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Copyrights--Equity--Neither Filing of Architectural Plans Nor Erection of Building Is Such Publication as Would Forfeit Common-Law Copyright (Smith v. Paul, 174 Cal. App.2d 804 (Dist. Ct. App. 1959))

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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 law [3] 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]

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[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

In 1834, in *Wheaton v. Peters,*[7] the United States Supreme Court adopted this "dual copyright system" by interpreting the first federal copyright statute[8] as having created a right in published works which previously had not existed under the common law.

The present form of the copyright statute expressly preserves the author's common-law rights in the unpublished work.[9] It fails, however, to define publication.[10]

Where copies are sold by the author with restrictions upon the use thereof, it is held that they are published, if put within the reach of the general public, no matter what limitations are put upon them.[11] An offer to sell the copy to the public suffices for publication, and no actual sale need be made.[12] Where the copies are neither sold nor offered for sale, the courts have predicated publication upon the intention of the author to abandon his rights or dedicate his creation to the public.[13] A limited distribution does not constitute the necessary abandonment or dedication.[14] It "is one which communicates a knowledge of its contents under conditions expressly or impliedly precluding its dedication to the public." [15]

So, where a composer distributed mimeographed copies of his composition to a chorus for performance,[16] and where a painting was

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upon his statutory right, if any." COPINGER, LAW OF COPYRIGHT 4 (6th ed. 1927).

[7] 33 U.S. (8 Pet.) 374 (1834).

[8] 1 Stat. 124 (1790). The power of the legislature to enact a copyright statute is derived from article I, § 8 of the Constitution. "The Congress shall have power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." U.S. CONST. art. I, § 8.

[9] "Nothing in this title shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor." 17 U.S.C. § 2 (1958). The common-law right has come to be known as the right of first publication. See, *e.g.,* Chamberlain v. Feldman, 300 N.Y. 135, 139, 89 N.E.2d 863, 865 (1949); Palmer v. DeWitt, 47 N.Y. 532, 537 (1872).

[10] Hirshon v. United Artists Corp., 243 F.2d 640, 644 (D.C. Cir. 1957).

[11] Jewelers' Mercantile Agency v. Jewelers' Weekly Pub. Co., 155 N.Y. 241, 254, 49 N.E. 872, 876 (1898). See, *e.g.,* Vernon Abstract Co. v. Waggoner Title Co., 49 Tex. Civ. App. 144, 107 S.W. 919 (1908) (distribution on a commercial basis is publication). *But see* F.W. Dodge Corp. v. Comstock, 140 Misc. 105, 251 N.Y. Supp. 172 (Sup. Ct. 1931).

[12] See Jewelers' Mercantile Agency v. Jewelers' Weekly Pub. Co., *supra* note 11, at 251; Vernon Abstract Co. v. Waggoner Title Co., *supra* note 11, at 921; Varconi v. Unity Television Corp., 11 Misc.2d 191, 173 N.Y.S.2d 201 (Sup. Ct. 1958).

[13] See White v. Kimmell, 193 F.2d 744 (9th Cir. 1952); Werckmeister v. American Lithographic Co., 134 Fed. 321 (2d Cir. 1904) (dictum).

[14] Patterson v. Century Productions, Inc., 93 F.2d 489 (2d Cir. 1937); William A. Meier Glass Co. v. Anchor Hocking Glass Corp., 95 F. Supp. 264 (W.D. Pa. 1951).

[15] Werckmeister v. American Lithographic Co., *supra* note 13, at 324.

[16] Mills Music, Inc. v. Cromwell Music, Inc., 126 F. Supp. 54, 64 (S.D.N.Y. 1954).

exhibited in a gallery and the public prohibited from copying the work,[17] the courts have found the publication limited and not a forfeiture of the common-law copyright.

In summary, the courts hold that if the copies are sold[18] or offered for sale[19] publication occurs. If the copies are not sold, but distributed or exhibited in a manner failing to indicate an abandonment of rights in the copy, no publication occurs.[20] Thus, the traditional test of publication revolved around the copies, and whether they had been sold, offered for sale, or abandoned.[21]

It has long been held that the performance of a dramatic work before an audience does not constitute a publication of that work.[22] This view has been affirmed by the United States Supreme Court in *Ferris v. Frohman*.[23] The rationale propounded is a failure in these instances to demonstrate an abandonment of rights and a dedication to the public.[24] This concept has been extended to other performance areas. Performance of a song is not publication,[25] nor is the delivery of a lecture to an audience.[26] So, too, the exhibition of

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[17] American Tobacco Co. v. Werckmeister, 207 U.S. 284 (1907). *But see* Carns v. Keefe Bros., 242 Fed. 745 (D. Mont. 1917) (public statue published notwithstanding copying restrictions). If there is no restriction on copying the exhibit it is deemed the intent of the author to abandon his rights, and his common-law copyright is forfeited. See Morton v. Raphael, 79 N.E.2d 522 (Ill. App. 1948).

[18] Grandma Moses Properties, Inc. v. This Week Magazine, 117 F. Supp. 348 (S.D.N.Y. 1953); Larrowe-Loisette v. O'Loughlin, 88 Fed. 896 (C.C.S.D.N.Y. 1898); Jewelers' Mercantile Agency v. Jewelers' Weekly Pub. Co., 155 N.Y. 241, 49 N.E. 872 (1898).

[19] Varconi v. Unity Television Corp., 11 Misc.2d 191, 173 N.Y.S.2d 201 (Sup. Ct. 1958).

[20] See cases cited, note 13 *supra*.

[21] For a fuller discussion of this traditional test and its inadequacy see Roberts, *Publication in the Law of Copyright*, ASCAP COPYRIGHT SYMPOSIUM 111 (1958).

[22] Palmer v. DeWitt, 47 N.Y. 532 (1872). See 2 STORY, COMMENTARIES ON EQUITY JURISPRUDENCE § 950 (1836).

[23] 223 U.S. 424 (1912). "The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right . . . ." *Id.* at 435.

[24] Ferris v. Frohman, 223 U.S. 424 (1912). "[T]he public performance of the play is not an abandonment of it to the public use." *Id.* at 435; 2 STORY, *op. cit. supra* note 22, § 950. "[T]o act it [a dramatic work] at a public theatre does not amount to an abandonment of his [the author's] title, or a dedication of it to the public at large." *Ibid.*

[25] McCarthy & Fischer, Inc. v. White, 259 Fed. 364 (S.D.N.Y. 1919); Mills Music, Inc. v. Cromwell Music, Inc., 126 F. Supp. 54, 70 (S.D.N.Y. 1954) (dictum). Where copies of the composition are distributed in a limited manner, not evincing an abandonment of rights, no publication occurs. Hirshon v. United Artists Corp., 243 F.2d 640 (D.C. Cir. 1957) (2,000 copies to broadcasting stations for "plugging" purposes); Mills Music, Inc. v. Cromwell Music, Inc., *supra* at 64 (mimeographed copies to a choral group). Where, however, the copies are sold, the common-law rights in the composition are forfeited. Wagner v. Conried, 125 Fed. 798 (C.C.S.D.N.Y. 1903).

[26] Nutt v. National Institute, Inc., 31 F.2d 236 (2d Cir. 1929).

motion picture films was found lacking in the dedication to the public deemed necessary for publication,[27] and radio broadcasts fail by the same token to involve publication.[28]

The United States Supreme Court in *White-Smith Music Publishing Co. v. Apollo Co.*[29] held performance of a song by means of a piano roll was not an infringement of the author's rights in the song because a piano roll was not a copy of the musical composition.[30]

The principal case resolved two issues. The first involved the copy, the architectural plans, and whether the compulsory filing of them constituted a publication.[31] Two New York cases have answered this affirmatively,[32] but the rationale adopted by these cases has been questioned.[33] The Court in the principal case held the necessary intent [34] to dedicate to the public and abandon rights was lacking.[35] For this reason the filing of the plans was not a publication of them.

The second issue presented was whether the erection of the building in the public view constituted a publication of the building plans.[36] This also has been answered affirmatively in two instances.[37]

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[27] See Patterson v. Century Productions, Inc., 93 F.2d 489 (2d Cir. 1937); DeMille Co. v. Casey, 121 Misc. 78, 201 N.Y. Supp. 20 (Sup. Ct. 1923). The usual manner of distributing motion picture films is through licensing of them to theatre owners. This is not a publication of them. See DeMille Co. v. Casey, *supra*. But a sale of the film is a publication of it, divesting the author of his common-law rights. Universal Film Mfg. Co. v. Copperman, 212 Fed. 301 (S.D.N.Y. 1914).

[28] See Uproar Co. v. National Broadcasting Co., 8 F. Supp. 358, 362 (D. Mass. 1934); National Exhibition Co. v. Fass, 133 N.Y.S.2d 380 (Sup. Ct. 1954). *Contra,* Loeb v. Turner, 257 S.W.2d 800, 803 (Tex. Civ. App. 1953).

[29] 209 U.S. 1 (1907).

[30] White-Smith Music Publishing Co. v. Apollo Co., 209 U.S. 1, 18 (1907). The holding was broad enough to include phonograph records. For a discussion of the impact of this case on the record industry see Roberts, *Publication in the Law of Copyright,* ASCAP COPYRIGHT LAW SYMPOSIUM 111, 137-41 (1958).

[31] Smith v. Paul, 174 Cal. App.2d 804, 345 P.2d 546, 547 (Dist. Ct. App. 1959).

[32] Wright v. Eisle, 86 App. Div. 356, 83 N.Y. Supp. 887 (2d Dep't 1903); Tumey v. Little, 18 Misc.2d 462, 186 N.Y.S.2d 94 (Sup. Ct. 1959).

[33] Katz, *Copyright Protection of Architectural Plans, Drawings, and Designs,* 19 LAW & CONTEMP. PROB. 224, 233 (1954).

[34] "[T]o constitute publication there must be such a dissemination . . . among the public, as to justify the belief that it took place with the *intention* of rendering such work common property." American Tobacco Co. v. Werckmeister, 207 U.S. 284, 299-300 (1907). (Emphasis added.) A copy may be made "if the owner . . . *intentionally* makes it public. . . ." CAL. CIV. CODE ANN. § 983(b) (West 1954). (Emphasis added.)

[35] In filing the designs, the Court reasoned, the architect intends merely to have them approved as safe, and not to abandon his rights in them. Smith v. Paul, *supra* note 31, at 550.

[36] Smith v. Paul, 174 Cal. App.2d 804, 345 P.2d 546, 553 (Dist. Ct. App. 1959).

[37] Kurfiss v. Cowherd, 223 Mo. App. 397, 121 S.W.2d 282 (Mo. Ct. App. 1938); Gendell v. Orr, 13 Phila. 191 (C.P. 1879).

Gendell v. Orr [38] held the existence of the building on a public highway for three years to be sufficient dedication to forfeit the common-law copyright.[39] *Kurfiss v. Cowherd* [40] held the public exhibition of the building without restriction upon the right to measure and copy was a publication.[41]

However, in deciding this issue, the *Smith* case has disregarded the dedication and abandonment theories of the *Gendell* and *Kurfiss* cases. In their stead it has extended the *Apollo* rule. The house, the Court reasoned, was not a *copy* of the architectural plans and therefore could not be a publication of them.[42]

The *Apollo* rule is not new to the area of copyright.[43] However, in the United States the courts have confined it to the area of musical compositions and recordings. The *Smith* case is the first instance of its application in the area of architectural plans. This has left the door open for its further extension in the performance fields. The requirement of a copy and its strict definition furnishes the courts with a more solid criteria of publication than the traditional abandonment and dedication concept. Armed with this, the forewarning of the *Gendell* case concerning the possible uselessness of statutory copyright [44] may become reality in the performance areas.

CORPORATIONS — POWER OF PRESIDENT TO INSTITUTE SUIT IN THE CORPORATE NAME.—Defendant, a three-man corporation, con-

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[38] *Ibid.*

[39] The court may have anticipated the *Apollo* holding and its effect on statutory copyright when it pointed out: "Three years upon the highway must certainly be regarded as an abandonment of any right, else the copyright law . . . *would become useless.*" Gendell v. Orr, *supra* note 37. (Emphasis added.)

[40] *Supra* note 36.

[41] The building was a model home on exhibition. The court treated it much the same as a painting exhibited in a gallery. Kurfiss v. Cowherd, *supra* note 37, at 287. See note 17, *supra.*

[42] Smith v. Paul, 174 Cal. App.2d 804, 345 P.2d 546, 553 (Dist. Ct. App. 1959). The court also indicated that the exhibition of a film, the performance of a script, and the broadcast of a radio script are not copies. *Id.* at 553 (dictum).

[43] "The performance in public of a dramatic or musical work, and the delivery in public of a lecture, are not publication of the work or lecture . . . for obviously a performance is not an 'issue of copies' . . . .

"Neither is the exhibition in public of an artistic work or the construction of an architectural work of art, publication of it." COPINGER, LAW OF COPYRIGHT 36 (6th ed. 1927). The concept that publication requires an issuance of copies is found in the United Kingdom's Copyright Act, 1911, 1 & 2 GEO. 5, c. 46, § 1(3). This concept is also found in Article VI of the Universal Copyright Convention which defines publication as the reproduction in tangible form and the general distribution to the public of *copies* of a work. Universal Copyright Convention, 17 U.S.C. § 9 (1958).

[44] See note 39, *supra.*