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# RENEWAL RIGHTS IN COPYRIGHT

SIDNEY J. BROWN

*"... it continues to be the ingratitude of mankind, that they who teach wisdom by the surest means, shall generally live poor and unregarded, as if they were born only for the public, and had no interest in their own well-being, but were to be lighted up like tapers, and waste themselves for the benefit of others."*—DRYDEN.

## I. INTRODUCTION

The duration of copyright has long perplexed our legal masters. In an attempt to compromise the claims of the authors, booksellers, and the public,<sup>1</sup> our legislators finally devised a twenty-eight year term for the legal owner and an additional term of twenty-eight years for the author or his family in an order enumerated in the statute.<sup>2</sup>

It is with the latter period and its beneficiaries that this paper will concern itself. Its evolution will shed much light on a subject which has been made confusing because of a faulty evaluation of early cases and predecessor statutes.

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<sup>1</sup>For an excellent and short historical review of the struggles of early English Parliament with the copyright terms and the various proposals before the House of Commons seeking to protect the author, see LOWNDES, *HISTORICAL SKETCH OF THE LAW OF COPYRIGHT* (1840).

<sup>2</sup>Copyright Act of 1909, 35 STAT. 1080 (1909), 17 U. S. C. § 23 (1940). It will be profitable at this point to set out Section 23 of the Act in full since it will be referred to continuously throughout the article.

§ 23. **Duration; renewal and extension.** The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided*, That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright; *And provided further*, That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further*, That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

## II. HISTORICAL

The two term copyright originated with the Statute of Anne<sup>3</sup> which limited the term of copyright to fourteen years, and provided that after the expiration of this term the "sole right of printing or disposing of copies shall return to the authors thereof, if they are then living, for another term of 14 years."<sup>4</sup> This statute formed the basis for the colonial copyright acts<sup>5</sup> out of which developed the term adopted by the first Congress in 1790.<sup>6</sup> The Copyright Act of 1790 departed in only one essential particular from the Statute of Anne in that it gave the second term to the "author, or authors . . . or their executors, administrators, or assigns. . . ." <sup>7</sup> Except for the addition of the author's family and the extension of the terms of both the original<sup>8</sup> and the renewal<sup>9</sup> rights, the law and theory as to renewal rights have remained the same.

The English statutes, on the contrary, have shown marked changes. The Statute of 54 Geo. III in 1814 increased the first term to twenty-eight years and substituted a renewal term which was to endure for the life of the author, provided he was alive at the expiration of the first term.

In 1842 the renewal period was abolished and a term of life plus seven years of forty-two years straight, whichever was longer, was adopted.<sup>10</sup>

The present English statute, passed in 1911, granted a term of life plus fifty years, the last twenty-five years of which are specifically made unassignable during the life of the author.<sup>11</sup>

<sup>3</sup>8 ANNE, c. 19 (1710).

<sup>4</sup>The case of *Donaldson v. Beckett*, 4 Burr. 2408, 1 Eng. Rep. R. 837 (K. B. 1774) finally settled the dispute as to the existence of a perpetual copyright against such perpetual right.

<sup>5</sup>In 1783 the Colonial Congress passed a resolution recommending to the several states that they secure to the authors and publishers, their executors, administrators, and assigns the copyright of books for a term of fourteen years and a second term of fourteen years if they survive the first. Pursuant to this resolution, twelve of the thirteen states passed copyright statutes. Of these, seven contained a fourteen year term with a renewal term of fourteen years. Five of the states created straight terms, the shortest being fourteen years and the longest twenty-one. SOLBERG, *COPYRIGHT ENACTMENTS* (1906).

<sup>6</sup>1 STAT. 124 (1790).

<sup>7</sup>*Id.* § 1.

<sup>8</sup>The Copyright Act of 1831, 4 STAT. 436 (1831), increased the first term to twenty-eight years and saved the second term for the widow or children of the author in case the author should not be living at the expiration of the first term.

<sup>9</sup>The 1909 Act added fourteen years to the renewal term and extended the right to renew to the executor and to the next of kin. That Act also permitted renewal by proprietors of works specifically enumerated therein. See note 2 *supra*.

<sup>10</sup>5 & 6 VICT., c. 45 (1842). For an interesting discussion of the developments leading up to the passage of this Act and the struggle of Sergeant Talfourd on behalf of the authors to retain an inalienable renewal term which he had introduced in his "Bill," see LOWNDES, *HISTORICAL SKETCH OF COPYRIGHT* (1840) 84 *et seq.*

<sup>11</sup>Copyright Act, 1911, 1 & 2 GEO. V, c. 46, § 5 (2) provides:

The Canadian statute is more like the American Copyright Act except that the renewal term is limited to fourteen years and to the author's widow and children, if the author be not living. A second registration is required to be made within one year *after* the expiration of the first term.<sup>12</sup>

### III. RIGHTS OF THE ASSIGNEE

In reviewing the cases interpreting these statutes and determining the proper application of the present statute, it is of the utmost importance to carefully examine the particular statute giving rise to the claim, the character of the claimant, the basis of the claim, and the nature and extent of the interest claimed.

The alienability of the renewal term and the effect of attempted alienation on the author and the others enumerated in the Copyright Act has been the subject of much controversy.<sup>13</sup>

The intent to protect the author, encourage learning, and thereby promote science and industry, is sufficiently indicated in the famous case of *Donaldson v. Beckett*<sup>14</sup> where the court in denying the existence of a perpetual copyright said, "In the case of a perpetual privilege and monopoly, the bookseller becomes the author's leave-giver; . . . But should the work pursuant to the Statute of Queen Anne, revert to the author in 14 years, he will become the guardian of his own fame, and in consequence, learned and industrious men will be enabled to reap not only fame, but the profits of their labours, to the honor and advantage of themselves and their families."

Despite the court's opinion as to the effect of the statute, it soon developed that the author could be deprived of this additional term if he saw fit to assign it away. In the case of *Carnan v. Bowles*,<sup>15</sup> relying on the unreported

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" . . . Where the author of a work is the first owner of the copyright therein, no assignment of the copyright, and no grant of interest therein, made by him (otherwise than by will) after the passing of this Act, shall be operative to vest in the assignee or grantee any rights with respect to the copyright in the work beyond the expiration of 25 years from the death of the author, and the reversionary interest in the copyright expectant on the termination of that period shall, on the death of the author, notwithstanding any agreement to the contrary, devolve on his (legal representative) as part of his estate, and any agreement entered into by him as to the disposition of such reversionary interest shall be null and void but nothing in this proviso shall be construed as applying to the assignment of copyright in a collective work or a license to publish a work or part of a work as part of a collective work."

<sup>12</sup>Copyright Act R. S., c. 62 *et seq.*, 2 REV. STAT. OF CAN. c. 70, § 19.

<sup>13</sup>As early as 1774, the English court indicated its doubt as to the ownership of the renewal term in case of an assignment when it said, "If the book at the end of 14 years reverts to the author, his interest is saved; if it does not, the legislature, by such a construction, has extended no benefit to learned men." *Donaldson v. Beckett*, 4 Burr. 2408, 1 Eng. Rep. R. 837 (K. B. 1774).

<sup>14</sup>*Ibid.*

<sup>15</sup>2 Bro. C. C. 80, 29 Eng. Rep. R. 45 (Ch. 1786).

case of *Rennet v. Thompson*, came the suggestion in reference to the author's sale of "all his interest" in the copyright of a book of roads, that "It must, I think, be considered as conveying his whole right. If he had meant to convey his first term only, he should have said so."<sup>16</sup>

In *Rundell v. Murray*,<sup>17</sup> where the author of a cook book had made a gift of it to a publisher, the court refused to restrain the publisher at the expiration of fourteen years on the theory that the author was estopped from claiming any right in the work.<sup>18</sup>

The only issue in these English cases was the intention of the parties and whether such intention had sufficiently manifested itself in the agreement between them.<sup>19</sup> If the author survived the first term, the assignee automatically became entitled to the second. No additional assignment was necessary.

The early treatises on copyright law were all in accord with the view that a general assignment carried with it the contingent interest in the second term. There was no doubt, therefore, that under the Statute of Anne, the renewal term was assignable.<sup>20</sup>

That such was undoubtedly the belief of the leaders in Parliament, witness the efforts of men like Sergeant Talfourd<sup>21</sup> and the Lord Macaulay<sup>22</sup> in seeking further protection for the author and the subsequent abolition of the renewal term in England.

The renewal clauses as contained in the American Copyright Acts of 1790 and 1831 received their first interpretation in this country in 1846 in the celebrated case of *Pierpont v. Fowle*.<sup>23</sup> This much cited case involved an assignment by an author of a book copyrighted under the 1790 Act in terms, "The copyright of said book." Prior to the expiration of the first fourteen year term, the 1831 Act was passed which increased the first term in new works to twenty-eight years, and similarly extended the term in subsisting copyrights<sup>24</sup> to the *author* if still living.<sup>25</sup> It does not appear whether the

<sup>16</sup>It should be noted that this was not a direct holding by the court because the claim that the first assignment did not carry the second term was abandoned by the defendant who was a second assignee from the author and had received his assignment after the expiration of the first term.

<sup>17</sup>1 Jac. 311, 37 Eng. Rep. R. 868 (Ch. 1821).

<sup>18</sup>In this case, the court conceded the right to assign the contingent term if expressly so indicated in the agreement.

<sup>19</sup>See also *Brooke v. Clark*, 1 B. & Ald. 396, 106 Eng. Rep. R. 146 (K. B. 1818).

<sup>20</sup>See CURTIS, *THE LAW OF COPYRIGHT* (1847) 234; GODSON, *A PRACTICAL TREATISE ON THE LAW OF PATENTS FOR INVENTION AND COPYRIGHT* (2d ed. 1851) 431.

<sup>21</sup>See note 10 *supra*.

<sup>22</sup>See Pamphlet, *Speeches by Macaulay*, Feb. 5, 1841, April 6, 1842.

<sup>23</sup>Woodb. & M. 23, 19 Fed. Cas. 652 (C. C. D. Mass. 1846).

<sup>24</sup>Copyright Act of 1831, 4 STAT. 436, § 1 (1831).

<sup>25</sup>*Id.* § 16.

defendant assignee was claiming the renewal term under the 1790 Act or the extended term under the 1831 Act.<sup>26</sup> In a lengthy and confused opinion the court held that the assignee was entitled only to the first fourteen year term in view of the limited nature and extent of the assignment. The court advanced various reasons for so holding but mixed up the rights of an assignee under the 1790 Act in the renewal term with the rights of an assignee to the extended term under the 1831 Act in subsisting works.<sup>27</sup> Although the case has been cited by many authorities as holding that the renewal term cannot be assigned, dicta in the case indicate quite the contrary. In citing *Carnan v. Bowles*<sup>28</sup> as representative of the type of assignment that will carry the renewal term, the court at least clearly indicated its belief that the term *is assignable*, if not also that a general assignment showing an intention to include the renewal term will pass it to the assignee.<sup>29</sup> The court, however, requires proof of a clear intention that the contingent term was assigned and that a fair consideration was paid for it.<sup>30</sup>

The case of *Paige v. Banks*<sup>31</sup> was the first Supreme Court expression on the issue as to the right of an assignee to the renewal term. In that case a court reporter contracted with a publisher to furnish him with the reports and the publisher was to have the "copyright of said reports to them and their heirs and assigns forever." The reporter was to receive \$1,000 per volume as each report was published. In refusing to enjoin the further publication of the reports after the expiration of the first term of twenty-eight years, the Court held that the agreement was intended to pass all the interest of the author in the particular work and that the publisher became

<sup>26</sup>It would seem that in view of the express provision of the statute that only the author should get the extended period, the defendant's claim must have been of the renewal term under the 1790 Act which gave the renewal term to the assignee as well as the author.

<sup>27</sup>With respect to the renewal term under the 1790 Act, the court, it is submitted, wrongly interpreted that Act when it said that the clause meant *later* assigns when it spoke of the author and his assigns as being entitled to the renewal term. A later case, *Cowen v. Banks*, 24 How. Pr. 72 (C. C. N. Y. 1862) is in accord with this case's interpretation of the 1790 Statute. *But cf.* *White-Smith Music Pub. Co. v. Goff*, 187 Fed. 247 (C. C. A. 1st, 1911).

<sup>28</sup>*Supra* note 15.

<sup>29</sup>For a contrary opinion as to this latter point see *CURTIS, loc. cit. supra* note 20.

<sup>30</sup>*Cf.* *Cowen v. Banks*, 24 How. Pr. 72 (C. C. N. Y. 1862) where the court found as a fact that the intent of the reporter of court opinions was to assign his entire interest in a copyright under the 1790 Act, and therefore, the assignee was entitled as against the plaintiff administrator of the author, to the extension under the 1831 Act as well as the renewal. It is submitted that the court erred in granting to the assignee any interest in the extension of the 1831 Act since that Act specifically limited the extension to the author, if living at the time of the passage of the Act, which was the case here. It might, however, be justified on the theory that the author was estopped to claim any interest in the work and any rights he obtained under the Act he held in trust for the assignee.

<sup>31</sup>13 Wall. 608 (U. S. 1871).

the absolute owner of it. The Court treated the entire transaction as a matter of ordinary contract law. The case did not determine whether the assignee was entitled to an exclusive right for twenty-eight more years. It decided only that the author was estopped as against this publisher from claiming an exclusive right. Actually it is not authority for anything beyond that, although there is a dictum in the case in accord with *Pierpont v. Fowle* to the effect that the intention of an author to assign his entire interest in a copyrighted work will carry the renewal term.<sup>32</sup>

The conclusion to be drawn from these early cases is that it was considered possible at that time for the author to assign the renewal term along with the original term if he clearly so intended. And this was generally the opinion of the legal writers commenting on the American and English cases.<sup>33</sup>

Although the copyright statute was amended in 1870, 1891, and 1909, and the legislators had before them the rather consistent line of cases recognizing the assignability of the renewal term, with the exception of the few changes already mentioned,<sup>34</sup> they did not, as the English statute does,<sup>35</sup> make the renewal term inalienable. As a matter of fact, the committee which reported the 1909 Act stated that it sought to frame that Act "as is the existing law," in opposition to suggestions that a term of life plus fifty years be substituted for the two term system.<sup>36</sup>

The confusion in recent cases is caused by a lack of appreciation of what the committee, and the Assistant Attorney General Fowler, in his opinion on the assignability of the renewal right meant when they declared the right to be unassignable.<sup>37</sup> A distinction must be observed in speaking of renewal right, renewal term, and renewal period. The renewal right is unassignable, at least prior to the accrual of the twenty-eighth year. Since the statute

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<sup>32</sup>The case of *Paige v. Banks* aroused the first real interest on the part of the text writers in the subject of renewal rights. E. S. Drone, in his treatise, *Law of Property in Intellectual Productions*, published in 1879, gave a very broad interpretation to the case. In the first discussion of any appreciable length to be found so early among the copyright authorities; Drone cites the *Paige* case as holding that the absolute sale of a manuscript carries the renewal term, and also that not only the author, but his widow and children, in case he does not survive, lose all right to the copyright and any possible renewals. It is submitted that Drone goes too far, and that later cases and authorities do not support his view, although he has been relied on by most authorities for their views on the nature of the renewal term and the effect of outright sale. See also MACGILLIVRAY, *LAW OF COPYRIGHT* (1902) 270, and *cf.* BOWKER, *COPYRIGHT, ITS HISTORY AND ITS LAW* (1912) 117.

<sup>33</sup>DRONE, *op. cit. supra* note 32, at 326, 332; SCRUTON, *LAW OF COPYRIGHT* (1883); MACGILLIVRAY, *LAW OF COPYRIGHT* (1902); *see* JENNER, *THE PUBLISHER AGAINST THE PEOPLE* (1907) (Pamphlet) who suggests a third term of fourteen years for the benefit of the author and that it be made unassignable.

<sup>34</sup>See note 9 *supra*.

<sup>35</sup>See note 11 *supra*.

<sup>36</sup>H. R. REP. NO. 2220, 60th Cong., 2d Sess. (1908).

<sup>37</sup>28 OP. ATT'Y GEN. (1910) 162.

specifically enumerates the individuals who may apply for the renewal, the right to apply may not be assigned in such manner as to entitle the assignee to apply for the renewal in his own name.<sup>38</sup> The renewal term as we have seen, may be assigned. The renewal period is the year prior to the expiration date of the copyright and during which application for the renewal term must be made.

Subsequent to *Paige v. Banks*, and after a lapse of forty years during which the renewal term did not once come up for consideration by the courts, the case of *White-Smith Music Publishing Company v. Goff*,<sup>39</sup> was decided. The court in that case, in accordance with the opinion of the attorney general and the explicit provisions of the statute, denied the assignee of a copyright the right to apply for the renewal term under Section 24 of the statute.<sup>40</sup>

There can be no quarrel with this rule since the statute is specific, but both the *Goff* case and the attorney general indicated a recognition of the equitable right of the assignee in this term if and when the author obtains it. Subsequent cases rendered lip service to this principle although the point was not directly involved.<sup>41</sup>

Up to this point there had been very few cases involving the second term because most copyrighted works were hardly profitable during the first term, let alone during a renewal term. There was, therefore, very little interest on the part of those who might be legally entitled to the renewal term, to renew, or to contest the rights of those who had renewed. But the advent of radio broadcasting and its search for material together with the new medium of expression which it offered, and the constant rotation of entertainment brought out of retirement many songs and books that had been cast aside or forgotten. The potentiality of renewed popularity and new financial rewards soon brought about protracted litigation as to the renewal term since most of the works had been copyrighted many years ago and little interest had been displayed in proper application for the renewal term.

It was not, however, until early in 1941 in *Witmark & Sons v. Fisher Music Co.*,<sup>42</sup> that a court found itself face to face with the issue as to whether

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<sup>38</sup>*Ibid.*

<sup>39</sup>187 Fed. 247 (C. C. A. 1st, 1911).

<sup>40</sup>Section 24 extends the term of subsisting copyrights, giving the renewal right to substantially the same persons as Section 23 (see note 2 *supra*) with certain exceptions hereafter noted.

<sup>41</sup>*Silverman v. Sunrise Pictures Corp.*, 273 Fed. 909 (C. C. A. 2d, 1921); 290 Fed. 804 (C. C. A. 2d, 1923); *Tobani v. Carl Fischer*, 98 F. (2d) 57 (C. C. A. 2d, 1938), *cert. den.* 305 U. S. 650, 59 Sup. Ct. 243 (1938).

<sup>42</sup>38 F. Supp. 72 (S. D. N. Y. 1941), *aff'd*, 125 F. (2d) 949 (C. C. A. 2d, 1942). All references to the *Witmark* case are to the decision in the circuit court of appeals unless otherwise indicated. The case was affirmed by the Supreme Court on April 5, 1943, and comment thereon has been inserted as note 56a *infra*.

an assignee could enjoin the author or his subsequent assignee, from publishing after the expiration of the first term. In all prior cases, it will be recalled, the author sought to enjoin his assignee from further publication after the expiration of the first term and many of the courts had denied him relief on equitable principles. In this case Ball, Olcott, and Graff composed the song "When Irish Eyes Are Smiling," transferring all rights, including renewals, to the publisher Witmark and Sons, plaintiff herein. During the last year of the first term, plaintiff applied for the renewal in Graff's name and on behalf of Olcott's widow and then assigned the copyrights so obtained to itself. Graff also renewed and assigned the renewal to the defendant publishing company. Witmark obtained an injunction against further publication by the defendant and this was affirmed by the circuit court of appeals. This court in a very able opinion discussed earlier cases where the right to assign the renewal term was unquestioned and noted the absence in the 1909 statute of any prohibition on assignment.

In a lengthy and stirring dissent,<sup>43</sup> Judge Frank criticized the opinion of the majority on several grounds. He said that since this was a court of equity it should look into the adequacy of the consideration paid by Witmark for the assignment and the difference in bargaining power between the author and the publisher. There is much merit in such an argument but the ordinary principles of equity are quite as capable of application here as in any other case coming within equity's general jurisdiction.<sup>44</sup> Nor are these principles entirely disregarded by the majority.<sup>45</sup> It is submitted, however, that as to the interpretation of cases and authorities cited by Judge Frank, he has been unduly influenced by some broad language, and a careless use of terms. Thus in *Shapiro, Bernstein and Company v. Bryan et al.*,<sup>46</sup> which involved employer and proprietor rights, though the court spoke of a limitation on the author's right to assign, it merely meant that he could not sign away the term in such a manner as to deprive his widow and children thereof if he died before the last year.

The minority placed much reliance on the report of the committee accompanying the bill which became the present Copyright Act.<sup>47</sup> The committee

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<sup>43</sup>125 F. (2d) 949, 954-969 (C. C. A. 2d, 1942).

<sup>44</sup>The equitable principle suggested here by Judge Frank was in fact first enunciated in this type of case in *Pierpont v. Fowle* (*supra* notes 23 and 30) where the court set adequacy of consideration as an element to be considered in determining renewal rights.

<sup>45</sup>See 125 F. (2d) 949, 954, where the court said: "On this interlocutory issue we ought not to foreclose other contentions which the parties may wish and be entitled to raise on the merits, including possibly claims of inadequacy of consideration in 1917, so gross as to prevent negative enforcement of the assignment. . . ."

<sup>46</sup>123 F. (2d) 697 (C. C. A. 2d, 1941).

<sup>47</sup>*Supra* note 36.

undoubtedly had in mind the interest of the author in phrasing the renewal term. So had the committee in reporting the 1831 Act.<sup>48</sup> And such has been the intention of most of the copyright legislation in England and in other countries.<sup>49</sup> But they have not been successful in protecting the author against himself.<sup>50</sup> The committee sought only to prevent an outright sale from carrying the renewal.<sup>51</sup> Such was the state of law as enunciated in *Pierpont v. Fowle*<sup>52</sup> and *Paige v. Banks*.<sup>53</sup> It, however, did not seek to prevent the author from specifically assigning the renewal term. This is evident from the language used. The committee sought to frame the new law as was the existing law so "that he [the author] could not be deprived of that right" [to take the renewal term]. The existing law recognized the right of the assignee, where the renewal term was assigned to him, to require the author if he survived and applied for the renewal, to hold it in trust for his benefit.<sup>54</sup> If Congress had sought to prohibit wholly the assignment of this renewal term prior to its accrual, it might have said so since it had before it the interpretation of prior similar statutes by the courts.<sup>55</sup> It might have, for instance, enacted a provision similar to that found in the English statute which specifically provides that any assignment of the last twenty-five years is void.<sup>56</sup> Congress can do likewise with respect to the renewal term. Until it does so, it is unfair to expect the courts to legislate judicially such a provision into execution.

Recent cases have carried into practice the opinion of the circuit court of appeals in the *Witmark* case.<sup>56a</sup> In *Schirmer, Inc. v. Robbins Music Co.*,<sup>57</sup>

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<sup>48</sup>H. R. REP. No. 3, 21st Cong., 2d Sess. (1830).

<sup>49</sup>See notes 10 and 22 *supra*.

<sup>50</sup>*Ibid.*

<sup>51</sup>28 OP. ATT'Y GEN. (1910) 162. That such had been the effect of prior legislation, see also notes 32 *supra*.

<sup>52</sup>*Supra* notes 23 and 30.

<sup>53</sup>*Supra* notes 31 and 32.

<sup>54</sup>*Supra* note 41. See also COPINGER, LAW OF COPYRIGHT (7th ed. 1936); it would be vain to attempt to set out in repetition the eleven other authorities among the text writers cited by Judge Clark speaking for the majority in the *Witmark* case, 125 F. (2d) 949, 952 (C. C. A. 2d, 1942), notes 4, 5, and 6.

<sup>55</sup>See notes 33-35.

<sup>56</sup>*Supra* note 11. See COPINGER, LAW OF COPYRIGHT (7th ed. 1936) 106, where that eminent authority criticizes the ineffectiveness of this "curious proviso" in the English act which permits an assignment of the last twenty-five years by the legal representative of a deceased author, and permits its sale for his debts. Copinger also states that a specific legatee will probably sell it outright and it is usually sold in winding up the estate so that the publisher will get it anyway.

<sup>56a</sup>Subsequent to the completion of this article, the United States Supreme Court on April 5, 1943 (— U. S. —, 63 Sup. Ct. 773), in a divided opinion, affirmed the decision of the majority in the *Witmark* case. The Court in a historical approach to the problem saw before it only the question whether the Copyright Act nullified an assignment by a copyright owner of the contingent renewal term. Under the facts of this particular case it found, in accord with the writer's view, that prior to the enactment

the New York Supreme Court granted specific performance of a contract to convey the renewal term in a suit by the assignee against the author, who had obtained the renewal and had assigned it to another. Judge Wasservogel correctly interpreted the law when he saw as the only question before the court the enforcement of a contract involving a determination as to the intention of the parties with respect to the renewal term.<sup>58</sup>

In *Marks Music Corp. v. Vogel Music Corp.*,<sup>59</sup> the court in refusing summary judgment to an assignee of the renewal rights in a song, in view of the claims of a prior assignee of all the author's "right, title and interest," deemed it a triable issue as to whether the prior assignment had not as a matter of fact carried the equitable right to the renewal term. This would seem to be carrying the *Witmark* case to its furthest extreme. It is submitted that as to the prior assignment the court should have found as a matter of law that the renewal term did not pass.<sup>60</sup>

A rather unusual twist as to the effect of an assignment of the renewal term is found in the recent case of *Selwyn & Co. v. Veiller*.<sup>61</sup> There Veiller assigned all his rights in a play he had written, including the renewal term, to Selwyn, who in turn assigned to Loew's, Inc. Thereafter, Loew's desiring to make a motion picture based on the play and seeking to assure itself of complete protection, obtained an assignment from Veiller of any interest he might have therein. Selwyn in this action sought to recover from Veiller the consideration received by him from Loew's for the assignment on the

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of the present statute the renewal term was assignable and that the 1909 amendment did not change that law. The Court confirmed the holdings in earlier cases that an assignment by the author of his "copyright" in general terms did not include conveyance of his renewal interest (see *supra* notes 30-33), and that therefore in the absence of a specific assignment of the renewal term the assignee will be entitled to the first term only. Justice Frankfurter, speaking for the majority, specifically refused to rule on the question whether a court may deny enforcement of a particular assignment because made under oppressive circumstances.

<sup>57</sup>176 Misc. 578, 28 N. Y. S. (2d) 699 (Sup. Ct. 1941).

<sup>58</sup>*Accord*, *Paige v. Banks*, *supra* note 31.

<sup>59</sup>42 F. Supp. 859-1 (S. D. N. Y. 1942).

<sup>60</sup>CURTIS, *op. cit. supra* note 20, at 234; LAW, COPYRIGHT AND PATENT LAW OF THE U. S. (1870) 59 (contains forms for contracts to make a general assignment and also forms that include a specific assignment and the renewal as well). SHAFTER, MUSICAL COPYRIGHT (1st ed. 1932) (2d ed. 1939). If a mere assignment without any mention of the renewal term can be considered as conveying the renewal, there would be nothing left of the statute. In *Paige v. Banks* where the language used tends to support the denial of summary judgment in the *Marks* case, the author was the plaintiff and extensive evidence indicated an intention on his part to give up all interest in the reports for the \$1,000 per volume. In the *Tobani* case, ill-considered dicta which was apparently taken from the *Paige* case also tends to support the defendant's claim in the *Marks* case. The language of the committee, the attorney general, the general trend of authority cited above and the more recent cases, such as the *Witmark* case, seem to indicate a more rigid scrutiny of any agreement claiming to assign a renewal term. See also criticism, note 32 *supra*.

<sup>61</sup>43 F. Supp. 491 (S. D. N. Y. 1942).

theory that any rights that Veiller had belonged to it. In denying recovery, the court held that if plaintiff received all of the author's rights under the original assignment, then the defendant gave Loew's nothing belonging to the plaintiff. And if plaintiff left the defendant with any rights, then the defendant was entitled to the consideration he received for those rights. The case illustrates the element of uncertainty that has been introduced into assignment contracts, but such uncertainty is to be expected in view of the very nature of the interest sought to be purchased. The assignee's right to the renewal term depends on the author's surviving the twenty-seventh year. Since that is uncertain, the purchaser must also get assignments from all those who might be entitled on the author's death, so that if they are alive they can be required to obtain the renewal and make the assignment. But all the assignments in the world cannot protect the assignee if he should leave out some distant relative or be unable to find one who can apply for the renewal. Obtaining the renewal term is a highly speculative venture at its best, so that those who seek it in avoidance of the intent of the statute to give it to the author and his family, cannot complain too much about having to pay tribute to so many people and having no complete assurance that they will get the renewal term.<sup>61</sup> At best, the assignee is really protecting himself against suits for infringement, since the work will pass into the public domain if not renewed by those entitled.<sup>62</sup> But even that is not certain for, as has been stated, a distant relative whose prior assignment was not obtained might appear and sue for infringement.

#### IV. EFFECT OF ASSIGNMENT

Thus far we have been considering the assignability of the renewal term and the rights of the assignee. The effect of the assignment on the others mentioned in the statute as well as the rights of those specifically enumerated therein, and the curious possibilities that might arise must still be considered. Their rights will be examined in the order in which they are mentioned in the statute.

It is worthy of note that the author's family has not always received the benefit of the renewal term in the specific and express manner in which it is now protected. The Statute of Anne merely returned the copyright to the *author*, if still living at the expiration of the first term.<sup>63</sup> The first American copyright statute in 1790 gave the renewal term to the author, or authors,

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<sup>61</sup>The *Tobani v. Fischer* cases are illustrative of a publisher's futile attempt to assure himself of the renewal term. 98 F. (2d) 57 (C. C. A. 2d, 1938), and 263 App. Div. 503, 33 N. Y. S. (2d) 294 (2d Dep't 1942); see note 80 *infra*.

<sup>62</sup>Copyright Act of 1909, 35 STAT. 1080, 17 U. S. C. § 23 (1940); see note 2 *supra*.

<sup>63</sup>See notes 3 and 4 *supra*.

"his or their executors, administrators and assigns."<sup>64</sup> The 1831 Act added the widow and children as those entitled to the renewal copyright and dropped executors, administrators, and assigns.<sup>65</sup> The Copyright Act remained in this form for almost a hundred years, until the committee reporting the present act stated, "Instead of confining the right of renewal to the author, if still living, or to the widow or children of the author, if he be dead, we provide that the author of such work if still living, may apply for the renewal, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower or children be not living, then the author's executor, or in the absence of a will, his next of kin."<sup>66</sup>

#### A. The Author

Many courts and text writers have indicated the possibility that an author may deprive himself of all right in the renewal term by an assignment before the accrual of the renewal period which purports to convey away all interest in the copyright. Thus, although the words used may not be sufficient to constitute an assignment of the exclusive right granted under the statute, they may be effective to debar the author from claiming the renewal copyright.<sup>67</sup>

Such apparently was the conclusion of the Court in *Paige v. Banks*,<sup>68</sup> where the Court without deciding whether the defendant assignee got the renewal term by the assignment from the author, refused to enjoin further publication by the defendant, finding as a result that the author had lost the right to the renewal term.

In the *Goff* case, the court, relying on *Paige v. Banks*, said by way of dictum that aside from considerations of statute, the author can estop himself from claiming any further rights in a copyrighted work by virtue of some act or agreement in relation thereto. There have been no recent cases directly on this point although dicta in several are in conflict.<sup>69</sup> The statute

<sup>64</sup>*Supra* note 7. See also note 27 *supra*.

<sup>65</sup>*Supra* note 8.

<sup>66</sup>H. R. REP. No. 2220, 60th Cong., 2d Sess. (1908) as enacted in Copyright Act of 1909, 35 STAT. 1080, 17 U. S. C. § 23 (1940).

<sup>67</sup>*Rundell v. Murray*, 1 Jac. 311, 37 Eng. Rep. R. 868 (Ch. 1821); *Cowan v. Banks*, 24 How. Pr. 72 (C. C. N. Y. 1862); *Paige v. Banks*, 13 Wall. 608 (U. S. 1871); *White-Smith Music Pub. Co. v. Goff et al.*, 187 Fed. 247 (C. C. A. 1st, 1911); *Tobani v. Carl Fischer*, 98 F. (2d) 57 (C. C. A. 2d, 1938); *Marks Music Corp. v. Vogel Music Corp.*, 42 F. Supp. 859-1 (S. D. N. Y. 1942); *DRONE, op. cit. supra* note 32, at 326; *MACGILLIVRAY, op. cit. supra* note 33, at 270; *BOWKER, op. cit. supra* note 32, at 117-118. *Contra: Witmark & Sons v. Fred Fisher Music Co.*, 125 F. (2d) 949, 951 (C. C. A. 2d, 1942); H. R. REP. No. 2220, 60th Cong., 2d Sess. (1908); 28 OP. ATT'Y GEN. (1910) 162; WEIL, AMERICAN COPYRIGHT LAW (1917) 366-367; *SHAFTER, op. cit. supra* note 60, at 176.

<sup>68</sup>80 U. S. 608 (1871).

<sup>69</sup>See note 67 *supra* and compare especially the *Witmark* case and the *Marks* case.

itself is silent as to any estoppel against the author's claiming rights after such a conveyance, though it would seem that in view of the statute's express terms that the author is to have the renewal right, he should not be deprived of that right.

### B. *Widow, Widower, and Children*

We have seen that the intent of the statute to benefit the author is carried over to the author's family in the event that the author is not alive when the time to make the renewal application arrives.<sup>70</sup> Thus the second term may be secured by the widow, widower, or children. The issue then is whether the author by a prior assignment of the term, or sale of all his interest in the renewal copyright, can deprive his widow and children of the renewal should the author not survive the twenty-seventh year of the first term.

In a dictum in the *Tobani v. Fischer*<sup>71</sup> case, Judge Manton suggested that the author could deprive his children of the renewal term by divesting himself of all interest in the work.<sup>72</sup> Such a statement was unnecessary to the decision in that case since the composer, Tobani, was not entitled to any interest in the copyright *ab initio* because it was a work made for hire, and thus the employer was entitled to the original as well as the renewal right under the statute.<sup>73</sup> The statute intends to give the renewal term to the family of the author only where he himself had some interest in the original term. So although Tobani's children had renewed, they were not entitled to the renewal right since as to this copyright they were not mentioned in the statute.

The *Witmark* case contains a dictum to the effect that an assignment prior to the accrual of the renewal period could not cut off the rights of those enumerated in the statute if the author died prior to or during the last year of the old term without applying for the renewal.<sup>74</sup> This view has logic on its side and is in accord with the clear intent of the statute. The rights given to the widow and children are not dependent on the author's, except insofar as he must have been entitled to the original term as the

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<sup>70</sup>*Supra* notes 2, 8, and 9.

<sup>71</sup>198 F. (2d) 57 (C. C. A. 2d, 1938).

<sup>72</sup>The court in the *Tobani* case apparently was relying on a statement in *DRONE, op. cit. supra* note 32, at 332. Drone is criticized in 28 *OP. ATT'Y GEN* (1910) 162 where Assistant Attorney General Fowler says, "When the application for renewal is presented to the Register of Copyrights, the only thing left for his consideration is whether the applicant is one of the persons designated in the statute."

<sup>73</sup>Copyright Act of 1909. See note 2, *supra*.

<sup>74</sup>125 F. (2d) 949, 950 (C. C. A. 2d, 1942). *Accord*: *Shapiro, Bernstein & Co. v. Bryan*, 123 F. (2d) 697 (C. C. A. 2d, 1941); *Fox Film Corp. v. Knowles*, 261 U. S. 326, 43 Sup. Ct. 365 (1923).

author in a technical and legal sense. The case of *Silverman v. Sunrise Pictures Corp.*,<sup>75</sup> quite adequately sums up the nature of the widow's and children's rights in the following manner: The purpose of the renewal provision,

"is to give to the persons enumerated in the order of their enumeration a new right or estate, not growing legally out of the original copyright property, but a new creation for the benefit (if the author be dead) of those naturally dependent upon or properly expectant of the author's bounty."

"The author cannot take away the right of the widow, children, etc., before the opening of the last year of the original copyright. It is not until then that any estate or chose in action arises or exists; and when such a right arises it is . . . a new estate, not a true extension of the existing copyright."

Although the question has not been directly before the courts for determination, all the text writers, with a single exception, and the committee which reported the present act, are unanimous in finding the widow's and children's rights independent of the author's and not subject to his control or disposition.<sup>76</sup>

Frohlich and Schwartz in their treatise<sup>77</sup> suggest that if the author makes an assignment during the last year of the first term and then dies, the assignee and not the persons enumerated in the statute would get the new term. It is submitted that this would not be so unless the author or his assignee in the author's name had already obtained the renewal at the time of the assignment. The statute puts a premium on the application and if the author had not applied, it would be impossible for the assignee to make the application, he not being mentioned in the statute, any power of attorney he may have expiring with the death of the author. The conditions precedent to the rights of the author's family would then be present and they would be entitled.

In the first edition of Shafter's work on musical copyright, that author followed Drone and the dictum in the *Tobani* case in stating that the author's contract of assignment would be enforceable even as against his family, if he should not survive.<sup>78</sup> In his 1939 edition, however, he discards this statement and substitutes the other extreme saying that such an assignment would

<sup>75</sup>273 Fed. 909 (C. C. A. 2d, 1921), 290 Fed. 804 (C. C. A. 2d, 1923).

<sup>76</sup>CURTIS, *op. cit. supra* note 20, at 235; WEIL, *op. cit. supra* note 67, at 365, 366; FROHLICH AND SCHWARTZ, *LAW OF MOTION PICTURES AND THE THEATRE* (1918) 549; DEWOLF, *AN OUTLINE OF COPYRIGHT LAW* (1925) 65; AMDUR, *COPYRIGHT LAW AND PRACTICE* (1936) 541; (1939) 10 AIR L. REV. 198. *Contra*: DRONE, *op. cit. supra* note 32, at 332.

<sup>77</sup>*Supra* note 76.

<sup>78</sup>SHAFTER, *op. cit. supra* note 60 (1st ed. 1932), at 138.

not be enforceable against the widow even if she joined in the assignment.<sup>79</sup> This latter would not seem to follow since she could be required by a court of equity to apply for the renewal and make the conveyance to the assignee, if she survived, in the same manner as the author.<sup>80</sup>

### C. *Executor: Disposition by Will: Legatees*

If neither the author nor his widow or children survive the first term, the statute provides that the executor may make the application for the renewal term, and then it rather ambiguously states that "in the absence of a will, his next of kin shall be entitled to a renewal. . . ."<sup>81</sup>

As has been previously noted, the executor is not a newcomer to this family of persons entitled to apply for the renewal, since he was provided for in the first Copyright Act<sup>82</sup> though later dropped and not revived until the present act. This perhaps might account for the curious statement in the first *Silverman* case<sup>83</sup> to the effect that the executor had no rights in the renewal unless the author survived the twenty-seventh year. Thereafter, the case of *Fox Film Corp. v. Knowles*<sup>84</sup> went to the Supreme Court which reversed the lower courts<sup>85</sup> and held that the executor's right was independent of the author's and existed solely in the creation of the statute, and that his right to apply for renewal did not depend on the author's being alive in the last year of the original term.

The right of the executor to apply for renewal in the absence of a widow or children was carried to an illogical extreme in *Yardley v. Houghton Mifflin Co.*<sup>86</sup> There an artist painted a picture for the New York City

<sup>79</sup>SHAFTER, *op. cit. supra* note 60 (2d ed. 1939), at 171.

<sup>80</sup>See *Tobani v. Carl Fischer*, 263 App. Div. 503, 33 N. Y. S. (2d) 294 (2d Dep't 1942). This case was an interesting aftermath of the 1938 *Tobani* case in the federal court (see note 74 *supra*). It seems that when Fischer obtained Tobani's acknowledgment of his employee status with regard to his work copyrighted by Fischer, the latter also contracted to pay Tobani's wife \$5,000 on Tobani's decease, and she assigned to him all her rights in any renewal terms in said copyrights. Thereafter Mrs. Tobani pre-deceased her husband and therefore was not entitled to any renewal rights. In this suit by Tobani's children as administrator of Mrs. Tobani, they sought to recover the \$5,000 payable thirty days after Tobani's decease. The court in granting judgment for the plaintiff recognized that Mrs. Tobani had an interest under the statute even prior to the accrual of the renewal period that she might bind herself to convey if she ever became entitled. Unless this is so, there was here no consideration for Fischer's promise. It is submitted that the case is incorrectly decided anyway, since the federal court had held that Tobani never had any interest in this copyright and therefore there was in fact no consideration given by Mrs. Tobani in her covenant because she could never become entitled to any renewal rights in a work made for hire.

<sup>81</sup>See note 2 *supra*.

<sup>82</sup>*Supra* note 7.

<sup>83</sup>273 Fed. 909 (C. C. A. 2d, 1921).

<sup>84</sup>261 U. S. 326, 43 Sup. Ct. 365 (1923).

<sup>85</sup>275 Fed. 582 (S. D. N. Y. 1921), 274 Fed. 731 (E. D. N. Y. 1921), *both aff'd*, 279 Fed. 1018 (C. C. A. 2d, 1922).

<sup>86</sup>108 F. (2d) 28 (C. C. A. 2d, 1939), *cert. den.* 309 U. S. 686, 60 Sup. Ct. 891 (1940).

Board of Education to be displayed in a high school, and copyrighted it in his own name. He died prior to the renewal period and appointed one Class his executor. The artist left surviving him two sisters as his only heirs and next of kin, who applied for and obtained the renewal term. It appears that the defendant infringed this copyright prior to the expiration of the first term, though after the death of the artist, and was still using the picture at the time of this suit. The executor had never applied for the renewal, though prior to suit he had assigned all his rights to the sisters. In this suit against the defendant by the sisters, the district court held that plaintiffs did not obtain a valid renewal because the executor was entitled thereto.<sup>87</sup> In the circuit court, the claim as to a renewal was abandoned by the plaintiffs, and they were permitted to recover for the infringements during the first term. The court, however, held on a counterclaim that the plaintiffs renewal was invalid. It would seem that such a holding was mere dictum, but it is nevertheless a significant disregard for the policy and intent of the statute. Certainly if the executor had renewed, he would have held the term in trust for the next of kin.<sup>88</sup> Also, since the next of kin are specifically mentioned in the statute as entitled to renew, there can be no technical question of the validity of the renewal especially in view of the fact that the policy that motivates the courts in denying the right of the assignee to make the application in his own name, is not present in the case of the author's own family. When the statute says that in the absence of a will the next of kin may renew, it obviously means where the will fails to make a beneficial disposition of the renewal term. In the *Yardley* case, it did not appear whether any beneficial disposition was made. In any event, if the executor refused to act, can it be denied that the next of kin would be entitled to renew?<sup>88a</sup>

As has been seen, the statute provides that in the absence of a will, the next of kin may renew. Whether this means that if there is a will and the will names legatees they will be entitled to the renewal copyright or whether it merely refers to the existence of an executor is not clear. A reference to the committee report on the Copyright Act sheds some light on the question. It says, "It was not the intention to permit the administrator to apply for the renewal, but to permit the author who had no wife or children to *bequeath by will the right to apply for the renewal.*"<sup>89</sup> Thus is indicated the

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<sup>87</sup>25 F. Supp. 36 (S. D. N. Y. 1938).

<sup>88</sup>WELL, *op. cit. supra* note 67, at 365; AMDUR, *op. cit. supra* note 76, at 545; SHAFER, *op. cit. supra* note 60, at 177 (suggests that the executor might be compelled to renew for the benefit of a publisher-assignee).

<sup>88a</sup>The *Silverman* case poses a similar question with respect to legatees.

<sup>89</sup>H. R. REP. No. 2220, 60th Cong., 2d Sess. (1908).

purpose of the clause. Apparently then, the executor *or* the legatees<sup>90</sup> may apply, the former having been included as one who would best know the nature and extent of his testator's property and could be relied on to make the application at the proper time for the benefit of all those beneficially entitled.

Despite the explanatory statement of the committee, the court in the *Silverman* case stated that a disposition by will prior to the accrual of the renewal period is ineffective to convey to the legatees the renewal right.<sup>91</sup> If that is the proper interpretation of the statute, then it is submitted that the clause has no meaning at all since the aid of the statute is not needed to permit a disposition by will if the author survives the twenty-seventh year and obtains the renewal. At that point it is property like any other and a testator may dispose of it in any way he sees fit.

The right of the next of kin to renew where the executor has been discharged is sanctioned by the *Silverman* case.<sup>92</sup>

The administrator has no right to renew under any circumstances. He has been purposely left out of the present statute although he had been included in prior statutes.<sup>93</sup>

#### V. PROPRIETOR'S RIGHTS

In addition to providing a renewal term for the author and his family, the statute also enumerates certain cases where others may be similarly entitled. We have seen that in the ordinary case where an author composes a work on his own behalf, he alone and his family are entitled to the renewal even though not originally copyrighted by him. The statute does not make specific provision for a proprietor or assignee to make the renewal application except in the following instances:

1) In the case of a posthumous work, or a periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof;

<sup>90</sup>In *Stuff v. LaBudde Feed and Grain Co.*, 52 U. S. P. Q. 23 (E. D. Wis. 1941), the court indicates that a legatee may not be entitled to apply for renewal.

<sup>91</sup>There is little authority on this point. WEIL, *op. cit. supra* note 67, at 365, observes that a testamentary disposition in favor of a publisher would not be enforceable against the next of kin. SHAFER, *op. cit. supra* note 60, at 173, thinks that the author's bequest of the renewal right is invalid if he dies prior to the accrual of the renewal period. On the other hand, DEWOLF, *op. cit. supra* note 76, at 68, indicates his belief that the author may bequeath by will. See also Note (1941) 15 So. CALIF. L. REV. 108. It would seem that the reason for the hesitancy to permit the author to bequeath the renewal right is based on a desire to prevent a bequest in favor of the publisher and also because the legatee could not renew in his own name, though he would be entitled to the beneficial interest.

<sup>92</sup>See also *Fitch v. Schubert*, 20 F. Supp. 314 (S. D. N. Y. 1937).

<sup>93</sup>H. R. REP. No. 2220, 60th Cong., 2d Sess. (1908); *Danks v. Gordon*, 272 Fed. 821 (C. C. A. 2d, 1921).

2) In the case of any work originally copyrighted by a corporate body, provided it did not obtain the original copyright as assignee or licensee of an individual author;

3) In the case of any work copyrighted by an employer for whom such work was made for hire.

In either of these three cases the "proprietor of such copyright shall be entitled to a renewal."<sup>94</sup>

The case of a work copyrighted by an employer where the work was made for hire, has received the most frequent interpretation and has been productive of some interesting results.

In *Tobani v. Fischer*,<sup>95</sup> Tobani, a composer and arranger was employed by the defendant. When the first term of the copyright obtained for Tobani's work had expired, the composer's children, Tobani having died, renewed in their own names. They sought in this action to restrain the former employer from continuing to publish the copyrighted work. In refusing to enjoin the defendant, the court held that defendant was the *author* of the work as defined in Section 62 of the Copyright Act, the word "author" including an employer in case of a work made for hire.<sup>96</sup> The court, however, denied the defendant's counterclaim for an assignment of the renewal term thus obtained because defendant alone having been entitled to apply for the renewal copyright, the renewal by Tobani's children was void and they had nothing to assign. The defendant, having failed to renew within the time limited, the work passed into the public domain.

The *Tobani* case was decided under Section 24 of the Act relating to subsisting copyrights since the works involved were copyrighted prior to 1909. The Act makes an apparently unintentional distinction between new and subsisting works because it omits the rights granted to the proprietors in Section 23, excepting in case of a composite work, though it includes the author's family proviso of Section 23.

It was not until the case of *Shapiro, Bernstein and Co. v. Bryan*<sup>97</sup> that the "employer in case of work made for hire" clause and the term "proprietor" as used in Section 23 received interpretation. In that case Bryan and Fisher wrote "Come Josephine in My Flying Machine" while employed by Shapiro.

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<sup>94</sup>Copyright Act of 1909, § 23, *supra* note 2.

<sup>95</sup>98 F. (2d) 57 (C. C. A. 2d, 1938).

<sup>96</sup>In the *Yardley* case, where the artist painted a picture for the Board of Education, the circuit court passed over the district courts' suggestion that the artist had no right to the original copyright, because it was a work made for hire, and went on to make some unnecessary, and, it is submitted, incorrect holdings heretofore discussed (*supra* note 86); *Yale University Press v. Row, Peterson & Co.*, 40 F. (2d) 290 (S. D. N. Y. 1930); *National Cloak and Suit Co. v. Kaufman*, 189 Fed. 215 (C. C. M. D. Pa. 1911).

<sup>97</sup>123 F. (2d) 697 (C. C. A. 2d, 1941).

The song was copyrighted by Shapiro in 1910. After Shapiro's death in 1911, his widow assigned the copyright to plaintiff who renewed in 1937 as "proprietor of a work 'made for hire.'" In a suit for infringement against the author who had also renewed, the court held that the plaintiff as *proprietor of the copyright at the time of the renewal* was entitled thereto within the meaning of the statute.<sup>98</sup>

Thus we have a different rule for proprietors than we have for authors. In the former case, the employer can assign the right to apply for renewal and the assignee's right is not dependent on the assignor's surviving the first term. Nor is there any limitation on those who are to take on the employer's death. This is in line with the policy of the Act to protect the author only, as used in its colloquial sense. The Act seeks also to secure the author's family. There is no such interest in case of an employer.

A curious possibility apparently overlooked in the *Tobani* case would occur if the employer-author, in case of a work subsisting before the passage of the Act, died before the renewal right accrued. Section 24 which deals with copyright in subsisting works does not contain an employer-proprietor clause such as is found in Section 23 and therefore under Section 24 the employer's only claim is as an author under the definition of Section 62.<sup>99</sup> And as such he is limited in his control and disposition of the renewal term in the same manner as any other author. However, this point is purely academic since there are no copyrights outstanding today which subsisted in 1909, unless they are already in their renewal terms.

## VI. JOINT RIGHTS

Recent cases have presented some unusual patterns to confuse the courts and suggest others that the authorities might have to grapple with in the near future.

It is unquestioned law that where two parties jointly create or compose they are equally entitled to the copyright secured for their joint effort, in the absence of a contrary intent.<sup>100</sup>

Where there are several entitled to the renewal term, such as the next of kin, they take as tenants in common, the renewal by one inuring to the benefit of all.<sup>101</sup>

<sup>98</sup>See also *Vitaphone Corp. v. Hutchinson Amusement Co.*, 28 F. Supp. 526 (C. C. D. Mass. 1939).

<sup>99</sup>WELL, *op. cit. supra* note 67, at 372.

<sup>100</sup>*Powell v. Head*, 12 Ch. D. 686 (1879); *Levy v. Rutley*, L. R., 6 C. P. 523 (1871); *Maurel v. Smith*, 220 Fed. 195 (S. D. N. Y. 1915); *So. Music Pub. Co. v. Bibo-Lang*, 10 F. Supp. 972 (S. D. N. Y. 1935) (joint author entitled to register renewal).

<sup>101</sup>*Silverman v. Sunrise Pictures Corp.*, 290 Fed. 804 (C. C. A. 2d, 1923), 273 Fed. 909 (C. C. A. 2d, 1921). *AMDUR, op. cit. supra* note 76, at 552; *DEWOLF, op. cit. supra* note 76, at 68 (children take as tenants in common).

The situations that might arise through a combination of these two principles can be recited *ad infinitum*. Cases involving musical copyright are probably the greatest problem in this regard because of the manner in which music is written. In the usual case, the lyrics are written by one person, and the music composed by another or perhaps two others.

The case of *Marks Music Corp. v. Vogel Music Corp. et al.*<sup>102</sup> is representative of the type of situations that might arise for adjudication in various patterns. Actually there are three cases between the same parties dealt with in the opinion.

In the first case, one Howard wrote the music and Hough and Adams the lyrics for a musical show. Among the songs written was one entitled, "I Wonder Who's Kissing Her Now." The song was written in the following manner. Howard would write the music and he would send it to the producer who in turn would send it to Hough and Adams for the lyrics. Howard assigned to the plaintiff all his rights in the song, specifically including the renewal rights. Pursuant to the assignment, Howard conveyed the renewal term to the plaintiff after applying for and obtaining it. Hough and Adams also renewed and assigned to the defendant. In this suit by plaintiff to restrain the defendant from publishing the song, plaintiff relies on the renewal being a new right and admits defendant's ownership of the title and lyrics, but denies its right to the music. The court properly found that the work was created as part of a common design, the parties intending the combination of the words and music, and that the renewal was of the entire work and that therefore the parties were tenants in common of the entire song for the renewal term.

In the second case, Stein, a publisher, copyrighted a song, "The Bird in Nellie's Hat," by virtue of assignments from Lamb, the lyricist, and Solman, the composer. Thereafter, Lamb and Solman made a separate assignment of their rights in the renewal terms (as yet unaccrued) to Stein. The plaintiff succeeded to Stein's business and Solman obtained the renewal term and executed a conveyance thereof to it. The defendant claims a right in this song by virtue of an assignment from Lamb's brother who as his next of kin (there being no widow or children) was entitled to the renewal term, Lamb having died prior to the last year of the first term. Plaintiff contended (among other things) that since the brother did not apply for the renewal term his right lapsed and his interest passed into the public domain. In denying plaintiff's motion for summary judgment, the court at least recognized that there might be some merit in defendant's case. It would seem inequitable, however, under these particular facts to permit Lamb's brother,

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<sup>102</sup>42 F. Supp. 859 (S. D. N. Y. 1942).

and therefore his assignee, to have the advantage of Solman's renewal when in fact Lamb had ceased being a joint owner by virtue of his assignment to Stein. Since the brother's claim is dependent wholly on the statute, and he is required to make an application for the renewal term in order to be beneficially entitled thereto, he should be held to the letter of it, especially where to permit a deviation will work an inequitable result.

In the last case, one Marks wrote lyrics and sent them to a publisher who obtained music from one Loraine. The song, "December in May," was copyrighted by the publisher and renewed by Marks. Loraine never renewed but assigned all his interest in the song to the defendant subsequent to the expiration of the renewal period. Defendant claims an interest in the song as tenant in common contending that Marks's renewal inured to Loraine's benefit. The plaintiff argued that Marks renewed for the lyrics only, and that the music not having been renewed passed into the public domain. The court found, as it did in the first case, that the song was written as part of a common design. In an able discussion of joint authorship the court concluded that physical propinquity of the authors and consultations are not essential to the creation of a joint work. The only requirement, as Judge Learned Hand puts it in *Maurel v. Smith*,<sup>103</sup> is that the collaborators knowingly engage in the production of a piece which is to be presented originally as a whole only. The original unity of words and music in the copyrighted song was not dissolved by the application for renewal which in its terms was of a musical composition. And Marks's renewal inured to the benefit of both himself and Loraine.<sup>104</sup>

In *Harris v. Coca-Cola Co.*,<sup>105</sup> the circuit court reversed the district court and held that the renewal copyright of a book did not cover the illustrations contained therein which had been contributed by another artist. This case decided in 1934 would seem to be in conflict with principles enunciated above and probably would not be followed. Whether a renewal copyright may be obtained for a part of a work produced under a common design and copyrighted as a joint work would seem to be an open question. No doubt the application of equitable principles will determine this issue.

## VII. SUMMARY AND CONCLUSIONS

Out of this maze of case and text authority, certain well defined legal principles are rapidly forming. Although, as has been seen one cannot be too sure of the ultimate solution of the many problems involved in the deter-

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<sup>103</sup>220 Fed. 195, 200 (S. D. N. Y. 1915).

<sup>104</sup>See note 101 *supra*.

<sup>105</sup>73 F. (2d) 370 (C. C. A. 5th, 1934), *rev'd* 1 F. Supp. 713 (N. D. Ga. 1932).

mination of renewal rights, the trend of judicial opinion indicates the following conclusions:

1. An ordinary assignment of the copyright in a particular work carries no right, legal or equitable, to the renewal term.
2. Where the renewal term is specifically assigned, or the intention that the assignee is to have the renewal term sufficiently indicated, the courts will impose a trust on the author in favor of the assignee should he apply for and obtain the renewal; and they will require a conveyance by the author to the assignee of the renewal term.
3. The assignee may never renew in his own name, although if he obtains a power of attorney from the author he may secure the renewal in the author's name and make a conveyance to himself, PROVIDED, the author survives the twenty-seventh year of the first term and is alive when the application is made. In the absence of such a power of attorney, a court of equity may require the author to renew and make a conveyance to the assignee.
4. If the author dies prior to the accrual of the renewal period the assignee of the renewal term will not be entitled thereto.
5. It is submitted that even though an author who has assigned his renewal term lives beyond the twenty-seventh year of the first term, if he dies prior to the making of the application for the renewal copyright, the assignee will not be entitled thereto if thereafter acquired by the author's widow, children, *etc.*
6. On application for specific enforcement of the assignment contract, the court may refuse to enforce the contract if it finds any over-reaching on the part of the assignee or deems the consideration inadequate in view of the unequal bargaining power of the parties.
7. The author may bequeath the renewal right by will, though it will be ineffective if he is survived by a widow or children who are alive at the time of the accrual of the renewal period. It is submitted that such disposition by will is effective even if made prior to the accrual of the renewal period, though subject to the rights of the widow and children.
8. It is submitted that the legatees may renew whether or not there is an executor.
9. The executor may renew in the absence of a widow or children, and even though the author died prior to the accrual of the renewal period. The executor holds the renewal term for the benefit of the legatees or next of kin.
10. It is submitted that the next of kin may renew, where they are beneficially entitled to the renewal term, even though there is an executor where the latter refuses to or fails to make prompt application for the renewal term.
11. The beneficiaries enumerated in the statute may assign away their interest in the renewal term in the same manner as the author, subject to similar restrictions, conditions, and limitations.
12. The proprietor of the copyright of a work made for hire is one who owns such a work when the renewal right accrues. He may

renew in his own name, and in the event of his death prior to such accrual, his legal heirs succeed to his rights in the renewal term.

13. Where a work was originally copyrighted by a corporation otherwise than as assignee of an individual author, or in the case of any posthumous, periodical, cyclopedic, or other composite work originally copyrighted by a proprietor, any proprietor at the time of the accrual of the renewal period may apply for and obtain the renewal.
14. Where a work is created through a common design of the contributors, renewal by one co-author inures to the benefit of all, and if any co-author be dead, to the benefit of those enumerated in the statute.
15. A renewal of a work created by a common design is a renewal of the entire work and not only of the part contributed by the person renewing.
16. Where a work is created by several as co-authors, the beneficiaries as named in the statute are entitled as tenants in common to the renewal term with renewing co-authors or co-beneficiaries.