been borrowed to a considerable extent, he had a right to take them, as the use he made of them was substantially new, and different from that made by the complainant in the two prior annotated editions of the work, because they were used by him in illustrations of new and original propositions. . . . The doctrine of new and different use in the law of copyright applies more particularly to the old materials, and not to the materials of a work like that of the last annotated edition of the complainant, where the materials collected are much abridged, and sometimes paraphrased and newly arranged, and combined with the text of the original work. Beyond all doubt, he might take the old materials as found in the sources from which the matters of fact, citations, and authorities of the complainant were drawn, and use them as he pleased in

illustration of new and original propositions, or for any other purpose not substantially the same as that to which they are applied in the annotated editions edited by the complainant: but he could not borrow the materials as therein collected and furnished, nor could he rightfully use the plan and arrangement, or the mode by which they are combined with the text, beyond the extent falling within the definition of fair use; which rule is only applicable to the materials, and not to the plan, arrangement, and mode of operation." Clifford, J., *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 124. See also *Grace v. Newman*, Law Rep. 19 Eq. 623.

² *Murray v. Bogue*, 1 Drew. 353; *Spiers v. Brown*, 6 W. R. 352; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Mack v. Petter*, Law Rep. 14 Eq. 431; *Lawrence v. Cupples*, 9 U. S. Pat. Off. Gaz. 254; *Banks v. McDivitt*, 13 Blatchf. 163.

servilely copied the arrangement and combination from the earlier publication, the question arises, whether he can escape the penalty of piracy by showing that he has obtained the materials from the common sources. The chief value of a compilation is in the choice and arrangement of its contents. To make apt selections, and arrange effectively, to collect valuable illustrations and citations for purposes of annotation, and combine them properly with another's text, often require great research, judgment, scholarship, and literary knowledge. When such a compilation is made, any one, with little labor and no literary knowledge or skill, may be able to duplicate it; and the injury done to the original compiler is not less when the selections are copied from the original sources.¹ The subsequent compiler may not be prevented from arranging different materials on the same plan, or from making a new arrangement of the same common selections. But, in adopting both the arrangement and the materials of an existing compilation, though the materials are obtained from the original sources, he avails himself of the labor, judgment, and learning of his predecessor, to publish a rival work identical with that of the latter. I am not aware that a case of this kind has been decided, or that the law on this point has been judicially expounded. But the courts have frequently declared, and the principle is well grounded, that no one shall appropriate the substantial fruits of the industry and learning of another, to the injury of the latter; and, when this is done by a subsequent

¹ This is well illustrated by Lockhart's annotated edition of Scott's *Minstrelsy of the Scottish Border*, which was brought into controversy in the recent Scotch case of *Black v. Murray*. Of the two hundred notes added by the editor, it appeared that all but fifteen were quotations from common sources. The ballads also were common property. "To a considerable extent," said Lord Kinloch, "the notes borrowed (to use a euphemism) from Messrs. Black's edition, consist of quotations from various authors, employed by Mr. Lockhart to illustrate ballads in the *Minstrelsy*. It was per-

haps thought that to repeat quotations from well-known authors was not piracy. If so, I think a great mistake was committed. In the adaptation of the quotation to the ballad which it illustrates, the literary research which discovered it, the critical skill which applied it, — there was, I think, an act of authorship performed, of which no one was entitled to take the benefit for his own publication, and thereby to save the labor, the learning, and the expenditure necessary even for this part of the annotation." 9 Sc. Sess. Cas. 8d ser. 355.

compiler in the manner above described, he should, in my judgment, be held to have committed piracy.¹

But there is nothing in the law of copyright to prevent any person who has obtained common materials from the original sources from using them in substantially the same manner, and for the same purpose, as they have been previously used; provided the arrangement is his own, and is not servilely copied from the work of another. Two authors, writing on the same subject, citing the same authorities, and taking the same illustrations and quotations from common sources, will naturally use such common materials for like purposes and in a similar manner. As far as citations of authorities, quotations, &c., are concerned, there may be a striking resemblance, amounting in some instances to substantial identity. This, however, does not amount to piracy, unless it appears that there has been servile copying from the preceding work.² In *Pike v. Nicholas*, a substantial identity was shown between the two works in controversy, both as to common materials used and their arrangement and mode of treatment. The Vice-Chancellor was satisfied that the later work was the result of piratical copying, and not of independent labor. But the court of appeal, finding that the subsequent writer had obtained his materials from the original sources, and that the resemblance in the use of the materials of the two works was natural under the circumstances, held that it was not a case of piracy.³ Hence, in determining the question of piracy in cases of this kind, much allowance should be made for the natural resemblance between the two productions. In the case of two compilations on the same subject, the author of the later one should not be

¹ In *Story's Executors v. Holcombe*, Mr. Justice McLean said: "So far as citations are made in the Commentaries, Mr. Holcombe had a right to go to the original works and copy from them; but he could not avail himself of the labor of Judge Story, by copying the extracts as compiled by him. This is a well-established principle. Nor could he copy the plan or arrangement of the subjects in the Commentaries. It is said there can be no copy-

right in a plan, distinct from the work itself, any more than there can be a copyright in an idea. This is admitted; but the words in which an idea is expressed is a subject of property, and so is the classification." 4 McLean, 316.

² *Murray v. Bogue*, 1 Drew. 353; *Spiers v. Brown*, 6 W. R. 352; *Webb v. Powers*, 2 Woodb. & M. 497; *Banks v. McDivitt*, 13 Blatchf. 163.

³ Law Rep. 5 Ch. 251.

held too strictly accountable for similarity in arrangement and combination between his and the earlier work. So a person should not be held too rigidly to the penalty of piracy for having followed a preceding plan and arrangement, which have little or no material originality or merit. But, in general, a subsequent compiler should not be allowed servilely to copy, to a material extent and to the injury of his predecessor, the arrangement and combination which give value to a pre-existing work.

ASCERTAINING THE FACT OF COPYING.

Before the question of piracy can be determined, it will be necessary to ascertain what use the defendant has made of the plaintiff's work. In the case of literal copying, this can usually be done with little difficulty and with certainty. But, when the matter alleged to have been taken is more or less disguised in the later publication by change of language, form, arrangement, &c., the determination of the question of copying will often be attended with great difficulties. When the defendant frankly admits the extent to which the plaintiff's work has been used, and his evidence is accepted as conclusive, the fact will thereby be established, and the law determined accordingly. More frequently, however, copying is denied, or only a fair use of the protected work is admitted to have been made; but this evidence is often inconsistent with the likeness between the two publications, and will be insufficient to rebut the charge of copying. A comparison of the two works will then be made with the aid of such direct or circumstantial evidence as may be available; and not unfrequently the question will have to be determined solely or chiefly by the internal evidence afforded by such comparison.

Common Errors Test of Copying. — The occurrence of the same errors in the two publications in controversy affords one of the surest tests of copying, especially in the case of compilations where a close resemblance is a natural consequence of the use of common materials. In some instances, it may be made apparent that both writers have naturally made the same mistakes; but, in general, this result is so improbable that the

presence in both works of common inaccuracies creates a presumption of copying so well grounded that it can be overcome only by the strongest evidence. Hence, in the absence of conclusive proof to the contrary, the courts have uniformly accepted the evidence afforded by such errors, when sufficiently numerous or peculiar, as adequate to sustain the charge of copying.¹ And Lord Eldon laid down the rule, that, when parts of a book have been proved by this test to have been pirated, other identical passages in which common blunders do not appear must be presumed to have been copied.²

Things against Presumption of Copying.— Due weight should be given to those circumstances which indicate that certain common peculiarities may be fairly attributed to other agencies than copying. Thus, punctuation, spelling, the use of capitals, and kindred matters, are often regulated, not by the author, but by the proof-reader. Hence, peculiarities of this kind may appear in a publication without the author's agency. Especially are the probabilities in favor of copying afforded by such resemblances greatly lessened when it appears, as in *Lawrence v. Dana*,³ that both works were printed in the same office, where

¹ *Longman v. Winchester*, 16 Ves. 269; *Mawman v. Tegg*, 2 Russ. 385; *Murray v. Bogue*, 1 Drew. 353; *Spiers v. Brown*, 31 L. T. R. 16; s. c. 6 W. R. 352; *Kelly v. Morris*, Law Rep. 1 Eq. 697, 702; *Pike v. Nicholas*, Law Rep. 5 Ch. 251; *Cox v. Land & Water Journal Co.*, Law Rep. 9 Eq. 824; *Lawrence v. Dana*, 2 Am. L. T. R. n. s. 402.

"From the identity of the inaccuracies, it is impossible to deny that the one was copied from the other *verbatim et literatim*." Lord Eldon, *Longman v. Winchester*, *supra*, 272.

"Some instances are stated in the bill, and others were stated at the bar, to show that Mr. Bogue has the plaintiff's errors, which is the ordinary and familiar mode of trying the fact whether the defendant has used the plaintiff's book. Now, the use of showing the same errors in both is, that where the defendant says he has got his information not from the plaintiff, but from other sources, if the evidence is unsatisfactory on the question whether the defendant did use the plaintiff's

work or not, to show the same errors in the subsequent work that are contained in the original is a strong argument to show copying." *Kindersley, V. C.*, *Murray v. Bogue*, 1 Drew. 366.

² "It is necessary to ascertain how much of the one book has been copied from the other; and many cases have established, that you cannot have better evidence of such copying than the circumstance which occurs in several of the passages here complained of,—namely, the fact of blunders in the original book being transferred into the book which is accused of piracy. And I may add, that, when a considerable number of passages are proved to have been copied, by the copying of the blunders in them, other passages which are the same with passages in the original book must be presumed, *prima facie*, to be likewise copied, though no blunders occur in them." *Mawman v. Tegg*, 2 Russ. 393-394.

³ 2 Am. L. T. R. n. s. 402.

the proof-reading is governed by uniform rules, or that both were corrected by the same proof-reader.

So, in *Pike v. Nicholas*, it appeared that both plaintiff and defendant had made the same quotation from Prichard, in which that author had cited a passage from Livy, relating to the color of the hair of the Gauls, and that both had pointed out that the correct reading of the Latin text was *rutilatæ comæ*, "reddened heir," and not, as given by Prichard, *rutilæ comæ*, "red hair." This was cited as evidence of copying. But the Lord Justices of appeal gave much weight to the consideration that the defendant was a fair Latin scholar, and might naturally have made the same criticism as did the plaintiff on Prichard's reading. And this view was strengthened by the fact that the form *rutilatæ* was to be found in a German and in a French translation of the passage in question.¹

So, also, it will be in the defendant's favor if the erroneous passage alleged to have been copied in his book is free from some of the inaccuracies which are found in the same passage in the plaintiff's publication.² Still, it is to be remembered that the errors may have been corrected in copying.

Circumstances such as the above are not necessarily conclusive; but they will be entitled to due consideration in weighing the probabilities.

Presumption of Copying Created by Likeness must be Overcome by Defendant. — When the publication complained of contains resemblances striking enough to warrant the inference of piracy, it is for the defendant to show that the likeness is not the result of copying from the complainant's work.³ He may establish the fact that his own work was prepared without any recourse whatever to that of the plaintiff; or, admitting that he had seen or used the latter, he may show that the parts complained of in his own work were taken by him from a source other than the publication alleged to have been pirated. It

¹ Law Rep. 5 Ch. 251.

² In *M'Neill v. Williams*, 11 Jur. 344, it appeared that seven errors in the plaintiff's mathematical tables were also found in those of the defendant. The latter declared that this was accidental, and that the plaintiff's book

contained seventy errors not to be found in his own. It does not appear what importance the court attached to this circumstance; but the injunction was refused.

³ See *ante*, p. 400.

will not be enough for the defendant simply to show that the passages in question are to be found in other books than the plaintiff's, and that such books were accessible to him, or even were used by him in the preparation of his own. This evidence may lessen the probabilities that there was unlawful copying. But it must be proved that the defendant actually got the matter in dispute from the common source without copying from the protected work. It is obvious that there would be little protection for compilations and other works containing selections, quotations, citations, &c., gathered from common sources, if the charge of piracy could be successfully met by showing that the defendant might have obtained the matter complained of from the original authorities. The pivotal question is not what he might have done, but what he has done.

So, when coincidence of errors is brought forward as evidence of copying, it will doubtless be in the defendant's favor to show that the same inaccuracies are found in the work of another author. But it by no means follows from this that the erroneous passages in the defendant's work were not copied from that of the plaintiff.

When the defendant is charged with having copied quotations from the plaintiff's work, instead of going to the original authorities, it will be a circumstance of much weight if the quoted matter in the later compilation is more extensive than in the earlier one.¹

Intention to pirate on the part of the person charged with wrong will have much weight in determining the question of copying.² And so it will often be important for the defendant to produce his manuscript, or satisfactorily account for its non-production.³ He may also be called upon to explain such matters relating to the preparation of his work as may throw light on the question of unlawful copying. In a recent English

¹ "On the other hand, the defendant had quoted an author taken from Prichard, Calpurnius Flaccus, who was not quoted by the plaintiff, and had added to his quotation a passage from Tertullian, which was not apt to the subject. These circumstances showed clearly that the defendant went to the original source, namely, Prichard, and

that he got those quotations from Prichard which the plaintiff got from Prichard." Lord Hatherley, *Pike v. Nicholas*, Law Rep. 5 Ch. 262.

² See *ante*, p. 402.

³ *Hotten v. Arthur*, 1 Hem. & M. 609; *Jarrold v. Houlston*, 8 Kay & J. 708; *Spiers v. Brown*, 6 W. R. 352. See this point considered in Chap. XI.

case, where the defendant denied that he had copied from the plaintiff's book quotations from Retzius and from Pouchét, his evidence was not credited, because he could not say where he had seen the original works of those authors, which were so rare that copies were not in the British Museum. The defendant was further charged with having copied an argument based on the physical characteristics of ten thousand persons which he claimed to have observed at public meetings; but it was a significant fact against him that he could not give the time or place of such meetings.¹

¹ Pike *v.* Nicholas, Law Rep. 5 Ch. 251. See also Kelly *v.* Wyman, 17 W. R. 399; s. c. 20 L. T. N. S. 300.

CHAPTER IX.

ABRIDGMENTS, TRANSLATIONS, AND DRAMATIZATIONS,
CONSIDERED WITH REFERENCE TO PIRACY.

General Principles. — In considering the question of piracy in the case of these productions, certain fundamental principles, which apply equally to all of them, should be borne in mind. Any person, or any number of persons, may abridge, translate, or dramatize any publication not protected by copyright. The original being common property, no legal rights are secured to its author; therefore, none are violated by the uses above mentioned. Hence, there may be numerous abridgments, translations, or dramatizations of the same original, and copyright will vest in each.¹ This copyright will prevent any person without license from copying the abridgment, translation, or dramatization, but not from using the original for the same purpose. Whether one abridgment, translation, or dramatization infringes another is determined by the fact, whether the alleged wrong-doer has produced his own from the original by independent labor, or has copied that of another. So also a person with the consent of the author may secure a copyright for an abridgment, translation, or dramatization of a work protected by copyright.

Alterations, additions, improvements, &c., made without authority, however extensive or valuable they may be, confer no right to use a copyrighted work.² A person may acquire copyright in new matter added to a work of which he is not the author, or in changes, improvements, &c., made in such work; but he must show that the original is common property, or, if protected by copyright, that he has authority so to use it. Hence, it is no defence of piracy that the

¹ See *ante*, p. 158.

² See *ante*, pp. 405–407.

unauthorized abridgment, translation, or dramatization of a copyrighted work presents the original in a new and improved, a more useful, or a less expensive form. It is a fundamental principle of the law of copyright that to take a material part, *verbatim* or in substance, of a protected work, except under the recognized privilege of fair use, is piracy. This principle is universally recognized. It was affirmed by Lord Langdale, when he said, "Whilst all are entitled to resort to common sources of information, none are entitled to save themselves trouble and expense by availing themselves, for their own profit, of other men's works still subject to copyright and entitled to protection;"¹ and by Mr. Justice Story, when he said that if "the labors of the original author are substantially to an injurious extent appropriated by another, that is sufficient in point of law to constitute a piracy *pro tanto*."² This principle is not less applicable to the productions now under consideration than it is to any other kind.

The question of piracy, then, in the case of an abridgment, translation, or dramatization of a work protected by copyright, is to be determined by two inquiries: 1. Whether the whole or a material part of the original has been substantially reproduced; 2. Whether the original has been used with the consent of the owner.³

ABRIDGMENTS.

The judicial history of copyright is fertile in examples showing how false doctrines become firmly rooted in jurisprudence by the practice of blindly following precedents without examining the grounds on which they are based. No subject presents a more striking illustration of the evils of this custom than that of abridgments. In 1847, Mr. Justice McLean, after emphatically declaring that the doctrine held by the courts in relation to abridgments was contrary to right and established principles, said that he was "bound by precedent;"⁴ and as lately as 1869 Mr. Justice Clifford declared that the prevailing doctrine on this subject "has been too long

¹ *Lewis v. Fullarton*, 2 Beav. 8.

² *Folsom v. Marsh*, 2 Story, 115.

³ Dramatizations for performance are further governed by the question

whether the work dramatized is a dramatic composition.

⁴ *Story's Executors v. Holcombe*, 4 McLean, 808, 809.

established to be considered at the present time as open to controversy.”¹ Let us consider what authorities there are in favor of this latter conclusion, and to what weight they are entitled. For the true spirit of inquiry is, that a doctrine in jurisprudence is never beyond pertinent question until it rests firmly on reason and sound principles.

English Authorities.—The theory that an abridgment of a copyrighted work is not an invasion of literary property is traced to a *dictum* expressed by Lord Hardwicke in 1740, when Sir Matthew Hale’s Pleas of the Crown was alleged to have been infringed. The book complained of was found to be not an abridgment, but a reprint, of the original, “colorably shortened.” Lord Hardwicke said: “Where books are colorably shortened only, they are undoubtedly within the meaning of the act of Parliament, and are a mere evasion of the statute, and cannot be called an abridgment. But this must not be carried so far as to restrain persons from making a real and fair abridgment, for abridgments may with great propriety be called a new book; because not only the paper and print, but the invention, learning, and judgment, of the author is shown in them, and in many cases are extremely useful, though in some instances prejudicial, by mistaking and curtailing the sense of the author. If I should extend the rule so far as to restrain all abridgments, it would be of mischievous consequence.”² Brief *dicta*, or admissions of like import, are to be found in the opinions in *Tonson v. Walker*,³ decided in 1752; *Dodsley v. Kinnersley*,⁴ in 1761; *Millar v. Taylor*,⁵ in 1769; *Bell v. Walker*,⁶ in 1785; *D’Almaine v. Boosey*,⁷ in 1835; and *Prince Albert v. Strange*,⁸ in 1849. In none of these cases was

¹ *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 425.

² *Gyles v. Wilcox*, 2 Atk. 141.

³ 3 Swans. 678.

⁴ Amb. 408.

⁵ 4 Burr. 2310.

⁶ 1 Bro. C. C. 451.

⁷ 1 Y. & C. Exch. 301.

⁸ 2 De G. & Sm. 693. Vice-Chancellor Knight Bruce also seems to have thought that an abridgment was not necessarily piratical. But his views are not expressed with precision. “I am not aware,” he said, “that one man

has a right to abridge the works of another. On the other hand, I do not mean to say that there may not be an abridgment which may be lawful, which may be protected; but, to say that one man has the right to abridge, and so publish in an abridged form, the work of another without more, is going much beyond my notion of what the law of this country is.” The language following in the opinion indicates that the question of piracy is to be determined by the character of the abridgment. The work complained of was

the publication complained of an abridgment, and in none was the law governing piracy in the case of abridgments fully considered or discussed. Hence, these decisions afford no direct test of the question now under consideration, and have no binding force as precedents.

The only English case wherein the decision turned directly on this point was one against Newbery, in 1774. It was there found that the defendant had made a *bona fide* abridgment of Dr. Hawkesworth's *Voyages*; and Lord Chancellor Apsley, after consultation with Sir William Blackstone, held that "an abridgment, where the understanding is employed in retrenching unnecessary and uninteresting circumstances, which rather deaden the narration, is not an act of plagiarism upon the original work, nor against any property of the author in it, but an allowable and meritorious work." The injunction was, therefore, refused.¹

All the English decisions in favor of the doctrine that a *bona fide* abridgment of a protected work is no infringement of the copyright in the original have now been cited. It will be seen that, with two unimportant exceptions, they all belong to the last century. Age does not necessarily weaken the force of an authority. Fundamental principles remain unchanged by time, though new conditions may be imposed by the legislature, and precedents may be overruled by the courts. But when, in the growth of jurisprudence, are developed sound principles wholly antagonistic to those on which earlier decisions rest, such decisions properly lose the weight of authority. Tried by this test, the cases just cited must be considered obsolete as far as they bear on the question now under consideration. While they have not been formally overruled, the doctrine which they

found to be a republication of Dickens's Christmas Carol, with merely colorable alterations, and therefore not a *bona fide* abridgment. *Dickens v. Lee*, 8 Jur. 184.

In *Butterworth v. Robinson*, 5 Ves. 709, it was held that the plaintiff was entitled to an injunction to restrain the publication of *An Abridgment of Cases*. But it was alleged that "this work was by no means a fair abridgment;

that, except by colorably leaving out some parts of the cases, such as the arguments of counsel, it was a mere copy *verbatim* of several of the reports of cases in the courts of law, and among them the Term Reports, of which plaintiff is proprietor." Lord Chancellor Loughborough said, "It appears to me an extremely illiberal publication."

¹ Lofft, 775.

sanction cannot be reconciled with those principles which have repeatedly governed the courts in determining questions of piracy in more recent cases.¹

American Authorities. — It is not surprising that a doctrine unquestioned for a century in England should have found a place in American jurisprudence. It has been apparently recognized, in part at least, by Mr. Justice Story, in *Gray v. Russell*,² and *Folsom v. Marsh*;³ by Mr. Justice Woodbury, in *Webb v. Powers*;⁴ and by Mr. Justice Clifford, in *Lawrence v. Dana*.⁵ It has been applied by Mr. Justice McLean, in *Story's Executors v. Holcombe*.⁶ In the four cases first cited, the works complained of were not abridgments. Hence, these decisions are not binding as precedents on this question. Nevertheless the opinions of the distinguished jurists who pronounced them, when they are the result of their own reasoning, are entitled to careful consideration. But in the cases referred to they seem simply to have repeated the views found in the English reports. Moreover, the English doctrine was accepted with a qualification which amounts to its practical rejection. Mr. Justice Story was of opinion that, if the abridgment will "prejudice or supersede the original work," it is piratical;⁷ and Mr. Justice Clifford declared that an abridgment "which is of

¹ "Recent decisions afford more ample protection to copyright than those of an earlier date, and they also restrict the privilege of the subsequent writer or compiler in respect to the use of the matter protected by the copyright within narrower limits." Clifford, J., *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 428.

² 1 Story, 19.

³ 2 Id. 106.

⁴ 2 Woodb. & M. 520.

⁵ 2 Am. L. T. R. N. S. 425, 426.

⁶ 4 McLean, 306.

⁷ "In some cases, indeed," said Mr. Justice Story, "it may be a very nice question what amounts to a piracy of a work, or not. Thus, if large extracts are made therefrom in a review, it might be a question whether those extracts were designed *bona fide* for the mere purpose of criticism, or were designed to supersede the original work,

under the pretence of a review, by giving its substance in a fugitive form. The same difficulty may arise in relation to an abridgment of an original work. The question in such a case must be compounded of various considerations, whether it be a *bona fide* abridgment, or only an invasion by the omission of some unimportant parts; whether it will, in its present form, prejudice or supersede the original work; whether it will be adapted to the same class of readers; and many other considerations of the same sort, which may enter as elements in ascertaining whether there has been a piracy or not. Although the doctrine is often laid down in the books, that an abridgment is not a piracy of the original copyright, yet this proposition must be received with many qualifications." *Gray v. Russell*, 1 Story, 19. See also 2 Eq. Jur. § 939.

the character to supersede the original" is "an infringement of the franchise secured by the copyright."¹ This proviso nearly, if not quite, annuls the doctrine to which it is applied. For, excepting perhaps in rare cases, the effect of the abridgment must be to prejudice or to supersede the original, to a material extent.

The complaint in *Story's Executors v. Holcombe* was that the copyright in *Story's Commentaries on Equity Jurisprudence* had been infringed by the publication of an *Introduction to Equity Jurisprudence*, prepared by the defendant. The defence was set up that the latter was a *bona fide* abridgment of the former. The Master reported that *Story's* work had been fairly

¹ "Courts have sometimes supposed," said Mr. Justice Clifford, "that the same rule of decision should be applied to a copyright as to a patent for a machine, and consequently that an abridgment of an original work, made and condensed by another person without the consent of the author of the original work, ought to be regarded as an infringement; but the language of the respective acts of Congress, making provision for the protection of such rights, is different; and the opposite doctrine has been too long established to be considered at the present time as open to controversy. *Story v. Holcombe*, 4 McLean, 309. Whatever might be thought if the question was an open one, it is too late to agitate it at the present time, as the rule is settled that the publication of an unauthorized but *bona fide* abridgment or digest of a published literary copyright, in a certain class of cases at least, is no infringement on the original. Phillips on Copyright, 171; *Newbery's Case*, Loft, 775; *Dodsley v. Kinnersley*, Amb. 403; *Whittingham v. Wooler*, 2 Swans. 428; *Gyles v. Wilcox*, 2 Atk. 141.

"Strong doubts are expressed by Mr. Curtis, whether the definition of an allowable abridgment, as given in the earlier cases, can be sustained, except as applied to such works as histories, or works composed of translations, and others of like kind; but it was decided

in this court, in the case of *Folsom v. Marsh*, 2 Story, 105, that an abridgment in which there is a substantial condensation of the materials of the original work, and which required intellectual labor and judgment to make the same, does not constitute an infringement of the copyright of the original author; and the court, as now constituted, is inclined to adopt that rule in cases where it also appears that the abridgment was made *bona fide* as such, and that it is not of a character to supersede the copyrighted publication: Unless it be denied that a legal copyright secures to the author 'the sole right and liberty of printing, reprinting, publishing, and vending the book' copyrighted, it cannot be held that an abridgment or digest of any kind of the contents of the copyrighted publication, which is of a character to supersede the original work, is not an infringement of the franchise secured by the copyright. What constitutes a fair and *bona fide* abridgment in the sense of the law is, or may be under particular circumstances, one of the most difficult questions which can well arise for judicial consideration; but it is well settled that a mere selection or different arrangement of parts of the original work into a smaller compass will not be held to be such an abridgment." *Lawrence v. Dana*, 2 Am. L. T. R. N. S. 425.

abridged, and hence that there was no infringement. Against this conclusion, the court found that the first third of the defendant's book, including one hundred pages, was not a fair abridgment, and granted an injunction against that part. The rest was regarded as an abridgment, and its publication was not enjoined.¹ In considering the principles which govern piracy in the case of abridgments, Mr. Justice McLean said: "This controversy has caused me great anxiety and embarrassment. On the subject of copyright, there is a painful uncertainty in the authorities; and, indeed, there is an inconsistency in some of them. That the complainants are entitled to the copyright which they assert in their bill is not controverted by the defendants. The decision must turn on the question of abridgment. If this were an open question, I should feel little difficulty in determining it. An abridgment should contain an epitome of the work abridged, — the principles, in a condensed form, of the original book. Now, it would be difficult to maintain that such a work did not affect the sale of the book abridged. The argument that the abridgment is suited to a different class of readers, by its cheapness, and will be purchased on that account by persons unable and unwilling to purchase the work at large, is not satisfactory. This, to some extent, may be true; but are there not many who are able to buy the original work, that will be satisfied with the abridgment? What law library does not contain abridgments and digests, from Viners and Comyns down to the latest publications? The multiplication of law reports and elementary treatises creates a demand for abridgments and digests; and these being obtained, if they do not generally, they do frequently, prevent the purchase of the works at large. The reasoning on which the right to abridge is founded, therefore, seems to me to be false in fact. It does, to some extent in all cases, and not unfrequently to a great extent, impair the rights of the author, — a right secured by law.

"The same rule of decision should be applied to a copyright as to a patent for a machine. The construction of any other machine which acts upon the same principle, however its

¹ 4 McLean, 306.

structure may be varied, is an infringement on the patent. The second machine may be recommended by its simplicity and cheapness ; still, if it act upon the same principle of the one first patented, the patent is violated. Now, an abridgment, if fairly made, contains the principle of the original work ; and this constitutes its value. Why, then, in reason and justice, should not the same principle be applied in a case of copyright as in that of a patented machine ? With the assent of the patentee, a machine acting upon the same principle, but of less expensive structure than the one patented, may be built ; and so a book may be abridged by the author, or with his consent, should a cheaper work be wanted by the public. This, in my judgment, is the ground on which the rights of the author should be considered.

“ But a contrary doctrine has long been established in England, under the statute of Anne, which, in this respect, is similar to our own statute ; and in this country the same doctrine has prevailed. I am therefore bound by precedent ; and I yield to it in this instance more as a principle of law than a rule of reason or justice.”¹

The only American case, then, which directly supports the doctrine that a *bona fide* abridgment of a copyright book is not piratical is Story's *Executors v. Holcombe*. The authority of this will readily be set aside, when it is remembered that the decision was rendered under protest, so to speak, was contrary to the opinion of the judge who pronounced it, and was based on no other ground than that of supposed precedents, which have been shown to have had no force.

THE DOCTRINE MAINTAINED THAT AN UNAUTHORIZED ABRIDGMENT IS PIRATICAL.

The above review of all the decisions that can be cited in support of the prevailing doctrine concerning abridgments, and the absence of express authorities on the other side, show that the question whether the copyright in a work is violated by an unauthorized abridgment of the original must be deter-

¹ 4 McLean, 808.

mined by the application of those general principles which are uniformly recognized as governing the subject of piracy.

The word abridgment has been loosely applied to publications widely different in character. We may here dismiss from consideration those so-called abridgments which are made by merely colorably shortening the originals, or by simply selecting some parts and omitting others. Such productions are compilations or servile imitations, and, when copyrighted originals are used without authority, are conceded to be piratical, even by those who maintain that a *bona fide* abridgment is not an invasion of copyright. So, also, a biographical sketch of a page or so, written from an elaborate biography in one or more volumes, will doubtless not be considered an abridgment of the larger work.

What will be here regarded as a genuine abridgment is a production in which the substance of the whole, or of a material part, of a work is condensed into a much smaller compass, and is given in language substantially different from that of the original.¹ That labor, skill, and judgment may be required

¹ "What constitutes a fair and *bona fide* abridgment, in the sense of the law, is one of the most difficult points, under particular circumstances, which can well arise for judicial discussion. It is clear that a mere selection, or different arrangement, of parts of the original work, so as to bring the work into a smaller compass, will not be held to be such an abridgment. There must be real, substantial condensation of the materials, and intellectual labor bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work." Story, J., *Folsom v. Marsh*, 2 Story, 107.

"A fair abridgment of any book is considered a new work, as to write it requires labor and exercise of judgment. It is only new in the sense that the view of the author is given in a condensed form. Such a work must not only contain the arrangement of the book abridged, but the ideas must be taken from its pages.

"It must be in good faith an abridgment, and not a treatise interlarded with citations. To copy certain passages from a book, omitting others, is in no just sense an abridgment of it. It makes the work shorter, but it does not abridge it. The judgment is not exercised in condensing the views of the author. His language is copied, not condensed; and the views of the writer, in this mode, can be but partially given. To abridge is to preserve the substance, the essence, of the work, in language suited to such a purpose. Gould's Abridgment of Alison's History of Europe gives all the material facts of the original work, covering the whole line of the narrative; and this, in a legal sense, may be called an abridgment. . . .

"All the authorities agree that to abridge requires the exercise of the mind, and that it is not copying. To compile is to copy from various authors into one work. In this, the judgment may be said to be exercised to some extent in selecting and combining the

to produce this result; that such an abridgment may be a new work in outward form, of great merit, and highly useful by presenting the essence of the original in a less expensive, more convenient, and perhaps better shape, is wholly true. On these grounds was founded the doctrine that the rights of an author are not invaded by an unlicensed abridgment of his literary production; and they are the only ones to be found in the reported opinions to support that theory.¹ The qualities above mentioned are ample to sustain copyright in the abridgment of an unprotected work, or of a copyrighted work abridged with the consent of the author. But they confer no right on any

extracts. Such a work entitles the compiler, under the statute, to a right of property. This right may be compared to that of a patentee, who, by a combination of known mechanical structures, has produced a new result.

“Between a compilation and an abridgment there is a clear distinction; and yet it does not seem to have been drawn in any opinion cited. A compilation consists of selected extracts from different authors; an abridgment is a condensation of the views of the author. The former cannot be extended so as to convey the same knowledge as the original work; the latter contains an epitome of the work abridged, and consequently conveys substantially the same knowledge. The former cannot adopt the arrangement of the works cited; the latter must adopt the arrangement of the work abridged. The former infringes the copyright, if matter transcribed when published shall impair the value of the original book; a fair abridgment, though it may injure the original, is lawful. [*Bell v. Walker*] 1 Bro. C. C. 451; *Gyles v. Wilcox*, 2 Atk. 141.” *McLean, J., Story's Executors v. Holcombe*, 4 *McLéan*, 311-314.

¹ These grounds are most fully given in the case against Newbery, reported by Lofft, 775. Lord Chancellor Apsley “was of opinion that this abridgment of the work was not any

violation of the author's property whereon to ground an injunction. That, to constitute a true and proper abridgment of a work, the whole must be preserved in its sense; and then the act of abridgment is an act of understanding, employed in carrying a large work into a smaller compass, and rendering it less expensive and more convenient both to the time and use of the reader, which made an abridgment in the nature of a new and meritorious work.

“That this had been done by Mr. Newbery, whose edition might be read in the fourth part of the time, and all the substance preserved, and conveyed in language as good or better than in the original, and in a more agreeable and useful manner. That he had consulted Mr. Justice Blackstone, whose knowledge and skill in his profession was universally known, and who as an author himself had done honor to his country. That they had spent some hours together, and were agreed that an abridgment, where the understanding is employed in retrenching unnecessary and uninteresting circumstances, which rather deaden the narration, is not an act of plagiarism upon the original work, nor against any property of the author in it, but an allowable and meritorious work. And that this abridgment of Mr. Newbery falls within these reasons and descriptions.”

one to abridge without authority a work protected by copyright. If a person is entitled to republish any literary production which does not belong to him, simply because he may change it by labor and skill into a better, more useful, or less expensive form, there is obviously little protection for literary property. To defend piracy by such reasoning is the same in principle as to justify the unlicensed taking of material possessions on the sole ground of their conversion into useful products. The rights of property cannot justly be undermined by such fictions. A dramatization of a novel, or an arrangement for the piano of an opera, is a reproduction of an existing work in a new and useful form; but it has been properly held that no one without authority may dramatize for publication a copyrighted novel,¹ or arrange for the piano an opera protected by copyright.² The principle is the same in the case of an abridgment. The maker must show a clear title to that which he has taken, — a title derived from the owner of the original. The failure to recognize the vital distinction between the abridgment of a work which is and of one which is not protected by copyright doubtless led to the adoption of the erroneous doctrine which has been criticised.

The question whether a protected work is infringed by the publication of an unauthorized abridgment is one easily determined. We have but to ascertain whether the person charged with wrong has availed himself of the labor and learning of another to a material extent, and to the injury of the author entitled to protection. That the maker of an abridgment does this must be evident to most minds. The very plan of an abridgment and the purpose of its author require that it shall embody what is most valuable in the work abridged. Between the abridged and the unabridged, the difference is alone in form and size; the substance remains the same. A production which is the creation of rare genius, the fruit of great learning, or of years of toil, may be condensed, in a comparatively short time and with comparatively little labor, by a literary workman of ordinary skill. But that which is the essence

¹ *Tinsley v. Lacy*, 1 Hem. & M. 747. See also *Reade v. Lacy*, 1 Johns. & H. 524.

² See *ante*, pp. 410, 411.

of the abridgment, and constitutes its chief value, is due to the genius, learning, or industry of the original author. What would be an abridgment of Bancroft's History of the United States, but a reproduction of the substantial fruits of forty years' patient toil, and of the great learning of that historian? What would be an abridgment of the American Cyclopædia, but an appropriation of the wealth of information there garnered at a cost of half a million dollars for literary labor alone? It would seem to be needless, even thus briefly, to indicate that he who abridges a work takes the substantial results contained in the original.

It must be not less apparent that the publication of the abridgment will tend to supersede the unabridged, to lessen its sale, and thereby to injure its owner. Doubtless many buyers of the abridged would not have bought the unabridged; but, on the other hand, not a few will abstain from buying the larger work, simply because the smaller one is to be had. But it is not necessary to show that the sale of the original is prejudiced by the publication of the condensed edition. The rights of the author extend to the whole and all the parts of a literary composition, and to all the forms in which the whole or a material part may be published. It is for him to say whether an abridgment shall be published; to him belongs whatever profit or credit may attend such publication. Whether he has or has not issued an abridgment, he may be injured by the publication of an unauthorized one. In one case, the injury is actual; in the other, potential. Moreover, the reputation of the original author may be hurt by the publication of an unauthorized abridgment which fails to reproduce the original with accuracy and fidelity; and, in some cases, by any condensation of the original, however faithfully and skilfully done.

The conclusion of fact, then, to which we are brought is, that a genuine abridgment embodies the substantial results contained in the work abridged; and, if unauthorized, is damaging to the author of the original. The question of piracy is determined by the application of the established principle that no one without authority shall take a material part of another's work, to the injury of the person entitled to protection. It is