

COMMON-LAW COPYRIGHT

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Sound recordings made before 1972 are governed by a confusing array of state-law protections, the most notable of these being common-law copyright. Although frequently treated as a pre-publication version of statutory copyright, common-law copyright has less in common with statutory copyright than is generally assumed, and these differences have real effects on copyright holders and broadcasters. This piece aims to take the measure of common-law copyright and demonstrate that it is a substantially broader doctrine than statutory copyright in terms of what rights it grants to creators. Given that satellite, internet, and terrestrial radio broadcasters are currently facing lawsuits seeking damages for transmission of pre-1972 sound recordings, particular attention is paid to the right of public performance at common-law, which does not obey statutory limitations but instead offers blanket protection to rights holders.

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I. INTRODUCTION

Sound recordings made before February 15, 1972,¹ are not protected in the United States by the federal copyright statute found at 17 U.S.C. 101 *et seq.* Instead, they are protected by a patchwork of state statutory and common-law protections.² These protections are most typically a

1. Referred to throughout as “pre-1972 sound recordings,” while sound recordings made on this date or after are referred to as “post-1972 sound recordings.” U.S. COPYRIGHT OFFICE, FEDERAL COPYRIGHT PROTECTION FOR PRE-1972 SOUND RECORDINGS (2011).

2. *Pre-1972 Sound Recordings*, in 2 NIMMER ON COPYRIGHT § 8C.03 (2017).

mix of common-law copyright, unfair competition, conversion, and right of publicity remedies, along with criminal statutes against the unauthorized commercial use of these sound recordings. While all but two states have these criminal statutes, the nature and scope of civil remedies is unclear. Most states recognize torts of unfair competition and for violation of the right of publicity, and other possible tort claims, but these causes of action require a showing of actions and harm above and beyond what is necessary to show copyright infringement.

This leaves the increasingly archaic doctrine of common-law copyright as the best remedy for holders of rights in pre-72 sound recordings. In the modern parlance, common-law copyright is a common-law right of control in works of authorship that have not been published, with “publication” used as a term of art.³ Under the 1909 Copyright Act in effect (as amended) through 1972, a work retained its common-law protection until it was published.⁴ This publication divested the work of common-law protection, but if the publication was made in compliance with the formalities of the 1972 Act, then the work was vested with federal copyright protection. However, until 1972, sound recordings were not eligible for federal copyright protection, even though the musical compositions they embodied were. In 1971 the federal copyright law was amended to provide that all sound recordings fixed on or after February 15, 1972, and thereafter would be eligible for federal copyright protection, but that no such rights would be granted to works fixed before that date. In 1976, a new copyright act was passed, abolishing the requirement of publication for copyright, and with it common-law copyright. However, the new statute provided an exception for pre-72 sound recordings, specifically providing that the statute did not preempt their protections under state law, including common-law copyright.⁵

Under a common-law model of copyright, state law controls the determination of whether such a “divestitive” publication that divests a work of common-law protection has occurred.⁶ Although a sale of

3. Louis D. Brandeis & Samuel D. Warren, *The Right to Privacy*, 4 HARV. L. REV. 193, 198 et seq. (1890).

4. In the eighteenth and early nineteenth century, attempts were made for a different sort of common-law copyright, one that endured after publication in complement to statutory copyright protection. In the United States post-publication common-law copyright was famously rejected by the Supreme Court in *Wheaton v. Peters*. *Wheaton v. Peters*, 33 U.S. 591 (1834). When common-law copyright is discussed in this article, it refers to pre-publication common-law copyright.

5. 17 U.S.C. § 301(c) (2012). The labels used to describe common-law copyright protections vary slightly. For the cases from the middle of the twentieth century, the litigants did not use “the label ‘common law copyright,’ but have rather been based either upon an asserted ‘property right’ or upon a theory of unfair competition.” Nimmer, *The Law of Copyright* § 35.22 (1975).

6. By contrast, the determination of whether a “divestitive” publication of the kind required for protection under earlier federal copyright statutes has occurred, is a question of federal law. See *infra* at

copies of an expressive work to the general public is generally considered a divestitive publication, courts in states that have considered the issue have generally held that the public sale of a record, CD, or digital download does not constitute publication that divests a work of its common-law copyright protection. California is the only state with a civil statute protecting copyright in pre-72 for sound recordings, and is generally considered to generally provide for analogous protection as common-law copyright. However, courts in only a minority of states have ever considered the issue of common-law copyright for sound recordings, leaving the question of what nationwide protection sound recordings have unclear.⁷ In addition, even if sound recordings are unpublished under state law, the scope of what rights and exceptions to those rights exist at common-law has been almost completely unexplored.⁸

This lack of clarity has been brought to the fore by a number of recent cases, most notably that of Flo & Eddie, the owners of the rights in the sound recordings of the Turtles, the group most famous for the song “Happy Together.” They brought suits in three jurisdictions – the Southern District of New York,⁹ the Central District of California,¹⁰ and the Southern District of Florida¹¹ – alleging violations of the forum state’s protections for pre-1972 sound recordings by Sirius XM Satellite Radio. After succeeding in the New York and California federal courts, and failing in the Florida federal courts, the question of what protection common-law offers sound recordings, and if that protection includes a right of public performance, is currently pending before the high courts of multiple states. In addition, other parties have brought suits asserting that the broadcast of pre-72 sound recordings on conventional (“terrestrial”) radio also violates the exclusive right of public performance in these recordings, even though no equivalent right exists in the federal copyright statute.

In order to determine once and for all whether a performance right exists at common-law, this piece will engage in a detailed exploration of

Part V(0).

7. PETER JASZI, PROGRAM ON INFORMATION JUSTICE & INTELLECTUAL PROP., PROTECTION FOR PRE-1972 SOUND RECORDINGS UNDER STATE LAW AND ITS IMPACT ON USE BY NONPROFIT INSTITUTIONS: A 10-STATE ANALYSIS, (2009), <https://www.loc.gov/programs/static/national-recording-preservation-plan/publications-and-reports/documents/pub146.pdf>; FEDERAL COPYRIGHT PROTECTION, *supra* note 1.

8. FEDERAL COPYRIGHT PROTECTION, *supra* note 1, at vii.

9. Flo & Eddie, Inc. v. Sirius XM Radio, Inc., No. 1:13-cv-05784-CM, 2016 BL (S.D.N.Y. filed Aug. 16, 2013).

10. Flo & Eddie, Inc. v. Sirius XM Radio, Inc., 2:13-cv-05693-PSG-GJS, 2016 BL (C.D. Cal. filed Aug. 06, 2013).

11. Flo & Eddie, Inc. v. Sirius XM Radio, Inc., 1:13-cv-23182-DPG, 2016 BL (S.D. Fla. filed Sept. 03, 2013).

the treatment—previously largely unknown—of the performance right for music under common-law, focused on the period before 1897 when the federal copyright act then in force did not yet grant an exclusive right of public performance to musical compositions. This involved a substantial degree of research into primary sources—both contemporary newspaper accounts and the actual case files now held at the National Archives. The results of this study are unambiguous—common-law copyright protects an exclusive right of public performance in an unpublished work, even if the work would not have such a right of public performance under the federal statute, and even if the work could not be protected by federal copyright at all, because it was authored by a foreigner before the passage of the statute instituting international copyright protection in 1891. This fact makes it difficult to avoid the conclusion that Sirius XM, Pandora, and even terrestrial radio stations, need to pay royalties to play sound recordings protected by common-law copyright, even if some state supreme courts have recently held the opposite.

Having examined the broader scope of the public performance right at common-law compared to its statutory analog, it is clear that an assessment of what exactly common-law copyright is, and what its rights and exceptions are, is clearly overdue. This piece thus aims to take common-law copyright seriously as a legal doctrine, one separate and distinct from its cousin statutory copyright. Although other scholarship has approached the question of common-law copyright for sound recordings, this piece aims to be the first to engage in a holistic exploration of what exactly common-law copyright is, and how it works as a freestanding legal doctrine. As this article will demonstrate, despite many similarities, common-law copyright and statutory copyright are more different than is commonly assumed, and one cannot simply apply caselaw and doctrines of statutory copyright to common-law copyright—it is necessary to consider what makes common-law copyright different first. To this end the structure of common-law copyright will be explored, both its exclusive rights and the nature of ownership and divestment by publication under state law.

Having explored the nature of common-law copyright in depth, examining how common-law copyright differs from statutory copyright in a host of areas, this article concludes with an assessment of what a deeper understanding of common-law copyright has to tell us about the nature and scope of statutory copyright. Common-law copyright differs from statutory copyright in that it relies on general common-law property doctrines, compared to the more limited grants of a federal statutory regime. However, the rights granted by the federal copyright statute are more similar to common-law copyright now than at any point

in the past, and this can offer insight into the eternal debate over the nature of the property grant in federal copyright.

II. THE ORIGINS OF COMMON-LAW COPYRIGHT IN THE UNITED STATES

A. The Linked Origins of Statutory and Common-Law Copyright

Scholars have argued that copyright emerged in England from the remains of the guild system and crown censorship, inevitably colored by the schism with the Catholic Church under Henry VIII.¹² In 1557, Queen Mary issued a charter to the Stationer's Company, and with that the regulation of books, in terms of what we would now describe as intellectual property, began.¹³ While the charter of the Stationer's Company is clearly focused on censorship of heretical (particularly anti-Catholic) material,¹⁴ the Stationer's Company quickly came to regulate the right to print particular books in England.¹⁵ In parallel to this, through the sixteenth and seventeenth century courts recognized a common-law right of the author to be paid for his writings by the publisher, and that the permission of the author was necessary to acquire a copyright in his work.¹⁶

In 1710, lobbying by the Stationers for continued protections culminated in the enactment of the first true copyright law, generally known today as the Statute of Anne.¹⁷ Although statutory copyright was created by the Statute of Anne, the booksellers who printed and sold books continued to argue that they separately retained a perpetual common-law copyright. The issue of whether common-law copyright survived publication continued to be fiercely fought in England, and it came to a head in two decisions in 1769 and 1774, finally establishing that common-law copyright could last no longer than the term of protection under the Statute of Anne.¹⁸

With copyright protection expressly enumerated as one of Congress's

12. LYMAN RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 20 (1968).

13. *Id.* at 28. The Stationer's Company had already existed since 1403 as a guild of "writers of textletter, illuminators, bookbinders, and booksellers." *Id.* at 29.

14. *Id.* at 31–32.

15. *Id.* at 42.

16. *Id.* at 65.

17. *Id.* at 143; 8 Ann. c. 19 (1709). Patterson notes that there were other censorship and licensing laws enacted in the century prior that functioned as de facto copyright laws, but the Statute of Anne is the first copyright law recognizable as an ancestor of modern copyright laws.

18. *Millar v. Taylor* [1769] 98 Eng. Rep. 201, 202; *Donaldson v. Becket* [1774] 1 Eng. Rep. 837; H. Tomás Gómez-Arostegui, *Copyright at Common Law in 1774*, 47 CONN. L. REV. 1 (2014). Although this section is necessarily abbreviated, the Gómez-Arostegui piece provides an excellent explanation of the major English cases of this era.

powers, the first Congress wasted no time and passed a copyright statute in 1790, “modeled very closely on the Statute of Anne.”¹⁹ However, it was nearly fifty years before the question of common-law copyright was tested in in the United States, in the case of *Wheaton v. Peters*, involving the copyright in the published reports of the U.S. Supreme Court.²⁰ The plaintiff was Henry Wheaton, the first official Reporter of Decisions for the Supreme Court, and at the time of the suit was serving as chargé d’affaires of the U.S. Embassy in Denmark.²¹ The defendant was Wheaton’s successor as reporter, Richard Peters, who had published a condensed version of the past reports of the Court—including those done by Wheaton—to great financial success.²² Wheaton accused Peters of infringing upon his copyright by incorporating Wheaton’s Reports of Supreme Court decisions between 1816 and 1827 into the Condensed Reports.²³ The plaintiffs argued that common-law entitled an author to a “perpetual property in the copy of his works, and in the profits of their publication.”²⁴

The Court concluded that there was no federal common-law copyright, and that Pennsylvania common-law did not recognize common-law copyright after publication. In reaching its conclusion that Wheaton’s rights at common-law were destroyed by publication, the court declined to find “a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.”²⁵ The author, under common-law, realized the fruit of his labor in the profits from the first publication, and the only way to enjoy post-publication profits was to have fulfilled the conditions for perfection of statutory copyright.²⁶ Thus, the Court confined common-law copyright to unpublished works, identified statutory copyright laws as the sole source of post-publication copyrights, and solidified the rationale for copyright as promoting creativity for the general welfare of society in accordance with the Copyright Clause.²⁷

19. R. Anthony Reese, *Innocent Infringement in U.S. Copyright Law: A History*, 30 COLUM. J.L. & ARTS 133, 148 (2007); see also Oren Bracha, *The Adventures of the Statute of Anne in the Land of Unlimited Possibilities: The Life of a Legal Transplant*, 25 BERKELEY TECH. L. J. 1427 (2010).

20. Jake Linford, *A Second Look at the Right of First Publication*, 58 J. COPYRIGHT SOC’Y U.S.A. 585, 605 (2011).

21. Craig Joyce, “A Curious Chapter in the History of Judicature”: *Wheaton v. Peters and the Rest of the Story (of Copyright in the New Republic)*, 42 HOUS. L. REV. 325, 351 (2005).

22. *Id.* at 358. Peters’ publisher John Griff was also a defendant.

23. *Wheaton v. Peters*, 33 U.S. 591, 593–95 (1834).

24. *Id.* at 654.

25. *Id.* at 657.

26. *Id.* at 657–58.

27. The Copyright Clause states: “To promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8.

B. The Development of Performance Rights at Common Law

The common-law performance right²⁸ grew organically out of the statutory copyright laws in place as courts struggled to determine where publication and infringement has occurred, partially out of necessity. The copyright statute did not include an exclusive right of public performance until the passage of the 1856 Dramatic Copyright Act,²⁹ which granted to the author or proprietor of a copyrighted dramatic work, in addition to the usual publication rights, “the sole right also to act, perform, or represent” such work.³⁰ The 1856 Act only included dramatic works, and musical works would not have an exclusive performance right until 1897.³¹ Although there were some attempts to argue that the 1856 Act included works with both dramatic and musical elements, these efforts met their end in 1885 in a case involving the famed operetta *The Mikado*, holding that the musical elements of the work could not be protected from unlicensed public performance under the statute then in force.³² However, the case of *The Mikado* was unusual, in that it involved putatively a composition by an American, who held a valid American copyright, and thus could claim the benefit of the 1856 Act.³³ Authors and composers who resided outside the United States and were not U.S. citizens could not receive copyright in the United States until 1891.³⁴

In the context of a weak 1856 Act, courts used common-law copyright to protect drama, and later music. The first decisions embracing a common-law copyright theory of performance rights came in 1860, in *Roberts v. Myers* and *Keene v. Kimball*.³⁵ In these cases the

28. This right has been referred to as “playright” by Eaton Drone in 1879 and was also the subject of a thorough study by Professor Jessica Litman. EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 553 (1879); Jessica D. Litman, *The Invention of Common Law Play Right*, 25 BERKELEY TECH. L.J. 1381 (2010). The narrative presented here is meant to complement Litman’s piece, which is essential reading on the subject.

29. Act of Aug. 18, 1856, 11 Stat. 138.

30. Act of Aug. 18, 1856, 11 Stat. 138, 139; see Litman, *supra* note 28, at 1403.

31. Zvi S. Rosen, *The Twilight of the Opera Pirates: A Prehistory of the Exclusive Right of Public Performance for Musical Compositions*, 24 CARDOZO ARTS & ENT. L.J. 1157 (2007).

32. *Id.* at 1175; *Carte v. Duff*, 25 F. 183 (C.C.S.D.N.Y. 1885). *The Mikado* case was an exceptional case where a valid American copyright existed in the piano arrangement—although the authors of *The Mikado* were British, they paid an American to transcribe the manuscript orchestral score into a published piano score, for which they received the statutory American copyright. This is how they were able to argue that they held performance rights under federal law.

33. Rosen, *supra* note 31, at 1172.

34. *Id.*; International Copyright Act of 1891, 26 Stat. 1106.

35. See *Roberts v. Myers*, 20 F. Cas. 898, 899 (C.C.D. Mass. 1860); *Keene v. Kimball*, 82 Mass. 545 (1860); see also Litman, *supra* note 28, at 1401. It is curious that no decisions are known from before 1856 where a common-law theory of performance rights was put forward. It is possible that *Wheaton v. Peters* had cast a pall on theories of common-law copyright, or simply that most of the plays

courts clearly distinguished the publication right from the performance right, explaining that “acting or representing is not a publication” and that the 1856 Dramatic Act “assumes the doctrine that representation is not publication.”³⁶ Because there had been no publication, the performance of the drama in question did not preclude the author from preventing others from performing his play.³⁷ Performance rights under common-law copyright did not depend on the citizenship or residence of the author, and courts protected works by British authors from unauthorized performance.³⁸

III. PERFORMANCE RIGHTS IN MUSIC BEFORE FEDERALIZATION

Although a statutory exclusive right of public performance had been created for dramatic works in 1856, no similar right of public performance existed for musical performances until 1897 in America.³⁹ All known cases from this era involving performance rights in music involved works produced by foreigners, where no statutory copyright could even be argued—except in the unique situation of Gilbert and Sullivan, where an end run around the statute was defeated in the Courts. This situation regarding foreigners would persist until 1891, and the federal statute was not amended until 1897 to grant performance rights to musical works.⁴⁰ This situation creates a natural laboratory for

being produced were British and not by Americans. Litman, *supra* note 28, at 1401.

36. *Roberts*, 20 F. Cas. at 898; see *Keene*, 82 Mass. at 549 (“The representation of a dramatic work upon the stage is not a publication which will deprive the author or his assignee of this [common-law] right of property.”).

37. See *Roberts*, 20 F. Cas. at 898; *Keene*, 82 Mass. at 549 (“[T]he performance of a play is not a publication which will prevent its proprietors from obtaining a copyright, or interfere with his right to resist its unauthorized publication by another.”).

38. *Palmer v. DeWitt*, 47 N.Y. 532 (1872); see also Litman, *supra* note 28, at 1408 n.168.

39. The 1856 Act was considered weak for its limited remedies, and the limitations of its remedies were more important to the passage of the stronger 1897 Act than was the 1897 Act’s inclusion of music. Rosen, *supra* note 31, at 1200.

40. *Id.* at 1167; An Act to Amend Title Sixty, Chapter Three, of the Revised Statutes of the United States, Relating to Copyrights, ch. 392, 54th Cong., 29 Stat. 694 (1897). Of course, an opera is a hybrid dramatic and musical work—in fact the Copyright Office called them dramatico-musical works for registration purposes in the first part of the twentieth century. See generally Catalog of Copyright Entries, 1909–1946. However, there is no evidence that operas were believed to have the same right of performance that pure drama had. In *The Mikado* case, the Court rejected a statutory performance right, noting that instrumental music could not be considered drama for purposes of the act, and noting that at most, the “literary part of an opera, together with the music of the voice parts, comprise all there is of the dramatic essence that lies in the action of the performers.” *Carte v. Duff*, 25 F. 183, 186–67 (C.C.S.D.N.Y. 1885).

The legislative history of the 1897 public performance act also suggests that opera was not considered drama for purposes of the public performance right until that point. Numerous drafts of the 1897 Act mentioned drama and opera as two separate categories of works that would be protected, and opera was changed to music in the final draft, suggesting that opera was not considered part of drama up to that point. Rosen, *supra* note 31, at 1201, 1206.

the scope of common-law copyright—in the 1880s works by foreign composers were widely performed in the United States, but these composers had no recourse under federal law. Their turn to common-law copyright—and the success of that strategy—shows that the performance right under common-law copyright does not obey the limitations of the federal statute, but rather that it functions as a general right of performance intrinsic to all creators and without limitation as to the type of work.

The cases discussed above regarding nonmusical dramas were fairly widely reported, and there are ample reported decisions. However, there is a second line of less-discussed cases and unreported dispositions, coupled with dicta from cases including *The Mikado* case, clearly showing that to the extent creative musical and operatic works remained unpublished, they retained an exclusive right of public performance at common-law. In order to excavate this forgotten history of performance rights in music in the era before any federal protection, it was necessary to go beyond the published decisions of the federal courts. A number of state-court decisions were published in the Copyright Decisions reporter published by the U.S. Copyright Office, and these fill an important gap in our understanding of performance rights for music in this period. Contemporary newspaper accounts are likewise a vital tool, informing us of injunctions and other dispositions—and their rationale—where no reported decision exists. Finally, for a number of important cases the original case file for the litigation was consulted at the National Archives, revealing invaluable information about business and litigation practice involving common-law copyright and music.

A. *The Origins of Common-Law Performance Right for Music*

As I have written about elsewhere, the famed English composers of light opera Gilbert and Sullivan were locked in constant litigation over their performance rights in the Americas upon the success of their operetta *H.M.S. Pinafore* in 1879.⁴¹ Although they had some initial success in litigation,⁴² they would find that common-law copyright offered them little protection because they had published both the piano score and the libretto in England, divesting these parts of the opera of U.S. Copyright.⁴³ Courts repeatedly held that impresarios were free to

41. Rosen, *supra* note 31, at 1169.

42. Gilbert & Sullivan v. Bacher & Boner, 14 C.O. Bull. 1068 (Pa. C.P. May 22, 1880) (enjoining publication of “Memories of Pirates of Penzance,” a book of tunes from *Pirates of Penzance* transcribed after attendance at a performance).

43. Carte v. Ford (*The Iolanthe Case*), 15 F. 439, 447 (C.C.D. Md. 1883); *Duff*, 25 F. at 183. However, in both cases the courts made clear that use of the unpublished orchestral scores of these

create their own orchestral scores from the published piano reductions, and as a result, so long as they did not use the manuscript orchestral score, they were not infringing the common-law rights of the composer.⁴⁴

Indeed, one constant of operatic practice in America for foreign works during the 1880s was the creation of the original orchestration from the piano score which had been published in Europe (and thus dedicated to the public domain). In litigation in 1885, one orchestrator employed by the Tivoli Opera House in San Francisco estimated that he had prepared some fifty orchestrations from piano reductions for performance.⁴⁵ Given the ubiquity of this practice, the legal rule was obvious to everyone at the time—that performance of the orchestra score that had been kept in manuscript and not published would be infringement of the common-law copyright performance rights of a composer, even though they lacked any such rights under the statute. The whole purpose of recreating the orchestration was to not fall afoul of common-law copyright.

B. Leo Goldmark Begins to Litigate

One of the first to realize the opportunity that common-law copyright offered was a New York attorney named Leo Goldmark. Although there were other such litigants, much of the major litigation involving a performance right at common-law for music in this decade involved Leo Goldmark and his partners, of whom the most frequent was Heinrich Conried. Leo Goldmark was part of a musical family from Hungary; notably his brother was Carl Goldmark, most famous in the nineteenth century for his opera *The Queen of Sheba*, although mostly remembered today for his Violin Concerto and *Rustic Wedding Symphony*.⁴⁶ After a stint as a cantor he moved to America in 1866, and after a number of jobs became an attorney.⁴⁷ Through his famous brother and other acquaintances he had access to many of the leading opera and operetta composers in Europe, and he seems to have used this to become assignee of performance rights for their works in America.

operettas would be an infringement of the composer's common-law rights. *Ford*, 15 F. at 442 (Plaintiff held "the sole right to use [Sullivan's] unpublished orchestration in the United States."); *Duff*, 25 F. at 184 (Gilbert and Sullivan "were well advised that, until publication of their manuscript, their exclusive right to multiply copies of their work and control its production upon the stage would be intact.").

44. Rosen, *supra* note 31, at 1176.

45. Lindtner. Aff., *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838).

46. *Guide to the Papers of the Goldmark Family 1832–1969*, LEO BAEK INSTITUTE (Jan. 3, 2014), <http://findingaids.cjh.org/?pID=476353>.

47. *Id.* Although he did not personally seem to have been a composer, he did write the libretto for an operetta entitled "1776" in the 1880s.

It is unknown which case was the first to be brought by Leo Goldmark, but it may have been his 1880 demands for injunctions against performances of adaptations of the German operetta *Seekadet* in Philadelphia and New York.⁴⁸ In New York, the trial court upheld the injunction, stating that a performance of the manuscript libretto was not permitted under the principles of common-law copyright.⁴⁹ While it was essentially admitted by the plaintiff that only the libretto (containing stage directions and interstitial dialogue as well as songs) was unpublished and thus protected by common-law copyright in this case, while the music had become public domain, Goldmark would seek to protect his rights at common-law in both the music and libretto to a large number of operas over the next decade.

In another reported decision in 1882, the Cook County Circuit Court in Chicago refused to dissolve its injunction of unauthorized performances of the Johann Strauss II operetta *A Merry War*.⁵⁰ As a general matter, the court asserted that “a dramatic or musical composition may be publicly performed, and no person, without the consent of the author, acquires thereby any right to make a similar use of it.”⁵¹ The court noted that when a work was published it lost that right, and that a piano reduction had been published of the music and songs.⁵² However, breaking with some of the other holdings of the day, the court held that a reconstruction of the opera by re-orchestrating the piano reduction was tantamount to performance of the manuscript opera, and thus infringed the common-law rights of the German composer and librettists and their American assignees.⁵³

In addition to these reported cases, there were many more cases that were not reported. Only a few weeks after the litigation over *Seekadet*, Goldmark successfully received an injunction and prevented a

48. The Philadelphia production was of an adaptation called *The Royal Middy at the North Broad Street Theater*, while the New York production was entitled *Very Merry Mariner*. N.Y. “*The Very Merry Mariner*,” N.Y. TIMES, Apr. 6, 1880, at 2; *Rights to a Libretto*, N.Y. TRIB., Apr. 6, 1880, at 2. Both lawsuits seem to have been brought in the New York Supreme Court. *Id.* There had been controversy over attempts to steal the score through surreptitious attempts at transcription a few weeks earlier. *Put Out of a Theatre*, N.Y. TRIB., Mar. 14, 1880, at 1 (describing an attempted transcription, ejection from the theatre, and subsequent lawsuit for assault against one of the ushers of the theater).

49. *Goldmark v. French*, 14 C.O. Bull. 1091 (N.Y. Sup. Ct. Apr. 5, 1880). There had been a hearing and a continuation of the temporary injunction issued in this case two weeks earlier. “*See Cadet*” in *Court*, N.Y. HERALD, Mar. 24, 1880, at 12.

50. *Goldmark v. Collmer*, 14 C.O. Bull. 1088 (Ill. Cir. Ct., Cook County, Nov. 1882). The injunction prevented the defendants from producing the opera in Chicago, St. Louis, or Milwaukee. *The Courts: Important Decision Regarding the Rights of Musical Composers*, CHI. TRIB., Nov. 2, 1882, at 7.

51. *Collmer*, 14 C.O. Bull. at 1089.

52. *Id.*

53. *Id.* at 1090.

performance of the opera *Fanchette* in Buffalo.⁵⁴ In 1882 he received an injunction against performance of *The Queen's Lace Handkerchief*, where the parties agreed to allow the performance to proceed provided royalties were held in escrow pending a disposition on the substance of the case.⁵⁵ On other occasions no litigation was needed, such as his licensing of the Johann Strauss II operetta *Prince Methusalem* to perform in New York the following year.⁵⁶ In yet another case the court denied an injunction sought by Augustin Daly against a performance of the opera *Apajune*, but only because it was not convinced Daly had valid legal title in the American common-law performance rights from Leo Goldmark, who the court recognized held the American performance rights to the work.⁵⁷

C. Goldmark v. Kreling

Two cases against the Kreling brothers who owned the Tivoli Opera House in San Francisco, of which substantial records have survived at the National Archives in San Rafael, California, offer a window into common-law copyright litigation in the 1880s. Taken together, they offer a convincing demonstration that common-law copyright contained a performance right, regardless of what rights the federal statute granted.

By September of 1885 Leo Goldmark had already brought twenty-six suits seeking to enjoin performance of an opera under a theory we would now recognize as common-law copyright.⁵⁸ Around then he learned that the operetta *Nanon* was being performed without authorization at the Tivoli. He first attempted to enter into a licensing scheme, offering to provide the manuscript score to the Krelings in return for 10% of the gross receipts.⁵⁹ These advances were rebuffed, and on September 18, 1885 Leo Goldmark and his partner Heinrich Conried brought a suit in the U.S. Circuit Court in San Francisco, alleging that a production of the opera *Nanon* at the Tivoli violated the rights they held at common-law in that opera.⁶⁰ The circuit court immediately granted a temporary restraining order against production of the opera and issued an order to show cause why an injunction should not be issued, and upon a failure to show cause the court issued an injunction against performance of the

54. *The Right to Play "Fanchette,"* N.Y. TIMES, Apr. 30, 1880, at 5.

55. *The Queen's Lace Handkerchief*, N.Y. HERALD, Oct. 22, 1882, at 13.

56. *Closing of the Cosmopolitan Theatre*, N.Y. HERALD, July 7, 1883, at 10.

57. *An Injunction Denied*, N.Y. TIMES, Feb. 21, 1882, at 3.

58. Petition for Reh'g, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838).

59. *Kreling Aff.*, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838).

60. Petition for Reh'g, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838). At the time this case was brought there was only one judicial district in the federal Courts in California, a situation that would change the following year. 24 Stat. 308 (Aug. 5, 1886).

opera.⁶¹ The willingness of the court to issue an injunction so readily certainly indicates that the plaintiffs were not presenting a far-fetched case.

Two weeks later the plaintiffs failed to provide adequate bond to continue the injunction, and the court dissolved it.⁶² The court further noted as a reason for dissolution of the injunction the recent decision from New York in *The Mikado* case, where the court had held that the composers and librettists had no rights to control the public representation of their published works.⁶³ In their petition for rehearing Goldmark and Conried argued that *The Mikado* case was distinguishable because it dealt with a published work, while *Nanon* was unpublished.⁶⁴

Kreling disputed this assertion. In a sworn affidavit, Kreling's staff orchestrator stated that he had orchestrated "about fifty" operas from the published piano score for performance at the Tivoli, including the opera *Nanon* at issue in this case, and made sure to state that he had made all of his arrangements without reference to the manuscript orchestral score.⁶⁵ In this affidavit there was no hesitation to admit that the published (German) song texts and piano score of *Nanon* had been used in this production, but it was vital for the defendant to deny any use of (or even exposure to) the manuscript orchestral score and libretto for *Nanon*, containing unpublished orchestration, stage direction, and interstitial dialogue.

Recognizing that it was an important legal question, Judge Sabin invited the other federal judges from California to sit with him on rehearing, leading to a three-judge panel hearing the motion to reinstate the injunction.⁶⁶ The judges made their decision from the bench, with Judge Sabin saying the case was one of first impression for the California federal court, and that he thought a playwright had the right to choose his licensee apart from copyright law.⁶⁷ This viewpoint was echoed by Judges Sawyer⁶⁸ and Hoffman,⁶⁹ again seemingly without reference to the publication status of the work. The injunction was

61. Petition for Reh'g, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838); "*Nanon*" – *Judge Hoffman Grants a Temporary Injunction*, S.F. CHRON., Oct. 2, 1885, at 2.

62. "*Nanon*", *supra* note 61, referencing dissolution of the injunction on October 16, 1885; *id.* at 5 (describing arguments made before Judge Sabin and noting that the hearing took almost the whole day).

63. *Id.* at 13. Petition for Reh'g at ¶ 13, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838).

64. *Id.*

65. *Lindtner Aff.*, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838). *Lindtner* states that it took him roughly six weeks to produce an orchestration of the published piano score.

66. *Goldmark v. Kreling*, 25 F. 349, 350 (C.C.D. Cal. 1885).

67. *Id.* at 351–52.

68. *Id.* at 356.

69. *Id.* at 360.

ordered reinstated subject to revised terms of the bond.

The opinion stated by the judges—that an author has a proprietary right to control dramatization regardless of the publication status of his work— was not consonant with the law at the time. Instead, both parties had been modeling their practices around what the law of common-law copyright actually was at the time— that authors and composers had a performance right in their work if it was unpublished regardless of whether the statute provided a remedy. This confusion was likely because this legal issue was one of first impression for the California court, and the case was barely a month old and had not had proper briefing or discovery yet.⁷⁰

With the injunction in place, the case became dormant for a number of years, until in 1888 the court—now the Circuit Court for the Northern District of California—had a chance to engage in a trial and have briefing on the legal issues.⁷¹ Although in 1885 the court had confusingly indicated that an author’s performance right under common-law survives publication, by 1888 the trial was clearly focused on a fact question, whether unpublished elements of *Nanon* were used in the Tivoli production.⁷² At trial a panel including Judges Sawyer and Hoffman from the 1885 hearing was joined by Supreme Court Justice Field, riding circuit.⁷³

In its decision the court indicated that it was not clear from the facts whether or not the publication of *Nanon* was with the assent of the composer and librettist, but that regardless the authors of *Nanon* had sent a manuscript copy to Goldmark and Conried and sold them the American rights, and that thus the common-law rights for America had vested and could not be destroyed by subsequent publication in Europe.⁷⁴ The court then examined the defense’s assertion that their version of *Nanon* was based on an old French play, and found that assertion was belied by the facts.⁷⁵ The Court held that the Krelings were not permitted to perform *Nanon* or advertise it as being the operetta *Nanon*, and that defendants only had rights in the pirate orchestral score that they had prepared.⁷⁶

70. *Id.* at 350.

71. *Footlight Flashes: An Important Decision on Copyright*, S.F. CHRON., July 15, 1888, at 3 (noting that the “case has been pending for a very long time.”).

72. *See generally* Brief for Defendants, *Goldmark v. Kreling*, 25 F. 349 (C.C.D. Cal. 1885) (No. 3838). The brief asserts that “the right of defendants to use the published portion of the Operetta is too plain for argument,” but does not assert any right to use the unpublished parts of *Nanon*. *Id.* at 2–3.

73. *Goldmark v. Kreling*, 35 F. 661 (C.C.N.D. Cal. 1888).

74. *Id.* at 662. This conclusion is questionable, and other Courts have not extended the doctrine of common-law copyright this far.

75. *Id.* at 662–63.

76. *Id.*

Obviously, this case stretched the bounds of common-law copyright farther than many other cases have done. However, what is pertinent is not the outer bounds of this decision but that it was uniformly agreed by all parties and the court that the manuscript orchestral score was sacrosanct because it was protected by common-law copyright. Any extension in the court's decision of common-law copyright onto work that had been published only serves to emphasize that at the core, no one doubted that a manuscript orchestral score could not be performed publicly without permission.

Following this decision, Goldmark and Conried achieved a judgment against the Krelings in New York State Supreme Court for performance of a number of the other operas to which they owned the performance rights.⁷⁷ However, efforts to collect on this judgment would stretch on for years. In 1891, the Krelings settled with Goldmark and his compatriots, agreeing to pay royalties for all future performances of operas they owned the rights to.⁷⁸ However, in 1892 Goldmark would bring another suit, alleging that the Tivoli had been performing these works without payment.⁷⁹ The action was dismissed by the plaintiffs, although when this dismissal was made is not indicated.⁸⁰ In late 1895 Goldmark and his allies brought another lawsuit, this one against the insolvent John Kreling and miscellaneous of his relatives, arguing that in anticipation of their judgment against him Mr. Kreling had fraudulently transferred his assets to family members, and demanded that those fraudulent transfers be avoided.⁸¹ It is unclear if Goldmark ever received even a fraction of what his lawsuit demanded.

D. French v. Kreling

Although Goldmark seems to have been the most prolific litigant for performance rights of operas, he was hardly the only one. For instance, the U.S. district court in Chicago enjoined production of an opera where the orchestration and full libretto had not been published, on common-law grounds.⁸² Another such case was almost certainly spurred on by

77. *An Attorney Criticized: J.D. Sullivan Doesn't Like H.H. Lowenthal's Methods*, S.F. CHRON., Feb. 9, 1894, at 9 (referencing an 1889 judgment by the New York Supreme Court).

78. Complaint of Leo Goldmark at 2–3, *Goldmark v. Kreling*, 25 F. 349 (C.C.N.D. Cal. 1892) (No. 11579).

79. *Id.* at 3. The operas listed as being illicitly performed were *Gypsy Baron*, *Beggar Student*, *Gasparone*, *De Fledermaus*, *Donna Juanita*, *Vice Admiral*, and the same *Nanon* as in the prior litigation.

80. Voluntary Dismissal, *Goldmark v. Kreling*, 25 F. 349 (C.C.N.D. Cal. 1892) (No. 11579).

81. *Charges of Fraud and Conspiracy, Creditors of John Kreling Sue*, S.F. CHRON., Dec. 22, 1895, at 27.

82. *Aronson v. Fleckenstein*, 28 F. 75 (C.C.N.D. Ill. 1886). In this case the songs and their words had been published, and the infringing opera was a product of an independent orchestration and

the success of Goldmark the previous year, and in 1886 Thomas French also sued Joseph and John Kreling, alleging that their production of the operetta *Falka* without payment of royalties violated his rights as the American assignee of the common-law copyright in the opera.⁸³ French was a music publisher based in New York who also was in the business of licensing common-law copyrights of foreign composers for production of their operas in America in exchange for royalties.⁸⁴ In response, the Krelings asserted a number of defenses, mostly focused on the assertion that the opera in the English translation at issue had already been published and widely distributed before the production commenced.⁸⁵

This case is unusual in that the transcripts of deposition testimony taken in this case survived in the case file in the National Archives.⁸⁶ These transcripts give unique insight into what claims and factual issues were presented to the court. William Kreling (who had since been added to the suit) testified that the orchestration used in their production of *Falka* had been made for them from the published piano score of the opera that they had purchased in a store.⁸⁷ However, the former stage manager at the Tivoli subsequently testified that the production had in fact used a manuscript of *Falka* that Joseph Kreling had procured from a licensed production in Chicago, containing unpublished elements of the production including “gags” to use during the production.⁸⁸ He further testified that the orchestral music was the same and the stage direction was similar in a licensed production using the manuscript score and stage directions.⁸⁹ Mr. French of the plaintiffs then testified that they had purchased the rights to *Falka* from the translator and paid him extensive royalties, and that the printed libretto only included the words and piano reduction to the songs, not the stage direction, dialogue, or

libretto based on these published songs, but the Court nonetheless held that the common-law protected against such a use of the title of an unpublished opera. *Id.* at 75–78.

83. Complaint of French at 3, French v. Kreling, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035). *Falka* was the English translation of the operetta *Le droit d'aïnesse*, with the original music by Francis Chassaing and an English translation of the libretto by Henry Farnie. The testimony given in this case repeatedly asks whether the Tivoli theater had used similar procedures (that had been found unlawful) in its production of *Nanon* that it used to produce *Falka*.

84. Testimony of Pyke at 5, French v. Kreling, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035). Technically this was not testimony but a leading question from French’s attorney, but the factual takeaway is clear.

85. Answer of John Kreling, French v. Kreling, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

86. On file at the National Archives, Regional Division, San Bruno CA.

87. Testimony of William Kreling at 778, French v. Kreling, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

88. Testimony of William F. Rochester at 38, French v. Kreling, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

89. *Id.*

orchestration.

The testimony of the translator/adaptor Henry Farnie and his publisher Alfred Hays clarified the publication status of *Falka* considerably.⁹⁰ Farnie testified that he had adapted the French opera substantially, using its music and the broad outlines of the plot, but adding characters, writing new dialogue between scenes, and making other changes.⁹¹ Hays testified that there had been two volumes printed—one containing the entire operetta, including orchestration, stage direction, dialogue between scenes, gags, and more.⁹² This was limited to a print run of twenty copies, and was kept from the public and was meant only for use in rehearsal.⁹³ The other version was printed and widely sold, but only had the words and the piano reduction to the songs.⁹⁴

The fact that a copy of the full unpublished manuscript was in the possession of the defendants in this case would prove fatal before the court. The manuscript in particular indicated that it was the property of one of the actors in an authorized domestic production, a fact which did not escape the notice of the court. In their bill requesting relief the plaintiffs limited their argument almost entirely to reference to the *Nanon* case brought by Goldmark,⁹⁵ and the court agreed. Mostly reciting the evidence presented, the court concluded without extensive analysis that the plaintiff's rights in *Falka* had been violated and found in their favor.⁹⁶ Shortly thereafter, the parties reached a stipulated settlement, where they agreed that the Krelings would desist from any further performance of an opera whose rights were owned by French, and would pay French \$250.⁹⁷ It is unclear how much the litigation had cost the parties over the previous eight years.⁹⁸

As noted above, by 1895 John Kreling was insolvent. Although the Tivoli Opera House would continue to operate during these years, in 1903 the city declared the building a "firetrap" and condemned it.⁹⁹ Although it was rebuilt, it did not reopen after the earthquake of 1906.¹⁰⁰

90. Interrogatories of Farnie and Hays, *French v. Kreling*, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

91. *Id.* Bill in Equity at 4, 6, *French v. Kreling*, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

92. *Id.*

93. *Id.*

94. *Id.*

95. Bill in Equity at 13, *French v. Kreling*, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

96. *French v. Kreling*, 63 F. 621, 621–23 (C.C.N.D. Cal. 1894).

97. Stipulation and Settlement, *French v. Kreling*, 63 F. 621 (C.C.N.D. Cal. 1892) (No. 4035).

98. The plaintiff was based in New York, and deposed there, while a number of interrogatories were taken in London, with service through the American Consul there.

99. JAMES R. SMITH, *SAN FRANCISCO'S LOST LANDMARKS* 108 (2005).

100. CALIFORNIA IN THE 1930S: THE WPA GUIDE TO CALIFORNIA THE GOLDEN STATE 152 (1939).

E. The Wagner Operas

Although the lawsuits with the Krelings seem to have occupied the greatest energy of any one lawsuit, Goldmark continued to be a prolific litigant through the 1890s. Also in 1885, the Courts in New York, Chicago, and Milwaukee enjoined performances of both the opera *The Black Hussar* and the song “Read the Answer in the Stars.”¹⁰¹ The New York Supreme Court repeatedly granted both temporary and permanent injunctions against performances of operas to which Goldmark owned the common-law rights.¹⁰² Not only was he successful in lawsuits he owned the American common-law rights for, but Courts recognized that he had a real and valuable set of rights under common-law.¹⁰³ By 1890, “Goldmark & Conried’s Author’s & Composer’s International Agency” was doing business with a letterhead indicating “manuscript works only.”¹⁰⁴ Common-law performance rights in opera had become serious business.

Goldmark’s greatest catch in terms of common-law rights, at least putatively, was the rights to perform the operas of Richard Wagner in the United States. In 1887 Goldmark wrote a “somewhat bewildering” letter to the *New York Tribune*, informing them that he had “sole and exclusive right and ownership of all the operas of the deceased composer for America and Australia.”¹⁰⁵ The *Tribune* explicated on their bewilderment, noting that “inasmuch as the scores and parts of all the Wagner’s operas . . . can be bought in Germany without the slightest difficulty . . . it is not easy to imagine over what rights Mr. Goldmark is

101. *Read the Answer in the Stars*, N.Y. HERALD, Jul. 3, 1885, at 8. In defiance of that injunction Sydney Rosenfeld continued to promote his production of that opera in Chicago and Milwaukee, including that song, leading Goldmark to expend considerable cost to receive injunctions against Rosenfeld in those cities. *Plays and Players*, CLEVELAND PLAIN DEALER, Jan. 30, 1887, at 4; *Troubles of “The Black Hussar,”* CHI. TRIB., Oct. 30, 1885, at 5. Upon his return to New York, Rosenfeld was found liable to the attorney’s fees in receiving the injunctions. *Id.* One irony is that Goldmark and Conried has been among those who helped Rosenfeld pay off his fine for unauthorized representation of *The Mikado* two years prior. Rosen, *supra* note 31, at 1175.

102. *Theatrical Injunctions*, N.Y. HERALD, Apr. 2, 1886, at 9; *May Play “The Bat,”* N.Y. HERALD, Mar. 21, 1887, at 4 (the manager of a theater had agreed to pay for the rights to various operas including “The Bat” by Johann Strauss Jr., but had refused to pay and had further performances enjoined); *Theatrical Injunctions*, N.Y. HERALD, Apr. 2, 1886, at 9 (injunctions against performances of *Nanon* and *The Beggar Student* made permanent); *The “Queen of Sheba” in Court*, N.Y. TIMES, Mar. 13, 1886, at 8 (enjoining a performance of the famous opera by Goldmark’s brother).

103. For instance, in 1887 the New York Supreme Court granted Goldmark an attachment on the property of the German composer of *The Trompeter of Sackingen*, who had been granted Goldmark the American common-law rights, but who had then negotiated a separate agreement with the Metropolitan Opera without Goldmark’s involvement. *Quarreling Over an Opera*, N.Y. WORLD, Dec. 9, 1887, at 1.

104. Letters from Leo Goldmark to Augustin Daly, Augustin Daly Papers, Folger Shakespeare Library (1889, 1890) (copies on file with author).

105. *Musical and Dramatic Notes*, N.Y. TRIB., June 25, 1887, at 4.

to exercise control.”¹⁰⁶

While there was skepticism as to the genuineness of Goldmark’s rights, he was successful at first before the courts, winning a temporary injunction against a production of *Lohengrin* in 1890.¹⁰⁷ However, when he and Conried sued for an injunction against performances of any of Wagner’s operas, this request was opposed.¹⁰⁸ Instead of winning a quick injunction or payment, Goldmark was instead bogged down in a lengthy lawsuit, including an international discovery process.¹⁰⁹ A short time thereafter it was discovered that most of Wagner’s works had already been published in England, destroying any common-law copyright that might exist.¹¹⁰ A much more limited contract between Goldmark and the Metropolitan Opera was signed instead, acknowledging that no rights existed in America but voluntarily paying minor royalties.¹¹¹ It does not seem that Goldmark would engage in litigation significant enough to make the papers again.

F. The Close of the Golden Age of Opera Litigation

By the middle of the 1890s, the laws began to change to give owners of musical works additional protections against the unauthorized performance of their compositions. The most notable of these changes was the enactment of the 1897 Act creating an exclusive right of public performance for musical compositions under a federal law.¹¹² In addition, in the years immediately after the enactment of the 1897 Act, a significant number of states enacted laws creating criminal liability for the unauthorized performance of an unpublished work.¹¹³

In 1897, seeing that a right of public performance for musical compositions was likely nigh, Goldmark and Conried registered the operas they owned the rights to for copyright with the Library of Congress.¹¹⁴ The following year, they assigned all interest in these

106. *Id.* Restatements of this understanding of the common-law performance right are not hard to find. In 1891 Goldmark himself stated them in this form, explaining that he had been asked to act as the American rightsholder for the opera *Cavalleria Rusticana*, but had replied that if it had been published, there would be nothing to protect. *Cavalleria Rusticana Again*, N.Y. TRIB., Sep. 4, 1891.

107. *A Monopoly of “Lohengrin,”* N.Y. HERALD, Oct. 28, 1890, at 10.

108. *German Opera in Dispute*, N.Y. TRIB., Dec. 25, 1891, at 7; *Are Wagner’s Operas Free*, N.Y. HERALD, Dec. 26, 1891, at 7.

109. *The Courts*, N.Y. TRIB., Jan. 1, 1892, at 3.

110. MONTROSE J. MOSES, *THE LIFE OF HEINRICH CONRIED* 236 (1916). Publication anywhere in the world would destroy common-law copyright, whether in England or elsewhere.

111. *Id.*

112. Act of Mar. 3, 1897, Ch. 392, 29 Stat. 694 (1897).

113. Rosen, *supra* note 31, at 1205 n.361. New Hampshire enacted its law in 1895, and it is still on the books today. N.H. REV. STAT. ANN. § 352:1 (1895). The others were passed between 1899 and 1905.

114. *The Beggar Student*, U.S. Copyright No. 9150; *The Black Hussar*, U.S. Copyright No. 9787; *Libretto to Merry War*, U.S. Copyright No. 15600; *Dorothy*, U.S. Copyright No. 12060; *Amorita*, U.S. Copyright No. 15914; *Prince Methusalem*, U.S. Copyright No. 17505; *Manon*, U.S. Copyright No.

copyrights to Carl Herrmann, thus leaving the business of opera lawsuits.¹¹⁵ By 1900 Leo Goldmark was deeply in debt, with his property in foreclosure.¹¹⁶ His partner Heinrich Conried, by contrast, would continue to bring a number of these suits, including one involving the operas of Johann Strauss II,¹¹⁷ although the volume of this litigation seems to have lessened. Conried would ascend yet higher, and became director of the Metropolitan Opera in 1903.¹¹⁸ As director of the Metropolitan Opera his previous arrangements with the Wagner estate would come back to haunt him, when Wagner's heirs sued him to prevent a performance of the opera *Parsifal* on numerous bases, one of which was estoppel based on his contract with Wagner's heirs a decade previous.¹¹⁹ Although such suits would continue to periodically appear, the existence of statutory remedies largely left the common-law opera performance lawsuits as a thing of the past.¹²⁰

Nonetheless, the 1909 Copyright Act was careful to preserve common-law rights.¹²¹ Three years later, in its 1912 decision in *Ferris v. Frohman*, the U.S. Supreme Court affirmed the general consensus that had already existed among various state and federal courts for half a century—that performance was not publication, and a work retained common-law rights after it was performed.¹²² Thus, the doctrine of

19644; Donna Juanita, U.S. Copyright No. 22549; The Royal Middy, U.S. Copyright No. 24074; The Gypsy Baron, U.S. Copyright 33363; A Night in Venice, U.S. Copyright No. 42133, The Fledermaus, U.S. Copyright No. 42294. It is not clear if these works were registered as published or unpublished works.

115. 19 COPYRIGHT ASSIGNMENTS 99-111 (Copyright Office, Jan. 20, 1898). Interestingly, while discussing the pending copyright revision that would become the 1909 Act, Nathan Burkan asked the Register of Copyrights whether the opera *The Beggar Student* had been deposited with the Copyright Office by Conried, Herrmann, “or by one Goldmark.” Letter from Nathan Burkan to Thorvald Solberg, Register of Copyrights, Oct. 18, 1907.

116. *Business Troubles*, N.Y. TIMES, Aug. 8, 1900, at 10 (indicating a judgment entered against him for \$6,381 by T.B. Burnham, presumably Thomas Brownell Burnham); *Foreclosure Sales*, N.Y. TRIB., Jun. 8, 1900, at 12.

117. *Conried v. Witmark*, 76 N.Y.S. 690 (Sup. Ct. App. Div. 1902) (granting leave to file a supplemental answer).

118. MOSES, *supra* note 110, at 175.

119. *Wagner v. Conried*, 125 F. 798, 801 (C.C.S.D.N.Y. 1903). In that case the court refused to enjoin a performance of *Parsifal* on a common-law copyright theory, noting that the opera had been fully published, but ordered further fact-finding on the estoppel claim.

120. *Savage v. Hoffmann*, 159 F. 584, 586 (C.C.S.D.N.Y. 1908) (refusing to enjoin performance of a song from the opera *The Merry Widow* by Lehar as common-law rights had been extinguished by publication, and noting that publication and availment of statutory performance rights in the opera's orchestration extinguishes common-law performance rights).

121. Act of March 4, 1909, Pub. L. No. 60-349, § 2, 35 Stat. 1075 (1909) (repealed by the Copyright Act of 1976) (“That nothing in this Act shall be construed to annul or limit the right of the author or proprietor of an unpublished work, at common-law or in equity, to prevent the copying, publication, or use of such unpublished work without his consent, and to obtain damages therefor.”).

122. *Ferris v. Frohman*, 223 U.S. 424, 435 (1912) (“The public representation of a dramatic composition, not printed and published, does not deprive the owner of his common-law right, save by

performance right as a separate right from the right of first publication continued to hold strong, even after the passage of a more robust Copyright Act in 1909.

IV. THE REVIVAL OF COMMON-LAW COPYRIGHT FOR SOUND RECORDINGS

Even as litigation over common-law performance rights in operas was raging, technologies for recording sound via physical media were being developed at a rapid clip. It would not be long before these technologies would begin to interact with the badly outdated copyright law, and these confused legal reactions are the foundations of the problem of common-law copyright for sound recordings today.

A. The Origins of Sound Recordings

Attempts to record sounds in a tangible medium date to 1857, to the phonograph of Édouard-Léon Scott de Martinville, which depicted sound waves as undulations on smoke-blackened paper or glass.¹²³ This was the first of a number of attempts to fix sound waves in a tangible way, but it was not until the 1877 invention by Thomas Edison of the phonograph that sound recordings could be both recorded and played back.¹²⁴ Edison had originally intended his invention for use recording spoken words (much like a Dictaphone), and the cylinders it created could only be played back once. However, in 1887 Emile Berliner patented the gramophone, which played flat discs which could be mass-produced and played repeatedly. In the mid-1890s gramophone-style discs began to be sold, and quickly became popular.¹²⁵ Within a decade after the various cylinder technologies that sprung from Edison's phonograph had been driven out of business, and flat discs became the dominant paradigm for the distribution of recorded sound.¹²⁶ By the end of the First World War, making records was a \$150 million business.¹²⁷ This first "golden age," fueled by the dance craze featuring such steps as the foxtrot, would last until the record business faced its first major

operation of statute.”).

123. Jody Rosen, *Researchers Play Tune Recorded Before Edison*, N.Y. TIMES (Mar. 27, 2008), www.nytimes.com/2008/03/27/arts/27soun.html.

124. ANDRE MILLARD, *AMERICA ON RECORD: A HISTORY OF RECORDED SOUND* 24 (2d ed. 1995).

125. DAVID L. MORTON, JR., *SOUND RECORDINGS: THE LIFE STORY OF A TECHNOLOGY* 36 (2004).

126. *Id.* at 33.

127. *Id.* at 64.

crisis in the early 1920s with the arrival of radio.¹²⁸

The acoustic recording process in use until 1925, although it improved over time, involved severe compromises, requiring adjustments on the part of the performers and substitution of certain instruments to produce an acceptable sound quality.¹²⁹ Perhaps due to these issues, alternative systems for the mechanical reproduction also became popular around this time, just as sound recordings were entering their first heyday.¹³⁰ Although music boxes and similar devices had existed for centuries beforehand, the player piano (or pianola) powered by pneumatic action in conjunction with a perforated roll was made practical only in 1887.¹³¹ After a few years of technological developments, including the miniaturization of the mechanism and the combination of the player mechanism with the ability to play the pianola as a regular piano, sales exploded, with some 2.5 million player pianos sold between 1900 and 1930, with a peak between 1910 and 1925 in the U.S.¹³²

Between 1901 and 1903 the librarian of the Metropolitan Opera in New York, Lionel Mapleson, made a series of semi-unauthorized recordings of the Met's live performances using a phonograph he had been given by Edison in person, earning the title the "Father of Bootlegging."¹³³ Such incidents aside, though, it does not seem that record piracy was a major problem in this era, owing to the difficulty of copying discs or making live recordings.¹³⁴ Player piano rolls at this time were the subject of greater piracy, no doubt in part due to a comparative lack of technological challenges in their reproduction.¹³⁵

128. SUSAN SCHMIDT HORNING, CHASING SOUND: TECHNOLOGY, CULTURE & THE ART OF STUDIO RECORDING FROM EDISON TO THE LP 32 (2013).

129. *Id.* at 17. The acoustic recording process involved directing sound towards a horn, without any microphones or amplification. *Id.* at 20.

130. Musical culture would also shift as part of this shift to mechanical music, as it shifted away from being a participatory activity into a passive one. *See, e.g.*, John Philip Sousa, *The Menace of Mechanical Music*, APPLETON'S MAG., Sept. 1906, at 278; Patrick Warfield, *John Philip Sousa and "The Menace of Mechanical Music,"* 3 J. SOC. FOR AMER. MUSIC 431 (2009).

131. ARTHUR W.J.G. ORD-HUME, PIANOLA: THE HISTORY OF THE SELF-PLAYING PIANO 24 (1984).

132. *Id.* at 28, 39.

133. CLINTON HEYLIN, BOOTLEG: THE SECRET HISTORY OF THE OTHER RECORDING INDUSTRY 28 (1994). These recordings have been described as "probably the worst-sounding collection of live performances ever recorded," but retain importance as historical documents of operatic performances over one hundred years ago. *Id.*

134. *Id.* at 30. Until Edison introduced the idea of gold-plating the master cylinder in 1901, making copies of cylinders without degradation of fidelity was very difficult, and there would be another decade of advances in reproduction technology before a standard method was reached. MORTON, JR., *supra* note 125, at 27–28. Even so, all of these methods relied on using a reinforced "master" cylinder for reproduction. *Id.*

135. HEYLIN, *supra* note 133, at 24.

However, the major copyright issue of the era was whether the reproduction of a musical composition by mechanical means constituted an infringement of that musical composition. These cases manifested themselves quickly, and in 1888 a court held that a perforated roll for use in an “organette” was not a copy of the sheet music.¹³⁶ As of 1888 the exclusive rights in a musical work were limited by the Copyright Act of 1870 to “printing, reprinting, publishing, completing, copying, executing, finishing, or vending,” and thus if a piano roll was not a copy, it did not infringe the exclusive rights of a copyright holder under the 1870 Act.¹³⁷ The issue next arose in 1900 in the context of an actual sound recording, where a wax cylinder manufacturer was sued by the copyright holders in two pieces of music, alleging that the cylinders he was manufacturing were copies of their copyrighted musical compositions.¹³⁸ After a demurrer was granted by the trial court dismissing the case, the plaintiffs argued that these wax cylinders violated both their statutory and common-law rights in their musical compositions.¹³⁹ In 1901 the Court of Appeals of the District of Columbia affirmed the dismissal of this case, holding that a sound recording did not infringe the copyright in the musical composition being performed.¹⁴⁰ With this decision that consensus had become fairly clear that mechanical reproductions that could not be read by humans were not copies of musical works, and thus their creation and sale did not violate the 1870 Copyright Act.¹⁴¹

In 1902, the Aeolian Company made a concerted effort to collect rights to popular musical compositions for reproduction via its patented

136. Kennedy v. McTammany, 33 F. 584 (C.C.D. Mass. 1888); *Copyright - Adaptation of Sheet Music to Organettes*, 2 HARV. L. REV. 50 (1888). The case was appealed to the U.S. Supreme Court, but the parties failed to comply with Supreme Court rules for printing the record, and the case was abandoned. *Revision of Copyright Laws: Hearings Before the Comm. On Patents of the S. and H.R. on Pending Bills to Amend and Consolidate the Acts Respecting Copyright*, 60 Cong. 218 (Mar. 26–28, 1908) (statement of Nathan Burkan). An English court reached a similar conclusion in 1899. *Kennedy*, 33 F. 584; *Boosey v. Whight* [1899] 1 Ch. 836.

137. 16 Stat. 198, 212 (1870). A public performance right for music was added in 1897. Rosen, *supra* note 31, at 1165.

138. Brief for Appellants at 1–3, *Stern v. Rosey*, 17 App. D.C. 562 (D.C. Cir. 1901) (No. 1005). The Complaint alleges that Rosey had made some 5,000 cylinders—the record does not reveal how these copies were made. *Id.* at 3.

139. It was perhaps a sign of the desperation of their case that the brief of the Plaintiff-Appellants spent a substantial portion of their brief attempting to re-argue *Wheaton v. Peters*. *Id.* at 4–7. It seems that the Plaintiffs did not attempt to argue for common-law protection until their appeal. *Id.* at 3–4.

140. *Stern*, 17 App. D.C. at 562.

141. Not everyone was pleased with the result—for instance the *American Lawyer* stated that “a very good brief” might be offered for the contrary position in this case, and that Rosey’s cylinders were “manifestly a literary piracy.” *Is the Copyright in a Musical Composition Infringed by its Phonographic Reproduction*, 9 AM. LAW. 153 (Apr. 1901).

“pianola.”¹⁴² “The purpose of the arrangement as was quite clear: Because Aeolian player piano rolls could only be played on Aeolian pianolas, if Aeolian held the exclusive rights to mechanical performance of major musical compositions, excessive prices could be charged for rolls and pianolas, and independents could be run out of the business.”¹⁴³ As noted there was already legal precedent that no such rights existed under copyright law, but the Aeolian company funded litigation to challenge these precedents, with the large music publisher White-Smith as named plaintiff.¹⁴⁴ The case was brought against The Apollo

142. *Hearing on S. 6330 and H.R. 19853 Before the H.R. Comm. on Patents, conjointly with the S. Comm. on Patents*, 59 Cong. 127–128 (1906) (Statement of H.N. Low Esq. of Washington D.C.); Howard B. Abrams, *Copyright's First Compulsory License*, 26 SANTA CLARA COMPUTER & HIGH TECH. L.J. 215, 220 n.23 (2009).

143. 1 PATRY ON COPYRIGHT § 1:45. While this is the conventional version of the story, Aeolian issued a largely forgotten pamphlet that confirmed some of these charges and denied others. Nathan Burkan, *The Charge that the Passage of the Copyright Bill, Senate Bill 6330, Will Create a Monopoly in the Manufacture of Automatic Musical Devices is False* (Jan. 8, 1907). According to Burkan, Aeolian entered into a number of contracts in early 1902 with music publishers, having seen the decisions in *Kennedy v. McTammany* and *Stern v. Rosey*, and fearing it faced massive retroactive liability if those decisions were not reversed (or merely the cost of fighting such suits, although that was not mentioned). *Id.* at 1–3. The deal Aeolian reached with these music publishers was that they would bear the expense of bringing a lawsuit to establish that a piano roll was in fact a copy of a musical composition, and would pay royalties from the date of such a decision forward, but would not be liable for any infringement up to the date of such a decision. *Id.* at 4. The pamphlet further argues that even if the court ruled in favor of White-Smith, Aeolian would not have a monopoly on piano rolls, and that the contracts signed had no application to the separate market of sound recordings. *Id.* at 6–14. A pamphlet issued by a group lead by the composer Victor Herbert made similar claims, admitting that Aeolian had funded the suit but asserting that the contracts with Aeolian were of short duration (five to ten years), and that the music publishers would be amenable to terms that would foreclose the possibility of a monopoly. Harry D. Kerr, *Copyright Legislation: An Answer to the Argument of the Manufacturers of Phonographs and Other Mechanical Reproduction Devices*, THE AMERICAN AUTHORS AND COMPOSERS COPYRIGHT LEAGUE (1907) (pamphlet, copy on file with author); NEIL GOULD & VICTOR HERBERT: A THEATRICAL LIFE 214 (2011). According to this pamphlet, Aeolian had already expended between forty and fifty thousand dollars on the suit, or almost a million dollars adjusted for inflation in 2016. Kerr, *id.* at 4. In response, the other piano manufacturers reiterated the position that Aeolian had signed contracts with essentially all music publishing houses, and that Aeolian would have a monopoly for thirty-five years should the law pass. *The Copyright Bill: Statement of the Special Committee of the National Piano Manufacturers Association of America* (Nov. 15, 1907) (pamphlet, copy on file with author).

144. Abrams, *supra* note 142, at 220; *White-Smith Music Pub. Co. v. Apollo Co.*, 139 F. 427, 429 (C.C.S.D.N.Y. 1905); *White-Smith Music Pub. Co. v. Apollo Co.*, 147 F. 226 (2d Cir. 1906); *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908). The case began as two separate but simultaneously filed complaints on June 2, 1902, alleging infringement of the song “Kentucky Babe Schottische” and a companion piece “Little Cotton Dolly (Plantation Lullaby).” *White-Smith Music Pub. Co.*, 209 U.S. at 8–9. The piece was presumably chosen both due to popularity and clear title—both pieces had been assigned to White-Smith and White Smith had registered the pieces with the Copyright Office. “Kentucky Babe Schottische” was registered with the Copyright Office on November 25, 1896, and had been popular, selling approximately 80,000 copies. Deposition of Walter M. Bacon at 26, *White-Smith Music Pub. Co. v. Apollo Co.*, 139 F. 427 (C.C.S.D.N.Y. 1902) (No. 8126). The expectation was that “Little Cotton Dolly” would be similarly successful, and royalties had been paid to the composer for 7,739 copies sold as of October 10, 1902, along with 13,100 copies of the quartette version sold without royalties, providing evidence that at least the requisite amount of \$5,000 was in

Company of New Jersey in June 1902, which had earlier that year sold an agent of White-Smith piano roll copies of two songs copyrighted by White-Smith.¹⁴⁵

By 1905, the trial court reached its decision, and it joined the previous case law in holding that the transcription of a musical composition on a piano roll was not an infringement of the copyright in that composition.¹⁴⁶ The court first held that infringement requires the production of a copy.¹⁴⁷ The court then held that “[t]he words ‘musical composition’ undoubtedly relate to the intellectual conception of the composer; but . . . a careful reading of the copyright law . . . indicates that protection only of the material semblance in which the musical composition finds expression is afforded.”¹⁴⁸ In other words, even though a musical composition is an incorporeal intellectual construction, it is only protected to the extent it is fixed in a tangible medium of expression.¹⁴⁹ Looking back to *Burrow-Giles v. Sarony*, the court held that the Constitution only permitted copyright protection for works “by which the ideas in the mind of the author are given visible expression.”¹⁵⁰ Given that piano rolls were neither “copies” within the meaning of the statute, nor “writings” within the meaning of the Constitution, they could not be infringing on the copyright in the underlying musical composition, and judgment was entered for the defendant. Implicit was that piano rolls could not be protected by

controversy. *Id.* at 9; Deposition of James Maguire at 16, *White-Smith Music Pub. Co. v. Apollo Co.*, 139 F. 427 (C.C.S.D.N.Y. 1902) (No. 8126).

145. Deposition of Adolf L. Janson, 139 F. 427 (C.C.S.D.N.Y. 1902) (No. 8127). Although Abrahms and others assert that this case was a test case, Janson’s testimony suggests otherwise. As an initial matter, it seems that the intended target of the litigation was the manufacturer of the piano rolls or the corporation that made the Apollo Organette used to play them. However, Janson’s testimony revealed that the defendant was really just a regional sales agent for the Melville Clark Piano Company, which made the Organettes, and the rolls were made by the QRS Company, both of which were based in Chicago. *Id.* Clark was a major innovator in the player piano market and inventor of the Apollo-type player piano. Jere DeBacker, *Melville Clark Piano Company*, MECHANICAL MUSIC REGISTRY PROJ., <http://www.mechanicalmusicpress.com/registry/apollo/apollo.htm> (last visited June 17, 2017). QRS was another company he founded and continues to operate to this day making piano rolls, the only remaining company of its kind. *The History of QRS Music Technology*, QRS MUSICAL TECHNOLOGIES, INC., <https://www.qrsmusic.com/history.asp> (last visited June 17, 2017).

146. *White-Smith*, 139 F. at 429.

147. *Id.* The case cited, *Perris v. Hexamer*, is a Supreme Court case that is really about the idea/expression dichotomy. In that case in which a fire map of Philadelphia was asserted to infringe the copyright in a fire map of New York because they used similar legends and symbols, but the Court held that no copying had occurred so there was no infringement. *Perris v. Hexamer*, 99 U.S. 674 (1878); Zvi Rosen, *How Perris v. Hexamer Was Lost in the Shadow of Baker v. Selden*, 68 *Syracuse L. Rev.* 231 (2018).

148. *White-Smith*, 139 F. at 430.

149. This is really just a restatement of the idea/expression dichotomy.

150. *White-Smith*, 139 F. at 430 (*id.* quoting *Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53 (1884)).

copyright altogether. This decision was affirmed the following year by the still fairly new Second Circuit Court of Appeals, in a per curiam opinion bereft of citations.¹⁵¹ The case had been attracting substantial attention, and it unsurprisingly found its way to the United States Supreme Court.

Against the backdrop of this litigation, and the specter of the Aeolian Company cornering the market in rolls for player pianos, the gears had already begun turning on a law that would become the most significant change to American copyright law since at least 1831. In the waning days of the Fifty-Eighth Congress in early 1905, the Librarian of Congress was asked to convene a conference to prepare a copyright law to be introduced in the following session of Congress.¹⁵² Three conferences on copyright were held in 1905 and 1906 bringing together copyright stakeholders, and by 1906 a bill drafted by Thorvald Solberg, then the Register of Copyrights, was under consideration before Congress.¹⁵³ While the revision of the copyright law was motivated by concerns far beyond the mechanical reproduction of music, the issue was of concern, especially following a number of statements at congressional hearings in 1906.¹⁵⁴ However, Congress failed to pass a new law in the Fifty-Ninth Congress, and roughly a month into the Sixtieth Congress the Supreme Court heard oral argument in the *White-Smith* case.¹⁵⁵

The Supreme Court, in an opinion by Justice Day, upheld the ruling of the circuit court dismissing the case.¹⁵⁶ The rationale of the decision largely embraced the rationale of the trial court—copyright law granted an exclusive right to make a copy of the printed sheet music, but a piano roll is only a copy of the abstract musical composition embodied in that sheet music.¹⁵⁷ In addition, it had been twenty years since the circuit court in Massachusetts had decided the *Kennedy* case, and Justice Day found the lack of legislative response to that decision (as well as *Stern v.*

151. *White-Smith Music Pub. Co. v. Apollo Co.*, 147 F. 226 (2d Cir. 1906).

152. Letter from Senator A. B. Kittredge, Chairman of the Senate Committee on Patents, to the Librarian of Congress, Herbert Putnam, urging the Librarian to call a conference “for the purpose of preparing a complete copyright law for consideration at the next session of Congress,” Apr. 10, 1905, reproduced at Legislative History of the 1909 Copyright Act at M5.

153. Calendar, Legislative History of the 1909 Copyright Act, xvii to xix.

154. Abrams, *supra* note 142, at 220.

155. *White-Smith Music Pub. Co. v. Apollo Co.*, 209 U.S. 1 (1908). The Petition for Certiorari is dated October 31, 1907, well after the Fifty-Ninth Congress had ended that March. Cert Petition in Records and Briefs. The delay of a year and a half from the decision of the Second Circuit Court of Appeals on May 25, 1906, suggests that the parties may have expected a legislative resolution to the issue, and turned to the Supreme Court when that was not forthcoming.

156. The decision came a little over a month later, in the middle of February 1908. *Id.*

157. *Id.* at 17.

Rosey and cases overseas) significant.¹⁵⁸ In closing, Justice Day recognized that this decision “enables the manufacturers thereof to enjoy the use of musical compositions for which they pay no value.”¹⁵⁹ However, he asserted that such concerns were properly addressed to the legislature, not the Court.¹⁶⁰

Justice Holmes concurred specially—not disputing the judgment but taking issue with the assertion that the copyright law as drafted protected only literal copying of what had been deposited for protection under the statute. Instead, he urged that a work should “be protected according to what was its essence,” and that thus “[o]n principle anything that mechanically reproduces that collocation of sounds ought to be held a copy, or, if the statute is too narrow, ought to be made so by a further act.”¹⁶¹ In this concurrence, coupled with his opinion for the Court five years earlier in *Bleistein*, Justice Holmes saw the future of copyright law with a clarity not necessarily matched by his colleagues.

Although the *White-Smith* decision forestalled concerns of a monopoly, the Court’s recognition of the injustice of denying composers compensation for the mechanical reproduction of their music was an indication that legislative change was coming. Although there continued to be opposition to a mechanical reproduction right, the following year Congress passed a full overhaul of the copyright system, and in so doing instituted a requirement that royalties for mechanical reproductions of musical compositions be paid at a statutorily determined rate.¹⁶² Although the owners of musical compositions would be paid for mechanical reproductions under the new compulsory license, mechanical reproductions themselves were intentionally excluded from this statutory revision, and offered no protection under federal copyright law.¹⁶³

158. *Id.* at 14.

159. *Id.* at 18.

160. *Id.*

161. *White-Smith*, 209 U.S. at 19 (Holmes, J., concurring).

162. *Abrams*, *supra* note 142, at 220–21; Copyright Act of 1909, Pub. L. 60-349, 35 Stat. 1075 (Mar. 4, 1909; repealed Jan. 1, 1978).

163. The decision of the court in *Aeolian Co. v. Royal Music Roll Co.* is frequently cited for the proposition that “under the provisions of the copyright law, such music rolls or records are not strictly matters of copyright.” 196 F. 926, 927 (W.D.N.Y. 1912). While in that case the court actually enjoined a rival music roll publisher from making copies of Aeolian piano rolls, subsequent decisions would recognize this as being part of a separate doctrine, permitting mechanical reproductions of musical compositions only if they were similar— i.e., new recordings—rather than being identical. *Jondora Music Pub. Co. v. Melody Recordings, Inc.*, 506 F.2d 392, 395 (3d Cir. 1974); *Piracy on Records*, 5 STAN. L. REV. 433, 445 (1953) (“The Aeolian case has never been expressly overruled. But it is doubtful if record companies find much comfort in it today.”). In any case, the Copyright Office consistently refused to grant registration to sound recordings under the 1909 Act. BARBARA A RINGER, STUDY NO. 26: THE UNAUTHORIZED DUPLICATION OF SOUND RECORDINGS 5–6, 86TH CONG. (Comm. Print 1957).

B. Sound Recordings Under the 1909 Act

With a new law, composers would quickly move to assert their rights in mechanical reproductions, while the shift towards radio in the 1930s produced a complicated array of warring factions over who claimed a right to profit from music. Although federal protection for sound recordings was proposed numerous times beginning in 1925, no such law would be passed for decades.¹⁶⁴ Against this backdrop, the chief importance of sound recordings to musicians was that they competed against live music for radio time. This would be especially true as the record business was almost entirely consumed by radio in the 1920s, with proceeds from records sales dropping from \$106 million in 1921 to \$6 million in 1933.¹⁶⁵ After the Second World War, by contrast, studio recordings would replace live music in the public imagination, and tape piracy would become a major concern. In order to understand the major decisions regarding sound recordings in the twentieth century, it is necessary to understand the milieu and interests from which these cases arose.

1. Composers and Broadcasters

With the inclusion of the mechanical reproduction provisions in the 1909 Act, efforts began quickly to collect royalties for public performances of musical compositions. In 1913, composer Victor Herbert heard an unlicensed performance of music from one of his Broadway shows playing in a New York restaurant and brought suit.¹⁶⁶ Restaurant, cabaret, and hotel owners united against the copyright holders, but composers and songwriters did likewise, forming the American Society of Composers, Authors, and Publishers (ASCAP) in 1914 by composers including Victor Herbert and John Philip Sousa, as well as by copyright attorney Nathan Burkan.¹⁶⁷ The organization was created to collect a “performance royalty” payment whenever one of their songs was played in a public forum for profit.¹⁶⁸

164. *Id.* at 21–37; Benjamin Kaplan, *Performer’s Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409, 410 n.3 (1956).

165. CATHERINE S. CORRY, *THE PHONOGRAPH RECORD INDUSTRY; AN ECONOMIC STUDY* 10 (1965) (statistics taken from Billboard).

166. Richard W. Ergo, *ASCAP and the Anti-Trust Laws: The Story of a Reasonable Compromise*, 1959 DUKE L. J. 258, 259 (1959). This case has been called a test case, although evidence has not generally been provided for this proposition. Carl William Doozan, *Infringement of Copyright Musical Compositions by Radio Broadcasting*, 14 NOTRE DAME L. REV. 430, 431 (1939) (see rules 16.7.3 & B8.1).

167. Robert Israel Goodman, *Music Copyright Associations and the Antitrust Laws*, 25 IND. L.J. 168 (1949).

168. BRUCE POLLOCK, *A FRIEND IN THE MUSIC BUSINESS: THE ASCAP STORY* 1 (2014).

The litigation arising out of this restaurant dispute, *Herbert v. Shanley Co.*, confirmed the right of an individual copyright owner to receive compensation for the public performance of their work, even when (like in a restaurant) no admission fee was charged for entering a venue.¹⁶⁹ The Supreme Court held even though diners had not been charged admission,

The defendants' performances are not eleemosynary. They are part of a total for which the public pays, and the fact that the price of the whole is attributed to a particular item which those present are expected to order is not important. It is true that the music is not the sole object, but neither is the food, which probably could be got cheaper elsewhere. The object is a repast in surroundings that to people having limited powers of conversation or disliking the rival noise give a luxurious pleasure not to be had from eating a silent meal. If music did not pay it would be given up. If it pays it pays out of the public's pocket. Whether it pays or not the purpose of employing it is profit and that is enough.¹⁷⁰

After this decision the federal courts interpreted the public performance right to apply to radio broadcasts of copyrighted compositions,¹⁷¹ reproduction of radio broadcasts from loudspeakers in hotel lobbies,¹⁷² performances in movie theaters, and performances in dance halls.¹⁷³

While ASCAP was pushing for increased payments on behalf of musicians, the National Association of Broadcasters (NAB) was pushing back against them on behalf of the radio industry.¹⁷⁴ NAB believed that composers were indebted to the broadcasters for publicizing their compositions via the airwaves.¹⁷⁵ Rather than sit back, NAB went on

169. Ergo, *supra* note 166, at 260.

170. *Id.*; *Herbert v. Shanley Co.*, 242 U.S. 591, 594–95 (1917).

171. Ergo, *supra* note 166, at 260; *Witmark & Sons v. Bamgerger & Co.*, 291 F. 411 (6th Cir. 1925).

172. Ergo, *supra* note 166, at 260; *Buck v. Jewell-LaSalle Realty Co.*, 283 U.S. 191, 195–196; 202 (1931).

173. Ergo, *supra* note 166, at 260; *Witmark & Sons v. Pastime Amusement Co.*, 298 F. 470 (E.D.S.C. 1924).

174. John Cirace, *CBS v. ASCAP: An Economic Analysis of a Political Problem*, 47 *FORDHAM L. REV.* 277, 287 n.62 (1978). NAB is a trade organization, founded in 1924 in direct response to ASCAP's fight for performance royalties, and its principal cause is to protect the rights of those in the broadcasting industry. POLLOCK, *supra* note 168, at 33; *National Association of Broadcasters Records, 1938–1982*, WISCONSIN HISTORICAL SOC'Y, <http://digicoll.library.wisc.edu/cgi/f/findaid/findaid-idx?c=wiarchives;view=reslist;subview=standard;didno=uw-whs-us0156af;focusrgn=bioghist;cc=wiarchives;byte=439535307> (last visited June 17, 2017).

175. Cirace, *supra* note 174 at 287, n. 62.

the offensive and launched an aggressive legal campaign against ASCAP to annihilate the performance royalty and the organization as a whole.¹⁷⁶ One mechanism through which NAB tried to accomplish these goals was through the passage of state laws which prohibited blanket licensing, or putting a tax on ASACP compositions, and were colloquially known as “anti-ASCAP” statutes.¹⁷⁷

2. The Musicians

With the songwriters and broadcasters at war, the situation would only be further complicated by the emergence of the American Federation of Musicians (AFM) as a potent policy force.¹⁷⁸ After decades of growth, by the 1940s the AFM represented nearly all professional musicians in the United States and Canada.¹⁷⁹ Throughout the 1920s musicians began appearing live on radio programs, performing in studio while the radio station would broadcast the concert.¹⁸⁰ At first these broadcasts created new jobs for musicians and the performers happily played for free, accepting publicity as adequate compensation.¹⁸¹ The practice of playing for free was short-lived though, as the AFM quickly began to negotiate wage scales between local radio stations and the AFM local chapters (Locals).¹⁸² Soon after these negotiations began, radio stations discovered that recordings could serve as a substitute for live performance. Faced with the prospect of paying for live music, radio stations used recordings more frequently, often presenting them in a manner that gave the audience the false impression the music was being performed live.¹⁸³ The use of sound recordings had a devastating impact on musicians’ employment rates and by the late 1930s over half of the music played on American radio was recorded, taking jobs away from “staff orchestras” and other live musicians.¹⁸⁴

In 1937, AFM’s local Chicago president James Petrillo declared war

176. GARY A. ROSEN, *UNFAIR TO GENIUS: THE STRANGE AND LITIGIOUS CAREER OF IRA B. ARNSTEIN* (2012).

177. Cirace, *supra* note 174, at 287 n.62.

178. ROBERT D. LEITER, *THE MUSICIANS AND PETRILLO* 17 (1953).

179. Mindy Schwartz, *The American Federation of Musicians: An Unearned Encore for Featherbedding*, 47 WAYNE L. REV. 1339, 1342 (2002).

180. LEITER, *supra* note 178, at 67.

181. *Id.*; Robert A. Gorman, *The Recording Musician and Union Power: A Case Study of the American Federation of Musicians*, 37 SW. L.J. 697, 699 (1983).

182. *Id.*

183. *Id.*

184. Christopher Milazzo, *A Swan Song for Live Music?: Problems Facing the American Federation of Musicians in the Technological Age*, 13 HOFSTRA LAB. L.J. 557, 559 (1996).

against radio and recorded music.¹⁸⁵ He proclaimed that Chicago Local AFM Members were no longer allowed to “make recordings or transcriptions unless the union was assured ‘that there would be an end to the menacing threat of canned music.’”¹⁸⁶ Petrillo’s Chicago policies gained traction at the AFM’s annual convention in 1937, which subsequently gave its mandate to AFM national president Joseph N. Weber to begin an economic war against the encroachment of recorded music.¹⁸⁷ On behalf of the union, Weber crafted a set of demands, and after weeks of negotiation Weber reached a deal with the key radio stations of the three networks and the independent network affiliates, requiring a significant increase in the size of radio staff orchestras.¹⁸⁸ In 1938 Weber also reached similar “quota” agreements with unaffiliated stations that negotiated via the National Committee of Independent Broadcasters.¹⁸⁹ The 1938 agreements Weber made with recording companies required them all to put a restrictive label similar to “only for noncommercial use on phonographs in home” on each record.¹⁹⁰ The purpose of these labels was to establish an “equitable servitude” in the musical recordings, so that the musicians could enjoy their use in radio broadcasts.¹⁹¹

3. The Bandleader Cases

Thus far unmentioned in the players of the radio wars were the leaders of the “big bands,” who were the era’s biggest musical acts. Although they were comparatively minor players compared to AFM (with whom they were generally allied on radio issues), ASCAP, or NAB, it was the bandleaders who were able to assert common-law copyright in their recordings, and thus through their efforts the foundational cases on common-law copyright were decided.

The impetus for the organization of the bandleaders was Maurice Speiser, a prominent Philadelphia attorney with a deep appreciation for

185. Schwartz, *supra* note 179, at 1343; Gorman, *supra* note 181, at 702–03.

186. Schwartz, *supra* note 179; Milazzo, *supra* note 184, at 560 (citing Gorman, *supra* note 181, at 703).

187. Gorman, *supra* note 181; Maggie Schreiner, *Guide to the American Federation of Musicians, Local 802 Records WAG.038*, THE TAMMINGTON LIBRARY & ROBERT F. WAGNER LABOR ARCHIVES (2014), http://dlib.nyu.edu/findingaids/html/tamwag/wag_038/bioghist.html.

188. ABC was not in existence yet at the time of these negotiations. *Id.*

189. LEITER, *supra* note 178, at 69, 70.

190. Gorman, *supra* note 181, at 703.

191. *Id.* In an unpublished letter from Sydney Kaye, counsel to NAB, to Harvard Law Professor Zechariah Chafee, Kaye argued against federal protection for sound recordings, since all the benefit would go to the AFM. Letter from Sydney Kaye, NAB Counsel, to Zachariah Chafee, Professor at Harvard Law School (Oct. 29, 1945) (copy on file with author).

music and the arts generally.¹⁹² Speiser became inspired by the greater European legal protections for performing artists when he translated French attorney Robert Homburg's *Legal Rights of Performing Artists* in 1934.¹⁹³ Differences between U.S. law, limited in scope and lifespan, and French copyright law were significant;¹⁹⁴ and for centuries European states afforded authors and artists legal protections beyond those provided by the United States.¹⁹⁵ These protections included "moral rights", the right to contest false attribution, the right to withdraw work from public view, and the right to prevent disfigurement of works after purchase.¹⁹⁶ Speiser's translation laid out several theories which could be employed by the courts to establish a property right in a performer's recorded performance, and Speiser hoped to introduce these broad protections to the United States.¹⁹⁷

Motivated by the prospect of providing stronger copyright protection for musicians, in 1935 Speiser formed the National Association of Performing Artists (NAPA) with some of the most prominent bandleaders of the time including Fred Waring,¹⁹⁸ Paul Whiteman, Bing Crosby, and Guy Lombardo.¹⁹⁸ Waring was subsequently elected president of the group, and the organization pursued a "claim of ownership rights for recording musicians."¹⁹⁹ At the time, live bands commonly gave performances on the radio, with broadcasters playing their music directly from the in-studio concert.²⁰⁰ The group saw recorded music as an increasing threat to live performance, with Waring stating, "I felt it unfair . . . for them to have our records playing in competition to us, and it was a growing menace to all performers."²⁰¹

192. Jill M. Jividen, *Power of Attorney: Business and Friendship Between Ernest Hemingway and Maurice J. Speiser* 16–17 (2008) (unpublished Ph.D. dissertation, University of South Carolina).

193. Harry P. Warner, *Unfair Competition and the Protection of Radio and Television Programs II*, 1950 WASH. U. L. REV. 498 (1950); see R. HOMBURG, *LEGAL RIGHTS OF PERFORMING ARTISTS* (1934).

194. Alex S. Cummings, *From Monopoly to Intellectual Property: Music Piracy and the Remaking of American Copyright, 1909–1971*, J. AM. L. HIST. 659 (2010).

195. See Kurt Newman, *RCA v. Whiteman: Contested Authorship, Copyright, and the Racial Politics of The Fight for Property Rights in Musical Recordings in the 1930s* 18 (unpublished abstract, University of California Santa Barbara).

196. *Id.*; see Vern Countryman, *The Organized Musicians II*, 16 U. CHI. L. REV. 128, 251–52 (1949).

197. *Id.*

198. ALBIN J. ZAK III, *I DON'T SOUND LIKE NOBODY: REMAKING MUSIC IN 1950S AMERICA* 20 (2010).

199. *Id.*

200. Jon M. Waxman, *Performance Rights in Sound Recordings*, 52 TEX. L. REV. 42, 44 (1973).

201. ZAK, *supra* note 198; see VIRGINIA WARING, *FRED WARING AND THE PENNSYLVANIANS* 138 (1997). One avenue that Speiser took was to attempt registration of a sound recording with the Copyright Office, but the application was denied by the Register of Copyrights. Plaintiff's Exh. No. 3 at 151a, Letter from the Office of the Register of Copyrights to Fred Waring (Aug. 22, 1925), Waring v.

NAPA's ultimate mission was to regulate the use of commercial sound recordings on the radio, using the growing frustration among musicians to garner support.²⁰² The opportunity for NAPA emerged when phonograph record manufacturer RCA-Victor began printing "Not Licensed for Radio Broadcast" on each disc they produced.²⁰³ Despite these labels, the radio station WDAS in Philadelphia continued to broadcast Waring's recordings over the radio. Speiser subsequently filed suit against WDAS on behalf of Waring in Pennsylvania state court for these broadcasts, and *Waring v. WDAS* was tried in 1936. Waring sought an injunction against the radio station, reasoning "the typical purchaser does not buy a record of just a song; he buys a record of someone's interpretation of that song," and through NAPA, Waring's goal was to "add to the copyright law the *Right of Interpretation*."²⁰⁴

The trial court held "that common-law literary property rights are not lost unless the act claimed to be a publication is indicative of an intent to abandon or dedicate to the public."²⁰⁵ In other words, if copyright did not protect the works, then the selling of records could not be a publication because the creator of those sound recordings would not want to lose protection. This approach turns the concept of publication on its head, but the court noted that "the discussion [of common-law copyright] turns very little on our main problem," which was whether the notation "Not Licensed for Radio Broadcast" printed on the discs was enforceable.²⁰⁶ The court found that this notation created an enforceable equitable servitude, and thus created a valid bar to their being played on the radio.²⁰⁷ WDAS was thus enjoined from broadcasting Waring's recordings.²⁰⁸

WDAS appealed the decision, and a year later the case was brought before the Supreme Court of Pennsylvania.²⁰⁹ Writing for the court, Justice Horace upheld the district court ruling, noting that the property

WDAS Broadcast. Station, Inc., 327 Pa. 433 (1937) (No. 9053).

202. Newman, *supra* note 195, at 20.

203. Columbia and Brunswick were partners with RCA and were also responsible for printing the "Not Licensed for Radio Broadcast" onto the discs.

204. Zak, *supra* note 198, at 20; *see* WARING, *supra* note 201, at 139.

205. *Waring v. WDAS Broad. Station, Inc.*, 27 Pa. D. & C. 297, 311 (Com. Pl. 1936).

206. *Id.* at 313.

207. *Id.*; Zechariah Chafee, Jr., *Equitable Servitudes on Chattels*, 41 HARV. L. REV. 945, 956 (1928). The trial court also found for Waring under a theory of unfair competition, following the doctrine from *Fonotipia Ltd. v. Bradley*, which found the copying of records to be unfair competition, looking to stock-ticker and ticket-scalping cases. 171 F. 951, 961-62 (C.C.E.D.N.Y. 1909). The other major point of reference is the always-troublesome decision of the Supreme Court in *INS v. AP*, holding that a news story was protectable under a doctrine of unfair competition, even if copyright did not provide relief. *Int'l News Serv. v. AP*, 248 U.S. 215 (1916).

208. *Waring v. WDAS Broadcast. Station, Inc.*, 327 Pa. 433 (1937).

209. *Id.*

rights claimed by Waring were not covered by existing copyright laws, and that therefore it was necessary to turn to the common-law in order to seek a remedy. However, in fashioning a remedy, the court continued the trial court's conflation of common-law copyright, contract, and unfair competition law. Explaining this synthesis, the court held that the recordings made by Waring's orchestra were protected by common-law and the question was whether "the publication effected by the making and sale of the records [could] be limited in its generality so as to enable plaintiff to prevent their use for broadcasting."²¹⁰ The court's rationale is that if a publication was not truly general then common-law continued to protect the records, and the restriction against radio play could be enforced. The court stated a test for general publication, looking both to the "objective character of the dissemination and partly to the proprietor's intent in regard to the relinquishment of his property rights."²¹¹

While it is easy to imagine the response as to whether Waring intended to abandon his rights, the court never fully addresses the question of publication in this case, and instead moved on to the question of notice regarding radio play, finding it enforceable as a reasonable restriction on the use of records.²¹² Implicit was that the court was concerned that cases like *Bobbs-Merrill Co. v. Straus* would control and prevent the effectiveness of the restrictive covenant, either through the first sale doctrine or statutory preemption.²¹³ In a concurrence, Justice Maxey agreed that Waring's rights were violated, but thought that the relevant legal doctrine was the right of privacy, not unfair competition.²¹⁴

Shortly after the triumph over WDAS, Waring successfully enjoined radio station WMFD in Wilmington, North Carolina from playing electrical transcriptions of musical renditions of his orchestra in *Waring v. Dunlea*.²¹⁵ The court's decision was much shorter than in the *WDAS* case, and once again made clear that the "public sale of the authorized records does not forfeit the common-law right in the sound track fixation of the recorded performance."²¹⁶ However, the backlash in both North and South Carolina was swift and immediate. The decision was handed down on January 25, 1939, and on February 2, 1939, a bill was

210. *Id.* at 443.

211. *Id.* at 444.

212. *Id.* at 445–48.

213. 210 U.S. 339 (1908).

214. *Waring*, 327 Pa. at 456–64 (Maxey, J., concurring).

215. *Waring v. Dunlea*, 26 F. Supp. 338 (E.D.N.C. Jan. 25, 1939); Bill of Complaint, *Waring v. Dunlea*, 26 F. Supp. 338 (E.D.N.C. Jan. 25, 1939).

216. *Waring*, 26 F. Supp. 338; COPYRIGHT AND RELATED TOPICS, A CHOICE OF ARTICLES (The Los Angeles Copyright School & The UCLA School of Law eds., 1964).

introduced in the North Carolina Senate to abolish common-law copyright for sound recordings and permit the free playing of phonograph records on the radio.²¹⁷ South Carolina had already introduced such a bill on January 18, 1939, and managed the feat of having their bill go through both state legislatures by February 16, 1939.²¹⁸ The North Carolina bill abrogating the result in *Waring v. Dunlea* similarly became law on March 16, 1939.²¹⁹ In 1941, Florida would include a similar measure in a broad anti-ASCAP statute, which would be repealed in 1977.²²⁰

With the *Waring* victories under its belt, NAPA continued to pursue a slew of cases against small radio broadcasters and weak opponents in an attempt to develop the doctrine of common-law copyright for recording artists.²²¹ RCA was concerned that the accumulating NAPA victories would set a precedent that musicians held continuing rights in their sound recordings (and not the record companies), and believed they had to combat this by asserting their own rights in these recordings. In 1937 RCA intervened in several California cases, where Wayne King and Jan Garber had brought suit against Warner Bros. Broadcasting Corporation to stop the broadcasting of their phonograph records.²²² RCA intervened to establish that artists “[d]id not have property rights in records [and] that if they ever had any such property rights they had been transferred to RCA,” while also proving that “RCA had a special property right of its own in its records . . . and that the use of phonograph records for broadcast purposes infringes this property right and constitutes unfair competition.”²²³ In other words, in theory RCA agreed with the

217. N.C. S.B. 95, ch. 113 (Mar. 15, 1939); N.C. S. J. 148 (Feb. 2, 1939).

218. S.C. H.B. 46, (Jan. 18, 1939), S.C. H. J. (1939). It remains in force. Repeal of common-law rights in phonograph records to restrict use or collect royalties on commercial use after sale, S.C. Code Ann. § 39-3-510. Although the trial court held firmly that this barred any common-law rights in sound recordings, and thus recordings were not protected against unlicensed copying, this view was repudiated (over a dissent) by the South Carolina Supreme Court. *Columbia Broad. Sys., Inc v. Custom Recording Co., Inc.*, 1971 WL 16649, at *1 (S.C. C.P. Sept. 25, 1971), *rev'd sub nom.* *Columbia Broad. Sys., Inc. v. Custom Recording Co.*, 189 S.E.2d 305 (S.C. 1972).

219. N.C. S.J. 411 (Mar. 16, 1939). It remains in force. Prohibition of rights to further restrict or to collect royalties on commercial use, N.C. Gen. Stat. Ann. § 66-28. As in South Carolina, this law has been held to only apply to performance of sound recordings, not to reproduction. *United Artists Records, Inc. v. E. Tape Corp.*, 19 N.C. App. 207, 212 (1973).

220. *Restricting Use of Musical Compositions*, Fla. Laws Ch. 20991, § 1, 1941 (repealed 1977). Although the Florida statute is discussed as being repealed in 1977, this does not necessarily mean any specific intent by the State of Florida to repeal the common-law copyright provisions—the repeal was of all the anti-ASCAP statutes. It seems far more likely that Florida repealed its anti-ASCAP statutes to comply with the preemption provisions of the new Federal copyright act, passed in 1976 but not in force until 1978.

221. Newman, *supra* note 195, at 25; *see, e.g.*, *Nat'l Ass'n of Performing Artists v. Wm. Penn Broad. Co.*, 38 F. Supp. 531 (E.D. Pa. 1941).

222. *Id.* at 26.

223. Newman, *supra* note 195, at 27.

underlying cause of action, but felt it belonged to them, not to the artist who made the recordings.

Another opportunity arose when Paul Whiteman, a popular bandleader, sought an injunction against WNEW, a New York radio station, for broadcasting a number of recordings he made for the RCA label, hoping to build upon the holding from *Waring v. WDAS*.²²⁴ RCA intervened, arguing that if any rights were violated by the broadcasting of these recordings, those rights belonged to RCA rather than Whiteman.²²⁵ After WNEW elected to not defend the case, the litigation became limited to RCA's action against Whiteman.²²⁶ RCA stated the "use of RCA's records by other for profit" constituted a "wrongful exploitation of its property rights" and further alleged that WNEW was guilty of "breach of contract resulting from violation of a restrictive covenant."²²⁷ Specifically pointing at Whiteman, RCA claimed the bandleader was attempting to "exploit, as his own, property rights belonging to [RCA]" by licensing records for broadcasting and public performances himself.²²⁸

At trial, the court addressed an issue that previous courts had avoided—whether a radio station could play Whiteman's records if no notice prohibiting airplay was provided.²²⁹ The court suggested that the very form of publication of a record might be seen as carrying an implicit notice that it was not licensed for radio play, but did not base its holding upon this supposition.²³⁰ This holding instead once rested upon the theory of unfair competition, and the court enjoined WNEW from playing Waring's recordings.²³¹

The case was swiftly appealed by all parties, to the Second Circuit Court of Appeals, where in a decision by Learned Hand, common-law copyright for sound recordings seemed to meet its Waterloo.²³² Judge Hand reasoned that Whiteman did in fact have property rights in his sound recordings, but the "common-law property" in these performances ended with the sale of the records" at which time the

224. Steve Gordon & Anjana Puri, *The Current State of Pre-1972 Sound Recordings: Recent Federal Court Decisions in California and New York Against Sirius XM Have Broader Implications Than Just Whether Satellite and Internet Radio Stations Must Pay for Pre-1972 Sound Recordings*, 4 NYU J. INTELL. PROP. & ENT. L. 336, 352–53 (2015); Newman, *supra* note 195, at 27.

225. *RCA Mfg. Co. v. Whiteman*, 28 F. Supp. 787 (S.D.N.Y. July 24, 1939). Maurice J. Speiser once again served as counsel to the bandleader, as well as serving as counsel to NAPA as *amicus curiae*. *Id.*

226. *Id.* at 790.

227. *Id.*; Newman, *supra* note 195, at 28.

228. Newman, *supra* note 195, at 28.

229. *RCA Mfg. Co.*, 28 F. Supp. at 792.

230. *Id.* at 793.

231. *Id.*

232. *See RCA Mfg. Co., Inc. v. Whiteman*, 114 F.2d 86 (2nd Cir. 1940).

recordings were dedicated to the public.²³³ Examining the authorities as to whether the sound recordings in question were published, he could

see no reason why the same acts that unconditionally dedicate the common-law copyright in works copyrightable under the act, should not do the same in the case of works not copyrightable. Otherwise it would be possible, at least pro tanto, to have the advantage of dissemination of the work at large, and to retain a perpetual though partial, monopoly in it. That is contrary to the whole policy of the Copyright Act and of the Constitution. Any relief which justice demands must be found in extending statutory copyright to such works, not in recognizing perpetual monopolies, however limited their scope.²³⁴

This remains the pith of the problem with common-law copyright for sound recordings to this day, and in 1940 it carried the day. Having found that any common-law rights in the recordings had been extinguished by publication, the court further found that the “Not Licensed for Radio Broadcast” labels were illegitimate, as equitable servitudes on chattels are “prima facie invalid; they must be justified by some exceptional reason, normally they are ‘repugnant.’”²³⁵ The arguments made under unfair competition and the right of privacy were similarly dealt with, the latter clearly seeming ludicrous to the court.²³⁶

RCA regarded the verdict as a “complete victory for the broadcasting industry as opposed to the recording companies and NAPA.”²³⁷ Obviously this was a serious blow to NAPA, but the music business was on the verge of a seismic shift following the war. The big band leaders, once the dominant force in popular music, would be pushed aside in favor of recorded music assembled from multiple tracks in the studio. The era of live performance was coming to an end, and in its place came the era of rock-and-roll.

4. The Era of Recordings

After World War II, magnetic tape and modern recording techniques became more prominent, leading to a revolution in recording techniques,

233. *Id.*

234. *Id.* at 89.

235. *Id.* As has been commented above as well, the argument regarding equitable servitudes, much as various courts accepted it, is somewhat perverse, and would not be used after this round of cases. It confuses the chattel and the intangible property it possesses, and is generally unnecessary to a theory of common-law copyright.

236. *Id.* at 90.

237. Newman, *supra* note 195, at 32.

and in turn a revolution in popular music generally. While the lawsuits of the radio era were all about preventing competition with live music from the playing of records on the radio, radio airplay became immensely desirable in the era of recordings, and the litigation over protection for sound recordings in the postwar era would be concerned with large-scale copying of music.

The early cases in the postwar era were generally focused on classical music. It was common in this era to take broadcasts of classical performances and press them for public distribution, often coupled with an obfuscation of the source of the recording. While the term “bootleg” was initially used to refer to illicit booze during the prohibition era, its use crossed over to the musical realm around 1929 when *Variety* referred to a “huge market” for “bootleg disk records,” by which they meant unlicensed copies of commercially released records.²³⁸

Bootlegging came in many different types, the most obvious being counterfeit recordings. When a particular album became a hit, counterfeiters would purchase a copy and then have it taped. A metal-plated master disc was made from the tape, and after two more processes, thousands of copies of the disc could be pressed.²³⁹ Album covers could also be duplicated through different photo-engraving processes, and the finished records were then introduced to the market through immoral or naïve distributors.²⁴⁰ Another type of bootlegging was also known as “privateering.” Under this practice, private clubs would issue transfers of old recordings of live performances to their members on a nonprofit basis.²⁴¹ There were many such clubs devoted to preserving the musical works of a particular artist or sharing a particular type of music. They worked without commissions from musicians or labels, issuing music on “private” labels, but hardly considered themselves in the same category as lowly counterfeiters. Specifically, producers of operative private labels did not counterfeit records, nor did they copy records which were still in print; rather, they issued recordings of live performances taped off the air or from inside the opera house. One example of “privateering” occurred when American Opera Society’s performances with Montserrat Caballe’s American debut in Donizetti’s *Lucrezia Borgia* at Carnegie Hall were published via a privateer label, and became the most famous pirated opera recording.²⁴² The privateer responsible for these recordings never revealed the source of the Carnegie Hall recordings.

238. HEYLIN, *supra* note 133, at 6.

239. William Livingstone, *Piracy in the Record Industry*, STEREO REVIEW, Feb. 1970.

240. *Id.*

241. *Id.*

242. *Id.*

Privateers saw themselves as vocal historians, preserving precious musical history before it was lost in time, as opposed to rogue pirates feeding off the success of the music industry. Privateers claimed their work was a “labor of love” motivated by their affinity for classical music. In making their case, it has been observed they made little to no profits, artists were pleased or at least tolerant of their recordings, collectors encouraged them to issue more records, and they contributed to future musicians by preserving great performances for future study.²⁴³ One of the earlier sound recording cases of this era, *Metropolitan Opera v. Wagner-Nichols*, was also one of the few to address the implications of this hobbyist piracy under the law.²⁴⁴ Wagner-Nichols recorded the Met’s Saturday radio performances and pressed them into records, in competition with the Met’s recording contract with Columbia Records.²⁴⁵ The case was not strictly speaking a common-law copyright case, since the broadcasts were of live performances, and Columbia’s records were studio recordings of different performances. However, the court made clear that the Met Opera was not divested of its property rights by broadcast of these performances, in addition to granting judgment to claimants for unfair competition and similar causes for relief.²⁴⁶

Several years later, in a complex dispute over the rights to distribute classical recordings made in Nazi Germany, the courts upheld a right to prevent unauthorized reproduction and distribution of sound recordings in *Capitol Records v. Mercury*.²⁴⁷ In the case, Capitol held an exclusive right from German company Telefunken to reproduce and distribute phonograph records in the United States, while Mercury had been granted certain rights in the U.S. by Telefunken’s Czech assignee.²⁴⁸ Capitol sued for declaratory relief, requesting a judgment that Mercury’s sale of these recordings violated their exclusive rights under New York

243. *Id.*

244. *Metro. Opera Ass’n v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483, 499 (N.Y. 1950), *aff’d*, 107 N.Y.S.2d 795 (App. Div. 1951).

245. Bruce D. Epperson, *A Circle and a “C”: One Hundred Years of Recorded Music in American Copyright, Part 14*, BLOG ASS’N FOR RECORDED SOUND COLLECTIONS, <http://arsc-audio.org/blog/author/kimpeach/page/10/> (Sept. 23, 2013).; Benjamin Kaplan, *Performer’s Right and Copyright: The Capitol Records Case*, 69 HARV. L. REV. 409 (1956).

246. The case was appealed to the Appellate Division, which affirmed the trial court without an opinion, and which refused to certify an appeal of the interlocutory question to the New York Court of Appeals. James J. Guinan, *Metropolitan Opera Assn. v. Wagner-Nichols Recorder Corp: A Dissent and Proposal 3* (1952) (unpublished seminar paper) (on file with author).

247. Jake Linford, *A Second Look at the Rights of First Publication*, 58 J. COPYRIGHT SOC’Y U.S.A. 585 (2011); 221 F.2d 657, 664–68 (2d Cir. 1955).

248. *Capitol Records v. Mercury Records Corp.*, 109 F. Supp. 330 (1952). Ultraphon’s full title was Ultraphon Actien Gessellschaft Fur Grammophon Industrie Und Handel of Prague. *Id.*

law.²⁴⁹

The district court found for Capitol, *inter alia* on the ground of unfair competition, not addressing the question of publication or common-law copyright at all.²⁵⁰ The district court brushed aside *RCA v. Whiteman* as being about the effectiveness of a servitude on records, and thus not relevant to broader concerns of common-law copyright and competition.²⁵¹ On appeal, the briefs of the parties were sensibly thus focused on the question of unfair competition as well.²⁵² However, the Second Circuit did not dodge the question of common-law copyright, but instead addressed it head-on.²⁵³ The court recognized its earlier decision in *Whiteman*, but held that the intervening decision in the *Wagner-Nichols* case showed that they had been wrong about publication under New York law.²⁵⁴ Although *Wagner-Nichols* was a case of unfair competition, the court felt it would be an absurdity if *Wagner-Nichols* was prohibited from selling live broadcasts of operas, but permitted to copy and sell Columbia's recordings of the operas.²⁵⁵ The Second Circuit found the conclusion "inescapable" that "where the originator, or the assignee of the originator, or records of the performances by musical artists puts those records on public sale, his act does not constitute a dedication of the right to copy and sell the records."²⁵⁶ The verdict of the district court was thus affirmed, and ever since this holding has been repeated in multiple jurisdictions to minimal resistance.²⁵⁷ For essentially every court to consider the issue since

249. *Id.*

250. *Id.*

251. *Id.*

252. Notably Capitol Records in its brief, and Mercury in its Reply Brief. Brief of Capitol Records, *Capitol Records v. Mercury Records Corp.*, 109 F. Supp. 330 (1952) (No. 49-580) (copy on file with author); Brief of Mercury Record Corp., *Capitol Records v. Mercury Records Corp.*, 109 F. Supp. 330 (1952) (No. 49-580) (copy on file with author).

253. *Capitol Records v. Mercury Records Corp.*, 221 F.2d 657 (2nd Cir. 1955).

254. *Id.* at 663.

255. *Id.*

256. *Id.*

257. *Id.* Abrams provides a string cite of the main cases applying this doctrine in other states. HOWARD B. ABRAMS, 1 THE LAW OF COPYRIGHT § 8:38; *A & M Records, Inc. v. M.V.C. Distributing Corp.*, 574 F.2d 312 (6th Cir. 1978) (applying Michigan law); *CBS, Inc. v. Garrod*, 622 F. Supp. 532 (M.D. Fla. 1985), *aff'd*, 803 F.2d 1183 (11th Cir. 1986) (applying Florida law); *Capitol Records, Inc. v. Erickson*, 2 Cal. App. 3d 526 (2d Dist. 1969); *Capitol Records, Inc. v. Spies*, 264 N.E.2d 874 (1st Dist. 1970); *GAI Audio of N.Y., Inc. v. Columbia Broad. System, Inc.*, 340 A.2d 736 (1975); *Columbia Broad. System, Inc. v. Melody Recordings, Inc.*, 341 A.2d 348 (App. Div. 1975); *Capitol Records, Inc. v. Greatest Records, Inc.*, 252 N.Y.S.2d 553 (Sup. 1964); *Metropolitan Opera Ass'n v. Wagner-Nichols Recorder Corp.*, 101 N.Y.S.2d 483 (Sup. 1950), *order aff'd*, 107 N.Y.S.2d 795 (1st Dep't 1951) and (rejected by, *Financial Info, Inc. v. Moody's Inv'rs Serv., Inc.*, 808 F.2d 204 (2d Cir. 1986)); *United Artists Records, Inc. v. Eastern Tape Corp.*, 198 S.E.2d 452 (1973); *Liberty/UA, Inc. v. E. Tape Corp.*, 180 S.E.2d 414 (1971); *Columbia Broad. System, Inc. v. Custom Recording Co.*, 189 S.E.2d 305 (1972); *Mercury Record Prods., Inc. v. Economic Consultants, Inc.*, 218 N.W.2d 705 (1974).

1955, a sound recording made before 1972 has never been published for purposes of copyright law.

5. The Era of Piracy

Tape recording and long-playing records were two significant technological advances of the 1940s which contributed to the societal shift in music enjoyment and consumption. They transformed popular audio recordings into a new art form distinct from live performance, and created a new category of popular performer—the recording artist. Although these developments led to a second boom for the record industry, problems inevitably developed. A new generation of pirates were able to rob record labels of significant profits by selling bootleg prerecorded tapes and illicit discs to the public, drawing revenue away from the legitimate musicians and labels.²⁵⁸ Record pirates would transfer the sound of a commercial recording onto another disc or tape, apply a counterfeit label, and sell it without permission from the creator of the original recording.²⁵⁹

The first cases of record piracy received national attention, beginning in 1951 when Classic Editions published a recording of Verdi's *A Masked Ball* purportedly made in Italy. It was revealed as a fraud by the media shortly after its release in the same year as *Metropolitan Opera v. Wagner-Nichols*.²⁶⁰ However, the bulk of this problem would concern popular releases, where a surprising percentage of bootleg recordings were produced from the record company's master tape, not the mass-produced consumer LP, indicative of a broader ties between record pirates and organized crime.²⁶¹ For instance, in 1959 the mafia was held responsible for inundating the market with illegal 45 RPM records of Bobby Rydell's hit song "Ding-A-Ling."²⁶² In addition, the use of pirated records in jukeboxes was directly profitable to the mafia, and also provided a veneer of a legitimate business through which to launder funds.²⁶³ In the early 1960s, counterfeiters took an estimated \$20 million from the recording industry,²⁶⁴ and one out of every three prerecorded tapes sold was a pirate release.²⁶⁵

258. Livingstone, *supra* note 239.

259. *Id.*

260. *Id.*; Metro. Opera Ass'n v. Wagner-Nichols Recorder Corp., 101 N.Y.S.2d 483, 499 (Sup. Ct. 1950), *aff'd*, 107 N.Y.S.2d 795 (App. Div. 1951).

261. ALEX SAYF CUMMINGS, DEMOCRACY OF SOUND: MUSIC PIRACY AND THE REMAKING OF AMERICAN COPYRIGHT IN THE TWENTIETH CENTURY 142 (2013).

262. *Id.*; 2 Dealers Charged in Disk Bootlegging, N.Y. TIMES, June 11, 1960, at 21.

263. *Id.*

264. Stanley Green, *Jukebox Piracy*, ATLANTIC, Apr. 1962.

265. Livingstone, *supra* note 239.

The music industry “watched as copyright reform idled in Congress, courts yielded empty successes, and piracy grew more widespread and flagrant” in the 1960s.²⁶⁶ Although criminal laws for infringement of common-law copyright had been passed in 1895 to 1904 relating to play piracy, these were not used, and instead the industry’s next step was to lobby state legislatures for stronger remedies.²⁶⁷ In 1966 New York Attorney General Louis J. Lefkowitz ordered hearings on record piracy, as a result of numerous consumer complaints where record buyers felt they had been defrauded.²⁶⁸ After the hearings, New York Governor Nelson Rockefeller quickly passed the first state anti-piracy law,²⁶⁹ making it a misdemeanor to knowingly copy records without the consent of the owner with intent to sell them, or to distribute pirated records.²⁷⁰ California was the next state to pass anti-piracy legislation in 1968, followed by Arkansas, Florida, Pennsylvania, Tennessee, and Texas in 1971.²⁷¹

Although the state statutes helped remedy the problem of piracy, it became clear that state-level protection was too piecemeal to be effective going forward.²⁷² The view that the Constitution offered no resistance to federal protection of sound recordings, contrary to the implication of *White-Smith*, traces to Zechariah Chafee’s seminal 1945 article *Reflections on the Law of Copyright*, which asserted that even if the word “writings” barred registration of sound recordings under the 1909 Act, that same word in the Constitution was not an outright bar to their registration.²⁷³ Ten years later, in the *Mercury* decision, the court stated that “[t]here can be no doubt that” Congress has the power to protect sound recordings.²⁷⁴ That same year, the Copyright Office was asked to submit proposals for a new copyright act,²⁷⁵ but it would be a decade before a bill was introduced, during which time the Copyright

266. CUMMINGS, *supra* note 261, at 125.

267. *Id.*; *supra* at II(C)(6); note 113.

268. Livingstone, *supra* note 239, at 63.

269. CUMMINGS, *supra* note 261, at 125. There had been a Los Angeles City Ordinance passed twenty years earlier, but no previous state laws. L.A., CAL. MUNICIPAL CODE 42.19.1 (1945) (repealed 1970 once the California state statute was passed).

270. *Id.*

271. *Id.*; Louis J. Lefkowitz, *Piracy Hearing: Tape Piracy, State of New York*, 5 PERFORMING ARTS REV. 1–2, 69–73. Eventually all but two states would pass statutes criminalizing record piracy. *State Criminal Laws: Pre-1972 Sound Recordings*, U.S. COPYRIGHT OFF., http://www.copyright.gov/docs/sound/20111212_survey_state_criminal_laws_ARL_CO_v2.pdf, (last visited Mar. 22, 2017) (summarizing state law).

272. CLINTON HEYLIN, *BOOTLEG: THE SECRET HISTORY OF THE OTHER RECORDING INDUSTRY* (1994).

273. *Reflections on the Law of Copyright: II*, 45 COLUM. L. REV. 719, 735 (1945).

274. *Capitol Records v. Mercury Records Corp.*, 221 F.2d 657, 660 (2d Cir. 1955).

275. HEYLIN, *supra* note 272, at 67.

Office prepared a thorough study of the issue of sound recordings.²⁷⁶ When the Bill was introduced to the Senate in 1968 by John L. McClellan (the McClellan Bill), it was immediately shot down, and reintroduced again in 1969 where it again failed to pass. The bill was essentially an anti-piracy bill, and facing defeat, the music industry knew that it would have to begin pushing harder for passage, so they used the publicity bootlegs received from 1969 to 1970 as a weapon in their arsenal.²⁷⁷

Getting federal protection against piracy had been a top priority of the RIAA since its inception in 1952, but technological advances of the late 1960s called for heightened determination to combat this new form of piracy.²⁷⁸ They, along with the National Association of Record Merchandisers and executive representatives from the major record labels, met in November 1970 to discuss the need for Federal anti-piracy legislation.²⁷⁹ By this time, growing awareness of music piracy and the rise of tape copying compelled Congress to act, with the Register of Copyrights stating to Congress in 1971, “Anyone working with this on a day-to-day basis cannot fail to be impressed with the enormous growth in [piracy] over the last 5 years or so.”²⁸⁰ She attributed piracy’s growth to the “ease of tape duplication” and “lack of clarity” in the law.²⁸¹

The McClellan Bill was once again reintroduced to the Senate on January 26, 1971, and passed on October 15 of that same year. The hope had been to include federalization of protection of sound recordings with a new copyright law, but it became clear that any new copyright act was still quite a while away, and indeed the hoped-for act would not be passed until 1976. The bill amended Title 17 of the U.S. Code “to provide for the creation of a limited copyright in sound recordings for the purpose of protecting against unauthorized duplication and piracy of sound recordings, and for other purposes.” To avoid controversy the bill was strictly an anti-piracy measure, and exempted “unpublished” sound recordings in addition to sound recordings fixed before February 15, 1972.²⁸² The law did not prohibit home recording from broadcasts, tapes, or records though if the recording was used privately with no commercial purposes.²⁸³

276. RINGER, *supra* note 163.

277. HEYLIN, *supra* note 272, at 67–68.

278. *Id.* at 101.

279. *Id.*

280. CUMMINGS, *supra* note 261, at 130.

281. *Id.*; *Prohibiting Piracy of Sound Recordings: Hearing on S. 646 and H.R. 6927 Before the Subcomm. of the Comm. on the Judiciary H.R.*, 92nd Cong. 1 (1971).

282. HEYLIN, *supra* note 272, at 102; Pub. L. No. 92-140, 85 Stat. 391 (1971).

283. Pub. L. No. 92-140, 85 Stat. 391.

C. The Era of Partial Federalization

On November 15, 1971, sound recordings finally received federal protection. Not only had tape piracy become rampant by this time, but a coming diplomatic conference to combat piracy scheduled for later in 1971 further accelerated the timetable for passage.²⁸⁴ Sound recordings fixed before the effective date of the law—February 15, 1972—were not brought under federal law, and existing remedies under state law remained for these sound recordings.²⁸⁵ Under this act sound recordings were not given any public performance rights, with protection “limited to the right to duplicate the sound recording in a tangible form that directly or indirectly recaptures the actual sounds fixed in the recording.”²⁸⁶

With the passage of this act, two separate constitutional questions raised their head—the constitutionality of the 1971 Act, and the constitutionality of continuing state protection for older sound recordings. Both the new federal statute and state anti-piracy laws would quickly be tested in the courts, and found constitutional by the Supreme Court.²⁸⁷ The Court’s decision in *Goldstein v. California* was a rejection of what some saw as an implication of the Court’s *Compco* decision, which held “that when an article is unprotected by patent or copyright, state law may not forbid others to copy that article.”²⁸⁸ Over two dissents, the Court held that “under the Constitution, the States have not relinquished all power to grant to authors ‘the exclusive Right to their respective Writings,’”²⁸⁹ and that the Supremacy Clause likewise did not bar state action against tape pirates.²⁹⁰ The Court also found that “writings,” as used in the Constitution, “may be interpreted to include any physical rendering of the fruits of creative intellectual or aesthetic labor,” including sound recordings.²⁹¹

The system of prospective federalization was now on secure footing, and when Congress passed a full revision of Copyright Law in 1976, the treatment of sound recordings was not changed markedly from its treatment under the 1971 Act.²⁹² Pre-1972 sound recordings were explicitly exempted from this preemption provisions of the new act in

284. U.S. COPYRIGHT OFFICE, FEDERAL COPYRIGHT PROTECTION FOR PRE-1972 SOUND RECORDINGS: A REPORT OF THE REGISTER OF COPYRIGHTS 11 (2011).

285. See H.R. REP. NO. 92-487, at 5 (1971); S. REP. NO. 92-72, at 3 (1971).

286. Pub. L. No. 92-140, § 1(a), 85 Stat. 391, 392.

287. *Goldstein v. California*, 412 U.S. 546 (1973).

288. *Id.* at 569; *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237–38 (1964).

289. *Goldstein*, 412 U.S. at 560.

290. *Id.* at 569–70.

291. *Id.* at 561.

292. COPYRIGHT REPORT, *supra* note 284, at 14.

section 301(c), which expressed that no state laws regarding pre-1972 sound recordings would be preempted.²⁹³ Following the passage of this law, the Copyright Office engaged in a substantial study of the issue of sound recordings and performance rights, but no amendment to the law was made.²⁹⁴

By 1990, it was clear that digital transmission was the future, and at the request of Congress the Copyright Office conducted a study on digital performance rights for sound recordings.²⁹⁵ In a report issued the following year, the Copyright Office recommended granting a public performance right to sound recordings, as digital transmissions and new technology would greatly affect economic rights of copyright holders in sound recordings.²⁹⁶ Competing bills were introduced in 1993,²⁹⁷ and on May 11, 1994, a consensus agreement was reached by ASCAP, BMI, AFM, AFTRA, NMPA, and RIAA that struck a balance between the interests of musicians, composers, performers, unions, music publishers, record companies, and broadcast companies, by only including a compensation system for sound recordings performed on commercial subscription services.²⁹⁸ The Digital Performance Right in Sound Recordings Act of 1995 (DPRA) reflected this consensus, creating a limited performance right for noninteractive digital transmission services.²⁹⁹ Although the act faced early criticism for only paying “minimal royalties,”³⁰⁰ by 2015 over \$3 billion had been paid to artists by SoundExchange, the performance rights organization that administers royalty payments under the DPRA.³⁰¹

V. THE CURRENT ERA: WHAT NOW?

Following a recession from 1978 to 1981, the 1980s and 1990s were boom years for the music industry, and perhaps coincidentally there was

293. *Id.*

294. STAFF OF H. COMM. ON THE JUDICIARY, 95TH CONG., PERFORMANCE RIGHTS IN SOUND RECORDINGS (Comm. Print (1978)).

295. REGISTER OF COPYRIGHTS, REPORT ON COPYRIGHT IMPLICATIONS OF DIGITAL AUDIO TRANSMISSION SERVICES I (1991).

296. *Id.* at 160.

297. H.R. 2576, 103d Cong. (1993); S.1421, 103d Cong. (1993)

298. *Digital Performance Right in Sound Recordings Act of 1995 (H.R. 1506): Hearing before the Subcomm. On Courts and Intellectual Prop.*, 104th Cong. 1 (1998) (statement of Marybeth Peter, The Register of Copyrights).

299. Pub. L. No. 104–39, 109 Stat. 336 (1995).

300. Rebecca F. Martin, *The Digital Performance Right in the Sound Recordings Act of 1995: Can It Protect U.S. Sound Recording Copyright Owners in a Global Market?*, 14 CARDOZO ARTS & ENT. L.J. 733 (1996).

301. Press Release, SoundExchange, SoundExchange Breaks the \$3 Billion Mark (Aug. 5, 2015), <http://www.soundexchange.com/pr/soundexchange-breaks-the-3-billion-mark/>.

comparatively little civil litigation that led to a published opinion over pre-1972 sound recordings.³⁰² However, the early years of the twenty-first century saw an increase in common-law copyright litigation as digital distribution began to effect the music industry. In 2005, the New York Court of Appeals reaffirmed common-law copyright protection for pre-1972 sound recordings in the state of New York.³⁰³ As the music industry began to reorganize in the age of streaming and the internet, the poorly-defined rights applicable to pre-1972 sound recordings offered the promise of additional revenue streams for content owners.

A. Capitol v. Naxos

In 2005, the New York Court of Appeals reaffirmed that common-law copyright protections for pre-1972 sound recordings remain effective in *Capitol Recordings, Inc. v. Naxos of America*.³⁰⁴ Naxos Records, an international discount classical record label and distributor based out of Hong Kong, offered a “historical” line of classical records. The records included Naxos’s own re-mastering of recordings which were out of copyright in certain European jurisdictions.³⁰⁵ There was no dispute that Naxos copied the original issues of these recordings, but since the recordings were made in the earlier twentieth century, the composers had been dead for decades or even centuries, meaning there was no copyright in the music to worry about. Additionally, there is no indication that Naxos copied any subsequent remastering which might have raised a separate question of statutory copyright infringement. Still, the New York Court of Appeals made clear that even if a work was out of copyright in its country of origin, it was still perpetually protected in New York State—at least until Federal law preempts such protection in 2067.³⁰⁶

Capitol Records, a subsidiary of EMI, asserted that it held the rights in the United States to classical sound recordings made in the 1930s by Capitol’s predecessor HMV.³⁰⁷ In 2002, Capitol sued Naxos, claiming *inter alia* common-law copyright infringement. The district court found

302. BRIAN LONGHURST, POPULAR MUSIC AND SOCIETY 209 (2d ed. 2007).

303. *Capitol Records, Inc. v. Naxos of America*, 830 N.E.2d 250 (N.Y. 2005).

304. *Id.*

305. *Naxos Historical CD Catalogue*, NAXOS RECORDS, http://www.naxos.com/labels/naxos_historical-cd.htm (last visited Apr. 10, 2017).

306. *Capitol Records, Inc.*, 830 N.E.2d 250.

307. *Id.* at 252. The recordings at issue in the *Naxos* case were Yehudi Menuhin’s July 1932 performance of Edward Elgar’s “Violin Concerto in B Minor, Opus 61,” Pablo Casals’ performances of J.S. Bach’s cello suites which were recorded sometime between November 1936 and June 1939, and Edwin Fischer’s performances of Bach’s “The Well-Tempered Clavier, Book II,” which was recorded sometime between February 1935 and June 1936. *Id.*

for Naxos,³⁰⁸ but on appeal the Second Circuit instead certified the question regarding common-law copyright under New York law to the New York Court of Appeals.³⁰⁹

The New York Court of Appeals ruled that New York protected the pre-1972 sound recordings at issue.³¹⁰ The Court of Appeals, relying on the U.S. Supreme Court's opinion in *Goldstein v. California*, found that the Copyright Clause of the United States Constitution does not prevent state legislation regarding copyright, save to the extent specifically preempted by federal statute.³¹¹ The court next determined New York did protect pre-1972 sound recordings, reaffirming the holding from *Capitol v. Mercury* fifty years earlier in holding that "the public sale of a sound recording otherwise unprotected by statutory copyright does not constitute a publication sufficient to divest the owner of common-law copyright protection."³¹² As the public sale of a sound recording does not constitute publication and common-law copyright thus remained in effect for the sound recordings at issue, the court held that Capitol would retain common-law copyright in these sound recordings until New York law was preempted by section 301 of the federal copyright statute in 2067.³¹³

The response to the decision was largely critical. Commentators expressed concern that the decision would give an unnaturally long copyright term to sound recordings, which would lead to a breakdown in archival preservation for older sound recordings of minimal value.³¹⁴ Others noted that after the *Naxos* decision the question of whether pre-1972 sound recordings have a performance right remained unsettled.³¹⁵

B. The Copyright Office Report and Legislation

In 2009, Congress asked the United States Copyright Office to study "the desirability of and means for bringing sound recordings fixed

308. *Capitol Records, Inc. v. Naxos of Am. Inc.*, 274 F.Supp.2d 472 (S.D.N.Y. 2003).

309. *Capitol Records, Inc. v. Naxos of Am., Inc.*, 372 F.3d 471 (2nd Cir. 2004). The certified question was: "In view of the District Court's assessment of the undisputed facts, but without regard to the issue of abandonment, is Naxos entitled to defeat Capitol's claim for infringement of common-law copyrights in the original recording?" *Id.*

310. *Id.* at 263.

311. *Id.*

312. *Capitol v. Naxos*, 830 NE 2d 250, 560 (N.Y. 2005).

313. *Id.*

314. Timothy P. Best, *Capitol Records v. Naxos of America, Inc.: The Persistence of Copyright on That Old Time Rock N' Roll*, 21 BERKELEY TECH. L.J. 335 (2006); Holly M. Sharp, *The Day the Music Died: How Overly Extended Copyright Terms Threaten the Very Existence of Our Nation's Earliest Musical Works*, 57 EMORY L.J. 279 (2007).

315. Michael Smith, *Gotta Fight for Your Right to Perform: Scope of New York Common Law Copyright For Pre-1972 Sound Recordings Post-Naxos*, 30 LOY. L.A. ENT. L. REV. 589 (2010).

before February 15, 1972, under federal jurisdiction.”³¹⁶ The Copyright Office collected public comments, held public meetings, and issued its report on December 28, 2011.³¹⁷ The Copyright Office’s report went into great detail about the history and development of common-law copyright for sound recordings, and the preservation concerns associated with the oldest—and least commercially significant—sound recordings.³¹⁸ Following this, the Copyright Office Report recommended that pre-1972 sound recordings be brought within the scope of protection of the federal copyright statute (federalized), to bring all sound recordings into one statutory scheme. Under this proposal, sound recordings fixed before February 15, 1972, would receive the standard term of protection if they were works made for hire or anonymous and pseudonymous works. Given that such federalization would effectively put pre-1923 sound recordings into the public domain immediately, the proposal contains provisions allowing for a twenty-five-year term of protection for pre-1923 sound recordings if it is made reasonably available, with protection until up to 2067 for sound recordings made between 1923 and 1972 if the sound recording is made reasonably available.³¹⁹

Before the Copyright Office even issued its report, the Sound Recording Simplification Act, which would have eliminated section 301(c) of the Copyright Act, was introduced in Congress.³²⁰ Perhaps unsurprisingly, this bill gained little traction. In mid-2014, the Respecting Senior Performers as Essential Cultural Treasures Act, or the RESPECT Act was introduced in Congress.³²¹ This bill would have required digital music services to pay royalties for pre-1972 sound recordings, as they do for more recent recordings, and provided they did so, would have immunized these services from copyright suits.³²² The Act was opposed by Sirius XM, and supported by the record companies

316. FEDERAL COPYRIGHT PROTECTION, *supra* note 1.

317. *Id.* All public documents relating to the process of creating the report are available at *A Study on the Desirability of and Means for Bringing Sound Recordings Fixed Before February 15, 1972, Under Federal Jurisdiction*, U.S. COPYRIGHT OFF., <http://www.copyright.gov/docs/sound/> (last visited Mar. 22, 2018).

318. FEDERAL COPYRIGHT PROTECTION, *supra* note 1, at ii–iii.

319. *Id.* at 175–78. This proposal could in theory raise issues under the takings clause of the Fifth Amendment, but these have been dismissed by both the *Pre-72 Report* and subsequent scholarship. *Id.* at 155; Eva E. Subotnik & June M. Besek, *Constitutional Obstacles? Reconsidering Copyright Protection for Pre-1972 Sound Recordings*, 37 COLUM. J. L. & ARTS 327 (2014).

320. Sound Recording Simplification Act, H.R. 2933, 112th Cong. (2011).

321. RESPECT Act, H.R. 4772, 113th Cong. (2014).

322. *Id.*; Steve Gordon & Anjana Puri, *The Current State of Pre-1972 Sound Recordings: Recent Federal Court Decisions in California and New York against Sirius XM Have Broader Implications than Just Whether Satellite and Internet Radio Stations Must Pay for Pre-1972 Sound Recordings*, 4 NYU J. INT. PROP. & ENT. L. 354 (2015).

and SoundExchange, but ultimately did not make it out of committee.³²³ In the following Congress, the provisions of the RESPECT Act were integrated into the Play Fair Pay Act, which would further require the payment of royalties to sound recording copyright owners for all performances, including terrestrial radio.³²⁴ With another Congress came another bill, and in July of 2017 a bill substantially similar to the 2014 RESPECT Act was introduced, this time called the CLASSICS Act.³²⁵ In April of 2018 the CLASSICS Act was incorporated as Title II of the Music Modernization Act.³²⁶

C. Pre-1972 Sound Recordings and Digital Audio Transmission

In February 2013, the Copyright Royalty Board (CRB) issued a Final Determination of Rates and Terms for Preexisting Subscription and Satellite Digital Audio Radio Services. The determination affected the royalty rates that would be paid by digital audio transmission services to SoundExchange, which collects royalties for payments made under the DPRA, as codified at Section 114 of the Copyright Act.³²⁷ The CRB noted that “[a]s with directly licensed works, pre-1972 sound recordings are not licensed under the statutory royalty regime and should not factor into determining the statutory royalty obligation.”³²⁸ Therefore, Sirius XM was not required “to account for performances of pre-1972 sound recordings” to SoundExchange for 2013 to 2017.³²⁹

Not long after CRB issued this determination, two separate groups filed suit: (1) major record labels; and (2) a certified class with Flo & Eddie of the band The Turtles as named plaintiffs. Although the litigation with the major record labels was a greater threat to Sirius XM and Pandora, these cases were settled amicably. In September 2013, the major record labels sued Sirius XM in California state court, alleging *inter alia* violation of the California codification of common-law copyright for sound recordings.³³⁰ The same set of plaintiffs sued

323. *Id.* at 337, 355–56.

324. Play Fair Pay Act, H.R. 1733, 114th Cong. (2015).

325. Compensating Legacy Artists for their Songs, Service, and Important Contributions to Society Act (CLASSICS Act), H.R. 3301 (2017).

326. Music Modernization Act, H.R. 5447, 115th Congress (2018).

327. Determination of Rates and Terms for Preexisting Subscription and Satellite Digital Audio Radio Services, 37 C.F.R. 382.1–382.8 (2017).

328. *Id.*

329. *Id.*; David Oxenford, *Full Text Copyright Royalty Board Decision on Sirius XM and Music Choice Royalties Released – The Basics of the Decision*, BROADCAST L. BLOG (Jan. 4, 2013), <http://www.broadcastlawblog.com/2013/01/articles/full-text-of-copyright-royalty-board-decision-on-sirius-xm-and-music-choice-royalties-released-the-basics-of-the-decision/>.

330. Complaint, Capitol Records LLC v. Sirius XM Radio Inc., Case No. BC 520981 (Cal. Sup. Ct. L.A. Cty., Sept. 11, 2013). The plaintiffs were Capitol Records, joined by Sony Music

Pandora for unauthorized use of their pre-1972 sound recordings in April 2014, alleging infringement of common-law copyright along with unfair competition and other theories of recovery.³³¹ In October 2014, the trial court in California instructed the jury that pre-1972 sound recordings “include the exclusive right to publicly perform, or authorize others to publicly perform, the sound recording by means of digital transmission.”³³² Following this ruling, Sirius XM settled the suit for \$210 million in June 2015, which included back royalties and rights to play pre-1972 recordings owned by the plaintiffs through 2017.³³³ Pandora likewise settled the suit against them in October 2015, paying \$90 million to the record labels.³³⁴ The Flo & Eddie lawsuits, however, were not so easily concluded.

1. Flo & Eddie

Flo & Eddie, Inc., is a California corporation owned by Mark Volman and Howard Kaylan, who were original members of the 60s rock band The Turtles. The corporation asserts ownership in the band’s common-law copyrights.³³⁵ In 2013, Flo & Eddie brought separate suits in the federal district courts in California, Florida, and New York for common-law copyright infringement and unfair competition claims under state statute and common-law against Sirius XM.³³⁶ Each case followed a

Entertainment, UMG Recordings, Warner Music Group, and ABKCO Music & Records (owner of certain copyrights in the Rolling Stones and other groups).

331. Eriq Gardner, *Record Labels Sue Pandora Over Pre-1972 Recordings*, HOLLYWOOD REPORTER (Apr. 17, 2014), <https://www.hollywoodreporter.com/thr-esq/record-labels-sue-pandora-pre-697327>; see also *Capitol Records LLC v. Pandora Media Inc.*, No. 651195/2014 (N.Y. Sup. Ct. Apr. 17, 2014).

332. *Capitol Records LLC v. Sirius XM Radio Inc.*, No. BC5209681, 2014 WL 7002054 (Cal. Sup. Oct. 14, 2014); Notice of Motion for Jury Instruction, *Capital Records LLC v. Sirius XM Radio Inc.*, No. BC 520981, 2014 WL 7148746 (Cal. Sup. Feb. 3, 2014). The court had preliminarily rejected such a jury instruction, but reversed its decision upon the intervening decision of the Central District of California in the Flo & Eddie case there. Motion for Reconsideration, *Capital Records LLC v. Sirius XM Radio Inc.*, No. BC 520981*Id.*, 2014 WL 7148751 (Cal. Sup. Oct. 28, 2014).

333. Todd Spangler, *Sirius XM to Pay \$210 Million to Companies for Pre-1972 Songs*, VARIETY (June 26, 2015), <http://variety.com/2015/music/news/sirius-xm-settlement-record-companies-pre-1972-songs-1201529103/>.

334. Eriq Gardner, *Pandora Reaches \$90 Million Settlement With Labels Over Pre-1972 Music*, BILLBOARD (Oct. 22, 2015), <http://www.billboard.com/articles/business/6738203/pandora-settlement-record-labels-pre-1972-music-riaa>.

335. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 62 F.Supp.3d 325, 330 (S.D.N.Y. 2014).

336. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, No. 13-CV-5784 (S.D.N.Y., Aug. 16, 2013); *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, No. 13-cv-23182 (S.D. Fla. 2013, Sep. 3, 2013). The suit in California was actually brought in state Court, but removed by the defendant. Defendant Sirius XM Radio Inc.’s Notice of Removal, *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, No. CV-13-5693 (C.D. Cal. Aug. 6, 2013).

fairly straightforward path: Sirius XM filed a motion to dismiss or for summary judgment, arguing *inter alia* that common-law copyright (or in California, the statutory codification) does not provide an exclusive right of public performance to owners of common-law copyrights, at least regarding pre-1972 sound recordings. However, each court reached its own result, initially creating a split among the states.

In New York, the Southern District denied Sirius XM's motion for summary judgment on the grounds that New York provides owners of pre-1972 sound recordings exclusive public performance rights.³³⁷ The court noted that when New York began to recognize common-law rights in sound recordings, federal law did not yet recognize any rights in sound recordings.³³⁸ Noting that common-law copyright does not necessarily track the rights and limitations of statutory copyright, the court looked to the "background principles and history of New York copyright common-law."³³⁹ The court noted that a performance right was clearly established by New York common-law, and that such a right applied to sound recordings.³⁴⁰ The case was appealed to the Second Circuit Court of Appeals, who certified to the New York Court of Appeals the question "is there a right of public performance for creators of sound recordings under New York law and, if so, what is the nature and scope of that right?"³⁴¹

In December of 2016, a divided New York Court of Appeals reached its decision, with four justices holding New York common law does not provide a right of public performance to sound recordings.³⁴² One justice concurred, but would have held that there may be a performance right at common-law regarding "on demand" services like Spotify, while two justices dissented, stating they would have recognized a performance right in sound recordings at common-law. The majority interpreted the 1955 *Mercury* decision to only constitute an abrogation of its previous precedent in *Whiteman* vis-à-vis piracy by copying records, but that the *Whiteman* decision meant that the rights held in a sound recording do "not include control over other rights in the work,

337. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 62 F.Supp.3d 325, 341 (S.D.N.Y. 2014), certifying questions to 821 F.3d 265 (2d Cir. 2016). The court also held that the copies of the recordings were not protected by the fair use doctrine in copyright law, that Sirius engaged in unfair competition, that the claims brought by Flo & Eddie did not violate the Dormant Commerce Clause, and that Sirius could not invoke the doctrine of laches. *Id.*

338. *Flo & Eddie*, 62 F.Supp.3d at 339.

339. *Id.*

340. *Id.*

341. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 821 F.3d 265, 272 (2d Cir. 2016), certifying questions to 27 N.Y.3d 1015, 52 N.E.3d 240 (2016).

342. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 28 NY.3d 583 (N.Y. 2016).

such as public performance.”³⁴³ The court also weighed societal expectations heavily, noting it would be “illogical to conclude that the right of public performance would have existed for decades without the courts recognizing such a right as a matter of state common law.”³⁴⁴ The majority recognized its decision was creating a split with the law of Pennsylvania,³⁴⁵ but asserted that defining the contours of a common-law performance right in the digital age was fraught with insoluble difficulties.³⁴⁶ In a concurrence, Justice Fahey agreed that no public performance right existed for sound recordings at common law, but argued that at least for interactive music services, New York common law creates exclusive rights.³⁴⁷

Unsurprisingly, given that the history of common-law performance rights demonstrates fairly clearly that they exist, the majority and concurring opinions of the New York Court of Appeals are long on policy arguments, but short on precedent. Looking at how New York common law has long recognized performance rights in other types of works, Judge Rivera’s dissent explains that “[t]here is no logical basis to distinguish between the copyright protections of those works and a sound recording.”³⁴⁸ The dissent further notes that the *Whiteman* decision was overruled by *Capitol v. Mercury*, not just limited, contrary to the argument made by the majority.³⁴⁹ However, it was for naught, with four judges holding that no common-law right of public performance exists, in reference to sound recordings, in New York.³⁵⁰ Shortly thereafter, the Second Circuit found that the answer to the certified question was determinative and remanded the case to the Southern District with instructions to grant Sirius XM’s motion for summary judgment.³⁵¹

The Flo & Eddie lawsuits offered a fairly clear choice between

343. *Id.* at 598.

344. *Id.* at 605.

345. *Id.* at 600 (“To the extent [*Waring*] pronounced a public performance right for creators of sound recordings under Pennsylvania common law, we find this holding inapplicable in the context of New York state common-law copyright.”).

346. *Id.* at 608–610.

347. *Id.* at 610–617.

348. *Flo & Eddie*, 28 NY.3d at 625. Judge Abdus-Salaam joined the dissent, only several months before her death. Matthew Haag & William K. Rashbaum, *Sheila Abdus-Salaam, Judge on New York’s Top Court, Is Found Dead in Hudson River* (Apr. 12, 2017), <https://www.nytimes.com/2017/04/12/nyregion/judge-dead-hudson-river-sheila-abdus-salaam.html>.

349. *Flo & Eddie*, 28 NY.3d at 629.

350. Interestingly, it does not appear that any Judges on the New York Court of Appeals would find that the common law includes a performance right that includes terrestrial radio. *Id.* at 634.

351. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 849 F.3d 14 (2nd Cir. 2017) (per curiam). The case was dismissed with prejudice the following month. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 2017 U.S. Dist. LEXIS 48605 (S.D.N.Y. Mar. 17, 2017).

precedent and policy arguments, and the majority of the New York Court of Appeals felt that the policy arguments to the effect that state protection of public performance rights for sound recordings would be unworkable practically. In the process the New York Court of Appeals created a split with Pennsylvania, and teed up further examination of the question in the Supreme Courts of Florida and California.

Unlike the fairly well-developed jurisprudence of common-law copyright in New York, there was almost a complete absence of such precedent in Florida. Further confusing the issue, Florida abolished common-law copyright for sound recordings by statute in 1941. While the relevant code section abolishing common-law copyright was repealed in 1977, it is not clear whether common-law copyright was reinstated, since no statute regarding common-law copyright replaced it.³⁵² Sirius XM contended that Florida granted no performance rights to sound recordings, so Flo & Eddie lost any common-law protection in their recordings after the first publication of The Turtles' music forty years prior.³⁵³ The district court expressed the difficulty they faced, noting that "neither Florida litigation nor Florida case law answers the question of whether Florida common-law copyright includes an exclusive right of public performance."³⁵⁴

Flo & Eddie argued that Florida common-law conceived property very broadly, including intangible property, meaning Florida common law includes the entire bundle of rights typically associated with intangible property.³⁵⁵ The district court refused to accept this, however, ruling that Florida common-law did not provide Flo & Eddie with the exclusive public performance right in their recordings.³⁵⁶ The court believed that, if common-law provided such an exclusive public performance right, the music industry would be left with unanswered questions regarding administration and exceptions to such a public performance right, since the licensing mechanisms for post-1972 sound recordings would not necessarily exist for pre-1972 sound recordings.³⁵⁷ Even more surprisingly, the district court refused to state clearly that sound recordings have any protection under Florida common law,

352. 1977 Fla. Laws 440.

353. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, No. 13-23182-CIV, 2015 WL 3852692 (S.D. Fla. June 22, 2015). Regarding the second issue of reproduction, the court was faced with the question of whether the back-up and buffered copies constituted unlawful reproduction. *Id.* at *6.

354. *Id.* at *4.

355. Plaintiff's *Flo & Eddie, Inc.*'s Response to Sirius XM Radio's Motion for Summary Judgement, *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, No. 13-23182-CIV, 2015 WL 3852692 (S.D. Fla. June 22, 2015).

356. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, No. 13-23182-CIV, 2015 WL 3852692, at *5 (S.D. Fla. June 22, 2015).

357. *Id.*

instead stating that even if such rights existed, they had not been infringed.³⁵⁸ On appeal, the Eleventh Circuit Court of Appeals indicated that the questions at issue would be better resolved by the Supreme Court of Florida (much as the Second Circuit had done), and formulated the question that was being presented to them into four certified questions, namely (1) whether reproduction and performance rights for sound recordings exist under Florida common-law, (2) whether such rights had been divested by the sale of records, and (3) whether Sirius XM had infringed such a reproduction right by making transitory copies on its servers.³⁵⁹ The Florida Supreme Court held oral arguments on April 6, 2017.³⁶⁰

On October 26, 2017, the Florida Supreme Court issued its decision.³⁶¹ Instead of addressing these questions, the court chose to address a reformulated question of its own, namely “[d]oes Florida common law recognize the exclusive right of public performance in pre-1972 sound recordings?”³⁶² The court answered in the negative, noting that to “recognize such a right for the first time today would be an inherently legislative task” that the court did not feel was appropriate.³⁶³ The court explicitly refused to make any statement about whether reproduction rights exist in Florida at common law, leaving the question unsettled.³⁶⁴ Unlike Florida or New York, California has a copyright statute that directly addresses the issues with pre-1972 sound recordings.³⁶⁵

358. *Id.*

359. The question certified was “whether Florida common-law copyright extends to pre-1972 sound recordings and, if so, whether it includes an exclusive right of public performance and/or an exclusive right of reproduction. We also certify the question of whether Flo & Eddie has forfeited any common-law copyright by publication. Additionally, to the extent that Florida recognizes a common-law copyright in sound recordings including a right of exclusive reproduction, we certify the question of whether the backup or buffer copies made by Sirius constitute infringement of Flo & Eddie’s common-law copyright.” *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 827 F.3d 1016, at 1024 (11th Cir. 2016)

360. A video recording of the oral argument before the Florida Supreme Court was made, and it is a fascinating document of a court grappling with complex issues it does not usually deal with. *4/6/17 Florida Supreme Court Oral Arguments: Flo & Eddie, Inc., etc., v. Sirius XM Radio, Inc., etc.*, SC16-1161, FLA. CHANNEL, <http://thefloridachannel.org/videos/4617-florida-supreme-court-oral-arguments-flo-eddie-inc-etc-v-sirius-xm-radio-inc-etc-sc16-1161/> (last visited Mar. 22, 2018).

361. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 229 So.3d 305 (Fla. 2017).

362. *Id.* at 311; Zvi S. Rosen, *Another Season, Another Common-Law Copyright Opinion*, MOSTLY IP HISTORY (Oct. 26, 2017), <http://www.zvirosen.com/2017/10/26/another-season-another-common-law-copyright-opinion/> (criticism of this reformulation and the court’s subsequent analysis).

363. *Flo & Eddie*, 229 So.3d at 316.

364. For instance, the court stated that “[e]ven assuming that Florida common law recognizes the existence of a post-sale exclusive right of reproduction in pre-1972 sound recordings, any such right would not be unfettered.” *Id.* at 320.

365. CAL. CIV. CODE § 980(a)(2) provides:

The author of an original work of authorship consisting of a sound recording initially fixed prior to

Although the statute makes clear that exclusive rights vest in the owner of the rights in a sound recording, without recourse to the definition of “publication,” the statute is unclear as to the extent to which “exclusive ownership” includes an exclusive right to public performance. Flo & Eddie thus brought suit against Sirius XM in California, arguing that the California statute does provide such rights. The U.S. District Court for the Central District of California found that in fact it does, looking to the rules of statutory interpretation, as well as limited prior case law, to determine that “exclusive ownership” of the rights in a sound recording includes an exclusive right to publicly perform it.³⁶⁶ The court therefore granted summary judgment in favor of Flo & Eddie. With this decision in hand, Flo & Eddie then brought suit against Pandora in the same California federal court. In February of 2015 the court reaffirmed its opinion in the Sirius XM cases, denying a motion to dismiss by Pandora.³⁶⁷ Pandora appealed to the Ninth Circuit, who felt that certification to the California Supreme Court was needed, to determine whether either the California statute or common law give the owners of rights in sound recordings an exclusive right of public performance.³⁶⁸ As of the writing, the case is currently being briefed before the California Supreme Court.

2. Other Lawsuits

The Flo & Eddie cases have seen the most activity of cases asserting a common-law performance right, by a wide margin. However, they have hardly been the only ones. For instance, following in Flo & Eddie’s footsteps, Zenbu Magazine sued Apple’s Beat Electronics, Sony Entertainment, Google, Rdio, Songza, Slacker, and Escape Media Group for misappropriation and conversion of its pre-1972 sound recordings by The Flying Burrito Brothers, Hot Tuna, and New Riders of the Purple Sage.³⁶⁹ Similarly, an “obscure R&B Group,” The Ponderosa Twins

February 15, 1972, has an exclusive ownership therein until February 15, 2047, as against all persons except one who independently makes or duplicates another sound recording that does not directly or indirectly recapture the actual sounds fixed in such prior recording, but consists entirely of an independent fixation of other sounds, even though such sounds imitate or simulate the sounds contained in the prior sound recording.

366. Flo & Eddie Inc. v. Sirius XM Radio Inc., No. CV 13-5693 PSG (RZx), 2014 U.S. Dist. LEXIS 139053 (C.D. Cal. Sep. 22, 2014); (citing Capitol Records, LLC v. BlueBeat, Inc., 765 F. Supp. 2d 1198 (C.D. Cal. 2010); Bagdasarian Prods., LLC v. Capitol Records, Inc., No. B217960, 2010 Cal. App. Unpub. LEXIS 6590, 2010 WL 3245795 (Cal. Ct. App. August 18, 2010)).

367. Civil Minutes, Order DENYING Pandora’s Anti-SLAPP Motion to Dismiss, Flo & Eddie, Inc. v. Pandora Media, Inc., No. CV-14-07648 D.I. 28 (C.D. Cal. Feb. 23, 2015).

368. Flo & Eddie, Inc. v. Pandora Media, Inc., 851 F.3d 950 (9th Cir. 2017).

369. Eriq Gardner, *Sony, Google, Apple Hit with Lawsuits Over Pre-1972 Music*, BILLBOARD

Plus One, filed a class action lawsuit against Spotify, Apple, Google, SoundCloud, iHeartMedia, Pandora, and Sony Computer Entertainment for copyright infringement of their pre-1972 sound recordings.³⁷⁰

The largest set of lawsuits to argue for common-law performance rights vis-à-vis digital subscription services—ten in all—were brought by Arthur and Barbara Sheridan. Mr. Sheridan “owned and operated record companies specializing in doo-wop, jazz, and rhythm and blues music,” and these suits stem from his rights in these recordings.³⁷¹ In the District of New Jersey the Sheridans brought suit against Sirius XM and Pandora,³⁷² and separately against terrestrial radio giant iHeartmedia, Inc.,³⁷³ for common-law copyright infringement for performance of sound recordings and for unjust enrichment. Four of these suits had already been stayed pending a disposition of the Flo & Eddie cases, and the New Jersey District Court likewise stayed the two cases before them.³⁷⁴ In another suit in Georgia, the U.S. District Court for the Middle District certified a question as to whether a state statute protected defendant iHeartMedia’s internet radio streaming services, and found that Georgia’s criminal antbootlegging statute did in fact protect internet radio stations.³⁷⁵

The most surprising decision to come out of the Sheridan litigation

(Jan. 23, 2015), <http://www.billboard.com/articles/business/6450640/sony-google-apple-lawsuit-pre-1972>. Zenbu actually filed a raft of lawsuits on January 22, 2015. Zenbu Magazines LLC v. Beats Electronics LLC, No. 2:15-cv-00464 (C.D. Cal. Jan. 22, 2015) (dismissed the following day); Zenbu Magazines LLC v. Google, Inc., No. 5:15-cv-00307 (N.D. Cal. Jan. 22, 2015) (dismissed the following day); Zenbu Magazines LLC v. Rdio, Inc., No. 3:15-cv-00311 (N.D. Cal. Jan. 22, 2015) (dismissed the following day); Zenbu Magazines LLC v. Apple Inc., No. 5:15-cv-00309 (N.D. Cal. Jan. 22, 2015) (dismissed the following day); Zenbu Magazines LLC v. Sony Comput. Entm’t America LLC, No. 3:15-cv-00310 (N.D. Cal. Jan. 22, 2015) (dismissed May 21, 2015); Zenbu Magazines LLC v. Slacker, Inc., No. 3:15-cv-00151 (S.D. Cal. Jan. 22, 2015) (dismissed Jan. 28, 2015); Zenbu Magazines LLC v. Songza, Inc., No. 1:15-cv-00351 (E.D.N.Y. Jan. 22, 2015) (dismissed the following day); Zenbu Magazines LLC v. Escape Media Group, Inc., No. 1:15-cv-00349 (E.D.N.Y. Jan. 22, 2015) (dismissed June 1, 2015).

370. Andrew Flanagan, *Digital Giants Including Spotify, Apple Named in Suit from Leader of Obscure R&B Group Over Pre-1972 Licenses*, BILLBOARD (Feb. 2, 2016), <http://www.billboard.com/articles/business/6873918/digital-giants-spotify-apple-suit-pre-1972>; Ponderosa Twins Plus One v. iHeartMedia, Inc., No. 1:16-cv-00953 (S.D.N.Y. Feb. 8, 2016).

371. Sheridan v. iHeartMedia, Inc., No. 15-cv-07574, 2016 WL 1059268, at *3 (D.N.J. Mar. 16, 2016).

372. Sheridan v. Sirius XM Radio, Inc., No. 2:15-cv-07576 (D.N.J. Oct. 19, 2015).

373. Sheridan v. iHeartMedia, Inc., No. 2:15-cv-07574, 2016 WL 1059268 (D.N.J. Oct. 19, 2015).

374. *Id.* The four other cases stayed are: Order Granting Stipulation re: Stay of Further Proceedings, Sheridan v. Sirius XM Radio Inc., No. 3:15-cv-04081 (N.D. Cal. Oct. 28, 2015), ECF No. 32; Order Regarding Stipulation to Stay Further Proceedings, Sheridan v. Sirius XM Radio, Inc., No. 1:15-cv-07056 (S.D.N.Y. Oct. 28, 2015), ECF No. 33; Order Regarding Stipulation to Stay Further Proceedings, Sheridan v. iHeartMedia, Inc., No. 1:15-cv-06747 (S.D.N.Y. Oct. 13, 2015), ECF No. 23; Sheridan v. iHeartMedia, Inc., No. 2:15-cv-04067 (C.D. Cal. May 29, 2015).

375. iHeartMedia, Inc. v. Sheridan, 798 S.E.2d 223 (Ga. 2017)

thus far, though, has come from the U.S. District Court for the Northern District of Illinois, where the court became the first Court in quite some time to hold that public sale of a sound recording constituted a publication under common law, and thus the Sheridans held no common-law rights in Illinois.³⁷⁶ The court found that although the Sheridans had cited common law from other states, the only previous case regarding the publication of sound recordings under Illinois common law was an obscure unpublished disposition, which asserted that “it is eminently clear that the broadcast of the records manufactured by Plaintiff or the sale of those records constitutes a publication or public performance.”³⁷⁷ Although some coverage suggested that this holding was only about whether digital broadcast services have to pay royalties,³⁷⁸ the decision fairly clearly states that common-law copyright protection is not available to commercially sold sound recordings in Illinois, leaving the only remedy as unfair competition.³⁷⁹ Although not raised directly in these cases, a number of courts would note that the arguments raised by Flo & Eddie regarding a public performance right for digital transmission (where federal law provides such a right) really apply with equal force to terrestrial (over the air) radio (where federal law provides no such right).

D. Pre-1972 Sound Recordings and Terrestrial Radio

With the pending litigation against Sirius XM and Pandora, it is unclear whether the common-law performance right should be limited to digital audio transmission, as the federal statute is. It was thus unsurprising when ABS Entertainment, which asserts exclusive ownership in many pre-1972 sound recordings by artists such as Al Green, brought suit against three major players in the terrestrial broadcasting space: iHeartMedia (f/k/a Clear Channel), Cumulus Media, and CBS for common-law copyright infringement in New York and infringement of section 980(a) in California.³⁸⁰

376. *Sheridan v. iHeartMedia, Inc.*, No. 15-CV-09229, 2017 U.S. Dist. LEXIS 85858 (N.D. Ill. June 5, 2017).

377. *Id.* at *10 (quoting *Columbia Broad. Sys., Inc. v. Spies*, No. 69-CH-3477, 1970 WL 10120 (Ill. Cir. Ct. Oct. 19, 1970)).

378. Anandashankar Mazumdar, *Radio Giant, Streamers Avoid Royalties for Illinois Oldies*, BLOOMBERG LAW (June 6, 2017), <https://www.bna.com/radio-giant-streamers-n73014452859>.

379. The court recognized that record piracy had been found to constitute unfair competition, but held that unfair competition did not encompass public performance of a record. *Sheridan*, 2017 U.S. Dist. LEXIS 85858, at *19. No notice of appeal was filed on the docket, indicating that this result will not go before the Seventh Circuit Court of Appeals.

380. *ABS Entm't, Inc. v. iHeartMedia, Inc.*, 1:15-CV-06807 (S.D.N.Y. Apr. 3, 2017); *ABS Entm't, Inc. v. Cumulus Media, Inc.*, 1:15-cv-06806 (S.D.N.Y. Apr. 3, 2017); *ABS Entm't Inc. v. CBS Corp.*, 2:15-CV-06257, (C.D. Cal. 2015); *In re iHeartMedia Pre-1972 Sound Recording Litig.*, Case No.

ABS alleged substantially the same claims in the suits brought in New York , arguing that pre-1972 sound recordings are afforded protection from “unauthorized reproduction, performance, distribution or other exploitation,” and that New York common-law protects these rights regardless of any such limitations in the federal statute.³⁸¹ The ABS cases in New York were stayed in 2015 to allow the Flo & Eddie cases to take their course, and when the New York Court of Appeals found that sound recordings have no performance rights under New York common law, these cases were voluntarily dismissed.³⁸²

In the absence of such a decision from the California Supreme Court,³⁸³ litigation has moved forward on the claims of ABS in the Central District of California. ABS and its co-litigants claim that California Civil Code section 980(a)(2) provides an exclusive right of public performance, unbound of the limitations of federal copyright law regarding sound recordings and broadcast radio.³⁸⁴ Recognizing that in decisions regarding Sirius XM and Pandora, the Central District had interpreted section 980(a)(2) broadly, CBS took a different tack, arguing that state law should not apply at all, since all of the recording played by CBS were digital transfers made after 1972, which they argued would make them post-72 instead of pre-72 sound recordings.³⁸⁵ In essence, the argument made by CBS was that whatever the date of creation of the sound recordings at issue (before 1972 for all relevant ones in this case), everything CBS was playing was a digital transfer of that sound recording made before 1972. CBS thus argued that they were not playing pre-1972 sound recordings protected by state law, they were playing post-1972 derivative works protected by federal copyright

15-cv-4067 (C.D. Cal. June 29, 2017) (ABS and Sheridan cases against iHeartMedia in California consolidated). Other plaintiffs in these cases include Barnaby Records, Inc., Brunswick Record Corporation, and Malaco, Inc., who assert that they own the common-law copyrights to a large number of other pre-1972 sound recordings. ABS Entertainment is the successor in interest to the Cream Records and Hi Records labels, and is based in West Memphis, Arkansas. Amended Complaint at 3, *ABS Entm't, Inc. v. CBS Corp.*, No. 2:15-cv-06257 (C.D. Cal. Aug. 17, 2015), ECF No. 48. *Adalah Bennet Shaw Obituary*, POINSETT CTY. DEMOCRAT TRIB. (June 19, 2008), <http://www.democrattribune.com/story/1438397.html>.

381. Amended Complaint at 41, *BS Entm't, Inc. v. CBS Corp.*, No. 2:15-cv-06257 (C.D. Cal. Aug. 17, 2015), ECF No. 48.

382. Notice of Voluntary Dismissal, *ABS Entm't, Inc. v. iHeartMedia, Inc.*, 1:15-CV-06807 (S.D.N.Y. 2015 Apr. 3, 2017), EFC No. 47; Notice of Voluntary Dismissal, *ABS Entm't, Inc. v. Cumulus Media, Inc.*, 1:15-cv-06806 (S.D.N.Y. Apr. 3, 2017), EFC No. 44.

383. As noted above, the question has in fact been certified to the California Supreme Court, but the case is still being briefed as of August of 2017.

384. Amended Complaint and Demand for Jury Trial at 2, *ABS Entm't, Inc. v. CBS Corp.*, No. 2:15-CV-06257 (C.D. Cal. Aug. 17, 2015), ECF No. 48.

385. Eriq Gardner, *CBS Beats Lawsuit Over Pre-1972 Songs With Bold Copyright Argument*, BILLBOARD (June 1, 2016), <http://www.billboard.com/articles/business/7392764/cbs-beats-lawsuit-pre-1972-songs-bold-copyright-argument>.

law—that the digital transfers were separate copyright entities. Because the digital transfers were post-1972 sound recordings, federal law is clear that CBS does not need to pay royalties.

This approach proved successful, and the court in California dismissed ABS's suit, although an appeal is now pending.³⁸⁶ As an initial matter, the court held that the remastered version of a pre-1972 sound recording qualified as a federally copyrightable derivative work.³⁸⁷ The court determined that, during the remastering process, "at least some perceptible changes were made to Plaintiffs' Pre-1972 Sound Recordings," and that without exception this was sufficient to qualify for federal copyright protection as derivative works.³⁸⁸ While one can take issue with the court's fact finding (it is unlikely that every single remastering qualified for protection as a derivative work), this is a fairly uncontroversial ruling, and is supported by the Copyright Office's own compendium.³⁸⁹ More controversially, the court then concluded that because CBS only performed these "remastered, post-1972 sound recordings," there was no infringement of copyright under California state law.³⁹⁰ The court acknowledged that "the copyright in the derivative works extends only to the original and independent expression contained therein," but nonetheless held that if a copyrightable post-1972 remastering of a pre-1972 recording was played on the radio, only rights under federal law were implicated.³⁹¹ Given that federal law allows CBS the right to "perform post-1972 sound recordings on terrestrial radio without payment," the court held that there was no issue of infringement.³⁹²

The court's ruling suffers from fundamental flaws, and the discussion as to whether digitally remastered works fulfill the originality requirement of copyright obscured the real and separate issue of infringement. The court appeared to give short shrift to the concept that the author of the derivative work gains protection only for the new parts that the author contributed to the base work.³⁹³ Instead, it appears the

386. *ABS Entm't, Inc. v. CBS Corp.*, No. 2:15-cv-06257, 2016 U.S. Dist. LEXIS 71470 (C.D. Cal. May 30, 2016).

387. *Id.* at *4.

388. *Id.* at *11.

389. *Id.*

390. *Id.* at *15.

391. *Id.* *15.

392. *ABS Entm't, Inc.*, 2016 U.S. Dist. LEXIS 71470, at *15 (citing 17 U.S.C. § 114).

393. *Id.*; see also *Roy Export Co. Establishment of Vaduz, Liechtenstein v. Columbia Broad. Sys., Inc.*, 672 F.2d 1095, 1103 (2d Cir. 1982). This doctrine is codified in federal law at 17 U.S.C. § 103(b), but represents a codification of a much older doctrine. See *E.G. Am. Code Co. v. Bensinger*, 282 F. 829, 834 (2d Cir. 1922) (copyright in a work containing public domain elements "is valid as to the new and original matter which has been incorporated therein").

court felt that federal copyright covers the entire derivative work, not just what is contributed to the base work.³⁹⁴ However, the rights of the owner of the underlying common-law copyright may still be infringed even if the rights of the owner of the federally copyrighted derivative work are not, as common-law copyright “survives intact despite the incorporation of that work into a derivative work.”³⁹⁵ In other words, federal copyright law may protect works that incorporate elements that are unpublished and protected by common-law copyright, such as a new sound recording that includes elements of—or even the entirety of—a pre-1972 sound recording. However, despite the inclusion of these elements in a published work, the common-law copyright may still exist for the original sound recording and can still be infringed under state law.³⁹⁶

This argument may have been better in the inverse; in the post-1972 era, remasterings were not independently copyrightable, but rather straightforward publications of unpublished sound recordings. Then, whatever protections existed as unpublished works from before 1976, post-publication only federal law applied. However, Section 301(c) of the Copyright Act forecloses these avenues, and prevents *de jure* federalization completely.³⁹⁷

The preemptive provisions of Section 301(c) are quite broad, encompassing “any rights or remedies under the common law or statutes of any State,” and render any attempt to avoid state-law protection by using federal copyright law essentially impossible. Section 301(c) states that state-law protection for pre-1972 sound recordings “shall not be annulled or limited by this title.”³⁹⁸ In its less frequently cited final sentence, this subsection states that “no sound recording fixed before February 15, 1972, shall be subject to copyright under this title” for all time.³⁹⁹ It is profoundly difficult to square this language with the conclusion that a pre-1972 sound recording can be subject to the

394. *ABS Entm't, Inc.*, 2016 U.S. Dist. LEXIS 71470, at *15.

395. See *Gilliam v. American Broad. Companies*, 538 F.2d 14, 20 (2d Cir. 1976) (citing *Davis v. E.I. DuPont deNumeours & Co.*, 240 F. Supp. 612 (S.D.N.Y. 1965)).

396. The court's cursory analysis on the question of infringement only references one unpublished opinion, *Pryor v. Jean*. No. CV 13-02867, 2014 WL 5023088 (C.D. Cal. Oct. 8, 2014). That was a case under federal, not state, copyright law, where the court dismissed a complaint for copyright infringement over the sampling of a song where the actual samples came from a remastered and edited version of the song, *inter alia* because only the owner of the rights in the remastering would have a valid cause of action for infringement. However, as noted *infra*, it is difficult to square such a limitation on the infringement right with the broader rights of state-law copyright. In addition to this and other difficulties of the analysis, it is difficult to square this analysis with 17 U.S.C. § 301, as noted *supra*.

397. In addition, California's statute does not reference the publication status of a work, unlike the common law of other states.

398. 17 U.S.C. § 301 (2012).

399. *Id.*

limitations of federal law merely because it was remastered.

E. Safe Harbor Cases

Vimeo is a video-sharing website platform that lets users upload and share videos, and requires users to have created, at least partially, the videos they upload.⁴⁰⁰ Capitol Records and others brought suit against Vimeo, alleging *inter alia* common-law copyright infringement of pre-1972 sound recordings.⁴⁰¹ Ordinarily, the plaintiffs would need to follow the notice-and-takedown system established by the Digital Millennium Copyright Act (DMCA) as a prerequisite to bringing suit, and failure to do so would immunize Vimeo from liability.⁴⁰² The relevant “safe harbor” provision of the DMCA states that subject to certain requirements, service providers shall not be liable “for infringement of copyright by reason of the storage at the direction of a user.”⁴⁰³ The U.S. District Court for the Southern District of New York granted summary judgment to the plaintiffs on the threshold issue that the safe harbor does not apply to videos containing pre-1972 sound recordings, defining “copyright” under this section to mean only federal statutory copyright.⁴⁰⁴ However, the court allowed an interlocutory appeal on the question of “whether the DMCA’s safe-harbor provisions are applicable to sound recordings fixed prior to February 15, 1972.”⁴⁰⁵

On appeal, the Second Circuit Court of Appeals held that section 512 applies to pre-1972 sound recordings, and accordingly vacated the district court’s grant of partial summary judgment to plaintiffs on this matter.⁴⁰⁶ In a decision heavily focused on public policy and Congressional intent, Judge Pierre Leval asserted that interpreting the DMCA to leave ISPs exposed to liability under state copyright law would rebuff congressional intent.⁴⁰⁷ Judge Leval argued that “services providers would be compelled either to incur heavy costs of monitoring every posting to be sure it did not contain infringing pre-1972 recordings, or incurring potentially crushing liabilities under state

400. *Capitol Records, LLC v. Vimeo, LLC*, 972 F.Supp.2d 537, 542 (S.D.N.Y. 2013).

401. *Id.*

402. *Id.*

403. *Id.*; *see also* 17 U.S.C. § 512(c)(1) (2012).

404. *Capitol Records*, 972 F.Supp.2d at 542.

405. *Id.* at 556.

406. *Capitol Records, LLC v. Vimeo, LLC*, 826 F.3d 78 (2d Cir. 2016). The Court also applied the standard set forth in *Viacom International, Inc. v. YouTube, Inc.*, and found that some viewing by Vimeo employees did not exempt the service from safe harbor. On the question of willful blindness, the court affirmed the district court’s ruling in Vimeo’s favor. *Id.*

407. *Id.*; *Vimeo Wins U.S. Appeal in Music Copyright Case*, WESTLAW J. INTELLECTUAL PROP., June 2016, at 11.

copyright laws.”⁴⁰⁸ The recording industry was obviously disappointed in this result and petitioned for *en banc* review.⁴⁰⁹ One unexpected consequence of this decision might be to slow the march towards federalization of pre-1972 sound recordings—an opposite ruling by the court would have likely created a crisis that would have essentially forced Congress to take up the issue. Of course, the question of the relationship between section 512 and pre-72 sound recordings is still open in all other circuits.

VI. THE NATURE OF COMMON-LAW COPYRIGHT I: OWNERSHIP

As we have seen, common-law copyright has been invoked over the past two centuries in support of claims that go well beyond what the federal law then in force provides for. However, for a legal doctrine that protects intellectual property worth billions of dollars, the nature of common-law copyright has remained largely unexamined. The following three sections will explore what common-law copyright truly is, and develop a cohesive theory of common-law copyright as a body of law distinct from statutory copyright, even though they naturally share many parallels.

A. Initial Ownership and Fixation

The ownership of the common-law copyright initially vests in the author of the work in question.⁴¹⁰ This right vests once the “new and innocent product of mental labor . . . has been embodied in writing.”⁴¹¹ The subject matter of statutory copyright is similar to common-law copyright, but common-law copyright is not limited by the constitutional requirement that copyright only protects “writings.” Some cases have suggested that common-law copyright may extend to unwritten creations as well, such as conversational speech.⁴¹² This makes sense in the context of the protection of sound recordings: if common-law copyright only protected works that were “writings” within the meaning of the Constitution or federal copyright law, it would likewise possibly exclude

408. *Capitol Records*, 826 F.3d at 90.

409. Rhian Jones, *A2IM, RIAA and Concord Support Capitol Records in Vimeo Lawsuit*, MUSIC BUS. WORLDWIDE (July 21, 2016), <http://www.musicbusinessworldwide.com/a2im-riaa-concord-support-capitol-records-vimeo-lawsuit/>.

410. *Palmer v. De Witt*, 47 N.Y. 532, 536 (1872) (“The author of a literary work or composition has, by law, a right to the first publication of it.”).

411. *Id.* at 537.

412. *Hemingway’s Estate v. Random House, Inc.*, 244 N.E.2d 250, 255 (N.Y. 1968); *Jenkins v. News Syndicate Co.*, 219 N.Y.S. 196, 199 (Sup. Ct. 1926); Thomas J. Griffin, *Common-Law Copyright in the Spoken Word*, 32 A.L.R.Fed. 3d 618 (1970) (citing the 1966 edition of *Nimmer on Copyright*).

sound recordings.

In the absence of evidence to the contrary, the default assumption is that the author owns the common-law copyright to the work in question.⁴¹³ However, common-law copyright in works created in the scope of employment is the property of the employer, as in statutory copyright.⁴¹⁴ It is unclear if the limitations of the work-for-hire doctrine under statutory copyright are applicable to common-law copyright as well.

B. Assignability and Divisibility

An author may transfer his or her common-law copyright.⁴¹⁵ The common-law copyright or “property in a manuscript” is indistinguishable from any other personal property.⁴¹⁶ It is governed by the “same rules of transfer and succession . . . protected by the same process, and has the benefit of all the remedies accorded to other property so far as applicable.”⁴¹⁷ Because “[t]he right of sale and transfer is one of the inseparable incidents of property,” common-law copyrights may be assigned to others and these assignees’ rights will be protected just as if they were the author’s.⁴¹⁸ For common-law copyrights, the assignments do not have to be in writing or observe any formalities.⁴¹⁹

Although statutory copyright was indivisible under the various copyright acts before 1978, courts have always allowed some form of divisibility of common-law copyrights.⁴²⁰ In *Palmer v. De Witt*, involving the rights to perform the drama *Play in America*, the plaintiff had acquired “the right to the first publication of [the] drama, as well as the right to represent the same upon the stage in the United States” from a British author.⁴²¹ These rights would have allowed the plaintiff to

413. *Williams v. Weisser*, 273 Cal. App. 2d 726, 733 (Ct. App. 1969).

414. *See Bajpayee v. Rothermich*, No. 76AP-919, 1977 WL 200196, at *1 (Ohio Ct. App. June 7, 1977) (“Plaintiff was employed as a biochemist in charge of the research laboratory of Columbus Medical Center Foundation[.] . . . While so employed, plaintiff made discoveries . . . and set forth such discoveries in an article, which was not published[.] . . . Plaintiff concedes he has no common-law copyright interest in the publication and that the discovery because of shop rights is the property of the employer, rather than that of the plaintiff.”).

415. *Richlin v. Metro-Goldwyn-Mayer Pictures, Inc.*, 531 F.3d 962, 972 (9th Cir. 2008).

416. *Palmer v. De Witt*, 47 N.Y. 532, 538 (1872).

417. *Id.*

418. *Id.* at 540.

419. *Self-Realization Fellowship Church v. Ananda Church of Self-Realization*, 206 F.3d 1322, 1325 (9th Cir. 2000).

420. ABRAHAM L. KAMINSTEIN, *DIVISIBILITY OF COPYRIGHTS* (1957), <https://www.copyright.gov/history/studies/study11.pdf>.

421. *Palmer*, 47 N.Y. at 533, 541.

restrain everyone, including the author, from “publishing the work within the United States to his prejudice.”⁴²² Although the court was not concerned with whether “the instrument is called a transfer or a license,”⁴²³ in essence, the plaintiff was assigned partial geographical rights of the drama’s common-law copyright, in a way that would not have been permissible under the statute.

Courts have also allowed divisibility of portions of the derivative work right for common-law copyrights. For example, in *Muller v. Walt Disney Productions*, a conductor entered into a contractual relationship with Disney in regards to the music he rendered and performed for Disney’s feature film, *Fantasia*.⁴²⁴ Disney specifically negotiated for the “sole charge and control of the manner in which, and the terms upon which, said photoplay shall be distributed, [exploited] and/or exhibited, and the ownership of all rights in connection with said photoplay shall belong to [Disney].”⁴²⁵ However, the conductor still owned the common-law copyright to the underlying arrangements and orchestrations—albeit with a complicated licensing structure to Disney—and as such, when Disney wanted to use *Fantasia* music in phonograph records, Disney and the conductor entered into a subsequent agreement with royalties to be paid to the conductor.⁴²⁶

Similarly, in *Gilliam v. American Broadcasting Companies, Inc.*, the Monty Python group granted the BBC the right to create television programs based on their common-law copyrighted scripts, as well as the right to license such programs out to parties in other countries, but the Monty Python group specifically retained all remaining rights in the unpublished script.⁴²⁷ Thus, courts have recognized that authors may enter into contracts that split off parts of their common-law copyright in regards to different types of derivative works.

C. Adverse Possession

Adverse possession is a common-law doctrine that allows a person to acquire valid title to property that is not legally his so long as the possession is (1) continuous; (2) hostile; (3) open and notorious; (4) actual; and (5) exclusive.⁴²⁸ Federal copyright law “has never had any

422. *Id.* at 541.

423. *Id.*

424. *Muller v. Walt Disney Prod.*, 871 F. Supp. 678, 680 (S.D.N.Y. 1994).

425. *Id.*

426. *Id.*

427. *Gilliam v. American Broad. Companies*, 538 F.2d 14, 14 (2d Cir. 1976)

428. *Adverse Possession*, LEGAL INFO. INST., CORNELL UNIV. LAW SCH., https://www.law.cornell.edu/wex/adverse_possession# (last updated Aug. 2016).

version of adverse possession.”⁴²⁹ However, several courts have recognized that adverse possession is a valid method for the transfer of common-law copyrights.

In 1915, the New York Supreme Court considered whether common-law copyright could be acquired by adverse possession. The owner of the common-law copyright in the English dramatization of *The Count of Monte Cristo* filed suit against a film company that was seeking to adapt the story.⁴³⁰ The film company claimed they were only using the Dumas novel *The Count of Monte Cristo* as source material, but the suit claimed they were using the manuscript dramatization as well. The defendants asserted that the plaintiffs had no right to the manuscript drama, but the trial court held that the plaintiffs had “valid title to the manuscript play by adverse possession.”⁴³¹ On appeal, the plaintiff-appellee expanded on this argument by asserting that even if they only had possession of the manuscript and the successful defense of their claim for thirty years, this “would be sufficient title as against a pirate who makes no claim of ownership.”⁴³² The appellate court acknowledged this argument,⁴³³ but did not find any precedent for the position that adverse possession could be used for common-law copyrights, and disposed of the case on other grounds.⁴³⁴

This particular theory has mostly been overlooked by courts until a 1979 case revived it.⁴³⁵ In *Gee v. CBS, Inc.*, the purported heirs of Bessie Smith⁴³⁶ sued CBS, Inc.,⁴³⁷ for, among other things, “re-recording the original 78 r.p.m. songs in the 1950s and again in the

429. Robert Brauneis, *Copyright and the World's Most Popular Song*, 56 J. COPYRIGHT SOC'Y U.S.A. 335, 340 (2009).

430. O'Neill v. General Film Co., 152 N.Y.S. 599 (1915).

431. *Id.* at 603.

432. Brief of Plaintiff-Respondent at 19, O'Neill v. General Film Company, 171 A.D. 854 (1916) (emphasis removed).

433. *Id.* at 864 (“Title to a *chattel* may be acquired by adverse possession and claim of ownership, and on the evidence title to *the manuscript* by adverse possession and claim of ownership was sufficiently shown . . . but present title to the manuscript, while some evidence of the ownership of the play, if standing alone, might be insufficient to sustain the action, for the owner might have parted with possession of the manuscript without parting with his rights as an author.” (citations omitted)).

434. *Id.* at 864 (“No decision is cited, and we have found none, which holds that *such* rights may be acquired by adverse possession and claim of ownership.”).

435. *Gee v. CBS, Inc.*, 471 F. Supp. 600 (E.D. Pa. 1979), *aff'd without op.*, 612 F.2d 572 (3d Cir. 1979).

436. Bessie Smith was known as the “Empress of the Blues” and one of America’s most well-known recording stars during the 1920s. *Id.* at 609–10. She was an exclusive recording artist for Columbia Phonograph Company from 1923 to her death in 1937. *Id.* at 610. The plaintiffs in this case are Jack Gee, Jr., the alleged adopted son of Bessie Smith and Jack Gee, Sr., and the executor of Jack Gee, Sr.’s estate. *Id.*

437. CBS, Inc. is the parent company of Columbia Records, Inc., which, in turn, was the successor to Columbia Phonograph Company. *Id.*

1970s without the permission of Bessie Smith's heirs."⁴³⁸ The plaintiffs claimed that Smith had a property interest in "her *singing* style on the 160 records," essentially arguing that "Smith had acquired rights in her artistic performance which have descended to her heirs."⁴³⁹ Because federal copyright law neither protected a singer's performance rights nor sound recordings at the time when Smith's rights vested, the court looked to state law.⁴⁴⁰

The court dismissed claims over the 1972 re-issuance of "At the Christmas Ball" on the basis that Columbia had adversely possessed it.⁴⁴¹ The court reasoned that while adverse possession was generally applied only to real property, it also applied to personal property and more importantly, intangible property rights.⁴⁴² New York had already applied the adverse possession doctrine to intangible property rights with *Lightfoot v. Davis*,⁴⁴³ and although Pennsylvania had not yet considered the question, the court pointed to the Pennsylvania Supreme Court's statement in *Waring v. WDAS Broadcasting Station* as support for their view that common-law copyrights are substantially similar to other forms of property.⁴⁴⁴ The court found that all the requirements of adverse possession had been fulfilled, and Columbia had successfully gained valid title to "At the Christmas Ball" in New York and Pennsylvania.⁴⁴⁵

Courts have been reluctant to make definitive statements on the applicability of adverse possession to intangible property. In *Sporn v. MCA Records, Inc.*, despite a dissent raising the issue for consideration, the New York Court of Appeals found "no reason to consider . . . the applicability of the doctrine of adverse possession to intangible property," as the plaintiff's claim was time-barred by the statute of limitations.⁴⁴⁶ However, one recent unpublished case accepted the use of the Louisiana equivalent of adverse possession for common-law copyright.⁴⁴⁷ In *Modeliste*, plaintiff, who was a member of a recording

438. *Id.* at 611.

439. *Id.*

440. *Id.* at 647.

441. *Gee*, 471 F. Supp. at 653, 657.

442. *Id.* at 653–55.

443. *Id.* at 654 (citing *Lightfoot v. Davis*, 92 N.E. 582, 583 (1910)).

444. *Id.* at 655 ("At common-law, rights in a literary or artistic work were recognized on substantially the same basis as title to other property.") (quoting *Waring v. WDAS Broad. Station*, 194 A. 631, 634 (Pa. 1937)).

445. *Id.* at 657. This decision was affirmed by the Third Circuit, but without an opinion. *Gee v. CBS, Inc.*, 612 F.2d 572 (3d Cir. 1979); *cf.* Matthew W. Daus, *The Adverse Possession of Copyright*, 13 LOY. L.A. ENT. L.J. 45, 97 (1992).

446. *Sporn v. MCA Records, Inc.*, 58 N.Y. 2d 482, 486–87, 489 (1983).

447. *Modeliste v. Sehorn*, No. 2007–CA–0297, 2008 WL 8917564, at *2–3 (La. App. Oct. 22, 2008).

group, entered into a royalties contract with a music publisher, but the publisher never paid royalties.⁴⁴⁸ The defendant argued that they had acquired rights in the recordings by acquisitive prescription, which is defined simply as “a mode of acquiring ownership or other real rights by possession for a period of time.”⁴⁴⁹ The court did not dispute that intellectual property could be acquisitively prescribed, although “proof of adverse possession of [intellectual property] is not as easy” as for tangible property.⁴⁵⁰

Courts have thus far recognized that adverse possession may be applicable to common-law copyright, even as they remain uneasy about its use. Thus far it does not seem that adverse possession has otherwise come up in pre-1972 cases, but there is no reason it should not.

D. Publication and Duration

It is axiomatic that common-law copyright is perpetual; it lasts until “the sun rises in the west and sets in the east.”⁴⁵¹ Although protection is perpetual, “when a work is published in print, the owner’s common-law rights are lost.”⁴⁵² This forms the balance of common-law copyright: strong rights that go even beyond those of statutory copyright, but with the caveat that they expire when the author publishes, and thus abandons his or her common-law rights. The duration of common-law copyright can, however, be affected by both federal or state action, and any remaining state-law protections for sound recordings, including common-law copyright, will be preempted as of 2067, barring further legislation.⁴⁵³

Prior to 1909, copyright needed to be secured before publication to receive protection, and publication before registration abandoned any protection the work might have had.⁴⁵⁴ Under the 1909 Act (as amended) copyright was secured by publication with notice of copyright, with registration a required step for litigation and renewal of

448. *Id.* at *1.

449. LA. CIV. CODE ANN. art. 3446 (1983).

450. *Modeliste*, 2008 WL 8917564, at *3.

451. GEORGE R.R. MARTIN, *A DANCE WITH DRAGONS* 1032 (2015); *Bobbs-Merrill Co. v. Straus*, 210 U.S. 339, 347 (1908).

452. *Id.* (quoting EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES* 100 (1879)).

453. 17 U.S.C. § 301 (2012). The California statute has rights expiring in 2047, the date in the federal statute until 1998. However, as of July 2016 the California statute had not been amended to 2067. CAL. CIV. CODE § 980(a)(2) (West, Westlaw through Ch. 9 of 2017 Reg. Sess).

454. Copyright Act of 1790, 1 Stat. 124; Copyright Act of 1831, 4 Stat. 436; Copyright Act of 1870, 16 Stat. 198. It has also historically been possible to register unpublished musical and dramatic works.

the term.⁴⁵⁵ Under the 1909 Copyright Act, publication without notice of copyright abandoned all copyright protection. While publication can no longer divest a work of copyright protection under the 1976 Copyright, publication remains an important term of art, relevant to matters including the term of protection of works created for hire.⁴⁵⁶

Copyright law recognizes two forms of publication: limited publication and general, or “divestitive,” publication.⁴⁵⁷ As previously discussed, performance is not considered publication.⁴⁵⁸ General or divestitive (the terms are synonymous) publication involves distribution to “members of the public at large without regard to who they are or what they propose to do with it,” and is considered a dedication to the public such that the work becomes public domain.⁴⁵⁹ Limited publication occurs when distribution has occurred but only to “a limited class of persons and for a limited purpose” and therefore does not qualify as triggering the publication right.⁴⁶⁰ General or divestitive publication is not related to federal copyright law—it operates to destroy common-law copyright and is a question of state law.⁴⁶¹

Under the 1909 Copyright Act and earlier federal copyright statutes, courts would apply “different tests of publication depending on whether plaintiff is claiming” the benefit of common-law copyright or statutory copyright.⁴⁶² Courts required that a high bar of publication be met in order for common-law copyright to be considered divested, but a low bar to be met for a publication to be sufficient to invest a work with federal copyright protection (“investitive” publication).⁴⁶³ Cases and commentators have largely treated this distinction as being results-oriented jurisprudence,⁴⁶⁴ but publication is actually two entangled doctrines—general and limited publication—that carry different standards. The question of divestitive publication is best understood as a question of state law, while investitive publication is a question of federal law, especially regarding works where investitive publication is

455. Copyright Act of 1909, Pub. L. No. 60-349, 35 Stat. 1075 (1909).

456. 17 U.S.C. § 302(c) (2012).

457. *Burke v. National Broad. Co., Inc.*, 598 F.2d 688, 691 (1st Cir. 1979).

458. *Id.*

459. *Id.*

460. *Id.* at 692.

461. *Am. Vitagraph, Inc. v. Levy*, 659 F.2d 1023, 1026–27 (9th Cir. 1981).

462. *Am. Visuals Corp. v. Holland*, 239 F.2d 740, 744 (2d Cir. 1956).

463. *Id.* An investitive publication can be a limited publication, but the act of obtaining federal protection destroys common-law copyright in the work by operation of the Supremacy Clause of the Constitution. *Id.*

464. *Id.*; HOWARD B. ABRAMS, *Publication Prior to the 1976 Copyright Act — “Investive” and “Divestive” Publication—Are the Standards Different?*, 1 THE LAW OF COPYRIGHT § 8:13 (2016).

impossible.⁴⁶⁵

This position was embraced by the Supreme Court in a footnote to *Goldstein v. California*, which states:

We have no need to determine whether, under state law, these recordings had been published or what legal consequences such publication might have. For purposes of federal law, “publication” serves only as a term of the art which defines the legal relationships which Congress has adopted under the federal copyright statutes.⁴⁶⁶

With this footnote, the Court indicated that divestitive publication for purposes of common-law copyright was a question of state law, a question that did not seem to have been addressed head-on previously.⁴⁶⁷ This helps clarify cases like *Waring v. WDAS* that apply a state-specific definition for general publication. The courts were not interpreting publication for purposes of the federal statute, but rather a separate Pennsylvania doctrine of the same name.⁴⁶⁸ Of course, this also means that there is a different rule for divestitive publication of a pre-1972 sound recording in each state, as it is a question of state law. If it were otherwise we would have a federal doctrine for whether sound recordings retain common-law protection, even if the contours would be different from state to state.

VII. THE NATURE OF COMMON-LAW COPYRIGHT II: EXCLUSIVE RIGHTS

Copyright under the federal statute encompasses a number of different exclusive rights of the author.⁴⁶⁹ The scope of two of those rights have been discussed above: public performance and digital transmission of a sound recording. This section will explore the remaining exclusive rights of common-law copyright, including moral rights not included in the federal statute.

A. The Core Distribution and First Publication Right

The traditional core of statutory copyright is the act from which the term itself springs—the right to make copies of a work. For common-

465. Howard I. Kalodner & Verne W. Vance, Jr., *The Relation Between Federal and State Protection of Literary and Artistic Property*, 72 HARV. L. REV. 1079, 1095–96 (1959).

466. *Goldstein v. California*, 412 U.S. 546, 570 n.25 (1973)

467. See *Ferris v. Frohman*, 32 S.Ct. 263 (1912).

468. *Waring v. WDAS Broad. Station, Inc.*, 327 Pa. 433, 433 (1937).

469. 17 U.S.C. § 106 (2012).

law copyright, on the other hand, the right of first publication is the core right.⁴⁷⁰ In the context of common law, the distribution right reserved to the copyright holder refers to distributions which are not publications and the “right of first publication.”⁴⁷¹ The author has the “right to determine whether [the work] shall be published at all, and if published, when, where, by whom, and in what form.”⁴⁷² The right when stated this way is obviously core to the idea of common-law copyright—it allows authors to choose whether to allow their work to be publicized, and the method by which their work will be publicized. Publication then destroys the author’s common-law rights.

B. The Subsidiary Reproduction Right

The reproduction right refers to the exclusive right of copyright holders “to reproduce the copyrighted work in copies or phonorecords.”⁴⁷³ Since the statutory copyright term now “subsists from its creation and . . . endures for a term consisting of the life of the author and 70 years after the author’s death,”⁴⁷⁴ the author may use any and all of his exclusive statutory rights, including publication and reproduction, until such time as the term ends. In other words, the statutory copyright holder has the “right to multiply copies or to control the subsequent issue of copies by others.”⁴⁷⁵ However, the author at common-law only has a “right to the first publication” and “once published[,] it is dedicated to the public.”⁴⁷⁶ Thus, the common-law copyright holder has “the right to make copies before publication and the right of first publication.”⁴⁷⁷

Common-law copyright is frequently viewed as only the right to first publication.⁴⁷⁸ However, the more accurate view is that common-law copyright encompasses all rights, which are exclusive to the holder, to a copyrightable work so long as there has been no publication. In other words, common-law copyright is copyright before publication.⁴⁷⁹ The

470. “The typical, but by no means sole, common-law claim involved the right of first publication—the right to control when and in what form a work would be released to the public.” WILLIAM F. PATRY, *Overview of Exclusive Rights: The Common-Law*, 3 PATRY ON COPYRIGHT § 8:9 (2017).

471. *Palmer v. De Witt*, 47 N.Y. 532, 536 (1872); *Hemingway’s Estate v. Random House, Inc.*, 244 N.E.2d 250, 254 (N.Y. 1968).

472. *Palmer*, 47 N.Y. at 536.

473. 17 U.S.C. § 106(1).

474. 17 U.S.C. § 302(a) (2012).

475. *Palmer*, 47 N.Y. at 536.

476. *Id.* at 536.

477. *Werckmeister v. Am. Lithographic Co.*, 134 F. 321, 324 (2d Cir. 1904).

478. *Palmer*, 47 N.Y. at 536.

479. *Id.*

right to reproduce prior to general publication, which, as a dedication to the public, eliminates common-law copyright,⁴⁸⁰ is necessary because the author can hardly “determine whether [the work] shall be published at all, and if published, when, where, by whom, and in what form”⁴⁸¹ without it.

Common-law copyright is intended to grant the author some form of compensation, whether that be from the first publication profits or a sale of his copyright.⁴⁸² By definition, a limited publication has already exercised the right of both reproduction and distribution but has not yet forfeited the common-law copyright.⁴⁸³ The “exhibition or private circulation of the original *or of printed copies* is not a publication,” and “no rights inconsistent with or adverse to such restrictions are surrendered.”⁴⁸⁴ Because works are “inviolable while they remain unpublished,”⁴⁸⁵ there is “no doubt” that the “common-law copyright or control of the right to reproduce belongs to the artist or author until disposed of him [by publication] and will be protected by the courts.”⁴⁸⁶

A question that has not been raised thus far is whether common-law copyright has the same limitations on the reproduction right for sound recordings as are found in the federal statute. Section 114(b) of the Copyright Act states that the reproduction right is “limited to the right to duplicate the sound recording in the form of phonorecords or copies that directly or indirectly recapture the actual sounds fixed in the recording.”⁴⁸⁷ In other words, while other copyrightable works are protected against both literal and nonliteral copying, sound recordings are only protected under federal law from literal copying. If performance rights are not limited under common-law the way they are under the federal copyright statute, though, there is no reason to think reproduction rights are so limited, either.

C. The Derivative Works Right

Derivative works are defined in the Copyright Act of 1976 as works “based upon one or more preexisting works,” in “any form in which a

480. *Werckmeister*, 134 F. at 324.

481. *Palmer*, 47 N.Y. at 536.

482. *Werckmeister*, 134 F. at 325 (“The author of dramatic compositions is entitled to the profit arising from public delivery or performance, to the sale of the manuscript, and to the printing and publishing of it.”).

483. *Id.* at 326.

484. *Id.* (emphasis added).

485. *Palmer*, 47 N.Y. at 536.

486. *Pushman v. New York Graphic Soc., Inc.*, 39 N.E.2d 249, 250–51 (N.Y. 1942).

487. 17 U.S.C. § 114 (2012).

work may be recast, transformed, or adapted.”⁴⁸⁸ The author of the derivative work has copyright in new material contributed to the preexisting work, but the copyright of the derivative work is independent of the copyright protection in the original material.⁴⁸⁹ For common-law copyrights, the scheme is much the same.⁴⁹⁰ The common-law copyright holder had “absolute” rights in his intellectual property until the author voluntarily parted with it through publication, including the exclusive right to create derivative works or authorize others to create derivative works.⁴⁹¹ As discussed below, an unauthorized derivative work infringes upon a common-law copyright holder’s rights.

Courts have assumed that the exclusive derivative works right existed for common-law copyrights.⁴⁹² For example, in *Meta-Film Associates, Inc. v. MCA, Inc.*, the plaintiff alleged that the defendants had copied a motion picture and TV series from an unpublished screenplay owned by the plaintiff, infringing the plaintiff’s common-law copyright.⁴⁹³ The court denied the defendants’ motion for summary judgment, allowing claims for infringement of the derivative work right at common-law to go forward.⁴⁹⁴

Even where the derivative work is authorized, unless the holder assigns his own rights in the underlying work, the author of the derivative work gains protection only for those original parts of the product that he contributed.⁴⁹⁵ There is some ambiguity as to whether the common-law copyright in the preexisting work is lost if an authorized derivative work enters into the public domain. Some courts believe that, based on the Supreme Court’s decision in *Stewart v.*

488. Copyright Act of 1976, 17 U.S.C. § 101 (2012).

489. 17 U.S.C. § 103 (2012). The statutory scheme was roughly the same in the Copyright Act of 1909. 17 U.S.C. § 7 (repealed effective 1978).

490. The Copyright Act of 1976 has preempted many common-law copyright claims and converted most into statutory copyrights with a few notable exceptions. 17 U.S.C. § 301 (2012).

491. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 551 (1985).

492. *See, e.g., Roberts v. Petrova*, 213 N.Y.S. 434, 434–35 (1925) (plaintiff with common-law copyright in screenplay charges defendant with infringement for producing and publishing the play as her own production; dramatization of manuscript is a derivative work); *Casino Prod. v. Vitaphone Corp.*, 295 N.Y.S. 501, 502–04 (1937) (Plaintiff sued defendant for creating a motion picture of their play without authorization; a motion picture version of a work is a derivative work); *UMG Recordings, Inc. v. MP3.Com, Inc.*, 92 F.Supp.2d 349, 350 (2000) (plaintiff sued defendant for purchasing tens of thousands of CDs and converting said CD sound recordings into digital sound recordings; transforming CDs into digital sound recordings is a transformation into a derivative work).

493. *Meta-Film Associates, Inc. v. MCA, Inc.*, 568 F. Supp. 1346, 1349–50 (C.D. Cal. 1984).

494. *Id.* at 1361.

495. *Roy Export Co. Establishment of Vaduz, Liechtenstein v. Columbia Broad. Sys., Inc.*, 672 F.2d 1095, 1103 (2d Cir. 1982). This is similar to how statutory copyright treats derivative works. *See* 17 U.S.C. § 103(a), (b) (2012).

Abend,⁴⁹⁶ section 7 of the Copyright Act of 1909 applies to both statutory and common-law copyright. The status of the derivative work, therefore, does not affect the “‘force or validity’ of the copyright in the matter from which it is derived.”⁴⁹⁷ However, starting from *Batjac Productions Inc. v. GoodTimes Home Video Corp.* in 1998, courts that have addressed this issue have held that section 7 of the 1909 Act only refers to statutory copyright and the entrance of a derivative work into the public domain also puts the parts of the preexisting work that was incorporated into the derivative work into the public domain.⁴⁹⁸

D. The Quiet Public Display Right

While the exclusive right to publicly display one’s work is guaranteed under the Copyright Act of 1976,⁴⁹⁹ whether such exclusive right exists under common-law is much murkier. Most common-law cases in this area are more concerned with whether public display of a work constitutes publication and thus, a forfeit of the common-law right.⁵⁰⁰ Publicly displaying the author’s work pre-publication is a violation of their author’s common-law rights, though.⁵⁰¹ As previously mentioned, the point of common-law is to protect the author’s right to decide on what terms, if any, the author’s work will be revealed to the public.⁵⁰² There is little chance of the public display right being violated as of 2016, however, as common-law copyright has been abrogated for all works save for sound recordings,⁵⁰³ and it is difficult to conceive of a way to publicly display a sound recording.

496. *Stewart v. Abend*, 495 U.S. 207, 231–33 (1990).

497. *Gilliam v. American Broad. Co., Inc.*, 538 F.2d 14, 19–20 (2d Cir. 1976); *Jim Henson Prod., Inc. v. John T. Brady & Assoc., Inc.*, 867 F. Supp. 175, 185–86 (S.D.N.Y. 1994).

498. *Batjac Prod., Inc. v. GoodTimes Home Video Corp.*, 160 F.3d 1223, 1231 (9th Cir. 1998); *see also Shoptalk, Ltd. v. Concodre-New Horizons Corp.*, 168 F.3d 586, 592–93 (2d Cir. 1999).

499. The Copyright Act of 1976, 17 U.S.C. § 106(5) (2012) (“Subject to sections 107 through 122, the owner of the copyright under this title has the exclusive right[] to do and to authorize any of the following: (5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly[.]”).

500. *Compare Am. Tobacco Co. v. Werckmeister*, 207 U.S. 284, 299–300 (1907) (public display of work does not constitute publication) *with Letter Edged in Black Press, Inc. v. Public Building Comm’n of Chicago*, 329 F. Supp. 1303, 1305 (N.D. Ill. 1970) (public display with no restrictions on copying constitutes publication).

501. *Kurfiss v. Cowherd*, 121 S.W.2d 282, 286 (Mo. 1938).

502. *Palmer v. De Witt*, 47 N.Y. 532, 536 (1872).

I. 503. 17 U.S.C. § 301 (2012)

E. Moral Rights

Moral rights, also known as *droit moral*, is focused on attribution and integrity (protection against mutilation), both of which deal with “the right of the artist to have his work attributed to him in the form in which he created it.”⁵⁰⁴ Moral rights revolve around fairness: lack of attribution prevents an author from receiving his proper due from the public, and mutilation subjects an author to public criticism for a work that is not his own.⁵⁰⁵ Although the federal copyright statute does not recognize moral rights due to its focus on authors’ economic rights,⁵⁰⁶ as discussed below courts have recognized the existence of moral rights under common-law copyright.

Although case law is sparse, it seems that there is a right of attribution under common-law copyright. Even when authors relinquish or assign their common-law copyrights to an employer, “there is no way that it [can] be reasonably concluded” that authors relinquish “the right to have recognition for [their] own work and ideas.”⁵⁰⁷ However, in the same decision the court equivocated as to whether “failure to give recognition to plaintiff upon an authorized publication,” would constitute a violation of a common-law right of attribution.⁵⁰⁸

By contrast, *Gilliam v. ABC* represents a powerful assertion of the relevance of the right to protection from mutilation of their works at common-law.⁵⁰⁹ Authorization to other parties to use a work protected by common-law copyright in a derivative work may not exceed the “specific purpose for which permission was granted.”⁵¹⁰ Since “the ability of the copyright holder to control his work remains paramount,” mutilation, or unauthorized editing, of the underlying work constitutes infringement of a common-law copyright for exceeding the terms of the license.⁵¹¹ In other words, the common-law copyright holder has the right to forbid mutilation of their work.

504. *Gilliam v. American Broad. Co., Inc.*, 538 F.2d 14, 24 (2d Cir. 1976).

505. *Mass. Museum of Contemporary Art Found., Inc. v. Buchel*, 593 F.3d 38, 49 (1st Cir. 2010).

506. *Carter v. Helmsley-Spear, Inc.*, 71 F. 3d 77, 81–82 (2nd Cir. 1995).

507. *Bajpayee v. Rothermich*, No. 76AP-919, 1977 WL 200196, at *3 (Ohio Ct. App. June 7, 1977).

508. *Id.* at *5.

509. *Gilliam*, 538 F.2d at 24.

510. *Id.* The scripts provided by Monty Python were protected by common-law copyright. *Id.* at 19 n.3.

511. *Id.* at 21.

VIII. THE NATURE OF COMMON-LAW COPYRIGHT III: DEFENSES AND
REMEDIES

A. Fair Use

Fair use is an affirmative defense to copyright infringement that looks to the nature, purpose, and effect of the infringement.⁵¹² Congress codified fair use in the 1976 Act, although the doctrine was recognized as early as 1841.⁵¹³ Courts recognized that the “author’s consent to a reasonable use of his copyrighted works”⁵¹⁴ was necessary “to promote the progress of science and useful arts.”⁵¹⁵ However, because the doctrine turned on the “author’s implied consent to ‘reasonable and customary’ use” and because common-law copyright holders were frequently viewed as having “absolute” protection until publication, courts traditionally did not recognize fair use as a defense to infringement of common-law copyright over unpublished works.⁵¹⁶ However, as early as 1937, courts considered fair use a relevant consideration in the context of common-law copyright, even if they did not find the use at issue fair.⁵¹⁷

In 2008, a New York trial court asserted that “New York cases acknowledge that fair use exists at common-law,” and denied a motion to preliminarily enjoin distribution of a documentary film that included an unlicensed pre-1972 sound recording.⁵¹⁸ The issue was raised again in *Flo & Eddie v. Sirius XM*,⁵¹⁹ where the court recognized fair use as a defense to common-law copyright infringement⁵²⁰ and treated fair use at common-law under the federal definition.⁵²¹ The court concluded that, because Sirius XM’s use was non-transformative and commercial,

512. Codified at 17 U.S.C. § 107 for purposes of federal law. Lydia Pallas Loren, *Fair Use: An Affirmative Defense?*, 90 WASH. L. REV. 685 (2015).

513. *Folsom v. Marsh*, 9 F.Cas. 342 (C.C.D. Mass. 1841).

514. *Harper & Row Publishers, Inc. v. Nation Enter.*, 471 U.S. 539, 549 (1985) (quoting H. BALL, *LAW OF COPYRIGHT AND LITERARY PROPERTY* 260 (1944)).

515. U.S. CONST. art. I, § 8, cl. 8.

516. *Harper & Row*, 471 U.S. at 550–51.

517. *Casino Productions v. Vitaphone Corp.*, 295 N.Y.S. 501 (1937) (use of several scenes from unpublished drama in motion picture is not fair use).

518. *EMI Records Ltd. v. Premise Media Corp. L.P.*, No. 601209/08, 2008 WL 5027245 (Sup. Ct. N.Y. Aug. 8, 2008).

519. *Flo & Eddie, Inc. v. Sirius XM Radio, Inc.*, 62 F.Supp.3d 325 (2014), *certifying questions to* 821 F.3d 265 (2d Cir. 2016).

520. *See Hemingway’s Estate v. Random House, Inc.*, 53 Misc. 2d 462, 466 (1967) (“Before an action may be maintained, there must be a showing of a significant appropriation of plaintiff’s property – significant both in volume and impact. In this regard, the federal law of copyright and the state law of common-law copyright are in accord. Where there is mere minor use of fragments of another’s work . . . such appropriation is characterized as a ‘fair use’, and is permitted”) (citations omitted).

521. *Id.*

“Sirius’s creation of the unauthorized copies fails to qualify as ‘fair use.’”⁵²²

Given that fair use is a judge-made equitable doctrine, it is unsurprising that fair use is available as a defense to common-law copyright infringement claims. However, each state will need to build its own body of common-law fair use, and thus far only New York has.

B. Remedies

One of the most notable aspects of federal copyright law is the availability of substantial damages without a showing of harm—up to \$150,000 per willful infringement.⁵²³ Due to the availability of these statutory damages, punitive damages are not generally permitted under federal copyright law.⁵²⁴ For common-law copyright, the situation is reversed. As the name implies, statutory damages are not available for infringements of common-law copyright, and the appropriate remedies are limited to actual and punitive damages.⁵²⁵ Awards of punitive damages for common-law copyright infringement are governed by the same constitutional limitations as awards of punitive damages in non-copyright settings.⁵²⁶

In theory this distinction is substantive, and suggests that in certain cases (like those involving file-sharing), there might be a meaningful distinction between pre-1972 and post-1972 sound recordings, because of the drastically lower per-infringement damages available. However, the issue was rarely addressed in the file-sharing lawsuits of the late 1990s and early 2000s, the first time individual listeners faced liability for infringement of intellectual property rights in sound recordings, whether because of ignorance of the law on the part of defendants, or because lawsuits were only brought for post-1972 sound recordings.⁵²⁷ During the public meetings held by the Copyright Office, Jennifer Pariser of the RIAA indicated that statutory damages were perhaps not of significantly greater interest to the recording industry than punitive

522. *Id.*

523. 17 U.S.C. § 504(c) (2012).

524. Lara A. Holzman & Melissa Mendelsohn, *Punitive Damages Under the Copyright Act*, INTELL. PROP. L. NEWSL., Winter 2005, at 21 (collecting cases); *Viacom Int’l Inc. v. Youtube, Inc.*, 540 F.Supp.2d 461, 464 (S.D.N.Y. 2008) (“[P]unitive damages cannot be recovered under the Copyright Act.”).

525. *Roy Exp. Co. Establishment of Vaduz, Liechtenstein v. Columbia Broad. Sys., Inc.*, 672 F.2d 1095, 1106 (2d Cir. 1982)

526. *Bridgeport Music, Inc. v. Justin Combs Pub.*, 507 F.3d 470, 486 (6th Cir. 2007).

527. In the Jammie Rasset-Thomas case, for instance, all twenty-two tracks were post-1972 sound recordings. David Kravets, *RIAA Trial Produces Playlist of the Century*, WIRED (Oct. 4, 2007), <https://www.wired.com/2007/10/trial-of-the-ce/>.

damages.⁵²⁸ This raises interesting questions of the importance of statutory damages as opposed to a more conventional damages regime, but there does not seem to be much evidence on the ground of how punitive damages play out in the individual infringer context.

IX. TAKING COMMON-LAW COPYRIGHT SERIOUSLY

Common-law copyright has too often been treated as statutory copyright by another name, but it is a fundamentally different doctrine. This has been masked by the structural similarities between common-law copyright and statutory copyright, but also the fact that with the preemption of common-law copyright with the 1976 Copyright Act, aside from the narrow niche of pre-1972 sound recordings, common-law copyright just isn't discussed or litigated anymore. However, in an era where broadcasting or distribution of sound recordings is not tied to a substantial infrastructure commitment, or even a physical presence, the amorphous contours of common-law copyright offer only minimal guidance or predictability, especially given that it is actually fifty distinct bodies of state common-law copyright law. The lawsuits against satellite and internet radio giants brought by Flo & Eddie and others are really only the tip of the iceberg of possible lawsuits. The ABS Lawsuits suggest that actions are possible not just against major radio chains, but also against independent radio stations. Outside of the Second Circuit, it is not clear that website operators have any safe harbor protections regarding pre-1972 sound recordings.

Examining the confusion over common-law copyright and sound recordings in the 1940s and 1950s, the copyright scholar Benjamin Kaplan noted that “[s]ome sheep are being treated like goats and the resulting mélange can satisfy no one except those who happen to profit from the confusion.”⁵²⁹ In this digital age of depressed revenues for the record business and a plethora of digital distribution avenues, there is no reason to think these performance rights lawsuits are anything but the tip of the iceberg for the possibilities for a wide array of lawsuits regarding common-law rights in pre-1972 sound recordings. Without the delineated rights and limitations of federal copyright law, Courts have largely had to resort to ad hoc determinations of equity in determining the scope of common-law copyright for sound recordings.⁵³⁰ Without reference to the history and structure of common-law copyright, the

528. U.S. COPYRIGHT OFFICE, PRE-1972 SOUND RECORDINGS PUBLIC MEETING 457 (June 3, 2011).

529. Kaplan, *Publication in Copyright Law: The Question of Phonograph Records*, 103 U. PA. L. REV. 469, 489 (1955).

result may be a legal chaos that benefits no-one except the lawyers.⁵³¹

The goal of this article has been to offer a gentle reminder that such precedents already exist for common-law copyright, if you care to find them. Common-law copyright is more than a handful of cases from the middle of the twentieth century regarding sound recordings, it is a doctrine that is hundreds of years old that has answers to many of the questions that are being asked. State courts are of course free to say what their state's common law is, but precedent offers numerous benefits, including predictability and doctrinal clarity and guidance. In lieu of a federalization that seems as far away as ever, (roughly) two hundred years of precedents regarding common-law copyright in the United States must be more than a footnote.

531. Noble as such cause may be.