

Copyrights--Government Employee--Application of Patent Law "Shop Right" Rule to Speeches of Naval Officer (Public Affairs Associates v. Rickover, 177 F. Supp. 601 (D.D.C. 1959))

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enforcement by a state court of a privately created racially discriminatory restrictive covenant or agreement relative to the ownership or occupancy of land is "state action," which violates a thereby excluded person's rights under the equal protection clause of the fourteenth amendment,²⁰ it is surprising that the Court in the present case recognized that the threat to sell to an "undesirable party" constituted duress. Although doing what a person has a legal right to do, when done in a wrongful manner may constitute duress, it would seem that the judicial taboo in the area of enforcing covenants and agreements concerning discrimination in housing should have precluded the Court from holding as it did.



COPYRIGHTS — GOVERNMENT EMPLOYEE — APPLICATION OF PATENT LAW "SHOP RIGHT" RULE TO SPEECHES OF NAVAL OFFICER.—A prominent naval officer delivered several addresses on the subject of naval technical advances, coupled with remarks on the state of education in this country. In an action for declaratory judgment, a publishing house, seeking to quote from these speeches without the author's permission, alleged that the material was official government property and thus by statute¹ not subject to copyright. The United States District Court for the District of Columbia held that even though some of the material was gained from the author's official relationships and paid for in part by the government, the property rights remained in the author and consequently were protected by copyright. *Public Affairs Associates v. Rickover*, 177 F. Supp. 601 (D.D.C. 1959).

In 1854 the House of Lords, in *Jefferys v. Boosey*² recognized that common-law copyright *after publication* had never, in fact, existed. Previously, in 1834 the United States Supreme Court in *Wheaton v. Peters*³ had held similarly, predicating its decision on the constitutional provision for copyrights.⁴ In view of this statutory

²⁰ U.S. CONST. amend. XIV.

¹ 17 U.S.C. § 8 (1958). "No copyright shall subsist in the original text of any work which is in the public domain . . . or in any publication of the United States Government . . ." *Ibid.*

² See *Jefferys v. Boosey*, 4 H.L. 815, 977, 10 Eng. Rep. 681, 744 (1854). See generally Rogers, *A Chapter in the History of Literary Property: The Booksellers' Fight for Perpetual Copyright*, 5 ILL. L. REV. 551, 559 (1911).

³ *Wheaton v. Peters*, 33 U.S. 590, 660 (1834). See generally Rogers, *supra* note 2, at 560.

⁴ U.S. CONST. art. I, § 8, cl. 8. This clause provides that Congress shall have the power: "to promote the Progress of Science and the useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . ." (Emphasis added.) *Wheaton v. Peters*, *supra* note 3, at 660, construed the word "securing" to be

construction, courts, during the nineteenth century, were concerned with the intended scope and limitations of the applicable legislative and constitutional provisions.⁵ They were unwilling to limit application to published writings, but expanded protection to include all works of intellectual labor recognizable as distinctively one's own.⁶ It was a common sense approach to originality within the meaning of the Constitution.

In 1909 Congress passed a copyright act "To Amend and consolidate the Acts respecting copyright."⁷ It was an attempt to revise the law in light of judicial and legislative developments in the area.⁸ Protection was expressly denied to materials and works in the public domain,⁹ providing, however, that treatment of such public material might be copyrighted if individually distinctive, reflecting one's own labor.¹⁰

The subject matter of the speeches, therefore, could not have been of primary significance in the final analysis because the author's labor and individualism is controlling. As a result, the basic issue is not whether the speeches per se are subject to copyright, but whether the author as a government official has the legal capacity to obtain a copyright in light of the copyright law¹¹ which denies protection to government publications.¹²

the creation of a new right rather than a protection of a common-law right because it refers to inventors, as well as authors, who never had a common-law right of protection.

⁵ Howell, *The Scope of the Law of Copyright*, 4 VA. L. REV. 385 (1917). For examples of the proposition set forth by Howell, see *Higgins v. Keuffel*, 140 U.S. 428 (1891); *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884).

⁶ See *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903); *Trade-Mark Cases*, 100 U.S. 82, 94 (1879).

⁷ 35 Stat. 1075 (1909).

⁸ See HOWELL, *THE COPYRIGHT LAW* 8, 253-56 (3d ed. 1952). See also *Burrow-Giles Lithographic Co. v. Sarony*, *supra* note 5, at 58 (writings construed as ideas reduced to a visible expression); *Trade-Mark Cases*, *supra* note 6, at 94 (all original writings, being creative, are subject to copyright protection).

⁹ 35 Stat. 1075 (1909), 17 U.S.C. § 8 (1958).

¹⁰ 35 Stat. 1075 (1909), 17 U.S.C. § 7 (1958). In *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951), originality, in the sense of the copyright statutes, was deemed to mean little more than the lack of plagiarism, the court indicating that statute and the Constitution would be satisfied by a mere trivial variation which is a mark of the author's individuality. *Id.* at 102-03.

¹¹ 17 U.S.C. § 8 (1958).

¹² The Court in the instant case also considered a second question, whether a restricted distribution of a limited number of copies of the speeches constituted an abandonment of the literary property. In deciding that there was no general publication or loss of property interest in the defendant's material, it relied heavily on *Werckmeister v. American Lithographing Co.*, 134 Fed. 321 (2d Cir. 1904). In that case a publication was defined as a general release or offer to the public, resulting in a forfeiture of any literary property in the work. A limited publication, however, was defined as only a conditional re-

Clearly, when an author is hired to write or create something, and that which is created is the subject of his employ, then any copyright obtained on it belongs not to the author, but is held in trust for the employer.¹³ The copyright is therefore ineffective if that employer is the government.¹⁴ This is a principle not unique to copyrights, but is common to patent law as well, predicated on the theory that the employee has produced only that which has been the object of his employment.¹⁵ Obviously, the converse is also true, *i.e.*, that an employee is not, because of his employment, arbitrarily precluded from securing patent or copyright protection, provided his creation is independent of the purpose of his employment.¹⁶

While the law is clear in the foregoing areas, the Court was confronted with a novel situation in the instant case, where the material was written in conjunction with, but not in furtherance of the author's employment.¹⁷ Fortunately, in patent law this deficiency has been remedied by the "shop right" rule which, in these circumstances, protects both employer and inventor.¹⁸

The practical effect of this decision is to extend the protection of the "shop right" rule to copyright cases, thereby affording the author a protection previously reserved to the inventor. The Court's reasoning behind such an extension is that the two areas are analogous, each being predicated on a property interest in one's own ideas or intellectual developments.¹⁹ Patents are issued for inventions which are the result of an original idea or inventive act reduced to practice as a beneficial application of the laws in a physical or chemical form.²⁰ In light of this, the "shop right" rule is derived from the distinction made between employment to invent, which is

lease which precludes any dedication to the public and does not act to terminate the author's interest therein. *Id.* at 326. See also *American Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299-300 (1907); *Patterson v. Century Prod., Inc.*, 93 F.2d 489, 492 (2d Cir. 1937).

¹³ *United States Ozone Co. v. United States Ozone Co. of America*, 62 F.2d 881, 887 (7th Cir. 1932); see *Sawyer v. Crowell Pub. Co.*, 46 F. Supp. 471, 473 (S.D.N.Y. 1942).

¹⁴ 17 U.S.C. § 8 (1958).

¹⁵ See *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 187 (1933).

¹⁶ No distinction is made between the government and a private employer on this point. See *United States v. Dubilier Condenser Corp.*, *supra* note 15, at 189-90; *Solomons v. United States*, 137 U.S. 342, 346 (1890).

¹⁷ *Public Affairs Associates v. Rickover*, 177 F. Supp. 601, 603 (D.D.C. 1959).

¹⁸ Under the "shop right" rule, if an employee creates or develops an invention using the employer's time and materials so that the employer in effect is the financial sponsor, then that employer will have an indefeasible license to use that invention in his business, regardless of any patent rights obtained by the employee. See *Pure Oil Co. v. Hyman*, 95 F.2d 22, 25 (7th Cir. 1938); *Brown v. L. V. Marks & Sons*, 64 F. Supp. 352, 356 (E.D. Ky. 1946).

¹⁹ *Public Affairs Associates v. Rickover*, *supra* note 17, at 603. See generally Note, 47 HARV. L. REV. 1419 (1934).

²⁰ See *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 188 (1933); *Clark Thread Co. v. Willimantic Linen Co.*, 140 U.S. 481, 489 (1891).

predicated on and absorbs such unique conceptions of the employee, and employment merely to design, construct, or devise methods of manufacture, which is predicated more on labor and effort than on uniqueness of thought.²¹ The necessity for unique ideas is lacking in copyright cases, however, as protection is given not necessarily for ideas, but for labor and individuality of work regardless of uniqueness of thought.²² Because uniqueness is not controlling in the copyright area, a difficulty naturally arises in application. It would seem that the rationale to be applied is solely the distinction between the effort used in the copyrighted material, and that which is the object of the employment. The difficulty in drawing a clear distinction based solely on the nature of such labor and effort is apparent.

Whether such a diversification exists in this case is not clear, leaving the Court, in the instant case, to make a decision relying to a great extent on policy considerations. Judicial notice was taken that it is in the public interest for government and private industry to encourage intellectual development of its employees, and that contributions to science and literature are looked upon with favor.²³ To refuse protection in this case would not only have contravened public and governmental policies in this respect, but would have been adverse to the constitutional nature of copyright law.

The constitutional function of copyright is "to promote the Progress of Science and useful Arts. . ."²⁴ By implication, therefore, the purpose of such protection is to encourage authors to develop their ideas for the public welfare.²⁵ It was obviously in this spirit that the Court made its decision.

Since the Court has decided that it was in the spirit of the law and was justifiable under the "shop right" rule to extend protection to the defendant, then under the same principle the government, as employer, should be given a license to use the material. Conceivably, this was an objective of the Court in applying the rule, rather than giving the defendant an exclusive protection. Fortunately, this would not upset the logic of the decision nor its desired effects. If the

²¹ See *United States v. Dubilier Condenser Corp.*, *supra* note 20, at 188-89.

²² See *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 103 (2d Cir. 1951); *Fred Fisher, Inc. v. Dillingham*, 298 Fed. 145, 147, 150 (S.D.N.Y. 1924).

²³ *Public Affairs Associates v. Rickover*, 177 F. Supp. 601, 604-05 (D.D.C. 1959).

²⁴ U.S. CONST. art. I, § 8, cl. 8.

²⁵ See *Mazer v. Stein*, 347 U.S. 201 (1954), where the Court held: "The economic philosophy behind the clauses empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered." *Id.* at 219. See also *Mercoid Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661, 665 (1944); *Washingtonian Publishing Co. v. Pearson*, 306 U.S. 30, 36 (1939).

author is to have copyright protection, then use of the material by the government will not effect a forfeiture of that right, even though government materials usually are in the public domain and consequently not subject to copyright.²⁶



COPYRIGHTS — EQUITY — NEITHER FILING OF ARCHITECTURAL PLANS NOR ERECTION OF BUILDING IS SUCH PUBLICATION AS WOULD FORFEIT COMMON-LAW COPYRIGHT. — Plaintiff filed his architectural plans as required by county ordinance and thereafter erected a building conforming to them. Defendant duplicated this building in detail. Plaintiff sued to recover damages for the infringement of his common-law copyright. The Superior Court entered judgment for defendant, and plaintiff appealed to the District Court of Appeal which *held* that mere filing of architectural plans in the county office, as required by county ordinance, and erection of the house is not such a publication as causes the loss of the common-law copyright protecting the plans. *Smith v. Paul*, 174 Cal. App.2d 804, 345 P.2d 546 (Dist. Ct. App. 1959).

"Copyright is the exclusive right of the owner to multiply and to dispose of copies of an intellectual production. It is the sole right to the copy or to copy it."¹ In early English law, the original ownership of a literary work in the author was conceded.² The first English copyright law³ was passed in 1709.⁴ As it was later construed, the common-law rights of the author in his intellectual production were reaffirmed, with the qualification that these rights were relinquished upon publication.⁵ After publication the author had to depend upon a statutory copyright to protect any rights in the object.⁶

²⁶ 17 U.S.C. § 8 (1958). "The publication or republication by the Government, either separately or in a public document, of any material in which copyright is subsisting shall not be taken to cause any abridgement or annulment of the copyright or to authorize any use or appropriation of such copyright material without the consent of the copyright proprietor." *Ibid*.

¹ Katz, *Copyright Protection of Architectural Plans, Drawings and Designs*, 19 LAW & CONTEMP. PROB. 224 (1954), quoting DRONE, PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 100-01 (1879).

² See *Holmes v. Hurst*, 174 U.S. 82, 84-85 (1899). See also Rossett, *Burlesque as Copyright Infringement*, ASCAP COPYRIGHT SYMPOSIUM 1, 2-3 n.5 (1958).

³ Copyright Act, 1709, 8 Anne, c. 19.

⁴ See Katz, *Copyright Protection of Architectural Plans, Drawings and Designs*, 19 LAW & CONTEMP. PROB. 224, 226 (1954).

⁵ *Donaldsons v. Becket*, 4 Burr. 2408, 98 Eng. Rep. 257 (H.L. 1774).

⁶ "[T]his case [*Donaldsons v. Becket*, *supra* note 5] must be taken to have finally decided that publication put an end to the common law perpetual right, and that after publication an author had to base his claim for protection