

1967

First Publication Abroad—Investive, Divestitive, or Inoperative? A Territorial View of Copyright

Elihu Inselbuch

Follow this and additional works at: <https://ir.lawnet.fordham.edu/flr>



Part of the [Law Commons](#)

Recommended Citation

Elihu Inselbuch, *First Publication Abroad—Investive, Divestitive, or Inoperative? A Territorial View of Copyright*, 35 Fordham L. Rev. 477 (1967).

Available at: <https://ir.lawnet.fordham.edu/flr/vol35/iss3/4>

This Article is brought to you for free and open access by FLASH: The Fordham Law Archive of Scholarship and History. It has been accepted for inclusion in Fordham Law Review by an authorized editor of FLASH: The Fordham Law Archive of Scholarship and History. For more information, please contact tmelnick@law.fordham.edu.

First Publication Abroad—Investive, Divestitive, or Inoperative? A Territorial View of Copyright

Cover Page Footnote

Member of the New York Bar

FIRST PUBLICATION ABROAD—INVESTIVE,
DIVESTITIVE, OR INOPERATIVE?
A TERRITORIAL VIEW
OF COPYRIGHT

ELIHU INSELBUCH*

I. INTRODUCTION

THE purpose of this article is to focus on the questions arising when a copyrightable work is first published in a country other than the United States. Specifically, these questions are: (1) whether a first publication abroad can ever invest United States' statutory copyright; and, (2) whether a first publication abroad which fails to satisfy investing requirements of the country of publication, or those of the United States, serves to divest, forever, the United States' protection.

Recently, two cases in the United States district court for the Southern District of New York have presented such issues. They are *Ross Prods., Inc. v. New York Merchandise Co.*¹ and *G. P. Putnam's Sons v. Lancer Books, Inc.*² In each case, the first publication was abroad and it did not contain the notice of copyright required by American law, although it apparently satisfied whatever local formalities existed.³

Both decisions deny temporary injunctions and in *Ross Prods.* plaintiff's motion for summary judgment has been denied.⁴

In *Ross Prods.*, the plaintiff, an American corporation, was the copyright proprietor of an inflatable figure of a baseball catcher. The product was manufactured in Japan and marketed in the United States with an appropriate copyright notice. Before the first figures were imported into the United States, however, the plaintiff had displayed the figure at a Japanese toy fair and had offered it for sale at various Japanese department stores. As displayed and sold in Japan, the figure did not contain the notice required by American law.⁵

The court framed the issue as follows: "We are thus faced with the case of an American proprietor who has published abroad without adequate copyright notice. The issue is a simple one—does this prior pub-

* Member of the New York Bar.

1. 233 F. Supp. 260 (S.D.N.Y. 1964).

2. 239 F. Supp. 782 (S.D.N.Y. 1965).

3. Neither case considered the formalities required at the place of publication.

4. 242 F. Supp. 878 (S.D.N.Y. 1965).

5. 233 F. Supp. at 261. See 17 U.S.C. § 19 (1964). Although the court did not discuss the issue, no notice is required by Japanese law.

lication abroad place the work in the public domain, preventing the later acquisition of a valid copyright?"⁶

The district court, relying heavily on a regulation of the Copyright Office,⁷ an old district court decision later disapproved in its circuit,⁸ and the Universal Copyright Convention,⁹ which is inapplicable to Americans as to questions of American law, answered the question in the affirmative¹⁰ and denied a preliminary injunction.

On a subsequent motion for summary judgment, the district court held that, notwithstanding the plaintiff's legal arguments, there remained the factual issue of good faith so that the motion had to be denied. The issue of good faith was raised by the plaintiff's failure to disclose the prior publication in Japan in the application for American registration. The court indicated that if the plaintiff had not acted in good faith it would be denied the equitable relief it sought.¹¹

In *Lancer Books*, the court denied a temporary injunction to the plaintiff, the assignee of the rights of the authors of the recent best selling book, "Candy." The book had been previously published in France in 1958 in the English language. No *ad interim* protection had been perfected. The book was published in the United States, with proper notice, in 1964.

Although the opinion seems to turn on the *ad interim* provisions,¹² the court indicated one of the contentions of the plaintiffs as follows:

[P]laintiffs took the position that . . . the French edition of "Candy" which defendants copied was not in the public domain because it had never been published without notice of copyright in the United States. In other words, their contention is that a book in the English language by American authors which was published only in a foreign country is not in the public domain, within the meaning of the United States copyright laws, and at any time that the authors apply for registration of a United States copyright on that book as revised, they secure United States copyright protection for the entire book, not merely for the revisions.¹³

The court rejected this contention and noted that no authority was cited for this proposition.¹⁴

6. 233 F. Supp. at 262.

7. *Id.* at 262-63, quoting 37 C.F.R. § 202.2(a)(3) (1960).

8. 233 F. Supp. at 263, citing *Basevi v. Edward O'Toole Co.*, 26 F. Supp. 41 (S.D.N.Y. 1939).

9. 233 F. Supp. at 262-63, citing Universal Copyright Convention of 1952, 17 U.S.C. § 9 (1964).

10. 233 F. Supp. at 263.

11. 242 F. Supp. at 880.

12. 239 F. Supp. at 783. See 17 U.S.C. §§ 22, 23 (1964).

13. 239 F. Supp. at 785.

14. *Ibid.*

It is submitted that both decisions are wrong, both as a construction of the statute, and as a balance of the equities. It is further submitted that a proper reading of the United States law requires that actions in Japan, France, or in any other foreign place, have no effect as to the United States copyright law. While the work may be dedicated in a foreign country, deliberately, or inadvertently, or protected in a foreign country, only action within the territory of the United States can invest or divest American statutory protection.

It is beyond the scope of this inquiry to consider the relative merits of notice requirements, manufacturing provisions, the *ad interim* provisions, or what constitutes a general publication. Wherever necessary, general publications shall be assumed and the manufacturing provisions considered inapplicable or satisfied.

II. TWO ROUTES TO UNITED STATES COPYRIGHT

Section nine of the copyright law provides that authors or proprietors shall have copyright "for the terms specified" and "under the conditions" of the United States copyright law.¹⁵ This is the only route available to citizens of the United States.¹⁶ The section specifies three provisos operative if the author or proprietor is not a citizen of the United States.¹⁷

The first and second provisos merely expand the group entitled to the protection of the United States laws, they do not alter the terms or conditions of that protection. The first proviso includes aliens with citizens if the alien was a United States domiciliary at the time of the first publication of the work.¹⁸ The second proviso includes aliens with citizens if the alien is a citizen or subject of a "proclaimed country"—one which provides similar protection to the citizens of the United States.¹⁹

This, then, is the first route to United States protection—compliance with the provisions of the United States copyright law. It must be followed by American nationals, American alien domiciliaries, and nationals of proclaimed countries.

Judge Van Pelt Bryan recently granted a motion to dismiss. 251 F. Supp. 210 (S.D.N.Y. 1966). This is an anomalous result of the provision in the copyright law which disables a plaintiff from bringing a lawsuit for infringement until there has been a registration. 17 U.S.C. § 13 (1964). Here, *ad interim* registration was denied pursuant to 37 C.F.R. § 202.4(b) (1960), due to the fact that the book was banned during the relevant time periods. The Register's action is, however, being tested by *mandamus*.

15. 17 U.S.C. § 9 (1964).

16. *Ibid*.

17. 17 U.S.C. §§ 9(a), (b), (c) (1964).

18. 17 U.S.C. § 9(a) (1964).

19. 17 U.S.C. § 9(b) (1964).

The third proviso of section nine²⁰ was enacted in 1954, and, along with the Universal Copyright Convention, it became effective on September 16, 1955. The avowed purpose of this proviso was to amend the United States law to the extent necessary to implement the Convention which the United States had previously signed and ratified.²¹ While this subsection, in the historic tradition of the United States copyright law, has its murky aspects and presents certain difficulties of interpretation, certain of its provisions are clear.

It should first be emphasized that this third proviso, as with the first two, is only applicable to citizens or subjects of foreign states or nations.²² The proviso exempts works to which it applies from certain requirements of the United States copyright law, and substitutes, as conditions of the exemption, the specific formalities permitted by the Convention. The proviso is applicable to works of authors who are citizens or subjects of Convention member nations and who first publish anywhere outside of the United States; and to works of any non-domiciliary aliens first published in Convention member nations other than the United States. The Convention specifically denies preemption.²³ Thus, the proviso implements the Convention by providing national treatment, United States protection in the United States, for the works in question, conditioned only upon compliance with the formalities of the Convention.²⁴

What the Convention sought to provide was a uniform and simple method, an insured route, for obtaining protection throughout its member nations. The thrust of subsection nine (c), even with certain textual difficulties, is to allow certain non-resident aliens who comply with a stated universal formality to enjoy copyright protection in the United States notwithstanding non-compliance with certain requirements of American law.

This, then, is the second route to United States copyright protection—compliance with the special requirements of subsection nine (c). This does not supercede the first two provisos, rather it eliminates certain require-

20. 17 U.S.C. § 9(c) (1964). The Convention provided for its own effectiveness three months after deposit of twelve instruments of ratification, at least four of which had to be from non-Berne Union countries. Universal Copyright Convention, art. IX, § 1, Sept. 6, 1952, 17 U.S.C. § 9 (1964).

21. See generally Latman, *Howell's Copyright Law* 185-90 (rev. ed. 1962).

22. This gives rise to the textual difficulty of the reference to citizens of the United States found in the last paragraph of the subsection. See Nimmer, *Copyright* § 65.33, at 256-58 (1966).

23. Universal Copyright Convention, arts. XVIII, XIX, Sept. 6, 1952, 17 U.S.C. § 9 (1964).

24. 17 U.S.C. § 9(c) (1964).

ments of the first route and provides an alternative route for those who can invoke its aid.

Copyright Office Regulation section 202.2(a)(3) provides that "works first published abroad, other than works eligible for ad interim registration, must bear an adequate copyright notice at the time of their first publication in order to secure copyright under the law of the United States."²⁵

The Copyright Office view was that, prior to the enactment of the Convention amendments,²⁶ in accordance with the doctrine of *Heim v. Universal Pictures Co.*,²⁷ registration of works first published abroad without United States notice was of doubtful effect. The Office is of the view that by enacting the Convention amendments, Congress had expressed its intention that in all cases of first publication abroad, works must bear the United States notice if they are to enjoy United States protection.²⁸

It is submitted that the regulation is an improper construction of the statute generally, as will be discussed below, and that its reasoning is inapt. Congress was certainly not addressing this question.

The *Heim* doctrine was addressed to copyright protection through the first route. We have seen that the second route was enacted as an alternative, not as a replacement, and thus, to whatever degree it is correct, *Heim* should have continuing application to protection secured or sought through the first route. Thus, as a construction of subsection nine (c), the regulation is wholly inapposite to the scope of that subsection.

Having seen that there are two routes to United States copyright protection, the remainder of this article will be confined to the first, as the second is a specialized alternative which is only available to a limited group.

III. THE UNITED STATES COPYRIGHT STATUTE IN HISTORICAL PERSPECTIVE

The operation of the United States copyright statute, which transforms so-called common law property right protection into statutory protection, is centered around section ten of the copyright statute:

Any person entitled thereto by this title may secure copyright for his work by publication thereof with the notice of copyright required by this title; and such notice shall be affixed to each copy thereof published or offered for sale in the

25. 37 C.F.R. § 202.2(a)(3) (1960).

26. 68 Stat. 1030 (1954), 17 U.S.C. § 9 (1964).

27. 154 F.2d 480 (2d Cir. 1946).

28. See Cary, Proposed New Copyright Office Regulations, Copyright Soc'y 6 Bull. 213 (1959). Professor Cary is the Deputy Register of Copyrights.

United States by authority of the copyright proprietor, except in the case of books seeking ad interim protection under section 22 of this title.²⁹

This section has remained substantially unchanged since its original enactment as section nine of the revision of 1909,³⁰ the basic copyright statute.

The first clause of the section requires, in order to invest statutory protection, publication of the work with the requisite notice. The second clause of the section mandates that the notice be inscribed on all copies distributed in the United States. It is the view of this writer that what the Congress intended to require by the first clause was a publication *in the United States* with the requisite notice, and that the second clause is a codification of *United Dictionary Co. v. G. & C. Merriam Co.*³¹ This case had been decided by the Supreme Court just over one year before the enactment of the 1909 revision, and it was certainly considered by the draftsmen.

The first copyright statute, the Statute of Anne,³² was enacted by the British Parliament in 1710. Although there was later to be much discussion as to whether a right of literary property had previously existed at common law and whether such a right survived the statute,³³ Parliament decided, after a long struggle with the booksellers of London, that a limited statutory monopoly would be granted to authors.³⁴

Since its inception, the thrust of British copyright law has been to make the work product of authors available to the *British* public by encouraging the publication and dissemination of their works *in England* through provision for a profitable, though limited, author's monopoly.³⁵

Except for the effect of international agreements—Berne Union, Universal Convention, or individual bilateral treaties—England requires that the work be first published in England if it is to be protected.³⁶ Such a requirement reflects the Parliamentary purpose in enacting a copyright statute, the public good of having the products of authors readily available to the people of *England*.

Prior to the adoption of the Constitution, the Continental Congress adopted a resolution encouraging the several states to enact copyright

29. 17 U.S.C. § 10 (1964).

30. Act of March 4, 1909, ch. 320, § 9, 35 Stat. 1077.

31. 208 U.S. 260 (1908).

32. 8 Anne, c. 19 (1709).

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

34. See Morris, *The Origins of the Statute of Anne*, in ASCAP Copyright Law Symposium No. 12, at 222 (1963).

35. *Jefferys v. Boosey*, 4 H.L.C. 815, 10 Eng. Rep. 681 (1854).

36. Copyright Act, 1956, 4 & 5 Eliz. 2, c. 74, §§ 2(2)(a), 3(3)(a).

legislation.³⁷ Pursuant to this resolution, and with some prodding from Noah Webster,³⁸ twelve of the original thirteen states enacted copyright legislation.³⁹ The preamble of the first such statute, adopted by Connecticut, read: "Whereas it is perfectly agreeable to the principles of natural equity and justice, that every author should be secured in receiving the profits that may arise from the sale of his works, and such security may encourage men of learning and genius to publish their writings; which may do honor to their country, and service to mankind . . ." ⁴⁰ The authors of our earliest legislation had in view the same values to be derived from copyright protection—publication and availability to the public—as did their English cousins. But, publication where?

The union existing under the Articles of Confederation was that of thirteen sovereigns, and, in the days of the founding of our nation, economic necessity and technological change had not yet required the dilution of the sovereignty of individual states. State sovereignty was more jealously guarded than it is at present.⁴¹ It is, then, not surprising that five states specifically prescribed the monopoly to exist for a term commencing upon the first publication of the work in their own state.⁴² In addition, five statutes specifically provided remedies in the state courts if an insufficient number of copies were made available in the state, or if the price charged for copies within the state was unreasonable;⁴³ and one state required, as a condition of copyright, that copies of the work be deposited in a specified library within the state.⁴⁴ Thus, of the twelve states which enacted legislation, eight specifically required, as a condition of copyright, dissemination of the work within their own boundaries. The remaining four statutes did not specifically embody a different view, but were merely, like our present federal statute, silent on this point. In

37. 24 Journals, Continental Congress 326 (1783).

38. Subcommittee on Patents, Trademarks, and Copyrights of the Senate Committee on the Judiciary, 86th Cong., 2d Sess., Study No. 3 on Copyright Law Revision 69 n.22 (Comm. Print 1961).

39. These states were Connecticut, Georgia, Massachusetts, Maryland, New Jersey, New Hampshire, New York, North Carolina, Rhode Island, Pennsylvania, South Carolina and Virginia. U.S. Copyright Office, Bull. No. 3, Copyright Enactments 1-21 (rev. ed. 1963). This is a compilation of all United States copyright enactments revised through 1962.

40. *Id.* at 1.

41. See *M'Culloch v. Maryland*, 17 U.S. (4 Wheat.) 316 (1819).

42. Connecticut, Georgia, New Jersey, New York, and Pennsylvania had such provisions. U.S. Copyright Office, Bull. No. 3, Copyright Enactments at 2, 7, 10, 17, 19 (rev. ed. 1963).

43. Connecticut, Georgia, North Carolina, New York, and South Carolina were the states which provided such remedies. *Id.* at 2-3, 13, 16, 18, 20.

44. This state was Massachusetts. *Id.* at 4.

view of the position taken by the states which did speak to the point, it is likely that a local court in a mute state, if called on to construe publication, would have read it to require publication within the state in question. But, the adoption of the Constitution and the enactment shortly thereafter of the first federal copyright law rendered issues of state construction moot as to statutory or post-publication copyright.

The drafters of the Constitution included in the description of the powers of Congress contained in article I, the 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"⁴⁵

The Constitutional Convention adopted the view, established in England some eighty years before and then existing in twelve states, that the public good is to be served in making available the writings of authors, and that this good is best secured through the device of granting a limited monopoly to the proprietors of the works, thus encouraging them to publish. This is the understanding placed upon the constitutional purpose by the Supreme Court.^{45a}

This constitutional provision was implemented almost immediately by the enactment, at the second session of the first Congress of the United States, of the first copyright act.⁴⁶

The original copyright procedure gave any citizen or resident author the sole right of printing, reprinting, publishing and vending, for the term specified, if he complied with the following requirements: (1) deposit, before publication, of a printed copy of the title of the work in the office of the clerk of the district court where the author resided; (2) publication of the clerk's certificate for four weeks, within two months of deposit of title, in a newspaper printed in the United States; and, (3) delivery, within six months of publication, of a copy of the work to the Secretary of State.⁴⁷ Certainly these requirements do not, on their face, indicate that a publication outside of the United States was envisioned by the Congress. The amendment of 1802⁴⁸ added a fourth requirement—that the clerk's certificate be inserted in full on the title page or the page immediately following.⁴⁹ This was the beginning of the American copyright notice. A shorter form of notice was provided for maps and charts.⁵⁰

45. U.S. Const. art. I, § 8.

45a. *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

46. Act of May 31, 1790, ch. 15, 1 Stat. 124.

47. Act of May 31, 1790, ch. 15, §§ 3, 4, 1 Stat. 125.

48. Act of April 29, 1802, ch. 36, 2 Stat. 171.

49. Act of April 29, 1802, ch. 36, § 1, 2 Stat. 171.

50. *Ibid.*

That the purpose of Congress was to provide an incentive for authors to make their writings available within the United States is further born out by the first provision of the 1790 act. In granting one term of copyright to books previously published, the grant was restricted to authors of works already printed *within these United States*.⁵¹

Protection for non-resident aliens was specifically disavowed.⁵² This disavowal was intended to permit American entrepreneurs to import copies of foreign works, or to reprint them in America, thus furthering the public good of having the greatest possible number of works available to Americans.

In 1831, the newspaper publication requirement was abandoned and copies were to be deposited with the district courts for forwarding to the Secretary of State.⁵³ As of 1870, copies were to be deposited with the Librarian of Congress.⁵⁴ These were the formalities required prior to the revision of 1909. Failure to comply with any of the formalities was fatal to the copyright.⁵⁵

The purpose of copyright remained unchanged in the eyes of the 1909 draftsmen of the 1909 revision,⁵⁶ although the mechanics were to be somewhat altered. Chairman Currier of the House Committee on Patents, in the now famous Report No. 2222,⁵⁷ described the purpose of Congress quite clearly:

The enactment of copyright legislation by Congress under the terms of the Constitution is not based upon any natural right that the author has in his writings, for the Supreme Court has held that such rights as he has are purely statutory rights, but upon the ground that the welfare of the public will be served and progress of science and useful arts will be promoted by securing to authors for limited periods the exclusive rights to their writings. The Constitution does not establish copyrights, but provides that Congress shall have the power to grant such rights if it thinks best. Not primarily for the benefit of the author, but primarily for the benefit of the public, such rights are given. Not that any particular class of citizens, however worthy, may benefit, but because the policy is believed to be for the benefit of the great body of people, in that it will stimulate writing and invention, to give some bonus to authors and inventors.⁵⁸

It is submitted that if the monopoly granted could have been secured by compliance with the prepublication formalities and perfected by

51. Act of May 31, 1790, ch. 15, § 1, 1 Stat. 124.

52. Act of May 31, 1790, ch. 15, § 5, 1 Stat. 125.

53. Act of Feb. 3, 1831, ch. 16, § 4, 4 Stat. 437.

54. Rev. Stat. § 4956 (1875).

55. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

56. Act of March 4, 1909, ch. 320, 35 Stat. 1075.

57. H.R. Rep. No. 2222, 60th Cong., 2d Sess. (1909).

58. *Id.* at 7.

publication, observing notice formalities, in a foreign place, it would have thwarted the major purpose of the Constitution and the Congress, a purpose which had remained unchanged throughout our history. Wherever Congress used the word publication without specifying the place of publication, it was saying, albeit *sub silentio*, publication in the United States. This is especially the case in that, at this time, the economic situation, the state of international copyright relations and the nature of copyrightable work made it unlikely that a resident American author would publish his book in a foreign country.

The English statute requires a first publication in England. It can be argued that Congress, in refusing to require a first publication in the United States, was willing to leave the door open to a later investitive publication in the United States, but hardly that that first publication abroad would itself invest the protection in the United States.

In addition, if the first publication abroad were to invest copyright in the United States, each day which followed would shorten the term of protection here and thereby decrease the economic motivation which might stimulate a publication in the United States. This, again, would be in contravention of the avowed purpose of the Constitution and the Congress.

A further demonstration that by its use of the term publication Congress meant publication within the United States can be found in the amendments to the copyright law made in 1891.⁵⁹ It is in these amendments that we find the only specific reference to first publication abroad, a reference which lasted only eighteen years.

Section 4956 of the Revised Statutes, as originally enacted in 1873, was a codification of the prior requirements for securing copyright:

No person shall be entitled to a copyright unless he shall, before publication, deliver at the office of the Librarian of Congress . . . a printed copy of the title of the book or other article . . . nor unless he shall also, within ten days from the publication thereof, deliver at the office of the Librarian of Congress . . . two copies of such copyright book or other article . . .⁶⁰

In the 1880's pressure for some form of recognition and protection for foreign authors, and reciprocity for American authors in foreign lands, reached its peak. Congress reacted by passage of the Act of March 3, 1891.⁶¹ The purpose of this act can be found in its section thirteen, the precursor of the present section 9. Section 13 stated:

59. Act of March 3, 1891, ch. 565, 26 Stat. 1106.

60. Rev. Stat. § 4956 (1875).

61. Act of March 3, 1891, ch. 565, 26 Stat. 1106.

That this act shall only apply to a citizen or subject of a foreign state or nation when such foreign state or nation permits to citizens of the United States of America the benefit of copyright on substantially the same basis as its own citizens; or when such foreign state or nation is a party to an international agreement which provides for reciprocity in the granting of copyright, by the terms of which agreement the United States of America may, at its pleasure, become a party to such agreement. The existence of either of the conditions aforesaid shall be determined by the President of the United States by proclamation made from time to time as the purposes of this act may require.⁶²

Thus, the first route of protection was now made available to citizens of other countries.

Section three of this act amended section 4956 of the Revised Statutes to read:

No person shall be entitled to a copyright unless he shall, on or before the day of the publication in this or any foreign country, deliver at the office of the Librarian of Congress . . . a printed copy of the title of the book . . . nor unless he shall also, not later than the day of publication thereof in this or any foreign country, deliver at the office of the Librarian of Congress . . . two copies of such copyright book . . .⁶³

While it might be argued that this is a directive to American proprietors who might choose to publish abroad first, it is submitted that this was not the intention of Congress. Rather, provision was being made to make American copyright available on a reciprocal basis to foreign proprietors—individuals who would most likely first publish in their home countries. The probability of an American author first publishing abroad was still small and was probably not considered.

The most important observation, concerning the 1891 amendment, is that when Congress wished to provide requirements with respect to foreign publications, it did so specifically, and not by implication. The silence of the 1909 act with respect to foreign publications should, therefore, be viewed not as an oversight—a gap to be filled by the courts—but rather as a deliberate return to the pre-1891 requirement of publication within the United States.

Brief attention should also be given to section 8 of the present law, originally section 7 of the 1909 revision.⁶⁴ The portion of that section relevant to this discussion has remained virtually unchanged since its enactment:

[N]o copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country

62. Act of March 3, 1891, ch. 565, § 13, 26 Stat. 1110.

63. Act of March 3, 1891, ch. 565, § 3, 26 Stat. 1107.

64. Act of March 4, 1909, ch. 320, § 7, 35 Stat. 1077.

prior to the going into effect of this Act and has not been already copyrighted in the United States⁶⁵

Reading this section together with the prior law, section 4956 of the Revised Statutes, further indicates Congressional ability to refer to foreign publications specifically and to understand the consequences of the reference when made.

In sum, the first clause of section ten of the present law should be read to say publication in the United States. American copyright protection cannot be invested by anything less, since to permit foreign publication to invest American copyright must be in contravention of the constitutional mandate and the congressional purpose.

IV. CONSTRUCTION OF THE COPYRIGHT STATUTE

It is a general rule of statutory construction that statutes will be construed to confine their effects to the territorial confines of the jurisdiction of the enacting legislature. "All legislation is *prima facie* territorial."⁶⁶

The canon of construction which teaches that legislation of Congress, unless a contrary intent appears, is meant to apply only within the territorial jurisdiction of the United States . . . is a valid approach whereby unexpressed congressional intent may be ascertained. It is based on the assumption that Congress is primarily concerned with domestic conditions.⁶⁷

Thus, "the copyright laws of one country have no extraterritorial operation, unless otherwise provided."⁶⁸

Such construction reenforces our earlier explorations. Certainly the Congress by its silence could not be construed to inflict burdens upon actions taken without the jurisdiction of the United States. While Congress could require certain action to be taken without the United States, its purpose would have to be clear. Congress' function is generally to provide law regulating conduct within the United States.

So far it has been demonstrated that a proper construction of the act would preclude a foreign publication from investing copyright through the first route. But, if the foreign publication does not invest the copyright, does it, then, divest the American common law right? Does the foreign publication make it impossible ever to invest the American protection? General publication in the United States terminates the com-

65. *Ibid.* The committee report describes the purpose of this clause, "to make it clear that the original text of any work which has fallen into the public domain can not be copyrighted." H.R. Rep. No. 2222, 60th Cong., 2d Sess. 10 (1909).

66. *American Banana Co. v. United Fruit Co.*, 213 U.S. 347, 357 (1909).

67. *Foley Bros., Inc. v. Filardo*, 336 U.S. 281, 285 (1949). (Citation omitted.)

68. *American Code Co. v. Bensinger*, 282 Fed. 829, 833 (2d Cir. 1922).

mon law right so that, if statutory protection has not commenced, all rights are gone.⁶⁹ It is then said that the work is in the public domain. There are three possible views of the effect of a general foreign publication upon the American common law right. The first, and the harshest, is that if the foreign publication does not comply with American statutory formalities, it will constitute a dedication for the purpose of American law. Such a view assumes, of course, that the foreign publication could have been investitive. This is the view taken by the district court in *Ross Prods.*

A middle view is that no divestiture will occur if the publication does not serve to dedicate the work in the country of publication. This view, the one taken by the court in *Heim*, also assumes that the foreign publication is investitive, but does not require it to comply with American formalities.

The third view, the view of this writer, is that the foreign publication is totally inoperative—it neither invests statutory protection nor divests common law rights.

It has already been shown that section 8 of the present statute⁷⁰ indicates that American statutory protection cannot be had for a work in the public domain. The three views stated above can therefore be reduced to the question, which publication will place the work in the public domain, foreign publication which does not satisfy American formalities, foreign publication which does not satisfy formalities of the locus of publication, or neither?

Each and every definition of the public domain, or its Latin forbear, the *publici juris*, can be reduced to one simple phrase—the common property of the entire state.⁷¹ The word “public,” used as an adjective, is always defined and restricted by sovereignties.⁷² Section 8, then, when referring to the public domain was referring to the common property of all the citizens of the United States.

It is quite clear that a work can be in the public domain in one country and protected by copyright in another. This was true of all foreign works in the United States until 1891. It is probably true of works of Americans today which may be protected in the United States although unprotected in other countries of the world, the U.S.S.R. for example. Also, the term of copyright protection varies from place to place.

69. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834).

70. 17 U.S.C. § 8 (1964).

71. See Black, *Law Dictionary* 571 (4th ed. 1951); Webster, *New International Dictionary* 1836 (3d ed. 1961).

72. *Ibid.*

That the public domain is a territorial concept seems to be the view of the Supreme Court of the United States. In *Ferris v. Frohman*,⁷³ the court recognized one individual to be the owner of the English common law rights and another to be the owner of American common law rights, indicating that they are, indeed, separate packages. Thus, a general publication of a work in a foreign country should have no effect upon the American common law right. The only act which will divest the American common law right is the general publication of the work in America to the American people—what the courts euphemistically refer to as a dedication. It is at that point that statutory copyright must be invested if protection is to remain.

V. THE CASE LAW UNDER THE COPYRIGHT STATUTES

The search for authorities is not generously rewarded. As can be understood readily, the physical distance between the United States and Europe made this issue unimportant until the late nineteenth century. Today, in view of the closeness of the entire world, the question of the effect of foreign actions has become of increasing significance.

The economic proximity of England and the continent of Europe, however, has been great for many centuries, and it is in the English reporters that the first case law is found. The English Statute of Anne, the model for a great part of the original American statute, initially provided that protection would commence upon publication, and it required formalities much the same as did the later American statute—deposit of title, copies, and the like. In the initial statute, the word publication was not expressly modified to mean British publication as it is today.

Early in the nineteenth century the question arose whether a French author had secured British protection by a publication in France. In *Clementi v. Walker*,⁷⁴ the British court had this to say:

[T]he *British* Legislature must be supposed to have legislated with a view to *British* interests and the advancement of *British* learning. . . . Without very clear words, therefore, to shew an intention to extend the privilege to foreign publications, I should think it must be confined to books printed in this kingdom, and instead of there being any such clear words to shew that intention, there are provisions which strongly imply the latter. The provisions directing that the authors of books *generally* shall have the sole right of printing and reprinting, and that before publication the title shall be entered, and copies delivered at *Stationers' Hall*, evidently contemplate a *British*, not a foreign publication.⁷⁵

73. 223 U.S. 424 (1912).

74. 2 B. & C. 861, 107 Eng. Rep. 601 (K.B. 1824).

75. *Id.* at 867-68, 107 Eng. Rep. at 604. (Emphasis added.)

Shortly thereafter, in *Chappell v. Purday*,⁷⁶ another British court held that a foreigner had no common law rights since they could not arise until there had been some connection with England.

The result of these cases was that a first publication abroad by a foreigner would be fatal for English protection since it did not invest British copyright and the work could be published in England with impunity. The foreign author had no common law rights on which to base his complaints. Since anyone could import the foreign print of the work, the courts held that no one could have a copyright in it.

The question of the common law copyrights of foreigners reached the English House of Lords in 1854.⁷⁷ The issue was somewhat muddled by the assignment of the copyright of the author, an Italian, to an Italian publisher, who then assigned the British rights to an English party. The case was referred to the judges of the law courts who rendered advisory opinions to the Lords. A majority of the judges felt that the assignee who first published in England had a good copyright in the work. There had been no prior publication anywhere else.

The House of Lords, following the *Clementi* and *Chappell* cases, adopted the position of the minority of the judges. The Lords held that the second assignee could not have anything more than the original assignor had to assign. The Italian author had never gone to England or done anything else which might have satisfied the Lords. Since the Italian author had no English common law rights, he could assign none. Accordingly, there were no rights to be invested by publication of the work in England. Once the work became generally available in England, anyone could print it.

In dictum there was unanimous agreement that, had there been a prior publication in Italy, there could not have been an English copyright. All the judges cited *Chappell*, which held that foreigners do not have common law rights.

The result of these early British cases was that the word publication did indeed mean *publication in England*. This lends added support to the argument that the word publication in American copyright statutes since 1783 has meant publication within the United States. In addition, the divestitive effect of a first foreign publication was considered for the first time. The basis for this dictum was the refusal of the courts, at that time, to recognize that a foreigner could have common law rights and protection in England unless he came into England and became personally subject to her laws.

76. 14 M. & W. 303, 153 Eng. Rep. 491 (Ex. 1845).

77. *Jefferys v. Boosey*, 4 H.L.C. 815, 10 Eng. Rep. 681 (1854).

There was, however, much dissent to this theory. Many felt that a friendly alien should be able to resort to the courts of a country and protect his rights whether he was in the country before or afterward. There was, of course, little authority at that time for either proposition. But a majority of the judges adhered to this latter view, and they referred to libel cases to support their view.

The first American court to deal with the effect of a first foreign publication was the New York Court of Appeals. The plaintiff, in *Palmer v. De Witt*,⁷⁸ was the assignee of the American rights in a British play. The play, which had never been printed, had been performed both in England and in New York, and the defendant was printing it in New York. The court held for the plaintiff, saying that the performance of the play in New York was not a general publication and that the performance of the play in England, although a publication there, did not divest the American common law right.⁷⁹ The court assumed that there was such a thing as an American common law right which could be segregated from the English right, thus supporting the view that the common law and the public domain are territorial concepts.

The case has been cited for the proposition that had there been something in England that would constitute a general publication under American law, then the American rights would have been lost. This issue was not, however, before the court. What is usually cited is a dictum by Judge Allen to the effect that a publication in England *may* result in the loss of American common law rights. For this proposition, Judge Allen cited the House of Lords opinion in *Jefferys v. Boosey*,^{79a} pointing out that that case was decided against the opinion of six of the ten judges of the law courts and indicating that the case might not be the law in England at all.⁸⁰ The court, thus, went out of its way to question the only authority on point.

In the later case of *Carte v. Duff*,⁸¹ there had been an attempt to secure some form of American protection by Gilbert and Sullivan. They engaged an American to come to London and make a piano score of the unpublished complete score of the Mikado. The American's piano score was then registered in Washington and the libretto, vocal score, and American piano score were then published in England. The defendant purchased the available material in England and hired his own orchestrator to make

78. 47 N.Y. 532 (1872).

79. *Id.* at 542-43.

79a. 4 H.L.C. 815, 10 Eng. Rep. 681 (1854).

80. *Id.* at 540-41.

81. 25 Fed. 183 (C.C.S.D.N.Y. 1885).

a full score of the operetta. The defendant then produced the operetta in the United States. The plaintiff was the assignee of the American presentation rights from Gilbert and Sullivan and of the registered American piano score.

The court decided the case on a very narrow issue and found for the defendant. At this time, there were no performance rights in music, only in dramatic works.⁸² The court felt that the piano score itself was not a dramatic work and, whether or not the copyright was valid, there had not been any infringement.

While it is much to be regretted that our statutes do not, like the English statutes, protect the author or proprietor in all the uses to which literary property may be legitimately applied, it is not the judicial function to supply the defect. In view of these conclusions, it is not necessary to consider whether a valid statutory copyright for the piano-forte arrangement . . . has been obtained, or whether there was a non-compliance in any particulars with the statutory requisites. These questions may be more properly reserved until an attempt is made to infringe the copyright by an unauthorized multiplication of copies.⁸³

Despite its narrow holding, the court made rather broad pronouncements in an unsupported dictum earlier in the opinion, and it is for these pronouncements that the case is now cited.

Common-law rights of authors run only to the time of the publication of their manuscripts with their consent. . . . It is immaterial whether the publication be made in one country or another. Such rights of authors as are saved by statute are not recognized extraterritorially. They can only be enforced in the sovereignty of their origin.⁸⁴

No authority was cited for these propositions and the court did not discuss the possibility of infringement of the common law right which might still have existed in the remainder of the operetta which had not been included in the piano score.

As performing rights in music were not recognized, the court's narrow holding was correct under the then existing law. In addition, plaintiff apparently did not allege infringement of his common law rights. This is no basis, however, for holding that rights in the United States were lost by extraterritorial publication.

In passing, a word should be said about *McLoughlin v. Raphael Tuck Co.*⁸⁵ There, the issue before the court was the criminality, in the United States, of affixing a fraudulent American notice to copies manufactured

82. Music performance rights were first recognized by the Act of January 6, 1897, 29 Stat. 481.

83. 25 Fed. at 187.

84. *Id.* at 184.

85. 191 U.S. 267 (1903).

abroad for import into the United States. The relevant section of the law⁸⁶ provided a penalty for false notices. Prior to 1897, the penalty was for impressing the false notice, without indication of where the false notice was impressed. After 1897, a penal provision was provided for the importation of copies with false notices.⁸⁷ This case arose prior to 1897 and the false notices were impressed in Europe. The Court found for the defendant and stated that "penal provisions of the law had no extra-territorial operation, and therefore did not embrace the act of affixing in a foreign country to a publication a false statement that it was copyrighted under the laws of the United States."⁸⁸

While the analogy between criminal sanctions and copyright protection is somewhat remote, there is some validity in urging that this holding is merely another demonstration of the understanding of territoriality in our law, both as to duties, sanctions and rights.

*United Dictionary Co. v. G. & C. Merriam Co.*⁸⁹ is the only decision by our highest court that deals with an aspect of the notice provision on a foreign publication. There had been a publication with notice in the United States and an authorized later publication of the same work in England, without the American notice. The Court held that the subsequent publication abroad, without notice, did not forfeit the American copyright.

While the case is not directly on point, the language of Justice Holmes is relevant as a view of the problem.

Of course, Congress could attach what conditions it saw fit to its grant, but it is unlikely that it would make requirements of personal action beyond the sphere of its control. Especially is it unlikely that it would require a warning to the public against the infraction of a law beyond the jurisdiction where that law was in force. The reasons for doing so have not grown less, yet in the late statute giving copyright for foreign publications the notice is necessary only in "all copies of such books sold or distributed in the United States." . . . So it is decided that the section punishing a false notice, which naturally would be coextensive with the requirement of notice, did not extend to false statements affixed abroad. *McLoughlin v. Raphael Tuck Co.* . . . The same conclusion would follow from the form prescribed for the notice, which would be inapt in foreign lands.⁹⁰

Holmes concluded that the Court was "satisfied that the statute does not require notice of the American copyright on books published abroad and sold only for use there . . ."⁹¹

86. Act of March 3, 1891, ch. 565, § 6, 26 Stat. 1109.

87. Act of March 3, 1897, ch. 392, § 1, 29 Stat. 694.

88. 191 U.S. at 270.

89. 208 U.S. 260 (1908).

90. *Id.* at 264. (Citation omitted.)

91. *Id.* at 266.

Holmes was dealing with a slightly different question, yet his remarks, are relevant on a much broader scale. Applied to the question of foreign investitive publication, his reasoning would dictate that publication in the United States was intended. In addressing the question of divestitive foreign publications, he found that notice provisions were for the protection of Americans. The presence or absence of a notice in a foreign publication should be a matter of indifference, in the absence of a specific Congressional directive.

*Ferris v. Frohman*⁹² is generally considered the leading case supporting the proposition that foreign publications without notice are divestitive of American common law rights. Once again, however, the case is, at best, somewhat ambiguous and can as easily be read for the opposite proposition. The issue was the validity of an American registration of a play which had been performed in England prior to publication and registration in the United States. The Supreme Court held it valid, although it recognized that the performance of a play is a publication under British law and would put the play in the public domain there if statutory protection did not invest. The Court held that the play was not in the public domain in the United States, regardless of its status in England. In dealing with the question of what is publication, the Court said that the "present case is not one in which the owner of a play has printed and published it and thus, having lost his rights at common law, must depend upon statutory copyright in this country."⁹³ While this is the language usually cited for the divestitive effect of foreign publications, it is certainly not unambiguous. Was the Court thinking about foreign publications, or was it merely talking to a definition of publication? One cannot be certain. The most telling point in the opinion is the Court's tacit recognition of the territoriality of the common law. The Court is not troubled by the possibility of the work being dedicated in one nation and protected in another. The Court recognizes this as a fact of territoriality and governs its opinion accordingly. Thus, if anything is to be learned from *Frohman*, it is the territoriality of the common law, and the result of such territoriality is that dedication can only occur on a country-by-country basis.

The plaintiff in *Universal Film Mfg. Co. v. Copperman*⁹⁴ was the assignee of the rights of a Danish film corporation to a Danish silent movie. The Danish company had sold prints of the film throughout Europe with

92. 223 U.S. 424 (1912).

93. *Id.* at 434.

94. 212 Fed. 301 (S.D.N.Y.), *aff'd*, 218 Fed. 577 (2d Cir.), *cert. denied*, 235 U.S. 704 (1914).

a proviso in each contract of sale to the effect that the film was not to be used outside the country of sale. Defendant purchased one of the films from a European vendee of the Danish film company in Europe, without knowledge of any restrictions, and showed it in the United States. Judge Hough, in the district court, held flatly that the publication of the film in Europe prior to investment of copyright in the United States required a ruling for the defendant. "Because . . . there was a publication in Europe before registration in the United States, this bill must be dismissed."⁹⁵ It is this proposition in the district court opinion which makes its way into later cases. The Second Circuit affirmed, but on a different theory. The appellate court reasoned that the copyright was valid. The restrictions put on the individual vendees were ineffectual and the licenses granted to purchasers by the Danish company were entirely consistent with the American copyright. The defendant was licensed to perform the copyrighted picture in the United States and the plaintiff's copyright could not be used to repudiate the defendants' prior license.

Although Judge Hough had been clear that the *showing* of the films on a wide scale basis in Europe had divested common law rights there, even as to this the Second Circuit disagreed. "The Nordisk Company abandoned its common-law property in the United States *when it took out the statutory copyright*."⁹⁶

In any event, the case does not stand for divestiture, rather, although not clearly articulated in the circuit court opinion, it indicates, again, the territoriality of copyright in that an American right could be and could support a statutory registration.

The Second Circuit's opinion in *Copperman* made a strong impression upon Judge Hough, for when faced with another instance of foreign publication, his views had changed. In *Italian Book Co. v. Cardilli*⁹⁷ an Italian song had been published in Italy in 1913 without any American copyright notice. The plaintiff was the assignee of the American rights in the song and he published the work with notice in the United States in 1918. Without citing *Copperman*, Judge Hough, considering the case one of first impression, held that the prior Italian publication did not prevent American copyright. The court was silent as to the commencement of the term of copyright although there is a reference to the application for registration indicating 1913 as the year of first publication.⁹⁸

95. 212 Fed. at 304.

96. 218 Fed. at 580. (Emphasis added.)

97. 273 Fed. 619 (S.D.N.Y. 1918).

98. *Ibid.*

The whole line of cases, holding that publication without copyrighting destroys the right to a subsequent copyright, are either founded on statutes differing from the present one, or on a proven publication in the country of the court rendering the decision. It seems to me as a matter of first impression that the publication in Italy was, by the terms of the notice printed or stamped on each copy sold, limited to Italy, and did not (in the absence of statutory prohibition) prevent the subsequent American copyright, if (as is the case here) there had been no publication in the United States prior to that of the copyright owner.⁹⁹

This language leaves room for some discussion. If Judge Hough, in discussing prior cases, was referring to prior American statutes, as he probably was, this further indicates that Congress specifically provided for foreign publications where it saw fit to do so. In addition, although there was no clear explanation of the Italian notice which restricted the publication to Italy, it has been our thesis that such a publication should be territorially restricted in this manner.

This case was decided upon uncertain ground. Yet, Judge Hough resolved the doubt so as to avoid causing a forfeiture and thereby benefiting a pirate. Certainly, this is the way to tip the scale.

In a later case, both the plaintiff and defendant were pirates. Plaintiff had copied, with certain minor editing, an older, previously published, English code book. Defendant copied plaintiff's edition and claimed that plaintiff had nothing to copyright. The sole issue in the case, *American Code Co. v. Bensinger*,¹⁰⁰ was whether the whole or any part of the plaintiff's edition was copyrightable. The Second Circuit, with Judge Hough sitting as a member of the panel, affirmed a temporary injunction and remanded the case for trial.

Once again, the language most often cited from the opinion is dictum, and ambiguous dictum at that.

If a British author, upon publication in England, copyrights his book in that country, the copyright protects him in that country; but, unless he has also copyrighted the work in the United States, his English copyright affords him no protection against anyone who brings out in this country a piratical edition of the work. The copyright laws of one country have no extraterritorial operation, unless otherwise provided. *Ferris v. Frohman* . . .¹⁰¹

The court was not referring to a possible claim of infringement of common law rights in the United States and its language is quite loose. It is hard to believe that Judge Hough would concur in such an opinion, only four years after his decision in *Cardilli*, if that issue had been squarely presented. In any event, the language is dictum, reinforcing

99. *Id.* at 620.

100. 282 Fed. 829 (2d Cir. 1922).

101. *Id.* at 833.

a territorial understanding of copyright protection, and pointing itself to a question of divestiture, not toward investiture.

There was a seventeen year hiatus before these questions were considered again. Then, in *Basevi v. Edward O'Toole Co.*,¹⁰² it was held, for the first time, that a first foreign publication, without American notice, was fatal to American rights. The language of Judge Woolsey is unmistakable. "[T]he publication of a book . . . in a foreign country, without notice of United States copyright thereon, will prevent the owner of the book from subsequently securing a valid copyright thereof in the United States."¹⁰³

Judge Woolsey cited the district court opinion in *Copperman, American Code, The Mikado Case*, and, with a "c.f.," *Frohman*. As has been pointed out above, these cases can hardly be said to be authority for this broad proposition. His discussion of *Cardilli* is interesting.

The case of *Italian Book Co. v. Cardilli* . . . cited by the plaintiff's counsel, must, I think, be regarded as having been overruled by the Circuit Court of Appeals in the *Bensinger Case* to which I have just referred. Furthermore, I find by looking up the *Cardilli Case* in *Shepard's Citations* that it has never been cited or followed in any reported case. I think, therefore, that it cannot any longer be regarded as an authority. It is a satisfaction to me to reach this conclusion, as, in view of our law, I have not been able to understand the rationale of Judge Hough's decision in that case.¹⁰⁴

Considering the fact that the issue had not been specifically raised since the *Cardilli* case, it is not surprising that Judge Hough had not been cited. A look at today's citator shows that neither Judge Hough nor Judge Woolsey is cited again until *Heim* in 1946. Both opinions are then cited again for the first time, on this point, in *Ross Products*, in 1964.

Little more than general disagreement with Judge Woolsey can be voiced, except to point out that his cases are not really authorities for his proposition. In any event, the Second Circuit has refused to follow his lead.

*Heim v. Universal Pictures Co.*¹⁰⁵ is the first case to state that a foreign publication, without American notice, will *invest* American copyright, so long as the publication does not divest copyright at the place of publication. Judge Frank's construction is a new view of copyright. All prior cases had, with the exception of *Basevi*, shied away from permitting a foreign publication to divest American protection, or had specifically

102. 26 F. Supp. 41 (S.D.N.Y. 1939).

103. Id. at 46.

104. Ibid. (Citation omitted.)

105. 154 F.2d 480 (2d Cir. 1946).

held that they did not divest protection. No one before had suggested that a foreign publication without an American notice would invest the statutory protection in the United States.

We construe the statute, as to a publication in a foreign country by a foreign author (i.e., as to a publication described in the 1914 amendment), not to require, as a condition of obtaining or maintaining a valid American copyright, that any notice be affixed to any copies whatever published in such foreign country, regardless of whether publication first occurred in that country or here, or whether it occurred before or after registration here.¹⁰⁶

It is submitted that Judge Frank has turned section ten inside out. The discussion above has shown that the proviso limiting the requirement of the notice to works published in the United States was probably a codification of the *United Dictionary* case. The thrust of that case was that once copyright had been secured by publication with notice in the United States, a publication abroad which did not bear the notice would not divest the American protection. To reason that notice is absolutely waived for an investitive foreign publication is wholly at odds with the first clause of section ten which provides that copyright will be secured by a publication *with* notice. Also, as has been argued before, to permit a foreign publication to invest protection is to thwart the purpose of the Constitution and of Congress.

Whether Judge Frank would be followed by another circuit, the Supreme Court, or even the Second Circuit today, is not known. Even Judge Clark, in concurring, expressed dismay at Judge Frank's views.¹⁰⁷ Nonetheless, *Heim* is in the books and must be considered in discussing this area.

The decision is certainly liberal in its view of forfeiture. Perhaps this flows from Judge Hough's opinion in *Cardilli*. But, it is submitted that *Heim* is wrong in its understanding of the basic purpose of copyright in the United States and that it should not be followed.¹⁰⁸

Apparently Justice McNally, sitting in the New York Supreme Court, was not impressed with the *Heim* decision. In a terse opinion which barely states the facts of the case, *Hill & Range Songs, Inc. v. London Records, Inc.*,¹⁰⁹ he said that "whatever common-law rights the plaintiff might have had prior thereto terminated with the publication of the music and lyric, although the publication thereof occurred abroad."¹¹⁰

106. Id. at 486. (Footnote omitted.)

107. Id. at 488.

108. The case has, however, been cited with apparent although questioning approval in *Mills Music, Inc. v. Cromwell Music, Inc.*, 126 F. Supp. 54, 75 (S.D.N.Y. 1954).

109. 142 N.Y.S.2d 311 (Sup. Ct. 1955).

110. Id. at 312.

Justice McNally, although a kindred spirit of Judge Woolsey, does not cite him. Neither does he cite Judge Frank nor Judge Hough. His authorities for this proposition are *Frohman*, which is hardly an authority for this proposition, three cases¹¹¹ which did not involve foreign publications but held that a general publication here will divest common law rights (a proposition which is not questioned), and *O'Neill v. General Film Co.*,¹¹² which held that the filing of copies of a play in England with the Lord Chamberlain, a requisite to obtaining a license to perform the play, and the performance of the play, did not divest American common law rights. The New York appellate division had indicated, by way of dictum in *O'Neill*, that American protection might be divested through acts in England. For this proposition the appellate division cited *Frohman* and *Palmer v. De Witt*.

Curiously, in *Hill & Range Songs, Inc.*, Justice McNally did not cite his strongest authority, *Basevi*, and did not make any attempt to distinguish *Heim*. At best his decision fails to discuss all the authorities and is the decision of a state court not often concerned with copyright questions.

One more district court opinion, *Rolland v. Henry Holt & Co.*,¹¹³ produced dictum to the effect that foreign publications can be divestitive. Here, no issue of copyright infringement was raised, but rather, some form of action founded on an implied contract was alleged.

In any event, the court's dictum does not give any weight to *Heim*. "Publication unprotected by United States copyright releases a work for copying; it is then dedicated to the public and the author's common law rights no longer protect the work against duplication."¹¹⁴ So far, so good. But then, Judge Walsh went on to state that "in this respect publication abroad has the same effect as publication here."¹¹⁵

He cited *American Code*, *Copperman*, *The Mikado Case*, *Basevi* and *Palmer v. De Witt*. With each succeeding case the dicta are compounded and broader and more authoritative language is produced.

A recent decision of the Second Circuit, *Beechwood Music Corp. v. Vee Jay Records, Inc.*,¹¹⁶ is also worthy of some attention. The plaintiff

111. *Société Des Films Menchen v. Vitagraph Co. of America*, 251 Fed. 258 (2d Cir. 1918); *Photo-Drama Motion Picture Co. v. Social Uplift Film Corp.*, 220 Fed. 448 (2d Cir. 1915); *Jewelers' Mercantile Agency v. Jewelers' Weekly Pub. Co.*, 155 N.Y. 241, 49 N.E. 872 (1898).

112. 171 App. Div. 854, 157 N.Y. Supp. 1028 (1st Dep't 1916).

113. 152 F. Supp. 167 (S.D.N.Y. 1957).

114. *Id.* at 168.

115. *Ibid.*

116. 328 F.2d 728 (2d Cir. 1964).

had licensed others to record certain music in England, the music being previously registered in the United States. The defendant made recordings of the music in the United States and the plaintiff sued for infringement. Defendant urged that the compulsory license provisions¹¹⁷ applied although the licensed recording was made in England. The court, stating that "rules of United States statutory law . . . apply only to conduct occurring within, or having effects within, the territory of the United States, unless the contrary is clearly indicated by the statute,"¹¹⁸ rejected this argument.

It seems that the importation of English recordings into the United States would have the same effect within the United States as the importation of English published books or Italian works of art or whatever. The court said, "although *Ferris v. Frohman* . . . dealt with a different claim of extraterritorial application of the Copyright Act, it points strongly against defendants' view."¹¹⁹ Has not the Second Circuit read *Frohman* as has been suggested above?

No mention is made of the issue of whether the production or wide dissemination of phonograph recordings is a publication under United States law,¹²⁰ since the composition had already been registered in the United States. The indication seems to be that if the Second Circuit were to again construe foreign publication, the same reasoning would be applied in the case of extraterritorial publications by printing as had been applied when the court was considering the effect of extraterritorial licensing.

VI. CONCLUSION

It is submitted that foreign publications cannot invest United States protection. To this extent the *Heim* case is incorrect and the Copyright Office regulation, by implication, is also wrong. In addition, it is also submitted that foreign publications cannot divest American common law rights as they are territorial. This is based upon *Frohman* and *Beechwood Music*. The *Basevi* case is wrong.

No matter what has happened outside the United States, therefore, a general publication in the United States will either invest statutory protection or divest the American common law property right. The proper approach in the current *Ross Products* case would be to disregard publica-

117. 17 U.S.C. § 1(e) (1964).

118. 328 F.2d at 729.

119. *Ibid.* (Citation omitted).

120. See *Nom Music, Inc. v. Kaslin*, 227 F. Supp. 922, 926 (S.D.N.Y. 1964), *aff'd*, 343 F.2d 198 (2d Cir. 1965); *Shapiro, Bernstein & Co. v. Miracle Record Co.*, 91 F. Supp. 473, 475 (N.D. Ill. 1950).

tion outside the United States. If the court then finds a general publication in the United States which satisfied the formalities of the United States statute, American protection for the statutory term commencing with that publication would have invested.

The copyright revision bill considered in the Eighty-ninth Congress¹²¹ provided that notice must be affixed to all copies distributed anywhere.¹²² If a similar bill is ultimately enacted, Congress will have made specific provision. Since the term of copyright would also be altered to the life of the author plus fifty years,¹²³ and since the forfeiture possibilities are well seasoned with safety factors,¹²⁴ these issues will become less important. The term of copyright would no longer be computed as fixed, starting with the date of publication, and the grant of Congress would, thus, not be watered down by commencing protection with a first publication abroad. The unavailability of counsel in foreign parts would also be less significant as the notice requirements would no longer be strictly enforced so as to produce forfeitures.

As Justice Holmes said, "Congress could attach what conditions it saw fit to its grant . . ." ¹²⁵ It is certainly better to have specific rules than wide grey areas. It remains to be seen, however, whether such proposals will ever be enacted into law.

121. S. 1006, 89th Cong., 1st Sess. (1965).

122. S. 1006, 89th Cong., 1st Sess. § 401(a) (1965).

123. S. 1006, 89th Cong., 1st Sess. § 302(a) (1965).

124. S. 1006, 89th Cong., 1st Sess. § 404(a) (1965).

125. *United Dictionary Co. v. G. & C. Merriam Co.*, 208 U.S. 260, 264 (1908).